



BENELUX-OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2014982
of 20 December 2019

Opponent : **COMPAGNIE DE VICHY**
1 et 3, avenue Eisenhower
03200 Vichy
France

Representative: **Office Kirkpatrick S.A.**
Avenue Wolfers 32
1310 La Hulpe
Belgium

Invoked right 1: **EU trademark 13495957**
La Compagnie de Vichy

Invoked right 2: **EU trademark 15311582**
VICHY CELESTINS

Invoked right 3: **EU trademark 16400889**
VICHY THERMALIA

against

Defendant: **S.A. Vichy Catalan**
Roger de Llúria 126
08037 Barcelona
Spain

Representative: **NLO Shieldmark B.V.**
New Babylon City Offices
Anna van Buerenplein 21 A
2595 DA Den Haag
Netherlands

Contested trademark: **Benelux application 1387688**
VICHY BARCELONA

I. FACTS AND PROCEEDINGS

A. Facts

1. On 24 December 2018 the defendant filed a Benelux trademark application for the word trademark VICHY BARCELONA for goods in class 32. This application was processed under number 1387688 and was published on 23 January 2019.

2. On 22 March 2019 the opponent filed an opposition against this application. The opposition is based on the following earlier trademarks:

- European Union trademark 13495957 for the word trademark La Compagnie de Vichy, filed on 26 November 2014 and registered on 28 September 2015 for goods and services in classes 29, 30, 32, 33, 35, 39, 41, 43 and 44;
- European Union trademark 15311582 for the word trademark VICHY CELESTINS, filed on 5 April 2016 and registered on 29 August 2016 for services classes 41, 43 and 44;
- European Union trademark 16400889 for the word trademark VICHY THERMALIA, filed on 23 February 2017 and registered on 17 July 2017 for services in classes 41, 43 and 44.

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

4. The opposition is directed against all the goods of the contested application and was initially based on all the goods and services of the trademarks invoked, but with the introduction of his arguments, the opponent limits the basis of the opposition to the goods and services in classes 32, 43 and 44 .

5. The grounds for opposition are those laid down in Article 2.14, 2 (a) Benelux Convention on Intellectual Property (hereinafter referred to as: "BCIP").¹

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and the Benelux Office for Intellectual Property (hereinafter referred to as: "the Office") notified the parties on 22 March 2019. During the administrative phase of the proceedings both parties filed arguments. All of the documents submitted meet the requirements as stated in the BCIP and the Implementing Regulations (hereinafter referred to as: "IR"). The administrative phase of the procedure was completed on 26 September 2019.

II. ARGUMENTS OF THE PARTIES

8. The opponent filed an opposition at the Office under article 2.14, 2 (a) BCIP, in accordance with the provisions of article 2.2ter, 1 (b) BCIP: the likelihood of confusion based on the identity or similarity of the relevant marks and of the goods or services concerned.

A. Opponent's arguments

¹ This decision refers to the laws and regulations applicable at the date of the decision, unless it concerns provisions that have undergone a material change relevant to the decision during the proceedings.

9. According to the opponent, the word VICHY in the contested sign prevails over the word BARCELONA, on the one hand because it is placed at the beginning of the mark, on the other hand because for most of the average Benelux consumers the term VICHY is a fictive word, whereas the word BARCELONA will be associated with one of the most famous cities in Europe.

10. In the first mark invoked the words *La Compagnie de* are a generic expression, meaning "the Company" and therefore the word VICHY is to be considered the distinctive element. Furthermore, it is reasonable to assume that consumers will remember and refer to the contested trademark by simply using the more distinctive word VICHY. In the other rights invoked the more dominant and visually eye-catching word is the first word VICHY, according to the opponent.

11. From a visual and phonetic point of view, the signs coincide in the common distinctive word VICHY. The marks differ in that they also contain other elements. However, in the opinion of the opponent, these differences are insufficient to counterbalance the overlap in the most distinctive element.

12. Conceptually, the term VICHY refers to the town in South Central France. However, according to the opponent, a large part of the Benelux public will not understand the word VICHY as being a place in France, and for these people, the word is a fictive word. The term BARCELONA in the contested trademark refers to a famous city. The term CELESTINS may refer to the Celestines, a Roman Catholic monastic order, a branch of the Benedictines, founded in the 13th century. Finally, the opponent points out that the word THERMALIA refers to thermal baths and spas. Following this, the marks evoke similar conceptual associations to the extent that the earlier marks on the one hand and the contested mark on the other all contain the word VICHY.

13. The opponent observes that the contested goods are identical or at least highly similar to the goods in the same class of the first trademark invoked. Furthermore, the goods of the contested trademark are complementary and therefore similar to some of the services in classes 43 and 44 of the trademarks invoked.

14. According to the opponent, the inherent distinctiveness of the earlier marks must at least be considered normal. Nevertheless, the second mark invoked has been used for several decades with respect to hotel, bar and spa services, resulting in an increased level of distinctiveness. The opponent submits several evidences to substantiate these assertions.

15. In the case at hand, the goods and services are usual consumer goods and services directed at the public at large with an average degree of attentiveness, according to the opponent.

16. In view of the elements mentioned above, the opponent concludes that there exists a likelihood of confusion and for this reason he requests that the Office grants the opposition. He also seeks that the opponent (as the Office understands: "the defendant") bears the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

B. Defendant's arguments

17. The defendant points out that the element VICHY is a generic indication for goods in class 32 and the only distinctive element of the contested application is BARCELONA, which is not present in, nor similar to any of the opponent's trademarks.

18. In addition, the trademarks have coexisted for many years without any confusion or objection, which confirms that there is no likelihood of confusion.

19. According to the defendant, the opponent's argument that VICHY is the most distinctive element of any of the trademarks involved in this procedure, is not consistent with its allegations in a cancellation procedure before EUIPO. Indeed, in the latter procedure, the opponent argued that the element VICHY merely indicates that the goods come from the town of Vichy in central France.

20. In that context, the defendant notes that the element VICHY is, at least in relation to the goods in class 32, generic and devoid of any distinctive character, and a term commonly used to refer to carbonated mineral waters.

21. The defendant includes a coexistence agreement between the VICHY CATALAN and VICHY CELESTINS trademarks since 1993 which, according to him, proves that there is no likelihood of confusion.

22. The defendant explains that he obtained its first VICHY CATALAN trademark in 1890 and was incorporated as its company in 1900. Furthermore, he states that the VICHY CATALAN trademarks are very well known and highly renowned.

23. Based on the arguments above, the defendant concludes that there is no likelihood of confusion. Therefore, he requests that the Office rejects the opposition, allows the contested application to proceed towards registration and have the opponent bear the costs incurred in this procedure.

III. DECISION

A.1 Likelihood of confusion

24. In accordance with article 2.14 BCIP, the 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 2.2ter BCIP.

25. Article 2.2ter, para. 1 BCIP stipulates that "*A trademark shall, in case an opposition is filed, not be registered (...) where: b. because of its identity with, or similarity to, the earlier trademark and the identity or similarity of the goods or services covered by the trademarks, there exists a likelihood of confusion on the part of the public; the likelihood of confusion includes the likelihood of association with the earlier trademark.*"

26. According to case law of the Court of Justice of the European Union (hereinafter: the "CJEU") concerning the interpretation of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 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 trademarks

27. The wording of Article 5, 1 (b) of the Directive (cf. article 2.2ter, 1 (b) BCIP) according to which “there exists a likelihood of confusion on the part of the public including the likelihood of association with the earlier trademark” 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).

28. 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).

29. The trademarks to be compared are the following:

With regard to the first trademark invoked (European Union trademark 13495957):

Opposition based on:	Opposition directed against:
La compagnie de Vichy	VICHY BARCELONA

Conceptual comparison

30. The element Vichy in both the trademark invoked and the contested trademark is a city in the Allier department of Auvergne-Rhône-Alpes in central France, in the historic province of Bourbonnais. It is a spa and resort town and in World War II was the seat of government of Vichy France from 1940 to 1944 (see <https://en.wikipedia.org/wiki/Vichy>).

31. Barcelona is a city on the coast of north-eastern Spain. It is the sixth most populous urban area in the European Union after Paris, London, Madrid, the Ruhr area and Milan (see: <https://en.wikipedia.org/wiki/Barcelona>).

32. Generally, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (EGC, Budmen, T-129/01, 3 July 2003, ECLI:EU:T:2003:184). The public will understand the words *La compagnie de* in the trademark invoked as French for “The company ...”, and not as a distinctive element of the trademark. In a certain way also the place-names Vichy and Barcelona can be considered as descriptive (as the geographical origin of the goods and services), but on the other hand not every consumer in the Benelux will know the French town Vichy. Furthermore, the trademark invoked can be understood as “The company with the name Vichy” as well.

33. The trademarks are conceptually similar in a certain degree for a part of the Benelux consumers. For the other part the trademarks have no established meaning and a conceptual comparison is not possible.

Visual comparison

34. Both trademarks are purely verbal trademarks, the earlier mark consisting of four words, the contested application of two. Aside, it should be noted that the fact that the trademark invoked is represented in lower-case letters, whereas the contested application is represented in capital letters, is

irrelevant for the purposes of a visual comparison of two word marks (TUE, Babilu, T-66/11, 31 January 2013, ECLI:EU:T:2013:48).

35. 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, ECLI:EU:T:2004:79). However, in the present case, the first part of the trademark invoked consists of the non-distinctive indication *La compagnie de* ("The company (of) ...), and therefore the consumer's attention will be more fixed on the element Vichy. This element appears identically as the first element in the contested application.

36. As the two trademarks have in common the name Vichy, they are visually similar to a certain degree.

Aural comparison

37. The common element Vichy will be pronounced identically in both trademarks. When referring to a trademark, the average consumer will not pronounce a caption or legend (EGC, Green by Missako, T-162/08, 11 November 2009) and a trademark comprising a number of terms will generally be abbreviated in order to make it easier to pronounce (EGC, BROTHERS by CAMPER, T-43/05, 30 November 2006). For this reason, the Office considers that at least part of the public could pronounce the trademark invoked as Vichy, also taking into account the non-distinctive character of the element "La compagnie de".

38. Aurally the trademarks are similar to a certain degree.

Conclusion

39. The trademarks are visually and aurally similar to a certain degree. Conceptually they are similar to a certain degree for a part of the relevant public.

Comparison of the goods

40. In assessing the similarity of the goods concerned, all the relevant factors relating to these goods 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).

41. In 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.

42. The goods to be compared are the following:

Opposition based on:	Opposition directed against:
Class 32 Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages; Whey beverages; Lemonades; Fruit nectars, non-alcoholic; Soda water; Aperitifs, non-alcoholic.	Class 32 Mineral and carbonated waters and other non-alcoholic beverages; beverages that contain vitamins; tonic water (non medicinal beverages); beverages on fruit basis and fruit juices; beers; flavoured carbonated beverages.

43. The goods *mineral waters and other non-alcoholic beverages, fruit juices and beers* are mentioned *expressis verbis* in the list of goods of the defendant as well as in the list of goods of the trademark invoked and are thus identical.

44. The goods *beverages on fruit basis* of the contested trademark only differ slightly in wordings from the goods *fruit beverages* of the trademark invoked and are identical to them.

45. The goods *beverages that contain vitamins* of the contested application belong to the category *fruit beverages, fruit juices and fruit nectars* of the trademark invoked and are therefore identical to them. Likewise, the goods *carbonated waters, tonic water (non medicinal beverages), and flavoured carbonated beverages* of the contested trademark belong to the broader categories *aerated waters and other non-alcoholic beverages, lemonades and soda water* of the trademark invoked. Indeed, according to established case law, if the goods of the earlier trademark also contain goods that are mentioned in the application for the contested trademark, these goods are considered identical (see EGC, Fifties, T-104/01, 23 October 2002, ECLI:EU:T:2002:262; Arthur et Félicie, T-346/04, 24 November 2005, ECLI:EU:T:2005:420 and Prazol, T-95/07, 21 October 2008, ECLI:EU:T:2008:455).

Conclusion

46. The goods of the contested trademark application are identical to the goods of the trademark invoked.

A.2 Global assessment

47. 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 of the signs are important factors.

48. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect (case Lloyd, already cited). It should also be considered that the average consumer's level of attention is likely to vary in accordance with the category of goods or services in question. The present case concerns basic consumer goods which are targeted at the public in general. For these goods the average level of attention of the public concerned may be deemed normal.

49. The global assessment of the likelihood of confusion assumes that there is a certain degree of interdependence between the factors that have 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 the case at hand the goods concerned are identical.

50. It should also be taken into consideration that the average consumer usually 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 and must place their trust in the imperfect picture of those that they have kept in their mind.

51. 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). According to the defendant, the trademark invoked has a very low distinctive power, as it is descriptive

for goods that originate from the French place Vichy (see points 17 and 20). The Office reminds however that at least a part of the public in Benelux may not be familiar with the geographical indication and will perceive it as a fantasy name.

52. Furthermore, by analogy to the case law of the European Court of Justice in the case F1-LIVE (C-196/11 P, 24 May 2012, ECLI:EU:C:2012:314), it cannot be concluded that an EU trademark that serves as the basis for an opposition in Benelux is considered as being devoid of distinctive character.

53. However, even if the Office assumed that the trademark invoked has a rather weak distinctive character, it is of importance that, according to European case law, a weak distinctive character does not by definition mean that there is no likelihood of confusion. Although the distinctive character of the marks must be taken into account with the assessment of the likelihood of confusion, it is only one of a number of elements concerning that assessment (CJEU, *Ferromix*, C-579/08, 15 January 2010, ECLI:EU:C:2010:18). Even in a case involving an earlier mark of weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity between the signs and between the goods or services covered (EGC, *Flexi Air*, T-112/03, 16 March 2005, ECLI:EU:T:2005:102).

54. The trademarks are visually and aurally similar to a certain degree. Conceptually they are similar to a certain degree for a part of the public. The goods concerned are identical. On the basis of the aforesaid, the Office comes to the conclusion that the relevant public might believe that the goods in question come from the same undertaking or from economically-linked undertakings.

B. Other factors

55. The coexistence of the trademarks neither the coexistence agreement to which the defendant refers (see points 18 and 21) cannot come into this opposition procedure. This procedure is limited to the specific grounds of article 2.14 in conjunction with article 2.2ter BCIP. Aside, the Office observes that the coexistence agreement concerns other trademarks and the territory of Spain.

56. The defendant refers to a cancellation procedure before EUIPO and to the arguments of the opponent in that procedure (see point 19). However, nor the arguments of the parties nor the decision of EUIPO in a cancellation procedure before that office can bind the parties or the Office in a Benelux opposition procedure. Aside, the Office observes that the cancellation procedure referred to was based on the ground of deception of the public and not on that of likelihood of confusion.

57. The defendant states that the VICHY CATALAN trademarks are very well known and highly renowned (see point 22). However, as the contested trademark is younger than the trademark invoked, the renown of the former doesn't play any part in this opposition procedure (see ECJ, *La Española*, C-498/07 P, 3 September 2009, ECLI:EU:C:2009:503). Aside, the Office observes that the trademark VICHY CATALAN is not involved in this procedure.

58. With reference to the request that the other party should bear all costs of the proceedings (see paragraphs 16 and 23), the Office considers that opposition proceedings with the Office provide for an allocation of the costs of the proceedings to the losing party. Article 2.16, 5 BCIP, as well as rule 1.28, 3 IR, only stipulates in this respect that an amount equalling the basic opposition fee shall be borne by the losing party.

C. Conclusion

59. Based on the foregoing the Office concludes that there exists a likelihood of confusion.

60. Since the opposition is already justified based on one of the trademarks invoked, it is not necessary that the Office conducts a comparison with the other trademarks invoked.

IV. CONSEQUENCE

61. The opposition with number 2014982 is justified.

62. Benelux application with number 1387688 will not be registered.

63. The defendant shall pay the opponent 1,045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 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, 20 December 2019

Willy Neys
rapporteur

Eline Schiebroek

Saskia Smits



Administrative officer:

Rudolf Wiersinga