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## General Court finds that “coffee products” are similar to edible items in Class 30

European Union - [NJORD](#)

- Aldi opposed the registration of the figurative mark HAPPY MORENO CHOCO in Classes 30 and 35 based on earlier MORENO marks in Class 30
- The court found that “confectionery, sweetmeats [candy], wafer biscuits, wafer rolls, pastries” and the limited goods “coffee, coffee-based products and beverages with a proportion of coffee; cocoa-based beverage powder” were similar
- Notably, the court referred to the limited goods as “coffee products and cocoa products”, at least in the English version

In [ZPC Flis sp.j. v European Union Intellectual Property Office](#) (EUIPO) (Case T-708/18), the General Court has essentially held that edible items in Class 30 are similar to “coffee products”.

### Background

The case started in January 2016 when the applicant, ZPC Flis sp.j., applied for the registration of the EU figurative mark depicted below for a range of goods in Classes 30 (“confectionery, sweetmeats [candy], wafer biscuits, wafer rolls, pastries”) and Class 35 (“retailing or wholesaling of confectionery, cookie molds, edible wafers and rolled wafers, wholesaling and retailing of confectionery, cookie molds, edible wafers and rolled wafers via the Internet):



The application was opposed by Aldi Einkauf GmbH & Co OHG based on the earlier German figurative marks depicted below, registered in 2007 for a range of goods in Class 30 (“coffee; coffee substitutes; coffee products; coffee-based beverages; tea, cocoa; cocoa products; cocoa-based beverages; chocolate-based beverages; all aforementioned goods also in instant form”):



It came to light later on that the list of goods covered by the earlier marks had been amended in 2008 and was limited to “coffee, coffee-based products and beverages with a proportion of coffee; cocoa-based beverage powder”.

Aldi based its opposition on Article 8(1)(b) of Regulation 2017/2009, arguing that the marks at issue were similar and there was a likelihood of confusion. The Opposition Division rejected the opposition, considering that the contested goods were dissimilar to Aldi’s amended list of goods. Since Aldi had not produced evidence of the renewal of the earlier mark depicted above on the right-hand side, it was left out of the examination.

Aldi filed an appeal. With its decision in Case R 2113/2017-1, the First Board of Appeal of the EUIPO annulled the Opposition Division’s decision in part, taking into account the evidence of the renewal of the earlier mark. The board held that there was a likelihood of confusion in respect of all goods and services in Classes 30 and 35, except the services in Class 35 corresponding to “retailing or wholesaling of cookie molds, wholesaling and retailing of cookie molds via the Internet”.

The Board of Appeal expressly based its determination of the similarity of the goods/services on the original list of goods, and not on the limited list of goods actually registered.

ZPC appealed to the General Court, claiming infringement of Article 8(1)(b) of Regulation 2017/2009 and, in that respect, an infringement of the principle of the protection of legitimate expectations and the principle of legal certainty.

### **General Court decision**

The General Court confirmed the view of the Board of Appeal that there was a likelihood of confusion between the signs in respect of all the goods and services for which registration was sought, apart from the services in Class 35 corresponding to “retailing or wholesaling of cookie molds; wholesaling and retailing of cookie molds via the Internet”.

In respect of the comparison of the goods and services, the applicant claimed that the goods at issue were different since:

- those covered by the applied-for mark were for eating, whereas the goods covered by the earlier mark were for drinking; and
- wafers, pastries and confectionery may consist of many ingredients, but cocoa or coffee is not their main ingredient.

Further, just because there is a possibility of adding cocoa or a cocoa or coffee-based flavouring to finished goods such as wafers, confectionery or pastries does not automatically mean that those goods would be marketed under the mark applied for. Moreover, the goods at issue are completely different foodstuffs which are not found near one another in, among other places, supermarkets. Finally, the Board of Appeal had failed to take into account the reasons set out in the Opposition Division’s decision in respect of the differences in the nature and intended purpose of the goods, namely for eating on the one hand and for drinking on the other.

The General Court confirmed the board’s finding that the goods covered by the signs at issue were identical; thus, the goods covered by the earlier marks included the goods covered by the mark applied for. The court also confirmed that the goods covered by the mark applied for, in respect of their nature and purpose, were different from those covered by the earlier marks. Finally, the court held, in accordance with the board’s view, that “confectionery, sweetmeats [candy], wafer biscuits, wafer rolls, pastries” and the limited goods “coffee, coffee-based products and beverages with a proportion of coffee; cocoa-based beverage powder” were similar. Notably, at this stage, the General Court referred to the limited goods as “coffee products and cocoa products”, at least in the English version.

As regards the similarity of the marks, the applicant argued that the dominant element was not the word element ‘moreno’ but, rather, the golden crown, which was a distinctive element of the sign as it referred to its proprietor. Moreover, the applicant submitted that the golden crown and the word ‘happy’, rather than the word ‘moreno’, would attract the attention of the consumer.

However, the General Court did not agree with these arguments and affirmed the Board of Appeal’s assessment. First, the court acknowledged that the word ‘moreno’ was the distinctive and dominant element of the sign applied for, because the word has no meaning in Germany, where the mark is registered. Second, the word ‘choco’ was allusive, the word ‘happy’ only possessed a weak distinctive character and the expression “rolls in chocolate with chocolate” was devoid of distinctive character. Third, the court held that the argument that the crown was a distinctive element of the sign could not succeed as it would only be perceived by the relevant public as laudatory.

Accordingly, there was a likelihood of confusion.

### **Comment**

This case is interesting for several reasons. Although the opponent’s registrations were more than five years old, it does not appear that the applicant demanded proof of use of these marks; this could have rendered the similarity of the goods even narrower. Further, the Board of Appeal was found to have reached its decision based on an overly broad list of goods, but the General Court affirmed the decision anyway. Finally, the fact that the General Court found that the opponent’s “coffee, coffee-based products and beverages with a proportion of coffee; cocoa-based beverage powder” could be shortened to “coffee products and cocoa products” for the purposes of the similarity of goods - at least in the English version - shows a new trend.

**Peter Gustav Olson**

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