

O-084-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3139175
BY BROADLAND WINERIES LTD
TO REGISTER THE TRADE MARK:**

Maroro

IN CLASSES 32 AND 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406228
BY GESTIONI PICCINI S.R.L.**

BACKGROUND AND PLEADINGS

1. On 4 December 2015, Broadland Wineries Ltd (“the applicant”) applied to register the trade mark **Maroro** for the following goods:

Class 32 Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines.

Class 33 Alcoholic beverages (except beers); alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

The application was published for opposition purposes on 11 December 2015.

2. The application is opposed by Gestioni Piccini s.r.l. (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon European Union Trade Mark (“EUTM”) registration no. 9746173 for the trade mark **MEMORO**, applied for on 17 February 2011 and for which the registration procedure was completed on 9 June 2011. The opponent relies upon all of the goods in its registration, namely, in class 33, “alcoholic beverages (except beers)”.

3. In its Notice of Opposition, the opponent claims that there is a likelihood of confusion, including the likelihood of association, because the marks are highly similar and because the goods are identical or highly similar.

4. The applicant filed a counterstatement denying that there is a likelihood of confusion. It disputes that the goods are similar and argues that “[t]here are sufficient visual, phonetic and conceptual differences between the respective marks to allow consumers to distinguish them”.

5. Both sides seek an award of costs.

6. Both parties are professionally represented, the applicant by Wildbore & Gibbons LLP, the opponent by Lysaght. Both parties filed evidence. I have read all of the evidence carefully; I will summarise it only to the extent that I consider necessary.

7. No hearing was requested. Only the applicant filed written submissions in lieu, though the opponent filed submissions (entitled “substantiation of opposition”) during the course of proceedings. This decision is taken following a careful reading of all of the papers.

Evidence

Opponent's evidence

8. This consists of the statement of Mario Piccini (provided on the tribunal's “statement of use” template) and eight exhibits, verified by a statement of truth. Mr Piccini gives his position as “Legale [sic] Representative of the firm Gestioni Piccini s.r.l.”. He states that the mark has been used continuously in the UK and Ireland since 2011. Mr Piccini states that “production of MEMORO wine in 2011 was around 500,000 bottles and that by the end of 2014 this had risen to 4,000,000 bottles. The majority of these sales were within the EU”. He indicates that the wine is typically priced between £6 and £9 per bottle.

9. Exhibit 1 is an article from www.thedrinksreport.com about the launch of Piccini Memoro wine. The article is dated 1 April 2011 and includes the name of the supplier in the UK, PLB.

10. Exhibit 2 is a wine review dated 20 October 2011 from www.windowonwine.co.uk, entitled Piccini Memoro NV. It indicates that the wine is available at Tesco, with the price given in sterling.

11. Exhibit 3 is a screen print from youtube.com. There is an image of a bottle with “MEMORO” in stylised font on the label. The print appears to show that Piccini Memoro was wine-pages.com’s wine of the week on 30 October 2011. The wine is said to be available at Tesco, priced in sterling, and the review was uploaded on 24 October 2011.

12. Exhibit 4 consists of product information and customer reviews of the Piccini Memoro wines, taken from www.tesco.com. The pages themselves are not dated but four reviews for the “Piccini Memoro Vintage” are dated between August and October 2015,¹ while two for the “Piccini Memoro Red” are dated September and November 2015.²

13. Exhibit 5 shows images of the opponent’s product packaging. At question 5, Mr Piccini states that the packaging relates to wines launched in 2011, 2012 and 2013.

14. Exhibits 6 and 7 are said to be extracts of financial data which detail “sales through PLB Group Ltd, including in particular to Tesco stores in the UK and Ireland and also to Morrisons stores”. The names “PLB Group Ltd”, “Tesco”, “Tesco Ireland” and “Morrisons” are visible. However, the documents are in Italian and are neither translated nor explained in any detail. Although some figures are given, it is not clear to what the sums relate and the mark is not shown. As a consequence, this evidence does not assist the opponent.

15. Exhibit 8 is an article taken from plb.co.uk about PLB Group Ltd. The article is not dated but refers to staff being “experts in the UK Off Trade”.

¹ pp. 2-3.

² p. 5.

Applicant's evidence

16. This consists of the witness statement of Jonathon Lansley, CEO of the applicant, and four exhibits. His witness statement includes both evidence and submission, the latter of which I will not detail here but will bear in mind.

17. Exhibit 1 consists of a definition of the term “memoro” from Wiktionary, search results for “memoro” from Wikipedia, a print from www.memoro.org and an image of the back label of Piccini Memoro wine, said to be the result of a web search. None of the prints is dated, save for the printing date of 24 October 2016 on pages 1-3.

18. Exhibit 2 consists of search results for “maroro” from www.tesco.com and www.tesco.com/wine, which are not dated apart from the printing date of 25 October 2016. Mr Lansley states that the exhibit shows that “search engine taxonomy does not confuse the names ‘maroro’ and ‘memoro’”. That may be the case but the matter must be determined not on the basis of a technical matrix but from the perspective of the average (human) consumer and the exhibit is thus of limited use to the applicant.

19. Exhibit 3 is a definition of “maroro” from maori.org.ck, dated 13 May 2014.

20. Exhibit 4 shows images of packaging bearing the applicant's and the opponent's marks. The images are not dated.

21. That concludes my summary of the evidence, to the extent that I consider it necessary.

Section 5(2)(b)

22. Section 5(2)(b) of the Act reads as follows:

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

(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”.

23. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

24. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, above, which qualifies as an earlier trade mark under the above provisions. Although there was some confusion as to the relevant period and proof of use in the pleadings, it is evident that the opponent’s earlier mark had not been registered for five years or more at the publication date of the opposed application. It is not subject to the proof of use provisions under section 6A of the Act and the opponent can, as a consequence, rely upon all of the goods in its specification.

25. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

27. The specifications for both marks cover beverages and syrups for making beverages. I consider that the average consumer of the goods at issue is a member of the general public, though in the case of the alcoholic beverages, that will be an adult over 18.

28. In my experience, the goods at issue are sold through a range of channels including restaurants, bars and public houses. They are also commonly sold in supermarkets, off-licences and their online equivalents. In restaurants, bars and public houses, the goods are likely to be on display, for example, in bottles, in optics or in fridges behind the bar. They may also be shown on drinks menus, where the trade mark will be visible. While I do not discount that there may be an aural component in the selection and ordering of the goods in bars, restaurants and public houses, this is likely to take place after a visual inspection of the bottles or drinks menu (see *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04 (GC)). In retail premises, the goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will most likely select the goods having viewed an image displayed on a web page. I am, therefore, of the view that the selection of the goods at issue will be primarily visual, although aural considerations will play a part.

29. The level of attention paid to the purchase of the goods at issue is likely to vary. Soft drinks (e.g. mineral and aerated waters, fruit juices) and syrups for making beverages are reasonably frequent, inexpensive purchases selected routinely from supermarket

shelves and their online equivalents. The attention paid to the selection process for these goods is likely to be fairly low, though it will not be the most casual of purchases. Alcoholic beverages and their low- and no-alcohol equivalents tend to be slightly more costly than soft drinks and the average consumer is likely to be attentive to the level of alcohol, as well as taking care to choose a particular type or flavour of beverage. These goods will be purchased with an average level of attention.

Comparison of goods

30. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

31. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

32. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if specifications are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

33. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert

sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

34. As far as complementarity is concerned, in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between services. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

35. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods and/or services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

36. I also bear in mind the guidance in the same case, where Mr Alexander warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

37. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

38. The opponent submits that the goods in the specification applied for are at least highly similar, if not identical, to the goods in the earlier specification. The applicant admits that “alcoholic wines” are covered by the earlier specification but argues that the other goods are not similar. This submission is, however, made on the basis that the opponent relies only upon “wines” and I have explained at paragraph 24, above, why the opponent is entitled to rely upon all of the goods for which its mark is registered.

Alcoholic beverages (except beers); alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails

39. All of these terms are included in the opponent’s “alcoholic beverages (except beers)”. The goods are identical, on the principle outlined in *Meric*.

Beers; shandy

40. Although beers are expressly excluded from the specification of the earlier mark, it is still possible for the goods to enjoy a degree of similarity. The opponent's "alcoholic beverages" covers a wide range of alcoholic drinks, which would include both short drinks high in alcohol, such as spirits, and longer drinks with a lower alcohol content, such as cider and perry. As a consequence, the respective goods may be similar in nature. The intended purpose of both is a pleasurable drinking experience, which may include the intoxicating effects of alcohol. The users and method of use are identical. The goods are likely to share channels of trade and in retail premises may be located not only in the same aisle but also on the same shelf. The goods may be in competition but they do not have a complementary relationship. "Beers" and "shandy" are similar to the opponent's goods to a high degree.

Non-alcoholic beers

41. Non-alcoholic beers may be marketed as an alternative to low-alcohol versions of goods covered by the opponent's specification, such as low-alcohol cider and perry. There is some difference in nature and purpose but the goods are likely to share users. As both are long drinks with no or low alcohol content they may be in competition, with one being a substitute for the other. They are likely to share channels of trade and be sold in close proximity to one another. There is a reasonably high degree of similarity between these goods.

Non-alcoholic drinks; de-alcoholised drinks, non-alcoholic wines

42. The goods in the opponent's specification self-evidently contain alcohol. There is, therefore, some difference in nature between those goods and the non-alcoholic drinks for which registration is sought. Having said that, the nature of the goods may in all other respects be identical, as the opponent's specification covers low-alcohol and alcoholic versions of the same drinks. The users, methods of use and channels of trade

are all likely to coincide, although I acknowledge that the users of alcoholic drinks will be over 18 years of age. As the goods in the application are likely to be marketed as an alternative to their alcoholic equivalents, they are in competition. The goods are not complementary as defined in the case law. I consider that the goods are similar to a reasonably high degree.

Mineral and aerated waters; fruit drinks and fruit juices

43. These goods are all soft drinks. The goods are similar in nature, to the extent that they are all drinks. However, there is a difference in intended purpose, the goods applied for being primarily for slaking the thirst while the opponent's goods are intended for relaxation or, potentially, intoxication. The users will all be members of the public, though the opponent's goods are restricted to adults. The channels of trade may coincide, insofar as the goods may be sold in the same premises or on the same websites. However, in retail outlets such as supermarkets and off-licences, the goods would typically be located in separate aisles. The goods are not in direct competition and, although they may be used together, are not complementary in the sense that the average consumer would expect responsibility for them to lie with the same or an economically connected undertaking. I find that the goods are similar to a low degree.

Syrups for making beverages

44. These goods are added to another liquid to make a drink. They are similar to the opponent's goods in that they are also liquids, though they are likely to be more viscous. They are usually concentrated and not intended to be consumed on their own. They may share users but they are unlikely to be located in the same section of retail premises as alcoholic beverages, they are not in competition and, for the same reasons as given above, are not complementary in the sense defined in the case law. The goods share a very low degree of similarity with the opponent's goods.

Comparison of trade marks

45. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

46. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

47. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

48. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
MEMORO	Maroro

49. Neither mark breaks down into separate elements, so their overall impression and distinctiveness lie in their totality. The marks are of equal length and both begin with the letter “M”. However, the next two letters are quite different (E-M in the earlier mark as opposed to “a-r” in the application). The combination “M-a-r-o” at the beginning of the applicant’s mark also strikes me as a combination which is unusual in English and visually conspicuous as a result. The final three letters of each mark are identical. The difference between the use of lower and upper case is not relevant, as notional and fair use would permit use of either mark in upper or lower case. Visually, there is a medium degree of similarity between the marks.

50. From an aural perspective, the earlier mark will be articulated “MEM-OR-OH”, while the application will be pronounced “MA-ROR-OH”. Each has three syllables, starts with an “M” sound and ends with “O”. However, there is a striking phonetic difference because of the differing vowel sounds at the beginning of the marks. I consider that there is a medium degree of aural similarity between the marks.

51. While the earlier mark might, to some, be evocative of the word memory/memories because of the commonality of the first five letters, the ending of the mark is very different. Taking the mark as a whole, I do not consider that memory/memories is a clear concept which will be identified by the average consumer.³ The opponent has submitted that the average consumer may perceive the final three letters in each mark (“ORO”) as the Spanish or Italian word for “gold”. I have no evidence to show how commonly Italian or Spanish is spoken in the UK. Some individuals may identify the word “ORO”/“oro” within the marks but I think it unlikely that the average consumer will deconstruct the mark in the way suggested by the opponent, not only because the UK consumer is notoriously monolingual but also because the beginnings of the marks (“MEM-”/ “Mar-”) do not have a meaning of their own which would prompt the consumer to divide them from the remainder of the mark.

³ For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer (see Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29).

52. The applicant has submitted that “maroro” is a type of flying fish and has filed evidence to show that that is the case.⁴ However, the word appears to be a Maori term and the evidence does not show that it is commonly understood in the UK. I do not consider that the average UK consumer would know this meaning of the word. I find that neither mark has a distinct meaning and that the conceptual position is neutral, there being neither conceptual similarity nor dissimilarity.

Distinctive character of the earlier trade mark

53. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

⁴ Exhibit 3.

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)".

54. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities (KODAK is the paradigm example). I consider that the earlier mark, notwithstanding its possible evocation to some of the word "memory", will be perceived as an invented word. As a consequence, I find that the earlier mark has a high degree of inherent distinctive character.

55. I indicated, above, that the exhibits provided by the opponent do not establish the level of sales it has achieved under the mark. On the basis of the evidence filed, I am not in a position to determine that the earlier mark has an enhanced distinctive character in relation to goods in class 33. I should make it clear that, even if the opponent's evidence were persuasive on this point, it is unlikely that its position would be improved materially, given my finding that the earlier mark is inherently highly distinctive.

Likelihood of confusion

56. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average

consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. Determining whether there is a likelihood of confusion is not scientific: there is no one formula to apply; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

57. In making my decision, I bear in mind the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, where it noted that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar".⁵

58. I have found that the goods in the application share varying degrees of similarity with the goods in the earlier specification and that the level of attention with which the average consumer will make the purchase will also vary: for those goods which have only a low or very low degree of similarity with the opponent's goods, the level of attention will be fairly low, while those goods which are similar to a reasonably high or high degree, or which are identical, will be selected with an average level of attention. I also bear in mind that the earlier mark is inherently highly distinctive, which increases the likelihood of confusion. I have found that the marks share a medium degree of visual similarity and that the purchase will be primarily visual. However, although both marks begin with an "M" and end in "ORO", I consider that the visual and phonetic differences created by the different second and third letters, in positions where they are likely to have a significant impact on the average consumer, are sufficiently marked that there is no likelihood of confusion, direct or indirect, even when the effects of imperfect recollection are taken into account. I consider this to be the case both in circumstances where the goods are similar to a reasonably high or high degree, or are identical, and where the average consumer pays an average level of attention to the purchase, and where the goods are purchased with a lower level of attention but where there is only a low or very low degree of similarity between the goods.

⁵ See also *Castellani SpA v OHIM*, T-149/06 and *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07; in *CureVac GmbH v OHIM* (T-80/08) identical beginnings between marks were not decisive.

Conclusion

58. The opposition has failed. Subject to appeal, the application will proceed to registration.

Costs

59. As the applicant has been successful, it is entitled to a contribution towards its costs. Both parties filed evidence. The applicant's evidence did not assist me in making my decision and I make no award in respect of it. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 4 of 2007. Using that TPN as a guide but bearing in mind my comments, above, I award costs to the applicant on the following basis:

Considering the notice of opposition and filing a counterstatement:	£200
Considering the other party's evidence:	£250
Written submissions	£300
Total:	£750

60. I order Gestioni Piccini s.r.l. to pay Broadland Wineries Ltd the sum of **£750**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 22nd day of February 2017



Heather Harrison
For the Registrar
The Comptroller-General