

# EUIPO rules on comparison between alcoholic and non-alcoholic beverages product.

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*To date, both EUIPO decisions and the case-law of the General Court/Court of Justice of the European Union have shown a certain contradiction on the existence of similarities/differences in relation to the comparative analysis of alcoholic beverages and non-alcoholic products. In the recent decision of 13 April 2022, the Grand Board of Appeal of the EUIPO has settled the debate and established the interpretative rules that should govern this type of comparative analysis.*

In trademark matters, whether in opposition proceedings against a trademark application or in infringement proceedings, the comparative analysis of the goods and services is one of the main factors to be taken into account when assessing whether there is a likelihood of confusion.

In certain cases, the comparative analysis between the goods and services covered by the marks at issue may be straightforward, provided they are the same or are obviously complementary. However, in other cases, this task may be more complex, insofar as it should be borne in mind that the Nice Classification is merely an administrative tool, so that the mere coincidence of the marks in question in a Nice class does not mean that there is identity in terms of the goods and/or services at stake, just as the mere existence of differences between the designated Nice classes does not per se mean the existence of real differences.

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On the contrary, settled caselaw of the courts usually takes into consideration all relevant factors that characterise the relationship between the goods and/or services at issue, including by way of example their nature, their intended purpose, their use and their competitive or complementary character (see in this sense the Judgment of the Court of Justice of the European Union of 29 September 1998 in Canon).

For this reason, and in order to defend their clients' interests with guarantees, lawyers often resort to searching for previous decisions issued by the relevant registry offices or courts in order to find precedents on the comparison of the goods and/or services in question.

However, it is not uncommon to find contradictions from one decision to another, meaning that it is possible to choose one decision in the best interest of a particular client despite the existence of another that says the opposite.

This has been the case, for example, in relation to the comparative analysis between alcoholic and non-alcoholic beverage products, insofar as there are decisions that argue for similarities between these products and others that say the opposite.

*There have been some contradictions in the case law on the comparative analysis between alcoholic and non-alcoholic beverage products, although this debate has been settled by the recent decision of the Grand Board of Appeal of the EUIPO.*

By way of example, in the Judgment of 5 October 2011, T-421/10, Rosalía de Castro, EU:T:2011:565, the General Court found that there is a low degree of similarity between "beers, mineral waters and other non-alcoholic beverages" and "alcoholic beverages - except beers". By contrast, in the Judgment of 4 October 2018, T-150/17, FLÜGEL, EU:T:2018:641, the Court held that "energy drinks" and "alcoholic beverages (except beers); alcoholic essences; alcoholic extracts; fruit extracts" are not similar.

However, it appears that this debate has been settled by the Grand Board of Appeal of the EUIPO in its decision of 13 April 2022. This decision arises from opposition proceedings brought by Euromadi Ibérica, S.A. against Zorka Gerdzhikova's application for registration of the EU trademark "ZORAYA" for goods in Class 32 (Non-alcoholic beverages; Flavoured carbonated beverages; Water; Vitamin-enriched sparkling water [beverages]), on the basis of the earlier Spanish trademark "VIÑA ZOROYA" registered for goods in Class 33 (Wines, spirits and liqueurs).

After analysing the most relevant case-law of the General Court of the EU/Court of Justice of the EU and the EUIPO, in which different conclusions are reached from one case to another, the Grand Board of Appeal of the EUIPO issues a series of guidelines that will clearly be very useful when facing a comparative analysis between alcoholic and non-alcoholic beverage products, among which we highlight the following:

(i) Non-alcoholic beverages include the following products: water and enriched mineral waters, fruit and vegetable juices, (flavoured) carbonated drinks, plant-based beverages consisting of extracts obtained from soya, rice, coconut, oats, almonds, quinoa or other plants, non-alcoholic beer, non-alcoholic wines, non-alcoholic spirits and mocktails.

(ii) Alcoholic beverages include the following products: beer and beverages based on beer, cider, wine, spirits and liqueurs, pre-mixed alcoholic beverages, in particular based on wine or cider alcopops, i.e. pre-mixed alcoholic beverages, based on spirits and liqueur, and cocktails.

(iv) It is very common to find non-alcoholic products on the market that have the same characteristics as an alcoholic product (e.g. beer, wine or tinto de verano).

Contrary to the view taken by part of the case-law, the alcohol content of the product is only one of the factors to be taken into consideration when comparing the goods and is therefore not decisive per se. . The other factors, in particular whether the

goods are manufactured by the same undertakings or whether substitutes are involved, are likewise relevant.

(v) Alcoholic and non-alcoholic products are sold through the same sale channels and together (e.g. alcoholic gin is offered alongside non-alcoholic gin) and are competing products, targeted at the same public and often manufactured by the same companies.

(vi) Therefore, 'non-alcoholic beverages' and 'wine' are similar to a low degree. 'Non-alcoholic beverages' and 'spirits and liqueurs' are similar. 'Flavoured beverages' and 'wine' are similar to a low degree.

(vii) 'Water and vitamin enriched mineral water' and 'wine' are not similar. 'Water and vitamin enriched mineral water' and 'spirits and liqueurs' are not similar.

For these reasons, the Grand Board of Appeal of the EUIPO considers that the goods in Class 32, designated by the contested trade mark application (Non-alcoholic beverages; Flavoured carbonated beverages; Water; Vitamin-enriched sparkling water [beverages]) are different from the goods in Class 33 designated by the earlier trade mark (Wines, spirits and liqueurs).