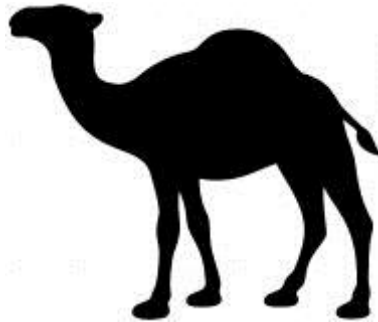


BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2009844
of 1 October 2015

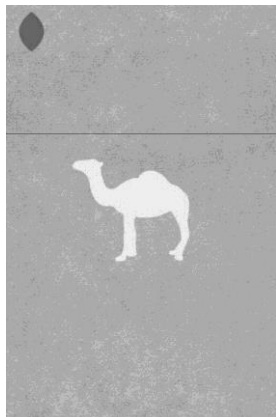
Opponent: **Japan Tobacco Inc.**
2-2-1 Toranomom
Genève 26
Switzerland

Representative: **Chiever BV**
Barbara Strozziiaan 201
1083 HN Amsterdam
The Netherlands

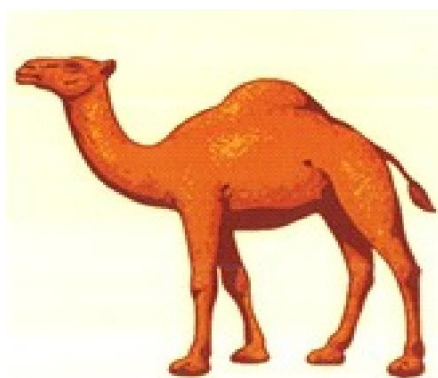
Invoked right 1: **International registration 1030881**



Invoked right 2: **International registration 901084**



Invoked right 3: **Well-known trademark according to the opponent**

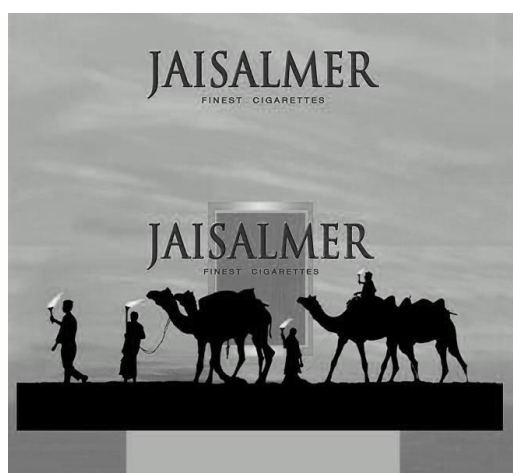


against

Defendant: **Godfrey Phillips India Ltd.**
Four Square House 49, Community Centre
Friends Colony - New Delhi-110065
India

Representative: **Algemeen Octrooi- en Merkenbureau B.V.**
John F. Kennedylaan 2
5612 AB Eindhoven
The Netherlands

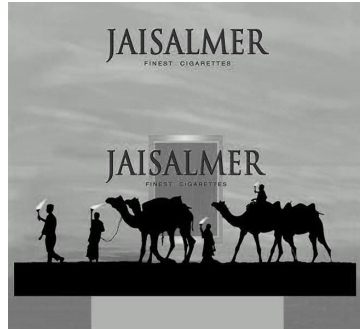
Contested trademark: **Benelux application 1284499**



I. FACTS AND PROCEEDINGS

A. Facts

1. On 18 February 2014 the defendant filed a trademark application in the Benelux for the figurative trademark



for goods in class 34. This application was processed under number 1284499 and was published on 12 March 2014.

2. On 12 May 2014 the opponent filed an opposition against the application. The opposition is based on the following earlier trademarks:

- International registration 1030881 of the figurative trademark



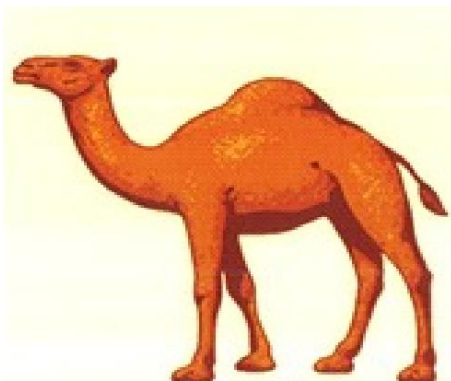
, filed on 10 February 2010 and registered for the Benelux on 24 February 2011 for goods in class 34;

- International registration 901084 of the figurative trademark



, filed on 18 September 2006 and registered for the Benelux on 26 April 2007 for goods in class 34;

- Well-known trademark (according to the opponent) according to article 6*bis* of the Paris Convention



3. According to the register the opponent is the holder of the registered trademarks invoked.
4. The opposition is directed against all of the goods of the contested application and is based on all of the goods of the trademarks invoked.
5. The grounds for opposition are those laid down in article 2.14, 1 (a) and (b) Benelux Convention on Intellectual Property (hereinafter referred to as "BCIP").
6. The language of the proceedings is English.

B. Chronological order of the proceedings

7. The opposition is admissible and was notified to the parties on 15 May 2014. In the same letter the Benelux Office for Intellectual Property (hereinafter: "the Office") gave the opponent an opportunity to submit a representation of the well-known trademark no later than 29 May 2014. On 28 May 2014 the opponent submitted such an image.
8. On 4 July 2014 Algemeen Octrooi- en Merkenbureau informed the Office that they would represent the defendant in these opposition proceedings. The Office notified the intervention to the parties on 4 July 2014. On the same day the parties also filed a joint request to change the language of the opposition proceedings to English. On 14 July 2014 the Office confirmed the change of language of the proceedings to the parties.
9. The adversarial phase of the procedure started on 16 July 2014. The Office sent the notification of the commencement of the proceedings on 18 July 2014 to the parties, giving the opponent the opportunity to substantiate the opposition by submitting arguments and documents with a time limit up to and including 18 September 2014.
10. On 16 September 2014 the opponent submitted supporting arguments to substantiate the opposition. These arguments were sent by the Office to the defendant on 30 September 2014, giving the defendant the opportunity to submit a response with a time limit up to and including 30 November 2014.
11. The defendant filed a response on 24 November 2014. This response together with an English translation was sent by the Office to the opponent on 26 November 2014.
12. Each party filed its observations within the time limits imposed by the Office.
13. The Office has sufficient information to come to a decision on the opposition.

II. ARGUMENTS OF THE PARTIES

A. Opponent's arguments

14. The opponent first explains that his company is known as one of the world's leading tobacco producers, holding the well-known tobacco brand 'CAMEL' featuring a characteristic "camel device". This brand appears on all

CAMEL packaging worldwide. Both the trademark CAMEL and the characteristic "camel device" can be considered as a well-known trademark as described in art. 6*bis* of the Paris Convention due to their long-standing worldwide use and the accompanying market share.

15. When comparing the goods, the opponent finds that the goods for which the trademarks invoked have been filed are either identical or highly similar to those for which the contested sign has been filed.

16. Furthermore the opponent considers that the relevant public at issue will be the public at large with a normal, moderate level of attention.

17. As far as the comparison of the signs is concerned, the opponent argues that, visually, the overall impression of the contested sign is confusingly similar to the overall impression of the prior trademarks. Phonetically, the prior trademarks and the contested sign are not similar, as both trademarks are purely device trademarks which are not, as such, pronounced. Conceptually, the opponent finds that the prior trademarks and the contested sign are similar as both have a camel as their only dominant element. Based on the foregoing, the opponent is of the opinion that the signs under comparison are confusingly similar.

18. The opponent continues that the dominant elements in both the prior mark and the contested sign overlap, in the sense that they both contain camel devices in a prominent way.

19. The opponent also argues that the camel device has to be considered as a strong brand with an extended distinctive character and even as a well-known trademark in the sense of article 6*bis* of the Paris Convention. To this end the opponent files several pieces of evidence to back up this claim: extracts from a couple of books giving information about the history of the CAMEL brand and the camel device, an overview of registrations worldwide of the camel device as such, several examples of packaging with the camel device and/or with the CAMEL brand, sales figures for the Benelux and worldwide. Due to the well-known status of the camel device, a risk of confusion will easily arise when a third party uses a confusingly similar sign for identical products. The aforementioned is emphasized by the fact that a camel device is far from being a commonly used device in relation to tobacco products. The opponent therefore is of the opinion that the defendant also infringes its trademark rights which it can invoke under article 6*bis* Paris Convention in conjunction with article 2.14,1 (b) BCIP.

20. The opponent concludes that the trademarks are visually and conceptually similar and that the goods are either identical or at least highly similar. Consequently there is a likelihood of confusion between the prior trademarks of the opponent and the contested sign of the applicant. Therefore the opponent requests that the Office refuse the contested sign and order the other party to bear the costs borne by the opponent.

B. Defendant's arguments

21. The defendant argues that, visually, the mere use of the same animal in a sign that, as a whole, is very different from the earlier trademarks and that clearly contains a wording that is completely dissimilar (JAISALMER), prevents any confusion for the relevant consumer. The defendant concludes that there is no visual similarity.

22. Phonetically, a direct comparison between the signs is not possible as the earlier trademarks do not contain word elements, according to the defendant. However the earlier trademark might be identified by the word "camel" (which is very likely considering the claim of it being a well-known trademark by the opponent). As the sign

of the defendant will always be pronounced as JAISALMER, phonetic confusion is not possible. The signs are thus phonetically different.

23. The defendant explains that conceptually, the JAISALMER trademark refers to the district of Jaisalmer, situated in the Indian part of the Thar Desert. Other elements of the defendant's concept are nomads, desert life, heat (fire), camels and caravans. The earlier trademark has a camel as a concept and is known for it. The defendant therefore concludes that the concept of the sign applied for is dissimilar to the concept of the earlier trademark.

24. Regarding the comparison of the goods, the defendant holds that, although certain goods are similar or identical, tobacco pouches and lighters for smokers are in no way similar to the goods of the opponent.

25. The defendant finds that the signs share the same relevant public, being the general public at large interested in smoking articles. As consumers of smoking articles tend to be very specific in choosing their brand, their level of attention is quite high, which reduces the chance of confusion in the market.

26. Furthermore the defendant provides the Office with some factual circumstances on the JAISALMER trademark. The defendant's contested sign has already been registered in 21 countries since 2004. The opponent has never opposed the JAISALMER trademark before. No confusion has ever occurred in the market.

27. The opponent's reputation is not contested by the defendant, however the latter argues that this reputation does not create a monopoly on the use of a certain animal for class 34 products. Because the opponent's trademark is well-known, the relevant public will immediately notice differences when a depiction of a camel deviates from the well-known image. The defendant refers here to a decision of the opposition division of the Office for Harmonization in the Internal Market (hereinafter referred to as "OHIM") stating that in that case a similar line of reasoning was followed regarding a similar comparison.

28. The defendant concludes that, apart from the use of the same animal, the signs are as a whole dissimilar on a visual, phonetic and conceptual level and that the relevant public is highly circumspect. Therefore confusion between the signs is not likely to occur. Based on the co-existence in over 21 countries without any confusion among the relevant consumers, the defendant is of the opinion that the Office should reject the present opposition and order the opponent to bear the costs.

III. DECISION

A.1 Likelihood of confusion

29. In accordance with article 2.14, 1 (a) and (b) BCIP, the applicant or holder of a prior trademark may submit a written opposition to the Office, within a period of two months to be calculated from the publication of the application, against a trademark which in the order of priority, ranks after its own in accordance with article 2.3 (b) BCIP or may give rise to confusion with its well-known trademark within the meaning of Article 6bis of the Paris Convention.

30. Article 2.3 (b) BCIP stipulates: *"In determining the order of priority for filings, account shall be taken of rights, existing at the time of filing and maintained at the time of the litigation, in: identical or similar trademarks filed for identical or similar goods or services, where there exists on the part of the public a likelihood of confusion that includes the likelihood of association with the prior trademark"*.

31. According to case law of the Court of Justice of the European Union (hereinafter: the “CJEU”) concerning the interpretation of Directive 2008/95/EG of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trademarks (hereinafter: “Directive”), the likelihood of confusion of the public, which is defined as the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, must be appreciated globally taking into account all factors relevant to the circumstances of the case (CJEU, Canon, C-39/97, 29 September 1998, Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999; CJBen, Brouwerij Haacht/Grandes Sources belges, A 98/3, 2 October 2000; Marca Mode/Adidas, A 98/5, 7 June 2002; Supreme Court of the Netherlands, Flügel-bottle, C02/133HR, 14 November 2003; Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

32. In assessing the similarity of the goods and services concerned, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end-users and their method of use and whether they are in competition with each other or are complementary (Canon, already cited).

33. The comparison of the goods must relate to those covered by the registration of the earlier trademarks in question and by the application of the contested sign (see e.g. EGC, Arthur et Felice, T-346/04, 24 November 2005).

34. The Office will first compare the invoked international rights 1030881 and 901084 and the contested sign.

35. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
CI 34 Raw or manufactured tobacco; tobacco for smokers, pipe tobacco, hand-rolling, tobacco chewing tobacco; snus; cigarettes, cigars, cigarillos; substances for smoking sold separately or mixed with tobacco for non-medical and non-therapeutic purposes; snuff; smokers' articles included in Class 34; cigarette paper, cigarette tubes and matches. <i>(International registration 1030881)</i>	CI 34 Cigarette paper; cigarette filters; tobacco pouches; lighters for smokers; cigarettes; cigars.
CI 34 Cigarettes, raw or manufactured tobacco; smokers' articles; matches. <i>(International registration 901084)</i>	

36. The goods “*Cigarette paper; cigarettes; cigars*” of the defendant are identical to the goods of the opponent’s rights invoked.

37. The goods “*cigarette filters; lighters for smokers*” of the defendant are included in the broad category of the opponent’s smokers’ articles. Both products concern articles made to be used by smokers. They will also be marketed through the same distribution channels. It must be borne in mind that, where the goods covered by the

earlier mark include the goods covered by the trademark application, those goods are considered to be identical (EGC, Hell, T-522/10, 17 January 2012). Therefore, these goods are considered identical as well. The same goes for the defendant's "tobacco pouches".

Conclusion

38. The goods are either identical or similar.

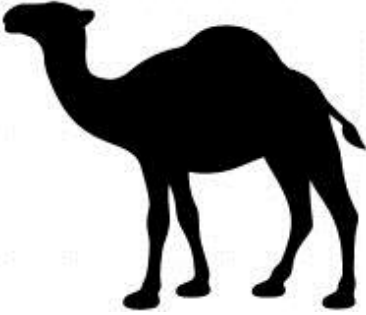
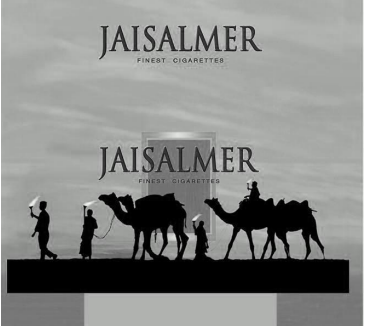
Comparison of the signs

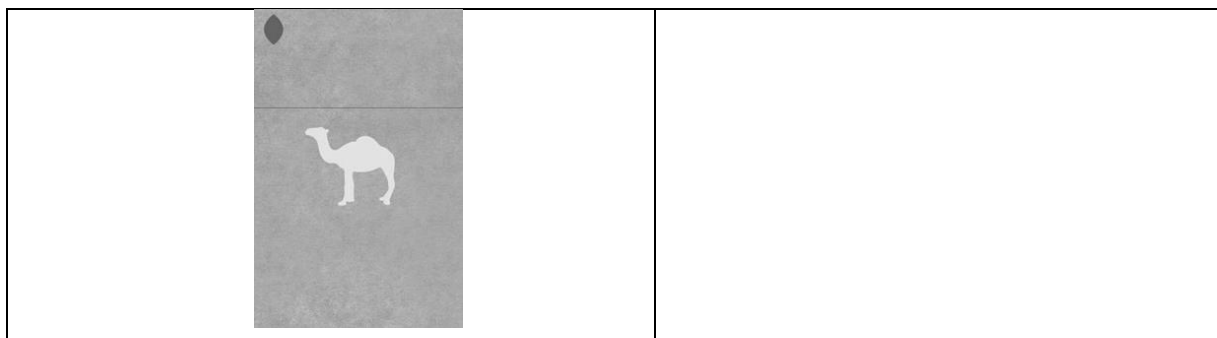
39. The wording of Article 4, 1 (b) of the Directive (cf. article 2.3, (b) BCIP) "... there exists a likelihood of confusion on the part of the public ..." shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global assessment of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (CJEU, Sabel, C-251/95, 11 November 1997).

40. Global assessment of the visual, phonetic or conceptual similarity of the marks at issue must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (CJEU, Sabel and Lloyd, already cited).

41. The overall impression created in the memory of the relevant public by a complex mark might, in certain circumstances, be dominated by one or more components of that mark (CJEU, Limonchello, C-334/05 P, 12 June 2007). With regard to the assessment of the dominant characteristics of one or more components of a complex trademark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (EGC, Matratzen, T-6/01, 23 October 2002 and El Charcutero Artesano, T-242/06, 13 December 2007).

42. The signs to be compared here are the following:

Opposition based on:	Opposition directed against:
	



43. In the rights invoked, a camel is featured either in black, with no background, or in white on a grey rectangular background, which has a horizontal fine line running across it just above the camel and which features an abstract, dark grey shape in the top left hand corner.

44. The contested sign shows a landscape with 3 nomads carrying torches and guiding 4 camels along. On one of these camels sits a fourth nomad. In the background, behind the aforementioned scene, is a dark grey rectangle. Over the top part of this rectangle is written the word "JAISALMER" in bold capital letters and underneath in a much smaller typeface "finest cigarettes". These two word elements are repeated in the same style again at the top of the contested sign.

45. With regard to the visual comparison of the signs, it is generally acknowledged that the verbal component of a complex mark is of more importance when analyzing the sign as a whole (EGC, SELENIUM-ACE, T-312/03, 14 July 2005). The average consumer looking at the contested sign will only remember the predominant word element which is "JAISALMER" as it visually draws the attention through its form -, it is written in bold capital letters - and its position - it occurs twice in eye-catching positions on the sign, once in the middle and once at the top. "Finest cigarettes" will moreover only be perceived as merely descriptive in relation to the goods concerned. It is therefore the word element JAISALMER which will enable the consumer to make the same choice on the occasion of a subsequent purchase.

46. Although the rights invoked and the contested sign both feature one or more camels facing the left, the Office finds that the overall impression of the signs at issue differs.

47. Regarding the phonetic comparison, it must be pointed out that, in the strict sense, the phonetic reproduction of a complex sign corresponds to that of all its verbal elements, regardless of their specific graphic features, which fall more within the scope of the analysis of the sign on a visual level (EGC, PC WORKS, T-352/02, 25 May 2005 and EGC, Thai Silk, T-361/08, 21 April 2010). The contested sign will be pronounced as "JAISALMER" as the average consumer will only remember the predominant word element, here "JAISALMER", which is reproduced in bold capital letters, twice, identically on the sign. The words "finest cigarettes" will not be pronounced as they are merely descriptive for the goods at issue and are represented as a subtitle in very small characters (EGC, Green by Missako, T-162/08, 11 November 2009).

48. The rights invoked are purely figurative trademarks that do not contain any verbal element. It follows from constant case law that when a purely figurative trademark represents a shape that the relevant public can easily recognize and associate with a particular word, it will refer to that trademark using that word whereas when a figurative trademark also contains a verbal element, that public will refer to this sign using that word element (EGC, GelenkGold, T-599/13, 7 May 2015). As a consequence the rights invoked will be pronounced as "camel".

49. The Office concludes that there is no phonetic similarity between the contested sign and the rights invoked.

50. Conceptually, as far as the rights invoked are concerned, they both show the image of a desert animal, a camel.

51. The contested sign refers to JAISALMER, a region in India, according to the defendant (paragraph 23). The Office is of the opinion that the average Benelux consumer will not know this, but will however recognize in the contested sign a desert landscape with camels. Therefore the Office is of the opinion that a limited degree of conceptual similarity can be at hand here.

A.2 Global assessment

52. When assessing the likelihood of confusion, in particular the level of attention of the relevant public, the similarity of the goods and services in question and the similarity of the signs are important factors.

53. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question. In the present case the Office considers that although tobacco products are relatively cheap mass consumption articles, smokers are considered particularly careful and selective as to the brand of cigarettes they smoke so a higher degree of brand loyalty and attention is assumed when tobacco products are involved. However this will not be the case when smokers buy lighters for example. Therefore, in the case of tobacco products a higher degree of similarity of signs may be required for confusion to occur (EGC, Kiowa, T-207/08, 18 May 2011). For the other goods the average consumer will have a normal degree of attention.

54. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors to be taken into account, particularly between the level of similarity of the signs and of the goods or services which they cover. A lesser degree of similarity between the relevant goods or services can be offset by a greater degree of similarity between the trademarks, and vice versa (Canon and Lloyd, already cited). In this case all contested goods are either identical or similar to the goods of the opponent.

55. It should also be taken into consideration here that normally, the average consumer perceives a mark as a whole and does not proceed to an analysis of its various details (Sabel and Lloyd, already cited). Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different trademarks but must place his trust in the imperfect picture of them that he has kept in his mind.

56. The more distinctive the earlier trademark, the greater the likelihood of confusion. Marks with a highly distinctive character, either *per se* or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character (Canon, Sabel and Lloyd, already cited). As the international rights invoked have no meaning in relation to the goods concerned in class 34, they enjoy a normal distinctive character.

57. The reputation of a mark, where it is demonstrated, is an element which, amongst others, may have a certain importance. Nevertheless, the Office points out that the reputation of a trademark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association

in the strict sense (ECJ, *Marca mode*, C-425/98, 22 June 2000). The reputation of the well-known trademark invoked here is *in confesso* between the parties. The Office is of the opinion that as there is only a limited conceptual similarity between the signs at issue, this will not be sufficient to establish a likelihood of confusion here, even if the trademark invoked has a reputation.

58. Finally, for reasons of procedural economy the Office will not proceed here to a further comparison between the well-known trademark invoked and the contested sign. In the context of opposition proceedings the scope of a well-known trademark is limited to situations in which there is a likelihood of confusion in accordance with article 6bis Paris Convention. This is expressly stated in article 2.14 (1) (b) BCIP in conjunction with article 6bis Paris Convention. Cases where there is no likelihood of confusion can therefore not be dealt with in an opposition by the Office. In the present case the well-known trademark will not be able to dismiss the aforementioned lack of a likelihood of confusion with the contested sign. The reason being that it is not different from the other international rights invoked to such an extent that it would change the outcome of the comparison of the signs, and thus the conclusion of a lack of a likelihood of confusion with the contested sign.

59. The trademarks invoked and the contested sign only show limited conceptual similarity and no visual or phonetic similarity. The Office is of the opinion that the small similarities between the signs concerned do not outweigh the many differences between them. Taking into account the higher level of attention with the relevant public for tobacco products, but also a normal level of attention for goods such as “lighters”, the Office considers that there will be no likelihood of confusion even if the goods are deemed identical or similar. Thus the relevant public will not believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Other factors

60. The existence of trademarks owned by the defendant that are older than the rights invoked (paragraph 26) is not a relevant argument for the assessment of the present opposition. As long as the earlier rights invoked are still actually protected, the existence of a prior registration or use is not relevant in the context of an opposition against a trademark application. In fact, only the earlier rights invoked and the contested sign can be taken into account here by the Office (EGC, YoKaNa, T-103/06, 13 April 2010).

61. Regarding the defendant’s reference to a decision by OHIM concerning, in the defendant’s view, a similar opposition (paragraph 27), the Office points out that it is obliged to render a decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions of other offices, whether they refer to similar cases or not (see, by analogy with, EGC, Curon, T- 353/04, 13 February 2007).

C. Conclusion

62. Based on the foregoing the Office is of the opinion that there exists no likelihood of confusion.

IV. DECISION

63. The opposition with number 2009844 is not justified.

64. The Benelux registration with number 1284499 is registered for all goods in class 34.

65. The opponent is under obligation to pay the defendant 1,000 euro in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 IR, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 1 October 2015

Tineke Van Hoey
(*rapporteur*)

Saskia Smits

Diter Wuytens

Administrative officer: Cees Van Swieten