

Notification to the opponent of a decision

Alicante, 26/05/2020

TEEKENS KARSTENS ADVOCATEN
NOTARISSEN
P.O. Box 1144
NL-2302 BC Leiden
PAÍSES BAJOS

Your reference: **mad-med-tokaj**

Opposition number: **B 003063988**

Contested trade mark number: **W01408540**

Name of the opponent: **Jeroboam Estate B.V.**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **26/05/2020**.



Sandra IBAÑEZ

Enclosures (excluding the cover letter): 07 pages.

Please note that the decisions of the Opposition Division will not be signed by the responsible officials, but will only indicate their full name and carry a printed seal of the Office according to Article 94(2) EUTMR.

OPPOSITION No B 3 063 988

Jeroboam Estate B.V., De Kevel 22, 2201 MB, Noordwijk, The Netherlands (opponent), represented by **Teekens Karstens Advocaten Notarissen**, Vondellaan 51, 2332 AA, Leiden, The Netherlands (professional representative)

a g a i n s t

Mad Goat Holding Kft., Ezredes u. 7/b, 1024, Budapest, Hungary (holder), represented by **Abk - Dr. Krajnyák & Partner Law and Patent Office**, Logodi u. 5-7., 1012 Budapest, Hungary (professional representative).

On 26/05/2020, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 063 988 is upheld for all the contested goods.
2. International registration No 1 408 540 is entirely refused protection in respect of the European Union.
3. The holder bears the costs, fixed at EUR 620.

REASONS

The opponent filed an opposition against all the goods of international registration



designating the European Union No 1 408 540. The opposition is based on

international trade mark registration No 1 165 472 designating the European Union. The opponent invoked Article 8(1)(b) EUTMR.

MAD

Preliminary remark:

The opponent, on its own motion, submitted evidence related to the use of the trade mark on which the opposition is based. Nevertheless, according to Article 47(2) EUTMR, use of the earlier mark needs to be shown only if the holder requests proof of use. As long as the EUTM holder does not request proof of use, the issue of

genuine use will not be addressed by the Office ex officio. In such cases, in principle, it is even irrelevant that the evidence produced by the opponent might demonstrate only a particular type or manner of use, or use that is limited to only part of the goods or services for which the earlier mark is registered. Therefore, the Opposition Division will not assess the genuine use of the earlier mark.

LIKELIHOOD OF CONFUSION — 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.

a) The goods

The goods on which the opposition is based are the following:

Class 33: *Wines, spirits, liqueurs.*

Following a limitation submitted on 23/01/2020, the contested goods are the following:

Class 33: *White wines originated from the area of appellation of origin Tokaj.*

Irrespective of the origin of the wines in question, as argued by the parties, the contested goods are included in the broad category of the opponent's *wines*. Therefore, they are identical.

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 found to be identical are directed at the public at large. Indeed, as also argued by the opponent, unless the mark applied for refers specifically to quality wines, sold at relatively high prices, the goods referred to in the application for registration must be intended for everyday consumption, so that the consumer, as a general rule, will show an average level of attention when purchasing them (27/06/2019, T-268/18, Luciano Sandrone, EU:T:2019:452, § 50-51).

c) The signs



Earlier trade mark

Contested sign

The relevant territory is the European Union.

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 European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57). This applies by analogy to international registrations designating the European Union. Therefore, a likelihood of confusion for only part of

the relevant public of the European Union is sufficient to reject the contested application.

Even if as argued by the opponent, the reversed letter 'a' in the earlier mark may also be read as the letter 'e' by a part of the public, given that it clearly can be identified as the letter 'a', it is reasonable to assume that a significant part of the public will associate this character with the letter 'a' and read the earlier mark 'MAD'.

The verbal element 'MAD' that the signs have in common, and repeated twice in the contested sign, will be understood by the English-speaking part of the public as describing 'people or things that you think are very foolish' (information extracted on 20/05/2020 from <https://www.collinsdictionary.com/dictionary/english/mad>). Such a common concept is distinctive since it is not related with the nature of the goods in question. Consequently, the Opposition Division finds it appropriate to focus the comparison of the signs on the English-speaking part of the public that will perceive the earlier mark as composed of the letters 'MAD', and for which the similarities between the signs are even higher, as explained below.

The verbal element 'TOKAJ', depicted on the bottle itself but hardly perceptible, might be perceived by a part of the public as a misspelling of the word 'TOKAY', a fine sweet wine or a variety of grape used to make this wine (information extracted on 20/05/2020 from <https://www.collinsdictionary.com/es/diccionario/ingles/tokay>). In such a case, the distinctive character of this element is very low. For the rest of the public to whom this element has no meaning, it is distinctive.

As far as the shape of the bottle in the contested sign is concerned, the holder argues that it is particularly distinctive and may help consumers to differentiate wines. Nevertheless, the shape of the bottles as such will not be perceived by the public as distinctive for alcoholic beverages and only plays a secondary role within the overall impression of the mark (26/06/2019, R 3/2019-5, JC JEAN CALL Champagne PRESTIGE Bottle (3D) /Bottle (3D) et al. § 29). Moreover, the General Court has held that, in the wines sector, consumers usually describe and recognise wine by reference to the verbal element that identifies it, particularly in bars and restaurants, where wines are ordered orally after their names have been seen on the wine list (23/11/2010, T 35/08, Artesa Napa Valley, EU:T:2010:476, § 62; 13/07/2005, T 40/03, Julián Murúa Entrena, EU:T:2005:285, § 56; 12/03/2008, T 332/04, Coto d'Arcis, EU:T:2008:69, § 38). Consequently, consumers will not pay so much attention to the bottle that is only the container of the product itself. Therefore, this argument must be set aside and the shape of the bottle is non-distinctive. The white label, with the depiction of a town and some verbal elements that are illegible, is rather common place and thus very lowly distinctive.

Contrary to the argument of the holder, the reversed letter 'a' in the earlier mark is not more dominant than the remaining letters. Indeed, first of all, the earlier mark is composed of only one component, 'MAD', and second, all of the letters in which this element consists are of the same size. Therefore, the earlier mark has no element that is more dominant than other.

However, because of its size and position and also because it is depicted in black against a white background, the verbal element 'MAD' is clearly the most eye-catching element of the contested sign and will most likely be the element used by consumers to refer to the sign.

Account is taken of the fact that 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, EU:T:2005:289, § 37).

Visually and aurally, the signs coincide in the word/sound 'MAD' that is distinctive and constitutes the earlier mark in its entirety. The signs differ in the additional verbal element/sound (in the event it would be pronounced) 'TOKAJ' of the contested sign that will not catch as much the attention as the element 'MAD' for the reasons already given above. Visually, the signs also differ in the additional figurative elements and shapes of the contested sign that are either non-distinctive or very lowly distinctive, and in the stylization of the earlier mark. Moreover, the accent on the letter 'A' in the contested sign has very little impact visually, while it has no impact at all at an aural level.

Therefore, the signs are visually and aurally similar to an average degree, at least and even aurally identical for the significant part of the public that will not pronounce the verbal element 'TOKAJ' of the contested sign.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the signs will be associated with a similar meaning, and taking into account the additional elements that also constitute the contested sign, the signs are conceptually similar to an average degree, at least.

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.

The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.

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 relevant public at issue in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

According to settled case-law, the likelihood of confusion on the part of the public must be appreciated globally, taking into account all factors relevant to the circumstances of the case (29/09/1998, C-39/97, Canon, EU:C:1998:442, §16).

Furthermore, 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).

In the present case, the goods are identical and the signs are visually, aurally and conceptually similar to an average degree at least on account of the coincidences between them. Indeed, as already outlined above, the distinctive verbal element 'MAD' of earlier mark is entirely reproduced in the contested sign where it is also the most eye-catching element and the element that the public will most likely use to refer to the sign.

The impact of the differences listed in part c) above will be minimal and this, even in the event that the verbal element 'TOKAJ', is pronounced. Indeed, likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings. In the present case, it is highly conceivable that the relevant consumer will perceive the contested mark as a sub-brand, designating a different product, configured in a different way according to the type of wines that it designates (23/10/2002, T 104/01, Fifties, EU:T:2002:262, § 49).

The holder refers to previous decisions of the Office to support its arguments. However, the Office is not bound by its previous decisions, as each case has to be dealt with separately and with regard to its particularities.

This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198).

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.

In the present case, the opposition B 849 846 'MED' vs 'MAD' referred to by the holder is not relevant to the present proceedings because, even if there was a certain level of aural similarity, as stated in the decision itself, 'the graphical representation of the letters composing the sign, together with the difference in the disposition of the letters and the contrast of black and white render the marks dissimilar from a visual point of view' were sufficient to consider the signs dissimilar.

In view of the above, it follows that, even if the previous decisions submitted to the Opposition Division are to some extent factually similar to the present case, the outcome may not be the same.

Considering all the above, there is a likelihood of confusion on the part of the English-speaking part of the public that perceives the earlier mark as 'MAD'. As stated above in section c) of this decision, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Therefore, the opposition is well founded on the basis of the opponent's international trade mark registration designating the European Union. It follows that the contested trade mark must be rejected for all the contested goods.

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 holder 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

Rosario GURRIERI

Sandra IBAÑEZ

Francesca DRAGOSTIN

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.