

OPPOSITION No B 3 159 459

Havana Club Holding S.A., 5 Place de la Gare, 1616 Luxembourg, Luxembourg (opponent), represented by **Berenguer y Pomares Abogados**, Avenida Ramón y Cajal 1, Entresuelo, 03001 Alicante, Spain (professional representative)

a g a i n s t

No.1 Capital AB, Järnvägsgatan 11, 65225 Karlstad, Sweden (applicant).

On 19/02/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 159 459 is upheld for all the contested goods.
2. European Union trade mark application No 18 544 286 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 02/12/2021, the opponent filed an opposition against all the goods (Class 33) of European Union trade mark application No 18 544 286 'HAVÄN' (word mark). The opposition is based on, inter alia, European Union trade mark registration No 5 414 917 'HAVANA CLUB' (word mark). The opponent invoked, inter alia, Article 8(1)(b) EUTMR.

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 public. 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 European Union trade mark registration No 5 414 917.

a) The goods

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

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

The contested goods are the following:

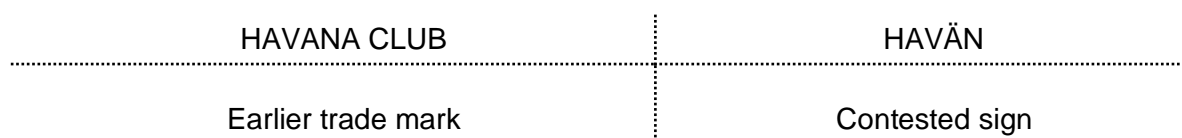
Class 33: *Alcoholic beverages (except beer); Cider*.

The contested goods are identical to the opponent's *alcoholic beverages (except beers)*, either because they are identically contained in both lists, or because the earlier goods include the contested goods.

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 target the public at large whose degree of attention is considered to be average.

c) The signs



The relevant territory is the European Union. The global appreciation of the visual, aural or conceptual similarity of the signs must be based on their overall impression, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, § 23).

The terms 'HAVANA' and 'CLUB' of the earlier mark are basic English words referring to the 'name of the capital and the largest city of Cuba' and 'an association dedicated to a particular interest or activity, for example, entertainment'. As both words are internationally widespread and commonly used, and their equivalents in other EU languages are very similar, both elements will be perceived with the above meaning by the vast majority of the relevant public. Bearing in mind that Cuba is known for the production of rum, that Havana is the country's main commercial center and that the relevant goods are alcoholic beverages, the inherent distinctiveness of the earlier mark is less than normal as its elements allude to the geographical origin of the goods and their place of consumption.

The contested sign's term 'HAVÄN' of the has no clear and specific meaning for the relevant public, that can be grasped immediately, and is, therefore, distinctive. Whilst the letter 'Ä' contained in the contested sign is part of the alphabet and has a specific pronunciation in parts of the relevant territory, for example in Germany or Sweden, knowledge of its correct pronunciation in other parts of the territory cannot be assumed (13/09/2020, T-292/08, OFTEN, § 83), and the letter 'Ä' will, therefore, be pronounced as the letter 'A' in most parts of the relevant territory, for example in French or Spanish. Having regard to the specific pronunciation of the contested sign in parts of the relevant territory, and that a likelihood of confusion for only part of the public of the European Union is sufficient to reject a contested application (18/09/2008, C-514/06 P, Armafoam, § 57), even for a non-negligible part of relevant consumers (04/7/2014, T-1/13, GLAMOUR.), it is appropriate to focus the comparison of the signs on the Spanish-speaking part of the public.

Conceptually, although the public will perceive the meaning of the earlier mark as explained above, the contested sign has no clear meaning in the territory under examination. Since one of the signs will not be associated with any meaning, the signs are conceptually not similar. However, the conceptual difference are less relevant, as the earlier mark alludes to certain characteristics of the goods at issue. **Visually** and **aurally**, the signs coincide in the letters 'HAV(*)N(*)' and their pronunciation, and the letters 'A' and 'Ä' at the beginning of the second syllable of the signs are pronounced identically by the public under examination. Moreover, these letters are also visually similar to a high degree as they can only be distinguished by the existence of two dots. The signs differ in the letter 'A' at the end of the earlier mark's first verbal element 'HAVANA' and in the term 'CLUB' at the end of the contested sign. However, the coincidence in 'HAV(*)N' is immediately perceptible and the pronunciation of 'HAVANA' and 'HAVÄN' only differs in one single letter 'A'. From a phonetic point of view, account is also taken of the fact that the public usually omits verbal elements that are less prominent (11/01/2013, T-568/11, interdit de me gronder IDMG, § 44). In the present case, at least a

non-negligible part the public under examination will most likely also not pronounce the term 'CLUB' of the earlier mark due to economy of language, particularly when taking into account that the goods at issue are predominantly ordered orally. Taking all this into account, the signs are, therefore, visually similar to an average degree and aurally similar to above average degree for at least part of the public under analysis. As there are similar aspects, the examination of likelihood of confusion will proceed.

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. According to the opponent, the earlier mark has been extensively used and enjoys an enhanced scope of protection. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment'). Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. Considering what has been stated above in section c) of this decision, the distinctiveness of the earlier mark must be seen as less than normal.

e) Global assessment, other arguments and conclusion

According to the Court, likelihood of confusion must be appreciated globally, taking into account all the factors relevant to the circumstances of the case; this appreciation depends on numerous elements and, in particular, on the degree of recognition of the mark on the market, the association that the public might make between the two marks and the degree of similarity between the signs and the goods (11/11/1997, C-251/95, Sabèl, § 22).

The Court has further stated that, when evaluating the importance attached to the degree of visual, aural and conceptual similarity between the signs, it is appropriate to take into account the category of goods and the way they are marketed (22/06/1999, C-342/97, Lloyd Schuhfabrik, § 27). Accordingly, the category of goods involved may increase the importance of one of the different aspects of similarity because of how the goods are ordered. Therefore, a visual or conceptual aspect may be less important in case of goods that are usually examined aurally.

Evaluating likelihood of confusion further implies some interdependence between the factors and, in particular, a similarity of the marks and of the goods. Therefore, a lesser degree of similarity between goods may be offset by a greater degree of similarity between the marks and vice versa (29/09/1998, C-39/97, Canon, § 17). Likelihood of confusion covers situations where the public directly confuses the marks themselves, or where it makes a connection between the conflicting signs and assumes that the goods covered are from the same or economically linked undertakings.

As set out above, the signs are visually similar to an average degree, aurally similar to above average degree for at least a part of the public under analysis and conceptually not similar. The goods have been found to be identical and they are directed at the public at large whose degree of attention is average. It is true that the visual similarity of the signs is not particularly high and they are conceptually not similar. However, the conceptual difference is less relevant as it stems from weak elements. Moreover, the relevant goods are beverages, and since these are frequently ordered in noisy establishments (bars, nightclubs), the phonetic similarity of the signs is particularly relevant (15/01/2003, T-99/01, Mystery, § 48).

In the present case, the first five letters of the earlier mark's term 'HAVAN(A)' and the sole element of the contested sign, namely the term 'HAVÄN', are pronounced identically by the relevant public under examination. At least from a phonetic point of view, the contested sign is, moreover, identically reproduced at the beginning of the earlier mark, and the overlap in the identical letters '*AV(*)N' as well as the high degree of visual similarity between the differing letters 'A' and 'Ä' are visually immediately perceptible.

It is true that the distinctiveness of the earlier mark is considered to be less than normal. However, this cannot call into question the finding of the likelihood of confusion. Although the distinctive character of the earlier mark must be taken into account in assessing the likelihood of confusion, it is only one factor among others involved in that assessment. Consequently, even in a case involving an earlier mark with a weak distinctive character, there may be a likelihood of confusion on account, in particular, of a similarity of the signs and the services (13/12/2007, T-134/06, PAGESJAUNES.COM, § 70). In the present case, the goods are identical, and the overall impression of the marks is similar due to the coincide in the identical letters 'HAV(*)N' at the beginnings of the signs which catches the consumer's attention first (15/12/2009, T-412/08, Trubion, § 40; 25/03/2009, T-109/07, Spa Therapy, § 30). Moreover, the beginning of the earlier mark is aurally identical to the sole verbal element of the contested sign, which is particularly relevant for the relevant goods as these are often ordered aurally. The differences of the signs do, therefore, not allow to safely distinguish them and are consequently not sufficient to exclude the risk that public may believe that the identical goods come from the same or economically-linked undertaking.

Considering all the above, there is a likelihood of confusion at least on a non-negligible part of the Spanish-speaking public. 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. Therefore, the opposition is well founded on the basis of the opponent's European Union trade mark registration No 5 414 917, and it follows that the contested trade mark must be rejected for all the contested goods. Since the opposition is successful on the basis of the inherent distinctiveness of the earlier mark, there is no need to assess the opponent's claim of enhanced degree of distinctiveness. The result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness. As European Union trade mark registration No 5 414 917 leads to the success of the opposition and to the rejection of the contested trade mark for all the goods against which the opposition was directed, there is also no need to examine the other earlier rights and ground invoked (16/09/2004, T-342/02, Moser Grupo Media, S.L.).

COSTS

According to Article 109(1) EUTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. Since the applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings. According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the opponent are the opposition fee and the costs of representation, which are to be fixed on the basis of the maximum rate set therein.



The Opposition Division

Sandra Theódóra
ÁRNADÓTTIR

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Teresa
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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.