

BENELUX OFFICE FOR INTELLECTUAL PROPERTY

OPPOSITION DECISION

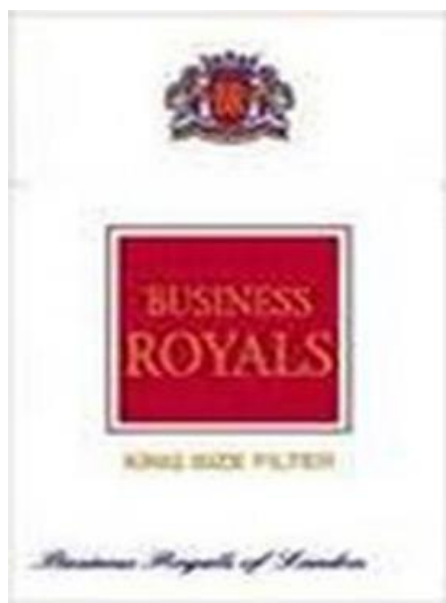
N° 2012799

of 6 May 2019

Opponent: **The Independent Tobacco FZE**
Plot No. S 10841; P.O. Box 261031
Jebel Ali, Dubai
United Arab Emirates

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

Invoked right 1: **According to the opponent a well-known trademark within the meaning of Article 6bis of the Paris Convention**



Invoked right 2: **According to the opponent a well-known trademark within the meaning of Article 6bis of the Paris Convention**



Invoked right 3: According to the opponent a well-known trademark within the meaning of Article 6bis of the Paris Convention

BUSINESS ROYALS

against

Defendant: International Tobacco Plc
Marshalsea Road 11, 120 Langdale House
SE1 2TU London
Great-Britain

Representative: HGF B.V.
Gedempt Hamerkanaal 147
1021 KP Amsterdam
The Netherlands

Contested trademark: Benelux application 1343007



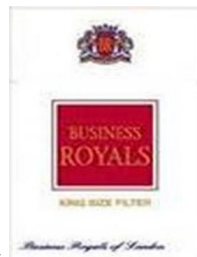
I. FACTS AND PROCEEDINGS**A. Facts**

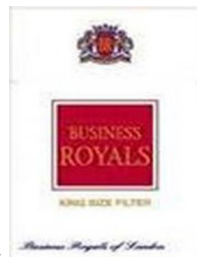
1. On 16 November 2016 the defendant filed a Benelux trademark application for the complex trademark




for goods in class 34. This application was processed under number 1343007 and was published on 13 December 2016.

2. On 1 February 2017 the opponent filed an opposition against the registration of the application. The opposition is based on the following earlier trademarks:



- The complex mark , according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention;



- The complex mark , according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention;
- The word mark BUSINESS ROYALS, according to the opponent, a well-known trademark within the meaning of Article 6bis of the Paris Convention.

3. The opposition is directed against all goods of the contested application.

4. The grounds for opposition are those laid down in article 2.14, 2 (a) the Benelux Convention on Intellectual Property (hereinafter: "BCIP").

5. The language of the proceedings is English.

B. Chronological order of the proceedings

6. The opposition is admissible and was notified to the parties on 13 February 2017. 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 "IR"). The administrative phase was completed on 12 October 2017.

II. ARGUMENTS

7. The opponent filed an opposition at the Benelux Office for Intellectual Property (hereinafter: "the Office") under article 2.14, 2 (a) BCIP and invokes article 2.2ter, 2 (d) 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. Arguments of the opponent

8. The opponent explains that he is a renowned name in the tobacco industry. He operates a worldwide and reputable business of tobacco products and is the exclusive owner of registrations for the word and device marks BUSINESS ROYALS. The opponent produces, amongst others, a list of several copies of trademark registration certificates for the sign BUSINESS ROYALS to demonstrate the use of this trademark invoked and its well-known status. He states that the trademark has been used in the following countries: Djibouti, Somaliland, Yemen, Iraq, Togo, Cambodia and Benin. By virtue of registrations, long-standing use, publicity and promotion, the trademark invoked BUSINESS ROYALS has earned substantial goodwill and reputation and members of the trade and public will thus associate the said mark with the opponent. According to the opponent, current sales of BUSINESS ROYALS cigarettes are in the range of 100 containers per month.

9. The opponent elaborates that he is acting against infringement at all times and has already seized many containers of counterfeit cigarettes and is pursuing legal action against infringers. He confirms that he has a distributorship agreement regarding the EU and that his goods regularly transit Europe on their way to Africa, which is the main market for his goods. Accordingly, he is of the opinion that registration of the contested sign could adversely affect the opponent's trademark rights in the Benelux and in Europe. Currently the main markets in which the opponent's goods are sold under the BUSINESS ROYALS trademark are Africa, Asia and the Middle East. The opponent produces several exhibits to demonstrate the use as well as the well-known status of the rights invoked.

10. Furthermore, the opponent argues that the filing of a nearly identical sign in the Benelux register is a clear attempt to harm the opponent as it is likely to impair or dilute in an unfair manner the distinctive character of the well-known mark. The opponent is thus of the opinion that the defendant has operated in bad faith.

11. As for the comparison of the signs, the opponent considers that the rights invoked and the contested sign are either identical or highly similar from a visual point of view as they all share the verbal element BUSINESS ROYALS. Aurally the signs are identical, according to the opponent, as they all consist of the words BUSINESS ROYALS. Conceptually the signs are identical as they refer to BUSINESS ROYALS.

12. The opponent observes that the goods of the rights invoked are identical or at least highly similar to the goods of the contested sign.

13. The figurative element in the contested sign is not distinctive and the verbal dominant elements of the signs are identical. Because of the identical and/or highly similar goods, the opponent finds that there is a clear likelihood of confusion. Besides the average consumer in relation to the goods and services will have an average to low level of attention since it concerns goods that are regularly bought.

14. For these reasons, the opponent requests that the Office upholds the opposition, that the contested sign will not be registered and that the defendant be ordered to bear all costs of the opposition.

B. Arguments of the defendant

15. The defendant states that the rights invoked do not meet the threshold for assuming that they are well-known within the meaning of article 6bis Paris Convention. The opponent did not demonstrate or at least insufficiently that a significant part of the relevant public has any awareness of the rights invoked.

16. As to the relevant public at issue, the defendant observes that the goods covered by the rights invoked are smokers' articles, particularly cigarettes, which are mass consumption products. Consequently the relevant public is the public at large. The opponent failed to give any insight and evidence on the relevant market and the relevant public for which the rights invoked would be destined here, according to the defendant.

17. The opponent did also not submit any evidence that the rights invoked are or have been used in the Benelux. All the exhibits submitted by the opponent are not precise, not conclusive and/or not presented (or translated) in the language of the opposition proceedings. As a result the defendant cannot assess and ascertain the nature, extent and geographical scope of the reputation of the rights invoked. Thus the opponent failed to sufficiently substantiate his opposition.

18. For these reasons, the defendant concludes that there is no basis for an opposition by virtue of a well-known trademark under article 6bis Paris Convention as the opponent failed to substantiate the opposition. Therefore the defendant requests that the opposition be rejected, that the contested sign be registered and that the opponent be ordered to bear all costs of the opposition.

III. DECISION

A.1 Well-known trademark within the meaning of Article 6bis of the Paris Convention

19. In accordance with Article 2.14 BCIP the proprietor of an older trademark may file within a period of two months, to be calculated from the publication of the trademark applied for, an opposition in writing with the Office against a trademark, the order of priority of which ranks after that of the applicant or proprietor, in accordance with the provisions of Article 2.2ter BCIP.

20. The opponent invokes three earlier rights which, according to him, are all well-known trademarks within the meaning of Article 6bis of the Paris Convention.

21. Under Rule 1.14 IR the opponent is granted a period of two months in which to submit, concurrently with the arguments, documents evidencing that the earlier trademarks are well-known.

22. The opponent submitted the following exhibits in order to demonstrate the well-known character of the rights invoked:

1. Declaration by a legal representative of BR International Holdings, holding its offices in Dubai, authorizing the opponent to use and register the trademark BUSINESS ROYALS in any country of the world, as well as to enforce the rights in the trademark. This declaration does not carry a date;
2. Overview of registrations worldwide for the BUSINESS ROYALS trademarks dated 7 September 2014;
3. Several copies of certificates of registration for numerous countries, however none of them having effect in the Benelux;
4. Several printouts of the opponent's website referring to the rights invoked, however none of these printouts carries an indication of a date or a location;
5. Several pictures of merchandising products mentioning the rights invoked, however none of these pictures are dated or carry any indication of a location;
6. Several pictures of marketing support and promotion samples, however none of these exhibits are dated nor do they carry any indication of a location;
7. Three brochure samples. One of them is dated January 2011, the others are not dated;
8. Samples of eleven legal actions against infringers in different countries, however none of them relate to the Benelux;
9. Overview of trademark applications filed by the defendant.

23. After an analysis of the exhibits at hand the Office finds that no, or at least not enough proof, has been provided in order to establish that the trademarks invoked are well-known trademarks within the meaning of Article 6bis of the Paris Convention in the Benelux.

24. First of all, none of the exhibits produced relate to the Benelux territory. No insight is given into the degree of familiarity or recognition of the trademarks in the relevant sector of the public, the duration, the intensity and geographical extent of the use or the promotion of the trademarks invoked or the value attached to the trademarks in relation to the Benelux.

25. Furthermore, it must be determined whether the trademarks invoked were well-known at the time the contested sign was filed (16 November 2016). However none of the exhibits are dated, or they refer to a date long before the relevant period.

26. The declaration filed as exhibit number 1 cannot be considered as independent evidence. On its own, it is insufficient to prove the well-known character of the trademarks invoked. Its probative value depends therefore on the evidence filed in support. However, other additional evidence in support of this declaration is lacking. There is no evidence to demonstrate the actual sales of products under the trademarks invoked or the degree of recognition of the marks at the relevant date in the Benelux.

27. Exhibits 4 to 7 concern printouts, pictures and brochure samples regarding products carrying the rights invoked. However there is no clear indication that these exhibits were actually used within the territory of the Benelux. Therefore the Office deems that they cannot be considered as valid proof of the well-known character of the rights invoked in the Benelux.

28. Other relevant references, like applications for registration of the trademark reflecting the use or recognition of the trademark, or a list showing the successful enforcement of trademark rights and the degree to which the trademark was recognised as a well-known trademark by the competent authorities are lacking. Exhibits 2, 3 and 8 are not relevant here as they do not relate to the Benelux. Besides some of these exhibits are drawn up in another language than the language of the proceedings or one of the languages used by the Office. They are also not accompanied by a translation. Documents serving to substantiate arguments do not necessarily need to be drawn up in the language of the proceedings or one of the languages used by the Office. These documents may be submitted in their original language, however they will only be considered if the Office judges that they can be sufficiently understood, in the light of the reason for their submission. The copies of certificates of trademark registrations (exhibit 3), can be identified as such, however a court decision from the court of Dubai in Arab (part of exhibit 8) cannot be sufficiently understood without translation and will therefore not be taken into account.

29. As there is no breakdown of turnover, marketing expenses or cogent evidence demonstrating that the signs are well known in the Benelux, the Office finds that the evidence submitted by the opponent is insufficient to demonstrate that the trademarks invoked are well-known for the goods in question, tobacco products, which are by their nature directed at all adult consumers in the Benelux.

30. Finally, the opponent himself also acknowledges that the main markets in which his goods are sold under the BUSINESS ROYALS trademark are Africa, Asia and the Middle East (see paragraph 9), and thus not the Benelux region.

Conclusion

31. It follows from the foregoing that the evidence the opponent filed with the Office, even when assessed overall, does not demonstrate the well-known character of the rights invoked in the Benelux at the time the contested sign was filed. Because the opponent fails to demonstrate the well-known character of the rights invoked, the Office will not proceed to an analysis of the likelihood of confusion.

B. Other factors

32. The opponent states that the defendant has filed the contested sign in bad faith (see paragraph 10). Such an argument cannot play a role in these proceedings. Opposition proceedings with the Office are intended to resolve conflicts between trademark owners in a fast and uncomplicated manner. These proceedings are therefore limited to specific grounds, stipulated in articles 2.14 jo 2.2ter BCIP. The application of these articles is solely judged based on the information as it appears in the trademark register. Other possible grounds of defence of or objection against a trademark application cannot play a role in opposition proceedings. To that end the parties should file legal proceedings before a court.

33. With reference to the request that the other party should bear all costs of the proceedings (see paragraphs 14 and 18), 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

34. Now that the evidence submitted does not succeed in establishing that the rights invoked were well known for the relevant goods in the Benelux, there is no need for the Office to examine the existence of a likelihood of confusion.

IV. DECISION

35. The opposition with number 2012799 is rejected.

36. Benelux application with number 1343007 will be registered.

37. The opponent shall pay the defendant 1.045 euros in accordance with article 2.16, 5 BCIP in conjunction with rule 1.28, 3 IR, as the opposition is not justified. This decision constitutes an enforceable order pursuant to article 2.16, 5 BCIP.

The Hague, 6 May 2019

Tineke Van Hoey
(*rapporteur*)

Tomas Westenbroek

Camille Janssen

Administrative officer: Loes Burger