



BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

N° 2012766

of 4 September 2018

Opponent: **Sazerac Brands, LLC**
10400 Linn Station Road, Suite 300
40223 Louisville Kentucky
United States of America

Representative: **Ploum Lodder Princen Maatschap**
Blaak 28
3011 TA Rotterdam
Netherlands

Invoked right: **European registration 2597961**

EAGLE RARE

against

Defendant: **VP BRANDS INTERNATIONAL S.A**
Dunav bul. 5
4000 Plovdiv
Bulgaria

Representative: **Bastion IP**
Lange Heul 193
1403 NJ Bussum
Netherlands

Contested trademark: **International application 1319868**

ROYAL EAGLE

I. FACTS AND PROCEEDINGS

A. Facts

1. On 11 July 2016 the defendant filed an international application for the wordmark ROYAL EAGLE for goods in class 33, in which inter alia the Benelux has been designated. This application was processed under number 1319868 and was published on 24 November 2016.

2. On 24 January 2017 the opponent filed an opposition against the registration of the application. The opposition is based on EU trademark 2597961 of the wordmark EAGLE RARE, filed on 1 March 2002 and registered on 13 August 2003 for goods in class 33.

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 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 25 January 2017. During the administrative phase of the proceedings both parties filed arguments and at the request of the defendant proof of use was filed. 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 30 October 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 argues that the most dominant element in the contested sign is the word 'eagle'. According to the opponent, the word 'eagle' is not commonly used in relation to alcoholic beverages, in contrast with the word 'royal', which is regularly used for all kinds of trademarks, including products in class 33. For this reason, the consumer's attention will be mostly drawn to the word 'eagle'.

10. The opponent states that the signs are visually similar, because of the identical dominant element 'eagle' as well as the fact that in both signs, the other word starts with the letter R. Furthermore, both signs are

wordmarks consisting of two short words. The opponent also argues that the word 'royal' lacks distinctive character, because it is a laudatory indication. For this reason, the opponent concludes that the signs are visually highly similar.

11. With regard to the conceptual similarity, the opponent argues that both signs refer to the concept of an eagle. The opponent is of the opinion that the consumer will know and understand the meaning of this English word. The addition of the two other words does not alter this concept. Furthermore, the opponent states that the conceptual similarity will be reinforced by the packaging of the products, because, according to the opponent, alcoholic beverages usually refer to an animal in their trademarks and this animal will also be depicted in the logo or on the bottle. Therefore, the opponent concludes that the signs are conceptually identical.

12. The opponent states that the dominant element in both signs, the word 'eagle', will be pronounced identically. In both signs, the other word next to 'eagle' starts with the letter R and therefore both have a similar, rather soft pronunciation. According to the opponent the signs are therefore aurally similar.

13. With regard to the comparison of the goods, the opponent states that the goods are partly identical and partly highly similar.

14. The opponent also argues that the trademark invoked is highly distinctive, because it is not descriptive and the use of the word 'eagle' for alcoholic beverages is uncommon. Furthermore, according to the opponent, the combination of the words EAGLE and RARE will be perceived as a fantasy expression by the Benelux consumer.

15. The opponent concludes that there exists a risk of confusion.

16. At the request of the defendant, the opponent filed proof of use which shows that, according to the opponent, the trademark invoked has been genuinely used for whiskey.

B. Defendant's arguments

17. The defendant argues that the goods concerned are alcoholic beverages. With regard to distilled spirits, the defendant is of the opinion that the degree of attention of the public will vary from above average to high, because these products are not purchased on a daily basis.

18. With regard to the distinctiveness of the trademark invoked, the defendant disputes the opponent's arguments that the trademark invoked is highly distinctive. The defendant states that it can only be assumed that the trademark invoked possesses a normal level of distinctiveness. Any higher degree of distinctiveness has not been proven by the opponent. Furthermore, the defendant also argues that the opponent has not demonstrated that the word 'royal' in the contested sign is descriptive. Therefore, the word 'royal' must be considered distinctive.

19. The defendant argues that the fact that both signs contain an identical word, does not necessarily mean that the signs are similar in their overall impression. The defendant also refers to case law concerning signs that also consist of two words of which one word is identical. In these cases, it was decided that despite the presence of an identical word the signs were not similar. In this case, the beginning and the ending of the signs are different. For this reason, the defendant states that the signs should be considered similar to a low degree.

20. With regard to the aural comparison, the defendant states that signs differ significantly because the word 'eagle' appears in a different order.

21. Both marks refer to an eagle. However according to the defendant, due to the addition of the word 'royal', the consumer will consider the contested sign as a reference to a royal or imperial standard since the eagle has been used as a symbol by many kingdoms and empires. The trademark invoked does not have this historical, royal or imperial connotation. For this reason, the defendant argues that the signs are conceptually different.

22. The defendant acknowledges that some goods are identical or similar. However, the defendant points out that not all alcoholic beverages can be considered similar, simply because these drinks contain alcohol. According to the defendant, it is very uncommon for a company to produce different types of alcoholic beverage under the same brand. The defendant also refers to case law in which a judgment was made that there is no similarity between rum and wine. For this reason, the defendant states that some of the goods are not similar or at the very most similar to a very low degree.

23. With respect to the proof of use submitted by the opponent, the defendant states that the documents only show that the trademark invoked has been genuinely used for whiskey and not for the other goods mentioned in class 33. As mentioned above, the defendant argues that whiskey is not similar to the majority of the goods for which the contested sign has been applied.

24. The defendant concludes that there exists no risk of confusion and requests that the Office rejects the opposition.

III. DECISION

A.1 Proof of use

25. Articles 2.16, 3 (a) and 2.26, 2 (a) BCIP and rule 1.29 IR stipulate that the right invoked should be put to genuine use within the Benelux territory for a continuous period of five years prior to the publication date of the sign against which the opposition is lodged. The contested sign was published on 24 November 2016. Therefore, the opponent was required to show use of the right invoked during the period from 24 November 2011 to 24 November 2016 ('the relevant period').

26. Given the fact that the right invoked was registered more than five years prior to the publication date of the contested sign, the defendant's request that proof of use is submitted, is legitimate.

27. Following rule 1.29 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the earlier trademark for the goods and services on which the opposition is based.

Analysis of the proof of use

28. The opponent submitted the following exhibits in order to demonstrate the genuine use of the right invoked:

- Screen prints from Gall&Gall (a Dutch chain of liquor stores) web shop displaying a bottle of Bourbon which is offered for sale under the trademark invoked;
- Overview of sales figures for the opponent's products covering the period 2001-2017;
- Screen print from a Dutch distributor's website that shows that this distributor sells a Bourbon Whiskey product, named EAGLE RARE;

- Copies of reviews regarding the Bourbon Whiskey EAGLE RARE on several blogs, dated between 3 September 2013 and 29 May 2016;
- Copy of a German catalogue 'Whiskey.de', dated autumn 2016 - summer 2017 in which the whiskey brand EAGLE RARE is listed;
- Google entry showing that on 8 February 2013 the Dutch website www.drankgigant.nl offered EAGLE RARE for sale;
- Several affidavits from Dutch, Belgian, French and German distributors stating that they have sold the whiskey brand EAGLE RARE within the relevant period;
- Copies of invoices showing the sale of EAGLE RARE in the Netherlands and Germany within the relevant period;
- Copy of the catalogue of a French distributor, dated October-December 2016 in which the whiskey brand EAGLE RARE is listed.

29. After careful analysis of all of the proof of use provided, the Office concludes that the evidence submitted only refers to the marketing and sale of '*whiskey; bourbon whiskey*'. This has also been acknowledged by the defendant (paragraph 23). For this reason, the assessment of the likelihood of confusion will be based on these goods only.

A.2 Likelihood of confusion

30. 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.

31. 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.*"

32. 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, 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; Court of Appeal Brussels, N-20060227-1, 27 February 2006).

Comparison of the signs

33. 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).

34. 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).

35. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
EAGLE RARE	ROYAL EAGLE

36. According to relevant case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects, inter alia the visual, aural and conceptual aspects (reference is made to EGC Matratzen, T-6/01, 23 October 2002, ECLI:EU:T:2002:261 and Sabel, already cited).

Conceptual comparison

37. Although the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Sabel and Lloyd, already cited), the fact remains that, when perceiving a verbal sign, he or she will break it down into elements which, for him or her, suggest a concrete meaning or which resemble words known to him (EGC, Respicur, T-256/04, 13 February 2007, ECLI:EU:T:2007:46; Aturion, T-146/06, 13 February 2008, ECLI:EU:T:2008:33; Galvalloy, T-189/05, 14 February 2008, ECLI:EU:T:2008:39 and Ecoblue, T-281/07, 12 November 2008, ECLI:EU:T:2008:489). The wordmark EAGLE RARE in the contested sign has no meaning in its entirety and therefore it is likely that the public will split the wordmark into different parts: EAGLE and RARE. An eagle is a large bird of prey with a massive hooked bill and long broad wings. The word ‘eagle’ could also refer to the figure of an eagle as a symbol¹. The word ‘rare’ indicates that an event, situation, or condition does not occur very often². The Office finds that the Benelux public will understand the meaning of these words.

38. The Benelux public will also know the meaning of the word ‘royal’, which will be understood as ‘belonging to, carried out, or exercised by a king or queen’³. With regard to the contested sign, due to the grammatical construction, the Office finds that the word ‘royal’ will be perceived as an adjective describing the noun ‘eagle’.

¹ <https://en.oxforddictionaries.com/definition/eagle>

² <https://en.oxforddictionaries.com/definition/rare>

³ <https://en.oxforddictionaries.com/definition/royal>

39. Even if, as the defendant argues, the word 'eagle' in the contested sign will be perceived as a symbol (paragraph 21), both signs still refer to the concept of an eagle. Therefore, the signs are conceptually similar to a certain extent.

Visual comparison

40. Both signs are purely verbal marks. The trademark invoked consists of two words of five and four letters, EAGLE RARE. The contested sign consists of two words of each five letters, ROYAL EAGLE.

41. Although the consumer normally attaches more importance to the first part of words (EGC, MUNDICOR, T-183/02 and T-184/02, 17 March 2004, ECLI:EU:T:2004:79), that consideration cannot apply in every case (EGC, ALLTREK, T-158/05, 16 May 2007, ECLI:EU:T:2007:143). Both signs contain the identical word 'eagle'. Although the contested sign contains this word at the end, it still has an independently distinctive role (EGC, Life Blog, T-460/07, 20 January 2010, ECLI:EU:T:2010:18), because, as also considered above, the visual impression is influenced by the grammatical construction, in which the element ROYAL clearly functions as an adjective. Therefore, in the contested sign, the public's attention will be drawn to the word EAGLE and this element will not be overlooked.

42. The signs differ because of the addition of the word 'rare' in the trademark invoked and the word 'royal' in the contested sign.

43. In the light of the above, the signs are visually similar to a certain extent.

Aural comparison

44. The trademark invoked consists of two words and three syllables. The contested sign consists of two words and four syllables. As also considered with regard to the visual comparison, even though the beginning and the ending of the signs are different, this does not change the fact that the pronunciation coincides in the sound of the word EAGLE, which holds an independently distinctive role in the contested sign, and to that extent the signs are aurally similar to a certain extent.

Conclusion

45. Trademark and sign are conceptually, visually and aurally similar to a certain extent.

Comparison of the goods and services

46. 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).

47. Since the use of the earlier mark has only been proven for 'whiskey; bourbon whiskey', these goods shall form the basis for the comparison with the contested goods. Therefore, goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 33 Whiskey; bourbon whiskey	Class 33 Alcoholic extracts, alcoholic essences, alcoholic beverages [except beer], alcoholic beverages containing fruit, anisette [liqueur], anise [liqueur], aperitifs, arak [arrack]; baijiu [Chinese distilled alcoholic beverage], brandy, wine, kirsch, vodka; bitters, distilled beverages, gin, digesters [liqueurs and spirits], cocktails, perry, Curacao, liqueurs, mead [hydromel], peppermint liqueurs, nira [sugarcane-based alcoholic beverage], rice alcohol, piquette, fruit extracts [alcoholic]; pre-mixed alcoholic beverages, other than beer based; rum, cider, sake, spirits [beverages], whisky.

48. The defendant does not dispute the similarity of the contested goods “*alcoholic beverages [except beer]; distilled beverages; pre-mixed alcoholic beverages, other than beer based; spirits [beverages], whisky*”. Therefore, the Office concludes that the similarity of these goods is in confesso between the parties.

49. The contested goods “*Alcoholic beverages containing fruit; anisette [liqueur], anise [liqueur]; aperitifs; arak [arrack]; baijiu [Chinese distilled alcoholic beverage], brandy, kirsch, vodka, bitters, gin, digesters [liqueurs and spirits], cocktails, perry, Curacao, liqueurs, mead [hydromel], peppermint liqueurs, nira [sugarcane-based alcoholic beverage], rice alcohol, piquette, rum, cider, sake*” all concern alcoholic beverages, as do the goods of the trademark invoked. The purpose, method of use and end-consumer of the goods at issue are the same, those being alcoholic drinks. They are distributed through the same commercial channels and are usually placed on the same shelves in supermarkets or listed in the same category on a menu. Furthermore, these goods may originate from the same undertakings. After all, it is not unlikely that a distillery produces several spirits, such as whiskey, vodka and liqueurs. Although their production processes are different and they can be made from different raw products (e.g. sugar, juniper, grain etc.), these goods all fall into the same group of alcoholic drinks intended for a wider public. Usually the general public, apart from maybe the consumer with a specific interest, does not exactly know the specific production process of these goods. In addition, the Office points out that a likelihood of confusion among part of the relevant public is sufficient to grant an opposition (EGC, Hai/Shark, T-33/03, 9 March 2005, ECLI:EU:T:2005:89). Therefore, in the light of the above, these goods are highly similar.

50. The contested goods “*Alcoholic extracts; alcoholic essences; fruit extracts [alcoholic]*” concern additives, which could be used by either professionals or consumers for preparing mixed alcoholic beverages. Furthermore, these goods can coincide in producers, end-users and distribution channels. These goods are considered similar only to a low degree to the opponent’s whiskey.

51. With regard to the contested good ‘*wine*’, the Office finds that wine is not similar to whiskey. Their production processes and ingredients are different, and due to the popular nature of wine, the general public is aware of that (reference is made to EGC, MONTEBELLO RHUM AGRICOLE, T-430/07, 29 April 2009, ECLI:EU:T:2009:127). Although these goods can be served in restaurants and in bars, and can be offered for sale through the same distribution channels, they can also be distinguished by subcategory which is expressed by the fact that they are displayed on separate shelves in supermarkets and liquor stores. Furthermore, these goods are neither in competition nor complementary.

Conclusion

52. The goods are partly identical, partly highly similar, partly similar to a low degree and partly not similar.

A.2 Global assessment

53. 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.

54. 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. Although certain types of alcoholic beverages will be purchased more often than others, the goods concerned are targeted at the public in general. Therefore, contrary to the defendant's point of view (paragraph 17), the Office finds that for these goods the average level of attention of the public concerned may be deemed normal.

55. 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).

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). In the present case, the trademark invoked has a normal distinctiveness, as it is not descriptive of the goods and services concerned. The Office will not take into consideration the opponent's argument that the trademark invoked has an inherently high distinctive character as it is uncommon and not descriptive for the products concerned (paragraph 14). According to article 2.1, 1 BCIP a sign should by definition be distinctive in order for it to be able to constitute a trademark (see also the decision of the Court of appeal The Hague, Roxstar, 200.044.463/01, 30 March 2010).

57. Based on the abovementioned circumstances, given the interdependence between the identity and similarity of the goods and the certain extent of similarity of the signs, the Office is of the opinion that the relevant public might believe that the identical and similar goods in question originate from the same undertaking or from economically-linked undertakings.

B. Other factors

58. With regard to the conceptual comparison of the signs, the opponent states that the conceptual similarity will be reinforced by the packaging of the products (paragraph 11). The Office points out that the opposition procedure leaves no room for considerations concerning the actual or future use of the signs concerned or any other signs. The comparison of the signs is solely based on the trademark and sign as registered (see to that effect: CJEU, Quantum, C-171/06, 15 March 2007, ECLI:EU:C:2007:171; O2 Holdings Limited, C-533/06, 12 June 2008, ECLI:EU:C:2008:339 and EGC, Ferromix e.a., T-305/06-T-307/06, 15 October 2008, ECLI:EU:T:2008:444).

59. Regarding the defendant's references to previous decisions concerning, in the defendant's view, similar oppositions (paragraph 19 and 22), the Office points out that it is obliged to render an independent decision based on regulation and case law applicable in the Benelux. The Office is not bound by decisions from other offices, whether they refer to similar cases or not (see, by analogy with, GEU, Curon, T- 353/04, 13 February 2007, ECLI:EU:T:2007:47).

C. Conclusion

60. Based on the foregoing the Office is of the opinion that there exists a likelihood of confusion for the identical and similar goods.

IV. DECISION

61. The opposition with number 2012766 is partially upheld.

62. Benelux application with number 1319868 will not be registered for the following goods:

- Class 33 Alcoholic extracts, alcoholic essences, alcoholic beverages [except beer], alcoholic beverages containing fruit, anisette [liqueur], anise [liqueur], aperitifs, arak [arrack]; baijiu [Chinese distilled alcoholic beverage], brandy, kirsch, vodka; bitters, distilled beverages, gin, digesters [liqueurs and spirits], cocktails, perry, Curacao, liqueurs, mead [hydromel], peppermint liqueurs, nira [sugarcane-based alcoholic beverage], rice alcohol, piquette, fruit extracts [alcoholic]; pre-mixed alcoholic beverages, other than beer based; rum, cider, sake, spirits [beverages], whisky.

63. Benelux application with number 1319868 will be registered for the following goods, which were found to be dissimilar:

- Class 33 Wine.

64. Neither of the parties shall pay the costs in accordance with Article 2.16(5) BCIP in conjunction with Rule 1.32(3) IR, as the opposition is partly justified.

The Hague, 4 September 2018

Eline Schiebroek
(*rapporteur*)

Saskia Smits

Camille Janssen

Administrative officer: Etienne Colsoul