

**Notification to the applicant/holder of a decision**

Alicante, 20/11/2018

CLERY DEVERNAY  
9 avenue Percier  
75008 Paris  
FRANCIA

*Your reference:*

*Opposition number:* **B 002999962**

*Contested trade mark number:* **017083148**

*Name of the applicant/holder:* **HOLDING BERNARD BLACHERE**

Please see the attached decision which ends the abovementioned opposition proceedings. It was taken on **20/11/2018**.



**Sandra IBAÑEZ**

Enclosures (excluding the cover letter): 5 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 2 999 962**

**Sánchez Romero Carvajal Jabugo S.A.**, Fernán Caballero 7, 11500 El Puerto de Santa María, Spain (parte oponente), representada por **Aguilar i Revenga**, Consell de Cent 415, 5º, 1ª, 08009 Barcelona, Spain (representante profesional)

a g a i n s t

**Holding Bernard Blachère**, 365 Chemin de Maya, 13160 Châteaurenard, France (applicant), represented by **Clery Devernay**, 9 Avenue Percier, 75008 Paris-8e-arrondissement, France (professional representative).

On 20/11/2018, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 2 999 962 is rejected in its entirety.
2. The opponent bears the costs, fixed at EUR 300.

**REASONS**

The opponent filed an opposition against some of the goods and services of



European Union trade mark application No 17 083 148 '  ', namely against all the goods and services in Classes 29 and 43. The opposition is based on European



Union trade mark registration No 16 159 981 '  ' for which the opponent invoked Article 8(1)(b) EUTMR, and on European Union trade mark registration No 9 335 662



'  ' for which the opponent invoked Article 8(5) EUTMR.

**LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR —** European Union trade mark registration No 16 159 981

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 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 earlier mark is a figurative mark consisting of a black circle in the middle of which the number '5' in Arabic numerals is represented in a relatively standard typeface and golden colour. The black circle in the centre is surrounded by a thin golden outline which is itself surrounded by a slightly thinner black outline.

The contested sign is a figurative mark consisting of a black square containing a white circle in the middle of which the letter 'V' is represented in white and in a rather standard typeface.

As far as the contested sign is concerned, the opponent argues that it represents the Roman numeral 'V' which corresponds to the Arabic numeral '5', but offers no explanation as to why this would be so. Nevertheless, albeit that a non-negligible part of the public in the territory understands Roman numerals, the rule throughout the territory to represent a numeral, is to use the Arabic and not the Roman numeral system. This is true regardless of the script used by different parts of the public, namely the Latin, Cyrillic or Greek alphabets. As the use of Roman numerals is only occasional, when confronted with the element 'V' only, without any additional Roman numeral or any other indication that would help consumers to automatically understand that they are facing a Roman numeral, the part of the public of the relevant territory using Latin and Cyrillic alphabet will rather intuitively recognize the letter 'V', in Latin script, to which they are used, or at least familiar with in the case of the part of the public that uses Cyrillic alphabet. For the part of the public that uses the Greek alphabet, the letter 'V' is the equivalent of the letter 'ν' in Latin script. Therefore, the Opposition Division considers that the element 'V' in the contested sign will be understood by the part of the public using Latin and Cyrillic alphabet as the letter 'V' in Latin script whereas the part of the public using Greek alphabet will perceive it as the equivalent to the letter 'ν' in Latin script. As a consequence, the argument of the opponent must be set aside.

The numeral '5' in the earlier mark and the element 'V' of the contested sign have no connection whatsoever with the goods and services in question, therefore, they are distinctive to an average degree. However, the black circle together with the golden and the black outlines in the earlier mark and the black square and the white circle of

the contested sign are non-distinctive since they are simple geometrical shapes of a purely decorative nature.

The signs have no element that could be considered clearly more dominant (visually more eye catching) than other elements.

Account must be taken of the fact that the length of the signs may influence the effect of the differences between them. The shorter a sign, the more easily the public is able to perceive all of its single elements. Therefore, in short signs, small differences may frequently lead to a different overall impression. In contrast, the public is less aware of differences between long signs.

**Visually**, the opponent argues that to some extent the signs are identical since they both consist of a black circle with a coloured outline with the Arabic numeral '5' or the Roman numeral 'V'. Even if it cannot be denied that the signs coincide to some extent as they both consist in a single element (letter or number) represented in the middle of a black circle, as already explained above, the figurative elements of both signs are non-distinctive since they only have a decorative purpose. Furthermore, the elements in the middle of the circles consist of the Arabic numeral '5' in the earlier mark and of the element 'V' in the contested sign as already explained in detail above, and, as a consequence, the shapes of these two elements are very different. In addition, the numeral '5' in the earlier mark is represented in golden colour whereas the element 'V' of the contested sign is represented in white. Finally, the golden circle of the earlier mark is surrounded by a black circle whereas, in the contested sign, the white circle is displayed against a black square.

In view of the aforementioned differences between the signs and taking into consideration that they only coincide in a non-distinctive element, the signs are visually dissimilar.

**Aurally**, the pronunciation in the different parts of the relevant territory corresponding to the numeral '5' in the earlier mark does not coincide with the pronunciation corresponding to the letter 'V' in the contested sign, whether perceived in Latin script by the part of the public using Latin and Cyrillic alphabets or perceived in Greek script by the part of the public using Greek alphabet.

Therefore, it is concluded that the signs are not aurally similar.

**Conceptually**, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the signs will be associated with a dissimilar meaning, the signs are conceptually not similar.

As the signs coincide only in a non-distinctive element, they are dissimilar.

## **b) Conclusion**

According to Article 8(1)(b) EUTMR, the similarity of the signs is a condition for a finding of likelihood of confusion. Since the signs are dissimilar, one of the necessary conditions of Article 8(1)(b) EUTMR is not fulfilled, and the opposition must be rejected as far as it is based on this ground.

**REPUTATION — ARTICLE 8(5) EUTMR — European Union trade mark registration No 9 335 662**

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will 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 European Union 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 contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.
- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.
- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-345/08 & T-357/08, Botolist / Botocyl, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

**a) The signs**

Earlier trade mark



Contested sign

Even if the signs at issue coincide in the black circle surrounded by a white outline, these elements are non-distinctive as already explained under the grounds of Article 8(1)(b) EUTMR. Therefore, reference is made to the findings reached under the grounds of Article 8(1)(b) EUTMR, which are equally valid for Article 8(5) EUTMR taking further into account that this earlier mark contains additional figurative and verbal elements, such as the letter 'J', the graphic representation of acorns and the

rectangular black and golden background, which are not present in the contested sign.

In view of the foregoing, the signs are dissimilar.

## **b) Conclusion**

As is clear from the above, the similarity of the signs is a condition for Article 8(5) EUTMR to be applied. Since the signs have been found to be dissimilar, one of the necessary conditions of Article 8(5) EUTMR is not fulfilled, and the opposition must be rejected on this ground, too.

## **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 opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMIR (former Rule 94(3) and Rule 94(7)(d)(ii) EUTMIR, in force before 01/10/2017), the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



## **The Opposition Division**

Frederique SULPICE

Sandra IBAÑEZ

Martina GALLE

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.