

O-357-12

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2550787
IN THE NAME OF THE FRESH OLIVE COMPANY LTD

AND

OPPOSITION THERETO UNDER NO 101351
BY CANTINE LEONARDO DA VINCI SOCIETA AGRICOLA COOPERATIVA

Background

1. Application No 2550787 has a filing date of 18 June 2010 and seeks registration of the trade mark VINCI. It stands in the name of The Fresh Olive Company Ltd (“the applicant”). Registration is sought in respect of the following goods:

Class 29

Prepared olives; processed olives, preserved olives, marinated olives.

2. Following publication of the application in the *Trade Marks Journal*, a notice of opposition was filed by Cantine Leonardo Da Vinci –Societa Agricola Cooperativa (“the opponent”). That notice of opposition has subsequently been amended to leave just a single ground of opposition brought under section 5(2)(b) of the Act and based on the following Community trade mark (“CTM”):

Mark	Filing/registration date	Specification
4507372 	21 July 2005/ 26 October 2011	Class 29 Olive oil, edible oils and fats Class 33 Wine, sparkling wine, grappa, wine-based liqueurs; wine-based alcoholic beverages

3. The applicant filed a counterstatement in which, essentially, it denies the ground of opposition.

4. Only the applicant filed evidence and only the opponent filed written submissions. Neither party requested to be heard. I therefore give this decision after reviewing all the papers before me.

Evidence

5. The applicant’s evidence takes the form of a witness statement by Adam Wells, that company’s Director since 2009. I do not intend to summarise this evidence as, in the main, it consists mainly of submissions and material not relevant to the amended grounds of opposition, but I will refer to its contents as necessary in this decision.

Decision

6. The single ground of opposition is founded on section 5(2)(b) of the Act which reads:

“5(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.”

7. In these proceedings, the opponent is relying on Community trade mark no. 4507372 which, given the relevant dates set out above, qualifies as an earlier trade mark under the above provisions. As it completed its registration process less than five years before the publication date of the mark for which registration has been applied, the opponent is not required to furnish proof of the use of the earlier mark.

8. In determining the question under section 5(2)(b), I take into account the guidance provided by the Court of Justice of the European Union (“CJEU”) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R 77, *Marca Mode CV v Adidas AG* [2000] E.T.M.R.723, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di Laudato & C. Sas v OHIM* C-334/05 (Limoncello). It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors: *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel BV v Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*, paragraph 23;

- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki v Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma Ag*, paragraph 24;
- (g) in determining whether similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer inc*; mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, paragraph 29;
- (j) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*;
- (k) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L Laudato & C. Sas v OHIM*.

9. In essence, the test under section 5(2)(b) is whether there are similarities in marks and goods which, when taking into account all the surrounding circumstances, would combine to create a likelihood of confusion. The likelihood of confusion must be appreciated globally and I need to address factors such as the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

The average consumer and the nature of the purchasing process

10. As each of the respective goods are for eating and drinking, the average consumer of each of them is a member of the public, albeit, in the case of the goods set out in class 33, those members of the public who have attained eighteen years of age. Each of the goods is one which is a regular purchase, the goods are widely available and likely to be of relatively low cost. None of the goods are such as will involve any great consideration in their purchase though some will take slightly more care when choosing wine. The goods as specified in class 29 are such that they will be purchased by self selection and therefore the visual aspect of the marks are likely to be of greater significance (though not to the extent that the other aspects can be ignored.) The selection of alcoholic beverages from retail outlets such as supermarkets, off-licences or from websites is also likely to consist predominantly of self selection. In bars and restaurants, alcoholic beverages may be chosen from a display behind the bar or from a menu. As a consequence, visual considerations are equally likely to dominate the selection process.

Comparison of the respective goods

11. For ease of reference, I set out below the goods to be compared:

Opponent's goods	Applicant's goods
29 Olive oil, edible oils and fats	29 Prepared olives; processed olives, preserved olives, marinated olives
33 Wine, sparkling wine, grappa, wine-based liqueurs; wine-based alcoholic beverages	

12. In its statement of grounds, the opponent states:

“The Class 29 goods of both parties are identical or similar. The Class 33 goods of the Opponent are similar insofar as these are produce originating from Italy as are the Class 29 goods and consumers of the Opponent's Class 33 goods could be confused when meeting the Applicant's mark being used on goods which are also commonly known to originate from Mediterranean countries, in particular Italy.

The goods would be sold through the same trade channels to the same consumers which increases the likelihood of confusion. These goods are sold in grocery shops, delicatessens and supermarkets throughout the whole of the United Kingdom and nowadays are commonly consumed items. They are also available to consume in outlets such as restaurants, hotels and bars. The average consumer is not, therefore, a specialised person but the ordinary member of the public.”

13. In its written submissions, it adds:

“The average consumer would realise that the respective goods are products which would naturally originate in a sunny country such as Italy. On the whole,

the average consumer would not expect such goods to originate from UK or a country with a cold or cool climate but would be used to seeing and purchasing such goods which originate from other sunnier parts of the EU, in particular from Mediterranean countries, including Italy. Such goods are well-known products and form an important part of the export market of, in particular, Italy.

The olive oil in the Opponent's specification is derived from the identical goods as those of the Applicant's specification. The goods are highly similar. Nowadays, olive oil is also used in manufacturing other edible fats such as butter-like spreads.

The class 33 goods of the Opponent are complementary and often sold in close proximity to the class 29 goods in, for example, Italian delicatessen stores which are nowadays a common feature of the UK High Street and very popular with UK consumers. They are also offered side-by-side in Italian restaurants which again are numerous in the UK and which promote Italian food and beverage products to UK consumers. Indeed, it is common for a small bowl of olives to be offered when one orders alcoholic beverages, such as wine, in a bar or restaurant."

14. For its part, in its counterstatement, the applicant states:

"The Applicant denies that the goods of both parties are identical or similar as asserted by the Opponent, and puts the Opponent to strict proof thereof. "

15. It continues:

"The Applicant's goods are clearly for actual Olives which are the fruit of the Olive tree and are sold as a foodstuff. There are clear differences between [the respective goods], in so much as they have clearly different appearances and culinary uses. In addition, Olive Trees and their fruit are grown worldwide and are in no way exclusive to Italy. The Opponent's argument that wine and olives can be considered similar as they are both produce of Italy is extremely tenuous and should be dismissed."

16. In considering the similarity or otherwise of the respective goods, I take into account the comments of Jacob J in *British Sugar PLC v James Robertson & Sons Ltd* [1996] RPC 280 ("*Treat*"), where he said (at 289):

"When it comes to construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade. After all, a trade mark specification is concerned with use in trade."

17. He went on (at 295) to set out the following factors as being relevant to the question of similarity (insofar as relevant to goods), without reference to the classes in which they fell:

- (a) the respective uses of the respective goods;
- (b) the respective users of the respective goods;
- (c) the physical nature of the goods;
- (d) the respective trade channels through which the goods reach the market;
- (e) in the case of self-service consumer items, where in practice they are respectively found or likely to be found in supermarkets;
- (f) the extent to which the respective goods are competitive. This enquiry may take into account how those in trade classify goods, for instance whether market research companies put the goods in the same or different sectors.

18. In *Canon Kabushiki Kaisha v MGM Inc.* (referred to above), the CJEU stated the following:

23. In assessing the similarity of the goods or services concerned,... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.

19. In *El Corte Ingles v OHIM* Case T-420/03, the court commented:

“96...goods or services which are complementary are those where there is a close connection between them, in the sense that one is indispensable or important for the use the other in such a way that customers may think that the responsibility for the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 *Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

20. I also take note of the case of *Les Éditions Albert René V Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM)* T-336/03, where it was held:

“The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

21. The opponent's goods in class 29 are each oils or fats. They are goods which will be consumed by the general public. Oils and fats are not foodstuffs which are normally eaten as items in their own right but instead will be used as an ingredient in the preparation of other dishes, e.g. to be incorporated into a cake mixture, for use in frying or as part of a dip, dressing or spread. The applicant's goods are olives which may be eaten, again by the general public, as and of themselves or used as an

ingredient in other dishes. Whilst the respective users may be the same and the respective goods may be sold in the same stores, in my experience, they are likely to appear on different shelves and in different areas of those stores. It is my view that the respective goods will reach the consumer through different trade channels with oils and fats being heavily processed from their raw ingredients (and distinguishable from them) whereas, despite a degree of processing, olives will still be recognisable and in substantially similar form to how they are when picked. The respective goods are not in competition with each other and one will not be used in place of the other. In my view, the respective goods are not similar however, if I am found to be wrong in this, then any similarity between the respective goods is, at best, very low.

22. The opponent's goods in class 33 are all alcoholic beverages. They are also goods for which the average consumer is a member of the general public, albeit, given the nature of those goods, those members who have attained the age of eighteen. Whilst each of the respective goods is an item which, in the broadest sense, is for consumption, their natures differ greatly: one is to be drunk, the other to be eaten. The applicant's goods are olives which, however "prepared", still broadly retain their original form. Each of the opponent's goods is such as has been made from a number of ingredients (often including some sort of fruit, though there is no evidence and I am not aware that the olive fruit is commonly, if ever, used in this context) with the end result being a liquid to be drunk. The trade channels by which these respective goods reach the market are entirely different. Whilst each of them may be sold in the same shop, they are highly unlikely to be displayed on the same shelves or even within the same area of the shop, more especially so given the legal restrictions placed upon the sale of alcohol.

23. As to the opponent's submissions that patrons of a bar or restaurants will sometimes be offered a bowl of olives with their drinks, whilst this may be true, being offered a bowl of olives by one's host does not equate to the normal purchasing process the average purchaser of olives would undertake. Olives offered in a bowl in a bar etc. is very much an adjunct to the purchase of a drink (and where the olives are given free of charge) rather than an act of purchasing olives per se. Additionally, in my experience, the drinker would rarely, if ever, be offered a range of olives from different producers from which to choose. If he is given any sort of choice, it is likely to be in the nature of e.g. "green or black" or "pitted or stuffed". The opponent's submission that consumers of the respective goods could be confused because both could originate from Italy or other Mediterranean countries is far-fetched in the extreme. The respective goods are not in competition nor are they complementary. These respective goods are not similar.

24. In order for there to be a positive finding under section 5(2)(b) there has to be some similarity in the respective goods. I have found the opponent's goods in class 33 to be dissimilar to those of the applicant. That being the case, the opposition based on the earlier mark insofar as it is registered for goods in class 33 fails. Whilst my primary finding as far as the respective goods in class 29 is concerned is that they are also dissimilar goods, I indicated that in case I am wrong in this finding, then any similarity is very low and I go on to consider the matter further on that basis.

Comparison of the respective marks

25. Again, for ease of reference, I set out the respective marks below:

Opponent's mark	Applicant's mark
	VINCI

26. In his witness statement filed on behalf of the applicant, Mr Wells refers me to (and exhibits at AW3) a copy of a decision from the Second Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM") in Case R 514/2008-2. That case involved the opponent (in that case acting as applicant) and a third party in a dispute regarding the opponent's application for the registration of a trade mark before OHIM. Mr Wells points to paragraph 13 of that decision which records the submission made by opponent (as applicant in that case) that:

"The search in the Office's data base showed 130 trade marks containing the words "Da Vinci" and 9 trade marks containing the words "LEONARDO DA VINCI". Thus, the mark is not very distinctive *per se* and any minor difference would avoid the likelihood of confusion."

27. The application before OHIM was the mark LEONARDO DA VINCI and therefore the opponent's comments in relation to the distinctiveness of that mark, which is a different mark to the one under consideration in these proceedings, does not assist the applicant. I do not find the submission to be of any assistance to the issue I have to decide.

28. The opponent states:

"The respective marks are visually, phonetically and conceptually similar. The overriding dominant element in [each] mark[-] is the word VINCI. This is the word which would best be remembered by the average consumer of the goods and which is most likely to stay in the mind of said consumer."

29. The opponent's earlier mark consists of what appears to me to be a detailed pen and ink line drawing of the head and shoulders of a young woman below which appear the words DA VINCI (with the letters D and V in slightly larger font than the other letters). Vinci is a town in Tuscany (indeed it is where the opponent is based). I am aware that the words within the mark mean „From Vinci' though I do not know whether the average consumer would know this, particularly in view of the poor reputation, as regards foreign language skills, of those in the UK. Vinci is the town accredited as the birthplace of the well-known Renaissance artist and engineer,

Leonardo Da Vinci, a man often referred to by the name Da Vinci. Whilst he may not be aware of this fact, the average consumer is likely to recognise the words within the mark as referring to the artist, especially so given the style of drawing also within the mark. On the long established principle that „words speak louder than devices’ they are a dominant element of the mark. I am given no information as to whether or not the drawing within the mark was created by Leonardo Da Vinci, however, whether it was or not, it is a detailed drawing which is distinctive and, given its size and position within the mark, it is also a dominant element within the mark.

30. The applicant’s mark consists of the word VINCI presented in plain block capitals. It is a word which has no meaning in English. The mark has no dominant or distinctive elements, its distinctiveness rests in its totality.

31. To the extent that both marks contain (or consist of) the word VINCI, there is a degree of similarity between them from a visual perspective. The respective marks also have significant differences, given the additional elements which appear only in the earlier mark. Given the differences between them, the degree of visual similarity is, at best, moderate.

32. From an aural perspective, the respective marks are somewhat closer. The drawing forming part of the earlier mark will not be articulated –the mark will be referred to as DA VINCI. With that in mind, the only point of aural difference is the addition of the word DA at the beginning of the opponent’s mark which is absent from the applicant’s mark. The respective marks are similar to a reasonable degree from an aural perspective.

33. Conceptually, the earlier mark brings to mind Leonardo Da Vinci. He is well-known as a Renaissance artist etc. and, whilst he is sometimes referred to as Leonardo or Leonardo Da Vinci, he is often referred to simply as Da Vinci. Whilst I am aware that Vinci is a Tuscan town, I have no evidence that the average consumer will be aware of this or that the average consumer will know the meaning of the words Da Vinci. It is more likely he will simply see it as referring to the famous artist, more especially so given the inclusion of the drawing within the mark. The mark applied for is the word VINCI. This is a word that has no meaning in English and, absent any other element as a trigger, is unlikely to bring anything particular to mind in which case the position from the conceptual perspective is neutral. I do not exclude the possibility, however, given how well-known the artist is, that the mark might, for some, bring that artist to mind. If this is the case, there is will be a fairly high degree of similarity between the marks from a conceptual perspective.

The distinctive character of the earlier mark

34. I must also assess the distinctive character of the earlier mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to

distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. The opponent has not filed any evidence of any use of its mark and therefore I have only its inherent distinctive character to consider. Whilst the drawing forming one element of the mark is distinctive of itself, the mark also contains the words Da Vinci, a well-known name rather than an invented word. When considered as a whole, as I must, it is, in my view, a mark with an average degree of inherent distinctive character.

Likelihood of confusion

35. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to factor in the distinctive character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

36. I have found the respective marks to have a moderate degree of visual similarity, a reasonable degree of aural similarity and, for some consumers at least, a fairly high degree of conceptual similarity. I have found the respective goods to be similar, at best, to a very low degree. Taking all factors into account, I find that the differences in the respective marks along with the differences in the respective goods more than offset any similarities between them such that there is no likelihood of confusion, whether direct (where one mark is mistaken for the other) or indirect (where the average consumer believes the respective goods originate from the same or a linked undertaking). Whilst it is possible there will be some consumers who, on seeing the applicant's mark, might think of the earlier mark, for most the later mark will have no meaning. In any event mere association is not enough and the fact that the earlier mark may be brought to mind is not enough for the consumer to go on to be confused about the economic origin of the goods. There is no likelihood of confusion.

Summary

37. The opposition fails in its entirety.

Costs

38. Having succeeded, the applicant is entitled to an award of costs as a contribution to the expense to which it has been put in these proceedings. In making an award, I take note that the opponent did not file any evidence and that the evidence filed by the applicant was not extensive and did not assist me in reaching my decision. I also take note that neither party sought a hearing, the decision having been made from the papers. I make the award as follows:

Preparing a statement and considering the other side's statement:	£400
For filing evidence and reviewing written submissions:	£300
Total:	£700

39. I order Cantine Leonardo Da Vinci-Societa Agricola Cooperativa to pay The Fresh Olive Company Limited the sum of £700. This 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 25th day of September 2012

**Ann Corbett
For the Registrar
The Comptroller-General**