

DECISION
of the Fourth Board of Appeal
of 19 June 2023

In case R 1901/2022-4

Intercontinental Great Brands LLC

100 Deforest Avenue
07936 East Hanover
United States

Opponent / Appellant

represented by HGF BV, Gedempt Hamerkanaal 147, 1021 KP Amsterdam, The Netherlands

v

**TAYYAR INVESTMENT FINANSAL YÖNETİM ANONİM
SİRKETİ**

Organize Sanayi Bölgesi 5.Cad. No:18 Merkez
Karaman
Turkey

Applicant / Defendant

represented by ADRIAN CĂVEȘCU, Str. Grivita 37E, 075100 Otopeni / Ilfov, Romania

APPEAL relating to Opposition Proceedings No B 3 125 209 (European Union trade mark application No 18 212 489)

THE FOURTH BOARD OF APPEAL

composed of N. Korjus (Chairperson), A. Kralik (Rapporteur) and C. Govers (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 18 March 2020, TAYYAR INVESTMENT FINANSAL YÖNETİM ANONİM ŞİRKETİ ('the applicant') sought to register the figurative mark



for the following list of goods and services:

Class 30: *Cocoa; Coffee-based beverages; Cocoa-based beverages; Chocolate-based beverages; Pasta; Jiaozi [stuffed dumplings]; Chinese stuffed dumplings (gyoza, cooked); Vareniki [stuffed dumplings]; Noodles; Bakery goods; Malt biscuits; Prepared desserts [chocolate based]; Chocolate desserts; Bread; Pitta bread; Pita chips; Sandwiches; Skin [pastry] for spring rolls; Pâtés en croûte; Chocolate pastries; Pastries containing creams; Shortcrust pastry; Pies; Baklava; Prepared desserts [pastries]; Prepared desserts [confectionery]; Instant dessert puddings; Custard; Instant pudding mixes; Rice pudding; Propolis; Propolis for food purposes; Honey; Food condiment consisting primarily of ketchup and salsa; Vanilla flavorings; Seasonings; Sauces [condiments]; Tomato sauce; Yeast; Baking powder; Flour; Semolina; Starch for food; Sugar; Cube sugar; Icing sugar; Tea; Iced tea; Confectionery; Chocolate; Salt crackers; Wafers; Chewing gum; Ice cream; Salt; Cereal-based snack food; Popcorn; Corn chips; Breakfast cereals; Processed wheat; Wheat germ for human consumption; Crushed barley; Oats for human consumption; Processed oats; Rice; Treacle; Pumpernickel; Rye flour; Rye full grain grist; Biscuits; Muesli desserts; Ice cream desserts; Flavored ices; Cereal preparations; Oat flakes; Chocolate candies; Coffee; Filled bread rolls; Egg roll cookies; Rolled wafers [biscuits]; Chocolate covered wafer biscuits; Chocolate caramel wafers; Multigrain-based snack foods; Pretzels; Soft pretzels; Bread rolls; Buns; Cream buns.*

Class 35: *Retail services in relation to savory sauces, chutneys and pastes; Retail services in relation to waffles; Retail services in relation to truffles [confectionery]; Retail services in relation to waffles with a chocolate coating; Retail services in relation to tiramisu; Retail services in relation to tablet (confectionary); Retail services in relation to dessert souffles; Retail services in relation to dessert mousses [confectionery]; Retail services in relation to chocolate mousses; Retail services in relation to viennoiserie; Retail services*

in relation to cinnamon rolls; Retail services in relation to turkish delight coated in chocolate; Retail services in relation to turkish delight; Retail services in relation to chocolate based products; Retail services in relation to confectionery items coated with chocolate; Retail services in relation to confectionery in frozen form; Retail services in relation to confectionery in liquid form; Retail services in relation to non-medicated confectionery in jelly form; Retail services in relation to non-medicated flour confectionery coated with chocolate; Retail services in relation to non-medicated flour confectionery containing chocolate; Retail services in relation to flavoured sugar confectionery; Retail services in relation to chocolate-coated sugar confectionery; Retail services in relation to nut confectionery; Retail services in relation to non-medicated chocolate confectionery; Retail services in relation to chocolate confectionery containing pralines; Retail services in relation to confectionery having liquid fruit fillings; Retail services in relation to mint flavoured confectionery (Non-medicated -); Retail services in relation to chocolate flavoured confectionery; Retail services in relation to frozen dairy confections; Retail services in relation to confectionery containing jelly; Retail services in relation to confectionery containing jam; Retail services in relation to boiled confectionery; Retail services in relation to baked goods; Retail services in relation to foodstuffs containing chocolate [as the main constituent]; Retail services in relation to wafered pralines; Retail services in relation to panettone; Retail services in relation to nougat; Retail services in relation to marzipan; Retail services in relation to halvah; Retail services in relation to snack foods consisting principally of confectionery; Retail services in relation to low-carbohydrate confectionery; Retail services in relation to prepared desserts [confectionery]; Retail services in relation to prepared desserts [chocolate based]; Retail services in relation to chocolate desserts; Retail services in relation to muesli desserts; Retail services in relation to instant dessert puddings; Retail services in relation to chocolate-based spreads; Retail services in relation to chocolate spreads for use on bread; Retail services in relation to cocoa based creams in the form of spreads; Retail services in relation to chocolate creams; Retail services in relation to croissants; Retail services in relation to chocolate; Retail services in relation to eight-treasure rice pudding; Retail services in relation to custard; Retail services in relation to fruited scones; Retail services in relation to chocolates; Retail services in relation to crackers flavoured with fruit; Retail services in relation to deep-fried dough sticks (Youtiao); Retail services in relation to chocolate coated nougat bars; Retail services in relation to hot chocolate mixes; Retail services in relation to kheer mix (rice pudding); Retail services in relation to chocolate-coated nuts; Retail services in relation to foods with a cocoa base; Retail services in relation to foodstuffs containing cocoa [as the main constituent]; Retail services in relation to tarts; Retail services in relation to petits fours [cakes]; Retail services in relation to brownies; Retail services in relation to fruit filled pastry products; Retail services in relation to fresh pasties; Retail services in relation to shortcrust pastry; Retail services in relation to long-life pastry; Retail services in relation to almond pastries; Retail services in relation to chocolate pastries; Retail services in relation to pastries containing creams and fruit; Retail services in relation to pastries containing creams; Retail services in relation to frozen pastries; Retail services in relation to pastries containing fruit; Retail services in relation to savory pastries; Retail services in relation to flour confectionery; Retail services in relation to chocolate covered cakes; Retail services in relation to deep chocolate cake made with chocolate sponge; Retail services in relation to malt cakes; Retail services in relation to oat cakes for human consumption; Retail services in relation to iced fruit cakes; Retail services in relation to fruit cakes; Retail services in relation to cream cakes; Retail services in relation to chocolate cakes; Retail services in relation to candied cakes of popped rice; Retail services in relation to steamed sponge cakes (fagao);

Retail services in relation to chocolate covered wafer biscuits; Retail services in relation to rolled wafers [biscuits]; Retail services in relation to wafers; Retail services in relation to shortbread part coated with chocolate; Retail services in relation to shortbread with a chocolate flavoured coating; Retail services in relation to shortbread with a chocolate coating; Retail services in relation to prepared desserts [pastries]; Retail services in relation to cream buns; Retail services in relation to muffins; Retail services in relation to biscuits having a chocolate coating; Retail services in relation to egg roll cookies; Retail services in relation to half covered chocolate biscuits; Retail services in relation to sweet biscuits for human consumption; Retail services in relation to oat biscuits for human consumption; Retail services in relation to chocolate biscuits; Retail services in relation to biscuits having a chocolate flavoured coating; Retail services in relation to biscuits with an iced topping; Retail services in relation to biscuits containing fruit; Retail services in relation to biscuits flavoured with fruit; Retail services in relation to biscuits containing chocolate flavoured ingredients; Retail services in relation to cake bars; Retail services in relation to cookie mixes; Retail services in relation to cereal cakes for human consumption; Retail services in relation to cereal products in bar form; Retail services in relation to cereal preparations consisting of bran; Retail services in relation to cereal preparations coated with sugar and honey; Retail services in relation to rice cake snacks; Retail services in relation to chocolate-coated bars; Retail services in relation to snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Retail services in relation to bars based on wheat; Retail services in relation to cereal based energy bars; Retail services in relation to sesame candy bars; Retail services in relation to oat bars; Retail services in relation to high-protein cereal bars; Retail services in relation to cereal bars; Retail services in relation to muesli bars; Retail services in relation to cereal based food bars; Retail services in relation to chocolate powder; Retail services in relation to cocoa powder; Retail services in relation to preparations for making beverages [coffee based]; Retail services in relation to preparations for making beverages [cocoa based]; Retail services in relation to preparations based on cocoa; Retail services in relation to drinking cocoa paste; Retail services in relation to cocoa beverages with milk; Retail services in relation to milk chocolates; Retail services in relation to hot chocolate; Retail services in relation to cocoa products; Retail services in relation to chocolate-based beverages with milk; Retail services in relation to coffee-based beverages; Retail services in relation to cocoa-based beverages; Retail services in relation to mixtures of coffee; Retail services in relation to cocoa mixes; Retail services in relation to chocolate-coated rice cakes; Retail services in relation to snack food products made from cereal flour; Retail services in relation to snack foods prepared from maize; Retail services in relation to snacks manufactured from muesli; Retail services in relation to snack foods made of whole wheat; Retail services in relation to snack foods consisting principally of extruded cereals; Retail services in relation to rice-based snack food; Retail services in relation to multigrain-based snack foods; Retail services in relation to snack foods made from wheat; Retail services in relation to cereal-based snack food; Retail services in relation to rice biscuits; Retail services in relation to chocolate-based meal replacement bars; Retail services in relation to cereal-based meal replacement bars; Retail services in relation to chocolate-based ready-to-eat food bars; Retail services in relation to canapes; Retail services in relation to oat clusters containing dried fruit; Wholesale services in relation to savory sauces, chutneys and pastes; Wholesale services in relation to waffles; Wholesale services in relation to truffles [confectionery]; Wholesale services in relation to waffles with a chocolate coating; Wholesale services in relation to tiramisu; Wholesale services in relation to tablet (confectionary); Wholesale services in relation to dessert souffles; Wholesale services in relation to dessert mousses [confectionery]; Wholesale services in

relation to chocolate mousses; Wholesale services in relation to viennoiserie; Wholesale services in relation to cinnamon rolls; Wholesale services in relation to turkish delight coated in chocolate; Wholesale services in relation to turkish delight; Wholesale services in relation to chocolate based products; Wholesale services in relation to confectionery items coated with chocolate; Wholesale services in relation to confectionery in frozen form; Wholesale services in relation to confectionery in liquid form; Wholesale services in relation to non-medicated confectionery in jelly form; Wholesale services in relation to non-medicated flour confectionery coated with chocolate; Wholesale services in relation to non-medicated flour confectionery containing chocolate; Wholesale services in relation to flavoured sugar confectionery; Wholesale services in relation to chocolate-coated sugar confectionery; Wholesale services in relation to nut confectionery; Wholesale services in relation to non-medicated chocolate confectionery; Wholesale services in relation to chocolate confectionery containing pralines; Wholesale services in relation to confectionery having liquid fruit fillings; Wholesale services in relation to mint flavoured confectionery (Non-medicated -); Wholesale services in relation to chocolate flavoured confectionery; Wholesale services in relation to frozen dairy confections; Wholesale services in relation to confectionery containing jelly; Wholesale services in relation to confectionery containing jam; Wholesale services in relation to boiled confectionery; Wholesale services in relation to baked goods; Wholesale services in relation to foodstuffs containing chocolate [as the main constituent]; Wholesale services in relation to wafered pralines; Wholesale services in relation to panettone; Wholesale services in relation to nougat; Wholesale services in relation to marzipan; Wholesale services in relation to halvah; Wholesale services in relation to snack foods consisting principally of confectionery; Wholesale services in relation to low-carbohydrate confectionery; Wholesale services in relation to prepared desserts [confectionery]; Wholesale services in relation to prepared desserts [chocolate based]; Wholesale services in relation to chocolate desserts; Wholesale services in relation to muesli desserts; Wholesale services in relation to instant dessert puddings; Wholesale services in relation to chocolate-based spreads; Wholesale services in relation to chocolate spreads for use on bread; Wholesale services in relation to cocoa based creams in the form of spreads; Wholesale services in relation to chocolate creams; Wholesale services in relation to croissants; Wholesale services in relation to chocolate; Wholesale services in relation to eight-treasure rice pudding; Wholesale services in relation to custard; Wholesale services in relation to fruited scones; Wholesale services in relation to chocolates; Wholesale services in relation to crackers flavoured with fruit; Wholesale services in relation to deep-fried dough sticks (Youtiao); Wholesale services in relation to chocolate coated nougat bars; Wholesale services in relation to hot chocolate mixes; Wholesale services in relation to kheer mix (rice pudding); Wholesale services in relation to chocolate-coated nuts; Wholesale services in relation to foods with a cocoa base; Wholesale services in relation to foodstuffs containing cocoa [as the main constituent]; Wholesale services in relation to tarts; Wholesale services in relation to petits fours [cakes]; Wholesale services in relation to brownies; Wholesale services in relation to fruit filled pastry products; Wholesale services in relation to fresh pasties; Wholesale services in relation to shortcrust pastry; Wholesale services in relation to long-life pastry; Wholesale services in relation to almond pastries; Wholesale services in relation to chocolate pastries; Wholesale services in relation to pastries containing creams and fruit; Wholesale services in relation to pastries containing creams; Wholesale services in relation to frozen pastries; Wholesale services in relation to pastries containing fruit; Wholesale services in relation to savory pastries; Wholesale services in relation to flour confectionery; Wholesale services in relation to chocolate covered cakes; Wholesale services in relation to deep chocolate cake made with chocolate

sponge; Wholesale services in relation to malt cakes; Wholesale services in relation to oat cakes for human consumption; Wholesale services in relation to iced fruit cakes; Wholesale services in relation to fruit cakes; Wholesale services in relation to cream cakes; Wholesale services in relation to chocolate cakes; Wholesale services in relation to candied cakes of popped rice; Wholesale services in relation to steamed sponge cakes (fagao); Wholesale services in relation to chocolate covered wafer biscuits; Wholesale services in relation to rolled wafers [biscuits]; Wholesale services in relation to wafers; Wholesale services in relation to shortbread part coated with chocolate; Wholesale services in relation to shortbread with a chocolate flavoured coating; Wholesale services in relation to shortbread with a chocolate coating; Wholesale services in relation to prepared desserts [pastries]; Wholesale services in relation to cream buns; Wholesale services in relation to muffins; Wholesale services in relation to biscuits having a chocolate coating; Wholesale services in relation to egg roll cookies; Wholesale services in relation to half covered chocolate biscuits; Wholesale services in relation to sweet biscuits for human consumption; Wholesale services in relation to oat biscuits for human consumption; Wholesale services in relation to chocolate biscuits; Wholesale services in relation to biscuits having a chocolate flavoured coating; Wholesale services in relation to biscuits with an iced topping; Wholesale services in relation to biscuits containing fruit; Wholesale services in relation to biscuits flavoured with fruit; Wholesale services in relation to biscuits containing chocolate flavoured ingredients; Wholesale services in relation to cake bars; Wholesale services in relation to cookie mixes; Wholesale services in relation to cereal cakes for human consumption; Wholesale services in relation to cereal products in bar form; Wholesale services in relation to cereal preparations consisting of bran; Wholesale services in relation to cereal preparations coated with sugar and honey; Wholesale services in relation to rice cake snacks; Wholesale services in relation to chocolate-coated bars; Wholesale services in relation to snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Wholesale services in relation to bars based on wheat; Wholesale services in relation to cereal based energy bars; Wholesale services in relation to sesame candy bars; Wholesale services in relation to oat bars; Wholesale services in relation to high-protein cereal bars; Wholesale services in relation to cereal bars; Wholesale services in relation to muesli bars; Wholesale services in relation to cereal based food bars; Wholesale services in relation to chocolate powder; Wholesale services in relation to cocoa powder; Wholesale services in relation to preparations for making beverages [coffee based]; Wholesale services in relation to preparations for making beverages [cocoa based]; Wholesale services in relation to preparations based on cocoa; Wholesale services in relation to drinking cocoa paste; Wholesale services in relation to cocoa beverages with milk; Wholesale services in relation to milk chocolates; Wholesale services in relation to hot chocolate; Wholesale services in relation to cocoa products; Wholesale services in relation to chocolate-based beverages with milk; Wholesale services in relation to coffee-based beverages; Wholesale services in relation to cocoa-based beverages; Wholesale services in relation to mixtures of coffee; Wholesale services in relation to cocoa mixes; Wholesale services in relation to chocolate-coated rice cakes; Wholesale services in relation to snack food products made from cereal flour; Wholesale services in relation to snack foods prepared from maize; Wholesale services in relation to snacks manufactured from muesli; Wholesale services in relation to snack foods made of whole wheat; Wholesale services in relation to snack foods consisting principally of extruded cereals; Wholesale services in relation to rice-based snack food; Wholesale services in relation to multigrain-based snack foods; Wholesale services in relation to snack foods made from wheat; Wholesale services in relation to cereal-based snack food; Wholesale services in relation to rice biscuits; Wholesale services in relation to chocolate-

based meal replacement bars; Wholesale services in relation to cereal-based meal replacement bars; Wholesale services in relation to chocolate-based ready-to-eat food bars; Wholesale services in relation to canapes; Wholesale services in relation to oat clusters containing dried fruit; Catalogue retail services in relation to savory sauces, chutneys and pastes; Catalogue retail services in relation to waffles; Catalogue retail services in relation to truffles [confectionery]; Catalogue retail services in relation to waffles with a chocolate coating; Catalogue retail services in relation to tiramisu; Catalogue retail services in relation to tablet (confectionary); Catalogue retail services in relation to dessert souffles; Catalogue retail services in relation to dessert mousses [confectionery]; Catalogue retail services in relation to chocolate mousses; Catalogue retail services in relation to viennoiserie; Catalogue retail services in relation to cinnamon rolls; Catalogue retail services in relation to turkish delight coated in chocolate; Catalogue retail services in relation to turkish delight; Catalogue retail services in relation to chocolate based products; Catalogue retail services in relation to confectionery items coated with chocolate; Catalogue retail services in relation to confectionery in frozen form; Catalogue retail services in relation to confectionery in liquid form; Catalogue retail services in relation to non-medicated confectionery in jelly form; Catalogue retail services in relation to non-medicated flour confectionery coated with chocolate; Catalogue retail services in relation to non-medicated flour confectionery containing chocolate; Catalogue retail services in relation to flavoured sugar confectionery; Catalogue retail services in relation to chocolate-coated sugar confectionery; Catalogue retail services in relation to nut confectionery; Catalogue retail services in relation to non-medicated chocolate confectionery; Catalogue retail services in relation to chocolate confectionery containing pralines; Catalogue retail services in relation to confectionery having liquid fruit fillings; Catalogue retail services in relation to mint flavoured confectionery (Non-medicated -); Catalogue retail services in relation to chocolate flavoured confectionery; Catalogue retail services in relation to frozen dairy confections; Catalogue retail services in relation to confectionery containing jelly; Catalogue retail services in relation to confectionery containing jam; Catalogue retail services in relation to boiled confectionery; Catalogue retail services in relation to bakery goods; Catalogue retail services in relation to foodstuffs containing chocolate [as the main constituent]; Catalogue retail services in relation to wafered pralines; Catalogue retail services in relation to panettone; Catalogue retail services in relation to nougat; Catalogue retail services in relation to marzipan; Catalogue retail services in relation to halvah; Catalogue retail services in relation to snack foods consisting principally of confectionery; Catalogue retail services in relation to low-carbohydrate confectionery; Catalogue retail services in relation to prepared desserts [confectionery]; Catalogue retail services in relation to prepared desserts [chocolate based]; Catalogue retail services in relation to chocolate desserts; Catalogue retail services in relation to muesli desserts; Catalogue retail services in relation to instant dessert puddings; Catalogue retail services in relation to chocolate-based spreads; Catalogue retail services in relation to chocolate spreads for use on bread; Catalogue retail services in relation to cocoa based creams in the form of spreads; Catalogue retail services in relation to chocolate creams; Catalogue retail services in relation to croissants; Catalogue retail services in relation to chocolate; Catalogue retail services in relation to eight-treasure rice pudding; Catalogue retail services in relation to custard; Catalogue retail services in relation to fruited scones; Catalogue retail services in relation to chocolates; Catalogue retail services in relation to crackers flavoured with fruit; Catalogue retail services in relation to deep-fried dough sticks (Youtiao); Catalogue retail services in relation to chocolate coated nougat bars; Catalogue retail services in relation to hot chocolate mixes; Catalogue retail services in relation to kheer mix (rice pudding);

Catalogue retail services in relation to chocolate-coated nuts; Catalogue retail services in relation to foods with a cocoa base; Catalogue retail services in relation to foodstuffs containing cocoa [as the main constituent]; Catalogue retail services in relation to tarts; Catalogue retail services in relation to petits fours [cakes]; Catalogue retail services in relation to brownies; Catalogue retail services in relation to fruit filled pastry products; Catalogue retail services in relation to fresh pasties; Catalogue retail services in relation to shortcrust pastry; Catalogue retail services in relation to long-life pastry; Catalogue retail services in relation to almond pastries; Catalogue retail services in relation to chocolate pastries; Catalogue retail services in relation to pastries containing creams and fruit; Catalogue retail services in relation to pastries containing creams; Catalogue retail services in relation to frozen pastries; Catalogue retail services in relation to pastries containing fruit; Catalogue retail services in relation to savory pastries; Catalogue retail services in relation to flour confectionery; Catalogue retail services in relation to chocolate covered cakes; Catalogue retail services in relation to deep chocolate cake made with chocolate sponge; Catalogue retail services in relation to malt cakes; Catalogue retail services in relation to oat cakes for human consumption; Catalogue retail services in relation to iced fruit cakes; Catalogue retail services in relation to fruit cakes; Catalogue retail services in relation to cream cakes; Catalogue retail services in relation to chocolate cakes; Catalogue retail services in relation to candied cakes of popped rice; Catalogue retail services in relation to steamed sponge cakes (fagao); Catalogue retail services in relation to chocolate covered wafer biscuits; Catalogue retail services in relation to rolled wafers [biscuits]; Catalogue retail services in relation to wafers; Catalogue retail services in relation to shortbread part coated with chocolate; Catalogue retail services in relation to shortbread with a chocolate flavoured coating; Catalogue retail services in relation to shortbread with a chocolate coating; Catalogue retail services in relation to prepared desserts [pastries]; Catalogue retail services in relation to cream buns; Catalogue retail services in relation to muffins; Catalogue retail services in relation to biscuits having a chocolate coating; Catalogue retail services in relation to egg roll cookies; Catalogue retail services in relation to half covered chocolate biscuits; Catalogue retail services in relation to sweet biscuits for human consumption; Catalogue retail services in relation to oat biscuits for human consumption; Catalogue retail services in relation to chocolate biscuits; Catalogue retail services in relation to biscuits having a chocolate flavoured coating; Catalogue retail services in relation to biscuits with an iced topping; Catalogue retail services in relation to biscuits containing fruit; Catalogue retail services in relation to biscuits flavoured with fruit; Catalogue retail services in relation to biscuits containing chocolate flavoured ingredients; Catalogue retail services in relation to cake bars; Catalogue retail services in relation to cookie mixes; Catalogue retail services in relation to cereal cakes for human consumption; Catalogue retail services in relation to cereal products in bar form; Catalogue retail services in relation to cereal preparations consisting of bran; Catalogue retail services in relation to cereal preparations coated with sugar and honey; Catalogue retail services in relation to rice cake snacks; Catalogue retail services in relation to chocolate-coated bars; Catalogue retail services in relation to snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Catalogue retail services in relation to bars based on wheat; Catalogue retail services in relation to cereal based energy bars; Catalogue retail services in relation to sesame candy bars; Catalogue retail services in relation to oat bars; Catalogue retail services in relation to high-protein cereal bars; Catalogue retail services in relation to cereal bars; Catalogue retail services in relation to muesli bars; Catalogue retail services in relation to cereal based food bars; Catalogue retail services in relation to chocolate powder; Catalogue retail services in relation to cocoa powder; Catalogue retail services in relation to preparations for making

beverages [coffee based]; Catalogue retail services in relation to preparations for making beverages [cocoa based]; Catalogue retail services in relation to preparations based on cocoa; Catalogue retail services in relation to drinking cocoa paste; Catalogue retail services in relation to cocoa beverages with milk; Catalogue retail services in relation to milk chocolates; Catalogue retail services in relation to hot chocolate; Catalogue retail services in relation to cocoa products; Catalogue retail services in relation to chocolate-based beverages with milk; Catalogue retail services in relation to coffee-based beverages; Catalogue retail services in relation to cocoa-based beverages; Catalogue retail services in relation to mixtures of coffee; Catalogue retail services in relation to cocoa mixes; Catalogue retail services in relation to chocolate-coated rice cakes; Catalogue retail services in relation to snack food products made from cereal flour; Catalogue retail services in relation to snack foods prepared from maize; Catalogue retail services in relation to snacks manufactured from muesli; Catalogue retail services in relation to snack foods made of whole wheat; Catalogue retail services in relation to snack foods consisting principally of extruded cereals; Catalogue retail services in relation to rice-based snack food; Catalogue retail services in relation to multigrain-based snack foods; Catalogue retail services in relation to snack foods made from wheat; Catalogue retail services in relation to cereal-based snack food; Catalogue retail services in relation to rice biscuits; Catalogue retail services in relation to chocolate-based meal replacement bars; Catalogue retail services in relation to cereal-based meal replacement bars; Catalogue retail services in relation to chocolate-based ready-to-eat food bars; Catalogue retail services in relation to canapes; Catalogue retail services in relation to oat clusters containing dried fruit; Online retail services in relation to savory sauces, chutneys and pastes; Online retail services in relation to waffles; Online retail services in relation to truffles [confectionery]; Online retail services in relation to waffles with a chocolate coating; Online retail services in relation to tiramisu; Online retail services in relation to tablet (confectionary); Online retail services in relation to dessert souffles; Online retail services in relation to dessert mousses [confectionery]; Online retail services in relation to chocolate mousses; Online retail services in relation to viennoiserie; Online retail services in relation to cinnamon rolls; Online retail services in relation to turkish delight coated in chocolate; Online retail services in relation to turkish delight; Online retail services in relation to chocolate based products; Online retail services in relation to confectionery items coated with chocolate; Online retail services in relation to confectionery in frozen form; Online retail services in relation to confectionery in liquid form; Online retail services in relation to non-medicated confectionery in jelly form; Online retail services in relation to non-medicated flour confectionery coated with chocolate; Online retail services in relation to non-medicated flour confectionery containing chocolate; Online retail services in relation to flavoured sugar confectionery; Online retail services in relation to chocolate-coated sugar confectionery; Online retail services in relation to nut confectionery; Online retail services in relation to non-medicated chocolate confectionery; Online retail services in relation to chocolate confectionery containing pralines; Online retail services in relation to confectionery having liquid fruit fillings; Online retail services in relation to mint flavoured confectionery (Non-medicated -); Online retail services in relation to chocolate flavoured confectionery; Online retail services in relation to frozen dairy confections; Online retail services in relation to confectionery containing jelly; Online retail services in relation to confectionery containing jam; Online retail services in relation to boiled confectionery; Online retail services in relation to bakery goods; Online retail services in relation to foodstuffs containing chocolate [as the main constituent]; Online retail services in relation to wafered pralines; Online retail services in relation to panettone; Online retail services in relation to nougat; Online retail services in relation to marzipan; Online

retail services in relation to halvah; Online retail services in relation to snack foods consisting principally of confectionery; Online retail services in relation to low-carbohydrate confectionery; Online retail services in relation to prepared desserts [confectionery]; Online retail services in relation to prepared desserts [chocolate based]; Online retail services in relation to chocolate desserts; Online retail services in relation to muesli desserts; Online retail services in relation to instant dessert puddings; Online retail services in relation to chocolate-based spreads; Online retail services in relation to chocolate spreads for use on bread; Online retail services in relation to cocoa based creams in the form of spreads; Online retail services in relation to chocolate creams; Online retail services in relation to croissants; Online retail services in relation to chocolate; Online retail services in relation to eight-treasure rice pudding; Online retail services in relation to custard; Online retail services in relation to fruited scones; Online retail services in relation to chocolates; Online retail services in relation to crackers flavoured with fruit; Online retail services in relation to deep-fried dough sticks (Youtiao); Online retail services in relation to chocolate coated nougat bars; Online retail services in relation to hot chocolate mixes; Online retail services in relation to kheer mix (rice pudding); Online retail services in relation to chocolate-coated nuts; Online retail services in relation to foods with a cocoa base; Online retail services in relation to foodstuffs containing cocoa [as the main constituent]; Online retail services in relation to tarts; Online retail services in relation to petits fours [cakes]; Online retail services in relation to brownies; Online retail services in relation to fruit filled pastry products; Online retail services in relation to fresh pasties; Online retail services in relation to shortcrust pastry; Online retail services in relation to long-life pastry; Online retail services in relation to almond pastries; Online retail services in relation to chocolate pastries; Online retail services in relation to pastries containing creams and fruit; Online retail services in relation to pastries containing creams; Online retail services in relation to frozen pastries; Online retail services in relation to pastries containing fruit; Online retail services in relation to savory pastries; Online retail services in relation to flour confectionery; Online retail services in relation to chocolate covered cakes; Online retail services in relation to deep chocolate cake made with chocolate sponge; Online retail services in relation to malt cakes; Online retail services in relation to oat cakes for human consumption; Online retail services in relation to iced fruit cakes; Online retail services in relation to fruit cakes; Online retail services in relation to cream cakes; Online retail services in relation to chocolate cakes; Online retail services in relation to candied cakes of popped rice; Online retail services in relation to steamed sponge cakes (fagao); Online retail services in relation to chocolate covered wafer biscuits; Online retail services in relation to rolled wafers [biscuits]; Online retail services in relation to wafers; Online retail services in relation to shortbread part coated with chocolate; Online retail services in relation to shortbread with a chocolate flavoured coating; Online retail services in relation to shortbread with a chocolate coating; Online retail services in relation to prepared desserts [pastries]; Online retail services in relation to cream buns; Online retail services in relation to muffins; Online retail services in relation to biscuits having a chocolate coating; Online retail services in relation to egg roll cookies; Online retail services in relation to half covered chocolate biscuits; Online retail services in relation to sweet biscuits for human consumption; Online retail services in relation to oat biscuits for human consumption; Online retail services in relation to chocolate biscuits; Online retail services in relation to biscuits having a chocolate flavoured coating; Online retail services in relation to biscuits with an iced topping; Online retail services in relation to biscuits containing fruit; Online retail services in relation to biscuits flavoured with fruit; Online retail services in relation to biscuits containing chocolate flavoured ingredients; Online

retail services in relation to cake bars; Online retail services in relation to cookie mixes; Online retail services in relation to cereal cakes for human consumption; Online retail services in relation to cereal products in bar form; Online retail services in relation to cereal preparations consisting of bran; Online retail services in relation to cereal preparations coated with sugar and honey; Online retail services in relation to rice cake snacks; Online retail services in relation to chocolate-coated bars; Online retail services in relation to snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Online retail services in relation to bars based on wheat; Online retail services in relation to cereal based energy bars; Online retail services in relation to sesame candy bars; Online retail services in relation to oat bars; Online retail services in relation to high-protein cereal bars; Online retail services in relation to cereal bars; Online retail services in relation to muesli bars; Online retail services in relation to cereal based food bars; Online retail services in relation to chocolate powder; Online retail services in relation to cocoa powder; Online retail services in relation to preparations for making beverages [coffee based]; Online retail services in relation to preparations for making beverages [cocoa based]; Online retail services in relation to preparations based on cocoa; Online retail services in relation to drinking cocoa paste; Online retail services in relation to cocoa beverages with milk; Online retail services in relation to milk chocolates; Online retail services in relation to hot chocolate; Online retail services in relation to cocoa products; Online retail services in relation to chocolate-based beverages with milk; Online retail services in relation to coffee-based beverages; Online retail services in relation to cocoa-based beverages; Online retail services in relation to mixtures of coffee; Online retail services in relation to cocoa mixes; Online retail services in relation to chocolate-coated rice cakes; Online retail services in relation to snack food products made from cereal flour; Online retail services in relation to snack foods prepared from maize; Online retail services in relation to snacks manufactured from muesli; Online retail services in relation to snack foods made of whole wheat; Online retail services in relation to snack foods consisting principally of extruded cereals; Online retail services in relation to rice-based snack food; Online retail services in relation to multigrain-based snack foods; Online retail services in relation to snack foods made from wheat; Online retail services in relation to cereal-based snack food; Online retail services in relation to rice biscuits; Online retail services in relation to chocolate-based meal replacement bars; Online retail services in relation to cereal-based meal replacement bars; Online retail services in relation to chocolate-based ready-to-eat food bars; Online retail services in relation to canapes; Online retail services in relation to oat clusters containing dried fruit.

- 2 The application was published on 30 March 2020.
- 3 On 29 June 2020, Intercontinental Great Brands LLC ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods and services.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) and Article 8(5) EUTMR.

5 The opposition was based on, inter alia, the following earlier rights:

- EUTM registration No 8 640 658 for the figurative mark



filed on 26 October 2009, registered on 10 May 2010, and duly renewed until 26 October 2029 for the following goods:

Class 30: Coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice.

- EUTM registration No 18 078 020 for the figurative mark



filed on 5 June 2019 and registered on 30 November 2019 for the following goods:

Class 29: Dairy products, especially dairy desserts and chilled dairy desserts, including crèmes [dairy products] and yoghurt products.

Class 30: Mousses.

- EUTM registration No 129 577 for the word mark

OREO

filed on 1 April 1996, registered on 29 March 2005, and renewed until 1 April 2026 for the following goods:

Class 30: Rice, pasta; cereals, cereal preparations, preparations made from wheat, cereal breakfast foods, confectionery, frozen confectionery, non-medicated confectionery having breath freshening properties; candy, chewing gum and bubble gum; syrups, honey, sauces, chocolate, imitation chocolate, cakes, sponges, pastries, biscuits, cookies, crackers, pancakes and waffles, scones, pastry and puddings, flans; bread, sugar and natural sweeteners; foodstuffs prepared in the form of snack foods, fillings, sandwiches, meals and constituents therefor, mixes for making bakery products; preparations consisting wholly or principally of nuts, all included in Class 30.

- 6 By decision of 29 July 2022 ('the contested decision'), the Opposition Division partially upheld the opposition and refused the trade mark applied for, for part of the contested goods and services, namely the following:

Class 30: Cocoa; cocoa-based beverages; chocolate-based beverages; bakery goods; malt biscuits; prepared desserts [chocolate based]; chocolate desserts; chocolate pastries; pastries containing creams; shortcrust pastry; pies; prepared desserts [pastries]; prepared desserts [confectionery]; instant dessert puddings; custard; instant pudding mixes; confectionery; chocolate; wafers; ice cream; cereal-based snack food; breakfast cereals; biscuits; muesli desserts; ice cream desserts; flavored ices; cereal preparations; chocolate candies; egg roll cookies; rolled wafers [biscuits]; chocolate covered wafer biscuits; chocolate caramel wafers; multigrain-based snack foods; pretzels; soft pretzels; bread rolls; buns; cream buns.

Class 35: Retail service in relation to/wholesale services in relation to/catalogue retail services in relation to/online retail services in relation to the following goods: *waffles; truffles [confectionery]; waffles with a chocolate coating; tiramisu; dessert souffles; dessert mousses [confectionery]; chocolate mousses; Viennoiserie; cinnamon rolls; chocolate based products; confectionery items coated with chocolate; confectionery in frozen form; non-medicated flour confectionery coated with chocolate; non-medicated flour confectionery containing chocolate; non-medicated chocolate confectionery; chocolate confectionery containing pralines; chocolate flavoured confectionery; foodstuffs containing chocolate [as the main constituent]; wafered pralines; snack foods consisting principally of confectionery; low-carbohydrate confectionery; prepared desserts [confectionery]; prepared desserts [chocolate based]; chocolate desserts; muesli desserts; chocolate; chocolates; foods with a cocoa base; foodstuffs containing cocoa [as the main constituent]; brownies; long-life pastry; chocolate pastries; flour confectionery; chocolate covered wafer biscuits; rolled wafers [biscuits]; wafers; prepared desserts [pastries]; cream buns; muffins; biscuits having a chocolate coating; egg roll cookies; half covered chocolate biscuits; sweet biscuits for human consumption; oat biscuits for human consumption; chocolate biscuits; biscuits having a chocolate flavoured coating; biscuits with an iced topping; biscuits containing fruit; biscuits flavoured with fruit; biscuits containing chocolate flavoured ingredients; cake bars; cookie mixes; cereal cakes for human consumption; cereal products in bar form; cereal preparations consisting of bran; cereal preparations coated with sugar and honey; chocolate-coated bars; bars based on wheat; cereal based energy bars; high-protein cereal bars; cereal bars; muesli bars; cereal based food bars; preparations based on cocoa; cocoa products; snack food products made from cereal flour; snacks manufactured from muesli; snack foods made of whole wheat; snack foods consisting principally of extruded cereals; multigrain-based snack foods; snack foods made from wheat; cereal-based snack food; chocolate-based meal replacement bars; cereal-based meal replacement bars; chocolate-based ready-to-eat food bars, as well as in relation to retail service in relation to/wholesale services in relation to: baked goods.*

The mark applied for was allowed to proceed for the remaining goods and services and each party was ordered to bear its own costs. The Opposition Division gave, in particular, the following grounds for its decision:

Proof of use

- Proof of use was requested by the applicant in relation to, inter alia, earlier right EUTM No 129 577 and as it was requested to keep certain commercial data

confidential, the evidence is only described in the most general terms without divulging any such data and is listed below:

- Attachment 1: extracts of Fact Sheet, dated 2017, containing (historic) facts and statistics regarding the OREO brand and its global presence, stating that ‘OREO’ is the world’s favourite cookie and the best-selling cookie brand of the 21st century, with over 2\$ billion in global annual revenues (2016). Oreo cookies may be found in more than 100 countries, whereas its biggest markets in Europe are Spain and Germany;
- Attachment 2: printouts from the official webpage of the opponent - www.oreo.eu, available in Greek, German, Spanish, French and English (dated 2021), on which a figurative sign consisting of the verbal element ‘OREO’ can be seen



;


- Attachment 3: printouts from the WayBackMachine, containing previous versions of web pages from the opponent’s website archived from dates in 2015, 2016, 2017, 2018 and 2019;
- Attachment 4-8: printouts from various social media channels showing the presence of the brand OREO online, in particular on Facebook, Twitter, Instagram, Instagram (Portugal) and YouTube (Facebook page has a reach of over 41 million likes and Twitter 917 thousand followers; OREO Instagram has a reach of over 3.1 million followers);



- Attachment 9: various samples of packaging, displays and cases, which, according to the opponent, have been all used for the EU market in the period 2015-2020;
- Attachment 10: printouts of online articles, discussing the most recent collaborations of the brand OREO with the iconic popstar Lady Gaga, blockbuster TV shows ‘Game of Thrones’, Google’s Android, and a longstanding partnership with McDonalds;
- Attachment 11: judgment 28/05/2020, T-677/18, GULLÓN TWINS COOKIE SANDWICH (fig.) / OREO et al., EU:T:2020:229, confirming that the evidence clearly demonstrated that the earlier OREO cookie mark had been used in a

prolonged and intensive manner and benefited from a reputation in Spain, with a consolidated position as a market leader, as shown by independent sources;

- Attachment 12: media articles and online publications, dated between 2016 and 2020 and containing references to the opponent's brand and its commercial success: (extracts taken from <https://www.sweetpress.com>; <https://www.lavanguardia.com>; www.marketingnews.es; www.youtube.com; www.alimarket.es);
- Attachment 13: printouts from the website of various grocery retail chains in the EU (The Netherlands, Germany, and France);
- Attachment 14: extracts, originating from the opponent's company group (Mondelez), showing media expenditures in relation to the OREO brand for, inter alia, France, Germany, and Spain (between 2016 and 2020): #PlaywithOreo campaign; #Athemewithoreo campaign; www.campaignlive.com; #CookieWithACause;
- Attachment 15: a copy of a decision issued by the Turkish PTO in opposition ALDIVA PORLEO, dated 02/11/2020, in which the application is rejected since it 'was filed in bad faith as the applicant "knowingly acted in violation of the fair trade principles in order to gain an unfair advantage"'.
- Attachment 16: PowerPoint document with OREO sales figures and market share data from the years 2018-2020 in several EU countries (France, Germany, Spain, and the UK), given as sales per country for the relevant period compared, together with the opponent's market share thereof. The data originates from Nielsen GPS.
- Attachment 17: a few advertisements in food and fashion press magazines Cosmopolitan and Joy, dated February 2020. Both feature the brand OREO and have a circulation number of 358 941.
- Attachment 18: 2017 summary deck for the OREO CRIPSY & THIN launch in Germany. The attachment also contains the various marketing tools that were aimed to be used, among which a 22-week TV commercial, mobile ads, and an immense social media campaign. The attachment contains the anticipated market penetration figures, totalling up to a reach of over 300 million;
- Attachment 19: materials from the 'OREO Stay Playful Twist your style campaign', promo mechanism, for 2020 in Germany;
- Attachment 20: an article that was published on the German MDLZ corporate website, discussing several OREO promotions in 2019;
- Attachment 21: displays of the PLAY WITH OREO campaign of 2015 which were located at REWE Frankenthal, in Germany;
- Attachment 22: 2015 summary deck for the "Let wonder loose in Germany";
- Attachment 23: German supermarket leaflets (REWE and EDEKA) all featuring OREO branded products in the period 2016-2021;
- Attachment 24: details of the "Great Oreo Cookie Search" campaign which ran in 2018 in Germany;
- Attachment 25: stills from two OREO TV commercials that ran in France in 2018; and two media articles from 2018;

- Attachment 26: article from the Effie Awards website (<https://www.effie.org/>) showing printouts from the website and the 2019 winner's list (which include the 'OREO' campaign);
 - Attachments 27-28: photos of the Award winning campaign "Do you Speak Oreo" in French supermarkets, as well as screenshots of #doyouspeakoreo campaign on social media. All photo's feature 'OREO' branded products and advertising and originate from 2018;
 - Attachments 29-30: #OREOPEOPLE Prize Posters, which were used on social media in the period January 2019-August 2019 and of content and post for the OREO France Facebook feed from June 2020 onwards;
 - Attachments 31 and 32: Spanish supermarket leaflets (a.o. Eroski, Hipercor, Carrefour) all featuring OREO branded products in the period 2018-2020, as well as various photos of point of sales materials in Spain supermarkets;
 - Attachment 33: stills from various OREO TV commercials that ran in Spain in 2015-2019, all featuring the brand;
 - Attachment 34: extracts presenting the opponent's 'OREO Academy campaign', dated 2020;
 - Attachments 35-36: OREO instore activity dated between 2017 and 2020, adds and TV commercials dated between 2016 and 2020, concerning the territory of the UK.
 - In addition evidence was also provided such as invoices, issued by the opponent for the period between 2015 and 2010, directed at distributors in France, Belgium, Italy, Spain, concerning sales of 'OREO' products
- In an overall assessment of the evidence submitted, it is clear that the earlier mark OREO has been genuinely used in the form as registered, mostly , and in relation to cookies and biscuits. A significant and sufficient part of the material also refers to the relevant period and to the relevant territory, i.e. France, Spain, Italy, Belgium, Germany, the Netherlands, and Portugal. Sufficient information concerning the commercial volume, territorial scope, duration, and frequency of use has also been provided.
- The extensive number of articles and publications concerning the opponent's brand, media expenditures presented in relation to promotions and campaigns, sales reflected in the singular invoices or the overview reports of market sales, rankings concerning the brand, including Attachment 12 ('OREO' is ranked in 22nd position worldwide in the Brand Footprint report Kantar for 2020), show genuine use of the mark as registered during the relevant period for the goods at issue in the territory of the European Union.

Reputation

- The opponent is a US manufacturer from the confectionery, food, and snack company, with multinational coverage of brands, among which one is OREO. OREO is the world's best-selling cookie brand of the 21st century, with over \$2 billion in global annual revenues (2016). The brand is ranked as one of the Top 10 brand Facebook pages in the world. Moreover, the opponent refers to some of its sponsorships and collaborations with celebrities from the past years.

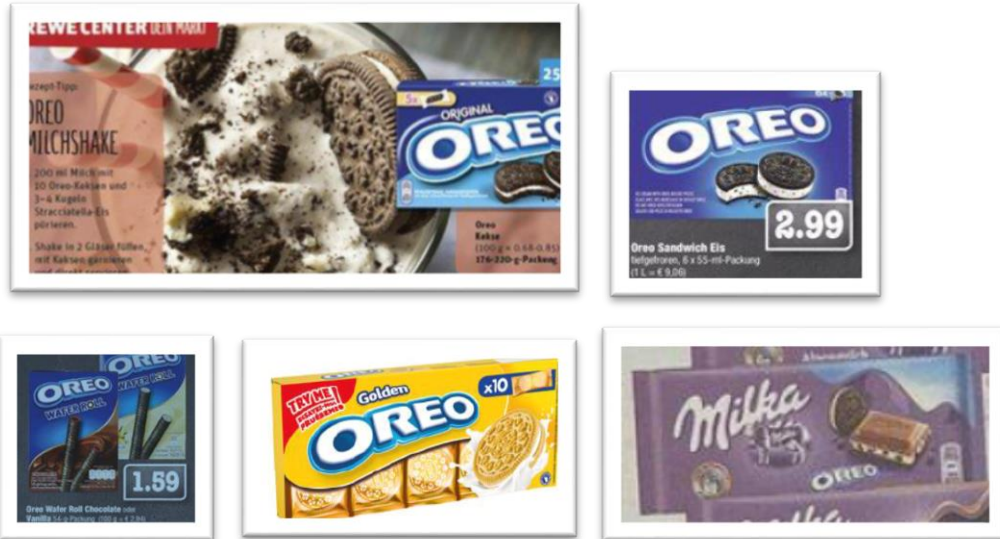
- The advertising campaigns, advertising, and promotional materials such as press releases, advertising spots, by means of various communication channels, promotional articles, offers, brochures, catalogues, leaflets, social media interactions all allow to draw conclusions about the degree of exposure of the public to advertising message concerning the mark (Attachments 4-8, 9, 10, 12, 29-33).
- Consequently, it is evident that the brand OREO as a word mark, displayed on packaging, promotional materials, campaigns or on the goods themselves has been subject to longstanding and intensive use and is generally known in the territory of the EU, as has been attested by the variety of materials presented in French, German, Dutch or Spanish. As a result, it was concluded that the opponent's brand OREO enjoys a consolidated position among the leading brands, as has been implied in some of the detailed overviews of the opponent's campaigns, as well as demonstrated by diverse independent sources. The sales figures, marketing expenditure and market shares shown by the evidence and the various references in the press to its success all unequivocally show that the mark enjoys a high degree of recognition among the relevant public.
- As such, it was found that the earlier trade mark enjoys significant reputation in the European Union, in particular in Spain, France and Germany, for *biscuits; cookies* in Class 30.
- OREO' and 'PORLEO' in the present case have no meaning for the relevant public and these elements are to that extent of an inherently distinctive nature.
- Visually and aurally, the signs are similar to a very remote degree insofar as they coincide in the letters 'O', 'R', 'E' and 'O', being all the letters of which the earlier mark consists as well as their sounds. The contested sign also has the differing letters 'P' and 'L'. The marks further differ in the beginnings of their conflicting elements ('OREO' and 'PORLEO'), the additional 'L' in the contested sign and in the additional elements ('Aldiva' and 'BUN'). They also have a different length.
- Aurally, the earlier mark is composed of three vowels and only one consonant, whereas the contested sign incorporates two additional consonants and leading to overall different syllables, rhythm, and intonation by the pronunciation of the contested sign's conflicting element, that is – o/re/o versus por/le/o. Despite the coincidences in a number of letters ('OR' and 'EO'), given their different position within the word and since they form part of differently audible syllables, the similarities in the signs remain diluted.
- Conceptually, for the great majority of the public, neither of the signs were found to have a meaning.

Link between the signs

- The establishment of a link, while triggered by the similarity or identity between the signs, requires that the relevant sections of the public for each of the goods and services covered by the trade marks in dispute are the same or overlap to some extent.
- The earlier mark is very reputed for *biscuits* and *cookies* in Class 30 and the contested goods and services consist also of food products in Class 30 and food related services, retail, online retail, wholesale, and catalogue sale, in Class 35.
- There is an inevitable link between some of the contested goods in Class 30 and the goods in Class 30 for which the earlier mark is reputed, in particular in relation to all

types of biscuits and cookies, as well as to other confectionery or bakery products based on chocolate or cocoa as main ingredient.

- It can be seen that some of the opponent's goods are already offered on the market under the brands




and the fact that consumers have been exposed to see these products in relation to the reputed cookies/biscuits only reinforces such a link to be triggered when encountering these products under the applicant's sign.

- Therefore, due to the very close proximate character of these goods in the niche in which the opponent's goods are reputed, a mental connection will be established between the conflicting signs, especially given the additional word 'BUN' in the contested sign may be associated with the nature or characteristics of most of these goods by part of the relevant public. All these goods will most likely be displayed on the same shelves or store sections and target the same relevant public.
- Even though the signs do not display high visual similarities, the degree of reputation of the opponent's mark is sufficient to outweigh these remote similarities from the perspective of the very same or proximate market niche.
- In relation to the contested services in Class 35; a link will also be established as far as they are offered in relation to goods with those same characteristics, as there is still a certain strong connection between these services and certain goods, especially when these are the exact subject of sale. In particular, retail services concerning the sale of specific goods are similar to an average degree to these specific goods. Although the nature and purpose might differ, they can be complementary as the services are generally offered in the same places as the goods are offered for sale, they are also directed at the same public.
- Consequently, the relevant consumers, when encountering the contested mark will likely associate it with the earlier sign, that is to say, establish a mental 'link' between the signs, as the coincidences between them, in the context of the opponent's reputation, are sufficient to evoke an association when encountered in the same or very proximate market niche.
- However no link will be made in relation to the remaining goods and services that have nothing or less in common. As a result, the opposition is not well-founded under

Article 8(5) EUTMR and must be rejected insofar as it was directed against these goods and services.

Risk of injury



- The opponent claims that use of the contested mark would take unfair advantage of the distinctive character or repute of its earlier trade mark. It states that the earlier mark has a very strong reputation as can be seen from the evidence provided and ‘OREO’ is used continuously and intensively; the signs are highly similar and the parties operate in identical or at least extremely proximate markets; use of the contested sign will immediately bring to mind the opponent’s reputed brand due to the coinciding verbal elements; consumers’ economic behaviour will be influenced in attributing positive associations to the new brand linked to the taste and the flavour of the ‘OREO’ goods and that these positive qualities will facilitate the sale of the applicant’s goods and this will result in causing material damage to the opponent’s earlier mark. Finally, the opponent states that the applicant will ‘free ride’ on its investments and promotion and on the marketing efforts made to create and maintain the image of its brand.
- The opponent’s mark is one of the players in the market of cookies and biscuits is particularly recognisable under the following depiction . It has been present on the market for a substantial period of time and enjoys significant recognition in the EU associated with cookies.
- The contested sign, when encountered in the same or proximate market niche, is indeed sufficiently similar to be associated with the earlier mark, especially with its broadly recognised stylisation and it is indeed highly probable that the applicant may intentionally or unintentionally influence consumers’ choice in purchasing preserved cookies, biscuits, and other chocolate-related confectionery products.
- As a result, the contested mark is likely to take unfair advantage of the distinctive character or repute of the earlier mark. Therefore, the opposition is well-founded based on Article 8(5) EUTMR against part of the goods and services listed above in paragraph 6.

Earlier EUTM No 8 640 658  *and EUTM No 129 577 OREO*

- Some of the contested goods and services were found to be identical to the goods on which the opposition was based and the examination proceeded as if all the conflicting goods and services were identical.
- The goods and services directed at the public at large or at professionals, insofar as wholesale services are concerned and the degree of attention is average.
- As the signs have already been compared under the grounds of Article 8(5) EUTMR, reference is made to those findings which are valid here for Article 8(1)(b) EUTMR.
- In a brief assessment, the word ‘OREO’ in the earlier marks has no relation to any of the goods at issue and, consequently, its degree of distinctiveness is normal. The stylisation of the earlier figurative mark (colour and typeface) is merely decorative. The signs were found to be visually and aurally similar only to a very low degree and no conceptual comparison is possible.

- Taking into account the different overall structure, pronunciation, and additional letters of the contested mark and even assuming that the goods and services are identical, despite the reputation of the earlier mark, there is no likelihood of confusion on the part of the public and the opposition must be rejected for these earlier EUTMs.
- 7 On 28 September 2022, the opponent filed an appeal against the contested decision, requesting that the decision be set aside to the extent that the opposition was rejected. The statement of grounds of the appeal was received on 29 November 2022.
- 8 No response was filed.

Submissions and arguments of the opponent

- 9 The arguments raised in the statement of grounds may be summarised as follows:
- The Office erred in its finding that there is no link between the signs. There is a clear overlap amongst the applicant’s goods and the earlier goods and services.
 - Visually, the signs coincide in the sequence of letters ‘*OR*EO’, resulting in the letters of the earlier mark being entirely incorporated in the contested sign. The term PORLEO is the most dominant element of the contested sign due to its size and prominent position in the centre of the mark. The component  also has almost an identical stylisation as the earlier mark . The signs are visually highly similar.
 - The OREO font has acquired an indisputable level of recognition throughout the world and the applicant has cleverly and deliberately copied the elements of the OREO branding. The colour blue and the typeface of PORLEO resembles the OREO typeface, it has similar rounded letters, in nearly an identical playful diagonal positioning, and all letters are written in upper case.
 - Aurally the signs coincide in the vowel sequence (O-E-O) which has the same number of syllables, leading to a very similar pronunciation. The addition of an initial consonant ‘P’ and ‘L’ in the middle of the contested sign does not result in a pronunciation that is sufficiently different.
 - Conceptually neither of the marks have a meaning and a conceptual comparison is not possible.
 - The OREO marks enjoy a significant reputation in the European Union for biscuits and cookies in Class 30, as a result of the particularly impressive duration and intensity of use, territorial reach and extensive marking and promotional efforts around the world, it has become one of the most recognised brands in the world.
 - The goods at issue (foodstuffs and beverages) are of common/mass consumption and are therefore primarily aimed at the average consumer, who is reasonably attentive and informed and will perceive the signs with an average degree of attention. The contested Class 35 services (retail services relating to food and drinks) are directed at the public at large and at business customers with specific professional knowledge or expertise and the degree of attention will vary from average to high.

- There is an obvious link between the opponent’s reputed goods and the contested goods in Class 30, which are various kinds of foodstuffs, snacks, and beverages, connected to varying degrees to the earlier signs cookies and biscuits. The goods in question have the same nature, are intended for human consumption, are usually sold in the same or neighbouring sections in supermarkets and can coincide in their producers and relevant public. Although they are commonly manufactured from different raw materials, the contested goods belong to the same category of foodstuffs as biscuits and cookies. Consequently, there is a link between them.
- In addition, some of these goods can be used in combination since the reputed goods are cookies and biscuits that may be used with coffee-based beverages, tea, coffee, and iced tea. The goods can also be offered through the same distribution channels (albeit in different sections), such as supermarkets or other food retail shops and usually target the same public.
- The opponent is constantly evolving and entering new market segments with its OREO brand and, accordingly, the consumer may easily assume that the contested goods are marketed by, or are under the control of, the opponent. All the more since the opponents usage of the mark OREO is not strictly confined to the cookies and biscuits sector and as such, there can be little doubt that there is a link between the contested goods and the earlier goods. A brand extension from one to the other would also be a plausible possibility from the perspective of consumers of all of these goods.
- As regards the contested retail services relating to various snacks in Class 35 and the earlier reputed goods, there is also a link due to the close connection between both in the market from the perspective of the consumer. The object of the Class 35 services are all interchangeable snacks. Consumers are accustomed to the practice that various snacks are usually offered for sale in the same shops or in the same or neighbouring sections of supermarkets. Moreover, the earlier reputed goods and the contested services target the same consumer. Consequently, the consumer could establish a link between the earlier reputed goods when seeing the contested sign on these contested services.
- As a result, taking into consideration the very strong reputation of the earlier mark, the similarity between the signs and the identity or close proximity of the conflicting goods and services in Classes 30 and 35, the relevant public would naturally be led to immediately establish mentally a link between the contested sign and the earlier reputed mark. Although some of the contested goods and services in Classes 30 and 35 may not appear to be directly and immediately linked with the earlier reputed goods, considering all the relevant factors, there can be a certain connection between them that could enable the relevant public to establish a mental link between the signs in dispute.
- Consequently, it is highly probable that the applicant may intentionally or unintentionally influence consumers’ choice in purchasing and this particular choice may be manipulated and especially encouraged by the array of positive qualities and associations that the earlier mark OREO may evoke in consumer’s minds, e.g. playfulness, originality, creativity. Such ‘image transfer’ will influence the consumers’ market behaviour and their preferences and the applicant will unfairly benefit from the power of attraction of the opponent’s brand in a way that it will not need to contribute to the development of goodwill of its own brand but will instead ride on the coattails of the similar mark with a reputation.

- The consumers' choice in purchasing will be influenced with *all* the contested goods and services, since there is a clear link between the parties' goods and services. Therefore, the opposition should be granted entirely and the contested sign refused for all the contested goods and services.

Reasons

- 10 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 12 The opponent appealed the contested decision to the extent that the opposition was rejected for the following goods and services:

Class 30: Coffee-based beverages; pasta; jiaozi [stuffed dumplings]; Chinese stuffed dumplings (gyoza, cooked); Vareniki [stuffed dumplings]; noodles; bread; pitta bread; pita chips; sandwiches; skin [pastry] for spring rolls; pâtés en croûte; baklava; rice pudding; propolis; propolis for food purposes; honey; food condiment consisting primarily of ketchup and salsa; vanilla flavorings; seasonings; sauces [condiments]; tomato sauce; yeast; baking powder; flour; semolina; starch for food; sugar; cube sugar; icing sugar; tea; iced tea; salt crackers; chewing gum; salt; popcorn; corn chips; processed wheat; wheat germ for human consumption; crushed barley; oats for human consumption; processed oats; rice; treacle; pumpnickel; rye flour; rye full grain grist; oat flakes; coffee; filled bread rolls.

Class 35: Retail service in relation to/wholesale services in relation to/catalogue retail services in relation to/online retail services in relation to the following goods: savory sauces, chutneys and pastes; tablet (confectionery); Turkish delight coated in chocolate; Turkish delight; confectionery in liquid form; nonmedicated confectionery in jelly form; flavoured sugar confectionery; chocolate coated sugar confectionery; nut confectionery; confectionery having liquid fruit fillings; mint flavoured confectionery (non-medicated -); frozen dairy confections; confectionery containing jelly; confectionery containing jam; boiled confectionery; panettone; nougat; marzipan; halvah; instant dessert puddings; chocolate-based spreads; chocolate spreads for use on bread; cocoa based creams in the form of spreads; chocolate creams; croissants; eight-treasure rice pudding; custard; fruited scones; crackers flavoured with fruit; deep-fried dough sticks (Youtiao); chocolate coated nougat bars; hot chocolate mixes; kheer mix (rice pudding); chocolate-coated nuts; crackers flavoured with fruit; tarts; petits fours [cakes]; fruit filled pastry products; fresh pasties; shortcrust pastry; almond pastries; pastries containing creams and fruit; pastries containing creams; frozen pastries; pastries containing fruit; savory pastries; chocolate covered cakes; deep chocolate cake made with chocolate sponge; malt cakes; oat cakes for human consumption; iced fruit cakes; fruit cakes; cream cakes; chocolate cakes; candied cakes of popped rice; steamed sponge cakes (fagao); shortbread part coated with chocolate; shortbread with a chocolate flavoured coating; shortbread with a chocolate coating; rice cake snacks; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; sesame candy bars; oat bars; chocolate powder; cocoa powder; preparations for making beverages [coffee based]; preparations for making beverages [cocoa based]; drinking cocoa paste; cocoa beverages with milk; milk chocolates; hot chocolate; chocolate-based beverages with milk; coffee-based beverages; cocoa-based

beverages; mixtures of coffee; cocoa mixes; chocolate-coated rice cakes; snack foods prepared from maize; rice-based snack food; rice biscuits; canapes; oat clusters containing dried fruit.

- 13 In the absence of the applicant's appeal and cross-appeal, the part of the order of the contested decision by which the opposition was upheld has become final.
- 14 It must be noted that the applicant requested proof of use pursuant to Article 47(2) and (3) EUTMR in relation to, inter alia, EUTM No 129 577 for the word mark 'OREO'. The Opposition Division found that this earlier mark has been used in the relevant territory for *cookies and biscuits*. These findings have not been challenged by the parties and therefore, pursuant to Article 27(3)(c) EUTMDR, they do not fall under the scope of the examination of the present appeal. The earlier mark is thus deemed to be used for *cookies and biscuits* as found in the contested decision.
- 15 Therefore, the Board will examine whether the Opposition Division rightly rejected the opposition with regard to the goods and services listed in paragraph 12. Like the Opposition Division, the Board finds it appropriate to start the examination on the basis of the earlier EUTM No 129 577 ('the earlier mark').

Preliminary remark on confidentiality

- 16 The opponent requested that some information in the evidence of use be kept confidential.
- 17 In accordance with Article 114(4) EUTMR, files may contain certain documents which are excluded from public inspection, e.g. parts of the file which the party concerned showed a special interest in keeping confidential.
- 18 In the event that special interest in keeping a document confidential, in accordance with this provision, is invoked, the Office must check whether that special interest is sufficiently shown. Such special interest exists because of the confidential nature of the document or its status as a trade or business secret.
- 19 In the present case, the Board considers that in relation to commercial data such as sales figures and market share data, the special interest arises due to the confidential nature of the documents containing such information.
- 20 Consequently, the Board, in line with the Opposition Division will keep the certain business information secret and will refer to such information only in general terms.

Article 8(5) EUTMR

- 21 Article 8(5) EUTMR provides that the trade mark applied for must not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier EU trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned, and where the use without due cause of the trade mark applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
- 22 It is clear from the wording of Article 8(5) EUTMR and from the case-law that, for an earlier trade mark to be afforded the broader protection under that provision, a number of conditions must therefore be satisfied.
- 23 First, the earlier trade mark which is claimed to have a reputation must be registered. Secondly, that mark and the mark applied for must be identical or similar. Thirdly, the

earlier mark must have a reputation in the European Union, in the case of an earlier EU trade mark, or in the Member State concerned, in the case of an earlier national trade mark. Fourthly, the use without due cause of the mark applied for must lead to the risk that unfair advantage might be taken of the distinctive character or the repute of the earlier trade mark or that it might be detrimental to the distinctive character or the repute of the earlier trade mark. As those conditions are cumulative, failure to satisfy one of them is sufficient to render that provision inapplicable (13/12/2018, T-274/17 *MONSTER DIP (fig.) / MONSTER ENERGY (fig.) et al.*, EU:T:2018:928, § 55).

- 24 In order to satisfy the condition relating to the similarity of the marks which is laid down by Article 8(5) EUTMR, it is not necessary to prove that there exists, on the part of the relevant public, a likelihood of confusion between the earlier mark with a reputation and the contested mark. It is sufficient for the degree of similarity between the earlier mark with a reputation and the contested mark to have the effect that the relevant public establishes a link between them, even though it does not confuse them (27/10/2016, T-625/15, *SPA VILLAGE / SPA et al.*, EU:T:2016:631, § 34).
- 25 According to the case-law, the fact that, for the average consumer, who is reasonably well informed and reasonably observant and circumspect, the later mark would call the earlier mark to mind is tantamount to the existence of such a link (see, by analogy 27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 60).
- 26 Whether such a link exists must be assessed globally, taking into account all factors relevant to the circumstances of the case, in particular the degree of similarity between the signs at issue; the nature of the goods or services for which the marks at issue are registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant public; the strength of the earlier mark's reputation and the existence of a likelihood of confusion on the part of the public (27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 42, 29/03/2012, T-369/10, *Beatle*, EU:T:2012:177, § 47, 05/05/2015, T-131/12, *SPARITUAL / SPA et al.*, EU:T:2015:257, § 48). However, this list is not exhaustive and is not required to be applied in its entirety in each individual case. On the contrary, it is possible that a link between the marks at issue may be established on the basis of some of those criteria or be the result of other factors. The question as to whether the relevant public will make a connection between the marks at issue is a question of fact which must be answered in the light of the facts and circumstances of each individual case (22/05/2012, T-570/10, *Tête de loup*, EU:T:2012:250, § 42) and a matter of public perception (11/12/2014, T-480/12, *MASTER*, EU:T:2014:1062, § 41 and the case-law cited).
- 27 As regards the degree of similarity between the marks at issue, the more similar they are, the more likely it is that the later mark will bring the earlier mark with a reputation to the mind of the relevant public. Furthermore, the stronger the distinctive character of the earlier mark, whether inherent or acquired through the use which has been made of it, the more likely it is that, faced with an identical or similar later mark, the relevant public will make a link with that earlier mark (27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 44 and 54).
- 28 Furthermore, it must be pointed out that certain marks may have acquired such a reputation that it goes beyond the relevant public with regard to the goods or services in respect of which those marks were registered. In such a case, it is possible that the relevant public with regard to the goods or services for which the later mark is registered will make a connection between the marks at issue, even though that public is wholly distinct from the relevant public with regard to the goods or services for which the earlier mark was registered (27/11/2008, C-252/07, *Intel*, EU:C:2008:655, § 51 and 52).


- 29 As regards the fourth condition referred to above, Article 8(5) EUTMR refers to three distinct and alternative types of risk, namely that use of the trade mark applied for without due cause would (i) be detrimental to the distinctive character of the earlier mark, (ii) be detrimental to the repute of the earlier mark, or (iii) take unfair advantage of the distinctive character or repute of the earlier mark.
- 30 The first type of risk referred to in that provision arises where the earlier mark is no longer capable of arousing immediate association with the goods for which it is registered and used. That risk thus refers to the dilution of the earlier mark through the dispersion of its identity and its hold upon the public mind. The second type of risk occurs where the goods or services covered by the mark applied for may be perceived by the public in such a way that the earlier mark's power of attraction is diminished. The third type of risk concerns the risk that the image of the mark with a reputation or the characteristics which it projects are transferred to the goods covered by the mark applied for, with the result that the marketing of those goods is made easier by that association with the earlier mark with a reputation. It should, however, be emphasised that in none of those cases is it necessary for there to be a likelihood of confusion between the marks at issue; the relevant public only has to be able to establish a link between them and does not necessarily have to confuse them (13/12/2018, T-274/17 MONSTER DIP (fig.) / MONSTER ENERGY (fig.) et al., EU:T:2018:928, § 56).
- 31 The existence of injury consisting of unfair advantage taken of the distinctive character or the repute of the earlier mark, insofar as what is prohibited is the drawing of benefit from that mark by the proprietor of the later mark, must be assessed by reference to average consumers of the goods or services for which the later mark is registered, who are reasonably well informed and reasonably observant and circumspect (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 36).
- 32 It is in the light of those principles that the Board will assess the applicability of Article 8(5) EUTMR with regard to goods and services falling within the scope of the appeal, and whether in this case, the conditions mentioned above are met.
- 33 Concretely, the Board will firstly begin by assessing the reputation of the earlier mark; secondly, the similarity between the contested sign and the mark for which the reputation is eventually proved; thirdly, the eventual existence of a link between the signs; fourthly the risk of injury, and fifthly, whether the use is without due cause.

Reputation

- 34 The evidence of reputation consists of the documents submitted by the opponent with the substantiation of its opposition as listed above in paragraph 6.
- 35 The Court has defined the nature of reputation by reference to the purpose of the relevant legal provisions and has established that Article 8(5) EUTMR implies a certain degree of knowledge of the earlier trade mark among the public. The Court has also explained that it 'is only where there is a sufficient degree of knowledge of that mark that the public, when confronted by the later trade mark, may possibly make an association between the two trade marks and that the earlier mark may consequently be damaged' (14/09/1999, C-375/97, Chevy, EU:C:1999:408, § 23).
- 36 The Opposition Division found that the earlier mark enjoys significant reputation in the European Union, in particular in Spain, France and Germany, for *biscuits; cookies* in Class 30. This conclusion has not been challenged by the parties and is endorsed by the Board.

Comparison of the signs

- 37 It must be recalled that similarity of the signs in the context of Article 8(5) EUTMR should be assessed according to the same criteria that apply in the context of Article 8(1)(b) EUTMR, thus taking into account elements of visual, aural, or conceptual similarity (24/03/2011, C-552/09 P, *TiMiKinderjoghurt*, EU:C:2011:177, § 52, 54).
- 38 However, those provisions differ in terms of the degree of similarity required. Whereas the protection provided for under Article 8(1)(b) EUTMR is conditional upon a finding of a degree of similarity between the marks at issue such that there is a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) EUTMR. Accordingly, the types of injury referred to in Article 8(5) EUTMR may result from a lesser degree of similarity between the marks in question, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is, to establish a link between them. If there is some similarity, even faint, between the marks, a global assessment must be carried out to ascertain whether, notwithstanding the low degree of similarity, other relevant factors serve to establish a link between the marks (24/03/2011, C-552/09 P, *TiMiKinderjoghurt*, EU:C:2011:177, § 53, 66; 20/11/2014, C-581/13 P & C-582/13 P, *Golden balls*, EU:C:2014:2387, § 72, 73).
- 39 The signs to be compared are:

OREO	
<i>Earlier mark</i>	<i>Contested sign</i>

- 40 The earlier mark is a word mark consisting of a single word ‘OREO’.
- 41 The contested sign is a complex figurative sign consisting of three main elements placed vertically. On the top, there is a depiction of the word ‘Aldiva’ depicted in white stylised fond on the red oval background. This element also contains the word ‘Thanks’, depicted in significantly smaller white font. In the central part there is a verbal element ‘PORLEO’ depicted in white uppercase letters with a dark- and light-blue rim. The lower part of the sign contains the element ‘BUN’ depicted in light-blue uppercase letters.
- 42 None of the verbal elements ‘OREO’ or ‘PORLEO’ in the present case has a meaning as regards the goods and services in question for the relevant public and these elements are to that extent of an inherently distinctive nature.

- 43 The word ‘Aldiva’ depicted in the upper part of the contested sign is meaningless and distinctive, whereas the other verbal element ‘Thanks’ written alongside the red label is of such a small size that it can be considered negligible element in the overall impression. The red label in which these elements are depicted has only a decorative character and, thus, a lowly distinctive nature. The word ‘BUN’, to the extent it will be understood by some of the public as a small roll similar to bread – namely by the English- and French-speaking public, is weakly distinctive in relation to the goods related to bakery goods, and the services related thereto. Moreover, to the extent that this word may have further meanings in other languages that bear nevertheless no relation to the goods/services, it is considered distinctive (e.g. to Hungarian speakers). For the rest of the consumers that perceive it as meaningless, it is of a normally distinctive character.
- 44 Contrary to what the opponent argues and despite the fact that the components of the contested sign are of different sizes, positions and colour arrangement, there is no element that is visually more striking, that is to say, the sign as a whole does not suggest the presence of a clearly outstanding visual element. At most, the elements ‘PORLEO’ and ‘BUN’, due to their uppercase letters, share a co-dominance compared to the other verbal element ‘Aldiva’ that remains isolated above in its own label, yet depicted in striking red.
- 45 Visually and aurally, the signs are similar to a remote degree on account of the resemblance between the earlier mark ‘OREO’ and the central element of the contested sign, namely ‘PORLEO’. These elements are similar to the extent that they coincide in the letters ‘O’, ‘R’, ‘E’ and ‘O’, being all the letters of which the earlier mark consists, and some of the letters of which the central verbal element ‘PORLEO’ is construed, as well as the sounds thereof. However, these coinciding letters occupy different positions within the signs, namely forming one single word in the earlier mark and integrated within the contested sign, in which they are preceded and followed by differing letters ‘P’ and ‘L’. The signs differ also in the additional elements (‘Aldiva’ and ‘BUN’) with a visual and aural impact that find no counterbalance in the earlier mark.
- 46 Account is taken of the fact that consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.
- 47 Conceptually, the earlier sign has no meaning in the relevant territory and as a result, to the extent that the contested sign will be attributed a meaning, the signs are conceptually not similar (12/01/2006, C-361/04 P, Picaro, EU:C:2006:25, § 55). From the perspective of the public who will not associate neither of the signs with a meaning, the conceptual aspect does not influence the assessment of the similarity of the signs.
- 48 Taking into account the visual and aural resemblances stemming from certain similarity between the elements ‘OREO’ and ‘PORLEO’ which are not entirely cancelled out by the abovementioned differences, the Board finds that there is indeed a remote similarity between the signs that attains the minimum threshold for similarity required in the context of Article 8(5) EUTMR.

The link between the signs

- 49 In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a ‘link’ between the conflicting marks in consumers’ minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31;

27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

50 Possible relevant factors for the examination of a ‘link’ include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;
- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of likelihood of confusion on the part of the public.

51 This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a ‘link’ may be established on the basis of only some of these criteria.

a) Connection between the goods and services

52 As regards the factor relating to goods and services, the clear wording of Article 8(5) EUTMR does not impose the condition of a similarity between the goods or services. Accordingly, if the nature of the goods or services concerned is one of the factors that must be taken into account in the assessment of whether there is a link on the part of the public concerned, the lack of similarity between those goods or services cannot be interpreted as implying that there is no such link (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42, 61; 29/11/2018, T-372/17, LV POWER ENERGY DRINK (fig.) / LV (fig.), EU:T:2018:851, § 110).

53 It must also be borne in mind that the relevant public’s assessment of the link between the signs at issue is likely to vary according to the strength of the reputation (04/10/2017, T-411/15, GAPPOL (fig.) / GAP et al., EU:T:2017:689, § 197). Certain marks may have acquired such a reputation that it goes beyond the relevant public as regards the goods or services in respect of which those marks were registered (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 51; 29/11/2018, T-372/17, LV POWER ENERGY DRINK (fig.) / LV (fig.), EU:T:2018:851, § 111).

54 Reputation of the earlier mark was found for *biscuits; cookies* in Class 30.

55 The Boards finds that the contested goods in Class 30, which are relevant in the present appeal proceedings, are various types of foodstuffs and beverages for human consumption. They are targeted at the consumer who is likely to display at most an average degree of attention. As rightly pointed out by the opponent, the earlier *biscuits; cookies* and the relevant goods in Class 30 have the same general nature and purpose, are usually sold in the same or adjacent sections of the supermarkets, and can coincide in their producers and relevant public. In addition, the contested goods such as *pita chips, baklava; salt crackers; chewing gum; popcorn; corn chips; filled bread rolls* are essentially snacks which can be in competition or interchangeable with the earlier *biscuits* and *cookies*. They are also often offered together (see Attachment 23). As a result, there is a close proximity between them.

- 56 There is also a closeness between the earlier reputed goods and the remaining contested goods in Class 30. Although they are commonly manufactured from different raw materials and can be produced by different undertakings, they coincide in their nature, purpose, distribution channels and target public. In addition, they are often offered and promoted together (see, for example supermarket leaflets in Attachment 23 and 31 where the earlier reputed goods appear side-by-side with noodles, bread, condiments, pasta sauces, rice, flour, honey, tea, or instant soups).
- 57 Moreover, some of the contested goods such as *honey; vanilla flavorings; seasonings; yeast; baking powder; flour; semolina; starch for food; sugar; icing sugar; salt; treacle, rye flour* can serve as ingredients of the reputed goods. The confectionery manufacturers often prompt consumers to prepare desserts with the use of their biscuits and cookies (see for example Attachments 23, 30, 32 and 34 showing examples of recipes and presentation of cakes using the goods in question). In addition, it is common ground that biscuits and cookies can be added to breakfast cereals which are closely related to the contested *processed wheat; wheat germ for human consumption; crushed barley; oats for human consumption; processed oats; rye full grain grist; oat flakes*. Furthermore, some of the goods in question, including *coffee-based beverages; rice pudding; tea; iced tea* can be used together with the earlier reputed goods. Moreover, cookies and biscuits are also promoted together with breakfast cereals (see for example supermarket leaflets in Attachment 31).
- 58 The Board takes the view that the consumers in the European Union have been exposed to the natural expansion of confectionery brands into other food and beverages sectors (see for example Attachment 35). This fact reinforces the likelihood that a mental association will be triggered when encountering the relevant contested goods of proximate character with the goods for which the earlier mark is reputed.
- 59 Turning now to the contested retail and wholesale services in Class 35, the Board finds that their subject matter consists of various kinds of foodstuffs and beverages. In particular, there is a close proximity between the earlier reputed goods and the savory and sweet goods that can be used as snacks, including *tablet (confectionary); Turkish delight coated in chocolate; Turkish delight; confectionery in liquid form; nonmedicated confectionery in jelly form; flavoured sugar confectionery; chocolate coated sugar confectionery; nut confectionery; confectionery having liquid fruit fillings; mint flavoured confectionery (non-medicated -); frozen dairy confections; confectionery containing jelly; confectionery containing jam; boiled confectionery; panettone; nougat; marzipan; halvah; instant dessert puddings; chocolate-based spreads; chocolate spreads for use on bread; cocoa based creams in the form of spreads; chocolate creams; croissants; eight-treasure rice pudding; custard; fruited scones; crackers flavoured with fruit; deep-fried dough sticks (Youtiao); chocolate coated nougat bars; hot chocolate mixes; kheer mix (rice pudding); chocolate-coated nuts; crackers flavoured with fruit; tarts; petits fours [cakes]; fruit filled pastry products; fresh pasties; shortcrust pastry; almond pastries; pastries containing creams and fruit; pastries containing creams; frozen pastries; pastries containing fruit; savory pastries; chocolate covered cakes; deep chocolate cake made with chocolate sponge; malt cakes; oat cakes for human consumption; iced fruit cakes; fruit cakes; cream cakes; chocolate cakes; candied cakes of popped rice; steamed sponge cakes (fagao); shortbread part coated with chocolate; shortbread with a chocolate flavoured coating; shortbread with a chocolate coating; rice cake snacks; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; sesame candy bars; oat bars; chocolate-coated rice cakes; snack foods prepared from maize; rice-based snack food; rice biscuits; canapes; oat clusters containing dried fruit*. To this extent, the relevant contested services

relate to the goods which are in competition or interchangeable with the earlier *biscuits; cookies*. In addition, the Board finds that consumers are accustomed to the practice that various snacks are usually offered for sale in the same shops or in the same or adjacent sections of supermarkets. They can be also offered and promoted in the same sections of the retail catalogues and leaflets (see, for example Attachment 23). Moreover, they can be sold side-by-side in the vending machines in schools, offices, or public spaces.

- 60 Furthermore, some of the goods which are subject matter of the relevant contested services in Class 35 may be bought and consumed together with the earlier reputed goods (see, for example Attachment 14). That applies in particular to *chocolate powder; cocoa powder; preparations for making beverages [coffee based]; preparations for making beverages [cocoa based]; drinking cocoa paste; cocoa beverages with milk; milk chocolates; hot chocolate; chocolate-based beverages with milk; coffee-based beverages; cocoa-based beverages; mixtures of coffee; cocoa mixes*. These goods may also coincide in their flavouring and filling. Moreover, these goods are often offered together for sale (see for example supermarket leaflets in Attachment 23 where the earlier reputed goods are offered together with coffee or chocolate based preparations for making creams).
- 61 It must be borne in mind that the existence of a similarity between the goods and services covered by the marks at issue does not constitute a condition for the application of the relative ground for refusal laid down in Article 8(5) EUTMR, but the nature and the degree of closeness of the goods or services concerned constitute factors that are relevant in order to assess whether a link between those marks exists (28/02/2019, T-459/18, PEPERO original (fig.) / REPRÉSENTATION D'UN BATÔNNET (fig.), EU:T:2019:119, § 182).
- 62 It should be noted that the reputed goods and the relevant services in Class 35 are complementary and that the services in question are generally offered in the same places as those where the goods in question are offered for sale. Moreover, having regard to the fact that the earlier reputed goods in Class 30 and the subject matter of the contested services in Class 35 have the same or similar nature and purpose and coincide in their distribution channels and end-users, the Board finds that the relevant consumer may reasonably establish a connection between them.
- 63 It may therefore be concluded that there is a clear proximity of the business sectors concerned, which may induce the link between the signs at issue in the minds of the relevant public.

b) Distinctive character and the nature of the earlier mark's reputation


- 64 As indicated above, the reputation of the earlier mark that the opponent has built in the European Union under the name 'OREO' is significant. It follows from the extensive evidence provided by the opponent before the Opposition Division and, in particular the opponent's collaboration and partnerships with other global brands, that the reputation of the earlier mark goes beyond the relevant public of the reputed goods.
- 65 The earlier sign has no meaning with regard to the earlier goods and hence, it possesses a normal degree of inherent distinctiveness. The earlier mark's distinctiveness has been further enhanced in view of the substantial marketing effort and intensive longstanding use.


c) Conclusion on the existence of a link between the signs

- 66 Taking into account the significant degree of recognition of the earlier mark amongst the relevant public, who views it as a strongly distinctive and highly reputed trade mark for *biscuits; cookies* as well as the connection between these goods and the contested goods

and services which are at stake in the present appeal proceedings, the Board finds that despite a remote degree of similarity between the signs, it is probable that the relevant public will establish a mental link between those signs for these goods and services for the purposes of Article 8(5) EUTMR.

- 67 As rightly observed by the Opposition Division, the opponent's brand as one of the leading players in the sector of cookies and biscuits is particularly recognisable under the following

depiction: . Undeniable resemblances may be observed between such

depiction and the stylisation of the contested sign's central element , in particular due to similar rounded typeface, white uppercase letters, diagonal positioning of the letters and use of different shades of blue. The contested sign, when encountered in the same or adjacent market segment, is indeed sufficiently similar to be associated with the earlier mark.

- 68 Such mental association is foreseeable also in view of the fact that the market reality is characterised by the expansion of successful confectionery brands into other food related goods and services (see for example Attachments 10, 12 and 35). Considering in particular the evidence submitted by the opponent and its numerous collaborations with third party brands that remain depicted on the package of the new products, it cannot be denied that the contested sign's differentiating elements such as red oval with words 'Aldiva Thanks' or the element 'BUN' may be considered by the consumers as another type of collaboration with a third party brand.

Unfair advantage

- 69 As regards the requirement that unfair advantage be taken of the distinctive character or the repute of the earlier marks, it should be borne in mind that the proprietor of an earlier trade mark is not required to demonstrate actual and present injury to its mark for the purposes of Article 8(5) EUTMR. When it is foreseeable that such injury will ensue from the use which the proprietor of the mark applied for may be led to make of its mark, the proprietor of the earlier mark cannot be required to wait for it actually to occur in order to be able to prohibit that use. The proprietor of the earlier mark must, however, prove that there is a serious risk that such an injury will occur in the future (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 38; 07/12/2010, T-59/08, Nimei La Perla Modern Classic, EU:T:2010:500, § 33; 25/01/2012, T-332/10, Viaguara, EU:T:2012:26, § 25; 29/03/2012, T-369/10, Beatle, EU:T:2012:177, § 61; 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 53).
- 70 Such a conclusion may be established, in particular, on the basis of logical deductions made from an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case (10/05/2007, T- 47/06, (Fig) NASDAQ / NASDAQ, EU:T:2007:131, § 54 and the case-law cited).
- 71 As regards the concept of 'taking unfair advantage of the distinctive character or the repute of the trade mark', also referred to as 'parasitism' or 'free-riding', that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation or riding on the coattails of the mark with a reputation. It follows that advantage taken by a third party of

the distinctive character or the repute of the mark may be unfair, even if the use of the identical or similar sign is not detrimental either to the distinctive character or to the repute of the mark or, more generally, to its proprietor (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 41, 43).

- 72 In order to determine whether use of a sign takes unfair advantage of the distinctive character or the repute of the mark, it is necessary to undertake a global assessment, taking into account all factors relevant to the circumstances of the case, which include the strength of the mark's reputation and the mark's degree of distinctive character, the degree of similarity between the marks at issue, and the nature and degree of proximity of the goods or services concerned (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 44).
- 73 As regards the strength of the reputation and the degree of distinctive character of the mark, the Court of Justice has already held that, the stronger that mark's distinctive character and reputation are, the easier it will be to accept that detriment has been caused to it. It is clear from case-law that, the more immediately and strongly the mark is brought to mind by the sign, the greater the likelihood that the current or future use of the sign takes, or will take, unfair advantage of the distinctive character or the repute of the mark or is, or will be, detrimental to it (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 67, 69; 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 44).
- 74 Where a third party attempts, through the use of a sign similar to a mark with a reputation, to ride on the coattails of that mark in order to benefit from its power of attraction, its reputation and its prestige, and to exploit, without paying any financial compensation and without being required to make efforts of its own in that regard, the marketing effort expended by the proprietor of that mark in order to create and maintain the image of that mark, the advantage resulting from such use must be considered to be an advantage that has been unfairly taken of the distinctive character or the repute of that mark (18/06/2009, C-487/07, L'Oréal, EU:C:2009:378, § 49).
- 75 As stated above, the earlier mark 'OREO' possesses significant reputation which goes beyond the scope of the reputed goods. When used in the same or adjacent sectors, which are all related to foodstuffs and beverages, the Board considers that it is likely that an association will be created between the marks. The use and registration of the applicant's mark would therefore, without due cause, take unfair advantage of the investments made by the opponent by riding on the coattails of the reputation it has fostered in its earlier mark over the years.
- 76 This means that the contested sign, when used in relation to the goods and services in question, can indeed profit from the attractiveness and the value vested in the earlier mark, which has been achieved by the opponent by conscious, persistent, wide-spread, and costly marketing efforts and long-term presence in the European Union resulting in significant market share and sales figures (see Attachments 14 and 16). This transfer of image and attractive power may result in unduly boosting of the sales of the applicant, thus exploiting the investment made the opponent's leading global brand without compensation. The consumers could, for instance, be encouraged to acquire goods and services advertised with the EUTM application as they will relate it to the earlier reputed 'OREO' brand, which they recognise and trust as a longstanding brand for *biscuits* and *cookies*. Taking into account the particular stylisation of the central element 'PORLEO' which resembles the recognisable depiction of the earlier mark used in the market, the Board finds it highly probable that the applicant may intentionally or unintentionally influence consumer's choice in purchasing the relevant categories of foodstuffs and beverages or related sale services. This particular choice may be manipulated and particularly encouraged by the

array of positive qualities and associations that the earlier mark ‘OREO’ may evoke in consumer’s minds due to intense promotional campaigns and personal experience.

77 Such unfair advantage may occur also due to the fact that the relevant consumers are aware of the market practice whereby the reputable food brands diversify their business activities by expanding into further adjacent market segments or create partnerships with other brands in the same or closely related sector. By way of illustration, reference is made to the Attachments 10 and 12 showing McDonald’s menu where the product ‘OREO McFlurry’ is offered. The said product consists of whipped, soft-serve vanilla-flavoured ice cream in a cup filled with crumbled OREO cookies. Similarly, the evidence provided by the opponent demonstrates expansion of the ‘OREO’ brand into the sector of sweet desserts and yogurts (see for example, ‘Oreo Philadelphia cheesecake’ or ‘Oreo Split Pot Yogurt Dessert’ in Attachment 13), ice-creams (see Attachments 12, 13 and 23), milkshakes (see Burger King’s product in Attachments 32 and 33) or instant hot chocolate (Attachment 35). In that regard, the case-law makes it possible to conclude that there is a risk of free-riding on the basis of logical inferences - provided that they are not limited to mere suppositions – resulting from the analysis of probabilities and taking into account the usual practices in the relevant commercial sector and all the other circumstances of the case (07/12/2017, T-61/16, MASTER (fig.) / COCA-COLA (fig.) et al., EU:T:2017:877, § 102 and the case-law cited).

78 In the context of these findings, there is no need for the Board to consider the other heads of damage listed in Article 8(5) EUTMR, as it is sufficient to find that it is foreseeable for one type of injury to occur.

Due cause

79 Finally, as regards the last condition of the application of Article 8(5) EUTMR, namely that the use of the sign applied for should be without due cause, the burden of proof lies with the applicant (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 39; 06/07/2012, T-60/10, Royal Shakespeare, EU:T:2012:348, § 67), who did not submit any claim or arguments to this effect. Thus, no due cause has been established.

Conclusion

80 The Board concludes that the opposition succeeds on the grounds of Article 8(5) EUTMR with respect to all the contested goods and services which are subject to the present appeal proceedings. Accordingly, it is not necessary to assess the opposition on the grounds of Article 8(1)(b) EUTMR. As the opposition based on the earlier EUTM No 129 577 leads to the success of the present appeal, there is no need to examine the other earlier marks invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L., EU:T:2004:268).

81 The appeal is allowed in its entirety.

Costs

82 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent’s costs of the opposition and appeal proceedings.

83 As regards the appeal proceedings, these consist of the appeal fee of EUR 720 and the opponent’s costs of professional representation of EUR 550.

84 As to the opposition proceedings, the Opposition Division ordered each party to bear its own costs. Since the application is rejected also for the remainder, the applicant must bear

the opponent's costs in their entirety, i.e. the opposition fee of EUR 320 and the opponent's costs of professional representation of EUR 300. The total amount to be paid by the applicant to the opponent is fixed at EUR 1 890.

Order

On those grounds,

THE BOARD

hereby:

- 1. Partially annuls the contested decision to the extent that the opposition was rejected for the following goods and services:**

Class 30: Coffee-based beverages; pasta; jiaozi [stuffed dumplings]; Chinese stuffed dumplings (gyoza, cooked); Vareniki [stuffed dumplings]; noodles; bread; pitta bread; pita chips; sandwiches; skin [pastry] for spring rolls; pâtés en croûte; baklava; rice pudding; propolis; propolis for food purposes; honey; food condiment consisting primarily of ketchup and salsa; vanilla flavorings; seasonings; sauces [condiments]; tomato sauce; yeast; baking powder; flour; semolina; starch for food; sugar; cube sugar; icing sugar; tea; iced tea; salt crackers; chewing gum; salt; popcorn; corn chips; processed wheat; wheat germ for human consumption; crushed barley; oats for human consumption; processed oats; rice; treacle; pumpernickel; rye flour; rye full grain grist; oat flakes; coffee; filled bread rolls.

Class 35: Retail service in relation to/wholesale services in relation to/catalogue retail services in relation to/online retail services in relation to the following goods: savory sauces, chutneys and pastes; tablet (confectionary); Turkish delight coated in chocolate; Turkish delight; confectionery in liquid form; nonmedicated confectionery in jelly form; flavoured sugar confectionery; chocolate coated sugar confectionery; nut confectionery; confectionery having liquid fruit fillings; mint flavoured confectionery (non-medicated -); frozen dairy confections; confectionery containing jelly; confectionery containing jam; boiled confectionery; panettone; nougat; marzipan; halvah; instant dessert puddings; chocolate-based spreads; chocolate spreads for use on bread; cocoa based creams in the form of spreads; chocolate creams; croissants; eight-treasure rice pudding; custard; fruited scones; crackers flavoured with fruit; deep-fried dough sticks (Youtiao); chocolate coated nougat bars; hot chocolate mixes; kheer mix (rice pudding); chocolate-coated nuts; crackers flavoured with fruit; tarts; petits fours [cakes]; fruit filled pastry products; fresh pasties; shortcrust pastry; almond pastries; pastries containing creams and fruit; pastries containing creams; frozen pastries; pastries containing fruit; savory pastries; chocolate covered cakes; deep chocolate cake made with chocolate sponge; malt cakes; oat cakes for human consumption; iced fruit cakes; fruit cakes; cream cakes; chocolate cakes; candied cakes of popped rice; steamed sponge cakes (fagao); shortbread part coated with chocolate; shortbread with a chocolate flavoured coating; shortbread with a chocolate coating; rice cake snacks; snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; sesame candy bars; oat bars; chocolate powder; cocoa powder; preparations for making beverages [coffee based]; preparations for making beverages [cocoa based]; drinking cocoa paste; cocoa beverages with milk; milk chocolates; hot chocolate; chocolate-based beverages with milk; coffee-based beverages; cocoa-based beverages; mixtures of coffee; cocoa mixes; chocolate-coated rice cakes; snack foods prepared from maize; rice-based snack food; rice biscuits; canapes; oat clusters containing dried fruit.

- 2. Rejects the application also for the abovementioned goods and services.**

3. Orders the applicant to bear the opponent's costs of the opposition and appeal proceedings amounting to EUR 1 890.

Signed

N. Korjus

Signed

A. Kralik

Signed

C. Govers

Registrar:

Signed

p.o. E. Apaolaza
Alm

