



OPPOSITION No B 2 406 885

Consorzio Di Tutela Della Denominazione Di Origine Controllata Prosecco, Piazza Filodrammatici 3, 31100 Treviso, Italy (opponent), represented by **Ferdinando Albisinni**, Via Ciro Menotti 4, 00195 Rome, Italy (professional representative)

a g a i n s t

J. Bünting Beteiligungs AG, Brunnenstr. 37, 26789 Leer / Ostfriesland, Germany (applicant), represented by **Boehmert & Boehmert Anwaltspartnerschaft Mbb - Patentanwälte Rechtsanwälte**, Hollerallee 32, 28209 Bremen, Germany (professional representative).

On 07/09/2015, the Opposition Division takes the following

DECISION:

1. Opposition No B 2 406 885 is partially upheld, namely for the following contested goods:

Class 32: *Beer and brewery products; non-alcoholic beverages; preparations for making beverages*

Class 33: *Alcoholic beverages (except beer)*

2. Community trade mark application No 12 743 671 is rejected for all the above goods. It may proceed for the remaining goods and services.
3. Each party bears its own costs.

REASONS:

The opponent filed an opposition against all the goods and services of Community trade mark application No 12 743 671 in Classes 30, 32, 33 and 43. The opposition is based on, inter alia, Collective Community trade mark registration No 11 619 764 and on an earlier sign used in the course of trade, namely European Protected Designation of Origin 'PROSECCO' number PDO-IT-A0516. The opponent invoked Article 8(1)(b), 8(4) and 8(5) CTMR.

LIKELIHOOD OF CONFUSION – ARTICLE 8(1)(b) CTMR

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 right. For reasons of procedural economy, the Opposition Division will first examine the opposition in relation to earlier Collective Community trade mark No 11 619 764.

a) The goods and services

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

Class 3: *Perfumery; Ethereal oils; Cosmetics; Hair lotions.*

Class 14: *Costume jewellery and jewellery; Cuff links, tie clips and pins; Medallions, Ornamental novelty badges, Buckles, Buttons, studs, Key rings, Coasters, Paper weights, All of the aforesaid goods made of precious or semi-precious metals, or coated therewith; Watches, pocket watches and clocks.*

Class 16: *Stationery, Printed matter, Pictures, Photographs, Posters, Newspapers, Reviews, Comic booklets, Printed publications, Handbooks [manuals], Catalogues, Calendars, diaries; Stickers, transfers; Books, Periodical, Booklets, Pamphlets.*

Class 18: *Leather and imitations of leather, and goods made of these materials and not included in other classes; Animal skins, hides; Trunks and travelling bags; Umbrellas and parasols; Walking sticks; Whips, harness and saddlery; Luggage and cases; Rucksacks and knapsacks; Handbags, Purses, Sling bags, Sportsbags, School bags, school satchels,, Writing set cases; Parasols and umbrellas; Wallets, book covers and key fobs, all of leather or imitation leather.*

Class 25: *Clothing, footwear, headgear.*

Class 33: *Wine, sparkling wine.*

Class 35: *Promotions which aims to raise awareness of Controlled Designation of Origin Prosecco produced by individuals in a production chain in accordance with the Rules of Production of Controlled Designation of Origin Prosecco and of this Controlled Designation of Origin, including attendance at trade fairs and organisation of publicity and promotional campaigns and by means of sponsorship agreements relating to commercial events; Development and support of commercial initiatives and events to promote Controlled Designation of Origin Prosecco and its image and reputation; Promotion of Prosecco and of Controlled Designation of Origin Prosecco by means of sponsorship agreements relating to informational, educational, cultural and sporting events.*

Class 41: *Organisation of trade fairs, Publishing services (including electronic publishing services), expositions, Seminars, Round tables, Cultural activities; Development and support of information, educational, cultural and sporting initiatives and events to promote Controlled Designation of Origin Prosecco and the related Controlled Designation of Origin and to promote its image and reputation.*

The contested goods and services are the following:

Class 30: *Prepared meals and savoury snacks, in particular snacks based on corn, cereals, flour and sesame, biscuits and crackers, dumplings, pancakes, pasta, rice and cereal foodstuffs, pastes and farinaceous foods, sandwiches and pizzas, spring rolls and seaweed rolls, steamed buns, tortilla foodstuffs; Cooking salt, Spices,*

Spices; Flavouring for beverages; Baked goods, confectionery, chocolate and desserts; Sugars, natural sweeteners, sweet coatings and fillings, bee products; Ice, ice creams, frozen yogurts and sorbets; Coffee, teas and cocoa and substitutes therefor; Processed grains, starches, and goods made thereof, baking preparations and yeasts.

Class 32: Beer and brewery products; Non-alcoholic beverages; Preparations for making beverages.

Class 33: Preparations for making alcoholic beverages; Alcoholic beverages (except beer).

Class 43: Temporary accommodation; Animal boarding; Rental of furniture, linens and table settings; Provision of food and drink; Consultancy and information in relation to the aforesaid services, included in this class.

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

The terms 'in particular' and 'including', used in the applicant's and the opponent's list of goods and services, indicates that the specific goods and services are only examples of items included in the category and that protection is not restricted to them. In other words, it introduces a non-exhaustive list of examples (on the use of 'in particular' see a reference in judgment of 09/04/2003, T 224/01, 'Nu Tride').

The relevant factors relating to the comparison of the goods or services include, inter alia, the nature and purpose of the goods or services, the distribution channels, the sales outlets, the producers, the method of use and whether they are in competition with each other or complementary to each other.

Contested goods in Class 30

The contested goods *prepared meals and savoury snacks, in particular snacks based on corn, cereals, flour and sesame, biscuits and crackers, dumplings, pancakes, pasta, rice and cereal foodstuffs, pastes and farinaceous foods, sandwiches and pizzas, spring rolls and seaweed rolls, steamed buns, tortilla foodstuffs; cooking salt, spices; flavouring for beverages; baked goods, confectionery, chocolate and desserts; sugars, natural sweeteners, sweet coatings and fillings, bee products; ice, ice creams, frozen yogurts and sorbets; coffee, teas and cocoa and substitutes therefor; processed grains, starches, and goods made thereof, baking preparations and yeasts* are dissimilar to all the opponent's goods and services in Classes 3, 14, 16, 18, 25, 33, 35 and 41. The contested goods are produced by different manufacturers, have different purpose, nature and are not in competition with each other. Therefore they are dissimilar.

Contested goods in Class 32

The contested *beer and brewery products* are similar to the earlier *wine, sparkling wine*. Although their production processes are different, these goods all belong to the same category of alcoholic drinks (nature) intended for the general public. They can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. These drinks can be found in the same area of supermarkets, even if among them some distinction according to their respective subcategory, for example, can also be made. Furthermore, these goods may originate from the same undertakings.

The contested *non-alcoholic beverages; preparations for making beverages* are similar to low degree to *wine*. Wine is an alcoholic beverage. Wines are sold side by side both in shops, bars and on drinks menus etc. These goods are directed at the same public and they may be in competition. It must be concluded that these goods are similar to a low degree, as they can coincide in end user, distribution channels and method of use.

Contested goods in Class 33

The contested *alcoholic beverages (except beer)* include, as a broader category, the opponent's *wine*. It is impossible for the Opposition Division to filter these goods from the abovementioned category. Since the Opposition Division cannot dissect *ex officio* the broad category of the applicant's goods, they are considered identical to the opponent's goods.

The contested goods *preparations for making alcoholic beverages* are dissimilar to the opponent's *wine, sparkling wine*. While it is true that these goods may be consumed in the same places and on the same occasions and may satisfy the same need (and only after mixing it), for example, enjoyment of a drink as an aperitif, the fact remains that they do not belong to the same family of alcoholic beverages and that the consumer perceives them as two distinct products. The goods are not normally displayed in the same shelves in the areas of supermarkets and other outlets selling drinks. They are also dissimilar to all the other opponent's goods and services in Classes 3, 14, 16, 18, 25, 35 and 41. The contested goods are produced by different manufacturers, have different purpose, nature and are not in competition with each other

Contested goods in Class 43

The contested services *temporary accommodation; animal boarding; rental of furniture, linens and table settings; provision of food and drink; consultancy and information in relation to the aforesaid services, included in this class* are dissimilar to all the opponent's goods and services in Classes 3, 14, 16, 18, 25, 33, 35 and 41. The contested services are produced by different manufacturers, have different purpose, nature and are not in competition with each other. Therefore they are dissimilar.

b) The signs



Earlier trade mark

t-secco

Contested sign

The relevant territory is the European Union. For reasons of procedural economy the Opposition Division will focus on the part of the relevant public who does not

understand any meaning of the marks, for example the Polish and Lithuanian-speaking part of the relevant public.

Visually, the signs are similar to the extent that they coincide in the letters 'SECCO'. However, they differ in the letters 'DOC PRO-* PDO' and the display of the letters 'DOC PROSECCO PDO' forming a circular shape made of nine wine glasses with decorated line elements and some circles placed above such glasses of the earlier mark and the letter 't' followed by an hyphen of the contested mark.

Aurally, irrespective of the different pronunciation rules in different parts of the relevant territory the pronunciation of the signs coincides in the syllables 'SE-CCO' present identically in both signs, and to that extent the signs are aurally similar. The pronunciation differs in the syllables 'DOC-PRO-* -PDO' of the earlier sign and the letter 't' of the contested sign which have no counterpart in the marks.

Conceptually, neither of the signs has a meaning for the public in the relevant territory. Since a conceptual comparison is not possible, the conceptual aspect does not influence the assessment of the similarity of the signs.

Taking into account the abovementioned visual and aural coincidences, the signs under comparison are similar.

c) Distinctive and dominant elements of the signs

In determining the existence of likelihood of confusion, the comparison of the conflicting signs must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.

The earlier mark has no element that could be clearly considered more distinctive than other elements.

The earlier mark has no element which could be considered more dominant (visually eye catching) than other elements.

The contested mark has no elements which could be considered more distinctive or dominant (visually eye-catching) than other elements.

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.

The opponent claims enhanced distinctiveness of the mark. However, for reasons of procedural economy, the evidence filed by the opponent to prove this claim does not have to be assessed in the present case (see below in 'Global assessment').

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se. In the present case, the earlier trade mark as a whole has no meaning for any of the goods and services in question from the perspective of the public in the relevant territory. Therefore, the distinctiveness of the earlier mark must be seen as normal.

e) 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.

In the present case, the goods found to be identical, similar, or similar to a low degree are directed at the public at large. The degree of attention of the relevant public in relation to these goods will be average.

f) Global assessment, other arguments and conclusion

In the present case the contested goods and services have been found partly identical, partly similar, partly similar to a low degree and partly dissimilar to the goods and services of the earlier mark.

As stated above, the distinctiveness of the earlier mark has been considered as normal.

The signs in question are visually and aurally similar to the extent that they have the verbal element 'SECCO' in common. The earlier and the contested marks additionally consist of the letters and 'DOC PRO-* PDO', the decorative elements and the letter and symbol 't'.

The goods that have been found identical, similar or lowly similar are alcoholic beverages, beer and brewery products, non-alcoholic beverages and preparations for making beverages. Alcoholic beverages, beers, non-alcoholic beverages and preparations for making beverages are traditionally ordered orally (judgment of 23/11/2010, T-35/08, 'Artesa Napa Valley' para. 62; judgment of 13/07/2005, T-40/03, 'Julián Murúa Entrena' para. 56; and judgment of 12/03/2008, T-332/04, 'Coto d'Arcis' para. 38). Hence, it is appropriate in this case to attach particular importance to the phonetic similarity between the signs in the finding of likelihood of confusion between the marks below for wine despite their visual differences.

Since the relevant average consumer only rarely has the chance to make a direct comparison between the different signs and must rely on an imperfect recollection of them, if so the Lithuanian and Polish-speaking consumer that has an imperfect recollection of the earlier mark, could confuse it with the contested with mark 't-secco' or imagining that it is a variation of the earlier mark, having therefore the same commercial origin being the goods identical similar and lowly similar.

Considering all of the above, the Opposition Division finds that there is a likelihood of confusion on the part of the Lithuanian- and Polish-speaking public and, therefore the opposition is partially well founded on the basis of the opponent's Community trade mark registration No 11 619 764.

It follows from the above that the contested trade mark must be rejected for the goods which have been found to be identical, similar and similar to a low degree to those covered by the earlier trade mark.

The rest of the contested goods and services are dissimilar. As similarity of goods and services is a necessary condition for the application of Article 8(1) CTMR, the opposition based on this article and directed at these services cannot be successful.

The Opposition Division will now examine the remaining ground on which the opposition is based, namely Article 8(4) CTMR.

NON-REGISTERED MARK OR ANOTHER SIGN USED IN THE COURSE OF TRADE – ARTICLE 8(4) CTMR

The Opposition is also based on an earlier sign used in the course of trade, namely European Protected Designation of Origin 'PROSECCO' number PDO-IT-A0516.

According to Article 8(4) CTMR, upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade of more than mere local significance, the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:

- (a) rights to that sign were acquired prior to the date of application for registration of the Community trade mark, or the date of the priority claimed for the application for registration of the Community trade mark;
- (b) that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark.

Therefore, the grounds of refusal of Article 8(4) CTMR are subject to the following requirements:

- the earlier sign must have been used in the course of trade of more than local significance prior to the filing of the contested trade mark;
- pursuant to the law governing it, prior to the filing of the contested trade mark, the opponent acquired rights to the sign on which the opposition is based, including the right to prohibit the use of a subsequent trade mark;
- the conditions under which the use of a subsequent trade mark may be prohibited are fulfilled in respect of the contested trade mark.

These conditions are cumulative. Therefore, where a sign does not satisfy one of those conditions, the opposition based on a non-registered trade mark or other signs used in the course of trade within the meaning of Article 8(4) CTMR cannot succeed.

a) Prior use in the course of trade of more than mere local significance

The condition requiring use in the course of trade is a fundamental requirement, without which the sign in question cannot enjoy any protection against the registration of a Community trade mark, irrespective of the requirements to be met under national law in order to acquire exclusive rights. Furthermore, such use must indicate that the sign in question is of more than mere local significance.

It must be recalled that the object of the condition laid down in Article 8(4) CTMR relating to use in the course of trade of a sign of more than mere local significance is to limit conflicts between signs by preventing an earlier right which is not sufficiently definite – that is to say, important and significant in the course of trade – from preventing registration of a new Community trade mark. A right of opposition of that kind must be reserved to signs with a real and actual presence on their relevant

market. To be capable of preventing registration of a new sign, the sign relied on in opposition must actually be used in a sufficiently significant manner in the course of trade and its geographical extent must not be merely local, which implies, where the territory in which that sign is protected may be regarded as other than local, that the sign must be used in a substantial part of that territory. In order to ascertain whether that is the case, account must be taken of the duration and intensity of the use of the sign as a distinctive element for its addressees, namely purchasers and consumers as well as suppliers and competitors. In that regard, the use made of the sign in advertising and commercial correspondence is of particular relevance. In addition, the condition relating to use in the course of trade must be assessed separately for each of the territories in which the right relied on in support of the opposition is protected. Finally, use of the sign in the course of trade must be shown to have occurred before the date of the application for registration of the Community trade mark (judgment of 29/03/2011, C-96/09 P, 'Bud', paragraphs 157, 159, 160, 163 and 166).

In the present case, the contested trade mark was filed on 31/03/2014. Therefore, the opponent was required to prove that the sign on which the opposition is based was used in the course of trade of more than local significance in the European Union prior to that date. The evidence must also show that the opponent's sign has been used in the course of trade for wines.

On 18/02/2015 the opponent filed inter alia, the following evidence:

- Annex C: copy of a brochure edited by the "Consortium for the Protection of the Registered Designation of Origin Prosecco", explaining where the wine producing Italian region is, the number of hectares of vineyards, number of winemakers, history and production method, total wine production, percentage of exports to other countries than Italy, etc.
- Annex D: website printout of www.discoverproseccowine.it, referring to the 1000 years history of the denomination.
- Annex E: explanation of the characteristics of the denomination Prosecco, edited by "Consorzio di Tutela della Denominazione di Origine Controllata Prosecco".
- Annex F: Global trade atlas list of sales or other type of numbers without reference in the world, Germany, United Kingdom, USA and Switzerland.

The documents filed, do not provide the Opposition Division with sufficient information concerning the commercial volume, the duration, and the frequency of use.

The evidence submitted has been elaborated and produced by the opponent himself. The opponent has not submitted any reliable evidence from independent sources such as press cuttings, market studies showing the public's level of recognition, invoices reflecting the amount of sales and the size of the sales, auditor's reports, chambers of commerce references, etc.

Therefore it must be concluded that the opponent's sign European Protected Designation of Origin 'PROSECCO' number PDO-IT-A0516 has not been used in the course of trade. As a result, the opposition is not well founded under Article 8(4) CTMR.

REPUTATION – ARTICLE 8(5) CTMR

According to Article 8(5) CTMR, upon opposition by the proprietor of an earlier trade mark within the meaning of Article 8(2) CTMR, the contested trade mark shall not be registered where it is identical with, or similar to, the earlier trade mark and is to be registered for goods or services which are not similar to those for which the earlier trade mark is registered, where, in the case of an earlier Community trade mark, the trade mark has a reputation in the Community and, 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.

According to Article 76(1) CTMR, in proceedings before it the Office shall examine the facts of its own motion; however, in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence and arguments provided by the parties and the relief sought.

It follows that the Office cannot take into account any alleged rights for which the opponent does not submit appropriate evidence.

According to Rule 19(1) CTMR, the Office shall give the opposing party the opportunity to present the facts, evidence and arguments in support of its opposition or to complete any facts, evidence or arguments that have already been submitted together with the notice of opposition, within a time limit specified by the Office.

According to Rule 19(2)(c) CTMR, when the opposition is based on a mark with reputation within the meaning of Article 8(5) CTMR, the opposing party shall provide evidence showing, *inter alia*, that the mark has a reputation, as well as evidence or arguments showing that 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 of refusal of Article 8(5) CTMR 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.
- Encroachment upon reputation: the use 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.

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) CTMR (judgment of 16/12/2010, joined cases T 345/08 and T 357/08, 'BOTOCYL', paragraph 41). However, the fulfilment of all the above mentioned conditions may not be sufficient. The opposition may still fail if the [applicant establishes due cause for the use of the contested trade mark.

As it has been examined under the requirements of Article 8(4) CTMR, the opponent was not able to submit sufficient evidence that might prove that the opponent's

European Protected Designation of Origin 'PROSECCO' number PDO-IT-A0516 has been used in the course of trade. Taking into account that the threshold to prove reputation is higher than the one needed to prove the use to under article 8(4) CTMR, the Office considers that one the requirement of article 8(5)CTMR – the reputation of the earlier mark, is not fulfilled. Specifically, as mentioned in the examination of article 8(4) CTMR, the evidence submitted originate all from the opponent itself, without third party confirmation. Evidence originating for the Opponent are not completely irrelevant, but the Office cannot assume reputation of a mark with consequent boarder protection only on the basis of evidence produced by the interested party and not confirmed by independent sources. As a result, the opposition is not well founded under Article 8(5) CTMR.

COSTS

According to Article 85(1) CTMR, the losing party in opposition proceedings must bear the fees and costs incurred by the other party. According to Article 85(2) CTMR, where each party succeeds on some heads and fails on others, or if reasons of equity so dictate, the Opposition Division shall decide a different apportionment of costs.

Since the opposition is successful only for part of the contested goods and services, both parties have succeeded on some heads and failed on others. Consequently, each party has to bear its own costs.



The Opposition Division

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According to Article 59 CTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 60 CTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. Furthermore, a written statement of the grounds of appeal must be filed within four months of the same date. The notice of appeal will be deemed to be filed only when the appeal fee of EUR 800 has been paid.