

## OPPOSITION No B 3 194 690

**Enexis Holding N.V.**, Magistratenlaan 116, 5223 MB 's-Hertogenbosch, Netherlands (opponent), represented by **Holla Advocaten**, Stationsplein 101, 5211 BM 's-Hertogenbosch, Netherlands (professional representative)

a g a i n s t

**Enixi GmbH**, Rosentaler Straße 150, 9020 Klagenfurt, Austria (applicant).


On 13/05/2024, the Opposition Division takes the following


### DECISION:

1. Opposition No B 3 194 690 is upheld for all the contested goods and services.
2. European Union trade mark application No 18 818 940 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

### REASONS

On 25/04/2023, the opponent filed an opposition against all the goods and services of

European Union trade mark application No 18 818 940  (figurative mark). The opposition is based on, inter alia, Benelux trade mark registration

No 1 006 013  (figurative mark). The opponent invoked Article 8(1)(b) EUTMR and 8(5) EUTMR.

### LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) EUTMR

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to examine the opponent's claim under Article 8(1)(b) in relation to the opponent's Benelux trade mark registration No 1 006 013.

### **a) The goods and services**

The goods and services on which the opposition is based are, inter alia, the following:

*Class 9: Software, including gas and electricity network management software.*

*Class 39: Transport and distribution of renewable energy, electricity, gas, heat, water, CO<sub>2</sub>, hydrogen and steam; education, information and consultancy on the aforementioned services, also within the framework of innovation platforms related to energy transition and renewable energy development.*

The contested goods and services are the following:

*Class 4: Electrical energy; electrical energy from non-renewable sources; electrical energy from renewable sources; electrical energy from wind power; electrical energy from solar power.*

*Class 9: Interactive database software; software for the integration of artificial intelligence and machine learning in the field of Big Data; computer e-commerce software to allow users to perform electronic business transactions via a global computer network; e-commerce and e-payment software; software platforms to allow users to collect money.*

*Class 38: Providing user access to platforms on the Internet; providing access to platforms on the Internet; providing access to platforms and portals on the Internet; provision of access to an electronic marketplace [portal] on computer networks.*

*Class 42: Consulting services in the field of software as a service [SaaS]; providing temporary use of web-based applications; providing temporary use of web-based software.*

An interpretation of the wording of the list of goods and services is required to determine the scope of protection of these goods and services.

The term 'including', used in the opponent's list of goods and services, indicates that the specific goods and services are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (09/04/2003, T-224/01, NU-TRIDE / TUFFTRIDE, EU:T:2003:107).

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition or complementary.

#### **Contested goods in Class 4**

It is admittedly true that the contested *electrical energy; electrical energy from non-renewable sources; electrical energy from renewable sources; electrical energy from wind power; electrical energy from solar power* in Class 4 differ in nature from the

opponent's *transport and distribution of renewable energy, electricity, gas, heat, water, CO<sub>2</sub>, hydrogen and steam* in Class 39. However, the Opposition Division considers that a clear connection exists between those goods and services. It is not uncommon in the relevant market sector for the producers of those goods, usually operators of power plants, wind parks, etc., to also provide services relating to their transport and distribution and vice versa. Furthermore, these goods and services target the same public and will be distributed through the same channels and are complementary to each other. Therefore, these goods and services are similar to an average degree.

### **Contested goods in Class 9**

The contested *interactive database software; software for the integration of artificial intelligence and machine learning in the field of Big Data; computer e-commerce software to allow users to perform electronic business transactions via a global computer network; e-commerce and e-payment software* are included in the broad category of the opponent's *software*. Therefore, they are identical.

The contested *software platforms to allow users to collect money* are at least similar to a high degree to the opponent's *software* because they at least coincide in nature, purpose, method of use, distribution channels, relevant public and producer.

### **Contested services in Class 38**

Telecommunication services and software, insofar as they enable access to these services, both target the same public and are provided through the same distribution channels. Clearly, these goods and services are complementary and serve the same purpose. Consequently, the contested *providing user access to platforms on the Internet; providing access to platforms on the Internet; providing access to platforms and portals on the Internet; provision of access to an electronic marketplace [portal] on computer networks* are similar to the opponent's *software* in Class 9 because they are complementary and coincide in purpose, distribution channels and relevant public.

### **Contested services in Class 42**

The contested *consulting services in the field of software as a service [SaaS]* are similar to the opponent's *software* in Class 9 because they coincide in distribution channels, relevant public and producer/provider.

The contested *providing temporary use of web-based applications; providing temporary use of web-based software* are similar to the opponent's *software* in Class 9 because they are in competition and coincide in distribution channels, relevant public and producer/provider.

### **b) Relevant public – degree of attention**

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods and services found to be identical or similar to varying degrees target the public at large and business customers with specific professional knowledge or expertise.

The degree of attention may vary from average to high, depending on the specialised nature of the goods, the frequency of purchase and their price.

### c) The signs



The relevant territory is Benelux.

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the Benelux trade mark means that an earlier Benelux trade mark has identical protection in the relevant territories. Earlier Benelux trade marks may therefore be relied upon to challenge any subsequent application for a trade mark that would prejudice their protection, even if this is only in relation to the perception of consumers in part of the Benelux (09/03/2005, T-33/03, Hai / SHARK (fig.), EU:T:2005:89, § 39; 03/03/2004, T-355/02, ZIRH / SIR (fig.), EU:T:2004:62, § 36).

As will be explained in detail below, the earlier mark's element 'GROEP' is at most weak for the Dutch-speaking part of the relevant public. Bearing in mind that this increases the similarity between the signs at issue, the Opposition Division finds it appropriate to focus on the Dutch-speaking part of the public.

The earlier mark's figurative device comprises partially overlapping pink and green squares. The overlapping part is depicted in blue. This element will be perceived as purely abstract and, due to its complexity, cannot be considered a basic geometrical shape. Therefore, it is considered distinctive to a normal degree for the relevant goods.

The earlier mark's verbal element 'ENEXIS' is meaningless and, therefore, distinctive.

The earlier mark's verbal element 'GROEP' means 'group'. This element is at most weak, if not non-distinctive, since it merely refers to the applicant's company structure (27/11/2020, R 809/2020-4, PACIFIC Group (fig.) / PACIFIC (fig.) § 14).

The earlier mark has no element that could be considered clearly more dominant than other elements.

The contested sign's figurative device is a purely abstract figure that is distinctive to a normal degree.

The contested sign's verbal element 'enixi' is meaningless and, therefore, distinctive.

The contested sign's verbal element 'Energie verbindet.' is a German phrase meaning 'energy connects'. The public under analysis will understand this phrase with this meaning, inter alia, because of its close equivalent Dutch phrase 'energie verbindt'. For the contested goods in Class 4, this element will be perceived as a slogan / advertising message extolling their qualities. Therefore, it is at best weak. However, this element may be distinctive to a normal degree for the remaining goods and services, as they do not necessarily relate to energy. In any event, this element is significantly smaller than, and positioned below, the contested sign's element 'enixi'. Therefore, it is secondary in the sign, as it is overshadowed by its remaining elements, which are dominant.

Both signs' verbal elements are depicted in a basic font that lacks distinctiveness.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, SELENIUM-ACE / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37).

**Visually**, the signs coincide in 'EN\*XI\*'. They differ in their third letters, namely '\*E\*' and '\*I\*', respectively, and in the earlier mark's final letter '\*S'. The signs further differ in their respective figurative elements and aspects and in the verbal elements 'GROEP' (earlier mark) and 'Energie verbindet.' (contested sign).

The signs coincide significantly in their distinctive verbal elements 'ENEXIS and 'enixi', respectively. Furthermore, their differing letters are placed in the centre or at the end of the signs, namely in a position where they are likely to attract less attention.

The remaining differences are non-distinctive (i.e. the signs' fonts), at most weak (the earlier mark's 'GROEP'), secondary (the contested sign's 'Energie verbindet.') or less impactful (the signs' figurative elements).

Therefore, the signs are visually similar to an average degree.

**Aurally**, the pronunciation of the signs coincides in the sound of the letters 'EN\*XI\*'. The signs differ in the sound of their third letters '\*E\*' and '\*I\*', respectively, and in the earlier mark's final letter 'S', which are in positions where consumers normally pay less attention.

Given its secondary position within the contested sign, the element 'Energie verbindet.' is unlikely to be pronounced. Case-law confirms that consumers generally refer to dominant elements, while less prominent elements are not pronounced (03/07/2013, T-206/12, LIBERTE american blend (fig.) / La LIBERTAD et al., EU:T:2013:342, § 43-44). In any case, consumers tend to shorten marks containing several words. (28/09/2016, T-539/15, SILICIUM ORGANIQUE G5 LLR-G5 (fig.) / Silicium Organique G5- Glycan 5-Si-Glycan-5-Si-G5 et al., EU:T:2016:571, § 56).

Conversely, as the earlier mark's element 'GROEP' is quite prominently depicted, it will most likely be pronounced.

Therefore, also considering that the element 'GROEP' is at best weak, the signs are aurally similar to at least an average degree.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The signs evoke different concepts, namely 'group'

(earlier mark) and 'energy connects' (contested sign). To this extent, the signs are conceptually dissimilar. However, this conceptual difference is of limited relevance in the overall comparison of signs, as it stems from elements that are at best weak or secondary.

As the signs have been found similar in at least one aspect of the comparison, the examination of likelihood of confusion will proceed.

#### **d) Distinctiveness of the earlier mark**

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection at least in relation to some of the registered services. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal, despite the presence of a non-distinctive element in the mark, as stated above in section c) of this decision.

#### **e) Global assessment, other arguments and conclusion**

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel. (fig.) / ACOTEL (fig.) et al, EU:T:2013:605, § 54).

The goods and services are identical or similar to varying degrees. The degree of attention of the public under analysis varies from average to high. The earlier mark has a normal degree of distinctiveness. The signs are visually similar to an average degree and aurally at least similar to an average degree. Although the signs are conceptually dissimilar, this aspect has a limited impact on the comparison for the reasons set out in part c) of this decision.

The signs coincide significantly in terms of their verbal elements 'ENEXIS' and 'enixi', respectively. These elements are distinctive and play an independent role in both signs. In contrast, all the remaining elements and aspects are non-distinctive, at best weak, secondary or less impactful.

Therefore, consumers will mainly try to memorise and recollect the signs by the elements 'ENEXIS' and 'enixi'. Consequently, it cannot be safely excluded that, in their imperfect recollection, consumers may fail to remember the exact spellings of these elements and, therefore, confuse the signs in the marketplace.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the Dutch-speaking public. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant Benelux public is sufficient to reject the contested application.

Therefore, the opposition is well founded on the basis of the opponent's Benelux trade

mark registration No 1 006 013  **ENEXIS**  
GROEP (figurative mark). It follows that the contested trade mark must be rejected for all the contested goods and services.

Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the enhanced degree of distinctiveness of the opposing mark due to its reputation as claimed by the opponent and in relation to identical and similar goods and services. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

As Benelux trade mark registration No 1 006 013 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods and services against which the opposition was directed, there is no need to examine the other earlier rights invoked by the opponent (16/09/2004, T-342/02, Moser Grupo Media, S.L. (fig.) / MGM, EU:T:2004:268).

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other ground of the opposition, namely Article 8(5) EUTMR.

## **COSTS**

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party.

Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



### The Opposition Division

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According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.