**OPPOSITION No B 3 237 370**

**Philip Morris Brands Sàrl**, Quai Jeanrenaud 3, 2000 Neuchâtel, Switzerland (opponent), represented by **Ecija**, Calle Serrano 69, 28006 Madrid, Spain (professional representative)

a g a i n s t

**J.S.S. Tobacco Ltd**, Suite 404, Albany House, 324/326 Regent Street, W1B 3HH London, United Kingdom (applicant), represented by **Lerroux**, Proción 7, (edif. America II) Bloque 2 - 2ºD, 28023 Madrid, Spain (professional representative).

On 10/07/2026, the Opposition Division takes the following

**DECISION:**

1. Opposition No B 3 237 370 is rejected in its entirety.

2. The opponent bears the costs, fixed at EUR 300.

**REASONS**

On 14/04/2025, the opponent filed an opposition against all the goods of European Union trade mark application No 19 103 793 

(figurative mark). The opposition is based on, inter alia, international trade mark registration designating European Union No 1 023 145, 

(figurative mark).

The opponent invoked Article 8(1)(b) and 8(5) EUTMR.

## 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.

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 the opponent's international trade mark registration designating European Union No 1 023 145**.**

**a) The goods**

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

Class 34: *Raw or manufactured tobacco; tobacco products, including cigars, cigarettes, cigarillos, hand-rolling tobacco, pipe tobacco, chewing tobacco, snuff, kretek; snus tobacco; tobacco substitutes (for non-medical use); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco boxes, cigarette cases and smokers' ashtrays, tobacco pipes, pocket machines for rolling cigarettes, smokers' lighters; matches.*

The contested goods are the following:

Class 34: *Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporizers for smokers; smokers' articles; matches; absorbent paper for tobacco pipes; cigarette filters; mouthpieces for cigarette holders; cigarette paper; books of cigarette papers; pocket machines for rolling cigarettes; cigarillos; cigar cutters; firestones; lighters for smokers; tobacco pipes; tobacco pouches.*

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

In this respect, the General Court has confirmed that the use of the term 'in particular' indicates that the specific goods or services are only examples of items included in the preceding category and that protection is not restricted to them (09/04/2003, T-224/01, NU-TRIDE / TUFFTRIDE, EU:T:2003:107, § 41). The same considerations must be found to apply to other synonymous terms like 'especially', 'for example', 'such as' or 'including'. In other words, the use of any such terms in the specifications of goods or services only introduces non-exhaustive lists of examples.

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.

**Contested goods in Class 34**

*Tobacco and tobacco substitutes; smokers' articles; matches* are identically contained in both lists of goods (including synonyms).

The contested *cigarettes and cigars; cigarillos* are included in the broad category of the opponent's *tobacco products*. Therefore, they are identical.

The contested *absorbent paper for tobacco pipes; cigarette filters; mouthpieces for cigarette holders; cigarette paper; pocket machines for rolling cigarettes; lighters for smokers; tobacco pipes; books of cigarette papers; cigar cutters; tobacco pouches* are included in the opponent's *smokers' articles*. Therefore, they are identical.

The contested *electronic cigarettes and oral vaporizers for smokers* are at least similar to the opponent's *tobacco substitutes (for non-medical use)* because they at least coincide in the purpose, method of use, distribution channels and relevant public, as well as are in competition.

The contested *firestones* in the tobacco industry refer to the small, replaceable flints used in mechanical lighters used to produce the spark needed to ignite the tobacco. They are <u>similar</u> to the opponent's *smokers' lighters*, because they coincide in the distribution channels, relevant public and producers and are complementary.

**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 (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

In the present case, the goods found to be identical or (at least) similar target the public at large, as well as business customers with specific professional knowledge or expertise.

The degree of attention varies from average, for example for some of the smoker’s accessories to high - for example for tobacco products, due to brand loyalty (26/02/2010, R 1562/2008-2, victory Slims (fig.) / VICTORIA et al., 25/04/2006, R 61/2005-2, GRANDUCATO / DUCADOS et al.)

**c) The signs**

| | |
|---|---|
| Marlboro | Manchester<br>UNITED KINGDOM |
| Earlier trade mark | Contested sign |

The relevant territory is 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 element 'Marlboro' of the earlier mark has no meaning for the relevant public and is, therefore, distinctive to a normal degree. It is depicted in a rather standard and non-distinctive font.

The element 'Manchester' of the contested sign will be understood as a reference to the well-known city in the United Kingdom by the relevant public throughout the EU, given its widespread recognition in cultural, commercial, and sporting contexts.

The element 'UNITED KINGDOM' of the contested sign will be understood as the name of the country comprising Great Britain and Northern Ireland.

Consumers' perception with respect to indications of an entire country is not the same as with respect to indications relating to an individual city (15/12/2011, T-377/09, Passionately Swiss, EU:T:2011:753, § 42). Indeed, consumers are used to see names of countries on the trade marks and treat them as an indication of country of production or origin of the relevant goods, rather than the indication of a commercial establishment. Therefore, the contested sign's verbal elements 'United Kingdom' are non-distinctive.

However, as far as cities' names are considered, in order to find an indication of a city to be non-distinctive, it has to be explained and proven in the individual case, or at least made plausible, that an indication of place is seriously considered from the perspective of consumers as a characteristic of goods in the relevant sector (08/06/2018, R 2528/2017-4, MIAMI; § 27).

In the present case, no reasons are apparent as to why consumers in the EU would associate the city of Manchester with tobacco and tobacco related products and accessories. There is no particular relationship between the geographical or climatic characteristics of the city of Manchester and the nature of the relevant goods in Class 34. Therefore, this element is distinctive.

The signs' verbal elements are depicted in a rather standard and non-distinctive fonts.

The heraldic crest device of the contested sign will be perceived as a traditional coat of arms or heraldic emblem conveying concepts of heritage, prestige, and official or royal association by the relevant public. Such heraldic devices are commonly encountered in the relevant market sector and are therefore of non-distinctive in relation to the goods at issue.

The elements 'Manchester' and the heraldic crest device in the contested sign are co-dominant.

When signs consist of both verbal and figurative components, in principle, the verbal component of the sign 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).

It follows that the contested sign's verbal element 'Manchester' has most impact on consumers in the overall perception of the contested sign.

Since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will have the same number of letters and even share some of them, but they cannot, for that reason alone, be regarded as visually and/or aurally similar (25/03/2009, T-402/07, ARCOL / CAPOL, EU:T:2009:85, § 81-82; 04/03/2010, C-193/09 P, ARCOL / CAPOL, EU:C:2010:121).

**Visually**, the earlier mark consists of the single fanciful word 'Marlboro'. The contested sign is a composite mark comprising a verbal element 'Manchester', a heraldic crest device positioned above the word 'Manchester' and the words 'UNITED KINGDOM' in smaller capitals beneath. The signs share only a highly similar font of the elements 'Marlboro' and 'Manchester', as well as the initial letters 'Ma' of these elements. Beyond those two letters, these verbal elements diverge entirely in their remaining letter sequences. Therefore, this minimal coincidence is insufficient to create a meaningful visual similarity. The contested sign further differs by the presence of the independent heraldic crest device, which is absent from the earlier mark, and by the overall vertical composite layout of the contested sign as opposed to the plain single-word presentation of the earlier mark.

Therefore, the signs are visually similar to at most a very low degree.

**Aurally**, the secondary and non-distinctive verbal elements 'UNITED KINGDOM' are unlikely to be pronounced. Indeed, the Court has stated that consumers generally refer to the dominant elements while less prominent elements are not pronounced (03/07/2013, T 206/12, LIBERTE american blend (fig.) / La LIBERTAD et al., EU:T:2013:342, § 44), as the consumers naturally tend to shorten long marks in order to reduce them to elements that are easier to refer to and remember (07/02/2013, T 50/12, METRO KIDS COMPANY (fig.) / METRO (fig.), EU:T:2013:68, § 42; 30/11/2011, T 477/10, SE SPORTS EQUIPMENT (fig.) / SE et al., EU:T:2011:707, § 55; 16/09/2009, T 400/06, ZERORH+ (fig.) / ZERO (fig.), EU:T:2009:331, § 58).

It follows that the signs share the initial sound of the letters 'Ma', but differ entirely in the remaining sequence of letters.

It follows that the signs are aurally similar to at most a very low degree.

**Conceptually**, the earlier mark is a fanciful, invented term and the contested sign conveys a clear geographical concept through its verbal elements — the city of Manchester and the United Kingdom. The contested sign's heraldic crest device evokes heritage and official association. Since one of the signs has no meaning and the other conveys specific and recognisable concepts, the signs are conceptually dissimilar.

**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 trade mark has a reputation in connection with all the goods for which it is registered, namely:

Class 34: *Raw or manufactured tobacco; tobacco products, including cigars, cigarettes, cigarillos, hand-rolling tobacco, pipe tobacco, chewing tobacco, snuff, kretek; snus tobacco; tobacco substitutes (for non-medical use); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco boxes, cigarette cases and smokers' ashtrays, tobacco pipes, pocket machines for rolling cigarettes, smokers' lighters; matches*.

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 highly distinctive character because of the recognition they possess on the market, enjoy broader protection than marks with a less distinctive character (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 18).

The enhanced distinctiveness of the earlier trade mark should exist at the time of filing of the contested EUTM application (or any priority date). In principle, it is sufficient that the opponent show that its mark had acquired enhanced distinctiveness on that date. Enhanced distinctiveness should also exist at the time when the opposition decision is taken. However, in principle, this will be assumed unless the applicant claims and proves any subsequent loss of enhanced distinctiveness.

In the present case, the contested trade mark was filed on 27/01/2025. Therefore, the opponent was required to prove that the trade mark on which the opposition is based had a reputation prior to that date.

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. The evidence relevant for the assessment of reputation consists of the following documents:

- **Exhibit 2**: **press article dated 1958 regarding 'MARLBORO's story**

  A press article titled 'The Marlboro Story: how one of America's most popular filter cigarette got that way', published in the *New Yorker* magazine on 15/11/1958. It summarises the opponent's story and states: 'MARLBORO quickly took its places as one of America's leading filter cigarettes'.

- **Exhibits 3-4**: **references to various trade mark registrations in the EU member states for 'MARLBORO' signs**

  A copy of Swedish trade mark registration No 35 885 'MARLBORO' from 1929 and a list of trade mark registrations in several EU MS (e.g. Denmark, Germany, France, and Portugal) dated between 1929 and 1958 for 'MARLBORO' and .

- **Exhibit 5**: **opponent's annual reports for 2008 to 2024**

  The majority of the documents refer to the shipment volume and market share of, inter alia, 'MARLBORO' cigarettes in the European Union. The figures are significant and are broken down by brand. Some of the figures are also broken down by territory, referring to various EU member states, such as Germany, Spain, France, Italy, and Poland.

  For example, the opponent's annual report for 2022 indicates that 'MARLBORO' celebrated its 50th anniversary as the world's leading cigarette brand. The report from 2024 indicates that Marlboro is the world's best-selling international cigarette.

  The opponent has a considerable market share for cigarettes in several territories, including several EU member stated, such as Belgium, the Czech Republic, Germany, Spain, France, Hungary, Italy, Austria, and Poland. It further indicates that the volume of the shipment of 'MARLBORO' cigarettes increased in the EU.

  The document provides broken-down information regarding the market share in several EU member states, such as Germany, Spain, France, Italy, Poland, and Romania. The percentages are considerable.

- **Exhibits 6-18**: **printouts of various articles indicating rankings and statements on the public's perception of 'MARLBORO' in various EU member states**

  - **Exhibit 6**: Data exported from Euromonitor from trade sources/national statistics in September 2025, identifying significant retail volumes of Marlboro cigarettes in Poland, France, Germany, Italy and Spain in the years 2018-2024.

- **Exhibit 7**: An article published in January 2024, in Hungarian and translated into English, referring to the American tobacco market and stating that Philip Morris' market share was 50.6%.

- **Exhibit 8**: an article titled 'Cigarete-ponašanje potrošača' (published in 2014 on jatrgovac.com), in Croatian with partial translation. The article states: 'When it comes to the cigarette brands with the highest consumption in Croatia, Ronhill comes first, followed by Marlboro and Walter Wolf.'

- **Exhibit 9**: an article dated in 2025 and published on a website with .cz top-level domain stating that Philip Morris CR in 2022 in Slovakia had almost 38% of market share for classic tobacco products and produced around 2.7 billion units of Marlboro cigarettes.

- **Exhibit 10**: an article titled 'The Marlboro company and its products' (published in 2011 on skirmanteapiemalbora.blogspot.com) in Lithuanian and English. It states, inter alia, that 'This company's revenue earned from the sale of 'MARLBORO's cigarettes broke all records'.

- **Exhibit 11**: an article published in 2025 in Frankfurter Allgemeine, in German and translated into English, stating that Marlboros are *the best-known and best-selling cigarettes in the world.*

- **Exhibit 12**: an article titled 'Where do the cigarettes sold in France come from' (published Tobacco Newson), in French with partial translation. The article refers to the data of the year 2020 and states that one of the main cigarette brands sold in France is Marlboro.

- **Exhibit 13**: an article titled 'Najlepšie vnímané značky' (dated 2005 and published on szzv.sk), in Slovak with partial translation. The article states: 'Best cigarette brand: Marlboro'.

- **Exhibit 14**: documents relating to Spain.

    - A printout from the opponent's website, printed in 2019, which states: 'our brands are among the top seven in the market, with *'MARLBORO'* being the leading brand of cigarettes'.

    - An article titled 'Spaniards' favorite tobacco brands in 2024' stating 'Marlboro is still king (…) with 16% market share (…) it remains the favorite among premium Spanish consumers.

    - Tables, which the opponent claims are rankings from the Spanish Commissioner for the Tobacco Market (under the Spanish Ministry of Finance and Public Administration) for 2022-2024, in which 'MARLBORO' appears as the leading tobacco brand per unit volume and euro sales.

- **Exhibit 15**: printouts from numbeo.com relating to the cost of living in various EU member states, such as Austra, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Irland, Italy, Latvia, Lithuania, Malta, Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Spain, Sweden. They reference the price of ‘MARLBORO’ are an example of the cost of cigarettes.

- **Exhibits 16-19**: **rankings from independent parties relating to, inter alia, ‘MARLBORO’ in the tobacco industry**

  - **Exhibit 16**: series of rankings titled ‘BrandZ Top 100 Most Valuable Global Brands’ ’ published on rankingthebrands.com for the years 2011-2025. Marlboro was ranked among the top 40 brands for tobacco.

  - **Exhibit 17**: a ranking of the world’s most valuable brands in 2020 by Forbes. It ranks ‘MARLBORO’ 25th in the tobacco industry. MARLBORO’ is the only tobacco brand mentioned in the listings, among other leading brands such as Google, Apple, Microsoft and Coca-Cola.

  - **Exhibit 18**: a ranking titled ‘Marketing Malta’, dated 2012, which indicates that ‘MARLBORO’ is one of the top 10 global brands. Another ranking titled ‘Dutch brand top 100’, dated 2022, ranks Marlboro as the number 1 brand in the territory, with EUR 626.4 million of revenue.

  - **Exhibit 19**: a ranking titled ‘The Maxwell Report’, which, according to the opponent, is a prominent report on the tobacco industry. It ranks ‘MARLBORO’ in 1st place from 1984 until 2005. It does not refer to any particular territory.

- **Exhibits 20-23**: previous decisions and judgement issued by the Office and by national authorities/offices (e.g. in Bulgaria, the Czech Republic, Spain, and Latvia), regarding the reputation and/or well-known character of the ‘MARLBORO’ or Marlboro sign in various territories.

- **Exhibit 24**: **certificates issued in 2008 and 2009**

  Two certificates issued by ANDEMA (Asociación Nacional para la Defensa de la Marca), which, as the opponent states, is the Spanish organisation for brand protection. They indicate that ‘MARLBORO’ is a very well-known trade mark in national and international trade and has a level of inherent brand distinctiveness, and that the trade mark has been commercially present in Spain since 1970, maintaining a market share of 16.324 % in a highly segmented market. This fame is proved by, inter alia, the following criteria:

  That its fame and prestige have been proven by the fulfillment of the following criteria:

  - Its turnover, its market share,
  - The age of the trademark
  - Its intensity and effective use both in Spain and abroad.
  - Highly distinctive character associated with the trademark, both the word component and the graphic component associated with its colors.
  - Broad dissemination of the trademark, among the different types of economic operators and consumers of the most varied and extreme markets, even in markets other than the ones that correspond to the products protected by the MARLBORO brand, apart from the direct consumers of its products
  - Investments in advertising and sponsorship of events, especially sporting events.

- **Exhibit 25-29**: samples of ‘MARLBORO’ packs and cigarettes undated or dated from the 1980th to 2017, as well as some promotional activities within some EU member states. Some are dated in 2015-2016, and others are undated.

- **Exhibit 30**: Letters sent by Philip Morris Spain S.L. to the Spanish Tobacco Market Commissioner.

It is clear from the evidence listed above that the earlier mark has been used for a substantial period. In this regard, indications of the duration of use are particularly useful for determining the longevity of the mark. The longer the mark has been used in the market, the larger will be the number of consumers that are likely to have encountered it, and the more likely it is that such consumers will have encountered the mark more than once. Moreover, as indicated in Exhibit 2, Marlboro’s story began in the United States; consequently, several documents refer to that territory. However, the opponent provided sufficient evidence that corroborates the development of the earlier mark in the European Union as well.

Indeed, from the opponent’s annual reports (Exhibit 5), the various press articles (Exhibits 6-19), and the certificates (Exhibit 24), which refer to various EU member states, such as Belgium, the Czech Republic, Germany, Greece, Spain, France, Italy, Hungary, Malta, Austria, Romania, etc., it can be deduced that the mark’s **intensity and territorial extent of use** is widespread enough to cover a substantial part of the relevant territory (i.e. the European Union).

Furthermore, from the content of the press articles (Exhibits 6-19) and the annual reports (Exhibit 5), it is clear that not only has the use of the mark extended to the EU, but also that the relevant public has a considerable degree of recognition of the earlier mark for cigarettes. This is corroborated by the annual reports, which indicate that the market share for cigarettes in several EU member states, such as Belgium, the Czech Republic, Germany, Spain, France, Germany, Italy, Hungary, Austria, and Poland, is quite high. Furthermore, several documents show that the earlier mark has a leading position regarding *cigarettes*.

Other independent sources attest that the brand was among the world’s most valuable intangible assets long before the filing of the contested application, and that the trade mark ranked among the top 10 of the world’s most valuable global brands. This helps to put the evidence in the context of the European Union, as it provides indications of the sales volumes, market share and value associated with the mark. Furthermore, from the opponent’s annual reports it can be concluded that the ‘MARLBORO’ trade mark was used extensively in many countries in the European Union.

Therefore, an overall assessment of the submitted documents provides information on the extent of use of the earlier trade mark in the relevant territory, the actual degree of recognition among the relevant public, the nature and scale of the promotional activities undertaken by the opponent, and the market share held by the earlier mark. Bearing in mind the above, the Opposition Division concludes that the earlier trade mark has a high degree of reputation throughout the European Union for *cigarettes*, for which, inter alia, the opponent has claimed reputation.

The opponent provided no evidence regarding the remaining goods. Therefore, for these goods it has to rely on the inherent distinctiveness of the earlier mark which, considered what has been stated in the section c) above, is normal.

**e) Global assessment**

The appreciation of likelihood of confusion on the part of the public depends, inter alia, on the recognition of the earlier mark on the market, the association that can be made with the registered mark, and the degree of similarity between the marks 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. The relevant public is the public at large as well as business customers with specific professional knowledge or expertise, whose degree of attention varies from average to high. The earlier mark is reputed for cigarettes and has a normal degree of inherent distinctiveness for the remaining goods at issue.

The signs are visually and aurally similar to at most a very low degree and conceptually dissimilar. While the signs share the initial two letters 'Ma' and a comparable font in their respective impactful verbal elements 'Marlboro' and 'Manchester', the remaining letter sequences of those elements diverge entirely. Beyond this minimal coincidence, the contested sign further includes other elements which are absent from the earlier mark, and its overall vertical composite layout contrasts sharply with the single-word presentation of the earlier mark.

At the conceptual level, 'Marlboro' is a fanciful invented term carrying no meaning, whereas the contested signs' elements convey clear and immediately perceptible references. Conceptual differences may counteract aural and visual similarities, provided that, for the relevant public, the meaning of at least one of the signs is clear and specific, so that the public is capable of grasping it immediately (03/03/2004, T 355/02, Zirh, EU:T:2004:62, § 49; 27/10/2005, T 336/03, Mobilix, EU:T:2005:379, § 80; 21/09/2012, T 278/10, WESTERN GOLD / WeserGold et al., EU:T:2012:1257, § 58).

In the present case, the public will attribute a clear and precise meaning to the contested sign. The earlier mark will be perceived as meaningless. Therefore, overall, the signs will be perceived differently by the relevant public.

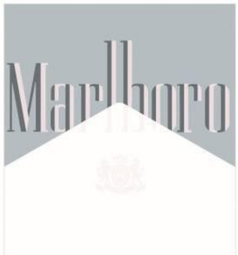
Even consumers who pay a high degree of attention need to rely on their imperfect recollection of trade marks (21/11/2013, T-443/12, ancotel. (fig.) / ACOTEL (fig.) et al., EU:T:2013:605, § 54). Account is also taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26). However, even applying the principle of imperfect recollection, the overall impressions created by the signs are so different — particularly given the entirely distinct dominant verbal elements, the additional figurative and verbal components of the contested sign, and the conceptual dissimilarity — that consumers at any level of attention are highly unlikely to confuse or associate the two marks.

Moreover, 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). In the present case, despite the identity or similarity between the goods, this factor cannot offset the overall at most very low visual and aural similarity and conceptual dissimilarity between the signs. There is nothing to prevent a finding that, in view of the circumstances of a particular case, there is no likelihood of confusion, even where goods are identical and there is a certain degree of similarity between the marks at issue (26/03/2020, T-343/19, SONANCE / conlance, EU:T:2020:124, § 63).

Considering all the above, there is no likelihood of confusion on the part of the public. Therefore, the opposition must be rejected.

The opponent has also based its opposition on the following earlier trade marks:

1) EUTM registration No 75 606, ‘MARLBORO’ (word mark)
2) EUTM registration No 18 515 324, ‘MARLBORO ONE’ (word mark);
3) EUTM registration No 18 618 141, 

;
4) EUTM registration No 18 618 142, 

;
5) EUTM registration No 18 822 617, 

;
6) EUTM registration No 18 822 712, 

;

7) EUTM registration No 18 972 764, 

;
8) EUTM registration No 19 104 878, ‘I AM MARLBORO’ (word mark).

The other earlier rights invoked by the opponent are less similar to the contested mark. This is because they contain further figurative elements or additional words which are not present in the contested trade mark. With regards to the marks containing the emblem, it is taken into account, in particular, that the impact of this similarity is very limited on account of the non-distinctive character of this device, as explained in the section c) above. Indeed, this coincidence is overshadowed by the remaining differing figurative and/or verbal elements present in these signs and, therefore, the earlier mark No. 1 023 145 was considered overall most similar to the contested sign.

Moreover, the remaining earlier rights cover the same or a narrower scope of the goods and the opposition has already been analysed for the sign that was considered most similar and in the context of the identical goods. Therefore, the most favourable scenario for the opponent has been already been considered and the outcome cannot be different with respect to goods for which the opposition has already been rejected; no likelihood of confusion exists with respect to those goods.

**REPUTATION — ARTICLE 8(5) EUTMR**

In relation to Article 8(5) EUTMR, the opponent invoked the following earlier rights:

1) EUTM registration No 75 606, ‘MARLBORO’ (word mark)
2) EUTM registration No 1 023 145, Marlboro
3) EUTM registration No 18 515 324, ‘MARLBORO ONE’ (word mark);
4) EUTM registration No 18 618 141, 

;

5) EUTM registration No 18 618 142, .

For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier international trade mark registration designating European Union No 1 023 145.

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.

Therefore, the grounds for refusal of Article 8(5) EUTMR are only applicable when the following conditions are met.

- The signs must be either identical or similar.

- The opponent's trade mark must have a reputation. The reputation must also be prior to the filing of the contested trade mark; it must exist in the territory concerned and for the goods and/or services on which the opposition is based.

- Risk of injury: use of the contested trade mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.

The abovementioned requirements are cumulative and, therefore, the absence of any one of them will lead to the rejection of the opposition under Article 8(5) EUTMR (16/12/2010, T-357/08, BOTOCYL / BOTOX, EU:T:2010:529, § 41; 16/12/2010, T-345/08, BOTOLIST / BOTOX, EU:T:2010:529, § 41). However, the fulfilment of all the abovementioned conditions may not be sufficient. The opposition may still fail if the applicant establishes due cause for the use of the contested trade mark.

In the present case, the applicant did not claim to have due cause for using the contested mark. Therefore, in the absence of any indications to the contrary, it must be assumed that no due cause exists.

**a) Reputation of the earlier trade mark**

The evidence submitted by the opponent to prove the reputation and highly distinctive character of the earlier trade mark has already been examined above under the grounds of Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR.

On the basis of the above the Opposition Division concludes that the earlier trade mark has strong reputation in the European Union for *cigarettes* in Class 34.

**b) The signs**

The signs have already been compared above under the grounds of Article 8(1)(b) EUTMR. Reference is made to those findings, which are equally valid for Article 8(5) EUTMR.

**c) The 'link' between the signs**

As seen above, the earlier mark is reputed and the signs are similar to some extent. In order to establish the existence of a risk of injury, it is necessary to demonstrate that, given all the relevant factors, the relevant public will establish a link (or association) between the signs. The necessity of such a 'link' between the conflicting marks in consumers' minds is not explicitly mentioned in Article 8(5) EUTMR but has been confirmed by several judgments (23/10/2003, C-408/01, Adidas, EU:C:2003:582, § 29, 31; 27/11/2008, C-252/07, Intel, EU:C:2008:655, § 66). It is not an additional requirement but merely reflects the need to determine whether the association that the public might establish between the signs is such that either detriment or unfair advantage is likely to occur after all of the factors that are relevant to the particular case have been assessed.

Possible relevant factors for the examination of a 'link' include (27/11/2008, C-252/07, Intel, EU:C:2008:655, § 42):

- the degree of similarity between the signs;

- the nature of the goods and services, including the degree of similarity or dissimilarity between those goods or services, and the relevant public;

- the strength of the earlier mark's reputation;

- the degree of the earlier mark's distinctive character, whether inherent or acquired through use;

- the existence of likelihood of confusion on the part of the public.

This list is not exhaustive and other criteria may be relevant depending on the particular circumstances. Moreover, the existence of a 'link' may be established on the basis of only some of these criteria.

Reference is made to the considerations regarding the nature of the goods, the relevant public, the strength of the earlier mark's reputation, the degree of the earlier mark's distinctive character, whether inherent or acquired through use and the existence of likelihood of confusion on the part of the public as presented in the section regarding Article 8(1)(b) EUTMR above.

Taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute. While the goods are identical or at least similar and target an overlapping relevant public, and while the earlier mark undeniably enjoys a high degree of reputation throughout the European Union for cigarettes, these factors alone are insufficient to establish a link, as it is well established that the reputation of a trade mark, even if high, does not automatically lead to the existence of a link between the trade marks.

The degree of similarity between the signs is the decisive factor here, and it weighs heavily against any finding of a link. The signs are visually and aurally similar to at most a very low degree, sharing only the initial two letters 'Ma' and a comparable typeface in their respective verbal elements 'Marlboro' and 'Manchester' — with divergence (contrary to the opponent's submissions) already occurring at the third letter and the sequence of the remaining letters differ entirely.

The impact of the shared font is particularly limited: the typeface used in both marks is rather standard and non-elaborate, lacking any striking stylisation or creative distinctiveness that could meaningfully contribute to a visual association between the signs. Therefore, the case 11/12/2014, T-480/12, MASTER, EU:T:2014:1062 cited by the opponent is not comparable to the present case, as the font used in the signs assessed in that case has been much more elaborated and memorable. Indeed, where a font is not unusual, its use in two different signs can be considered coincidental and carries negligible weight in the overall assessment. Beyond these minimal and unremarkable coincidences, the contested sign further incorporates a heraldic crest device and the words 'UNITED KINGDOM', reinforcing the overall different impression.

Moreover, the signs are conceptually dissimilar: 'Marlboro' is a fanciful, invented term carrying no meaning for the relevant public, whereas the dominant element of the contested sign, 'Manchester', conveys a clear, specific and immediately perceptible geographical reference — the well-known city in the United Kingdom — widely recognised across the EU in cultural, commercial and sporting contexts. Where the meaning of at least one of the signs is clear and specific so that it can be grasped immediately by the relevant public, conceptual differences may counteract visual and aural similarities and prevent any link from being made. Indeed, consumers encountering the contested sign in the tobacco sector will immediately perceive it as a geographical reference to Manchester, and not as a sign connected in any way with the fanciful word 'Marlboro'. It follows that the clear conceptual content of the contested sign, combined with their at most very low visual and aural similarity, effectively dispels any risk that the earlier reputed mark will be brought to mind.

The opponent refers to previous decisions of the Office and courts to support its arguments.

The Office is not bound by its previous decisions, as each case has to be dealt with separately and with regard to its particularities. This practice has been fully supported by the General Court, which stated that, according to settled case-law, the legality of decisions is to be assessed purely with reference to the EUTMR, and not to the Office's practice in earlier decisions (30/06/2004, T-281/02, Mehr für Ihr Geld, EU:T:2004:198).

Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.

The cited cases are not comparable because of several reasons:

1) they considered signs which font was much more elaborated than the one in the present case (for example the cited cases No. 2423658, 2092479, 1879553);

2) they considered signs that shared more letters than the ones in the present case (for example the cited cases No. 2509704, 1879553, 3158032, 19103828);

3) they considered signs that did not differ on account of the immediately perceptible concepts (for example the cited cases No. 2509704, 1879553)

4) they considered signs which were found similar on account of figurative device that is not present in the contested sign (R 1322/2018-2).

It follows that the opponent's arguments must be set aside.

With respect to the decisions of the Office, it is also taken into account that while the Office does have a duty to exercise its powers in accordance with the general principles of European Union law, such as the principle of equal treatment and the principle of sound administration, the way in which these principles are applied must be consistent with respect to legality. It must also be emphasised that each case must be examined on its own individual merits. The outcome of any particular case will depend on specific criteria applicable to the facts of that particular case, including, for example, the parties' assertions, arguments and submissions. Finally, a party in proceedings before the Office may not rely on, or use to its own advantage, a possible unlawful act committed for the benefit of some third party in order to secure an identical decision.

In view of the above, it follows that, even if the previous decisions submitted to the Opposition Division are to some extent factually similar to the present case, the outcome may not be the same.

The opponent claims that the Office should consider in its assessment the manner in which the contested sign is used on the market and quotes case-law to support its claims. It also provides the excerpts from the applicant's website in order to show how the contested mark is indeed being presented on the applicant's products. However, although these circumstances are indeed relevant for the assessment of the unfair advantage of the reputation of the earlier mark, they indeed do not affect the assessment of link between the signs which has to be objective.

Therefore, taking into account and weighing up all the relevant factors of the present case, the Opposition Division concludes that it is unlikely that the relevant public will make a mental connection between the signs in dispute, that is to say, establish a 'link' between them. Therefore, the opposition is not well founded under Article 8(5) EUTMR and must be rejected.

No link could be established also for the remaining rights invoked by the opponent under the Article 8(5) EUTMR. This is because the remaining rights, as already explained in the section a) above, are even less similar to the contested sign and the level of recognition found for them could not be any higher than the one already considered for the earlier mark No 1 023 145. Therefore, the opposition is not well founded under Article 8(5) EUTMR and must be rejected also for these earlier rights.

## 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 opponent is the losing party, it must bear the costs incurred by the applicant in the course of these proceedings.

According to Article 109(7) EUTMR and Article 18(1)(c)(i) EUTMIR, the costs to be paid to the applicant are the costs of representation, which are to be fixed on the basis of the maximum rate set therein.

**The Opposition Division**

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| Meglena BENOVA | Katarzyna ZYGMUNT | Tzvetelina IANTCHEVA |

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.