

OPPOSITION No B 3 160 962

Van Pur S.A., Rakszawa 334, 37-111 Rakszawa, Poland (opponent), represented by **Kancelaria Patentowa Dr W. Tabor Sp.J.**, Ul. Mazowiecka 28a/8-9, 30-019 Kraków, Poland (professional representative)

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SC Certinvest Srl, Str. Teatrului No. 5, Ap. 2, 410020 Oradea, Romania (applicant), represented by **Răzvan Dincă**, Str. Popa Tatu, Nr. 49, 1st District, 010803 București, Romania (professional representative).

On 04/09/2023, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 160 962 is upheld for all the contested goods.
2. European Union trade mark application No 18 538 245 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 23/12/2021, the opponent filed an opposition against all the goods of European Union



trade mark application No 18 538 245 (figurative mark). The opposition is based on Polish trade mark registration No R 280 489 'KARPACKIE' (word mark) for which the opponent invoked Article 8(1)(b) and Article 8(5) EUTMR, and on a non-registered trade mark used in the course of trade in Poland, for which the opponent invoked Article 8(4) EUTMR.

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 trade mark on which the opposition is based, namely Polish trade mark registration No R 280 489 'KARPACKIE' (word mark).

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

The date of filing of the contested application is 25/08/2021. The opponent was therefore required to prove that the trade mark on which the opposition is based was put to genuine use in Poland from 25/08/2016 to 24/08/2021 inclusive.

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

Class 32: *Beer*.

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 08/09/2022, in accordance with Article 10(2) EUTMDR, the Office gave the opponent until 13/11/2022 to submit evidence of use of the earlier trade mark. On 25/10/2022, within the time limit, the opponent submitted evidence of use. On 29/05/2022, for the purpose of showing, inter alia, the reputation of its earlier mark, the opponent submitted evidence. In the light of Article 10(2) EUTMDR, any evidence that has been submitted by the opponent at any time during the proceedings before the expiry of the time limit for providing proof of use has to be automatically taken into account when assessing proof of use. It follows that in the present case, the evidence submitted on 29/05/2022 must be taken into account for the purposes of assessing whether the earlier mark has been genuinely used and whether it has acquired reputation.

On 29/05/2022 and 25/10/2022, within the time limit, the opponent submitted evidence to support this claim. As the opponent requested that certain commercial data contained in the evidence be kept confidential vis-à-vis third parties, the Opposition Division will describe the evidence only in the most general terms without divulging any such data. However, this does not apply where the evidence is clearly publicly available (e.g. online material, promotional materials). The Opposition Division will take this into consideration below.

Evidence submitted on 29/05/2022

The evidence submitted on 29/05/2022 consists of the following documents.

In its observations, the following was, inter alia, mentioned:

The company VAN PUR SA (the Opponent) is the largest independent brewing company in Poland and one of the four main players on the Polish beer market. The Opponent possesses 6 breweries, each one with its own history and character, and the beers brewed there draw strongly on the diverse traditions of their respective regions. The Opponent acts since 1989.

The Opponent acts in markets such as: beers, radlers, as well as flavored and alcohol-free beers. The opponent possesses its own packaging production lines. The Opponent widely acts not only in Poland. The company VAN PUR SA currently collaborates with partners in 75 countries all around the world. The Opponent possesses an office in London and also representative offices in Chile, Brazil, Israel, Russia and the Balkans. The opponent has also provided a table which presents the amount of beer offered under the earlier brand 'KARPACKIE' from 2018-2021 showing a significant amount in hectoliters.

The beer 'KARPACKIE' was widely distributed in Poland, the scale is very important (showing a significant amount of hectoliters sold between 2018-2021).

The opponent also indicated the following in its observations:

- 1) Karpackie Mocne – a significant amount of hectolitres were offered:



- 2) Karpackie Pils – a significant amount of hectolitres were offered:



- 3) Karpackie Premium – a significant amount of hectolitres were offered:



- 4) Karpackie Super Mocne – a significant amount of hectolitres were offered:



Annex 1: printouts from the website www.vanpur.com.pl, extracted on 29/05/2022, and with a presentation of the opponent's company, such as its company profile, its history, types of custom-brewed products and packaging formats. There are several pictures displaying bottles/cans/trays of beer, for instance:

	<p>KARPACKIE PILS</p> <p>ALC. 4%</p> <p>Those who prefer a gentle bitterness and subtle heavy steam will find it in Karpackie Pils.</p>	<p>KARPACKIE STRONG</p> <p>ALC. 7%</p> <p>A beer with a strong character, a distinct bitterness and a deep, dark-golden colour. Its clear flavour and its slightly higher alcohol content make it an ideal strong beer, whose qualities will surely be appreciated by seasoned beer enthusiasts.</p>	
<p>KARPACKIE PREMIUM</p> <p>ALC. 5%</p> <p>Full of character and perfectly balanced. The original recipe from the 1990s is based on a balanced combination of ingredients providing flavour qualities for the beer that will allow everyone to enjoy its simplicity.</p>			<p>KARPACKIE SUPER STRONG</p> <p>ALC. 9%</p> <p>The most demanding beer amateurs will appreciate Karpackie 9%, it has a strong flavour, a full satisfying taste and a high alcohol content.</p>



Annex 2: a list of points of sale (301) in Poland where the trade mark 'KARPACKIE' beers are offered. At the top of the list the year 2021 is mentioned.

Annex 3: promotional instore newsletters in Polish from several supermarkets located in Poland, dated 20/04/2020-03/05/2020, 23/08/2021-05/09/2021, 29/11/2021-12/12/2021, 31/05/2021-13/06/2021, 01/02/2022-28/02/2022, 01/04/2021-30/04/2021, 01/04/2021-30/04/2021, 07/06/2021-12/06/2021, 17/03/2020-30/03/2020, 22/02/2022-07/03/2022, 22/02/2022-07/03/2022, 24/08/2021-06/09/2021, 01/04/2020-30/04/2020, 01/04/2020-11/04/2020, 01/06/2020-14/06/2020, 21/11/2019-27/11/2019, 26/03/2020-01/04/2020, 01/03/2021-02/04/2021, 01/09/2021-30/09/2021, 01/10/2019-31/10/2019, 14/10/2019-27/10/2019, 01/03/2021-31/03/2021, 01/10/2019-31/10/2019,

04/05/2021-31/05/2021, 09/03/2020-21/03/2020, 07/03/2021-03/04/2021, 02/02/2021-13/02/2021, 16/03/2021-22/03/2021, 12/11/2019-16/11/2019, 10/05/2021-22/05/2021, displaying pictures of cans/bottles of beer, such as the ones mentioned above, with the trade mark 'KARPACKIE' and their price in PLN.

Annex 4: a signed statement, dated 23/03/2022, in which it was indicated that the opponent has invested, between 2018 and 2022, a significant amount of PLN in marketing expenditure for the 'KARPACKIE' brand and another significant amount of PLN in marketing expenditure for its 11 different brands, including 'KARPACKIE'. In its observations, the opponent mentioned that:

[a]ccording to this statement, the Opponent undertook many advertising actions in order to promote the brand – these activities were undertaken to build-up a brand image and enhance trade mark awareness among the public. The brand was visible in all marketing areas – TV, RADIO, PRESS, SOCIAL MEDIA etc. The Opponent is very involved in sport activities – the trade mark KARPACKIE is visible in sports events in Poland. As an example of sponsoring activities, hereunder please photos of the race in Rzeszów.

–KARPACKIE - 18th race in Rzeszów (AUGUST 2009) where took place a round of the Polish car race championship and a round of the Rally Automobile Cup of the Polish Motor Association. Also for the first time, thanks to the cooperation with Auto Klub Kosice from Slovakia, the Rally obtained the status of the 5th and 6th Round of the Slovak Rally Championship. 33 crews in the RSMP, 83 in the Polish Cup and 37 in the Slovak championship competed in the rally fight on the well-known and interesting routes of Podkarpacie. A big attraction of the Rally was the 'Brewery' Special Stage. Its route led through the production plant of the Van Pur company - the General Sponsor of the Rally and the producer of KARPACKIE beer. The drivers drove successively past all the buildings where beer is produced.

Annex 5: printouts from websites and photographs of the above event. The opponent also organised many lottery games to increase the trade mark visibility in Poland. Furthermore, the opponent also cited the cooperation with the Faculty of Chemistry in Rzeszów under which the students visited the Van Pur Brewery in Rakszawa. It is here that a significant amount of hectolitres of beer are produced annually. This brewery produced the leading brand – 'KARPACKIE' beer. The production manager presented the characteristics of the beer market in Poland, characterised the basic raw materials, and discussed the processes taking place at individual stages of beer production. Students saw the brewhouse, fermentation, and beverage filtration departments, learned about the technology, devices, and how to control the process.

Annex 6: printouts from the website of the Faculty of Chemistry in Rzeszów (in Polish).

Evidence submitted on 25/10/2022

Annex 1: promotional instore newsletters in Polish from several supermarkets located in Poland (the same ones as those in Annex 3 above).

Annex 2: approximately 20 invoices from the opponent to several clients in, for instance, Germany, Hungary, the Netherlands, Poland and the UK, and some to countries outside of the EU, such as Costa Rica, Morocco, Taiwan and Uruguay, dated between February 2018 and 2021. The invoices mention several beer products under the trade mark 'KARPACKIE' for a substantial amount of units, the number of which, for reasons of confidentiality, cannot be revealed. There are eight invoices to clients in Poland (located in Bielsko-Bioła Tarnowo Podgórne, Warszawa and Komorniki), which are dated 22/11/2021, 06/02/2018, 13/11/2018, 03/02/2020, 15/04/2020, 10/07/2018, 25/09/2019 and 28/04/2018, also for a significant volume of beer.

Applicant's arguments regarding the proof of use

The applicant argues that it cannot be proven that the catalogues were actually put on the market in the relevant territory, that a considerable number of excerpts were dated outside of the relevant period and, with respect to the invoices, that the opponent did not prove a sufficient number of sales relating to products bearing the opponent's trade mark, because the invoices depict an insignificant number of products sold.

However, the requirements for proof of use are cumulative (05/10/2010, T-92/09, STRATEGI / Stratégies, EU:T:2010:424, § 43). This means that the opponent is obliged not only to indicate, but also to prove each of these requirements. However, the sufficiency of the indication and proof as to the place, time, extent and nature of use has to be considered in view of the entirety of the evidence submitted. A separate assessment of the various relevant factors, each considered in isolation, is not suitable (17/02/2011, T-324/09, Friboi, EU:T:2011:47, § 31). Therefore, the Office evaluates the evidence submitted in an overall assessment. All the circumstances of the specific case have to be taken into account and all the materials submitted must be assessed in conjunction with each other. Therefore, although items of evidence may be insufficient by themselves to prove the use of an earlier trade mark, they may contribute to proving use in combination with other documentation and information. Even if some relevant factors are lacking in some items of evidence, the combination of all the relevant factors in all the items of evidence may still indicate genuine use.

For these reasons, the Opposition Division finds that, taking all the evidence together, it is sufficient to prove use of the earlier mark, as will be explained in more detail below.

Regarding the argument that a considerable number of items were dated outside of the relevant period, 22 out of 30 instore newsletters (29/05/2022, Annex 3 and 25/10/2022, Annex 1) were dated inside the relevant period. Similarly, for the invoices, seven of the eight invoices to customers in Poland are dated within the relevant period (25/10/2022, Annex 2). Furthermore, the invoices do not have consecutive numbering, therefore, it can be inferred that they represent a sample selection and not the total sales under the mark at issue in relation to the relevant goods. Although the applicant argues that it cannot be proved that the catalogues (probably meaning the instore newsletters) were actually put on the market in the relevant territory, since the invoices show a significant amount of sales in litres/volumes, it is likely that the opponent has offered its products for sale in one way or another, otherwise there would be no sales at all.

The applicant argues that, according to the provisions of Article 55 EUTMDR, the pages of the evidence filed as proof of use must be numbered, in order to facilitate the analysis of its legitimacy and accuracy. However, the numbering of pages serves to control the evidence filed, but if from the index and observations it is clear what the opponent refers to and different parts of the evidence can be clearly identified, as is the case here, this argument should be set aside.

As will be explained in more detail below, the Opposition Division does not agree with the applicant's arguments, and these must be set aside.

Assessment of the evidence of proof of use

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).

The indications and evidence required in order to provide proof of use must consist of indications concerning the place, time, extent and nature of use of the trade mark for the relevant goods and/or services.

It is up to the opposing party to select the form of evidence that it considers suitable for the purpose of establishing that the earlier trade mark was put to genuine use during the relevant period (08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 37). The evidence submitted as proof of use can include documents such as invoices, price lists, affidavits, catalogues, surveys, turnover and sales figures, press cuttings, samples of goods/packaging, advertisements, offers made to potential clients and other documents confirming that the mark has been genuinely used on the market. The final outcome depends on the overall assessment of the evidence.

The use of the earlier mark must be established to the satisfaction of the Office and not merely assumed. Therefore, the evidence must be clear and convincing, in the sense that the opponent must clearly establish all the facts necessary to safely conclude that the mark has been used.

The purpose of Article 47(2) and (3) EUTMR is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade mark protection to only large-scale commercial use of the marks (08/07/2004, T-334/01, Hipoviton / HIPPOVIT, EU:T:2004:223, § 32; 08/07/2004, T-203/02, Vitafruit, EU:T:2004:225, § 38).

As far as the statement and other evidence originating from the opponent are concerned, Article 10(4) EUTMDR expressly mentions written statements referred to in Article 97(1)(f) EUTMR as admissible means of evidence. Article 97(1)(f) EUTMR lists means of giving evidence, amongst which are sworn or affirmed written statements or other statements that have a similar effect according to the law of the State in which they have been drawn up. This kind of evidence drawn up by the interested parties themselves or their employees is generally given less weight than independent evidence. This is because the perception of the party involved in the dispute may be more or less affected by its personal interests in the matter. However, this does not mean that such statements do not have any probative value at all. The final outcome depends on the

overall assessment of the evidence in the particular case. This is because, in general, further evidence is necessary to establish use, reputation or enhanced distinctiveness, since such statements or more subjective evidence have to be considered as having less probative value than physical evidence (labels, packaging, etc.) or evidence originating from independent sources. Bearing in mind the foregoing, it is necessary to assess the remaining evidence to see whether or not the statement from the opponent is supported by the other items of evidence, which, indeed, is the case here.

Taking into account the evidence in its entirety, the evidence submitted by the opponent is sufficient to prove genuine use of the earlier trade mark during the relevant period in the relevant territory for the goods on which the opposition is based, which will be described in more detail below.

Place of use

The evidence shows that the place of use is mainly Poland, as can be seen from the opponent's website domain-name-ending '.pl' (29/05/2022, Annex 1), the addresses on some of the invoices in Poland (Bielsko-Biała Tarnowo Podgórne, Warszawa and Komorniki) (25/10/2022, Annex 2), a table with a significant total amount of hectolitres distributed between 2018 and 2021 (from the opponent in its observations of 29/05/2022), points of sale in Poland (29/05/2022, Annex 2), instore promotional newsletters in Polish supermarkets with their price in PLN (29/05/2022, Annex 3), and a signed statement with marketing figures in PLN (29/05/2022, Annex 4). Furthermore, this can also be inferred from the language used in all the aforementioned Annexes. In addition, there are also some collaborations or sponsorships of several events in Poland (29/05/2022, Annex 4).

Therefore, use has been proved for the earlier mark, at least in Poland.

Time of use

The opponent was required to prove that the earlier mark on which the opposition is based was put to genuine use from 25/08/2016 to 24/08/2021 inclusive. Most of the documents provided are dated during the relevant period. Therefore, the evidence of use filed by the opponent contains sufficient indications concerning the time of use, especially since the opponent has submitted invoices (2018-2021) (25/10/2022, Annex 2), tables, one with distribution figures of litres of beer (2018-2021) and one with the marketing expenditure (2018-2022) (from the opponent in its observations of 29/05/2022 and 29/05/2022, Annex 4), promotional instore newsletters (dated 2019-2022) (29/05/2022, Annex 3), points of sale (2021) (29/05/2022, Annex 2), covering at least a period from 2018 to 2021, and the use is quite evenly spread over this period.

Although some evidence, such as the excerpt, extracted on 29/05/2022, from the opponent's company website (29/05/2022, Annex 1) and one invoice, dated 22/11/2021 (25/10/2022, Annex 2), refers to use made outside the relevant timeframe or is dated outside the relevant period, this is in general immaterial, unless it constitutes conclusive indirect proof that the mark must have also been put to genuine use during the relevant period. Circumstances subsequent to the relevant point of time may make it possible to confirm or better assess the extent to which the trade mark was used during the relevant period and the real intentions of the proprietor during that time (27/01/2004, C-259/02, *Laboratoire de la mer*, EU:C:2004:50, § 31). All the evidence outside of the relevant time period is, therefore, also useful, as it is close to the time of the relevant period, and

moreover, it shows use afterwards or before, meaning for example that the trade mark is still being used.

Extent of use

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 evidence submitted, such as the few invoices, accompanied by the extracts of the instore newsletters, excerpts from the opponent's website, the information in the opponent's signed statement, and the points of sale of the opponent's products, provide the Opposition Division with sufficient information concerning the commercial volume, the territorial scope, the duration, and the frequency of use. Although some of the invoices do not contain significant quantities of the items sold, use of the mark need not be quantitatively significant for it to be deemed genuine. The invoices show a certain frequency of sales during the relevant period in the relevant territory. Moreover, the invoices do not have consecutive numbering, therefore, it can be inferred that they represent only a sample selection and not the total sales under the mark at issue in relation to the relevant goods.

All the evidence provides the Opposition Division with sufficient information concerning the commercial volume, territorial scope, duration, and frequency of use, and give sufficient indications concerning the extent of use of the earlier mark.

Nature of use

Article 18(1), second subparagraph, point (a) EUTMR mentions that use of the mark in a form different from the one registered still constitutes use of the trade mark, as long as it does not alter the distinctive character of the trade mark. This means that differences between the form in which the mark is used on the market and the registered form are acceptable as long as the distinctive character of the mark is not altered. The purpose of this provision is to allow its proprietor to make variations in the sign that, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned (23/02/2006, T-194/03, *Bainbridge (fig.) / Bridge et al.*, EU:T:2006:65, § 50). Furthermore, additions do not, per se, alter the distinctive character of a mark. Indeed, if the addition is not distinctive or dominant and/or is weak, it does not alter the distinctive character of the registered trade mark (30/11/2009, T-353/07, *Coloris*, EU:T:2009:475, § 29-33; 10/06/2010, T-482/08, *Atlas Transport*, EU:T:2010:229, § 36). However, the addition of a figurative element can alter the distinctive character of a mark if this figurative element is not seen as a mere decorative element but is dominant and distinctive in the overall impression of the mark.

In the present case, the earlier mark, 'KARPACKIE', is a word mark and, in addition to appearing in the evidence as a word mark, for instance in the invoices, in the instore

newsletters or the opponent's website, it also appears several times as a figurative sign, for example:



The cans or bottles are very typical with all kinds of additional verbal and figurative elements, such as the wording '9%', 'pils', 'premium', all at best weak elements, which indicate, for example, the alcohol percentage, the nature of the goods and their quality, with in the middle, in a dominant position, the word 'KARPACKIE', depicted in a slightly stylised typeface in white, against a banderole in green, black or red. However, the alterations are confined to the slight stylisation and/or different colours of the script. All these aspects do not constitute an alteration to the distinctive character of the word mark 'KARPACKIE'.

Taken as a whole, the evidence submitted is sufficient to prove use of the mark on which the opposition is based in a form that does not alter its distinctive character.

In the evidence, the opponent has made reference to the sales of all kinds of cans/bottles/trays of beers and, therefore, the opponent has proven use for the goods on which the opposition is based, namely *beer* in Class 32.

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

Pursuant to 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 proven, are the following:

Class 32: *Beer.*

The contested goods are the following:

Class 32: *Beer and brewery products; flavoured carbonated beverages; juices; nut and soy based beverages; waters; alcohol free wine; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beverages containing vitamins; birch water; brown rice beverages other than milk substitutes; carbohydrate drinks; cider, non-alcoholic; cocktails, non-alcoholic; douzhi (fermented bean drink); energy drinks; frozen carbonated beverages; fruit-based soft drinks flavored with tea; green vegetable juice beverages; guarana drinks; isotonic beverages; lemon barley water; isotonic beverages [not for medical purposes]; protein-enriched sports beverages; protein drinks; part frozen slush drinks; orange barley water; oat-based beverages [not being milk substitutes]; nutritionally fortified beverages; non-carbonated soft drinks; non-alcoholic sparkling fruit juice drinks; non-alcoholic rice punch (sikhye); non-alcoholic punch; non-alcoholic malt free beverages [other than for medical use]; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic fruit punch; non-alcoholic fruit cocktails; non-alcoholic drinks enriched with vitamins and mineral salts; non-alcoholic dried fruit beverages; non-alcoholic cocktail bases; non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); maple water; mung bean beverages; non-alcoholic beverages containing vegetable juices; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; non-alcoholic beverages containing fruit juices; whey beverages; vitamin fortified non-alcoholic beverages; vitamin enriched sparkling water [beverages]; sports drinks containing electrolytes; sports drinks; sorbets in the nature of beverages; soft drinks; smoothies; smoked plum beverages; sherbets [beverages]; sarsaparilla [non-alcoholic beverage]; rice-based beverages, other than milk substitutes; ramune (Japanese soda pops); quinine water; pastilles for effervescing beverages; orgeat; orange squash; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic essences for making beverages; mixes for making sorbet beverages; malt wort; malt syrup for beverages; lime juice for use in the preparation of beverages; lime juice cordial; blackcurrant cordial; concentrates for making fruit drinks; concentrates for use in the preparation of soft drinks; cordials; dilutable preparations for making beverages; essences for making beverages; essences for making flavoured mineral water [not in the nature of essential oils]; extracts for making beverages; extracts of hops for making beer; extracts of unfermented must; grape must, unfermented; hop extracts for use in the preparation of beverages; lemon juice for use in the preparation of beverages; lemon squash; unfermented preserved must; syrups for making whey-based beverages; syrups for making soft drinks; syrups for making non-alcoholic beverages; syrups for making fruit-flavored drinks; syrups for making flavoured mineral waters; syrups for making beverages; syrups for lemonade; syrups for beverages; syrups and other non-alcoholic preparations for making beverages; squashes [non-alcoholic beverages]; preparations for making aerated water; powders used in the preparation of soft drinks; powders used in the preparation of fruit-based beverages; powders used in the preparation of*

coconut water drinks; powders for the preparation of beverages; powders for effervescing beverages.

The relevant 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.

Beer is identically contained in both lists of goods.

The contested *brewery products* include, as a broader category, the opponent's beer. Since the Opposition Division cannot dissect *ex officio* the broad category of the contested goods, they are considered identical to the opponent's goods.

The contested *flavoured carbonated beverages; juices; nut and soy based beverages; waters; alcohol free wine; aloe vera drinks, non-alcoholic; aperitifs, non-alcoholic; beverages containing vitamins; birch water; brown rice beverages other than milk substitutes; carbohydrate drinks; cider, non-alcoholic; cocktails, non-alcoholic; douzhi (fermented bean drink); energy drinks; frozen carbonated beverages; fruit-based soft drinks flavored with tea; green vegetable juice beverages; guarana drinks; isotonic beverages; lemon barley water; isotonic beverages [not for medical purposes]; protein-enriched sports beverages; protein drinks; part frozen slush drinks; orange barley water; oat-based beverages [not being milk substitutes]; nutritionally fortified beverages; non-carbonated soft drinks; non-alcoholic sparkling fruit juice drinks; non-alcoholic rice punch (sikhye); non-alcoholic punch; non-alcoholic malt free beverages [other than for medical use]; non-alcoholic malt drinks; non-alcoholic honey-based beverages; non-alcoholic fruit punch; non-alcoholic fruit cocktails; non-alcoholic drinks enriched with vitamins and mineral salts; non-alcoholic dried fruit beverages; non-alcoholic cocktail bases; non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); maple water; mung bean beverages; non-alcoholic beverages containing vegetable juices; non-alcoholic beverages flavoured with coffee; non-alcoholic beverages flavoured with tea; non-alcoholic beverages containing fruit juices; whey beverages; vitamin fortified non-alcoholic beverages; vitamin enriched sparkling water [beverages]; sports drinks containing electrolytes; sports drinks; sorbets in the nature of beverages; soft drinks; smoothies; smoked plum beverages; sherbets [beverages]; sarsaparilla [non-alcoholic beverage]; rice-based beverages, other than milk substitutes; ramune (Japanese soda pops); quinine water* are all kinds of non-alcoholic beverages and are at least similar to the opponent's beer. These goods may coincide at least in purpose, distribution channels and relevant public and they may also be in competition.

The contested *pastilles for effervescing beverages; orgeat; orange squash; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic essences for making beverages; mixes for making sorbet beverages; malt syrup for beverages; lime juice for use in the preparation of beverages; lime juice cordial; blackcurrant cordial; concentrates for making fruit drinks; concentrates for use in the preparation of soft drinks; cordials; dilutable preparations for making beverages; essences for making beverages; essences for making flavoured mineral water [not in the nature of essential oils]; extracts for making beverages; extracts of hops for making beer; extracts of unfermented must; grape must, unfermented; hop extracts for use in the preparation of beverages; lemon juice for use in the preparation of beverages; lemon squash; unfermented preserved must; syrups for making whey-based beverages; syrups for making soft drinks; syrups for making non-alcoholic beverages; syrups for making fruit-flavored drinks; syrups for making flavoured mineral waters; syrups for making beverages; syrups for lemonade; syrups for beverages; syrups and other non-alcoholic preparations for making beverages; squashes [non-alcoholic beverages]; preparations for making aerated water;*

powders used in the preparation of soft drinks; powders used in the preparation of fruit-based beverages; powders used in the preparation of coconut water drinks; powders for the preparation of beverages; powders for effervescing beverages are all kinds of non-alcoholic preparations for making beverages and are at least similar to the opponent's *beer*. These goods may coincide at least in distribution channels and relevant public, and may be manufactured by the same kind of undertakings.

The contested *malt wort* is similar to a low degree to the opponent's *beer*. These goods may coincide in distribution channels and relevant public, and may be manufactured by the same kind of undertakings.

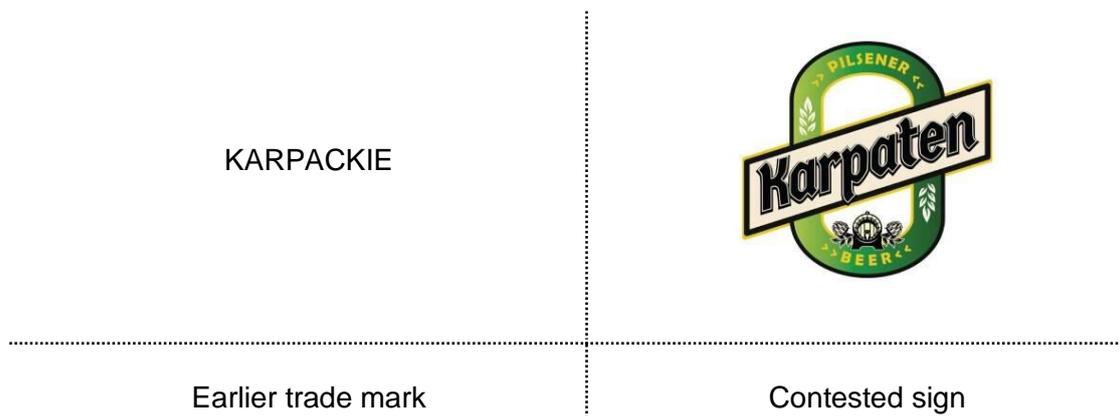
b) Relevant public – degree of attention

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 (at least) similar (to a low degree) target the public at large and business customers with specific professional knowledge or expertise.

The goods at issue, which are mostly beverages, are for everyday consumption and are normally widely distributed – ranging from the food section of supermarkets, department stores and other retail outlets to restaurants and cafes. Moreover, the consumer of non-alcoholic beverages is a member of the general public, who will demonstrate an average level of attention when purchasing such goods (19/01/2017, T-701/15, LUBELSKA (fig.) / Lubeca, EU:T:2017:16, § 22).

c) The signs



The relevant territory is Poland.

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 earlier mark is the word mark 'KARPACKIE'. The protection conferred by the registration of a word mark applies to the word stated in the application for registration and not to the individual graphic features that the mark might possess (22/05/2008, T-254/06, RadioCom, EU:T:2008:165, § 43). Consequently, it is irrelevant whether a word mark is depicted in upper- or lower-case letters, or in a combination thereof, provided it is in a manner that does not depart from the usual way of writing, as is the case here.

The contested sign is a figurative mark reminiscent of a label. The verbal element 'Karpaten' is located in the middle of the sign, inside a beige frame outlined in black. It is depicted in slightly fancy, bold title-case letters. At the top and bottom of the sign are, respectively, the verbal elements 'PILSENER' and 'BEER', depicted in much smaller fairly standard, yellow, bold, upper-case letters and some figurative elements, such as a beer keg and some wheat leaves. All these elements are placed on a rectangular frame with round corners in green, white and black.

The earlier mark will be perceived by the relevant public as an adjective deriving from the word 'karpaty', meaning in English, from the Carpathian Mountains, which is 'a mountain system of central and E Europe, extending from Slovakia to Central Romania (...)' (information extracted from *Collins English Dictionary* on 24/08/2023 at www.collinsdictionary.com/CarpathianMountains). The applicant states, inter alia:

(...) meaning 'Carpathian' or 'from the Carpathian Mountains' is allusive for beer products. More specific, trade marks designating beer products are often associated with mountains and woods, as these are symbols of cold refreshing waters and waterfalls. Thus, due to its allusive character the Opposed Trade mark 'KARPACKIE' must be regarded as having a weak level of protection (...).

The applicant also filed some pictures of beer brands that associate their image with mountains:





As regards the abovementioned listing of some trade marks, the Opposition Division fully agrees with the opponent, where it points out the following:

Secondly, we do not share the Applicant's statement about the alleged low protection of the earlier Polish trade mark. The Applicant did not file any evidence which could show that the word element 'KARPACKIE' is perceived by the Polish public as an indication about the properties of the marked goods. The element 'KARPACKIE' has no connection with goods such as 'beers'. The listed beer's trade marks (which use a mountain motif in their logo) are irrelevant for the present proceeding: firstly, the high majority of mentioned beers are not sold in Poland, then the element 'KARPACKIE/KARPATEN' is not used in the listed logos. **The presence of indications such as 'MT.'; 'MOUNT' or the graphic of mountain is not relevant to prove that Polish relevant public perceived the word element 'KARPACKIE' as a descriptive term for beers.** In this point, we would like to remember that pursuant to constant case-law, earlier registered trade marks are presumed to have at least a minimum degree of inherent distinctiveness (24/05/2012, C-196/11, F1-Live, EU:C:2012:314), even where persuasive evidence is submitted to challenge this presumption. In the present case, there is no evidence which could show the descriptiveness of the earlier trade mark. The distinctive character should be assessed at least as normal (sic.).

The Opposition Division agrees that the earlier mark might give an indication that the goods may be produced in the region of the Carpathian Mountains. However, it will require some mental steps to understand this element as having a clear meaning in relation to the goods, such as being associated with mountains and woods, which might affect the bitterness, taste or aroma from that region. Furthermore, this region is not commonly known as a place from which specific products, such as beers, come from (geographical origin) in order to enable consumers to trust and distinguish a certain quality of products. Therefore, as this element has no direct and clear relationship to the relevant goods, it is distinctive to a normal degree. In any case, if the earlier mark was considered as having a limited distinctiveness, the same would hold true for the contested sign, for the reasons that follow.

The contested sign's verbal element 'Karpaten', although it is not a purely Polish word, will also be perceived by the relevant public as something coming from the Carpathian Mountains, because for instance of its close equivalent word in Polish, *Karpaty*. The same applies here as with respect to the earlier mark, since it would take some mental steps to understand this element as being allusive for the relevant goods. Therefore, since it has no clear relationship to the relevant goods, it is distinctive to a normal degree.

The verbal elements 'PILSENER' and 'BEER' refer to the nature or ingredients of some of the goods and are non-distinctive, for instance for *beer and brewery products; extracts of hops for making beer*. Therefore, it can be reasonably assumed that the relevant public will perceive the verbal element 'BEER', given that it will be understood since it is a basic English word (16/09/2019, R 1290/2019-2, VITOSHA Beer (fig.) / Victoria et al., § 23). For another part of the goods, such as *juices; nut and soy based beverages*, these elements are distinctive, however, they play a clearly secondary role (see below).

The label format of the contested sign is ornamentally rather commonplace, for instance in the beer trade. It is likely to be affixed on the bottles or cans, and merely serves to highlight the information contained therein. Therefore, the impact of this label is limited, as consumers usually attribute little or no trade mark significance to it (15/12/2009, T-476/08, Best Buy, EU:T:2009:508, § 27). Notwithstanding, when signs consist of both

verbal and figurative components, in principle, the verbal component of the sign usually has a stronger impact on the consumer than the figurative component. This is because the public does not tend to analyse signs and will more easily refer to the signs in question by their verbal element than by describing their figurative elements (14/07/2005, T-312/03, Selenium-Ace / SELENIUM SPEZIAL A-C-E (fig.), EU:T:2005:289, § 37). Therefore, the verbal element of the contested sign has a stronger impact than its figurative element and will be given greater weight when referring to that sign (28/09/2016, T-539/15, SILICIUM ORGANIQUE G5 LLR-G5 (fig.) / Silicium Organique G5- Glycan 5-Si-Glycan-5-Si-G5 et al., EU:T:2016:571, § 54). This principle applies to the contested sign, since the relevant public is more likely to identify the sign by its verbal element 'Karpaten' than by describing its figurative elements. Furthermore, some of the figurative elements, such as the beer keg, are also at best weak for at least some of the goods, for instance *beer and brewery products*, since these products may be kept in the kegs or the product can be drunk from it.

In any case, the Opposition Division considers that the contested sign's verbal element 'Karpaten' is clearly more dominant than the other elements as, due to its position, size, dimension and/or use of colours, it would be more visually outstanding than the other elements.

Visually and **aurally**, the signs coincide in the string of letters 'KARPA*' (and its pronunciation). In addition, the coinciding string of letters are placed as the first part of the most distinctive and dominant verbal element 'Karpaten' of the contested sign. However, the signs differ in the remaining letters '*CKIE' (earlier mark) versus '*ten' (contested sign), the verbal elements 'PILSENER' and 'BEER' (unlikely to be pronounced, see below), and in the figurative element(s) forming (part of) a label with limited distinctiveness, if any, as mentioned above. Furthermore, the marks also differ in the typeface in which the verbal elements of the contested sign are depicted – which is either slightly stylised or fairly standard and will, in any case, not draw consumers' attention away from the verbal elements as such and in particular from the dominant verbal element 'Karpaten'.

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 or from top to bottom, making the part placed at the left or on top of the sign (the initial part) the one that first catches the attention of the reader. It is relevant for the comparison that the first part coincides, as is the case here.

Aurally, due to their position, size, dimension and limited distinctiveness, if any, 'PILSENER' and 'BEER' play a secondary role within the sign and have a limited impact on consumers' perception of the mark, since consumers generally refer aurally to the dominant elements in trade marks (03/07/2013, T-206/12, LIBERTE american blend, EU:T:2013:342, § 43-44; 30/11/2011, T-477/10, SE© Sports Equipment, EU:T:2011:707, § 55). Furthermore, economy of language might be another reason for assuming that this wording will be omitted, since consumers naturally tend to shorten long marks in order to reduce them to elements that are easier to refer to and remember. Therefore, the contested sign will most likely be referred to aurally as 'Karpaten' by the relevant public.

Furthermore, both marks have three syllables, coinciding in the first two syllables, and have a similar rhythm and intonation, 'KAR-PA-CKIE' versus 'Kar-pa-ten'.

Bearing in mind the above principles and assertions, the signs are visually similar to a below-average degree and aurally similar to an above-average degree.

Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. As both marks will refer to the concept of 'coming from the Carpathian Mountains', the marks are conceptually similar to a high degree.

As the signs have been found similar in at least one aspect of the comparison, 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 a reputation, and therefore also enjoys an enhanced degree of distinctiveness as a result of its long standing and intensive use in Poland in connection with beer. This claim must be properly considered given that the distinctiveness of the earlier trade mark must be taken into account in the assessment of likelihood of confusion. Indeed, the more distinctive the earlier mark, the greater will be the likelihood of confusion and, therefore, marks with a high degree of distinctiveness due to the recognition they possess on the market, enjoy broader protection than marks with less distinctiveness (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

On 29/05/2022, within the time limit for the opponent to file further facts, evidence and arguments, the opponent submitted evidence to support its claim, which has been mentioned above in the section of proof of use: evidence of 29/05/2022, Annexes 1-6. The evidence submitted on 25/10/2022, merely for proving use, cannot be taken into consideration, since, 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 laid down in Article 7(2) EUTMDR, the opposition will be rejected as unfounded. A claim of enhanced distinctiveness acquired through use or reputation of the earlier mark is a matter of law and fact which the Office cannot examine unless the opponent claims and substantiates it within the substantiation period which, in the present case, expired on 09/06/2022. Therefore, the evidence submitted on 25/10/2022, such as the invoices, cannot be taken into account for proving enhanced distinctiveness or reputation.

Having examined the material listed above, the Opposition Division concludes that the evidence submitted by the opponent does not demonstrate that the earlier trade mark had acquired a high degree of distinctiveness through use in Poland. There is no direct, and more importantly, objective information coming from someone other than the opponent itself, about the relevant public's degree of recognition of the mark 'KARPACKIE' in the form of, for example, surveys from an independent source. Neither does it show that the trade mark is known by a significant part of the relevant public. Furthermore, there is no information regarding its general position on the market when compared to other companies in the same sector. The opponent did not provide any figures, such as official annual reports including turnover or revenue figures for sales in Poland in relation to the relevant goods, nor is there any objective information concerning sales volumes, market share or the extent to which the mark has been promoted. The opponent has submitted a table with the amount of sales in hectolitres between 2018 and 2021 of its various beer products and it mentioned in Annex 4 that between 2018 and 2022 it had invested a significant amount of PLN in marketing expenditure for the 'KARPACKIE' brand. However, as stated above, according to Article 10(4) EUTMDR, the opponent should have filed other evidence to support its statements. The invoices, submitted after the substantiation period, even if submitted within the deadline, would

not be sufficient to prove these statements, as there were only eight invoices to clients in Poland. The evidence merely shows that the mark 'KARPACKIE' has been used on the market, and the remaining evidence that can be taken into account is not sufficient to corroborate the claims made by the opponent in the signed statement. Under these circumstances, the Opposition Division concludes that the opponent has failed to prove that its trade mark has a higher degree of distinctiveness through its use in Poland.

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 the goods in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) Global assessment, other arguments and conclusion

A likelihood of confusion (including a likelihood of association) 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.

The appreciation of a likelihood of confusion on the part of the public depends on numerous elements and, in particular, on the recognition of the trade mark on the market, the association that can be made with the used or registered sign, and the degree of similarity between the signs, and between the goods or services identified. 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).

The goods are identical or (at least) similar (to a low degree) and target the public at large and business customers with an average degree of attention. The earlier mark as a whole has a normal degree of inherent distinctiveness.

The marks are visually similar to a below-average degree, aurally similar to an above-average degree and conceptually similar to a high degree.

Consequently, even if average consumers are capable of detecting, for instance, certain visual and aural differences between the two conflicting signs, the likelihood that they might associate the signs with each other is very real. From the wording in Article 8(1)(b) EUTMR, 'the likelihood of confusion includes the likelihood of association with the earlier trade mark', it follows that the concept of a likelihood of association is not an alternative to that of a likelihood of confusion, but serves to define its scope. In the present case, it is conceivable that relevant consumers will perceive the contested sign as a variation of the earlier mark configured in a different way according to the type of goods which it designates (23/10/2002, T-104/01, Miss Fifties (fig.) / Fifties, EU:T:2002:262, § 49). Therefore, relevant consumers may regard the contested goods and the opponent's goods as belonging to two ranges of goods coming, nonetheless, from the same undertaking.

Furthermore, in order to grasp the differences between the two signs at issue, consumers would have to carry out a very detailed examination of them. However, this is unlikely, given that the average consumer only rarely has the chance to make a direct comparison between different marks, but must rely on their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). Therefore, in particular, the difference in the last letters of the main verbal elements of the signs is not

sufficient to outweigh the similarity arising from their beginnings (namely five letters in common).

The coincidences between the signs, that is to say, the almost identical length of the (main) verbal elements, the identical sequence of five out of the nine/eight letters of these verbal elements, in combination with the similar sound (at the beginning) and concept and the visual impression of the first coinciding letters 'KARPA*', together with the identity and (at least) similarity between the goods, are sufficient to find a likelihood of confusion. Furthermore, the relevant public will most likely refer to the contested sign by its verbal element rather than by describing its figurative elements.

In addition, it should be borne in mind that the relevant goods are beverages and, since these are frequently ordered in noisy establishments (bars, nightclubs), the phonetic similarity between the signs is particularly relevant (15/01/2003, T-99/01, *Mystery (fig.) / Mixery*, EU:T:2003:7, § 48). Accordingly, in such cases, it may be appropriate to attach particular importance to the above-average degree of aural similarity between the signs at issue. These considerations come into play in the finding of likelihood of confusion.

Considering all the above, the Opposition Division finds that there is a likelihood of confusion, including a likelihood of association, on the part of the relevant public and therefore the opposition is well founded on the basis of the opponent's Polish trade mark registration No R 280 489 'KARPACKIE' (word mark). The contested trade mark must be rejected for the goods found to be identical or (at least) similar to those of the earlier trade mark. This finding also applies to the goods found to be similar to a low degree since the high degree of conceptual similarity, coupled with the above-average degree of aural similarity of the signs and a normal degree of inherent distinctiveness of the earlier mark, are clearly sufficient to offset the low degree of similarity between some of the goods. Therefore, the opposition is successful and the contested trade mark must also be rejected in relation to the goods found to be similar to a low degree to those of the opponent.

Therefore, the opposition is well founded on the basis of the opponent's abovementioned earlier mark. It follows that the contested sign must be rejected for all the contested goods.

The opposition is successful on the basis of the inherent distinctiveness of the earlier mark. Furthermore, the fact that the opponent has not proved any enhanced degree of distinctiveness of the opponent's mark due to its extensive use/reputation does not alter the outcome of the case, as the result would be the same even if the earlier mark enjoyed an enhanced degree of distinctiveness.

Since the opposition is fully successful on the basis of the ground of Article 8(1)(b) EUTMR, there is no need to further examine the other grounds of the opposition, namely Article 8(4) and (5) EUTMR.

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

Monika CISZEWSKA

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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.