

OPPOSITION No B 3 124 209

Consorzio di Tutela della Denominazione di Origine Controllata Prosecco, Piazza Filodrammatici, 3, 31100 - Treviso, Italy (opponent), represented by **Studio Legale Bird & Bird**, Via Borgogna, 8, 20122 - Milan, Italy (professional representative)

a g a i n s t

Hempdrinks GmbH, Wolkensteingasse 37, 8020 Graz, Austria (applicant).

On 10/06/2021, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 124 209 is upheld for all the contested goods.
2. European Union trade mark application No 18 170 486 is rejected in its entirety.
3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 17/06/2020, the opponent filed an opposition against all the goods of European Union



trade mark application No 18 170 486 (figurative mark). The opposition is based on, inter alia, a protected designation of origin (PDO), 'PROSECCO' (the earlier PDO). In connection to this right, the opponent invoked Article 8(6) EUTMR.

DESIGNATIONS OF ORIGIN OR GEOGRAPHICAL INDICATIONS — ARTICLE 8(6) EUTMR

According to Article 8(6) EUTMR, upon opposition by any person authorised under the relevant law to exercise the rights arising from a designation of origin or a geographical indication, the trade mark applied for must not be registered where and to the extent that, pursuant to the Union legislation or national law providing for the protection of designations of origin or geographical indications:

- (i) an application for a designation of origin or a geographical indication had already been submitted, in accordance with Union legislation or national law, prior to the date of application for registration of the EU trade mark or the date of the priority claimed for the application, subject to its subsequent registration;
- (ii) that designation of origin or geographical indication confers the right to prohibit the use of a subsequent trade mark.

a) The right under the applicable law

In the present case, as shown in the extract of the registration certification submitted by the opponent in Annex 4, the PDO PROSECCO was registered for wine on 01/08/2009.

Designations of origin and geographical indications for wines and other grapevine products protected under Council Regulation (EC) No 1308/2013 of 17 December 2013 establishing a common organisation of the markets in agricultural products) fall under Article 8(6) EUTMR.

This includes the names already registered under Council Regulation (EC) No 1493/1999 of 17 May 1999 on the common organisation of the market in wine or Council Regulation No 479/2008 of 29/04/2008 on the common organisation of the market in wine. At present, geographical indications for wines are protected under EU legislation under Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013, known as the 'Wines Regulation', establishing a common organisation of the markets in agricultural products (Regulation No 1308/2013 or the Wines Regulation), which replaced and repealed Regulation No 1234/2007, which had integrated through codification by Regulation No 491/2009 the abovementioned Regulation No 479/2008, which was repealed at the same time. Wine names referred to in Articles 51 and 54 of Council Regulation (EC) No 1493/1999 and Article 28 of Commission Regulation (EC) No 753/2002 are automatically protected under this Regulation (see Article 107 of Council Regulation No 1308/2013 of 17 December 2013). The Wines Regulation protects geographical indications that were already protected in a Member State on 01/08/2009 (or on the date of accession of a new Member State) subject to further conditions, and any further geographical indications applied for and registered pursuant to the EU system of protection thereafter.

According to Article 93(1)(a) of Regulation No 1308/2013, 'designation of origin' means the name of a region, a specific place or, in exceptional and duly justifiable cases, a country used to describe a product referred to in Article 92(1) of Regulation No 1308/2013 that complies with the following requirements:

- its quality and characteristics are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors;
- the grapes from which it is produced come exclusively from this geographical area;
- its production takes place in this geographical area; and
- it is obtained from vine varieties belonging to *Vitis vinifera*.

According to Article 103(2) of Regulation No 1308/2013, protected designations of origins and protected geographical indications and the wines using those protected names in conformity with the product specification will be protected against:

- (a) any direct or indirect commercial use of a protected name:
 - (i) by comparable products not complying with the product specification of the protected name; or
 - (ii) insofar as such use exploits the reputation of a designation of origin or a geographical indication;
- (b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar;
- (c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material

or documents relating to the wine product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the consumer as to the true origin of the product.

b) The opponent's right vis-à-vis the contested trade mark

The opponent claims and shows with extracts from national law and their corresponding translations (see Annex 5), that it is the official body tasked with the functions of protection, promotion, enhancement, consumer information and general care of the interests of PDO PROSECCO as assigned by the Italian Ministry of Agricultural, Food and Forestry Policies through the Ministerial Decree of 22/03/2012 of the Italian Republic, Article 2 of which recognises the Consorzio as a 'Consorzio di Tutela'. It is, thus, entitled to defend all interests of the designation of origin PROSECCO according to Article 17, sub-paragraphs 1 and 4 of Italian Legislative Decree No 61/2010 of 08/04/2010 on the protection of designations of origin and geographical indications for wines. In this connection, Article 17 sub-paragraph 4 (the contents of which are mirrored in Article 41, Law No 238 of 12/12/2016) provides the consortium recognised as 'Consorzio di tutela' with *erga omnes* functions such as acting in all legal and administrative proceedings, protecting and safeguarding the relevant PDO and protecting the interest and rights of the relevant producers. The task assigned to the opponent has been confirmed by the Ministerial Decree of 01/06/2015 of the Italian Republic and more recently by Ministerial Decree No 46 634 of 22/06/2018 for a further three-year period.

In support of its arguments, the opponent submits a series of documents related to the PDO (product specification, graphic representation of the production area, Ministerial Decrees recognising the PDO in Annexes 1 to 6).

In light of the arguments and evidence submitted, the Opposition Division considers that the opponent is indeed entitled under the Italian law to exercise the rights arising from the designation of origin 'Prosecco'.

The opponent indicates that the scope of protection of the Protected Designation of Origin 'Prosecco' is governed by Article 103(2) of Regulation No 1308/2013 and that Prosecco is a protected designation of origin for wines, which includes fully sparkling wines ('spumante'), semi-sparkling wines ('frizzante') and still wines. The documents filed by the opponent show that 'PROSECCO' is protected as a PDO for wine and as can be seen in the product specification this includes semi-sparkling wine and sparkling wine, under Regulation (EU) No 1308/2013.

According to the opponent 'Prosecco' enjoys reputation and has been extensively used in Italy and in the European Union.

As mentioned earlier, the date of registration of the PDO 'PROSECCO' is 01/08/2009. The contested sign was filed on 22/12/2019 that is after the registration of the earlier PDO, which means that the earlier PDO is indeed earlier.

The opponent argues that the conditions of Article 103(2) of Regulation No 1308/2013 are fulfilled as the use of the contested sign will evoke and imitate the earlier PDO. This is because the contested sign will be associated with the earlier PDO due to the similarities between the word 'Prosecco' and the element of the contested sign 'Hemp-Secco' which is in a 'central and prominent' position as well as the reputation of the earlier PDO. According to the opponent 'Hemp-Secco' is clearly visible and plays an independent distinctive role within the overall context of the contested mark, which mirrors the usual design structure of wine labels and 'wine-style' beverages, which feature in different positions and characters the trade name of

the producers and / or the trade mark/name of the wine and other designations that convey specific information, including geographical indications/designations of origin. Furthermore, the opponent argues that the contested sign would also take unfair advantage of the 'aura of attractiveness and the positive images' that surround the earlier PDO.

The Opposition Division will now assess whether the conditions set by Article 103(2) of Regulation No 1308/2013 are met.

Evocation of the PDO PROSECCO

Article 103(2)(b) of Regulation (EU) No 1308/2013 states that a PDO shall be protected against any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation", "flavour", "like" or similar.

According to the Court, 'evocation' covers 'a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected' (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 51; 04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 25; 26/02/2008, C-132/05, Commission v Germany, EU:C:2008:117, § 44 and 21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 21). Consumers must establish a sufficiently clear and direct link between the term used to designate the product and the product whose name is protected (21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 22; 07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 53).

At the same time it is necessary to take account of the presumed expectations of the average consumer, who is reasonably well informed and reasonably observant and circumspect. The Court has clarified that such a link between the term used to designate the product and the product whose name is protected must be sufficiently clear and direct and that a mere association with the protected geographical indication or the geographical area relating thereto is not sufficient (07/06/2018, C-44/17, SCOTCH WHISKY, EU:C:2018:415, § 53; 21/01/2016, C-75/15, Viiniverla, EU:C:2016:35, § 22, 07/06/2018, C-44/17, Glen Buchenbach, EU:C:2018:415, § 53).

In assessing whether such a link is established, the Court has considered the phonetic and visual relationship between the signs and any evidence that may show that such a relationship between the EUTM and the PDO is not fortuitous (21/01/2016, C 75/15, VERLADOS / CALVADOS, EU:C:2016:35, § 48), as well as the degree of proximity of the goods concerned, including the actual physical appearance or the ingredients and taste of the products covered by the EUTM and the PDO (04/03/1999, C-87/97, Cambozola, EU:C:1999:115, § 27).

Finally, it should also be mentioned that the EU Regulations protect geographical indications and denominations of origin throughout the territory of the Union. As a result, the Court has ruled that in order to guarantee effective and uniform protection of those PGI/PDOs in that territory, it must be considered that the concept of the consumer covers European consumers and not merely consumers of the Member State in which the product giving rise to the evocation of the PGI/PDO is manufactured (21/01/2016, C 75/15, VERLADOS / CALVADOS, EU:C:2016:35, § 27).

1. The goods

The goods for which the PDO is protected are *wine*, the contested goods are *soft drinks* in Class 32 and *alcoholic beverages (except beer); wine; sparkling wines; sparkling white wines* in Class 33.

As regards the contested in Class 33, they are identical to *wine* for which the PDO is protected. This is because they are the same goods, *wine*, they include the PDO's goods as a broader category, *alcoholic beverages (except beer)*, or are included in the opponent's broader category, as in the case of *sparkling wines; sparkling white wines*.

As correctly pointed out by the opponent, as regards the contested *soft drinks*, a preliminary clarification must be made since it is obvious that there is a discrepancy between the definition of the goods in Class 32 in the first language and in the second language of the application.

It must be reminded that an application for an EUTM will be published in all the official languages of the European Union (Article 147(1) EUTMR). Likewise, all entries in the Register of European Union trade marks (the Register) will be in all these languages (Article 147(2) EUTMR). Both applications and entries in the Register are published in the EUTM Bulletin (Article 116(1)(a) and Article 116(2) EUTMR).

Nevertheless, in cases of a discrepancy, the definitive version of the list of goods is the text in the first language of the application, if the first language is one of the five languages of the Office.

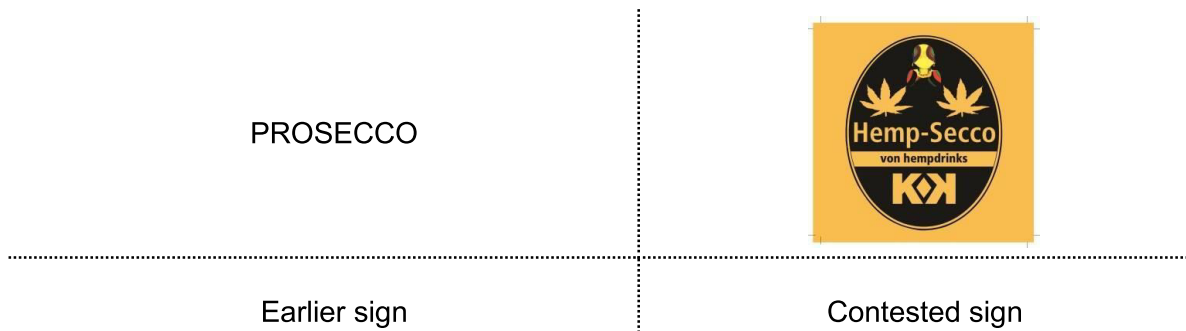
In the present case, the first language of the application is German, that is one of the five languages of the Office. The goods in Class 32 of the application are defined in German as *Alkoholfreie Getränke*, a more precise translation of which can be *non-alcoholic beverages*, instead of *soft drinks*.

According to case-law, products are comparable for the purposes of Article 103(2) of Regulation No 1308/2013 when they have common objective characteristics, such as the method of elaboration, the physical appearance of the product and the use of the same raw materials. Other factors which may be relevant are, from the perspective of the relevant public, the consumption on identical occasions and the identical channels of distribution and marketing methods (14/07/2011, C-4/10 & C-27/10, BNI Cognac, EU:C:2011:484, § 54).

A 'comparable' product is not to be interpreted as meaning a 'similar' product in the sense of Article 8(1)(b) EUTMR and, accordingly, the criteria set out in the *Canon* judgment (29/09/1998, C-39/97, Canon, EU:C:1998:442) should not necessarily be adhered to.

As the opponent correctly has observed, in the present case *non-alcoholic beverages* in Class 32 include *non-alcoholic wines*, which are to a certain extent comparable to *wine* because they have a similar physical appearance, they are elaborated from the same raw materials and are consumed on the same occasions. Consequently, in view of the foregoing, the goods are comparable.

2. The signs



The relevant territory is the European Union.

The contested sign consists of the image of a black label on an orange background, which as pointed out by the opponent can be expected to be applied on bottles. The element 'Hemp-Secco' is placed in a prominent position in the middle of the oval. The sign includes various additional figurative and decorative elements and also smaller verbal elements, namely 'von hempdrinks'. It is worth pointing out that the leaf devices will merely be seen as referring to a plant (hemp) so in this respect they are less distinctive. The size and position of the elements 'von hempdrinks' render them secondary when compared to the relevance of 'Hemp-Secco'. Moreover, if understood, this element will be taken as a reference to the producer.

The earlier sign 'Prosecco' and 'Hemp-Secco' of the contested sign share relevant similarities. Not only they coincide in the five letters 'secco', which for a sizeable part of the public have no meaning in connection with the goods in Classes 32 and 33, but they also share a letter 'P' in their first part, although not placed exactly in the same position. Also, it is particularly relevant the fact that these elements have the same structure, with the same number of syllables. Given the prominence of 'Hemp-Secco' it is this element that will be used aurally to refer to the goods at hand and due to this circumstance it is more likely that this element will be retained by the public.

Considering the above, the signs are **visually** and **aurally** similar to an average degree.

c) Conclusion on evocation

Considering, the identity and the proximity of the goods as well as the identified similarities between 'Hemp-Secco' and 'Prosecco', the Opposition Division concludes that the use of the contested trade mark on *soft drinks* in Class 32 (which corresponds to *Alkoholfreie Getränke* in the first language of the application) and *alcoholic beverages (except beer); wine; sparkling wines; sparkling white wines* in Class 33 will bring into the mind of the consumer the PDO 'Prosecco' protected for wines, which include sparkling wines.

Finally, the Opposition Division considers that the other elements in the contested sign will not be able to break the link triggered in the mind of the consumer with wines of the PDO 'Prosecco'. They are merely decorative or consist of elements that might even suggest different ingredients or will merely be interpreted, at least by a part of the relevant public, as the name of the producer ("von hempdrinks"). Additionally, the additional verbal elements are quite small and overshadowed by 'Hemp-Secco' on account of the size and central position.

Consequently, the contested sign does constitute an evocation of the earlier PDO within the meaning of Article 103(2)(b) of Regulation (EU) No 1308/2013. Therefore, the opposition is

well founded on the basis of Article 8(6) EUTMR in connection with Article 103(2)(b) of Regulation (EU) No 1308/2013.

Considering all the above, the Opposition Division finds the opposition well founded on the basis of the opponent's earlier PDO 'Prosecco'. Therefore, the contested trade mark must be rejected for all the contested goods.

As the opposition is entirely successful on the grounds of Article 8(6) EUTMR in connection with Article 103(2)(b) of Regulation (EU) No 1308/2013, it is not necessary to examine the remaining grounds and earlier rights on which the opposition is based.

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 applicant is the losing party, it must bear the opposition fee as well as the costs incurred by the opponent in the course of these proceedings.

According to Article 109(1) and (7) EUTMR and Article 18(1)(c)(i) EUTMR, the costs to be paid to the opponent are the opposition fee and 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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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.