

**DECISION
of the Fifth Board of Appeal
of 27 October 2020**

In case R 1082/2020-5

Luctor International LLC

375 Park Avenue Spirits
c/o Sazerac North America, Inc.
10101 Linn Station Road
Louisville, Kentucky 40223-3812
United States of America

Opponent / Appellant

represented by Joanne Claire Lazenby, 28 Mornington Terrace, London NW1 7RS,
United Kingdom

v

Changbo Sun

Group 4, Xiaoguang Village
Dongsheng Township, Taobei District
Baicheng, Jilin
People's Republic of China

Applicant / Defendant

represented by Metida Law Firm Zaboliene and Partners, Business Center Vertas
Gynėjų str. 16, 01109 Vilnius, Lithuania

APPEAL relating to Opposition Proceedings No B 3 076 118 (European Union trade
mark application No 17 980 847)

THE FIFTH BOARD OF APPEAL

composed of V. Melgar (Chairperson and Rapporteur), A. Pohlmann (Member) and C.
Govers (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 6 November 2018, Changbo Sun ('the applicant') sought to register the word mark

THE VAN GOGH

for the following list of goods:

Class 33 - Aperitifs; cocktails; fruit extracts, alcoholic; alcoholic beverages, except beer; liqueurs; spirits [beverages]; digesters [liqueurs and spirits]; baijiu [Chinese distilled alcoholic beverage]; alcoholic beverages containing fruit; wine.

- 2 The application was published on 16 November 2018.
- 3 On 18 February 2019, Luctor International LLC ('the opponent') filed an opposition against the registration of the published trade mark application for all the above goods.
- 4 The grounds of opposition were those laid down in Article 8(1)(a) and (b) EUTMR.
- 5 The opposition was based on the following two earlier rights:
 - a) European Union trade mark registration No 1 298 231 'VAN GOGH' filed on 3 September 1999 and registered on 18 August 2000 for the following goods:

Class 32 - Beer;

Class 33 - Alcoholic beverages (except beers).
 - b) European Union trade mark registration No 1 358 621 'VINCENT VAN GOGH' filed on 26 October 1999 and registered on 15 November 2000 for the following goods:

Class 32 - Beer;

Class 33 - Alcoholic beverages (except beers).
- 6 By decision of 3 April 2020 ('the contested decision'), the Opposition Division partially upheld the opposition on the grounds that there was a likelihood of confusion, namely for the following goods:

Class 33 - Aperitifs; cocktails; alcoholic beverages, except beer; liqueurs; spirits [beverages]; digesters [liqueurs and spirits]; baijiu [Chinese distilled alcoholic beverage]; alcoholic beverages containing fruit; wine.

It gave, in particular, the following grounds for its decision:

- The opposition is based on more than one earlier trade mark. The Opposition Division finds it appropriate to first examine the opposition in relation to the opponent's European Union trade mark registration No 1 298 231 'VAN GOGH' (see paragraph 5a).

The contested goods

- Alcoholic beverages, except beer are identically contained in both lists of goods.
- The contested aperitifs; cocktails; liqueurs; spirits [beverages]; digesters [liqueurs and spirits]; baijiu [Chinese distilled alcoholic beverage]; alcoholic beverages containing fruit; wine are included in the broad category of the opponent's alcoholic beverages (except beers). Therefore, they are identical.
- The contested fruit extracts, alcoholic are goods used for making alcoholic beverages, which are intended for business customers. These goods and the opponent's alcoholic beverages (including the opponent's beers in Class 32) are sold at different points of sale and do not target the same public. They differ in their natures and in their purposes as the fruit extracts are ingredients whereas the opponent's goods are finished products ready for consumption. Their producers are not the same. They are not in competition or complementary. By definition, goods intended for different publics cannot be complementary.
- Furthermore, there is no complementarity when one ingredient is needed for the production/preparation of another foodstuff. Complementarity only applies to the use of goods and not to their production processes. Therefore, contrary to the arguments of the opponent, the contested fruit extracts, alcoholic are dissimilar to the opponent's goods.

Relevant public — degree of attention

- The goods found to be identical are directed at the public at large who will display an average degree of attention.

The signs 'VAN GOGH' versus 'THE VAN GOGH'

- Conceptually, as the signs coincide in the words 'VAN GOGH', they are semantically highly similar for the public under analysis albeit the contested sign will be perceived as referring to a work of the painter Van Gogh whereas the earlier mark refers to the painter himself.
- Visually and aurally, as the signs coincide in the words/sounds 'VAN GOGH' they are visually and phonetically highly similar, differing only in the word 'THE' and its sound in the contested sign which will receive less

attention given that it will be perceived as being merely the definite article in English.

Distinctiveness of the earlier mark

- The opponent did not explicitly claim that its mark is particularly distinctive by virtue of intensive use or reputation.
- Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods in question from the perspective of the public under analysis in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

Global assessment, other arguments and conclusion

- The signs have been found to be visually, phonetically and conceptually highly similar for the public under analysis. The goods are partly identical and partly dissimilar. The earlier mark enjoys a normal degree of distinctive character and the relevant public's level of attention is average.
- Having considered all the relevant factors, the Opposition Division must conclude that the similarities manifestly and clearly outweigh the differences, pertaining only to the addition of the word 'THE' to the contested sign.
- Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the English-speaking part of the public, such as that in Malta and Ireland and therefore the opposition is partly well founded on the basis of the opponent's European Union trade mark registration No 1 298 231. A likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.
- It follows from the above that the contested trade mark must be rejected for the goods found to be identical to those of the earlier trade mark.
- The rest of the contested goods are dissimilar. As the similarity of the goods is a necessary condition for the application of Article 8(1) EUTMR, the opposition based on this Article and directed at these goods cannot be successful.
- The opponent has also based its opposition on the following earlier trade mark: European Union trade mark registration No 1 358 621 'VINCENT VAN GOGH' (see paragraph 5b). This earlier right covers the same scope of goods in Classes 32 and 33 as those of the other earlier mark (see paragraph 5a). Therefore, the outcome cannot be different with respect to goods for which the opposition has already been rejected; no likelihood of confusion exists with respect to those goods.

- For the sake of completeness, it must be mentioned that the opposition must also fail insofar as based on the grounds under Article 8(1)(a) EUTMR and directed against the remaining goods because the addition of the word ‘THE’ in the contested sign means that the signs are not identical, nor are the remaining contested goods.
- 7 On 28 May 2020, the opponent filed an appeal against the contested decision, requesting that the contested decision be partially set aside to the extent that the opposition was rejected for ‘fruit extracts, alcoholic’. The statement of grounds of the appeal was received on 2 August 2020.
- 8 No response was filed by the applicant.

Submissions and arguments of the opponent

- 9 The arguments raised in the statement of grounds may be summarised as follows:

Preliminary points

- The opponent refers to its submissions before the Opposition Division, which included a copy of the Fifth Board’s ‘Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)’ decision: (12/02/2019, R 1662/2018-5, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)).
- The applicant has not filed any arguments, or requested that the opponent provide evidence as regards its registered marks’ use, perhaps because the applicant is satisfied with the earlier marks’ use because of the opponent’s website <https://www.vangoghvodka.com/>.
- If there is a finding that no likelihood of confusion exists between ‘VAN GOGH’ alcoholic beverages and ‘THE VAN GOGH’ alcoholic fruit extracts, this puts the opponent in just as much economic risk as if there had been a finding of no likelihood of confusion with any of the other ‘THE VAN GOGH’ alcoholic goods, e.g. spirits.
- If instead of ‘VAN GOGH’ vodka there are ‘THE VAN GOGH’ fruit extracts soaked in vodka, which the average consumer can buy to mix a vodka cocktail at home, the applicant will have a way of selling its products at the risk of the opponent losing sales.

Introduction

- The opposition was based on both double identity under Article 8(1)(a) EUTMR and, in the alternative, a likelihood of confusion, Article 8(1)(b) EUTMR.

- The contested decision refused the contested mark for all its goods with the sole exception of ‘fruit extracts, alcoholic’, despite the Opposition Division’s findings that:
 - ‘VAN GOGH’ is highly similar to ‘THE VAN GOGH’;
 - ‘VAN GOGH’ has a normal degree of distinctiveness;
 - the opponent explicitly having drawn the Opposition Division’s attention to the ‘SUM011’ decision (12/02/2019, R 1662/2018-5, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)) that ‘fruit extracts, alcoholic’ were similar to a low degree to ‘alcoholic beverages’ in Class 33.
- There was enough at the very least for a finding under Article 8(1)(b) EUTMR. That there was no such finding therefore justifies subjecting the contested decision to very close scrutiny.

The Opposition Division failed to consider if the contested ‘THE VAN GOGH’ was identical to ‘VAN GOGH’ according to the ‘Arthur et Félicie’ judgment (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169)

- The opponent’s submissions to the Opposition Division included intensive arguments that ‘THE VAN GOGH’ was identical to ‘VAN GOGH’ because the ‘THE’ would go unnoticed (20/03/2003, C-291/00, Arthur et Félicie, EU:C:2003:169). There is nothing in the contested decision to indicate that this was considered. Within it there is neither a citation of this decision nor the words ‘go unnoticed’.
- Rather, the contested decision merely states that ‘THE’ ‘means that the signs are not identical’. This is a wrong approach. Rather, the right approach, as required by the Court of Justice, is to bear in mind that imperfect recollection applies not only to similarity but also identity.
- A finding that ‘THE VAN GOGH’ and ‘VAN GOGH’ are highly similar does not negate the need to determine if they are identical.
- This is because it is not only for Article 8(1)(a) EUTMR for which identity must be considered. Rather, it makes a difference to the weighting within the overall assessment under Article 8(1)(b) EUTMR.

The Opposition Division should not have decided that ‘alcoholic fruit extracts’ were dissimilar to ‘alcoholic beverages’ in Class 33.

- The opponent had thought that, under Article 8(1)(a) EUTMR, these goods were identical, on the basis that the alcohol was the essence of the fruit extract and needed only water to become a beverage.

- Nonetheless, if the Opposition Division were to disregard these arguments, the opponent also explicitly requested that the Opposition Division consider that there was at least a low degree of similarity between them.
- Despite this, there are nine errors in the contested decision:
 - Error 1: The Opposition Division did not consider any degree of similarity. Rather, there was a blunt dissection between ‘identical’ and ‘dissimilar’.
 - Error 2: None of the three General Court judgments to which the Opposition Division referred were relevant to alcoholic fruit extracts:
 - a) *Farma Mundi Farmaceuticos Mundi* (22/06/2011, T-76/09, *Farma Mundi Farmaceuticos Mundi*, EU:T:2011:298) considers pharmaceuticals and Class 39 and 35 services;
 - b) *Dolphin* (12/07/2012, T-361/11, *Dolphin*, EU:T:2012:377) deals with telecommunications equipment and other goods in Class 9;
 - c) *Flaco* (11/05/2011, T-74/10, *Flaco*, EU:T:2011:207) considers agricultural machinery, such as milking machines for cows.
 - Error 3: The Opposition Division should not have placed weight on the ‘FRUITINI’ appeal (11/12/2012, R 2571/2011-2, *FRUITINI*) because:
 - a) This involved ‘FRUITINI’ in Classes 29, 30 and 32 for non-alcoholic flavourings for beverages versus ‘FRUTINA’ in Class 29, which was solely for gelling agents for food, jam, cream and desserts. Nothing else. Neither ‘FRUITINIA’ or ‘FRUITINI’ covered ‘alcoholic beverages’. Neither of them involved ‘fruit extracts, alcoholic’;
 - b) The Board mentioned extracts of lemon, mango, orange and melon, as examples of the flavourings which would fall inside the Class 32 list for ‘FRUITINI’. The Board went on to state that ‘Although all of them are in the general category of foodstuff, they are not considered similar as they do not share the same purpose, they are not in competition, and are not manufactured by the same companies’ but the context of ‘similar’ in this decision is based on flavourings in Class 32 versus gelling agents in Class 29;
 - c) The Board did not make that sweeping statement that an extract from a lemon, mango, orange and melon was not similar to any foodstuff (and in any event, are alcoholic beverages foodstuffs?).
- The Opposition Division totally ignored the ‘SUM011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)’ decision (12/02/2019, R 1662/2018-5, *Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)*) which stated that ‘fruit extracts, alcoholic’ had a low

degree of similarity with ‘alcoholic beverages’ in Class 33. The Board’s finding that ‘fruit extracts; alcoholic’ had a low degree of similarity with ‘alcoholic beverages’ in Class 33 was not affected by the appeal to the General Court (12/03/2020, T-296/19, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.), EU:T:2020:93).

- The opponent is unable to understand why the Opposition Division placed weight on decisions regarding pharmaceuticals, telecoms, agricultural machinery and gelling agents for dairy products yet placed no weight at all on the abovementioned decision (12/02/2019, R 1662/2018-5, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)) for ‘fruit extracts, alcoholic’, to which the opponent had explicitly drawn attention.
- Also, an opposition decision (25/06/2019, B 3 058 442, TONKA / TONKA) stated that ‘fruit extracts, alcoholic’ were ‘similar to a low degree to “alcoholic beverages, except beer”. They usually coincide in producer, relevant public and distribution channels’.
 - Error 4: The Opposition Division was wrong to find that ‘fruit extracts, alcoholic’ were intended solely for business customers, because the abovementioned decision states that they are for both business customers and the general public.
 - Error 5: The Opposition Division was wrong not to find that ‘fruit extracts, alcoholic’ had different points of sale from ‘alcoholic beverages’, because the abovementioned decision found that they were ‘distributed through the same channels’.
 - Error 6: The Opposition Division was wrong to state that ‘the producers are not the same’, because the abovementioned decision found that they ‘share the same producers’.
 - Error 7: The Opposition Division was wrong to find that the goods differ in nature and purpose, because the abovementioned decision found that they shared the same purpose, i.e. for preparing alcoholic beverages at home.
 - Error 8: Because the Opposition Division made these errors, it also committed errors regarding complementarity: if it were true that there can be no complementarity if there are different publics, or are ingredients for other foodstuffs, or solely for production processes rather than sharing the same uses, the abovementioned decision found that the alcoholic fruit extracts did share the same public, were not solely for the production of a foodstuff and were not solely for a production process, and did share the same uses. The Opposition Division’s decision regarding the opponent’s arguments as regards complementarity should therefore not stand.

- Error 9: The Opposition Division was also wrong not to have considered the opponent's indirect confusion or economic connection submissions in respect of business customers, because:
 - a) The opponent explicitly argued that the test for a likelihood of confusion included not only one mark being mistaken for another, but also being mistaken for having come from the same company or group of undertakings;
 - b) Bars are highly likely to make the mistake that an alcoholic fruit extract called 'THE VAN GOGH' shares the same trade origin as 'VAN GOGH' vodka (the 'THE' would go unnoticed). Bars would stock the extract in order to mix it with 'VAN GOGH' vodka, totally unaware that it does not share an economic connection with 'VAN GOGH' vodka;
 - c) When someone walks into a bar and asks for peach 'VAN GOGH' vodka, and the bartender mixes it with 'THE VAN GOGH' peach extract, thinking (mistakenly) that it too has come from the same manufacturer as the vodka, and the bartender's customer does not like the drink which the bartender has served, the bar may well decide to no longer stock either product;
 - d) The opponent will therefore have lost the bar as its customer.

The Opposition Division did not apply the interdependence principle at all; if the Opposition Division had applied it, it would have been in favour of the opponent

- The opponent draws the Board's attention to the absence from the contested decision of the usual citation of the 'Canon' judgment: 'a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa' (29/09/1998, C-39/97, Canon, EU:C:1998:442).
- There was also the blunt dissection of the goods into either 'identical' or 'dissimilar'. There was no consideration of any degree of similarity, which led to a multiplicity of errors, not least of which was the nine errors caused by the failure to rely on the 'Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)' decision that 'alcoholic beverages' were similar to a low degree to 'fruit extracts, alcoholic' (12/02/2019, R 1662/2018-5, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)).
- By not applying the 'Canon' judgment (29/09/1998, C-39/97, Canon, EU:C:1998:442), the Opposition Division cannot be held to have applied the interdependence principle properly, if at all.
- Had the Opposition Division done so, this should have tipped the scales as far as 'fruit extracts, alcoholic' were concerned in favour of the opponent,

because, in situations where the marks are highly similar under all three criteria – visually, aurally, and conceptually, if not identical, the Opposition Division could have decided that the ‘THE’ would go unnoticed in ‘THE VAN GOGH’; there only needs to be a low degree of similarity between the goods.

Conclusion: the consequences if the contested decision is left to stand

- All the applicant’s goods except ‘fruit extracts, alcoholic’ for which the Opposition Division did refuse registration of ‘THE VAN GOGH’ are beverages which therefore could have easily been found identical.
- This is not enough to prevent the applicant’s interference with the opponent’s right to a guarantee of origin, because, if the applicant makes ‘THE VAN GOGH’ alcoholic fruit extracts, the applicant will have found a way of causing confusion with ‘VAN GOGH’ beverages just as much as if he uses ‘THE VAN GOGH’ for alcoholic beverages.
- Two examples are given:
 - The opponent’s business customers will not stock ‘VAN GOGH’ vodka if their clientele did not like it when mixed with ‘(THE) VAN GOGH’ fruit extracts;
 - The general public will buy ‘(THE) VAN GOGH’ fruit extracts soaked in vodka off the shelf at the supermarkets as an alternative to buying ‘VAN GOGH’ vodka for mixing their cocktails at home.
- If the contested decision is left to stand, it might even be seen by the applicant as a green signal that he can proceed with his plans for ‘THE VAN GOGH’ by adjusting his product line solely to fruit extracts.

Conclusion

- These are the types of loss which the principles regarding the right to prevent a likelihood of confusion are intended to prevent.
- Had the Opposition Division applied the methodology of these principles properly, and in the right order, the opponent would not be at risk of interference to its right to a guarantee of origin. It is because these principles have not been properly followed that the opponent is now vulnerable to this risk.
- The opponent therefore request that the appeal be upheld, the contested decision annulled, European Union trade mark application No 17 980 847 be rejected for all of its goods and that the costs be borne by the applicant.

Reasons

- 10 All references made in this decision should be seen as references to the EUTMR (EU) No 2017/1001 (OJ 2017 L 154, p. 1), codifying Regulation (EC) No 207/2009 as amended, unless specifically stated otherwise in this decision.
- 11 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

Scope of the appeal

- 12 The applicant could have filed an appeal against the contested decision which rejected the mark applied for the majority of the goods, he did not do so and did not even file observations. The opponent challenges the contested decision insofar as the opposition was rejected.

Article 8(1)(b) EUTMR

- 13 It follows from Article 8(1)(b) EUTMR that, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for must not be registered if, because of its identity with or similarity to the earlier trade mark and the identity or similarity between the goods or services covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected. A likelihood of confusion includes a likelihood of association with the earlier trade mark.
- 14 According to settled case-law, the risk that the public might believe that the goods in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of that article (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16-18; 29/09/1998, C-39/97, Canon, EU:C:1999:323, § 17).
- 15 The likelihood of confusion must be assessed globally, according to the relevant public's perception of the signs and the goods or services concerned and account being taken of all factors relevant to the circumstances of the case, in particular the interdependence between the similarity of the signs and that of the goods or services designated (09/07/2003, T-162/01, Giorgio Beverly Hills, EU:T:2003:199, § 30-33 and the case-law cited).

Relevant public and level of attention

- 16 The relevant public for the assessment of the likelihood of confusion is composed of users likely to use both the goods and services covered by the earlier mark and those covered by the mark applied for that were found to be identical or similar (24/05/2011, T-408/09, ancotel, EU:T:2011:241, § 38 and the case-law cited; 01/07/2008, T-328/05, Quartz, EU:T:2008:238, § 23; 10/07/2009, C-416/08 P, Quartz, EU:C:2009:450).

- 17 The goods of the contested mark are intended either for a professional public for those business customers which then take these ingredients and manufacture alcoholic drinks based on fruit extracts, but also for the general public who can make drinks at home; on the other hand the earlier mark goods are targeted at the general public; they are daily consumer goods.
- 18 Given that the earlier mark is an EU trade mark registration, the relevant territory is the European Union.

Comparison of the marks

- 19 With regard to the comparison of the signs, the likelihood of confusion must be determined by means of a global appraisal of the visual, phonetic and conceptual similarity of the signs, on the basis of the overall impression given by them, bearing in mind in particular their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).
- 20 In general terms, two signs 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, namely the visual, aural and conceptual aspects (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30 upheld on appeal by order of 28/04/2004, C-3/03 P, Matratzen, EU:C:2004:233; 12/07/2006, T-97/05, Marcorossi, EU:T:2006:203, § 39; 22/06/2005, T-34/04, Turkish Power, EU:T:2005:248, § 43, upheld on appeal by order 01/06/2006, C-324/05 P, Turkish Power, EU:C:2006:368).
- 21 The assessment of the similarity between two signs means more than taking just one component of a composite sign and comparing it with another sign. On the contrary, the comparison must be made by examining each of the signs in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite sign may not, in certain circumstances, be dominated by one or more of its components. It is only if all the other components of the sign are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element. That could be the case, in particular, where that component is capable on its own of dominating the image of that sign which members of the relevant public keep in their minds, so that all the other components are negligible in the overall impression created by that sign (20/09/2007, C-193/06 P, Quicky, EU:C:2007:539, § 42-43).
- 22 The signs to be compared are:

| | |
|---------------------|-----------------------|
| VAN GOGH | THE VAN GOGH |
| <i>Earlier mark</i> | <i>Contested sign</i> |

- 23 The sign applied for is a word mark composed of three words 'THE', 'VAN' and 'GOGH', the earlier mark is also a word mark composed of two verbal elements 'VAN' and 'GOGH'.
- 24 Visually the signs are highly similar as the earlier mark is totally contained in the contested sign, the only difference being the definite article 'THE' of the contested sign.
- 25 Aurally the signs are also highly similar the only difference in the pronunciation being the beginning of the contested sound 'THE'.
- 26 Conceptually the contested decision took the English-speaking public of Ireland and Malta as a reference to claim that the 'VAN GOGH' element common to both signs will be understood as referring to the famous Dutch painter Vincent Van Gogh.
- 27 The Board takes the view that most of the European Union public will make a clear reference to the painter Van Gogh in particular the Dutch public as Van Gogh was a Dutch painter. However, as it is well known also that Vincent Van Gogh spent part of his life in France, it is clear also that for the French public the elements Van Gogh will be immediately related to the painter.
- 28 As the Second Board stated in its 'VAN GOGH MUSEUM AMSTERDAM' decision (14/07/2016, R 1969/2015-2, VAN GOGH MUSEUM AMSTERDAM), Van Gogh is a Dutch family name and therefore inherently distinctive. This family name is not weak for goods in Classes 32 or 33. Van Gogh was the family name of Vincent van Gogh (1853 -1890) who was a major post-impressionist painter. He was a Dutch artist whose work had a far-reaching influence on 20th century art.
- 29 The concept introduced by the presence of the definite article 'THE' will not affect the high degree of conceptual similarity between the marks as it will make reference to a particular work by Van Gogh, the painter.

Comparison of the goods

- 30 In assessing the similarity of the goods concerned, all the relevant factors relating to those goods themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary (29/09/1998, C 39/97, Canon, EU:C:1998:442, § 23). Additional factors include the purpose of the goods, whether or not they can be manufactured, sold or supplied by the same undertaking or by economically linked undertakings, and also their distribution channels and sales outlets.
- 31 The goods applied for which are at issue in the present appeal are the following:

Class 33 - Fruit extracts, alcoholic.

32 The goods on which the opposition is based are the following:

Class 32 - Beer.

Class 33 - Alcoholic beverages (except beers).

33 The opponent argues that the conclusion of the contested decision that the goods in Class 33 of the earlier mark and the contested goods in Class 32 and 33 are dissimilar is wrong.

34 It proposes that it should have been concluded that the goods were at least similar to a low degree and invokes the 5th Board's 'Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)' decision (12/02/2019, R 1662/2018-5, Sum011 / ORIGINAL Sumol ORANGE ORIGINAL Sumol LARANJA (fig.)). However these arguments result from an incorrect reading of the abovementioned decision.

35 It is true that the Opposition Division in this case established that 'The contested "alcoholic fruit extracts" are goods used for making alcoholic beverages. They can be used both by business customers and by the general public; the latter might use them for preparing alcoholic beverages at home or as flavouring or cooking ingredients. Therefore, the contested goods and the opponent's "alcoholic beverages (except beers)" can have the same relevant public. Moreover, they can be distributed through the same channels and may have the same producers. Therefore, they are similar to a low degree.' However the Appeal in the Sumol case ruled only on the remaining services in Classes 35 and 39, so the conclusion that the goods were lowly similar is one of the Opposition Division and not from the Boards of Appeal.

36 The Board notes that the contested 'fruit extracts, alcoholic' are goods used for making alcoholic beverages, ingredients which are intended either for business customers in particular alcoholic drink producers but can also be bought by private persons who intend to make cocktails or mix them with soft drinks.

37 These goods and the opponent's 'alcoholic beverages' (including the opponent's 'beers' in Class 32) may be sold at the same points of sale and may target the same public.

38 The term 'alcoholic beverages' is broadly worded and also covers alcoholic beverages based on fruit and fruit juices.

39 Fruit juices can be made from apples, grapes and other fruits which can likewise constitute the basis for alcoholic beverages containing fruit, cider, wine or perry. The goods are also in competition with each other. Moreover, the goods may come from the same manufacturers and be sold via the same distribution channels.

40 There is at least a low degree of similarity between the contested goods 'fruit extracts, alcoholic' and the 'alcoholic beverages' in Class 33 of the earlier mark.

- 41 So the Board agrees with the opponent that the Opposition Division was wrong to consider that these goods were dissimilar.

Overall assessment of the likelihood of confusion

- 42 The appreciation of likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the earlier mark on the market, the association which can be made with the registered mark, the degree of similarity between the marks and between the goods or services identified (recital 8 of the EUTMR). It must be appreciated globally, taking into account all factors relevant to the circumstances of the case (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22).
- 43 Such a global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular, the similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods may be offset by a lower degree of similarity between the marks, and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).
- 44 The average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in his or her mind (see to this effect 11/11/1997, C-251/95, Sabèl EU:C:1997:528, § 23; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).
- 45 Furthermore, the more distinctive the earlier mark, the greater the risk of confusion, and 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 (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).
- 46 The opponent did not explicitly claim that its earlier mark had acquired reputation or enhanced distinctiveness through intensive use. Therefore, the assessment of distinctiveness of the earlier mark will rest on its inherent distinctiveness. Since the earlier sign has no connection with the relevant goods or their characteristics it has an average degree of distinctiveness.
- 47 The marks are highly similar from the visual, phonetic and conceptual points of view.
- 48 It is recalled that the fact that a mark consists exclusively of the earlier mark, to which another element has been added, is an indication that the two trade marks are similar, pursuant to extensive settled case-law, including the following judgments: 12/11/2008, T-281/07, Ecoblue, EU:T:2008:489, § 28 and the case-law cited therein; 03/07/2003, T-129/01, Budmen, EU:T:2003:184, § 47-50; 04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 40; 18/02/2004, T-10/03,

Conforflex, EU:T:2004:46, § 59 et seq.; 30/06/2004, T-186/02, Dieselit, EU:T:2004:197, § 46; 06/10/2004, T-356/02, Vitakraft, EU:T:2004:292, § 54-57; 04/05/2005, T-359/02, Star TV, EU:T:2005:156; 11/05/2005, T-31/03, Grupo Sada, EU:T:2005:169, § 49 et seq.; 25/05/2005, T-352/02, PC Works, EU:T:2005:176, § 34 et seq.; 25/05/2005, T-288/03, Teletech Global Ventures, EU:T:2005:177, § 86 et seq.; 22/03/2007, T-322/05, Terranus, EU:T:2007:94, § 35 et seq.; 08/09/2010, T-152/08, Scorpionexo, EU:T:2010:357, § 66 et seq.; 08/09/2010, T-369/09, Porto Alegre, EU:T:2010:362, § 26 et seq.; 20/09/2011, T-1/09, Meta, EU:T:2011:495; 28/09/2011, T-356/10, Victory Red, EU:T:2011:543, § 26 et seq.; 23/05/2007, T-342/05, Cor, EU:T:2007:152; 10/11/2011, T-313/10, Ayuuri Natural, EU:T:2011:653; 15/11/2011, T-434/10, Alpine Pro Sportswear & Equipment, EU:T:2011:663, § 55 et seq.). The Board cannot simply ignore such well-established case-law.

- 49 The Board recalls that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his or her trust in the imperfect picture of them that he or she has kept in his or her mind (see to this effect 11/11/1997, C-251/95, Sabèl EU:C:1997:528, § 23; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).
- 50 Taking into account, in particular, the high degree of similarity between the marks, due to the entire earlier mark being included in the contested sign with the mere addition of the definite article ‘THE’ and the similarity between the relevant goods, a significant part of the relevant public will believe that the similar goods designated by the conflicting signs originate from the same undertaking or from economically-linked undertakings, regardless whether or not they display a more than average level of attention.
- 51 Given the striking similarity between the signs, the Board notes that this finding is valid even in a case such as the present one where the goods are similar only to a low degree.
- 52 In light of the foregoing considerations and in light of the notion of imperfect recollection and of interdependence, it is thus held that a likelihood of confusion between the signs on the part of the relevant public exists in relation to all the contested goods, ‘fruit extracts alcoholic’ in Class 33.

Article 8(1)(a) EUTMR

- 53 The opponent also based its opposition on the provisions of Article 8(1)(a) EUTMR but as correctly stated in the contested decision there is no identity between the signs because the contested mark has the definite article ‘THE’ which is absent in the earlier mark, therefore the provisions of Article 8(1)(a) EUTMR are not applicable and in any case as the opposition succeeds on the basis of likelihood of confusion there is no need to further reason on the absence of identity.

Conclusion

54 The decision must therefore be annulled and the appeal upheld.

Costs

55 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent's costs of the appeal proceedings and of the opposition proceedings.

56 As to the appeal proceedings, these consist of the opponent's costs of professional representation of EUR 550 and of the appeal fee of EUR 720.

57 As to the opposition proceedings, these consist of the opponent's costs of professional representation of EUR 300 and the opposition fee of EUR 320. The total is EUR 1 890.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the contested trade mark for ‘fruit extracts alcoholic’ in Class 33;**
- 3. Orders the applicant to bear the costs incurred by the opponent in the appeal and opposition proceedings amounting to EUR 1 890.**

Signed

V. Melgar

Signed

A. Pohlmann

Signed

C. Govers

Registrar:

Signed

p.o. P. Nafz

