

OPPOSITION No B 3 102 279

Spier Wines (Pty) Ltd, Annandale Road, 7600 Stellenbosch, Western Cape, South Africa (opponent), represented by **Beck Greener LLP**, Fulwood House 12 Fulwood Place, London WC1V 6HR, United Kingdom (professional representative)

a g a i n s t

Georges El Badaoui, Via Dei Mille 13, 24036 Ponte San Pietro, Italy; **Vitalyv International**, Via Dei Mille 13, Ponte San Pietro Bg, Italy (applicant), represented by **Digitorium S.Coop.**, Harrobi Plaza 5, Planta 4, Módulo 9, 48003 Bilbao, Spain (professional representative).

On 28/04/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 102 279 is partially upheld, namely for the following contested goods:

Class 30: *flavoured vinegar; wine vinegar.*

Class 32: *Alcohol free wine; Non-alcoholic beverages; Low alcohol beer; Pale ale; Flavored beers; Coffee-flavored beer.*

Class 33: all of the contested goods in this Class except for *extracts of spiritous liquors; Fruit extracts, alcoholic; Preparations for making alcoholic beverages; Alcoholic preparations for making beverages; Alcoholic extracts.*

2. European Union trade mark application No 18 097 540 is rejected for all the above goods. It may proceed for the remaining goods.
3. Each party bears its own costs.

REASONS

On 05/11/2019, the opponent filed an opposition against all the goods of European Union



trade mark ('EUTM') application No 18 097 540 SAVANNAH DELIGHTS (figurative mark). The opposition is based on EUTM registration No 286 435 'SAVANHA' (word mark), EUTM



registration No. 2 014 330, SAVANHA (figurative mark), as well as the non-registered sign 'SAVANHA' (word mark) used in the course of trade in the United Kingdom and in Ireland) for *alcoholic beverages; wine* for which the opponent invoked Article 8(4) EUTMR. For both aforementioned earlier EUTMs, the opponent invoked Article 8(1)(b) and Article 8(5) EUTMR.

EARLIER UK RIGHTS

On 01/02/2020, the United Kingdom (the 'UK') withdrew from the EU subject to a transition period until 31/12/2020. During this transition period EU law remained applicable in the UK. As from 01/01/2021, UK rights ceased *ex-lege* to be earlier rights protected 'in a Member State' for the purposes of proceedings based on relative grounds. The conditions for applying Article 8(4), EUTMR, worded in the present tense, must also be fulfilled at the time of decision taking. It follows that the above-mentioned non-registered trade mark for which the opponent invoked Article 8(4) EUTMR no longer constitutes a valid basis of the opposition (see Communication No 2/20 of the Executive Director of the Office of 10 September 2020 on the impact of the United Kingdom's withdrawal from the European Union on certain aspects of the practice of the Office, Section V 'Earlier rights in *inter partes* proceedings'). The opposition must therefore be rejected as far as it is based on that earlier UK right.

PROOF OF USE

In accordance with Article 47(2) and (3) EUTMR, if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of filing or, where applicable, the date of priority of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is subject to the use obligation if, at that date, it has been registered for at least five years.

The same provision states that, in the absence of such proof, the opposition will be rejected.

The applicant requested that the opponent submit proof of use of the EUTMs on which the opposition is based, as set out above.

The request was submitted in due time and is admissible given that the earlier trade marks were registered more than five years prior to the relevant date mentioned above.

The date of filing of the contested application is 19/07/2019. The opponent was therefore required to prove that the said trade marks on which the opposition is based were put to genuine use in the European Union from 19/07/2014 to 18/07/2019 inclusive.

Furthermore, the evidence must show use of the trade marks for the goods and services on which the opposition is based, namely the following:

For EUTM registration No. 286 435 'SAVANHA' (word mark):

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

Class 42: *Distribution, import and export services; advisory and consultative services; all the foregoing in respect of wines.*



For EUTM registration No. 2014330 **SAVANHA** :

Class 33: *Alcoholic beverages, namely wine and liqueurs.*

According to Article 10(3) EUTMDR, the evidence of use must consist of indications concerning the place, time, extent and nature of use of the opposing trade mark for the goods or services in respect of which it is registered and on which the opposition is based.

On 19/04/2022, in accordance with Article 10(2) EUTMDR, the Office gave the opponent until 24/06/2022 to submit evidence of use of the earlier trade marks which date was later extended to 24/08/2022 at the request of the opponent. On 24/08/2022, within the due time limit, the opponent submitted evidence of use.

The evidence to be taken into account is the following:

Annex 1: stated by the opponent to be a *selection of invoices dated from 2014 – 2019 sent from Spier Farm Management Pty Limited to Skandinavisk Vintapper Aps in Denmark. This latter company bottles the Opponent's wines and supplies COOP, which is the Opponent's client, for distribution within in the EU. These invoices account for almost half a million bottles of SAVANHA branded wine being bottled and which were sold within the EU during the relevant period. The Opponent is a division of Spier Farm Management Pty Limited.*

The contents comprise about 20 sales invoices, non-sequentially numbered, with dates during the relevant period (i.e. during the years 2014-2019 inclusive), to a client entity in Denmark, clearly referring to the sale of wine under the word mark 'SAVANHA'. The quantities are very substantial and so also are the sale totals, provided in the Danish currency.

Annex 2: stated by the opponent to show *product development expenditure in ZA Rand (converted to Euros at the bottom of the spreadsheet) in Belgium, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Netherlands and Sweden. This demonstrates that nearly €350,000.00 has been spent on product development in the EU between 2014 and 2022. €325,000.00 of this sum falls within the relevant period.*

This is a two-page document, apparently an internal document, containing raw data and while the opponent has not provided much detail as to its contents (including how to understand the raw data therein), it is stated to concern the brand SAVANHA with listed promotional activities (such as wine samples, promotions, sponsorships) for Belgium, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, The Netherlands, and Sweden. A grand total (including in euros) at the foot is provided for the years 2014-2022 inclusive, the said figures being very substantial.

Annex 3: stated by the opponent to show *engagement with the Applicant's website in Denmark, France, Germany and Italy between 1 January 2018 and 30 June 2018*. Also shown is detail from the Opponent's Facebook page and Instagram page, both of which are accessible from within the EU.

This Annex commences with some raw data entitled Analytics (with Google cited at the foot thereof), apparently concerning web user data for various countries including Denmark, France, Germany, and Italy. Although the opponent has not provided any meaningful detail as to the significance or manner of interpretation of the raw data, it is not important for present purposes, given the evidence provided in the other listed Annexes.

After that, there are screenshots from the opponent's Facebook page which appear to be directed mainly at South Africa given, for example, the .co.za domain name reference. There are also some screenshots with text in Danish, dated within the relevant period referring to SAVANHA WINES, along with some screenshots from the opponent's Instagram page.

Annex 4: stated by the opponent to show *the point of sale material distributed at exhibitions and to retailers during the relevant period in Belgium, Croatia, Czech Republic, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Netherlands and Sweden*.

These comprise some screenshots as well as website screenshots from country-specific websites, including a handful identified therein as referring to Denmark, Croatia, Sweden,



and Estonia, with references to the word mark 'SAVANHA' as well as the mark (which is not one of the earlier marks in these proceedings). Most appear to be undated although the screenshot for Denmark (reproduced hereunder) is headline-dated December 2021:

Denmark, Superbrugsen
December 2021



Annex 5: stated by the opponent to be *the agenda for a meeting in Stockholm, Sweden that took place on 22 August 2016. Page 4 shows a newly designed label. Page 8 shows projected sales of SAVANHA wine in Sweden from June to December 2016, and a marketing budget of €38,297. Page 16 shows points to be discussed at the meeting.*

In light of the evidence in the other listed Annexes, it is not necessary to consider further the probative value of the contents of this annex which appears to be a presentation at a business meeting.

Annex 6: stated by the opponent to show bottles for sale at COOP's Fakta store in Denmark, dated 28 March 2018.

These are two photographs showing the offer for sale of SAVANHA wine in

shops/supermarkets, each concerning the trade mark in the form



Annex 7: stated by the opponent to show *invoices raised during the relevant period in Estonia and the Netherlands.*

These are four sales invoices to addresses in the Netherlands and Estonia, within the relevant period, most of which concern the sale of 'SAVANHA' wines, in significant quantities and for significant totals in euros.

Assessment of the evidence of genuine use:

The evidence, such as the sale invoices in Annexes 1 and 7, show that the place of use is the European Union, such as Denmark, The Netherlands and Estonia. This can be inferred from the currencies mentioned (i.e. euros or Danish Kroners) and the addresses in the said EU countries. Therefore, the evidence clearly relates to the relevant territory.

Most of the evidence – especially the sales invoices as well as the product development contents of Annex 2 - is dated within the relevant period.

As regards the extent of use, all the relevant facts and circumstances must be taken into account, including the nature of the relevant goods or services and the characteristics of the market concerned, the territorial extent of use, and its commercial volume, duration and frequency.

The assessment of genuine use entails a degree of interdependence between the factors taken into account. Thus, the fact that commercial volume achieved under the mark was not high may be offset by the fact that use of the mark was extensive or very regular, and vice versa. Likewise, the territorial scope of the use is only one of several factors to be taken into account, so that a limited territorial scope of use can be counteracted by a more significant volume or duration of use.

The documents filed, namely the sales invoices in Annex 1 and 7, the product development data in Annex 2, the point of sale material in Annex 4 as well as the photographs of the offer for sale of 'SAVANAH' wine in shops/supermarkets in Denmark (Annex 6), provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use. In particular, the sales invoices demonstrate significant quantities of sale of wines in a number of EU states throughout the relevant period, and this is corroborated at least to some extent by the contents of the other Annexes as outlined above.

Therefore, the Opposition Division considers that the opponent has provided sufficient indications concerning the extent of use of the earlier word mark 'SAVANAH'. In that regard,



although some of the evidence presents the opponent's brand in the form (which is not one of the earlier marks in these proceedings), much of the evidence is also by reference to use of the word mark 'SAVANHA'. Accordingly, as much of the evidence features the word mark 'SAVANAH', it is not necessary to make an assessment as to



whether the uses in the form constitute acceptable use of the said earlier word mark.

The Court of Justice has held that there is 'genuine use' of a mark where it is used 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, in order to create or preserve an outlet for those goods or services. Genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. Furthermore, the condition of genuine use of the mark requires that the mark, as protected in the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, Minimax, EU:C:2003:145; 12/03/2003, T-174/01, Silk Cocoon / COCOON, EU:T:2003:68).

Taking into account the evidence in its entirety, although the evidence submitted by the opponent is not particularly exhaustive, it does reach the minimum level necessary to establish genuine use of the earlier trade mark 'SAVANAH' (word mark) during the relevant period in the EU territory.

Regarding the earlier figurative mark, EUTM registration No. 2 014 330:



The evidence does not demonstrate any use of the earlier mark **S A V A N H A** so that it must be held that the opponent has failed to show genuine use of this earlier mark.

For the avoidance of doubt, the demonstrated use of the word mark 'SAVANAH' does not constitute an acceptable variation of this earlier figurative mark, under the provisions of Article 18(1)(a) EUTMR.

In that regard, the distinctive character of the said figurative mark as registered essentially derives from the combination of the stylised verbal element 'SAVANHA' and the said device element in the mark. Even if it were held that the distinctive character of the said device element were somewhat weak, it interacts with the verbal element, and is visually dominant due to its size and prominent position. It follows that omitting this device element clearly alters the distinctive character of the figurative mark as registered.

Therefore, the opposition must be rejected pursuant to Article 47(2) EUTMR and Article 10(2) EUTMDR for this earlier figurative mark.

However, the evidence filed by the opponent does not show genuine use of the earlier trade mark 'SAVANAH' (word mark) for all the goods and services covered by the earlier trade mark.

According to Article 47(2) EUTMR, if the earlier trade mark has been used in relation to only some of the goods or services for which it is registered it will, for the purposes of the examination of the opposition, be deemed to be registered in respect only of those goods or services.

In the present case, the evidence shows genuine use of the trade mark for the following goods:

Class 33: *Wines*.

In that regard, the evidence does not indicate any, or any sufficient degree of, use for any of the other protected goods and services in Classes 32 or 42.

Therefore, the Opposition Division will only consider the abovementioned goods – *wines* - in its further examination of the opposition. Indeed, at paragraph 6 of its accompanying submissions dated 24/08/2022, the opponent states that it *has made use of SAVANAH on wines* and while at paragraph 14 thereof, it contends that there has been genuine use for all the protected goods and services, the evidence filed does not support such a finding, other than in relation to wines in Class 33.

According to case-law, when applying the abovementioned provision, the following should be considered:

...if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories to which the goods or

services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

(14/07/2005, T-126/03, ALADIN / ALADDIN, EU:T:2005:288, § 45-46.)

In the present case, the evidence proves use only for *wines*. These goods can be considered to form an objective subcategory of the protected *alcoholic beverages (except beers)*.

Conclusion:

The Opposition Division concludes that the evidence furnished by the opponent is sufficient to prove that the earlier trade mark 'SAVANAH' (word mark) was genuinely used in the EU territory during the relevant period of time in respect of *wines* in Class 33, but not for the other protected goods and services thereof.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

A likelihood of confusion exists if there is a risk that the public might believe that the goods or services in question, under the assumption that they bear the marks in question, come from the same undertaking or, as the case may be, from economically linked undertakings. Whether a likelihood of confusion exists depends on the appreciation in a global assessment of several factors, which are interdependent. These factors include the similarity of the signs, the similarity of the goods and services, the distinctiveness of the earlier mark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods

The goods on which the opposition is based and for which genuine use has been demonstrated are the following:

EUTM registration No 286 435 'SAVANAH':

Class 33: *Wines*.

The contested goods are the following:

Class 29: *Milk; Milk products; Curd; Powdered milk; Flavoured milk; Albumin milk; Buttermilk; Prostokvasha [soured milk]; Flavoured yoghurts; Yoghurt; Drinking yogurts; Yogurt drinks; Fruit flavoured yoghurts; Soya yoghurt; Drinks based on yogurt; Preparations for making yoghurt; Yoghurt made from goats milk; Custard style yoghurts; Yoghurt desserts; Low fat yoghurts; Skimmed milk; Acidophilus milk; Evaporated milk; Organic milk; Cows' milk; Almond milk; Goat milk; Sheep milk; Rice milk; Soya milk; Whey; Condensed milk; Dips; Pickles; Vegetarian charcuterie; Cheese dips; Dairy-based dips; Bean dip; Soy sauce marinated crab (Ganjang-gejang); Beans cooked in soy sauce (Kongjaban); Vegetables pickled in soy sauce; Chile con queso; Savory butters; Flavoured nuts; Aromatized fruit; Flavoured oils; Flavoured milk beverages; Roast beef flavoured extract; Flavoured milk powder for making drinks; Cocoa flavored milk beverages; Milk-based beverages flavored with chocolate; Jellies for food; Vegetable jellies; Almond jelly; Fish jellies; Meat gelatines; Seafood jellies; Gelatine; Jellies, jams, compotes, fruit and vegetable spreads; Butter with herbs; Cheese containing herbs; Meat extracts; Extracts for soups; Tomato extracts; Fish extracts; Extracts of vegetables [juices] for cooking; Vegetable extracts for cooking; Vegetable extracts for food; Seaweed extracts for food; Seafood extracts; Extracts of poultry; Soups and stocks, meat extracts; Fruit-based snack food; Potato crisps in the form of snack foods; Soy-based snack foods; Tofu-based snacks; Snack foods based on legumes; Fruit- and nut-based snack bars; Bombay mix; Snacks of edible seaweed; Dried fruit-based snacks; Candied fruit snacks.*

Class 30: *Frozen yoghurt [confectionery ices]; Frozen yogurt cakes; Frozen yogurt confections; Ice, ice creams, frozen yogurts and sorbets; Yoghurt based ice cream [ice cream predominating]; Milk tablet candy; Ice lollies containing milk; Ice milk [ice cream]; Milk chocolates; Cocoa beverages with milk; Coffee beverages with milk; Liqueur chocolates; Savarins; Sauces; Sauce [edible]; Sauces [condiments]; Ready-made sauces; Tartare sauce; Teriyaki sauce; Spicy sauces; Ketchup [sauce]; Satay sauces; Concentrated sauce; Hot sauce; Pesto [sauce]; Salsas; Relish [condiment]; Sweet and sour sauce; Worcestershire sauce; Remoulade sauce; Sauce powders; Pasta sauce; Cheese sauce; Soya sauce; Canned sauces; Dressings for food; Gravy mixes; Mixes for preparing sauces; Sauces for pizzas; Dressings for salad; Chocolate topping; Chili sauce; Sauces containing nuts; Pepper sauces; Artichoke sauce; Savory sauces, chutneys and pastes; Sauces flavoured with nuts; Meat gravies; Preparations for making up into sauces; Vegetable purees [sauces]; Fruit coulis [sauces]; Sambals; Sausage binding materials; Shrimp sauce; Oyster sauce; Kebab sauce; Herb sauces; Fish sauce; Sauces for chicken; Tomato sauce; Horseradish sauces; Cooking sauces; Sauces for ice cream; Korean soy sauce [ganjang]; Curry sauces; Savory sauces used as condiments; Sauces for barbecued meat; Vegetable pulps [sauces - food]; Sausage rolls; Fresh sausage rolls; Apple sauce [condiment]; Sauces for frozen fish; Dried sauce in powder form; Vegetable pastes [sauces]; Barbecue sauce; Food dressings [sauces]; Brown sauce; Hot sausage and ketchup in cut open bread rolls; Seasoned soy sauce (Chiyou); Sriracha hot chili sauce; Canned spaghetti in tomato sauce; Pickle relish; Hot chili pepper sauce; Hon-mirin-type flavouring sauce; Prepared foodstuffs in the form of sauces; Flavourings in the form of concentrated sauces; Flavourings in the form of dehydrated sauces; Sambal oelek (ground red pepper sauce); Mushroom sauces; Cranberry sauce [condiment]; Mayonnaise-based sauces; Food condiment consisting primarily of ketchup and salsa; Smoke distillates from wood for flavouring foodstuffs; Chocolate with alcohol; Sweets (Non-medicated -) being alcohol based; Seasonings; Vanilla flavourings for culinary purposes; Flavoured vinegar; Flavoured coffee; Flavoured rice; Flavouring syrups; Vanilla flavorings; Flavourings for soups; Flavourings of lemons; Flavourings of almond; Chocolate flavourings; Coffee flavourings; Flavorings and seasonings; Flavourings for beverages; Flavourings for butter; Flavourings for foods; Flavourings for cakes; Flavourings for cheeses; Edible salt; Crackers flavoured with meat; Crackers flavoured with fruit; Biscuits flavoured with fruit; Crackers flavoured with cheese; Crackers flavoured with herbs; Flavoured sugar confectionery; Chocolate flavoured coatings; Drinks flavoured with chocolate; Chocolate flavoured confectionery; Pavlovas made with*

hazelnuts; Seasoned salt for cooking; Crackers flavoured with spices; Aromatic preparations for candies; Aromatic preparations for cakes; Aromatic preparations for ice-creams; Aromatic preparations for pastries; Popcorn seasoning; Food flavourings, other than essential oils; Salts, seasonings, flavourings and condiments; Flavourings made from poultry; Flavourings made from fruits; Flavourings made from snails; Flavourings made from fish; Flavourings of tea; Crackers flavoured with vegetables; Fruit teas; Bread flavoured with spices; Ice creams flavoured with chocolate; Ice lollies being milk flavoured; Liquorice flavoured confectionery; Vegetable flavoured corn chips; Sweetmeats [candy] being flavoured with fruit; Aromatic preparations for food; Flavourings made from meat; Fruit flavourings, except essences; Flavourings made from lobsters; Flavourings made from pickles; Flavourings made from shrimps; Teas (Non-medicated -) flavoured with lemon; Biscuits containing chocolate flavoured ingredients; Mint flavoured sweets (Non-medicated -); Mint flavoured confectionery (Non-medicated -); Seaweed flavoured corn chips; Fruit flavoured tea [other than medicinal]; Non-medicated confectionery having a milk flavour; Chocolate flavoured beverage making preparations; Aromatic preparations for making non-medicated tisanes; Aromatic teas [other than for medicinal use]; Aromatic preparations for making non-medicated infusions; Fruit flavorings, other than essential oils; Lemon flavorings, other than essential oils; Flavourings, other than essential oils, for cakes; Flavourings for snack foods [other than essential oils]; Seasoned coating for meat, fish, poultry; Flavourings of lemons for food or beverages; Flavourings for soups [other than essential oils]; Bases for making milk shakes [flavourings]; Sweets (Non-medicated -) containing herbal flavourings; Chocolate confectionery having a praline flavour; Flavourings, other than essential oils, for beverages; Malt extracts used as flavoring; Extracts used as flavoring [not essential oils]; Almond flavorings, other than essential oils; Seasoned breading mix for deep frying; Chocolate drink preparations flavoured with mocha; Cereal snack foods flavoured with cheese; Tea-based beverages with fruit flavoring; Chocolate drink preparations flavoured with orange; Chocolate drink preparations flavoured with nuts; Chocolate drink preparations flavoured with mint; Apple flavoured tea [other than for medicinal use]; Chocolate drink preparations flavoured with banana; Shortbread part coated with a chocolate flavoured coating; Chocolate drink preparations flavoured with toffee; Fruit flavoured water ices in the form of lollipops; Orange flavoured tea [other than for medicinal use]; Herbal flavourings for making beverages; Flavourings made from vegetables [other than essential oils]; Processed ginseng used as a herb, spice or flavoring; Substances imparting smell for addition to drink [other than essential oils]; Savory food flavourings for animal foods [other than essential oils]; Flavourings of almond for food or beverages; Flavourings made from fruits [other than essential oils]; Extracts of coffee for use as flavours in foodstuffs; Extracts of cocoa for use as flavours in beverages; Extracts of coffee for use as flavours in beverages; Extracts of cocoa for use as flavours in foodstuffs; Processed seeds used as a flavoring for foods and beverages; Breakfast cereals flavoured with honey; Natural flavourings for use in ice cream [other than etheric essences or essential oils]; Ice cream; Edible ices; Confectionery ices; Ice cream stick bars; Ice cream confectionery; Ice cream mixes; Ice confectionery; Ice cream gateaux; Iced cakes; Soft ices; Jelly beans; Binding agents for ice cream; Powders for making ice cream; Fruit ices; Ices and ice; Ice cream desserts; Frosting mixes; Frozen lollipops; Ice cream with fruit; Ice creams containing chocolate; Cones for ice cream; Truffle ices; Sorbet mixes [ices]; Organic binding agents for ice cream; Mixtures for making ice cream confections; Edible fruit ices; Frozen confectionery containing ice cream; Sorbets [water ices]; Ice cream sandwiches; Fruit jellies [confectionery]; Non-dairy ice cream; Sugar for making jellies; Mixtures for making water ices; Ice cream cone mixes; Soya based ice cream products; Ice cream drinks; Dairy ice cream; Parfaits; Instant ice cream mixes; Coffee-based beverages containing ice cream (affogato); Non-medicated confectionery in jelly form; Ice milk bars; Soy-based ice cream substitute; Sherbets [confectionery]; Mixtures for making ice cream products; Boxed lunches consisting of rice, with added meat, fish or vegetables; Pre-packaged lunches consisting primarily of rice, and also including meat, fish or vegetables; Processed herbs; Preserved herbs; Dried herbs; Seaweed [condiment]; Herbal infusions; Marinades containing herbs; Infusions, not medicinal; Dried herbs for culinary purposes;

Herbal honey; Yerba mate; Herbal honey lozenges [confectionery]; Herbal preparations for making beverages; Coffee extracts; Tea extracts; Chocolate extracts; Spice extracts; Malt coffee extracts; Tea extracts (Non-medicated -); Malt extract for food; Yeast extracts for human consumption; Mixtures of malt coffee extracts with coffee; Chocolate extracts for the preparation of beverages; Tea (Non-medicated -) consisting of cranberry extracts; Cocoa extracts for human consumption; Chicory extracts for use as substitutes for coffee; Mixtures of coffee essences and coffee extracts; Coffee extracts for use as substitutes for coffee; Ice lollies; Fruit ice bars; Flavored ices; Snack food products consisting of cereal products; Cheese curls [snacks]; Extruded snacks containing maize; Rice cake snacks; Snack foods made from wheat; Snack foods made from corn; Tortilla snacks; Snacks manufactured from muesli; Rice-based snack food; Cereal-based snack food; Snack foods consisting principally of confectionery; Puffed corn snacks; Ready to eat savory snack foods made from maize meal formed by extrusion; Snack bars containing a mixture of grains, nuts and dried fruit [confectionery]; Snack food products made from rusk flour; Snack foods made from corn and in the form of rings; Snack food products made from potato flour; Snack foods consisting principally of extruded cereals; Snack food products made from rice flour; Snack food products made from cereal flour; Snack food products made from soya flour; Snack foods consisting principally of bread; Snack foods consisting principally of pasta; Flour based savory snacks; Snack foods made of whole wheat; Crispbread snacks; Wine vinegar; Confectionery having wine fillings; Aperitif biscuits.

Class 31: Garden herbs, fresh; Fresh flavoring leaves of Japanese pepper tree (Sansho); Grasses [plants]; Unprocessed herbs; Organic fresh herbs; Potted fresh herbs; Weeds for human consumption; Fresh wine grapes.

Class 32: Preparations for making liqueurs; Blackcurrant cordial; Sarsaparilla [non-alcoholic beverage]; Distilled drinking water; Alcohol free wine; Non-alcoholic beverages; Soft drinks; Low alcohol beer; Cocktails, non-alcoholic; Non-alcoholic preparations for making beverages; Syrups for making soft drinks; Non-alcoholic sparkling fruit juice drinks; Pale ale; Non-alcoholic fruit juice beverages; Flavoured waters; Flavored beers; Flavoured mineral water; Flavoured carbonated beverages; Coffee-flavored beer; Fruit flavoured waters; Fruit-flavoured beverages; Non-alcoholic flavored carbonated beverages; Fruit flavored soft drinks; Non-alcoholic beverages flavoured with tea; Non-alcoholic beer flavored beverages; Non-alcoholic beverages flavoured with coffee; Non-alcoholic soda beverages flavoured with tea; Syrups for making flavoured mineral waters; Fruit-based soft drinks flavored with tea; Essences for making flavoured mineral water [not in the nature of essential oils]; Part frozen slush drinks; Iced fruit beverages; Root beer; Extracts for making beverages; Non-alcoholic fruit extracts; Extracts of hops for making beer; Water-based beverages containing tea extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Aperitifs, non-alcoholic.

Class 33: Liqueurs; Anise [liqueur]; Bitters; Fermented spirit; Spirits and liquors; Cream liqueurs; Herb liqueurs; Extracts of spiritous liquors; Flavored tonic liquors; Ginseng liquor; Digesters [liqueurs and spirits]; Red ginseng liquor; Chinese brewed liquor (laojiou); Blackcurrant liqueur; Japanese white liquor (shochu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Japanese sweet rice-based mixed liquor (shiro-zake); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Japanese liquor flavored with pine needle extracts; Japanese liquor flavored with Japanese plum extracts; Tonic liquor containing herb extracts (homeishu); Aperitifs with a distilled alcoholic liquor base; Chinese mixed liquor (wujiapie-jiou); Hullless barley liquor; Chinese spirit of sorghum (gaolian-jiou); Japanese liquor containing herb extracts; Scotch whisky based liqueurs; Coffee-based liqueurs; Liquor-based aperitifs; Chinese white liquor (baiganr); Japanese regenerated liquors (naoshi); Spirits [beverages]; Distilled beverages; Korean distilled spirits (soju); Distilled spirits of rice (awamori); Sorghum-based Chinese spirits; Alcoholic punches; Shochu (spirits); Alcoholic jellies;

Prepared alcoholic cocktails; Alcoholic aperitif bitters; Alcoholic energy drinks; Fruit extracts, alcoholic; Alcoholic cocktails containing milk; Alcoholic cocktail mixes; Pre-mixed alcoholic beverages; Alcopops; Low-alcoholic wine; Low alcoholic drinks; Alcoholic carbonated beverages, except beer; Potable spirits; Alcoholic beverages of fruit; Alcoholic coffee-based beverage; Alcoholic tea-based beverage; Alcoholic fruit cocktail drinks; Preparations for making alcoholic beverages; Alcoholic beverages (except beer); Alcoholic preparations for making beverages; Alcoholic cocktails in the form of chilled gelatins; Nira [sugarcane-based alcoholic beverage]; Alcoholic extracts; Japanese sweet grape wine containing extracts of ginseng and cinchona bark; Vodka; Wine; Fortified wines; Mulled wines; Sparkling wines; Still wine; Rose wines; Sweet wines; Alcoholic wines; Cooking wine; Wine-based aperitifs; Sparkling red wines; Sparkling white wines; Fruit wine; Table wines; Dessert wines; Red wine; White wine; Grape wine; Strawberry wine; Blackberry wine; Beverages containing wine [spritzers]; Prepared wine cocktails; Korean traditional rice wine (makgeoli); Black raspberry wine (Bokbunjaju); Wine-based drinks; Aperitifs.

An interpretation of the wording of the list of goods is required to determine the scope of protection of these goods and services.

The term ‘including’, used in the applicant’s list of goods indicates that the specific goods are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (09/04/2003, T-224/01, Nu-Tride / TUFFTRIDE, EU:T:2003:107).

However, the term ‘namely’ used in the opponent’s list of goods to show the relationship of individual goods and services to a broader category, is exclusive and restricts the scope of protection only to the goods specifically listed.

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant *Canon* factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition or complementary.

Contested goods in Classes 29 and 31

None of the contested goods in Classes 29 or 31 have anything relevant in common with the opponent’s earlier *wines* in Class 33 such as to justify or warrant a finding of similarity. They have different purposes and methods of use, being neither in competition nor complementary in the sense of one being indispensable for the use of the other and usually having different and distinct producers, distribution channels and end consumers. Therefore, they must be held to be dissimilar.

Contested goods in Class 30

Vinegar in Class 30 and wine in Class 33 share a common nature, as both are liquid products which are made from grapes and vinegar is commonly obtained by acetous fermentation of wine. The goods also target the same public. These are, therefore, considered to be similar to a low degree (12/12/2014, T-405/13, da rosa, EU:T:2014:1072, § 105). It follows that the contested *flavoured vinegar; wine vinegar* are similar to a low degree to the opponent’s earlier *wines* in Class 33.

However, none of the remaining contested goods in Class 30 has anything relevant in common with the opponent's earlier wines in Class 33 such as to justify or warrant a finding of similarity. They have different purposes and methods of use, being neither in competition nor complementary in the sense of one being indispensable for the use of the other and usually having different and distinct producers, distribution channels and end consumers. Therefore, they must be held to be dissimilar.

Contested goods in Class 32

The contested *low alcohol beer; pale ale; flavored beers; coffee-flavored beer* are similar to the opponent's earlier wines in Class 33 as they usually coincide in relevant public, distribution channels and method of use. Furthermore they are in competition.

The contested *non-alcoholic beverages* is similar to the opponent's earlier wines in Class 33 as they usually coincide in producer, relevant public and distribution channels. Furthermore they are in competition.

The contested *alcohol free wine* is similar to the opponent's earlier wines in Class 33 as they usually coincide in producer, relevant public and distribution channels. Furthermore they are in competition.

However none of the remaining contested goods in Class 32 has anything relevant in common with the opponent's earlier wines in Class 33 such as to justify or warrant a finding of similarity. They have different purposes and methods of use, being neither in competition nor complementary in the sense of one being indispensable for the use of the other and usually having different and distinct producers, distribution channels and end consumers. Therefore, they must be held to be dissimilar.

Contested goods in Class 33

The contested *low-alcoholic wine; low alcoholic drinks; alcoholic beverages (except beer); japanese sweet grape wine containing extracts of ginseng and cinchona bark; wine; fortified wines; mulled wines; sparkling wines; still wine; rose wines; sweet wines; alcoholic wines; cooking wine; sparkling red wines; sparkling white wines; fruit wine; table wines; dessert wines; red wine; white wine; grape wine; strawberry wine; blackberry wine; korean traditional rice wine (makgeoli); black raspberry wine (bokbunjaju); wine-based drinks* are identically included or otherwise included within the opponent's earlier wines so that they are identical.

The contested *liqueurs; anise [liqueur]; bitters; fermented spirit; spirits and liquors; cream liqueurs; herb liqueurs; flavored tonic liquors; ginseng liquor; digesters [liqueurs and spirits]; red ginseng liquor; chinese brewed liquor (laojiou); blackcurrant liqueur; japanese white liquor (shochu); tonic liquor flavored with pine needle extracts (matsuba-zake); japanese sweet rice-based mixed liquor (shiro-zake); tonic liquor containing mamushi-snake extracts (mamushi-zake); tonic liquor flavored with japanese plum extracts (umeshu); japanese liquor flavored with pine needle extracts; japanese liquor flavored with japanese plum extracts; tonic liquor containing herb extracts (homeishu); aperitifs with a distilled alcoholic liquor base; chinese mixed liquor (wujiapie-jiou); hullless barley liquor; chinese spirit of sorghum (gaolian-jiou); japanese liquor containing herb extracts; scotch whisky based liqueurs; coffee-based liqueurs; liquor-based aperitifs; chinese white liquor (baiganr); japanese regenerated liquors (naoshi); spirits [beverages]; distilled beverages; korean distilled spirits (soju); distilled spirits of rice (awamori); sorghum-based chinese spirits; alcoholic punches; shochu (spirits); alcoholic jellies; prepared alcoholic cocktails; alcoholic aperitif bitters;; alcoholic cocktails containing milk; alcoholic cocktail mixes; pre-mixed alcoholic beverages; alcopops; alcoholic carbonated beverages, except beer; potable spirits; alcoholic beverages*

of fruit; alcoholic coffee-based beverage; alcoholic tea-based beverage; alcoholic fruit cocktail drinks; alcoholic cocktails in the form of chilled gelatins; nira [sugarcane-based alcoholic beverage]; vodka; wine-based aperitifs; beverages containing wine [spritzers]; prepared wine cocktails; aperitifs are similar to the opponent's earlier wines as they have the same nature. They usually coincide in relevant public, distribution channels and method of use. Furthermore they are in competition.

The contested *alcoholic energy drinks*; are similar to the opponent's earlier wines as they have the same nature. They usually coincide in relevant public, distribution channels and method of use.

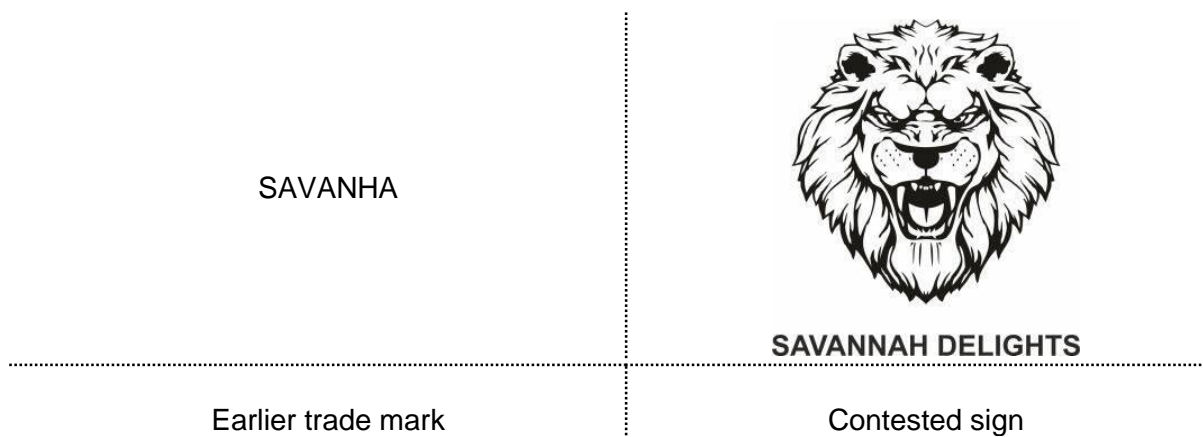
However, the contested *extracts of spiritous liquors; fruit extracts, alcoholic; preparations for making alcoholic beverages; alcoholic preparations for making beverages; alcoholic extracts* do not have anything relevant in common with the opponent's earlier wines in Class 33 such as to justify or warrant a finding of similarity. They have different purposes and methods of use, being neither in competition nor complementary in the sense of one being indispensable for the use of the other and usually having different and distinct producers, distribution channels and end consumers. Therefore, they must be held to be dissimilar.

b) Relevant public — degree of attention

The average consumer of the category of products concerned is deemed to be reasonably well informed and reasonably observant and circumspect. It should also be borne in mind that the average consumer's degree of attention is likely to vary according to the category of goods or services in question.

In the present case, the goods found to be identical or similar to varying degrees target the public at large for which the degree of attention average.

c) The signs



The relevant territory is the European Union

The global appreciation of the visual, aural or conceptual similarity of the marks in question must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, Armafoam, EU:C:2008:511, § 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

The earlier mark consists of the word 'SAVANHA'. In English, the word 'SAVANNAH' (and its variant 'SAVANNA') - which is very closely similar thereto, including orthographically - denotes a large area of flat grassy land, usually in Africa (information extracted from Collins English Dictionary on 25/04/2023 at <https://www.collinsdictionary.com/dictionary/english/savannah>). This word is likely to be understood also across the European Union given the similarity thereof in other EU member state languages e.g. savane in French, sabana in Spanish, savana in Hungarian, Italian, Portuguese and Romanian, Savanne in German, savanne in Dutch, savanni in Finnish, sawanna in Polish.

Irrespective of the above mentioned meanings and spelling variants, as the word 'SAVANHA' bears no reference to the goods in question, it is normally distinctive of them.

To avoid multiple scenarios, and given that the word 'DELIGHTS' of the contested sign is non distinctive for the English-speaking public (as stated below) and as this finding renders the risk of confusion higher - as it diminishes the differences between the signs - the Opposition Division shall proceed with the assessment on the basis of the part of the English-speaking public in Ireland and Malta.

The contested sign consists of the virtually standard stylised words 'SAVANNAH DELIGHTS' above which is depicted the front-on face view of a roaring lion. For the public under analysis, the word 'DELIGHTS' is laudatory of the relevant goods, as it merely indicates that such goods are delicious, and so non distinctive thereof.

Given its position and relative size, the figurative element of the contested sign is clearly the dominant element thereof, in the sense of being visually outstanding. As this figurative element bears no direct reference to the relevant goods, it is normally distinctive thereof. In fact, the device of the lion will tend to reinforce the meaning of 'SAVANNAH' as referring to African grasslands for the public under analysis.

Consumers generally tend to focus on the beginning of a sign when they encounter a trade mark. This is because the public reads from left to right, which makes the part placed at the left of the sign (the initial part) the one that first catches the attention of the reader.

Visually, the signs coincide in the letter string 'SAVAN**', differing in the additional letter 'N' at sixth position of the word 'SAVANNAH' in the contested sign, coinciding also in the final two letters of the words 'SAVANHA' and 'SAVANNAH' of the signs respectively, albeit reversed, as well as differing in the word 'DELIGHTS' and the figurative element thereof.

For the public under analysis, the words 'SAVANHA' and 'SAVANNAH' of the earlier mark and contested sign respectively are so closely similar as to be regarded as effectively interchangeable thereby reducing the visual impact of the said letter differences/letter reversal.

This is so also given that in English both 'SAVANNAH' and 'SAVANNA' are considered variants of the same word/concept so that the analysed consumer may regard 'SAVANHA'

as merely another variant or not even notice that it is not the actual dictionary word in question.

Moreover, the impact of the additional laudatory word 'DELIGHTS' of the contested sign will be somewhat diminished.

Taking into account the dominance of the figurative element of the contested sign, the signs are considered visually similar to a below average degree.

Aurally, as the final letter of the word 'SAVANNAH' is not sounded, the signs almost coincide in the sound of the words 'SAVANHA' and 'SAVANNAH', differing in the sound of the additional word 'DELIGHTS' of the contested sign.

Taking into account the laudatory nature of the word 'DELIGHTS', the signs are considered to be aurally similar to at least an average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As the word 'DELIGHTS' is laudatory, its semantic impact is very weak. Moreover, the concept of the roaring lion bears at least some semantic link to the coinciding concept of African grasslands. For the public under analysis, therefore, as both signs will be perceived as referring to grasslands in Africa - due to the words 'SAVANHA'/'SAVANNAH' therein –are conceptually similar to an average degree.

d) Distinctiveness of the earlier mark

The distinctiveness of the earlier mark is one of the factors to be taken into account in the global assessment of likelihood of confusion.

The opponent did not explicitly claim that the earlier trade mark enjoys enhanced distinctiveness through use.

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 has no meaning for any of the goods in question from the perspective of the public in the relevant analysed territories. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

Evaluating likelihood of confusion implies some interdependence between the relevant factors and, in particular, a similarity between the marks and between the goods or services. Therefore, a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).

Likelihood of confusion covers situations where the consumer directly confuses the trade marks themselves, or where the consumer makes a connection between the conflicting signs and assumes that the goods/services covered are from the same or economically linked undertakings.

For the public under analysis, the signs have been found to be visually similar to a below average degree, aurally similar at least to an average degree, and conceptually similar to an average degree. The goods are partly identical, partly similar to varying degrees, and partly

dissimilar, the earlier mark has normal distinctive character and the degree of attention upon purchase is average.

Taking the relevant factors into consideration, the Opposition Division considers that the very strong similarities between the words 'SAVANHA' and 'SAVANNAH' (albeit not identical) of the earlier mark and contested sign respectively, are not outweighed by the differences due to the additional laudatory word 'DELIGHTS' of the contested sign and the figurative element of the roaring lion thereof. In that regard, although the said figurative element is the dominant element of the contested sign, it must be recalled that the concept conveyed thereby bears at least some semantic link with the meaning of the earlier mark.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion on the part of the public under analysis (i.e. on the part of the English speaking public in Ireland and Malta) and, therefore, the opposition is partly well founded on the basis of the opponent's European Union trade mark registration No 286 435 'SAVANAH'. As stated above in section c) of this decision, 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 or similar to those of the earlier trade mark including those found similar only to a low degree having due regard to the application of the principle of interdependence of factors, as has been referred to above.

The rest of the contested goods are dissimilar. As similarity of goods and services 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.

We turn then to the remaining grounds of opposition, for the purposes of the remaining contested goods.

REPUTATION — ARTICLE 8(5) EUTMR

In relation to Article 8(5) EUTMR, the opponent invoked the two EUTM registrations set out on page 1 above of this decision. However, as proof of use has been demonstrated only for EUTM registration No. 286 435 'SAVANAH' (word mark), the analysis of this ground can proceed only for this earlier mark.

According to Article 8(5) EUTMR, upon opposition by the proprietor of a registered earlier trade mark within the meaning of Article 8(2) EUTMR, the contested trade mark will not be registered where it is identical with, or similar to, an earlier trade mark, irrespective of whether the goods or services for which it is applied are identical with, similar to or not similar to those for which the earlier trade mark is registered, where, in the case of an earlier European Union trade mark, the trade mark has a reputation in the Union or, in the case of an earlier national trade mark, the trade mark has a reputation in the Member State concerned and where the use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

According to Article 95(1) EUTMR, in proceedings before it the Office will examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office will be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Article 7(1) EUTMDR, the Office will give the opposing party the opportunity to present the facts, evidence and arguments in support of its opposition or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Article 7(2)(f) EUTMDR, when the opposition is based on a mark with reputation within the meaning of Article 8(5) EUTMR, the opposing party must provide evidence showing, inter alia, that the mark has a reputation, as well as evidence or arguments showing that use without due cause of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

In the present case, the notice of opposition was not accompanied by any evidence of the alleged reputation of the earlier trade mark.

On 25/05/2020 the opponent was given two months, commencing after the continuation of the proceedings, to submit the abovementioned material. This time limit expired on 24/01/2022. However, the opponent did not file any evidence of use/reputation before the expiration of the said deadline.

According to Article 7(5) EUTMDR, the Office will not take into account written submissions or documents, or parts thereof, that have not been submitted, or that have not been translated into the language of the proceedings, within the time limit set by the Office.

According to Article 8(1) EUTMDR, if until expiry of the period referred to in Article 7(1) EUTMDR, the opposing party has not submitted any evidence, or where the evidence submitted is manifestly irrelevant or manifestly insufficient to meet the requirements of laid down in Article 7(2) EUTMDR, the opposition will be rejected as unfounded.

Article 8(1) EUTMDR is an essentially procedural provision and it is apparent from the wording of that provision that when no evidence with regard to the reputation of the earlier mark concerned is submitted within the time limit set by the Office, the opposition must be rejected as unfounded. It follows that the Office cannot take into account evidence submitted for the first time after the expiry of the time limit, namely the evidence of proof of use filed by the opponent on 24/08/2022.

Given that the abovementioned evidence of proof of use cannot be taken into account, the opponent has failed to establish that the trade mark on which the opposition is based has a reputation.

Given that one of the necessary requirements of Article 8(5) EUTMR is not met, the opposition must be rejected as unfounded insofar as these grounds are concerned.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE — ARTICLE 8(4) EUTMR

According to Article 8(4) EUTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for will not be registered where and to the extent that, pursuant to the Union legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the European Union trade mark, or the date of the priority claimed for the application for registration of the European Union trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a European Union trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights.

According to Article 95(1) EUTMR, in proceedings before it the Office will examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office will be restricted in this examination to the facts, evidence and arguments submitted by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Article 7(1) EUTMDR, the Office will give the opposing party the opportunity to present the facts, evidence and arguments in support of its opposition or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Article 7(2) EUTMDR, within the period referred to above, the opposing party must also file proof of the existence, validity and scope of protection of its earlier mark or earlier right, as well as evidence proving its entitlement to file the opposition.

In the present case, the notice of opposition was not accompanied by any evidence of use of the earlier sign in the course of trade.

On 25/05/2020 the opponent was given two months, commencing after the continuation of the proceedings, to submit the abovementioned material. This time limit expired on 24/01/2022. However, the opponent did not file any evidence of use/reputation/goodwill before the expiration of the said deadline.

According to Rule 19(4) EUTMIR (in the version in force at the time of commencement of the adversarial part), the Office will not take into account written submissions or documents, or parts thereof, that have not been submitted in or that have not been translated into the language of the proceedings, within the time limit set by the Office.

It follows that the Office cannot take into account evidence submitted for the first time after the expiry of the time limit, namely the evidence of proof of use filed by the opponent on 24/08/2022.

Given that the abovementioned evidence cannot be taken into account, the opponent has failed to establish use in the course of trade of the sign in Ireland, on which the opposition is based.

Given that one of the necessary requirements of Article 8(4) EUTMR is not met, the opposition must be rejected as unfounded insofar as this ground is concerned.

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 109(3) EUTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division will decide a different apportionment of costs.

Since the opposition is successful for only some of the contested goods both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

Holger Peter KUNZ

Kieran HENEGHAN

Christin STEUDTNER

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.