

O-228-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2271147
BY CODORNIU SA TO REGISTER THE TRADE MARK
LA ROSCA IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 80310 BY CORA S.P.A.**

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by Codorniu SA to register the trade mark
La Rosca in Class 33**

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**IN THE MATTER OF Opposition thereto
under No. 80310 by Cora S.p.A.**

Background

1. On 26 May 2001 Codorniu SA of Spain applied to register the mark LA ROSCA for “alcoholic beverages (except beer)” in Class 33. The application is numbered 2271147.
2. On 25 October 2001 Cora S.p.A. filed notice of opposition to this application. They are the proprietors of the trade mark BOSCA which is registered under No. 896250 in respect of wines and alcoholic aperitifs. The opponents say that the goods of their earlier trade mark are identical to the goods applied for and the marks are similar such that there exists a likelihood of confusion. They ask that the application be refused under Section 5(2)(b).
3. The applicants filed a counterstatement accepting that certain of the goods were identical but denying that the marks were sufficiently similar for there to be a likelihood of confusion.
4. Both sides ask for an award of costs in their favour.
5. Both sides filed evidence. The parties were advised, following review by a Registry Hearing Officer, that it was considered that a decision could be reached on the basis of the papers filed. The parties were nevertheless reminded of their right to be heard or to file written submissions. In the event neither side has requested a hearing or filed written submissions (though the evidence itself includes what amount to submissions). Acting on behalf of the Registrar I, therefore, take this decision based on the papers filed.

The Law

6. Section 5(2) reads:

“5.-(2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Sub-paragraph (b) applies here.

7. The registration relied on by the opponents is an earlier trade mark within the meaning of Section 6(1) of the Act.

Comparison of goods

8. The opponents’ registration is in respect of wines and alcoholic aperitifs. Evidence filed on the opponents’ behalf indicates at the time of registration there was a condition that the mark would be used in relation only to goods, the produce of Italy. That condition no longer applies having regard to the Transitional Provisions of the 1994 Act (Schedule 3 paragraph 3(1)) though the opponents advise that they have continued to comply with it. The point is in any case academic as there is no restriction on the origin of the applicants’ goods. Both, therefore, encompass wines and alcoholic aperitifs. To that extent at least identical goods are involved. The application in suit also covers a wider range of alcoholic beverages which are, or could be, closely similar.

Distinctive character of the opponents’ mark

9. The distinctive character of the respective marks is a factor to be taken into account. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it (*Sabel BV v Puma AG* [1998] ETMR 1, paragraphs 23 and 24).

10. The opponents have filed evidence of use of their mark with the intention of showing that it has an enhanced degree of distinctive character. The evidence in this respect comes from two sources – Edmund Harrison, the opponents’ professional adviser based on information supplied to him by the opponents and Paul Burton, the joint Managing Director of Intercontinental Brands (ICB) Ltd, the opponents’ UK importers/distributors. The main points to emerge from Mr Harrison’s evidence are as follows:

- the mark BOSCA has been used in the UK since 1966 in relation mainly to sparkling wines (commonly referred to as ‘asti’ or ‘spumante’) as well as vermouth;
- a number of different names are used including Verdi Spumante, Asti *****, Toselli Spumante, Crema Bosca and Verdi Imperial. I note that in some cases

Bosca appears to be used as the company/bottler name but in others is clearly used as a trade mark in its own right;

- the name itself is that of the founding family;
- information is given on the sale of CANEI and VERDI Spumante products. It would seem from Exhibit EH3 (page 85) and Exhibit EH2 that these products have also carried the mark BOSCA though whether this is universally so is not clear;
- the number of cases sold to the opponents' UK distributors is given as follows:

1994	1200 Cases
1995	6554 Cases
1996	65173 Cases
1997	81700 Cases
1998	36360 Cases
1999	29980 Cases
2000	1800 Cases
2001	7022 Cases

- the number of cases sold on by the distributors is said to have been:

1999	18,777 Cases
2000	3,140 Cases
2001	9,564 Cases

- invoices establishing the above trade are exhibited at EH4 and 6. Sales values to UK retailers are shown in EH5. By my calculations the latter show sales as follows (ignoring pence):

Verdi Spumante	£149,654 (all product sizes)
Crema Bosca	£ 62,782
Bosca Five Star	£ 2,420

These figures cover the period from May 1999 to May 2001 (this latter being the material date).

11. On the basis of the material before me I find that there has been mixed use of BOSCA with the word appearing in relation to certain products as the primary trade mark and in other cases as a second tier mark in support of, for instance, the mark Verdi.

12. In some cases it is not possible to say how use of BOSCA will be seen by consumers bearing in mind that it is also the name of the bottling company (Bosca SpA). However, even if these doubts could be resolved in the opponents' favour I am not in a position to say that the mark has achieved an enhanced degree of distinctive character that would bring it to the household name

standard referred to in *DUONEBS Trade Mark*, O-048-01. The volume of sales appears to be modest though not, I agree, insignificant. If the mark does enjoy a more significant reputation in the area of sparkling wines or vermouth then it would have been necessary to place the sales figures in context to demonstrate that this was the case.

13. There is additionally, the evidence of Mr Burton. He says, *inter alia*, that:

“The BOSCA products are referred to under a number of different names including VERDI IMPERIAL, VERDI SPUMANTE, CREMA BOSCA and BOSCA FIVE STAR (also referred to as ASTI *****).”

14. He goes on to say that sales of BOSCA products are subject to fluctuations in volume, but they have generally been a popular product and have been sold widely throughout the UK. He later says that BOSCA is “relatively well known” in the UK. Mr Burton is the opponents’ importer/distributor and scarcely, therefore, a disinterested party. He is nevertheless in a senior position and has lengthy experience of the drinks industry. It was held in *Antec v SWC* CH 1996 A No. 4720 (and by reference to a number of other cases) that:

“... it appears now to be clearly settled by authority which I should follow that the evidence of witnesses engaged in the relevant trade can give admissible evidence as to what would be the reaction of the end-user in a case of this kind.”

15. Mr Burton’s evidence cannot, therefore, be lightly dismissed. I, nevertheless, find his evidence somewhat ambiguous in terms of the extent to which the BOSCA mark itself is recognised (as distinct from Verdi). Furthermore, although he describes the mark BOSCA as being ‘relatively well known’ he does not say whether this reflects retailers’ or consumers’ views. The latter are likely to be of particular relevance.

16. Making the best I can of this material I do not consider the mark BOSCA can be said to enjoy an enhanced degree of distinctive character. So far as its inherent characteristics are concerned it seems that it is a family name but almost certainly not one that would be particularly well known in this country. I, therefore, approach the matter on the basis that BOSCA is likely to be taken as an invented word and is, therefore, entitled to claim a reasonably high degree of inherent distinctive character.

Comparison of marks

17. The visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by those marks bearing in mind their distinctive and dominant components, *Sabel v Puma* paragraph 23. The matter must be judged through the eyes of the average consumer of the goods/services in question, *Sabel v Puma*, paragraph 23, the average consumer is deemed to be reasonably well informed and reasonably circumspect and observant but rarely has the chance to make direct comparisons between marks. Imperfect recollection must, therefore, be allowed for, *Lloyd Schuhfabrik v Klijsen Handel*, paragraph 27.

18. The opponents submissions, contained in Ms Harrison's evidence, are to the effect that the marks are visually and conceptually similar. It is suggested that the words LA ROSCA mean the thread (of a screw) in Spanish and Portuguese but that, for the average English consumer, both marks would have no easily defined meaning. In any case it is said LA would be understood to mean 'the' and, therefore, little significance would be attached to it. The opponents are of the view that visual appreciation of the marks is the most likely circumstance of trade and that the difference between the letters R and B at the beginning of the words ROSCA and BOSCA is minimal and the letters can be misread as each other. They say that "there is nothing in the meaning of the word itself which would help the eye to anticipate the initial letter of the word". There are further submissions bearing on the manner in which bottles are displayed which I will deal with as part of the overall assessment of likelihood of confusion.

19. The marks at issue are LA ROSCA and BOSCA. Plainly the applicants' mark is two words. The opponents may well be correct in saying that the average consumer will understand the first element (LA) to be the definite article in Spanish. Even if that means that greater attention will be focussed on the second element of the mark it does not mean that LA will be ignored. It is a feature that plays a part in the visual appreciation of the mark. The second element ROSCA shares the last four letters in common with the opponents' mark. That is sufficient, in my view, to suggest that the respective marks have a degree of similarity. Against that the difference is in the first letter. The beginnings of words are generally considered to be more important for the purpose of distinction (*Tripcastroid* 42 RPC 264). The opponents suggest that the difference between the letters R and B is minimal. That overstates the position in my view. I do not think people are generally so careless in the use and appreciation of language/letters that casual mistakes will occur. I also bear in mind the characteristics of the average consumer and the fact that wines and other alcoholic beverages are usually purchased with a modicum of care not least because a selection has to be made from a wide range of products.

20. Aurally the position seems to favour the applicants. It is reasonable to suppose that both elements of their mark will be articulated and there is little oral similarity between the letters R and B. The differences are not, however, such as to displace completely the element of similarity that arises from the common endings of the respective marks.

21. Neither mark yields a ready meaning to English consumers. They will, I think, be seen as invented words or, perhaps more accurately, foreign words whose meaning is not apparent. It seems to me that conceptual considerations are, on the whole, less likely to be determinative of the outcome of this case than visual and aural ones.

Likelihood of confusion

22. This is to be appreciated globally taking account of all relevant factors (*Sabel v Puma*, paragraph 22). The opponents have filed state of the register evidence in support of their claim that they enjoy a monopoly in -OSCA suffixed trade marks in the UK in respect of wines. Mr Burton, too, says that he has not encountered any other trade mark for wines with the suffix -OSCA. The applicants' in turn have filed evidence to suggest that this is not the case. In *British Sugar Plc v James Robertson & Sons Ltd*, [1996] RPC 281, it was said by Mr Justice Jacob (as he then was):

“Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual enquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

23. The state of the register evidence is, therefore, of little assistance. Of rather more relevance is evidence from the applicants that the mark LUIGI BOSCA is used in relation to wines in this country. Internet material has been filed to show that Luigi Bosca is an old established Argentinian wine producer. Luigi Bosca wines are stated to have won international competitions, including events hosted in the UK and to be listed by well known wine writers such as Robert Parker and Hugh Johnson. Exhibits SJW2 and 3 to evidence from Mr Wise, the applicants’ professional representative, has been filed in support of these claims. I note, too, that a number of items within the exhibits pre-date the application filing date. The clear inference is that if LUIGI BOSCA can live with BOSCA without evidence of any confusion then so too can LA ROSCA. It is a superficially attractive argument but I am not persuaded that it is, in itself, an answer to the opposition. The opponents’ evidence suggests that their mark is known for sparkling wines and vermouth. They seem, therefore, to be in a different area of the trade to the wines from LUIGI BOSCA (having regard to the information in Exhibits SJW2 and 3).

24. Furthermore it is part of the applicants’ case that wines are displayed by country of origin and hence the parties’ product offerings would be in different areas. If that is so then it would also follow that LUIGI BOSCA Argentinian wines would not be adjacent to the opponents’ Italian wines. However, whilst I accept that country of origin is often used as a basis for classifying and displaying wines (particularly in larger wine stores and supermarkets) it may not always be the case. In any case the applicants’ goods are not limited to Spanish wines. Furthermore as the applicants also produce a sparkling wine any classification/display by wine type as opposed to country of origin may bring the parties’ products closer together.

25. There is one further point I should mention. The opponents have filed photographic evidence (Exhibits EH8 and 9) to show the effect of displaying bottles of wine at different angles and hence obscuring part of the mark. I accept that it is in the nature of product display that bottle labels may not always be ‘full-on’ to the consumer. Equally consumers of wines can be expected to exercise a reasonable degree of care and attentiveness in the purchasing process. This will often involve inspecting bottles prior to purchase. In fact even the casual or less informed purchaser is unlikely in my view to be so indiscriminating that he or she fails to pay at least reasonable regard to the brand and other information on the label.

26. I, therefore, come back to the marks themselves bearing in mind that they could be used on identical or closely similar goods. I have hesitated over the answer to the question of whether there is a likelihood of confusion not least because where invented words are concerned

particular care must be taken to allow for the possible effects of imperfect recollection. I think it is quite possible that consumers noticing the common and unusual suffix –OSCA in the applicants' mark may recall the mark BOSCA. On the balance of probabilities I think it is unlikely that they will do so without also noticing the different first letters of the words of which that element is a major part and also the additional element LA in the mark applied for. Taking all these factors into account the opponents have not satisfied me that there is a likelihood of confusion nor that consumers might be led to think that the respective goods came from the same or economically linked undertakings. For these reasons the opposition fails.

27. The applicants are entitled to a contribution towards their costs. I order the opponents to pay them the sum of £1250. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12TH day of August 2003

**M REYNOLDS
For the Registrar
the Comptroller General**