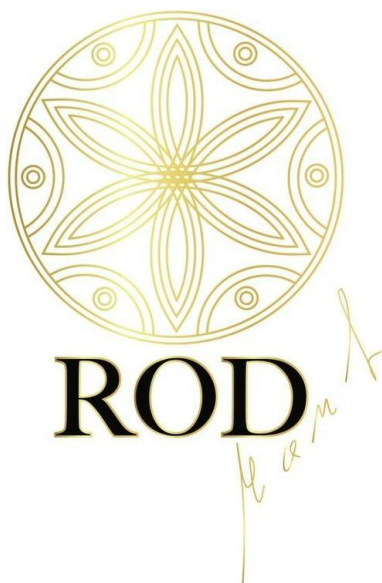


O/0765/26

TRADE MARKS ACT 1994

**IN THE MATTER OF THE REQUEST BY RODMARK GROUP S.R.O
FOR PROTECTION IN THE UK OF THE FOLLOWING INTERNATIONAL
REGISTRATION WO0000001830650:**



IN CLASSES 25, 28, 32, 33, 35 AND 41

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 453689

BY BODEGAS RODA, S.A.

Background and Pleadings

1. On 17 September 2024, RODMARK GROUP s. r. o. ('the Holder') requested protection in the UK of the International Registration shown on the cover of this decision, number WO0000001830650 ('the Contested Mark'). The Holder has claimed priority from its EUTM registration 019060806 from 12 September 2024.
2. The request for UK protection was published for opposition purposes in the Trade Marks Journal on 17 January 2025. UK protection is sought for a variety of goods and services in classes 25, 28, 32, 33, 35 and 41, of which only the following are opposed:¹

Class 33:

Alcoholic beverages (except beer); spirits [beverages]; liqueurs; wine; rum; vodka; whisky; aperitifs; gin; cocktails; mead [hydromel]; fruit (alcoholic beverages containing -); alcoholic extracts; anise [liqueur]; brandy; curacao; distilled beverages; digesters (liqueurs and spirits); arak [arrack]; sugarcane-based alcoholic beverages; rice alcohol; alcoholic fruit extracts; kirsch; bitters; alcoholic essences; peppermint liqueurs; grain-based distilled alcoholic beverages; sake; piquette; pre-mixed alcoholic beverages, other than beer-based; absinthe; alcoholic energy drinks; alcoholic punches; alcoholic preparations for making beverages; alcoholic egg nog; baijiu [chinese distilled alcoholic beverage]; cachaca; chinese spirit of sorghum (gaolian-jiou); soju; chinese mixed liquor (wujiapie-jiou); sake substitutes; nira [sugarcane-based alcoholic beverage]; rum-based beverages; preparations for making alcoholic beverages; tonic liquor containing mamushi-snake extracts (mamushi-zake); tonic liquor flavored with pine needle extracts (matsuba-zake); tonic liquor flavored with japanese plum extracts (umeshu); shochu (spirits); sangria; table wines; vermouth; wine punch; sparkling wines; cherry brandy; extracts of spiritous liquors.

Class 35:

retail and wholesale services in relation to [...] alcoholic beverages

¹ The full specification for IR WO0000001830650 is set out at Annex 1 to this decision.

3. On 17 April 2025, BODEGAS RODA, S.A. ('the Opponent') filed an opposition to the request for UK protection, pursuant to section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The Opponent relies on the following earlier registration, relying only on its goods in class 33 (underlined):

UK00906739891²

RODA

Filing date: 10 March 2008

Date of entry in register: 1 December 2008

Seniority details

Application date: 5 August 1998

Country: United Kingdom

Application number: 0703486

Registered for the following goods/services:

Class 31

Plants of all kinds, in particular wine grape plants.

Class 33

Wine and liqueurs and other alcoholic beverages (except beers)

Class 42

Scientific and technological research in the field of wine-growing.

4. The Opponent claims that the parties' marks are visually and phonetically highly similar, and that their respective goods/services are identical and similar; leading

² This registration is a comparable mark pursuant to Article 54 of the 'Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)', also known as the 'Withdrawal Agreement'. It is based on an International Registration ('IR') designating the EU, claiming seniority from the original UK filing.

to a likelihood of confusion.³ The Opponent claims to have made genuine use of its earlier mark in respect of wines and liqueurs.⁴

5. The Holder filed a Defence and Counterstatement in which it denies the claim against it in its entirety.⁵ Furthermore, the Holder puts the Opponent to proof in respect of its statement of use.⁶
6. The Opponent is represented by TR Intellectual Property LTD. The Holder is represented by Marek Rodák, the founder and director of the Holder.⁷
7. Both parties filed evidence and submissions.⁸ A hearing was neither requested nor considered necessary; and only the Holder filed written submissions in lieu thereof. The following decision has been made after careful consideration of the case papers available to me.

RELEVANCE OF EU LAW

8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE AND SUBMISSIONS

9. The Opponent's evidence comes from Amanda Chinae-Rodriguez, Director/Trade Mark Attorney of the Opponent's representative.⁹ Ms Chinae-Rodriguez' Witness

³ Opponent's Form TM7, section A continuation sheet addressing Q9.

⁴ Opponent's Form TM7, at Q7a.

⁵ Holder's counterstatement.

⁶ As above.

⁷ Witness Statement of M. Rodák, [1].

⁸ The document filed by the Opponent has been headed 'Evidence/Submissions on behalf of the Opponent', with nothing to explicitly demarcate the narrative evidence from the submissions.

⁹ Witness Statement of A Chinae-Rodriguez, [1].

Statement is dated 3 November 2025. Strictly speaking, the majority of the Witness Statement amounts to mere submission. The only paragraph by way of narrative evidence is a sentence enumerating exhibits ACR1 to ACR5 as ‘evidence of use and advertising during’, respectively, 2020, 2021, 2022, 2023 and 2024.¹⁰

10. The Holder’s evidence comes from Marek Rodák who, as noted, is the founder and director of the Holder. Mr Rodák’s Witness Statement is dated 5 January 2026, accompanied by three exhibits (MR1 – MR3), as well as written submissions.

11. The Holder’s written submissions in lieu of a hearing are dated 27 March 2026.

12. I confirm that I have read all of the evidence and submissions; and I will refer to them to the extent that they are relevant.

DECISION

Earlier mark

13. In accordance with section 6(1)(aa) of the Act, the Opponent’s mark is an earlier mark by virtue of its seniority date, which precedes the priority date claimed by the Holder in respect of its request for UK protection for the Contested Mark.

The proof of use provisions

14. Section 6A of the Act provides that, in opposition proceedings, where the date on which the registration procedure of the earlier mark was completed more than 5 years prior to the filing date (or priority date) of the Contested Mark, the Opponent may be required to prove use of the earlier mark. In the instant case, section 6A is engaged, because the earlier mark became registered more than 5 years before the priority date of the Contested Mark. The Holder has put the Opponent to proof of its claim that the earlier mark has been used. For reasons that will become apparent, however, it will not be necessary determine this issue.

¹⁰ Witness Statement of A. China-Rodriguez, [3].

The relevant legislation

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

‘5(1) [...]

(2) A trade mark shall not be registered if because—

(a) [...]

(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.’

16. I also note section 5A of the Act:

‘5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.’

Relevant case law

17. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

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

A note on fair and notional use

18. Mr Rodák has given narrative evidence on the way in which the Contested Mark has been/is presently used. It is important to clarify that I am required to make the assessment of the likelihood of confusion notionally and objectively based on the Opponent's goods as registered and the Holder's goods in respect of which UK protection is sought, in accordance with the relevant case law.¹¹ That assessment requires that I must not take into account the actual way in which either party has used its mark in the marketplace, or aspects of their goods/services that cannot be determined upon inspection of the register. Further, I must consider all of the circumstances in which the mark for which UK protection is sought might be used should such protection be granted.¹²

Comparison of the marks

19. 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 ('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

¹¹ Where a proof of use assessment is conducted, its purpose is to determine the goods/services for which the earlier mark has been put to genuine use. The subsequent comparison of the parties' terms is still conducted on a notional basis.

¹² As per *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C- 533/06, [66].

20. The marks to be compared are as follows:

Overall impression of the marks

9

22. Mr Rodák has described the Contested Mark as comprising: a figurative element by way of a stylised ornamental Slavic symbol; a bold word element 'ROD'; and a handwritten script element reading 'mark'.¹³ In its lattermost submission, the Holder has described its mark as 'comprising a figurative element together with the wording "RODmark"'.¹⁴

23. I respectfully disagree that the handwritten element would be seen as the word 'mark' and that the average consumer would 'add' it to the 'ROD' element and read 'RODmark'. Furthermore, I am not persuaded that a significant proportion of consumers would understand the circular element to be a Slavic symbol. In my view, the average UK consumer would see the aforesaid element as a roundel containing a geometric flower-like form. I find that the mark will be seen, first and foremost, as comprising the word element 'ROD' with the decorative roundel above it. As to the figurative 'handwritten' element, I am not persuaded that it would be seen as the word 'mark'; I do not consider it capable of being read at all. To my mind, the positioning, poor resolution and light tone of the 'handwritten' element are such that many average consumers may either overlook it or see it merely as indeterminate flourishes, possibly suggestive of a signature. If the element is seen as handwriting/a signature, it is not clearly legible (if legible at all). Furthermore, it is in the very nature of a handwritten signature that it is unique to the signatory's hand and, very often, not easy to read.

24. I consider that the decorative roundel and 'ROD' elements will be seen immediately; with the word 'ROD' having greater visual impact given its size, positioning, emboldened typeface and the fact that it is the only readily articulable element within the mark. Whilst some average consumers may notice the 'handwritten' element, my view is that it does not contribute a great deal to the overall visual impression. Even if it is presumed to be a word (or signature) it cannot be easily read (if at all). All things considered, I find that the immediate overall impression resides in the 'ROD' and decorative roundel elements, with the word 'ROD' playing the dominant role within the composite mark. If the 'handwritten'

¹³ Witness Statement of M. Rodák, [3]

¹⁴ Holder's written submissions in lieu of a hearing, [2].

element is noticed, it will unlikely make any appreciable contribution to the overall impression.

Visual comparison

25. The Opponent claims that the parties' marks are 'visually highly similar' given the shared 'ROD' element, which is the 'prominent part' of the Contested Mark.¹⁵

26. The Holder, on the other hand, claims that the marks are dissimilar; arguing that the 'additional element "mark" is clearly visible' in the Contested Mark, and that 'ROD' and 'mark' hang together as a unified whole to form a compound expression 'RODmark'.¹⁶

27. With respect, I do not agree with either party's position. I find that the overall visual impressions of the competing marks have significant differences; however, there is some overlap owing to the respective word elements. Whilst the string of characters 'ROD' is subsumed within (and forms the first part of) the earlier mark, the word elements 'ROD' and 'RODA', to my mind, form their own 'word' units. It is my view that the average consumer would not, therefore, see the 'ROD' portion of 'RODA' as a unit within the earlier mark. I find that the shared characters 'ROD' function differently within each mark; as the complete word element 'ROD' versus part of the word element 'RODA'.

28. I respectfully disagree with the Holder's submission on the 'handwritten' figurative element within the Contested Mark, for the reasons given above at [23] – [24].

29. The decorative roundel present in the Contested Mark will be noticed by the average consumer. That said, I have borne in mind that it is generally the case that words 'speak louder' than devices.¹⁷ I also remind myself that the beginnings of words tend to have more visual (and aural) impacts than their ends;¹⁸ although this

¹⁵ Opponent's Form TM7, second continuation sheet, second and third un-numbered paragraphs.

¹⁶ Holder's written submissions in lieu of a hearing, [3]; Holder's Counterstatement, third un-numbered paragraph of first continuation page.

¹⁷ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, [37].

¹⁸ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, [81] – [83].

is not an absolute rule. It is important to note that the word elements 'RODA' and 'ROD' are short. In this regard, I refer to the case of *dm-drogerie markt GmbH & Co. KG v OHIM*¹⁹ in which it was observed that 'in the context of word signs which are relatively short, even a difference consisting of a single consonant will preclude a finding that there is a high degree of visual similarity between the two signs'.²⁰

30. In the light of the foregoing, I find there to be a level of visual similarity between the marks in the low to medium range; in any event, no more than medium.

Aural comparison

31. The Opponent has argued that the marks are 'phonetically highly similar and almost identical'.²¹ It submits that the earlier mark would be pronounced 'ROD-A with more emphasis placed on ROD and a soft pronunciation of the A',²² (i.e. *ROD-UH*).

32. The Holder argues that the Contested Mark will be articulated as 'RODmark' and that, aurally speaking, the endings of the marks are 'materially different': 'a' in RODA versus 'mark' in RODmark.²³ The following comment suggests that the Holder considers the 'ROD' portion of the earlier mark to be articulated in the same way in both marks:²⁴

'In any event, even if some phonetic similarity were found due to the shared "ROD", this must be weighed against the significant visual and conceptual differences between the marks.'

[My underlining added]

33. The parties appear to agree that 'ROD' will be pronounced in the same way for each mark. I am not persuaded of this. I consider that the average UK consumer would articulate 'RODA' as '*ROE-DUH*' (to rhyme with 'soda'), rather than 'ROD-

¹⁹ Case T-304/10.

²⁰ As above, [42].

²¹ Opponent's Form TM7, second continuation sheet, fourth un-numbered paragraph.

²² Opponent's 'evidence/submissions' document, [13].

²³ Holder's written submissions of 5 January 2026, [19].

²⁴ As above, [20].

UH'. The articulation that the parties are advocating does not strike me as the natural pronunciation for consumers based in the UK. However, I do not think it is open to me to make a finding on my own view if the parties have agreed on another articulation. To do so would amount to improving the Holder's pleaded case. I must, therefore, base my aural comparison on the assumption that the 'ROD' portion of 'RODA' will be pronounced in the same way as the 'ROD' element of the Contested Mark.

34. I refer to my earlier finding (at [23] - [24]) that the 'handwritten' element of the Contested Mark unlikely makes an appreciable contribution to its overall impression; and that, if noticed at all, it will be seen either as indeterminate flourishes or illegible writing. It follows that the average consumer would be unlikely to attempt to articulate this part of the mark.

35. Because the competing marks are rather short, the difference in length (two syllables versus one syllable) will be particularly impactful aurally (as well as visually, as already noted). I find no more than a medium level of aural similarity between the marks.

Conceptual comparison

36. The Opponent has provided very little in its pleading, or by way of submission, on the conceptual aspect of its mark. The following comment comes from the Opponent's statement of grounds:²⁵

'Conceptually, since the terms **ROD** and **RODA** do not possess any common meaning beyond seeming variations of the same term, it is not possible to complete a conceptual comparison.' [my underlining added].

37. Whilst this is noted, it is of limited assistance. It is not clear what the Opponent means by 'variations of the same term' because it has not sought to set out what, if any, meaning might be ascribed to either 'RODA' or 'ROD' such that they would be perceived in this way. Furthermore, the Opponent has not argued that either (or

²⁵ Opponent's Form TM7, second continuation sheet, sixth un-numbered paragraph.

both) of the word elements are devoid of any obvious meaning, either. The only further comment made by the Opponent on the conceptual aspect of its mark is by way of a denial that 'RODA' has a meaning in Spanish.²⁶ In short, it has not really addressed the conceptual aspect of its own mark to any useful extent.

38. The Holder, in its counterstatement, has claimed that the marks are conceptually different.²⁷ It initially claimed that 'RODA' has a meaning in Spanish,²⁸ but appears to have retreated from this position later in the counterstatement; and subsequent evidence and submission make no further mention of a Spanish meaning. The Holder appears to have settled on the view that the earlier mark has no meaning, whereas the Contested Mark points to the name 'Rodák Marek'; with 'Marek' being a Slovak variant of the English name 'Mark' and 'Rod' being a shortening of 'Rodák'.²⁹

39. The Holder goes on to say that Marek Rodák is a footballer 'who played for the Premier League outfit Fulham for ten years' and that it will be apparent to the average consumer that the Contested Mark is a reference to Mr Rodák's name.³⁰ In support of its argument, the Holder has provided an image of Marek Rodák from a feature on Sky Sports, chronicling his rise to stardom with Fulham;³¹ together with an 'Instagram promotional poster' (in a non-English language that may be Slovak, but I cannot be certain) showing Marek Rodák as 'the face' of 'Rodmark Group'.³² The problem with this evidence is that, whilst it might demonstrate that Marek Rodák has enjoyed success in UK football, and that he is the face of 'Rodmark', I have found that the average consumer will not see 'mark' within the Contested Mark and will not, therefore, see 'Rodmark'. The evidence does not succeed in demonstrating that the average consumer will perceive the Contested Mark as a reference to Marek Rodák.

²⁶ Opponent's 'Evidence/Submissions' document, [8].

²⁷ Holder's Counterstatement, seventh un-numbered paragraph.

²⁸ Holder's counterstatement, first paragraph.

²⁹ As above.

³⁰ Holder's Counterstatement, seventh un-numbered paragraph.

³¹ Exhibit MR1

³² Exhibit MR2.

40. It is my view that the earlier mark 'RODA' will be perceived by most average consumers as a word whose meaning is unknown. It is at least possible that some might presume it to be a name, although neither party has suggested this. It is my view as an ordinary member of the English-speaking UK public, that the word 'ROD' would be understood as having either of two meanings; i. as a noun denoting some sort of long, straight, slender bar or stick made of metal or wood (or other materials); or ii. as a male forename, e.g. a shortened form of 'Rodney' (or, possibly, 'Rhodri'; although I understand that this name is less known outside of Wales). The figurative roundel within the Contested Mark does not make any obvious contribution to the conceptual aspect of the mark and will most likely be seen merely as a decorative flower-like form within a circle. As noted, the 'handwritten' element will contribute little, if anything, conceptually.

41. I consider that, irrespective of whether the Contested Mark conjures the idea of a rod (as in a stick/bar) or the male name 'Rod', the marks are conceptually different.

42. I have also considered whether a conceptual link might be perceived in the (to my mind, unlikely) event that an average consumer sees both ROD-UH and ROD as names. In this connection, I have borne in mind the decision in the case of *GEORGINE*,³³

from which I note the following points made/noted by Mr Philip Harris sitting as the Appointed Person:

- The mere fact that the marks in issue can be grouped under a common generic term of 'names' does not automatically lead to conceptual similarity;³⁴
- It is also the case that the mere fact that names differ structurally, or identify different individuals, does not necessarily preclude conceptual similarity;³⁵

³³ BLO/1212/23.

³⁴ As above, [31].

³⁵ BLO/1212/23, [32].

- Even though, at a general level, different names denote different people, at another level, they can have some conceptual similarity by virtue of deriving from the same root/concept/theme.³⁶

43. In the instant case, even if 'RODA' and 'ROD' are seen as names, I do not consider that the average consumer would perceive them to be equivalents of the same name. Furthermore, I can conceive of no common root/concept from which both might be derived. All things considered, I find that, even if both 'RODA' and 'ROD' were presumed to be names, I do not find any conceptual similarity between the marks.

Comparison of goods and services

44. The goods/services in issue are set out at [2] and [3].

My approach

45. I do not consider it necessary to undertake a 'proof of use' assessment for the earlier mark. Instead, I propose to identify an example of opposed goods that are identical to those of the Opponent. I will then proceed to assess the likelihood of confusion based on that point of identity. Should the opposition fail on that basis, then consideration of the matter of proof of use would have made no difference. Furthermore, conducting my assessment based upon any other of the opposed goods/services would be unlikely to place the Opponent in any better position.

46. Both parties' class 33 specifications include *wines*. The parties' goods are, therefore, self-evidently identical. The remainder of my assessment will proceed on this point of identity.

Average consumer and the purchasing act

³⁶ As above, [34].

47. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. The word 'average' denotes that the person is typical. In *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

- (a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;
- (b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;
- (c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;
- (d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;
- (e) The average consumer's level of attention varies according to the category of goods or services in question; and
- (f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and

must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

48. The average consumer of *wines* will be predominantly members of the general public aged 18 and above. The goods will also be purchased by professionals, e.g. in the catering and hospitality business. The purchasing act will be primarily visual, with the wines self-selected from shelves (in supermarkets and other physical shops) from product listings in their online equivalents and from menus in restaurants and bars. There will be an aural aspect to the purchasing process where requests are made to the seller or recommendations sought from waiting/serving staff, for example. The goods will be advertised online and in printed matter, as well as on television and radio. The price point will vary according to the bottle of wine purchased; from a few pounds for a 'supermarket' wine, to several tens of pounds for a higher quality beverage, and up to hundreds of pounds and beyond for 'high end' wines sought by discerning wine enthusiasts. Factors influencing the decision to make a purchase will include, inter alia: the vintage; the type of grape used; the region from which the wine originates; 'pairing' considerations when selecting a wine to complement a meal. I find that the level of attention paid during the purchasing act will vary. For example, purchasing a bottle of wine for £8-10 from a local shop to have with an ordinary meal at home will be more of an 'everyday' casual purchase. In this situation, I find that a medium level of attention would likely be paid. On the other hand, where a particular wine is sought for a special occasion, or in a high-end restaurant, for example, the consumer will be more discerning and will likely pay a higher level of attention.

Distinctive character of the earlier mark

49. 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)'.

50. Registered trade marks possess varying degrees of inherent distinctive character. Where a mark is suggestive or allusive of a characteristic of the goods or services, it tends to be lower. Inherent distinctive character may range up to a high level for marks which consist of invented words with no allusive qualities.

51. The Opponent has not addressed the matter of the level of distinctive character enjoyed by the earlier mark. The Holder appears to touch on it briefly, although its submission is somewhat muddled; it may have conflated the concept of enhanced distinctive character with the situation where enhanced protection is afforded to certain trade marks that have a reputation:³⁷

'[T]he earlier mark RODA is an invented word with no meaning in English, which means it is entitled to a normal but not enhanced scope of protection [...]'

³⁷ Holder's written submissions in lieu of a hearing, [5].

52. That said, I agree that most average consumers will perceive 'RODA' as a word whose meaning is unknown. It neither describes nor alludes to wines. I therefore find that it has at least a medium level of inherent distinctive character.

53. I now consider whether the Opponent's evidence demonstrates that the earlier mark enjoys an enhanced level of distinctiveness. The Opponent's evidence includes a selection of articles spanning 2020 to 2024, whose focus is on the type of wine 'Rioja', Rioja being the region from which these wines originate.³⁸ Of the articles clearly directed to the UK market (as opposed to the Republic of Ireland, which is outside the UK) many of them mention or feature RODA as a producer of Rioja wines, and some include specific examples of the Opponent's goods. I do not consider it necessary to address every article provided; I have noted a few examples below.

54. An article from The Guardian, a well-known UK 'broadsheet' known to have a wide reach, dated 4 February 2022, titled 'Old-world wines v new: what's the difference?', mentions RODA as an example of a Rioja-based producer of wines 'who use names rather than classifications for their top cuvées'.³⁹

55. There are several articles from 'Decanter', which appears to be a specialist publication on wines, presenting RODA wines in a favourable light. According to the information on, inter alia, target market and circulation noted in the document header, Decanter has a UK circulation of '410000 monthly'. An article from the aforesaid publication, dated 1 March 2022 refers to RODA as a 'leading Rioja name' that sells quickly.⁴⁰

56. An article from The Sunday Times, another well-known UK 'broadsheet', dated 5 May 2024 (just a few months prior to the Holder's application for UK protection of the Contested Mark) features a bottle of RODA 'Reserva Rioja' as one of its four 'wines of the week'.

³⁸ Exhibits ACR1-ACR5.

³⁹ Exhibit ACR3, page 16.

⁴⁰ Exhibit ACR3, page 20.

57. An article published in *The Buyer*, a publication aimed at the ‘premium drinks trade’, in 2024 announces a forthcoming ‘Rioja Somm’er School’ aimed at UK-based sommeliers and buyers states the following:⁴¹

‘Those who know, know. The likes of La Rioja Alta, Muga, Ramón Bilbao and Roda have always valued the quality of the grapes from the Rioja Oriental, especially its Garnachas, with the likes of Tudelilla and the Monte Yerga providing raw material for many of the best pan-regional blends’.

58. The evidence clearly demonstrates a level of awareness of ‘RODA’ wines in the UK, and that a number of sources speak highly of the products. However, it is my view that the evidential material provided is insufficient to support a finding that the earlier mark has an enhanced level of distinctive character. There is no evidence of sales revenue, marketing expenditure or information on the size of the market. Whilst the mentions of ‘RODA’ and its products will likely have promoted the Opponent’s goods, there is very little in the way of advertisements or promotional pieces focusing purely on RODA wines. Based on the body of evidence provided, I am unable to make a finding that the earlier mark enjoys a level of distinctiveness beyond its inherent level of ‘medium’.

Likelihood of confusion

59. Confusion can be direct or indirect. Mr Iain Purvis Q.C., (as he then was) as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc.*⁴² Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*,⁴³ the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the

⁴¹ Exhibit ACR5, pages 4-5.

⁴² Case BL O/375/10 at [16].

⁴³ *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue, leads them to conclude that the goods/services are the responsibility of the same or an economically linked undertaking.

60. I must keep in mind that a global assessment is required taking into account all of the relevant factors, including the principles a) – k) set out above at [17]. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods/services *may* be offset by a lesser degree of similarity between the marks, and vice versa.

61. My assessment of likelihood of confusion is based upon the identical goods *wines*. I will address direct confusion first. Visually speaking, I have found the parties’ marks to have low to medium level of similarity. The point of similarity arises because both marks feature the string of characters ‘ROD’. In the earlier mark, ‘ROD’ functions as part of the word element ‘RODA’, which represents the mark in its entirety. In the Contested Mark, ‘ROD’ constitutes the word element within the Holder’s composite mark, which also features a decorative roundel which will be seen by the average consumer. I have found that ‘ROD’ plays the greatest visual role within the Contested Mark, although the roundel will not be missed. I have found that the ‘handwritten’ element, if not overlooked, will unlikely contribute to the overall impression of the Contested Mark. Aurally speaking, the marks have no more than a medium level of similarity. Given the shortness of the word elements ‘RODA’ and ‘ROD’, the difference of one syllable will be impactful. I have been unable to find a conceptual link between the marks.

62. The Opponent has argued that ‘[a]ccount should also be taken that the relevant goods are alcoholic beverages, which are frequently ordered in noisy establishments such as bars and nightclubs’.⁴⁴ I have borne in mind the case of *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*⁴⁵

⁴⁴ Opponent’s Form TM7, second continuation sheet, eighth un-numbered paragraph.

⁴⁵ Case T-187-16, [35].

in which the General Court ('GC') considered and rejected a similar argument. In the aforesaid case, the GC noted that:⁴⁶

'alcoholic beverages, including wine, are normally sold in self-service shops, where customers choose the goods themselves and must therefore rely primarily on the image of the mark placed on that product. EUIPO is also correct to contend that, even in bars and restaurants, customers choose their wine from a list before placing their order verbally'.

63. Despite the identity of the goods, I consider that the net effect of the differences that I have identified between the marks is sufficient to prevent one mark from being mistaken for the other. For direct confusion to occur, the average consumer would need to overlook, *inter alia*, the presence of the 'A' in the earlier mark 'RODA'. I do not consider such an oversight to be plausible. I find this to be so even when only a medium level of attention is paid during the purchasing act. I have borne in mind the interdependency principle according to which a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods (or services), and vice versa. I do not think that the aforesaid principle has any impact in the instant case. It is my view that the differences between the marks are such that they cannot be tempered by the identity of the goods. There is no likelihood of direct confusion. I find this to be the case even where only a medium level of attention is paid during the purchasing act.

64. For completeness, I now consider the likelihood of indirect confusion.

65. In the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said the following at [16]:

'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say

⁴⁶ As above.

that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’.

66. Arnold LJ emphasised that ‘there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion’.⁴⁷

67. I also note that, in *L.A. Sugar Limited v Back Beat Inc*⁴⁸ Mr Iain Purvis Q. C. (as he then was), as the Appointed Person, explained that:

‘17. Instances where one may expect the average consumer to reach such a conclusion [i.e. to conclude that marks relate to the same or economically linked undertakings] tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as ‘LITE’, ‘EXPRESS’, ‘WORLDWIDE’, ‘MINI’ etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (‘FAT FACE’ to ‘BRAT FACE’ for example)’.

68. I acknowledge that these categories are not intended to be exhaustive. The instant case cannot be said to fall within any of the three categories identified by Mr Purvis. Furthermore, I can conceive of no other mental process according to which an average consumer would conclude that the parties’ marks belonged to the same or economically-related undertakings. I find that the extent and nature of the

⁴⁷ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207.

⁴⁸ Case BL O/375/10

differences between the marks is sufficient to prevent the average consumer from presuming a common economic origin. I can find no 'proper basis' for a finding of a likelihood of indirect confusion.

69. I do not consider that basing my assessment on any other point of identity would place the Opponent in any better position.

70. The section 5(2)(b) opposition has failed in its entirety. Subject to any successful appeal, the Contested Mark may proceed to grant of protection in the UK.

COSTS

71. The Holder is the successful party and is entitled to a contribution to its costs. I note that the Holder has filed Tribunal Cost Pro Forma in which it claims the following hours spent attending to its case, to which I have added the applicable sums:⁴⁹

	Appropriate award:	
Preparation of Notice of Defence 5.5 hours x £19 = £104.50	Full sum claimed	£104.50
Consideration of Opponent's Form TM7 4 hours x £19 = £76	Full sum claimed	£76
'Considering Opponent's evidence (including submissions within witness statement)' 5.5 hours x £24 = £132	Full sum claimed	£132
'Drafting Witness Statement (inc. initial submissions) and	I do not consider it appropriate to award the full cost claimed under	£72

⁴⁹ CPR 46.5 sets out the rate of remuneration for litigants-in-person at £19 per hour for work carried out before 1 October 2025 (thereafter, the increased rate of £24 per hour applies).

gathering and formatting exhibits' 6 hours x £24 = £144	this head for the reason that only a small amount of evidence was filed and it was of limited assistance. I consider 3 hours x £24 = £72 to be an appropriate sum to reflect time taken drafting the written submission.	
'Drafting and finalising written submissions in lieu of hearing and overall case review' 5 hours x £24 = £120	I consider 2 hours x £24 = £48 to be an appropriate sum to reflect the fact that the submission was very short, and it repeated aspects of earlier written submissions.	£48
'Case management, correspondence and procedural handling' 2.5 hours x £24 = £60	I do not consider it appropriate to award costs under this head. The instant case was not particularly complex, nor did it involve a great deal of correspondence.	0
	Total:	£432.50

72. I therefore order BODEGAS RODA, S.A. to pay RODMARK GROUP s. r. o. the sum of £432.50. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of August 2026

N. R. Morris

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

Annex 1 – the full specification for IR WO0000001830650, with the opposed terms underlined:

Class 25:

Football boots; football studs; clothing; footwear; hats; tee-shirts; undershirts; ready-to-wear clothing; gowns; pinafore dresses; suits; jackets [clothing]; topcoats; down jackets; camisoles; stuff jackets [clothing]; parkas; pelerines; ponchos; skirts; culotte skirts; briefs; sashes for wear; neckties; shirts; short-sleeve shirts; outerclothing; spats; leg warmers; footless tights; clothing for gymnastics; vest tops; sports singlets; cyclists' clothing; beachwear; swimming costumes; underwear; brassieres; slips [underclothing]; petticoats; teddies [underclothing]; garters; underpants; boxer shorts; pyjamas; knickers; babies' pants [clothing]; bodices [lingerie]; robes; sweaters; sweaters; knitwear [clothing]; layettes [clothing]; footwear; boots for sports; boots; sports shoes; gymnastic shoes; slippers; sandals; wooden shoes; beach shoes; espadrilles; fittings of metal for footwear; stockings; tights; socks; belts [clothing]; belts (money -) [clothing]; furs [clothing]; headbands [clothing]; caps [headwear]; visors [headwear]; skull caps; baseball caps; ear muffs [clothing]; hats; leather clothing; clothing of imitations of leather; motorists' clothing; rainproof clothing; combinations [clothing]; bandanas [neckerchiefs]; ascots; fur stoles; pockets for clothing; gloves [clothing]; muffs [clothing]; ski gloves; fingerless gloves.

Class 28:

Body-training apparatus; toy glow stick bracelets for parties; cone markers for sports; hand clappers [noisemaker toys]; trading cards [card games]; card games; electric muscle stimulation bodysuits for sports; printed lottery tickets; educational games; soccer goals; soccer balls; shin guards for soccer; football gloves; soccer disc cones; table football tables; soccer ball bags; miniature replica football kits; sporting articles and equipment; fitness exercise machines; training equipment for building muscle; muscle exercise apparatus; novelty toys for playing jokes; shuttlecocks; baseball gloves; billiard tables; boxing gloves; protective padding for sports; knee guards [sports articles]; shin guards [sports articles]; forearm guards [sports articles]; bar-bells; chest expanders [exercisers]; golf clubs; golf gloves; golf bag carts; gymnastic articles; games; games; balls for games; archery implements; swimming belts; water wings; tennis nets; supporters (men's athletic -) [sports articles]; trampolines; fabric toys; toy cars; party balloons; toy pushchairs; action

figures [toys or playthings]; action toys; dolls; puppets; doll houses; children's playthings; toy tea sets; wooden toys; toy figurines; toys made of rubber; rag dolls; musical toys; toy musical instructions; models being toys; toy tools; bathtub toys; toys for sandpits; infants' action crib toys; toys made of wood; costumes being children's playthings; toys made of metal; craft model kits; hand puppets; manipulative games; stuffed toys; dolls' clothes; shoes for dolls; bendable toys; plush toys; toy whistles; play money; puzzles; kites; toy sets; chess pieces; chessboards; building games; board games; train sets; spinning tops [toys]; exercise trampolines; exercise benches; yoga straps; gym balls for yoga; yoga blocks; waist trimmer exercise belts; stationary exercise bicycles; exercise treadmills; gameconsoles; controllers for game consoles; external cooling fans for game consoles; toy gum machines.

Class 32:

Preparations for making non alcoholic drinks; non-alcoholic honey-based beverages; protein-enriched sports beverages; non-alcoholic beverages flavoured with coffee; non-alcoholic dried fruit beverages; flavoured beer; non-alcoholic beverages; beers; energy drinks; mineral water [beverages]; waters [beverages]; table waters; bottled drinking water; syrups and other preparations for making non-alcoholic beverages; aerated water (preparations for making -); non-alcoholic beverages flavoured with tea; cocktails, non-alcoholic; flavoured waters; non-alcoholic fruit juice beverages; lemonades; soda water; seltzer water; aerated water; lithia water; isotonic drinks; rice-based beverages, other than milk substitutes; soya-based beverages, other than milk substitutes; non-alcoholic fruit extracts; beverages consisting of a blend of fruit and vegetable juices; beverages consisting principally of fruit juices; syrups for beverages; malt beer; beer wort; non-alcoholic beer; hops (extracts of -) for making beer; malt wort; ginger ale; kvass [non-alcoholic beverage]; beer-based cocktails; essences for making non-alcoholic beverages; fruit nectars, non-alcoholic; smoothies; must; sherbets [beverages]; juices; vegetable juices [beverages]; squashes [non-alcoholic beverages]; malt syrup for beverages; aperitifs, non-alcoholic.

Class 33:

Alcoholic beverages (except beer); spirits [beverages]; liqueurs; wine; rum; vodka; whisky; aperitifs; gin; cocktails; mead [hydromel]; fruit (alcoholic beverages

containing -); alcoholic extracts; anise [liqueur]; brandy; curacao; distilled beverages; digesters (liqueurs and spirits); arak [arrack]; sugarcane-based alcoholic beverages; rice alcohol; alcoholic fruit extracts; kirsch; bitters; alcoholic essences; peppermint liqueurs; grain-based distilled alcoholic beverages; sake; piquette; pre-mixed alcoholic beverages, other than beer-based; absinthe; alcoholic energy drinks; alcoholic punches; alcoholic preparations for making beverages; alcoholic egg nog; baijiu [chinese distilled alcoholic beverage]; cachaca; chinese spirit of sorghum (gaolian-jiou); soju; chinese mixed liquor (wujiapie-jiou); sake substitutes; nira [sugarcane-based alcoholic beverage]; rum-based beverages; preparations for making alcoholic beverages; tonic liquor containing mamushi-snake extracts (mamushi-zake); tonic liquor flavored with pine needle extracts (matsuba-zake); tonic liquor flavored with japanese plum extracts (umeshu); shochu (spirits); sangria; table wines; vermouth; wine punch; sparkling wines; cherry brandy; extracts of spiritous liquors.

Class 35:

Business management; business management and organization consultancy; updating of advertising material; sample distribution; advertising agencies; advisory services for business management; modelling for advertising or sales promotion; business consulting; arranging newspaper subscriptions for others; news clipping services; personnel selection using psychological testing; outsourcing services [business assistance]; sponsorship search; business management of sports people; telemarketing services; retail services for pharmaceutical, veterinary and sanitary preparations and medical supplies; promotion of goods and services through sponsorship of sports events; commercial intermediation services; mediation and conclusion of commercial transactions for others; provision of an on-line marketplace for buyers and sellers of goods and services; development of advertising concepts; scriptwriting for advertising purposes; business intermediary services relating to the matching of potential private investors with entrepreneurs needing funding; consultancy regarding advertising communications strategy; negotiation of business contracts for others; targeted marketing; media relations services; corporate communications services; business intermediary services relating to the matching of local retailers with customers; advertising services to create brand identity for others; promotion of goods through influencers; influencer

marketing; seeking business partners; marketing through [sic] product placement for others in virtual environments; retail and wholesale services in relation to dietary supplements, jewellery, wristwatches, clothing, footwear, headwear, football equipment, games, toys, sports equipment, alcoholic and non-alcoholic beverages, cereal bars and foodstuffs; import-export agency services; cost price analysis; business appraisal; price comparison services; commercial administration of the licensing of the goods and services of others; procurement services for others [purchasing goods and services for other businesses]; sales promotion for others; distribution and dissemination of advertising materials [leaflets, prospectuses, printed material, samples]; public relations services; advertising; distribution of advertising announcements; on-line advertising on a computer network; rental of advertising time on communication media; layout services for advertising purposes; publication of publicity texts; personnel recruitment; advertising by mail order; marketing services; business inquiries; demonstration of goods; fashion shows for promotional purposes (organization of -); organization of exhibitions for commercial or advertising purposes; arranging of trade fairs; presentation of goods on communication media, for retail purposes; bill-posting; rental of advertising space; publicity material rental; radio advertising; television advertising; production of advertising films; data search in computer files for others; consumers (commercial information and advice for -) [consumer advice shop]; computerized file management; administrative processing of purchase orders; compilation of information into computer databases; systemization of information into computer databases; business information; shop window dressing; rental of sales stands.

Class 41:

Rental of training simulators; physical fitness assessment services for training purposes; transfer of business knowledge and know-how [training]; arranging and conducting of entertainment events; academies [education]; football academy services; organisation of sports tournaments; organising of sporting events, competitions and sporting tournaments; refereeing, umpiring or officiating at sporting competitions; timing of sports events; strength and conditioning training; personal trainer services [fitness training]; fan club services (entertainment); sports club services; sport camp services; ticket reservation and booking services for sporting events; ticket procurement services for sporting events; provision of

information relating to sporting events; providing of information on sporting opportunities; recreation information; conducting fitness classes; production of sports television and radio programmes; organization of exhibitions for cultural or educational purposes; arranging of social events (other than advertising events); arranging of award ceremonies (other than for advertising purposes); film production, other than advertising films; rental of lighting apparatus for television studios; rental of scenery for television studios; rental of theatre scenery; arranging and conducting of concerts; arranging of music performances; sport camp services; camp services (holiday -) [entertainment]; arranging training courses; organisation of quizzes, games and competitions; organisation of seminars and conferences; organization of balls; performances (presentation of live -); photographic reporting; news reporters services; sign language interpretation; interpretation; education; arranging of training and courses and educational programmes; entertainment; publication of fact sheets; electronic desktop publication; providing on-line electronic publications, not downloadable; rental of sports equipment and facilities.