



Benelux Office for
**Intellectual
Property**

**BENELUX OFFICE FOR INTELLECTUAL PROPERTY
OPPOSITION DECISION
N° 2017676
of 28 March 2024**

Opponent: **OPUS ONE WINERY LLC. California corporation**
St. Helena Highway 7900
CA 9456 Oakville
United States of America

Representative: **NLO Shieldmark B.V.**
Anna van Buerenplein 21
2595 DA Den Haag
Netherlands

Invoked trademark 1: European Union trademark registration 16552101

OPUS ONE

Invoked trademark 2: European Union trademark registration 800391

OPUS

Invoked trademark 3: European Union trademark registration 3263076

OPUS ONE

against

Defendant: **OPUS REGIS SARL-S**
Wäistrooss 6
5495 Wintrange
Luxembourg

Representative: **Office Freylinger S.A.**
Route d'Arlon 234
8010 Strassen
Luxembourg

Contested sign: **Benelux trademark application 1452902**

OPUS REGIS

I. FACTS AND PROCEEDINGS**A. Facts**

1. On 29 October 2021, the defendant filed a Benelux trademark application for the verbal trademark OPUS REGIS, for goods and services in classes 5, 32, 33 and 42. This application was processed under number 1452902 and was published on 3 November 2021.

2. On 23 December 2021, the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:

- European Union trademark registration 9418872 of the verbal trademark OPUS ONE, filed on 4 October 2010 and registered on 5 September 2012 for goods in class 32;
- European Union trademark registration 016552101 of the verbal trademark OPUS ONE, filed on 4 April 2017 and registered on 29 September 2017 for services in classes 35, 39, 41 and 43;
- European Union trademark registration 800391 of the verbal trademark OPUS filed on 2 April 1998 and registered on 14 September 1999 for goods in class 33;
- European Union trademark registration 3263076 of the verbal trademark OPUS ONE, filed on 10 July 2003 and registered on 8 February 2005 for goods in class 33.

3. During the proceedings, the opponent indicated that the EUTM registration 9418872 would no longer be invoked, due to a pending cancellation action against this registration.

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

5. The opposition was initially directed against all goods and services covered by the contested application. In his arguments, the opponent limited the scope of the opposition by indicating that, with regard to class 5 and 42, the opposition was directed against part of the goods and services. Class 32 remains part of the proceedings in its entirety. The opposition is based on all goods and services covered by the trademarks invoked. During the proceedings, the defendant limited the list of goods and services, to the effect that class 33 was deleted.

6. The language of the proceedings is English.

B. Proceedings

7. The opposition is admissible and was notified by the Benelux Office for Intellectual Property (hereinafter: "the Office") to the parties on 6 January 2022. Subsequently, the proceedings were suspended several times. During the administrative phase of the proceedings both parties filed arguments and the defendant requested proof of use. Furthermore, the defendant limited the list of goods and services of the contested sign. The course of the proceedings meets the requirements as stated in the Benelux Convention on Intellectual Property (hereinafter: "BCIP") and the Implementing Regulations (hereinafter: "IR"). The administrative phase was completed on 9 May 2023.

II. LEGAL GROUNDS AND ARGUMENTS OF THE PARTIES

8. 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 his own in accordance with Article 2.2ter BCIP. The opponent claims that the contested sign should not be registered based on the following grounds:

- Article 2.2ter(1) BCIP, likelihood of confusion: *"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."*
- Article 2.2ter(3)(a) BCIP, reputation: *"a trademark shall, in case an opposition is filed, not be registered (...) where: a. it is identical with, or similar to, an earlier trademark irrespective of whether the goods or services for which it is applied or registered are identical with, similar to or not similar to those for which the earlier trademark is registered, where the earlier trademark has a reputation in the Benelux territory or, in the case of an EU trademark, has a reputation in the European Union and the use of the later trademark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark"*.

A. Opponent's arguments

9. The opponent first narrows the scope of the opposition as indicated above (paragraph 5).

10. The opponent states that the signs are visually and aurally similar to a high degree, because the first part OPUS is identical.

11. Conceptually, the opponent argues that the word 'opus' means 'a piece of music written by a particular musician' or 'any work of art' in English. Furthermore, the word also has a meaning in Latin, namely 'work'. According to the opponent, the word 'one' refers to the number one or 1 and the word 'regis' is Latin for 'of the king'. For this reason, the contested sign means 'work of the king'. The opponent states that from a conceptual point of view, the word OPUS is the dominant and distinctive element in both signs.

12. With regard to the comparison of the goods and services the opponent argues that the contested goods in class 5 and class 32 relate to drinks and beverages and are similar to the services in class 35 of the trademark invoked. According to the opponent, these goods and services are complementary and the services are generally offered in the same places where the goods are offered for sale. Furthermore, they target the same public. In addition, class 32 is also similar to the goods in class 33 and the services in class 43 of the trademark invoked. The opponent further states that the contested services in class 42 specifically relate to beverages and are therefore similar to the goods in class 33 and complementary to the services in class 35 of the trademark invoked.

13. The opponent states that in the present case, the goods concerned are aimed at the public at large for which the level of attention is normal.

14. As argued before, the contested sign means 'work of the king' and the invoked trademarks have the meaning 'work' or 'work one'. The word REGIS in the contested sign is an indication pointing back to

the word OPUS. Also, the word ONE in the invoked trademark merely gives a value judgement to the word OPUS. In the light of the meaning of the words 'one' and 'regis' and their subordinate position to the word 'opus', the opponent argues that the first part OPUS is the dominant and distinctive element. Moreover, according to the opponent, the trademarks invoked have a high level of distinctiveness and acquired reputation through active and intensive use.

15. The opponent further argues that the trademarks invoked have a reputation in both the European Union and the Benelux for the goods in class 33. The opponent refers to various pieces of evidence, such as invoices, sales figures and publications, in support of the reputation of the trademarks invoked. For this reason, even if there was no confusion between the signs, there still is an unfair advantage. The opponent argues that the sign OPUS REGIS clearly brings to mind the OPUS trademark. Furthermore, the inclusion and recognition of the trademarks invoked in the contested sign draws consumers to the product when they otherwise would not have looked at it. This is especially so taking into account the nature of the goods concerned in this case. For this reason, the opponent states that the defendant gains an unfair advantage through this association.

16. In the light of the above, the opponent requests that the Office decides, primarily on the ground of article 2.2ter (1) (b) BCIP and subsidiary on the ground of article 2.2ter (3) (a) BCIP, that the contested sign must be rejected for the goods and services against which the opposition is directed and orders that the defendant must bear the fees and costs incurred by the opponent.

Request for proof of use

17. The opponent argues that with regard to the first trademark invoked, proof of use is not required. Subsequently, the opponent submitted proof of use for the second and third invoked marks. In addition, the opponent also refers to the documents submitted previously together with the arguments in support of the reputation of the trademarks invoked. According to the opponent, these documents should also be regarded as evidence of use. The evidence of use includes invoices, sales figures, publications, screen prints of websites and images of packaging and labels.

18. The opponent further states that the limitation of goods of the contested sign (see paragraph 5) cannot lead to the goods and services no longer being similar. The opponent also refers to the previously submitted arguments in this regard.

B. Defendant's arguments

19. The defendant argues that the trademarks invoked are not used for goods in class 32. However, the defendant acknowledges that in this case the first trademark invoked is not subject to the use requirement. With regard to the submitted proof of use, the defendant argues that these documents are insufficient to conclude that there is genuine use of the trademark for 'bottles of wine' in class 33 in the European Union, during the relevant period.

20. In case the Office decides that there is genuine use of the trademark invoked for class 33, the defendant argues that the goods in question are different. According to the defendant, the goods of the opponent only concern luxury wines, which are not similar to other types of drinks in class 32. Furthermore, the goods and services of the contested sign are not similar to the services in class 35, 39 and 43 of the trademark invoked.

21. With regard to the comparison of the signs, the defendant states that the signs are visually, aurally and (for part of the public) conceptually similar to a low degree.

22. The defendant further states that with regard to the products concerned, the average consumer has a normal to high level of attention in the light of the luxury character of the wine products of the opponent.

23. Defendant concludes that there is no likelihood of confusion and requests that the Office rejects the opposition, registers the contested sign, and decides that the opponent should bear the costs.

III. DECISION

A. Proof of use

24. In accordance with Article 2.16bis BCIP, the opponent, at the request of the defendant, shall furnish proof that the trademark invoked has been put to genuine use as provided for in Article 2.23bis BCIP or that proper reasons for non-use existed. The evidence must show genuine use in five years prior to the filing or priority date of the trademark against which the opposition is lodged.

25. The filing date of the contested trademark is 29 October 2021. Therefore, the opponent was required to show use of the invoked trademarks during the period from 29 October 2016 to 29 October 2021 ('the relevant period'). Given that the second and third trademark invoked were registered for more than five years prior to the contested trademark's filing date, the defendant's request for proof of use regarding these invoked rights is legitimate.

In general

26. In accordance with the case-law of the European Court of Justice (hereinafter: "CJEU") there is genuine use of a trademark if the mark, in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, is used in order to create or preserve an outlet for those goods or services, not including token use for the sole purpose of preserving the rights conferred by the mark.¹ When assessing whether use of the trade mark is genuine, regard must be had for all the facts and circumstances relevant to establishing whether the commercial use of the mark is real, particularly the practices regarded as warranted in the relevant economic sector as a means of maintaining or creating market shares for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark.² In that regard, the condition relating to genuine use of the trademark requires that the mark, as protected in the relevant territory, be used publicly and outwardly.³

27. The General Court held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine.⁴ In interpreting the concept of genuine use, account should be taken of the fact that the *ratio legis* of the requirement that the mark must have been put to genuine use is not to

¹ CJEU 3 July 2019, C-668/17, ECLI:EU:C:2019:557, point 38 (Viridis) and CJEU 11 March 2003, C-40/01, ECLI:EU:C:2003:145, point 43 (Ansul).

² CJEU 31 January 2019, C-194/17, ECLI:EU:C:2019:-80, point 83 (Pandalis) and CJEU 11 March 2003, C40/01, ECLI:EU:C:2003: 145, point 43 (Ansul).

³ General Court (EU) 4 April 2019, T-910/16 and T-911/16, ECLI:EU:T:2019:221, point 29 and the case-law mentioned there (Testa Rossa).

⁴ General Court (EU) 8 July 2004, T-334/01, ECLI:EU:T:2004:223, point 36 (Hipoviton) and General Court (EU) 30 April 2008, T-131/06, ECLI:EU:T:2008:135, point 41 (Sonia Sonia Rykiel).

assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trademark protection to the case where large-scale commercial use has been made of the marks.⁵

28. The invoked trademarks are EU trademarks. The use obligation is therefore governed by Article 18 of EU TradeMark Regulation⁶, which provides that an EU-trademark must have been put to genuine use in the European Union. The territorial scope of use is not a separate requirement of genuine use, but one of the elements of genuine use that must be included in the overall analysis and examined together with its other elements. An EU-trademark enjoys territorially broader protection than a national (or Benelux) trademark, which also affects the territorial scope of the use obligation. As a result, an EU trademark can reasonably be expected to be used in a wider territory than the territory of a single Member State, barring the (exceptional) case where the market for the goods or services in question is in practice territorially limited. This must be abstracted from the borders of the territories of the Member States. It is not possible to determine a priori and in the abstract what quantitative threshold should be chosen in order to determine whether use is genuine or not.⁷ It should be demonstrated that the trademark is used for the purpose of maintaining or creating market share within the EU, taking into account all relevant facts and circumstances such as characteristics of the market concerned, the nature of the goods or services protected by the trademark and the territorial extent and the scale of the use as well as its frequency and regularity.⁸

29. Genuine use of a trademark cannot be proven by means of probabilities or suppositions but must be demonstrated by solid and objective evidence of effective and sufficient use of the trademark on the market concerned.⁹

30. Following rule 1.25 IR the proof of use should contain evidence of the place, duration, extent and manner of use of the trademarks invoked for the goods or services on which the opposition is based.

Analysis of the proof of use

31. The opponent submitted the following proof of use:

1. Statements by the CEO of Opus One Winery;
2. Opus One Winery brochure;
3. Screenprints website Opus One Winery;
4. Screenprints of wines on offer in webshops of wine merchants, such as Best of Wines, Global Wineries, Wein & Co, dated particularly in 2020;
5. Invoices dated between 2015 - 2019 focused on sales of Opus One wine in France and other countries;
6. Sales figures relating to Spain, Belgium, the Netherlands and Luxembourg;
7. Completed score forms;
8. List of titles of publications from 2007 - 2010;
9. Images of labels, gift bags and packaging;
10. List of customer contact details;

⁵ General Court (EU) 4 April 2019, T-910/16 and T911/16, ECLI:EU:T:2019:221, point 28 and the case-law mentioned there (Testa Rossa).

⁶ Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark.

⁷ CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, points 36, 44, 50 and 55 (ONEL); Benelux Court of Justice (second chamber) 28 June 2023, C-2022/6, point 20 (Gillette/Fontaine).

⁸ CJEU 19 December 2012, C-149/11, ECLI:EU:C:2012:816, point 58 (ONEL).

⁹ General Court (EU) 8 July 2020, T-686/19, ECLI:EU:T:2020:320, point 35 (GNC LIVE WELL).

11. Publications in NY Times (1989), Examiner.com (2013), The Wine Cellar Insider (no date), Frommers.com (2015), Los Angeles Times (1991), Vinous Media (2015), L'Hebdo (2003), Vertdevin.com (2014), Le Vin (2014) and Wein.com (2020).

32. Several documents do not contain a date or concern documents dated before the start of the relevant period. However, this does not necessarily mean that the documents should be disregarded as they may support the other evidence submitted. Accordingly, the Office will always assess the totality of the documents submitted on a case-by-case basis to determine whether there is genuine use.

33. The Office finds that the screen prints of web shops, invoices and publications (Nos. 4, 5 and 11), some of which fall within the relevant period, sufficiently and clearly demonstrate that the trademarks invoked were used to market wine, during the relevant period and in the European Union (in particular in France, but evidence is also submitted of activities in other EU countries). Genuine use for the other goods in class 33 has not been claimed or demonstrated.

34. In the light of the above, the Office considers that genuine use is demonstrated for 'Wines' in class 33 for the second and third trademark invoked. Accordingly, the likelihood of confusion will be examined below in relation to these goods.

B. Likelihood of confusion

35. 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.

36. Article 2.2ter (1) BCIP stipulates insofar as relevant 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."*¹⁰

37. A likelihood of confusion within the meaning of this provision exists if the public may believe that the goods or services designated by that trademark and those covered by the trademark applied for come from the same undertaking or, where appropriate, from undertakings which are economically linked.¹¹

38. According to settled case-law of the CJEU, the existence of a likelihood of confusion in the mind of the public must be assessed globally, considering all the relevant circumstances of the individual case, including the degree of similarity between the signs at issue and the goods or services concerned, the degree of recognition of the earlier trademark and the degree of distinctiveness – inherent or acquired through use – of the earlier trademark.¹²

¹⁰ Art. 2.2ter (1)(b) BCIP implements art. 5 (1)(b) 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. A similar provision can be found in art. 8 (1)(b) Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark.

¹¹ CJEU 11 June 2020, C-115/19 P, ECLI:EU:C:2020:469, point 54 (China Construction Bank).

¹² CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 57 (Equivalenza) and the case-law mentioned there.

Comparison of the signs

39. To assess the degree of similarity between the conflicting signs, their visual, phonetic, and conceptual similarity should be determined. The comparison must be based on the overall impression given by those signs. In the assessment, the perception of the signs by the average consumer plays a decisive role. The average consumer normally perceives a mark as a whole and does not engage in an analysis of its various details.¹³

40. Although the comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue.¹⁴ The overall impression created in the mind of the relevant public by a complex trademark may, in certain circumstances, be dominated by one or more of its components. Regarding the assessment whether this is the case, 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 and accessorially, account may be taken of the relative position of the various components within the arrangement of the complex mark.¹⁵

41. The assessment of the similarity between the signs, regarding the visual, aural and conceptual similarity of the signs, must be based on the overall impression created by them, taking into account, inter alia, their distinctive and dominant components.

42. The signs to be compared are the following:

Opposition based on:	Opposition directed against:
OPUS ONE	OPUS REGIS
OPUS	

Visual comparison

43. The trademarks invoked and the contested sign are purely verbal signs. The first and third trademark invoked consists of two words of four and three letters, OPUS ONE. The second trademark invoked consists of one word of four letters, OPUS. The contested sign consists of two words of four and five letters, OPUS REGIS.

44. The trademarks and sign all start with the word OPUS. Furthermore, the length of the first and third trademark invoked and the contested sign is nearly the same. The signs have a different ending. However, according to established caselaw, the consumer normally attaches more importance to the first part of a sign.¹⁶

45. For this reason, the Office finds that the signs are visually similar.

¹³ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 58 and the case-law mentioned there (Equivalenza).

¹⁴ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 71 and the case-law mentioned there (Equivalenza).

¹⁵ General Court (EU) 23 October 2002, T-6/01, ECLI:EU:T:2002:261, points 34 en 35 (Matratzen) en 13 December 2007, T-242/06, ECLI:EU:T:2007:391, point 47 (El Charcutero Artesano).

¹⁶ General Court EU 17 March 2004, T-183/02 en T-184/02, ECLI:EU:T:2004:79, point 81 (Mundicor).

Phonetic comparison

46. The first and the third trademark invoked consist of two words and three syllables: "O-PUS-ONE". The second trademark invoked consists of one word and two syllables: O-PUS. The contested sign consists of two words and four syllables: "O-PUS-RE-GIS". The first two syllables will be pronounced identically. The signs have a different ending, however as indicated above, the identical beginning of the signs will be of more importance to the public.

47. In the light of the above, the Office finds that the signs are aurally similar.

Conceptual comparison

48. The term 'opus' originates from Latin and is used in both the French and Dutch languages to indicate, inter alia, the work of a composer. The word 'regis' is also a Latin word which means 'of the king'. However, the Office considers that the words 'opus' and 'regis' are not commonly used in the Benelux countries. For this reason, without sufficient substantiation, this meaning cannot be assumed to be known by a substantial part of the public.¹⁷

49. The designation 'one' will be understood by the Benelux public as the English word for 'one'. This meaning will be known to the public, as it is a very common English designation.

50. However the signs involved, considered as a whole, have no clear and obvious meaning. Therefore, the Office finds a conceptual comparison is not possible.

Conclusion

51. The signs are visually and aurally similar. A conceptual comparison is not possible.

Comparison of the goods and services

52. In assessing the similarity of the goods and services concerned, account must be taken of all the relevant factors which characterise the relationship between them. 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.¹⁸

53. Complementarity only exists where the products and/or services are so closely related to each other that one is indispensable or important for the use of the other so that consumers may believe that the same undertaking is responsible for those products.¹⁹

54. In comparing the goods and services, the goods and services shall be considered in the terms set out in the register and not the actual or intended use.²⁰

¹⁷ Benelux Court of Justice (second chamber) 6 February 2024, C 2022/19, point 43 (Ariane Consulting).

¹⁸ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 23 (Canon).

¹⁹ General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (O STORE).

²⁰ General Court (EU) 16 June 2010, T-487/08, ECLI:EU:T:2010:237, point 71 (Kremezin).

55. Taking into account the limitations both parties have made (see paragraph 5), as well as (for the second and third trademark invoked) the goods for which genuine use has been established, the goods and services to be compared are the following:

Opposition based on:	Opposition directed against:
	CI 5 Powdered nutritional supplement energy drink mix; Vitamin drinks; Dietary supplement drinks; Dietary supplemental drinks; nutritional supplement meal replacement drinks for boosting energy; vitamin drink.
	CI 32 Beer and brewery products; Non-alcoholic beverages; Preparations for making beverages; Energy drinks; Soft drinks for energy supply; Energy drinks [not for medical purposes]; Sports drinks; Protein-enriched sports beverages; Sports drinks containing electrolytes; Isotonic beverages; Fruit beverages; Fruit-based beverages; Waters [beverages]; Mineral waters [beverages]; Beverages containing vitamins; Flavoured carbonated beverages; Nutritionally fortified beverages; Syrups for making beverages; Extracts for making beverages; Essences for making non-alcoholic beverages; Powders for the preparation of beverages; Concentrates used in the preparation of soft drinks.
CI 33 Wines.	
CI 35 Advertising; Business management; Business administration; Office functions; commercial business management; direct mail advertising; distribution and dissemination of advertising materials [leaflets, prospectuses, printed material, samples]; management of computer files; organization of exhibitions for commercial or advertising purposes; on-line advertising on a computer network; rental of advertising time on communication media; publication of publicity texts; rental of advertising space; dissemination of advertisements; public relations; arranging of demonstrations for trade purposes; arranging of displays for trade purposes; arranging of presentations for trade purposes; arranging of trade fairs; conducting of trade shows; organisation of exhibitions and trade fairs for business and promotional purposes; advertising and marketing; advertising services for the	

promotion of beverages; business promotion services; distribution of advertising, marketing and promotional material; exhibitions (arranging -) for trade purposes; promotion [advertising] of concerts; promotion of fairs for trade purposes; sponsoring wine and food tastings; sponsoring charitable auctions; retail and online retail services connected with the sale of household or kitchen utensils and containers, combs and sponges, brushes (except paintbrushes), brush-making materials, articles for cleaning purposes, steel wool, unworked or semi-worked glass (except glass used in building), glassware, porcelain and earthenware not included in other classes, wine tasters [siphons], tubes [pipettes] for wine tasting, wine jugs, dinner services; retail and online retail services connected with the sale of tableware, cookware and containers, china mugs, porcelain mugs, glass mugs, earthenware mugs, ceramic mugs, coffee mugs, beer mugs, corkscrews (electric and non-electric), glass carafes, bottle openers [hand-operated], bottle openers (electric and non-electric), porcelain coasters, plastic coasters, bottle coolers, coolers [ice pails], portable beverage coolers, crumb collecting instruments [non-electric]; retail and online retail services connected with the sale of dinnerware of porcelain, thermal insulated bags for food or beverages, wine bottle cradles, bottle cradles, foil cutters for wine bottles, wine glasses, coffee cups, mug, corkscrews, beverage glassware, carafes, cork screws, bottle openers, beverage stirrers, bread boards, charms for attachment to beverage glassware for identification purposes, cheese graters; retail and online retail services connected with the sale of coasters, not of paper and other than table linen, coolers for wine, cooling buckets for wine, crumb brushes, crumb trays, crumb-sweepers, dinnerware, thermal insulated containers for food or beverage, thermal insulated tote bags for food or beverages, wine bottle cradles, tobacco, cigars; retail and online retail services connected with the sale of beer, non-alcoholic beverages, alcoholic beverages, wine, spirits, liqueurs; business information services; display services for merchandise; administration of a

discount program for enabling participants to obtain discounts on goods and services through use of a discount membership card; business information services on wine-retailing; business merchandising display services; business management services; information, advisory and consultancy services relating to the aforesaid; none of the services are in connection with religious activities or religious education.	
	CI 42 Beverage research; Technical consultancy in relation to the technical research in the field of food and beverages; Quality control of manufactured goods; Testing of foodstuffs and beverages.
CI 43 Services for providing food and drink; restaurant, bar, banquet and catering services; wine bar services; wine bars; wine tasting services (provision of beverages); accommodation services; provision of temporary accommodation; hospitality services [accommodation]; hotel services; hotels, hostels and boarding houses, holiday and tourist accommodation; none of the services are in connection with religious activities or religious education.	

56. In general, goods and services are different in nature. While goods are tangible merchandise (that can be passed from one person to another), services are activities carried out by professionals. The use to which products and services is put also differs. However, both goods and services can be entirely complementary: indeed, certain services cannot be performed without the use of certain goods.

57. In this context, it should be remembered that complementarity only exists when the goods and/or services are closely connected in the sense that one is indispensable or important for the use of the other, so that consumers may believe that the same undertaking is responsible for both.²¹

Class 5

58. There is a certain similarity between the contested goods '*Powdered nutritional supplement energy drink mix; Vitamin drinks; Dietary supplement drinks; Dietary supplemental drinks; nutritional supplement meal replacement drinks for boosting energy; vitamin drink*' and the goods that are subject of the services '*retail and online retail services connected with the sale of non-alcoholic beverages*' mentioned in class 35 of the trademark invoked. The term '*non-alcoholic beverages*' mentioned in class 35 concerns a general category of beverages which could also include energy drinks, vitamin drinks and juices. These goods have the same nature, method of use, distribution channels, relevant public and, sometimes, producers as the contested goods in class 5. Although the goods in class 5 are substances prepared for special dietary

²¹ General Court (EU) 24 September 2008, T-116/06, ECLI:EU:T:2008:399, point 52 (The O STORE).

requirements, the end purpose is the same, namely quenching thirst. In addition, these goods could also be competitive. Therefore, the Office finds that these goods and services are similar to a certain degree.

Class 32

59. The contested goods '*Beer and brewery products; Non-alcoholic beverages; Preparations for making beverages; Energy drinks; Soft drinks for energy supply; Energy drinks [not for medical purposes]; Sports drinks; Protein-enriched sports beverages; Sports drinks containing electrolytes; Isotonic beverages; Fruit beverages; Fruit-based beverages; Waters [beverages]; Mineral waters [beverages]; Beverages containing vitamins; Flavoured carbonated beverages; Nutritionally fortified beverages*' are either identical or fall under the general category of beverages and drinks that are subject to the services '*retail and online retail services connected with the sale of beer, non-alcoholic beverages, alcoholic beverages*' mentioned in class 35 and the services '*Services for providing food and drink*' mentioned in class 43 of the trademark invoked. Therefore, the Office finds that there exists complementarity between these goods and services and that the goods and services are similar to a certain extent.

60. With regard to the contested goods '*Syrups for making beverages; Extracts for making beverages; Essences for making non-alcoholic beverages; Powders for the preparation of beverages; Concentrates used in the preparation of soft drinks*' the Office finds that there is a close connection between these goods and the beverages and drinks that are subject to the services in class 35 and 43 of the trademark invoked.²² These preparations are intended for use in the preparation of beverages. For this reason, the Office finds that these goods and services are similar to a low degree.

Class 42

61. The contested services '*Beverage research; Technical consultancy in relation to the technical research in the field of food and beverages; Testing of foodstuffs and beverages*' are similar to a low degree to the '*retail and online retail services connected with the sale of beer, non-alcoholic beverages, alcoholic beverages*' in class 35 and the '*Services for providing food and drinks*' in class 43. Although research, consultancy and testing services usually have no connection with the services of the trademark invoked, the contested application however expressly specifies that the services in class 42 relate to beverages. The services therefore all relate to the same specific area. In addition, the relevant public of the services may overlap. For this reason, the Office finds that these services are similar to a low degree.

62. However the services '*Quality control of manufactured goods*' are not similar to any of the goods and services of the trademarks invoked. Although these services *could* be used in order to market the goods of the opponent, there is no complementarity between those services and the opponent's goods in the sense that these goods are indispensable for the provision of the services of the contested sign and that the public might believe that they would originate from the same undertakings. Furthermore, the goods and services do not share the same purpose, distribution channels and manufactures or providers.

Conclusion

63. The goods and services are partly similar to a certain degree, partly similar to a low degree and partly not similar.

²² General Court (EU) 27 June 2019, T-268/18, ECLI:EU:T:2019:452, point 59 (Luciano Sandrone); General Court (EU) 28 April 2021, T-31/20, ECLI:EU:T:2021:217, point 75 (The King of SOHO); General Court (EU) 30 March 2022, T-206/21, ECLI:EU:T:2022:191, point 26 (Représentation de deux animaux).

Global assessment

64. The global assessment must be made by reference to the average consumer, who is reasonably well-informed and reasonably observant and circumspect about the goods or services in question. However, account must be taken of the fact that the average consumer only rarely has the opportunity to make a direct comparison between the different trademarks but relies on the imperfect impression left upon him. It must also be borne in mind that the average consumer's level of attention may vary depending on the type of goods or services at issue.²³ In the present case, the goods and services mainly concern everyday consumer products and services. They are aimed at the general public with an average level of attention. With regard to the contested services in class 42, the Office finds that these services target a professional public for which the level of attention will be higher than average.

65. The higher the degree of distinctiveness of the earlier trademark, the greater the likelihood of confusion. Trademarks with a highly distinctive character, either by their nature or because of their reputation on the market, enjoy greater protection than trademarks with a weak distinctive character.²⁴ In this case, the trademark invoked has a normal distinctiveness, as it is not descriptive for the goods and services concerned. The opponent refers to an enhanced distinctiveness through use (see paragraph 14), however the Office finds that it is not necessary to discuss this argument at this point as it has no influence on the outcome of assessment of the likelihood of confusion.

66. The global assessment of the likelihood of confusion presupposes a certain coherence between the factors to be considered and, in particular, between the similarity of the conflicting signs and the goods or services to which they relate. Thus, a low degree of similarity between the goods or services in question may be offset by a high degree of similarity between the signs, and vice versa.²⁵

67. In this case, the signs are visually and aurally similar and a conceptual comparison is not possible. Furthermore, the goods and services are partly similar to a certain degree and partly similar to a low degree. On the basis of these and the other factors mentioned above, and considering their interdependence, the Office considers that, notwithstanding the elevated level of attention of the public for part of the services, there is a likelihood of confusion regarding the goods and services found to be similar to a certain or low degree, in the sense that the public may believe that the goods and services designated by the trademark relied on and the goods and services to which the contested sign relates originate from the same undertaking or, as the case may be, from undertakings which are economically linked.

Conclusion

68. Based on the foregoing, the Office concludes that there is a likelihood of confusion with regard to the contested goods in class 5 and 32, as well as the contested services '*Beverage research; Technical consultancy in relation to the technical research in the field of food and beverages; Testing of foodstuffs and beverages*' in class 42.

C. Reputation

69. The opponent has based the opposition also on Article 2.2ter, 3 (a) BCIP.

²³ CJEU 22 June 1999, C-342/97, ECLI:EU:C:1999:323, point 26 (Lloyd Schuhfabrik Meyer).

²⁴ CJEU 29 September 1998, C-39/97, ECLI:EU:C:1998:442, point 18 (Canon).

²⁵ CJEU 4 March 2020, C-328/18 P, ECLI:EU:C:2020:156, point 59 and the case-law mentioned there. (Equivalenza)

70. The Office will proceed with the assessment of this claim, only with regard to part of the contested services for which no identity or similarity has been established, being '*Quality control of manufactured goods*' from class 42.

71. Article 2.2ter, 3 (a) BCIP is only applicable when the following conditions are met:

- (i) The conflicting signs are either identical or similar;
- (ii) The earlier trademark has a reputation;
- (iii) The use of the contested sign would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark;
- (iv) There is no due cause for the use of the contested sign.

72. According to the Court, the types of injury mentioned in this article, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them.²⁶

73. The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition based on Article 2.2ter, (3) (a) BCIP.

i) similarity between the signs

74. The Office has already established that the signs are visually and aurally similar (see paragraph 43 - 47).

ii) reputation of the trademark invoked

75. It must be observed that the expression "has a reputation in the Member State", in Article 5(3) of the Directive, has the same meaning as the identical expression in Article 10(2)(c) of the Directive, which is identical to Articles 8 (5) and 9(2)(c) of the European Union Trade Mark Regulation. In that connection, according to case law of the Court concerning the interpretation of the Directive and the Regulation, the trademark invoked must be known by a significant part of the public concerned by the goods or services covered by that trademark, in a substantial part of the relevant territory.²⁷ Such a part may, with regard to both an EU trademark or a Benelux trademark, in some circumstances, correspond to the territory of a single Member State.²⁸

76. This assessment concerns the average consumer who is deemed to be reasonably well informed and reasonably observant and circumspect.²⁹ The public amongst which the earlier trademark must have acquired a reputation is that concerned with that trademark, that is to say, depending on the product or service marketed, either the public at large or a more specialist public, for example traders in a specific sector.³⁰

²⁶ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 66 (Intel).

²⁷ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 31 (General Motors) and 6 October 2009, C-301/07, ECLI:EU:C:2009:611, point 24 (Pago International).

²⁸ CJEU 6 October 2009, C-301/07, ECLI:EU:C:2009:611, point 30 (Pago International and CJEU 3 September 2015, C-125/14, ECLI:EU:C:2015:539, point 29 (Iron & Smith/Unilever)

²⁹ CJEU 27 November 2008, C-252/07, ECLI:EU:C:2008:655, point 36 (Intel).

³⁰ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 24 (General Motors).

77. In examining the degree of knowledge amongst the relevant public all the relevant facts of the case, in particular the market share held by the trademark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it, must be taken into consideration.³¹

78. The relevant point in time to establish that the earlier trademark has acquired a reputation is the filing date or, where appropriate, the priority date of the contested trademark.³² The relevant point in time in this case is 29 October 2021, namely the date of the filing of the contested trademark.

Analysis of the evidence

79. The opponent submitted the following documents in order to demonstrate reputation of the trademarks invoked:

1. Statements by the CEO of Opus One Winery;
2. Opus One Winery brochure;
3. Screenprints website Opus One Winery and images of labels, gift bags and packaging.
4. Invoices dated between 2007 and 2019 focused on sales of Opus One wine in France and other countries;
5. Sales figures relating to different countries in the European Union;
6. Completed score forms;
7. Screenprint stating 'top 100 most search for wines' from the website Wine Searcher;
8. List of titles of publications from 2007 - 2010;
9. Publications in NY Times (1989), Examiner.com (2013), The Wine Cellar Insider (no date), Frommers.com (2015), Los Angeles Times (1991), Vinous Media (2015), L'Hebdo (2003), Vertdevin.com (2014), Le Vin (2014) and Wein.com (2020);
10. Screenprints webshops Le Figaro.fr (2017), Global Wineries (2018), Shiraz & Co, Best of Wines (2020), Vinexus (2020), Wein & Co (2020);

80. The Office considers that it does not follow from these documents that the trademarks invoked are known to a significant part of the public in the European Union. The goods concerned are wines, which are goods that are intended for the general public. While the screen prints of webshops and the invoices show that Opus One wine is sold in several European Union countries, it also shows that the bottles of wine are very expensive and that the sales numbers are not particularly high for the Benelux, for example.

81. Most of the media publications are from (well) before October 2021 (the point at which the reputation with the relevant public must be demonstrated) and, moreover, these publications are for the most part aimed at the public in the United States. Furthermore, the documents do not contain data on the market shares of the trademarks invoked and the investments made to make the trademarks known in the European Union.

Conclusion

82. The opponent did not show that the trademarks invoked have a reputation. Consequently, one of the (necessary) conditions laid down in Article 2.2ter (3)(a) BCIP has not been fulfilled and the opposition must be rejected on this ground.

³¹ CJEU 14 September 1999, C-375/97, ECLI:EU:C:1999:408, point 27 (General Motors).

³² See Article 2.2ter (2) and, by analogy, Article 2.30sexies BCIP).

D. Conclusion

83. Based on the foregoing the Office concludes that there exists a likelihood of confusion for the goods in class 5 and 32 and part of the services in class 42.

84. It has not been established that the trademarks invoked have a reputation within the meaning of Article 2.2ter(3)(a) BCIP.

IV. CONSEQUENCE

85. The opposition with number 2017676 is partially justified.

86. The Benelux application with number 1452902 will not be registered for the following goods and services:

- Class 5 Powdered nutritional supplement energy drink mix; Vitamin drinks; Dietary supplement drinks; Dietary supplemental drinks; nutritional supplement meal replacement drinks for boosting energy; vitamin drink.
- Class 32 (*all goods*)
- Class 42 Beverage research; Technical consultancy in relation to the technical research in the field of food and beverages; Testing of foodstuffs and beverages.

87. The Benelux application with number 1452902 will be registered for the following goods and services that are not similar or against which the opposition was not directed:

- Class 5 Dietary supplements and dietetic preparations; Cachets for pharmaceutical purposes; Dental preparations and articles, and medicated dentifrices; Sanitary preparations and articles; Pest control preparations and articles; Nutritional supplement energy bars; food supplements; Food supplements for sportsmen; Fitness and endurance supplements; Dietary supplements promoting fitness and endurance; Preparations for supplementing the body with essential vitamins and microelements; vitamin supplements; vitamin preparations, mineral preparations and substances for medical use.
- Class 42 Scientific and technological services and research and design relating thereto; Scientific and technological services and research and design relating thereto in the field of food and beverages; Research of foodstuffs; Food research; Quality control of partly manufactured goods; Quality control of manufactured goods; Technical consultancy in relation to research services relating to foods and dietary supplements; Technical advice relating to food and beverage production; product development; Providing information in the field of product development; Research in the field of artificial intelligence; Artificial intelligence consultancy; Artificial intelligence product development.

88. Neither of the parties shall pay the costs in accordance with article 2.16(5) BCIP, as the opposition is partly justified.

The Hague, 18 March 2024



Eline Schiebroek
(*rapporteur*)

Pieter Veeze

Camille Janssen

Administrative officer: Guy Abrams