



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2012382

of 11 September 2018

Opponent: **RAUCH Fruchtsäfte GmbH**
Langgasse 1
6830 Rankweil
Austria

Representative: **Octroibureau Vriesendorp & Gaade B.V.**
Koninginnegracht 19
2514 AB Den Haag
The Netherlands

Invoked right: **European trademark 14292767**

sonny

against

Defendant: **Rigo Trading S.A.**
Route de Trèves 6 EBBC, Building E
2633 Senningerberg
Luxembourg

Representative: **Rigo Trading S.A.**
Route de Trèves 6 EBBC Building E
2633 Senningerberg
Luxembourg

Contested trademark: **Benelux application 1337434**

SUNNY DRINKS

I. FACTS AND PROCEEDINGS

A. Facts

1. On 9 August 2016 the defendant filed an application for a trademark in the Benelux for the word mark "SUNNY DRINKS" for goods in class 30. This application was processed under number 1337434 and was published on 10 August 2016.

2. On 6 October 2016 the opponent filed an opposition against the registration of the application. The opposition is based on European trademark registration 14292767 of the word mark "sonny", filed on 25 June 2015 and registered on 14 October 2015 for goods in classes 30 and 32.

3. According to the register the opponent is the actual holder of the trademark invoked.

4. The opposition is directed against all goods of the contested application and is based on all goods in class 30 of the trademark invoked.

5. The grounds for opposition are those laid down in article 2.14, 1 (a) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

6. The language of the proceedings is English.

B. Course of the proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 7 October 2016. During the administrative phase of the proceedings both parties filed arguments. The course of the proceedings meets the requirements as stated in the BCIP and the Implementing Regulations (hereinafter "IR"). The administrative phase was completed on 27 March 2017.

II. ARGUMENTS

8. The opponent filed an opposition at the Office under article 2.14, 1 (a) BCIP, in accordance with the provisions of article 2.3 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and the identity or similarity of the goods or services concerned.

A. Opponent's arguments

9. The opponent is of the opinion that the signs are similar to a certain degree. According to the opponent, the word "DRINKS" does not form a dominant part of the contested sign. The signs coincide in their initial letter "S" and their last three letters "NNY", which are placed in the same order and position.

10. Regarding the aural comparison, the opponent finds that the first word of the mark applied for and the single word of the earlier mark are practically the same. The only difference lies in the sound of the vowels "O" and "U", which nonetheless bear a similar sound. Consequently the signs are aurally similar to a certain extent.

11. Conceptually neither signs considered in their entirety have a specific meaning in relation to the goods concerned. In any case there is no such conceptual difference that the visual and aural similarity is counteracted by an explicit conceptual difference.

12. With regard to the comparison of the goods, the opponent states that the goods are identical. The level of attention of the public concerned may be deemed average, according to the opponent.

13. The opponent is of the opinion that there exists a risk of confusion and he requests that the Office rejects the contested sign and orders the defendant to compensate the costs of these proceedings.

B. Defendant's arguments

14. The defendant does not argue the fact that the goods for which the earlier mark is registered and on which the opposition is based, are at least similar to a certain degree with the goods and services for which the contested sign has been applied for.

15. With regard to the comparison of the signs, the defendant argues that the signs are very different. According to the defendant, the opponent failed to submit any evidence that could permit the conclusion that the word "DRINKS" is purely descriptive for confectionery in class 30. As a consequence, when assessing the similarity of both signs, the word "DRINKS" must be considered just as much as the word "SUNNY".

16. Visually, the contested sign consists of two words, whereas the earlier mark consists of one word. The defendant considers the signs visually very different. The same goes for the aural comparison. Even by following the unfounded assumption of the opponent, that the general consumer will attach more importance to the word element "SUNNY" of the contested sign, the signs still have no phonetic similarity, given the obvious difference in pronunciation of an O and a U.

17. As regards the conceptual comparison, the defendant states that "SONNY" is mostly known in the U.S.A. as being a generic boy nickname. However, the average consumer of the Benelux would mostly perceive it as a fanciful word. Whereas the word "DRINKS" of the contested sign is self-explanatory, the word "SUNNY" of the contested sign has a distinctive meaning and would mostly be associated with bright and warm colours. According to the defendant, the signs are conceptually very different.

18. The defendant concludes that both signs can peacefully coexist and he requests that the Office rejects the opposition and orders the opponent to bear the cost of these proceedings.

III. DECISION

A.1 Likelihood of confusion

19. In accordance with article 2.14, 1 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 date of the application, against a trademark which in the order of priority, ranks after its own in accordance with Article 2.3 (a) and (b) BCIP.

20. Article 2.3 (a) and (b) BCIP stipulates that *"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: a. identical trademarks*

filed for identical goods or services; b. 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.”

21. According to case law of the Court of Justice of the European Union (hereinafter: “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, ECLI:EU:C:1998:442, Lloyd Schuhfabrik Meyer, C-342/97, 22 June 1999, ECLI:EU:C:1999:323; 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, ECLI:NL:HR:2003:AK4818; Brussels, N-20060227-1, 27 February 2006).

Comparison of the goods

22. In assessing the similarity of the goods and services concerned, all the relevant factors relating to these goods or services themselves should be taken into account. These 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).

23. With the comparison of the goods of the trademark invoked and the goods against which the opposition is filed, the goods are considered only on the basis of what is expressed in the register or as indicated in the trademark application.

24. The goods to be compared are the following:

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

25. The goods “confectionery” of the contested sign are mentioned *expressis verbis* in the list of goods in class 30 of both signs and are therefore identical.

Comparison of the signs

26. 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, ECLI:EU:C:1997:528).

27. Global assessment 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 (CJEU, Sabel and Lloyd, already cited).

28. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
sonny	SUNNY DRINKS

Conceptual comparison

29. The trademark invoked is an English noun, which means “*a form of address used by an older person to a boy or a young man*”¹, although it might also be perceived by part of the public as a name of a boy, as it was the first name of one of the main characters from the popular 80s series “Miami Vice”. The contested sign contains two words, the first an English adjective which means “*bright because of light from the sun*”² and the second the plural of the English noun drink, which means “(an amount of) liquid that is taken into the body through the mouth”.³ Even though the right invoked and the first word of the contested sign have a different meaning, the Office is of the opinion that part of the relevant Benelux public might not be aware of this, because of the fact that they are uncertain about the correct spelling of both English words. As a matter of fact, in Dutch, the equivalent of the first word of the contested sign would be “zonnig”, which might lead them to believe that in English the vowel to be used is also the letter “O” and not a “U”.

30. Even if the Office would consider both verbal elements of the contested sign to be equally dominant, as suggested by the defendant (see above, 15), it still comes to the conclusion that although the meaning of the signs is different, part of the relevant Benelux public will be unaware of this difference, due to an imperfect knowledge of English spelling. Since they will see in both signs a reference to the sun, the signs are for that part of the public at least conceptually similar.

Visual comparison

31. Both signs are purely verbal marks. The trademark invoked consists of one five letter word, “sonny”, whereas the contested sign consists of two words of respectively five and six letters, namely “SUNNY DRINKS”.

32. Firstly, it should be noted that, given that the earlier trade mark and the mark applied for are word marks, the fact that the former is represented in capital letters, whereas the latter is represented in lower-case letters, is irrelevant for the purposes of a visual comparison of those marks. (EGC, babilu, T-66/11, 31 January 2013).

33. According to consistent case law it must be taken into account that the consumer normally attaches more importance to the first part of a sign (EGC, Mundicor, T-183/02 and T-184/02, 17 March 2004). Both signs contain four identical letters which are also placed in the same order. The difference being the second letter (the vowel “O” instead of “U”, both having a similar rounded appearance) and the additional word “DRINKS” in the contested sign.

¹ <https://dictionary.cambridge.org/dictionary/english/sonny>

² <https://dictionary.cambridge.org/dictionary/english/sunny>

³ <https://dictionary.cambridge.org/dictionary/english/drink>

34. The Office considers that these differences are insufficient to evoke a different global visual impression.

35. The Office is of the opinion that the trademark invoked and the contested sign are visually similar to a certain extent.

Aural comparison

36. Aurally the right invoked is pronounced in two syllables, /'sʌn.i/. The contested sign is pronounced in three syllables, /'sʌn.i/ and /drɪŋks/.

37. The Office considers, in line with the visual comparison that the aural difference created through the additional word/syllable "DRINKS" is insufficient to evoke a different global aural impression, especially because the first part of the signs is identical (Mundicor, already cited).

38. The Office holds the signs to be aurally similar to a certain extent.

Conclusion

39. The right invoked and the contested sign are visually and aurally similar to a certain extent. The conceptual differences – should they be noticed by the relevant public – does not suffice to neutralize the similarities between the signs.

A.2 Global assessment

40. 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.

41. 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. The relevant goods are aimed at the general public and are purchased on a regular basis or even on impulse. The attention of the relevant public is therefore deemed to be at best average.

42. 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).

43. 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). In the present case, the trademark invoked has a normal distinctiveness, as it does not describe the relevant goods.

44. Furthermore, it is of importance that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind.

45. Based on the abovementioned circumstances, the Office finds that, given the interdependence between the identical goods and the extent of the similarity between the signs, the relevant public might be led to believe that the goods in question originate from the same undertaking or from economically-linked undertakings.

B. Conclusion

46. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion.

IV. DECISION

47. The opposition with number 2012382 is justified.

48. Benelux application with number 1337434 will not be registered.

49. The defendant shall pay the opponent 1,030 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.32, 3 Implementing Regulations, as the opposition is justified in its entirety. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 11 September 2018

Diter Wuytens
(rapporteur)

Eline Schiebroek

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