



Benelux Office for
**Intellectual
Property**

BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2018827
of 20 June 2024

Opponent: **OUTRIGHT GAMES LIMITED**
Merlin House, Meteor Way Unit 54
PO13 9FU Lee-On-The-Solent
United Kingdom

Representative: **BRAND PROTECT LIMITED**
Retiro Verde, Castleknock Road
15 Dublin
Ireland

Trademark invoked: **International trademark 1611432**
OUTRIGHT GAMES

against


Defendant: **Brenda Munsterman h.o.d.n. Outright Projects**
Kapittellaan 16
6077 BL Sint Odiliënberg
Netherlands

Contested trademark: **Benelux trademark application 1479964**

o u t r i g h t
p r o j e c t s

I. FACTS AND PROCEEDINGS

A. Facts

1. The opposition is directed against the Benelux trademark application filed for services in classes 35 and 41, for the semi-figurative trademark . This application was processed under the number 1479964 and published on 13 March 2023.

2. On 9 May 2023, the opponent filed an opposition against this application. The opposition is based on the earlier international trademark registration 1611432 designating, among others, the European union territory, filed and registered on 12 April 2021 for goods and services in classes 9, 41 and 42, for the word trademark OUTRIGHT GAMES.

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

4. The opposition is directed against all the services of the contested application and is based on all the goods and services of the trademark invoked.

5. The language of the proceedings is English.

B. Proceedings

6. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: 'the Office') notified the parties on 10 May 2023. During the administrative phase of the proceedings both parties filed arguments. All the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: 'IR'). The administrative phase of the procedure was completed on 13 November 2023.

II. ARGUMENTS OF THE PARTIES

7. 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 the relevant trademarks and of the goods or services concerned.

A. Opponent's arguments

8. Relying on case law, the opponent first recalls some principles for examining the likelihood of confusion. Regarding the comparison of goods and services, the opponent states that the contested services 'organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes' in class 35 of the contested trademark are unrestricted in nature and can include events for the computer games industry, attracting the same audience and being complementary to 'computer games' covered in class 9 by the trademark invoked. Hence, the opponent finds these goods and services to be similar. Besides, the opponent considers that corporate and commercial events intended for promotion and advertising can also be entertaining; making the contested services of organizing events in class 35 similar to entertainment services covered in class 41 by the trademark invoked. The opponent also finds that corporate and commercial events often have an educational aspect, like the International Trademark Association's annual meeting, making the contested service of organizing events in class 35 similar to education services covered in class 41 by the trademark invoked.

9. Concerning the marketing services covered in class 35 by the contested trademark, the opponent explains that they are aimed at promoting and selling goods or services, which are inherently linked to computer games (class 9), education (class 41), entertainment (class 41) and software development (class 41) of the trademark invoked. According to the opponent, the same nature and intended purpose result in these goods and services being similar. Besides, the opponent states that marketing executives and creators of goods/services operate within the same trade channels, making marketing in class 35 similar to goods and services in classes 9, 41, and 42. The opponent is also of the opinion that publishing services covered by the contested trademark, which involve bringing products to market and working with marketing companies, are similar to marketing in class 35 of the trademark invoked due to the same nature, purpose, and trade channels. According to opponent, they are also complementary.

10. The opponent explains that cultural events are both entertaining and educational, and sporting events are entertaining and, organizing these events in class 41 is identical to education services and entertainment covered by the trademark invoked. According to the opponent, providing information and advice about events is synonymous with organizing events, making these services identical to those covered by the trademark invoked. Besides, the opponent finds the services – like organizing computer game competitions and other events – to be cultural, entertaining, and/or sporting events, making them identical or similar to 'education services, entertainment, information relating to the aforesaid, advice relating to the aforesaid, consultancy services relating to the aforesaid of the trademark invoked.

11. The opponent states that the services in question could be consumed by both the general public and professional consumers, and therefore finds the degree of attention of the relevant public to be likely average.

12. Regarding the comparison of signs, the opponent indicates that the verbal elements in the marks are English words understood by the Benelux public. In that context, the opponent gives the followings definition from the Collins dictionary: OUTRIGHT stands for 'open and direct; complete and total; without qualifications; instantly', PROJECTS refers to 'a task requiring time and effort; a detailed study by a pupil/student' and GAME(S) is the name for 'an activity or sport with rules, often involving skill, knowledge, or chance'. The opponent reminds that consumers focus more on the beginning of word signs, influencing the overall impression, and that word elements are typically more distinctive than figurative elements, making the public to see the stylization of OUTRIGHT in the contested trademark as decorative as he will focus on the words.

13. Visually, the opponent finds the first word in each mark to be identical, i.e. OUTRIGHT. This element being clearly the dominant element in the contested sign due to its enhanced size and position above the word PROJECTS. Conceptually, the opponent underlines that both trademarks have the word OUTRIGHT followed by a noun and explains that, in English, adjectives precede nouns, making the word OUTRIGHT an adjective. The opponent is of the opinion that both trademarks can mean open/direct/complete tasks and are therefore conceptually similar. Phonetically, the opponent explains the contested trademark to be pronounced as 'OWT-RITE PRO-JECTS' and the invoked trademark to be pronounced as 'OWT-RITE GAYMES' and therefore he finds that the signs share the first identical verbal element, making them aurally similar.

14. According to the opponent the trademarks invoked, as a whole, do not describe the goods or services for which it is registered. He finds the word GAMES to be descriptive of many of the game-related goods and services in classes 9, 41 and 42, leading to a greater emphasis on the element OUTRIGHT. Therefore, the opponent is of the opinion that the trademark invoked has at least a normal degree of distinctiveness.

15. For the above-mentioned reasons, the interdependence principle and the fact that consumers typically perceive marks as wholes rather than analyzing details, the opponent considers that it is likely that consumers would either confuse the marks for one another or believe that there is a commercial connection and association between the marks, which is not the case. The opponent also indicates that he is unaware of any other entities trading under the name OUTRIGHT in the Benelux, making it distinctive. According to the opponent, the contested trademark should be refused for the contested goods and services due to the likelihood of confusion and association under Article 2.2ter (1) BCIP. The opponent requests that the contested trademark be refused in its entirety and that costs be awarded in his favor.

B. Defendant's arguments

16. The defendant refuses the opponent's request for an award of costs. He explains that he tried to reach an agreement with the opponent multiple times to avoid the need for an official opposition, but the opponent did not respond. Since the opponent chose to proceed with the opposition knowing the costs involved, the defendant considers that the opponent accepted this financial risk. The defendant provided evidence of multiple attempts to contact the opponent and offered to adjust the contested trademark to prevent the opposition and associated costs.

17. The defendant also refuses the opponent's request to refuse the application in its entirety. He explains that he understands the opponent's concerns and remains willing to adjust the wording of the contested trademark. The defendant indicates that he is a sole proprietorship offering project, event, and product management services, as well as marketing services, and does not organize events under the contested trademark and therefore, there will be no public confusion about OUTRIGHTS PROJECTS as an event organizer. The defendant agrees that the original description of goods and services might cause confusion and proposes the following adjusted wording to clarify the nature of his services:

Class 35: Project and Event Management services for organizations that organize events, exhibitions, fairs, and shows for commercial, promotional, and advertising purposes at their own account and liability; Marketing.

Class 41: Project and Event Management services for organizations that organize events for cultural, entertainment, and sporting purposes at their own account and liability.

18. The defendant is open to further suggestions from the opponent to adjust the wording to avoid confusion and expresses hope that the opponent is willing to reach an agreement.

III. DECISION

A.1 Likelihood of confusion

19. 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.

20. 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.¹

21. 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.²

22. According to settled case-law of the Court of Justice of the European Union (hereinafter "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.³

Comparison of the trademarks

23. 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.⁴

24. 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.⁵

25. 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.⁶

26. 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.⁷ 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 of 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.⁸

¹ Art. 2.2ter (1)(b) BTIP 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.

² CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 and the case-law mentioned there (Equivälzenza).

⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

⁵ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

⁶ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivälzenza).


⁷ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivälzenza).

⁸ 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).

27. The assessment of the similarity between the signs, regarding the visual, phonetical 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.

28. Respect for the principle that both sides should be heard referred to in Article 2.16 (1) BCIP implies in particular that the examination of the opposition is limited to the arguments, facts and evidence put forward by the parties. The Rule 1.21 (d) IR states, in that respect, that facts to which the other party did not respond will be deemed as undisputed.

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

Opposition based on:	Opposition directed against:
OUTRIGHT GAMES	
CI 9 Games software; computer games; video game discs; video game cartridges; video game programs; computer game software; game development software; downloadable game software; virtual reality game software; augmented reality game software; software programs for video games; pre-recorded DVDs featuring games; interactive multimedia software for playing games; software development programmes; software development tools; application software; software; entertainment software; downloadable publications; electronic publications; mobile application software; multimedia software; computer hardware.	
	CI 35 Organization of events, exhibitions, fairs and shows for commercial, promotional and advertising purposes; Marketing.
CI 41 On-line game services; providing on-line computer games; video game entertainment services; providing online games; provision of online computer games; entertainment services in the nature of video games; electronic games services, including provision of computer games on-line or by means of a global computer network; education services; publishing, reporting, and writing of texts; multimedia publishing relating to interactive computer game software; entertainment; online entertainment services; electronic	CI 41 Organisation of events for cultural, entertainment and sporting purposes.

<p>publication services; publishing services; multimedia publishing; education services; organising of computer game competitions; organising competitions; organising of esports competitions; organising of entertainment competitions; organization of electronic game competitions; organisation of quizzes, games and competitions; providing electronic publications, not downloadable; information relating to the aforesaid; advice relating to the aforesaid; consultancy services relating to the aforesaid.</p>	
<p>Cl 42 Design of games; video game software design; video game software development; video game development services; design of computer game software; rental of computer game software; rental of video game software; programming of video game software; computer programming of computer games; development of hardware for video games; design and development of computer game software; development of computer hardware for computer games; technical services for the downloading of video games; software development; computer software development; software development services; software development, programming and implementation; web site hosting services; software as a service; computer hardware development; design services; leasing of computer software; computer software rental; information relating to the aforesaid; advice relating to the aforesaid; consultancy services relating to the aforesaid.</p>	

30. The trademark invoked is a word trademark consisting of two words, namely 'OUTRIGHT and 'GAMES'.

31. The contested trademark is a combined word/figurative trademark consisting of two words, namely 'OUTRIGHT' and 'PROJECTS', with the word 'OUTRIGHT' being depicted in a stylized font.

32. Where a sign is composed of verbal and figurative elements, the former should be, in principle, regarded as more distinctive than the latter, since the average consumer will more readily refer to the goods and/or services in question by citing the name than by describing the figurative elements of the

sign.⁹ In the present case, although the figurative element in the contested trademark is not negligible¹⁰, the consumer's attention will be directed primarily to the word element OUTRIGHT, given its size and position within the sign. Two trademarks are generally similar if, from the point of view of the relevant public, they are at least partially similar as regards one or more relevant aspects.¹¹

33. It is clear that the signs at stake share the dominant element 'OUTRIGHT' and only differ in their non-dominant elements 'projects' and 'games' respectively, and the figurative layout of the contested sign. The signs are therefore visually, phonetically and conceptually similar, which is not contested by the defendant. The Office therefore considers that it is not necessary to develop their similarity further.

34. The opponent argues that all the contested services are either identical or similar to the goods and services covered by the trademark invoked (see paragraphs 8-10). The Office agrees that the contested services in classes 35 and 41 share similarities with the services of the trademark invoked in class 41. The organisation of events, whether for cultural, entertainment or sporting purposes or for commercial, promotional or marketing purposes, share a common nature and are often offered by the same undertakings. This assertion is not contested by the defendant (see paragraph 17) and the identity or similarity of the goods and services is therefore *in confesso*. The Office therefore considers that it is not necessary to develop their similarity further.

A.2 Global assessment

35. 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 trademarks are important factors.

36. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question.¹² In the case at hand, the services considered identical/similar are directed at the public at large, as well as at business customers searching for business solutions. The degree of attention may vary from average to higher than average.

37. 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.¹³ In the present case, the trademark invoked has a normal distinctive character, given that it does not describe a characteristic of the goods in question.

38. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have 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.¹⁴

⁹ General Court (EU) 14 July 2005, T-312/03, ECLI:EU:T:2005:289, point 37 (SELENIUM-ACE).

¹⁰ Court of Appeal of The Hague 11 September 2012, 200.105.827/0, ECLI:NLGHSGR:2012:BX8916 (MOOVE-4MOVE).

¹¹ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, point 30 (Matratzen) ; CJEU 11 November 1997, C-251/95, ECLI:EU:C:1997:528, point 6 (Sabel).

¹² CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

¹³ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

¹⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there (Equivalenza).

39. The trademarks are similar as they share the same dominant element, and the services are similar. Based on the aforesaid, the Office concludes that the relevant public might believe that the services in question come from the same undertaking or from economically linked undertakings.

B. Other factors

40. The defendant refers to the history between the parties prior to the opposition proceedings (see paragraph 16). The Office points out that the opposition proceedings are intended to determine whether there is a likelihood of confusion between the trademarks. History between the parties cannot be taken into account in the context of these proceedings.

41. As regards to the defendant's arguments relating to the specification of its activities (see paragraph 17), the Office points out that the actual use of the trademarks in question cannot be taken into account in opposition proceedings, since the trademarks are compared solely on the basis of the data in the register or, where applicable, on the basis of proof of use (Article 2.16bis BCIP), which is not applicable in this case.¹⁵

42. As regards the defendant's proposal to restrict the list of services of the contested trademark (paragraph 17), the Office points out that a services restriction can only be taken into account if it is unambiguously and unconditionally requested to the Office. In the present case, the opposition could therefore only be examined on the basis of all the services initially requested.

C. Conclusion

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

IV. CONSEQUENCE

44. The opposition with number 2018827 is justified.

45. Benelux application 1479964 is not registered.

46. Since the opposition is justified, 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. This decision constitutes an enforceable order pursuant to article 2.16 (5) BCIP.

The Hague, 20 June 2024



Flavie Rougier
rapporteur

Marjolein Bronneman

Camille Janssen

Administrative officer:

Vincent Munier

¹⁵ CJEU 15 March 2007, C-171/06, ECLI:EU:C:2007:171, point 59 (Quantum).