

O-004-15

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3033347  
BY  
APPROVED PRODUCTS LTD**

**TO REGISTER THE TRADE MARK**

**Bellavini**

**IN CLASS 33**

**AND**

**THE OPPOSITION THERETO  
UNDER NO. 401786  
BY  
INDEPENDENT FOOD SERVICES LTD**

## **Background and pleadings**

1. Approved Products Ltd (“the applicant”) applied to register the trade mark “Bellavini” in the UK on 4 December 2013. It was accepted and published in the Trade Marks Journal on 3 January 2014 in respect of “wine” in class 33.

2. On 3 March 2014 Independent Food Services Limited (“the opponent”) opposed the above application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is based on its earlier UK Trade Mark BELLARINI (no. 2581148) which covers class 33 “cider and perry”.

3. The opponent argues that the respective goods are “very similar” and that the marks are visually and aurally similar.

4. The applicant filed a counterstatement denying the claims made and stated:

“1) Although the goods are in the same class, they are both different products, 2) Different spelling and pronunciation of the words, 3) There are factors distinguishing both products; both visually different. Therefore the public will be able to differentiate and distinguish between the two, meaning there will not be any chance for confusion, and 4) The two products are sold in different markets – Bellavini wine is sold to the on trade market, whereas the Bellarini products are sold to the off trade market”.

5. Both sides filed evidence in these proceedings.

6. The opponent filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. The applicant did not file written submissions. No hearing was requested and so this decision is taken following a careful consideration of the papers.

## **EVIDENCE**

### **Opponent’s evidence**

7. The opponent’s evidence is given by its Trade Mark Attorney, Mr. Terry Roy Rundle. The purpose of Mr. Rundle’s evidence is to deny the applicant’s claims that the opponent’s BELLARINI goods are only sold to the off trade market. Mr Rundle states that BELLARINI goods are sold both to the on trade and off trade markets. His evidence comprises of two promotional brochures called “Licensed Christmas Promotions” (available between 18 November 2013 and 5 January 2014), and “East end” (available between 17 February and 8 March 2013”. Each offers bottles of BELLARINI in 1.5ltr and 75cl measures. The goods are offered under the heading of

“Sparkling and fortified wines”, although the earlier mark is registered for cider and perry.

### **Applicant’s evidence**

8. The applicant’s evidence is a Witness Statement of Budge Dhariwal who is a Director of the applicant.

9. The points raised in Mr. Dhariwal’s Witness Statement are as follows:

- The BELLAVINI mark was first used in the UK by the applicant in 2011 and has been sold exclusively to the “On Trade sector”.
- BELLAVINI is a still wine with an abv of 12.5%, screw cap closure and a three part label.
- BELLAVINI has developed into a volume range of 4 wines, namely Pinot Grigio, Chardonnay, Pinot Grigio Blush and Merlot, and it is sold to Regional and Independent wholesalers
- The volume sales currently amount to over 30,000 cases.
- Average advertising and promotional spend is around £6,000 per annum.

There are no exhibits to support these statements.

### **DECISION**

#### **Section 5(2)(b)**

10. Sections 5(2)(b) of the Act is 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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

#### **The principles**

11. 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.*

(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.

### **Comparison of goods**

12. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- 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.

14. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

“82 It is true that goods are complementary if 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...”.

15. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"...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."

16. The goods to be compared are:

<b>Earlier trade mark</b>	<b>Contested trade mark</b>
Cider and perry	Wine

17. The Collins English Dictionary (2000 edition) definition of the respective goods are as follows:

Wine: an alcoholic drink produced by the fermenting of grapes with water and sugar. An alcoholic drink produced in this way from other fruits, flowers, etc. e.g. elderberry wine.

Cider: an alcoholic drink made from the fermented juice of apples.

Perry: alcoholic drinks made of pears, similar in taste to cider

18. To assist with the comparison of goods, I refer to the decision of Mr Geoffrey Hobbs QC (sitting as the Appointed Person) in *Balmoral Trade Mark* [1998] RPC 297. *Balmoral Trade Mark* concerned a dispute where the relevant goods were whisky on the one hand and wine on the other, Mr Hobbs stated in this decision:

"At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different products which emanate (and are known to emanate) from producers specialising in different and distinct fields of commercial activity. This was said to render it unlikely that a producer of whisky would become (or be expected to become) a wine producer and unlikely that a producer of whisky who did become a wine producer would market (or be expected to market) his whisky and wines

under the same trade mark. I was urged to accept that this made it possible for one producer to use a mark for whisky and another producer to use the same mark concurrently for wines without any real likelihood of confusion ensuing.

I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the applicant over-emphasise the part played by producers and under-emphasise the part played by other traders in the business of buying and selling whisky and wines.

It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of "own brand" or "merchant-specific" labelling. Those who supply retail customers may be licensed to do so under an "off-licence" or a licence for "on and off sales" in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well.

When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar* case (uses, users and physical nature of the relevant goods and service; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines."

19. Having regard to the case law set out above I reach the following conclusions:

- Whilst the goods are not in direct competition with one another, there is a degree of competition. This is because the respective goods are capable of meeting the same needs, i.e. consumption during a meal or in a social event.

- I do not consider the goods to be complementary. In other words, the goods do not go “hand in hand”. In *Coca-Cola v OHIM*, Case T-175/06, the GC concluded that wine and beer were not complementary. I am of the view that cider and perry are akin to beer when considered in relation to wine.
- The applicant’s Witness Statement states that “BELLAVINI can be distinguished from BELLARINI as it is still wine with an abv of 12.5% screw cap closure and a three part label”. Whilst cider and perry are lower in alcohol volume which will impact the volume consumed, the goods still share a common characteristic insofar that they provide a relaxing drinking experience at home or a social event. Wine is more likely to accompany a meal than cider or perry, but the nature of the goods are nevertheless similar to a degree in that wine, cider and perry are all fermented drinks (from grapes for wine, apples for cider and pears for perry).
- Although there is no evidence regarding trade channels, I am aware from my own experience that wine, cider and perry are sold through the same retail outlets, including bars and restaurants. Therefore, it is concluded that there would be some overlap between the respective channels of trade.
- I am also aware that the cider trade has diversified in recent years, so that it is common to find ciders flavoured with various fruits, sold in smaller bottles and given a more ‘upmarket’ image. This may mean that whilst wine would not previously have tended to be placed next to cider and perry, there may now be more of a likelihood that they would be grouped in the same shelving area of a shop, the same fridge in a bar or section of a supermarket.

20. In view of the above, I conclude that there is a low to moderate degree of similarity between the applicant’s wine, and the opponent’s cider and perry.

### **The average consumer and purchasing act**

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22. 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.”

23. I also note that the GC, in *Simonds Farsons Cisk plc v OHIM* Case T-3/04 said:

“58 In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves, although they may not find those marks side by side.”

24. The average consumer in this instance is the adult general public. Alcohol may be bought in shops, supermarkets, bars and restaurants. It is a visual purchase and a process of self selection. The goods are also visually purchased in bars, via either perusing the hand pumps, bottles in the fridge or on the shelf. Overall, there is a visible aspect to the purchasing process but I do not ignore the aural aspect.

25. Except for wine connoisseurs who occupy a relatively small part of the relevant public, the level of attention in buying the goods themselves will not be of the highest level. Cider and perry is cheaper than wine so there will be a greater degree of care taken when purchasing wine. Nevertheless, my overall view is that an average degree of care and attention will be utilised.

### **Comparison of marks**

26. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

28. The respective trade marks are shown below:

<b>Earlier trade mark</b>	<b>Contested trade mark</b>
BELLARINI	Bellavini

29. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind.

30. In the applicant’s counterstatement it is stated that the marks differ since they are spelt and pronounced differently, plus they are visually different.

31. The overall impression of both marks is of single, invented words. The applicant’s trade mark consists of 9 letters beginning with a capital B and remaining letters being in lower case. The opponent’s trade mark also consists of 9 letters, all of which are in capitals. Whether a word trade mark is in capitals or lower case has no material effect on the likelihood of confusion.

32. Save for a “v” in the application and a “R” in the opponent’s trade mark, it is clear that there is a degree of both visual and aural similarity between the respective marks. Both contain 9 letters and the single letter difference does not have an

impact on the overall visual and aural similarities. The marks are relatively long words, with the only difference being a single letter within the mark. The first two syllables, BELLA, which comprises over half of the mark, is identical, and the third (and final) syllable ends in 'ini' in both marks. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of word 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.”

33. In the present case, not only are the beginnings of each mark identical visually and aurally, so are the endings. There is a high degree of visual and aural similarity between the marks.

34. With regard to the conceptual similarities, neither mark has a meaning. Both marks begin with the Italian word “BELLA” and end with “INI”. The opponent submits that “BELLA”, translates to “nice” in Italian. This may not be apparent to the average consumer in the UK. Overall, since neither word has an English meaning, there is no conceptual comparison.

35. In view of the above, whilst the marks are conceptually neutral, there is a high degree of visual and aural similarity between the marks.

## **Distinctive character of the earlier trade mark**

36. 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-0000, paragraph 49).

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).”

37. The distinctive character of the earlier mark is another important factor to consider because the more distinctive it is (based either on inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24).

38. IFS have filed examples of how the mark is used but no supporting turnover or advertising figures. Therefore, I only have the marks inherent nature to consider.

39. Bellavini is an invented word. As the opponent stated, “Bella” is Italian for “nice” but considering the word as a whole it would not be recognised as having an English meaning. Accordingly, given the inventive nature of the mark Bellavini, I consider it as having a higher than average inherent distinctive character.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion**

40. It is stated in the applicant’s witness statement that “the two products are sold in different markets – Bellavini wine is sold to the on trade market, whereas the

Bellarini products are sold to the off trade market.” The applicant’s claim that the opponent’s goods are only sold to the off trade is “emphatically denied” by the opponent.

41. In paragraph 66 of *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06) it is stated:

“66 Article 4(1)(b) of Directive 89/104, however, concerns the application for registration of a mark. Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.”

42. In view of the above, whether the existing use is limited to either the “on” or “off” trade is irrelevant. Should the trade mark application mature to registration for wine, its subsequent use may not always be limited to “on” or “off” trade. Therefore, the applicant’s current trading pattern has no bearing on these proceedings.

43. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision.

44. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

45. To summarise, I have found that, a) the average consumer of the respective goods will pay a reasonable degree of care and attention whilst purchasing the goods, b) there is a low to moderate degree of similarity between the goods, c) the earlier mark has a higher than average distinctive character, and d) there is a high degree of similarity between the marks visually and aurally, which is not offset by any concept. The difference of a single letter within the marks is not likely to be noticed by the average consumer, who will assume that the goods are a range of different alcoholic drinks sold under the same trade mark. Therefore, there is a likelihood of confusion.

## **Outcome**

**46. The opposition succeeds. The application is refused.**

## **COSTS**

47. The opponent has been successful and is entitled to a contribution (rather than compensation) towards its costs. The Registrar normally awards costs from the scale published in Tribunal Practice Notice 4/2007 (which can be viewed on the website of the Intellectual Property Office). I award the opponent the sum of £600 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the counterstatement	£200
Official opposition fee	£100
Considering applicant's evidence and filing submissions and evidence	£300
<b>Total:</b>	<b>£600</b>

48. I therefore order Approved Products Ltd to pay Independent Food Services Ltd the sum of £600. The above sum should 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 6th day of January 2015**

**Mark King  
For the Registrar,  
the Comptroller-General**