BL O/057/22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3495392

BY

PROSECCO INTERNATIONAL LIMITED

TO REGISTER THE FOLLOWING TRADE MARK:

BELLA

VINO BY BELLA PRINCIPESSA

AND

OPPOSITION NO. 422452 THERETO

BY

ENOITALIA S.P.A

Background and pleadings

1. On 31 May 2020, Prosecco International Limited (the "applicant") applied to register the trade mark as shown on the cover of this decision. The contested application was accepted, and published for opposition purposes in the Trade Marks Journal on 18 September 2020. Registration of the mark is sought in respect of the following goods:

Class 33 *Alcoholic wines; Beverages containing wine [spritzers]; Natural sparkling wines; Wine coolers [drinks]; Wine-based aperitifs; Wines; Rose wines; Sparkling red wines; Sparkling white wines; Sparkling wines; Prepared wine cocktails; Still wine.*

2. On 14 December 2020, Enoitalia S.p.A (the "opponent") opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 ("the Act"), on the basis of three earlier European Union Trade Marks (EUTMs):

EUTM 010350254 (the '-254' mark) BELLA BELLINA	Filing date: 18 October 2011 Registration date: 29 February 2012
Class 33: *Alcoholic beverages (except beers).*	
EUTM 003147006 (the '-006' mark) BELLINO	Filing date: 28 April 2003 Registration date: 21 July 2005
Class 33: *Wines, spirits and liqueurs, not for use in the preparation of wine, spirit and liqueur containing chocolate goods*.	
EUTM 003171915 (the '-915' mark) BELVINO	Filing date: 19 May 2003 Registration date: 16 June 2004
Class 33: *Wines, spirits and liqueurs*.	

3. The opponent relies upon the entire list of goods for which each of the earlier marks are registered for the purposes of this opposition.

4. In its notice of opposition, the opponent submitted that the application is highly similar to the earlier marks on a visual, aural and conceptual basis, as well as on the basis of an overall impression. In addition, the opponent contended that the contested mark is applied for in respect of goods which are identical and highly similar to those of the earlier marks. As a result, the opponent argued that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association.

5. The opponent's marks are earlier in accordance with section 6 of the Act,[1] and each mark completed its registration process more than five years before the date the contested mark was filed.

6. On 25 January 2021, the applicant filed a counterstatement denying the grounds of opposition in the following terms:

1. The Applicant accepts that the Opponents marks are registered for similar or identical goods.
2. The Applicant disputes that the Opponent owns numerous registrations for the marks BELLA BELLINA , BELLINO & BELVINO.
3. The Opponent denies that the Application is confusingly similar to BELLINO or BELVINO.
4. The only mark with any similarity is the Opponents BELLA BELLINA which post-dates the Applicants registered EUTM 18143054 and corresponding UK right 918143054 for BELLA PRINCIPESSA & Device of 25th February 2011.
5. In any event the Applicant denies that the mark applied for is confusingly similar to BELLA BELLINA.
6. Accordingly the Applicant requests that the Opposition be dismissed in its entirety and that an award of costs is made in the Applicant's favour.

7. Within the counterstatement, the applicant also requested that the opponent provide proof of use of its earlier marks. The effect of this is that the opponent may only rely upon the earlier marks to the extent to which their use has been proven.

[1] Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

Evidence and submissions

8. On 20 April 2021, the opponent filed evidence containing a witness statement by Mr Giorgio Pizzola, the president and legal representative of Enoitalia S.p.A. The witness statement identified that Enoitalia was founded in 1986, and is the largest privately owned winery in Italy. According to the witness statement, the winery produced 97 million bottles of wine and other alcoholic beverages in 2017, which were exported to customers across 4 continents in over 80 countries. This led to Enoitalia's total revenue for that year exceeding €170 million. The witness statement was accompanied by exhibits GP1 – GP28, which shall be summarised below to the extent that I deem necessary.

BELLA BELLINA

9. Mr Pizzola's witness statement claimed that Enoitalia's trade in the UK under and by reference to the BELLA BELLINA brand has been significant, and included the following gross turnover figures for the years 2015-2017:

Year	Total number of Bottles of alcohol sold under the BELLA BELLINA brand in UK	Total Gross Revenue generated from sales of goods under the BELLA BELLINA brand in UK
2015	18,396 bottles	€28,514 EUR
2016	10,920 bottles	€16,926 EUR
2017	2,520 bottles	€3,906 EUR

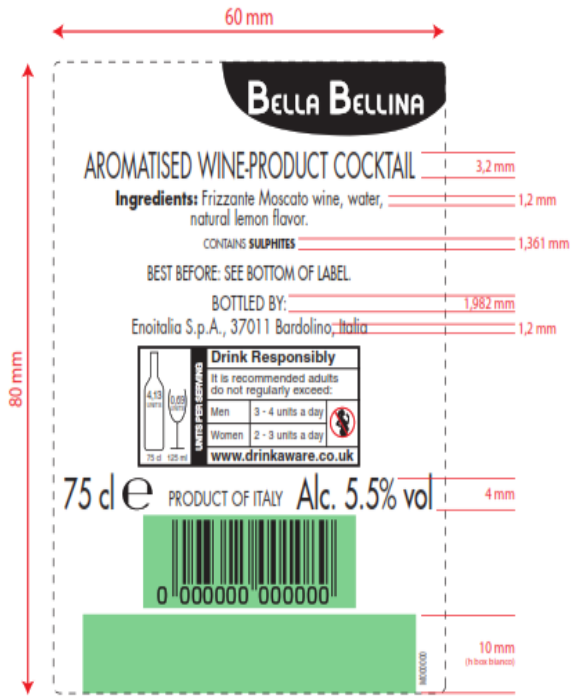
10. Exhibit GP1 consists of a breakdown of the total number of wine and sparkling wine bottles sold under BELLA BELLINA in the EU for the period 2015-2018:

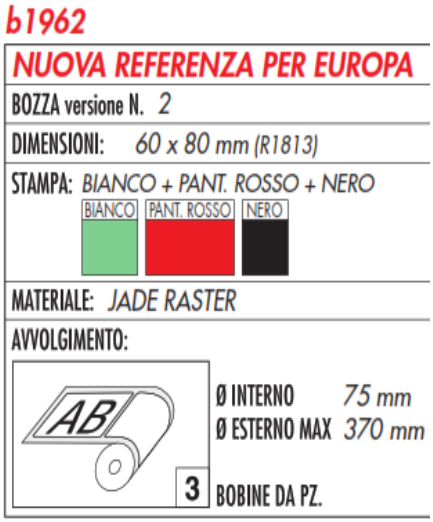
	2015		2016		2017		2018	
Country	Total Bottles sold under BELLA BELLINA brand	Total Gross Revenue from sales under BELLA BELLINA brand	Total Bottles sold under BELLA BELLINA brand	Total Gross Revenue from sales under BELLA BELLINA brand	Total Bottles sold under BELLA BELLINA brand	Total Gross Revenue from sales under BELLA BELLINA brand	Total Bottles sold under BELLA BELLINA brand	Total Gross Revenue from sales under BELLA BELLINA brand
Austria	120 bottles	€228 EUR	-	-	-	-	-	-
Germany	17,564 bottles	€21,621 EUR	10,126 bottles	€15,993 EUR	31,831 bottles	€50,430 EUR	-	-
Greece	-	-	120 bottles	€198 EUR	-	-	-	-
Ireland	1,260 bottles	€2,583 EUR	-	-	-	-	-	-
Italy	8,244 bottles	€14,755 EUR	-	-	-	-	-	-
Netherlands	672 bottles	€1,109 EUR	780 bottles	€1,109 EUR	-	-	672 bottles	€1,109 EUR
Poland	1,260 bottles	€2,583 EUR	-	-	-	-	-	-
Czech Republic	6,190 bottles	€8,215 EUR	-	-	-	-	-	-
Spain	-	-	22,608 bottles	€40,898 EUR	-	-	-	-
Sweden	-	-	1,260 bottles	€2,772 EUR	-	-	-	-
TOTAL	**35,310 BOTTLES**	**€51,094 EUR**	**34,864 BOTTLES**	**€60,970 EUR**	**31,831 BOTTLES**	**€50,430 EUR**	**672 BOTTLES**	**€1,109 EUR**

11. Exhibit GP2 consists of a selection of invoices for the period 2015-2017, showing sales of BELLA BELLINA wine and sparkling wine products in the UK.

12. Exhibits GP3 and GP4 contain mock-ups of BELLA BELLINA white and rosé wine products, produced and distributed in the UK in 2014:

13. Exhibit GP5 contains a draft drawing of a BELLA BELLINA white wine label, which would be affixed to those wine products sold in the UK. Exhibit GP6 is identical, but would be used for rosé wine. The labels were created by Italian company Etigraph Italia srl on behalf of Enoitalia in July 2014:





14. Exhibit GP7 consists of a finalised mock up of the BELLA BELLINA labels for white, rosé and orange wines, which would be sold in all UK ASDA stores. The labels were drawn up in July 2014.

15. Exhibit GP8 contains screenshots of BELLA BELLINA products sold online at Amazon, Vivino and ASDA. Displayed on the products are the labels identified in Exhibits GP3 and GP4. The website extracts are not dated.

16. Exhibit GP9 consists of a screenshot of an article written in August 2015, which featured in beverageindustry.com. The article refers to BELLA BELLINA's two new products 'Moscato Fragolata' and 'Moscato Lemonata'. Displayed on the products are the labels identified in Exhibits GP3 and GP4.

BELVINO

17. Mr Pizzola's witness statement claimed that Enoitalia's trade in the UK under and by reference to the BELVINO brand has been substantial, and included the following gross turnover figures for the years 2015-2020:

Year	Total number of Bottles of alcohol sold under the BELVINO brand in UK	Total Gross Revenue generated from sales of goods under the BELVINO brand in UK
2015	319,200 bottles	€421,420 EUR
2016	312,480 bottles	€398,756 EUR
2017	328,440 bottles	€418,253 EUR
2018	328,896 bottles	€513,095 EUR
2019	325,680 bottles	€510,916 EUR
2020	134,280 bottles	€173,189 EUR

18. Exhibit GP10 consists of a breakdown of the total number of wine, sparkling wine and Prosecco bottles sold under BELVINO in the EU for the period 2015-2018:

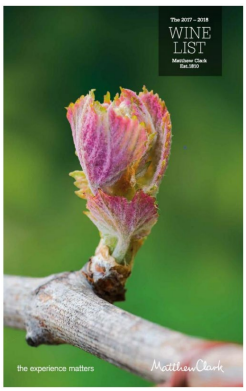
	2015		2016		2017		2018		2019		2020	
Country	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand	Total Bottles sold under BELVINO brand	Total Gross Revenue from sales under BELVINO brand
Belgium	-	-	-	-	-	-	-	-	-	-	192 bottles	€469 EUR
Denmark	-	-	-	-	-	-	1,800 bottles	€5,760 EUR	17,772 bottles	€51,734 EUR	10,380 bottles	€29,324 EUR
Estonia	-	-	-	-	-	-	-	-	2,994 bottles	€5,838 EUR	3,162 bottles	€5,850 EUR
Finland	53,904 bottles	€84,724 EUR	231,288 bottles	€408,099 EUR	342,204 bottles	€574,593 EUR	-	-	2,400 bottles	€4,680 EUR	10,080 bottles	€19,153 EUR
Germany	4,356 bottles	€8,704 EUR	-	-	-	-	-	-	264 bottles	€744 EUR	-	-
Italy	-	-	138 bottles	€283 EUR	6 bottles	€12 EUR	-	-	141,322 bottles	€186,221 EUR	197,362 bottles	€331,596 EUR
Netherlands	2,640 bottles	€3,802 EUR	-	-	-	-	-	-	-	-	-	-
Slovakia	-	-	-	-	-	-	-	-	1,200 bottles	€2,646 EUR	3,198 bottles	€7,224 EUR
TOTAL	**60,900 BOTTLES**	**€97,230 EUR**	**231,426 BOTTLES**	**€408,382 EUR**	**342,210 BOTTLES**	**€574,605 EUR**	**1,800 BOTTLES**	**€5,760 EUR**	**165,952 BOTTLES**	**€251,863 EUR**	**224,374 BOTTLES**	**€393,616**

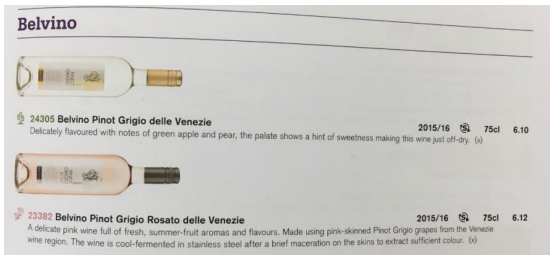
19. Exhibit GP11 consists of invoices, showing sales of BELVINO wine and Prosecco products in the UK, for the period of 2015-2020.

20. Exhibits GP12 and GP13 contain mock-ups of BELVINO white wine and Prosecco DOC[2] products, produced and distributed in the UK in 2015 and 2018 respectively:

21. Exhibits GP14, GP15 and GP16 contain finalised mock-up drawings of BELVINO Prosecco DOC labels to be affixed to product sold in the UK. They were displayed on bottles sold in the UK in 2018 (GP14 and GP15) and 2020 (GP16) respectively. One label is for the collar of the bottle, another is for the front, and the other is for the back of the bottle:

22. Exhibit GP17 (revised version) consists of a Matthew Clark wine list from 2013-2014 and 2017-18. It shows the advertisement of BELVINO Pinot Grigio in the UK:





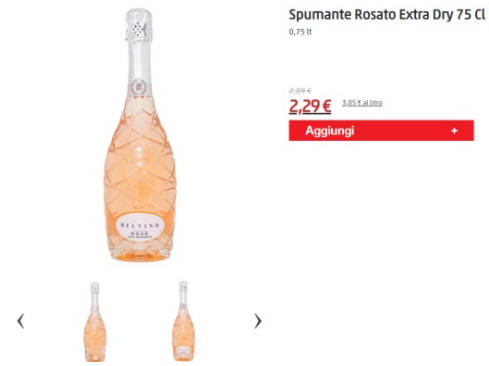
[2] 'DOC' or *Denominazione di origine controllata,* translates to "controlled and guaranteed designation of origin", and is part of the classification system for Italian wine –

https://en.wikipedia.org/wiki/Denominazione_di_origine_controllata

23. Exhibit GP18 also consists of a Matthew Clark wine list, which includes the advertisement of BELVINO Pinot Grigio in the UK, for the period 2020-2021.

24. Exhibit GP19 contains a pamphlet showing an offer from Penny Market's 2019 and 2020 catalogues. The pamphlet includes reference to BELVINO rosé written in Italian:

25. Exhibit GP20 consists of screenshots of BELVINO products sold online at Easywineshop, Vivino, Matthew Clark and Penny Market. Displayed on the products are the labels identified in Exhibits GP12 and GP13:



26. Exhibit GP21 consists of a marketing Christmas brochure created in 2018, used by an unnamed company that purchases the opponent's products. The brochure features the BELVINO Prosecco product.

27. Exhibit GP22 contains screenshots of UK third party references to BELVINO wines and Proseccos, featured on Facebook in January 2019 and July 2020, as well as Tripadvisor in November 2018. The references are by Chef & Brewer pub chain, and Hungry Horse pub.

BELLINO

28. Mr Pizzola's witness statement claimed that Enoitalia's trade in the UK under and by reference to the BELLINO brand has been substantial, and included the following gross turnover figures for the years 2017-2020:

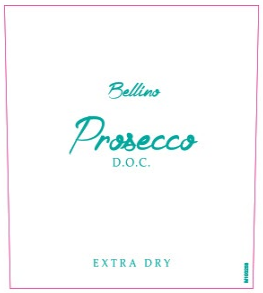
Year	Total number of Bottles of alcohol sold under the BELLINO brand in UK	Total Gross Revenue generated from sales of goods under the BELLINO brand in UK
2017	340,968 bottles	€818,707 EUR
2018	88,272 bottles	€224,570 EUR
2019	3,594 bottles	€7,817 EUR
2020	4,800 bottles	€10,128 EUR

29. Exhibit GP23 consists of a breakdown of the total number of sparkling wine and Prosecco bottles sold under BELLINO in the EU for the period 2017-2010:

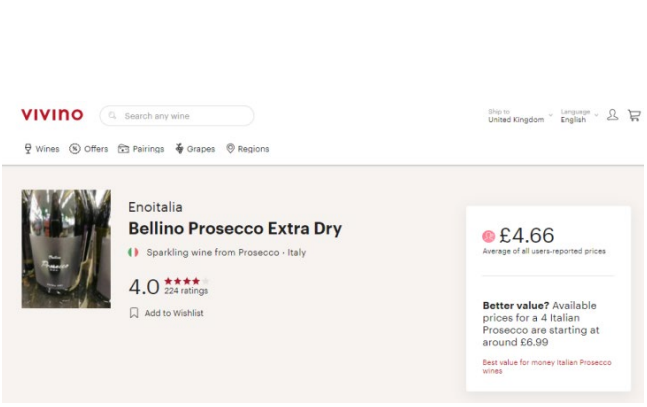
	2017		2018		2019		2020	
Country	Total Bottles sold under BELLINO brand	Total Gross Revenue from sales under BELLINO brand	Total Bottles sold under BELLINO brand	Total Gross Revenue from sales under BELLINO brand	Total Bottles sold under BELLINO brand	Total Gross Revenue from sales under BELLINO brand	Total Bottles sold under BELLINO brand	Total Gross Revenue from sales under BELLINO brand
Denmark	-	-	1,920 bottles	€5,568 EUR	3,714 bottles	€10,123 EUR	3,900 bottles	€10,423 EUR
France	-	-	62,934 bottles	€156,706 EUR	-	-	1,524 bottles	€1,676 EUR
Germany	-	-	780 bottles	€2,145 EUR	-	-	-	-
Italy	-	-	360 bottles	€1,022 EUR	-	-	90 bottles	€238 EUR
Romania	-	-	-	-	30 bottles	€92 EUR	-	-
Spain	-	-	2,880 bottles	€7,805 EUR	11,178 bottles	€28,012 EUR	-	-
TOTAL	**-**	**-**	**68,874 bottles**	**€167,526 EUR**	**14,922 bottles**	**€38,227 EUR**	**5,514 bottles**	**€12,337 EUR**

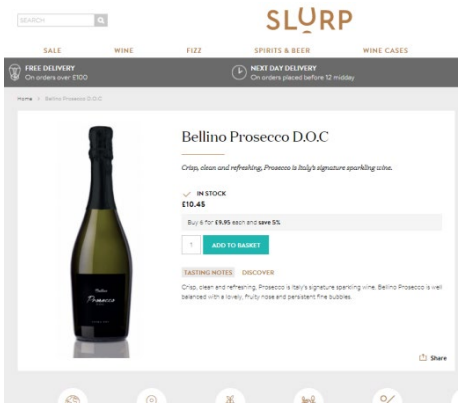
30. Exhibit GP24 consists of invoices, showing the sale of BELLINO wine and Prosecco products in the UK, for the period of 2017-2020.

31. Exhibits GP25 and GP26 contain mock-ups of BELLINO Prosecco DOC labels, used in the UK in 2017:



32. Exhibit GP27 contains screenshots of BELLINO wine and Prosecco products for sale online at Vivino and Slurp. Neither are dated:





33. Exhibit GP28 contains screenshots of UK third party references to BELLINO wines and Proseccos in the UK, featured on Instagram on 26 May 2017, 1 March 2018, and 20 March 2020. The references are by The Red Kite pub, and THEMILLENIALHOST.

34. This completes my summary of the evidence.

35. Whilst I do not propose to fully detail all of the subsequent submissions from either side, it is of course the case that all information that has been submitted has been carefully considered, and will be referred to as and where it is appropriate during the course of this decision.

36. Following a stay of proceedings, the applicant filed evidence in reply on 13 September 2021. The applicant submitted that the opponent's proof of use must relate to the five-year period predating the date of application, i.e. before 31 May 2020, and must consist of indications concerning the place, time, extent and nature of use of the mark in relation to the goods for which each earlier mark is registered. The applicant

argued that some of the evidence is not from the relevant period or location,[3] and must therefore be disregarded. The applicant further argued that certain exhibits do not support use, for example the extract in GP8 which shows the product BELLA BELLINA 'Moscato Lemonata' on Amazon is marked "currently unavailable". The applicant concluded that because the evidence of proof of use is insufficient and cannot be relied upon, the opposition should be rejected in its entirety.

37. In the event that the proof of use evidence is found to be sufficient, the applicant also provided its position on the Section 5(2)(b) objection. The applicant argued that all three of the earlier marks are clearly visually dissimilar to the contested mark, particularly because the contested mark contains a flower device. From an aural comparison stand point, the applicant argued that the contested mark is only similar to the earlier rights to the extent that they share the word 'Bella' (-254), or the prefix 'Bell' (-006), or the prefix 'Bel' and descriptive word 'Vino' (-915). The applicant argued that the verbal elements 'Vino By Bella Principessa' of the contested mark are aurally dissimilar to the each of the earlier rights (including -915, except to the degree that the marks share the descriptive word 'Vino', occupying the last four letters). The applicant also argued that the marks are conceptually dissimilar. The applicant claimed that the concept of the contested mark is that of a girl's first name (Bella), followed by the description of the product (Vino), and the Italian word for princess (Principessa). By contrast, it argued that the opponent's earlier rights have no conceptual meaning, except for the element 'Bella' contained within -254.

38. The applicant submitted that the relevant consumer of the goods at issue is likely to be an adult member of the public, who will purchase the goods via their selection from the shelves of retailers.

39. The applicant argued that because the term 'Bella' is commonplace in relation to goods in class 33 and subsequently has a weak distinctive character, "… it is the addition of further wording that confers the distinctive character of the mark considered as a whole." The applicant claimed that, "as a rule of thumb", there will be no likelihood of confusion whenever two signs share the same common first name but have a

[3] Paragraph 9 (v): "*Exhibit 9 contains an extract from the 'Beverage industry' and we note that the price indicated is in $ so we submit that this article was not targeted at a UK or EU audience and should be disregarded*".

different surname, or other word/s, and that mere coincidence in a first name will in general not lead to a likelihood of confusion.[4]

40. No hearing was requested. Only the opponent provided submissions in lieu, which were submitted on 4 November 2021.

41. The opponent submitted that the previously filed evidence clearly demonstrates genuine use of the earlier marks, at the very least in relation to *wines*; *sparkling/still wines*; and *Prosecco*. In response to the applicant's assertion that there is a lack of evidence of proof of product or actual sales in the UK or EU, the opponent argued that the witness statement of Giorgio Pizzolo is a statement of truth, and therefore the information contained within it should not be disputed. The opponent's submissions responded directly to each of the applicant's claims, for example countering the applicant's criticism of an exhibit which showed an item was currently unavailable (GP8) by arguing that a product marked in such a way simply means it is out of stock, and should be understood as indicating that the relevant retailer is nevertheless a customer of the opponent's products.

42. The opponent submitted that the registered goods are widely available to be viewed and purchased in retail stores, cafes, restaurants, bars and public houses. The opponent submitted that the goods would be purchased by the general public, which is deemed to be reasonably well informed, observant and circumspect, and with an average level of attention at most given that the goods are generally low value. The opponent identified that there may be an aural component in the selection and ordering of the goods in eating and drinking establishments.

43. The opponent reiterated and reinforced several of its original submissions in relation to the visual, aural and conceptual comparisons, most notably referring to the finding that generally speaking the beginning of a sign has a significant influence on the general impression made by the mark.[5] The opponent argued that the dominant and distinctive element of the contested mark is the word 'BELLA', and whilst the other visual elements, such as the device element (which the opponent has not described or named) and wording 'VINO BY BELLA PRINCIPESSA' cannot be ignored, they play

[4] Judgment of 10/12/1999, R 95/2000-2 '*LAURA/LAURA MERGER*'
[5] T-412/08 *Trubion* as cited

a secondary role in the application. The opponent also disputed the applicant's argument that BELLA has a weak distinctive character in relation to Class 33 goods.

44. In relation to the goods comparison, the opponent submitted that they are identical. The opponent argued that this finding influences the potential likelihood of confusion, which is direct or at the very least indirect, especially when considering the notion of imperfect recollection.

Representation

45. Both parties are professionally represented. The applicant is represented by Lewis Silkin LLP, and the opponent is represented by Stobbs.

Decision

46. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Proof of use

47. The relevant statutory provisions are as follows:

Section 6A:

> "(1) This section applies where
>
> (a) an application for registration of a trade mark has been published,
>
> (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
>
> (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office

of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

48. Section 100 of the Act states that:

"100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

49. The relevant period during which the opponent must show use of its three earlier marks is 1 June 2015 to 31 May 2020.

50. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

"114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to

create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]."

51. In *Awareness Limited v Plymouth City Council*, *PLYMOUTH LIFE CENTRE*, BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

> "22. The burden lies on the registered proprietor to prove use […]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public".

52. In *CATWALK* Trade Mark, BL O/404/13, Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

> "21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in Matsushita Electric Industrial Co. v. Comptroller- General of Patents [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:
>
> > [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what

is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not 'show' (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use"

53. For the purposes of procedural economy, I shall first make an assessment of genuine use in relation to the first earlier '-254' mark BELLA BELLINA. Once a conclusion has been reached in relation to this earlier mark, I shall at that point proceed to consider the remaining earlier rights.

BELLA BELLINA

54. Exhibits GP3 - GP9 are examples of how the trade mark BELLA BELLINA appears on the labels of wine bottles. It is clearly apparent that each of the labels on the front of the BELLA BELLINA wine bottles also contain the additional figurative element of a women on a motor scooter, e.g.:

55. The terms BELLA BELLINA appear in word-only form on the labels on the back of the bottles (GP5 and GP6), and also on the supplied invoices at GP2. The invoices frequently contain additional wording, such as 'Moscato Frixxante Cock. Di. Pr. Vitiv. Aromatizzato Limone UK'.

56. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (CJEU) found that:

> "32. … the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.
>
> …
>
> 35. Nevertheless, … a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".

57. It is clear from *Colloseum* that 'use' of a trade mark can be indicated if the sign has been used either independently, or in conjunction with another trade mark. Although the labels that appear on the front of the bottles contain additional elements which are distinctive in their own right, these elements do not alter the distinctive character of the trade mark BELLA BELLINA. As regards the invoices, whilst they contain the additional wording 'Moscato Frixxante Cock. Di. Pr. Vitiv. Aromatizzato Limone UK', this appears to be purely descriptive,[6] and does not alter the distinctive character of the earlier mark. In addition, it does not detract from the fact that the earlier mark is clearly present on the invoices.

58. In *Nirvana Trade Mark,* BL O/262/06, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test of use in a differing form from the trade mark as registered:

> "33. …. The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period…

[6] Opponent submissions in lieu: "*The fact that other word elements are contained upon the invoices within Exhibit GP2 does not mean that BELLA BELLINA is not being used as a trade mark by the Opponent. The additional word elements contained upon the invoices are descriptive elements that help the Opponent to distinguish various BELLA BELLINA products from one another for internal audit and referencing purposes. The words BELLA BELLINA are clearly shown and used upon all the invoices submitted – the 'example' shown by the Applicant also highlights this clearly*"

> 34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

59. The earlier trade mark is clearly visible on all of the bottle labels and invoices, and it has not been altered, affected, manipulated, or interfered with by the presence of the additional figurative and/or descriptive elements. The earlier trade mark appearing in conjunction with additional elements is an acceptable form of use, as identified in *Colloseum*, and so I find the evidence to provide examples which can at least be considered for assessing whether genuine use has been proven.

Genuine use

60. The assessment of genuine use is a multifactorial assessment, elements of which have been openly addressed and contributed to by both sides. The applicant has disputed the validity of certain exhibits filed by the opponent as part of their proof of use. For example, the applicant has argued that exhibit GP8 showing goods marked "currently unavailable" should be disregarded, as should exhibit GP9 which shows goods priced using the $ symbol, because it means they are not targeted at UK or EU consumers. The opponent responded by arguing that being marked "currently unavailable" simply means the products are out of stock [and should still be considered valid], and that although use of a $ symbol reflects the headquarters of the Beverage Industry publication as being outside of the UK/EU, the UK and EU should nevertheless still be considered key markets for the publication.

61. Considering that all three earlier rights are EUTMs, it is worth considering the comments from the CJEU in *Leno Merken BV v Hagelkruis Beheer BV,* Case C-149/11:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider* v *OHIM*, paragraphs 72 and 77).”

62. In light of the above, I tend to agree with the applicant's position that evidence indicating $ is not evidence showing use in a part of the EU and cannot therefore prove genuine use in the community. I am not swayed by the opponent's argument that the UK and EU should still be considered key markets for the publication, because if that were to be the case then I would expect evidence supporting this fact to be provided. In addition, it is my opinion that if sellers of certain products marked "currently unavailable" were indeed active customers, then it should have been relatively easy to evidence the retailer having the product in stock at any other point during the relevant five-year period. I keep in mind the comments from *Plymouth*, and I admit that I am sceptical that something which I imagine could have been provided with relative ease has not been conclusively evidenced.

63. Whilst Exhibit GP9 will not be considered, I nevertheless do find GP1 to be particularly useful for understanding the territorial scope of use. GP1 is a breakdown of wine sold under BELLA BELLINA in the EU for the period 2015-2018. In my opinion, the sales in the EU indicate a sufficient territorial scope of use for the earlier EUTM BELLA BELLINA. This is because the goods were sold in Austria, Germany, Greece, Ireland, Italy, Netherlands, Poland, Czech Republic, Spain and Sweden. The goods were also sold in the UK whilst it was still a Member State.

64. As stated in paragraph 36 of *Leno*, the territorial scope is only one factor for consideration. Another factor which has been challenged by the applicant is the use relating to the relevant period of time for proof of use, i.e. between 1 June 2015 and 31 May 2020. The opponent's witness statement provided BELLA BELLINA turnover figures for the period 2015-2017 in the UK, and provided exhibit GP9 to demonstrate turnover figures for the period 2015-2018 in the EU. The use of the earlier right does not have to be constant during the entire five-year period, and the earlier right has not been challenged under Section 46 of the Trade Marks Act 1994. Therefore, despite some of the evidence relating to before and/or after the relevant period (GP22), or not having been dated at all (GP27), I consider it fair to say that a sufficient amount of the evidence provided would satisfy Section 6A(1A) of the Trade Marks Act 1994.

65. However, it is certainly noteworthy that based on the turnover figures provided it appears that no sales of BELLA BELLINA were made in the UK for the last two and a half years (assuming the figures provided included up to the end of the calendar year)

of the relevant period, and that the annual recorded sales of the preceding years decreased significantly year upon year. Although the turnover in the EU fared better by recording sales in 2018 also, this year equated to only €1,109 in one country, the Netherlands.

66. The evidence of use must indicate 'actual use'[7] that is 'consistent with the essential function of a trade mark'.[8] Based on the evidence before me, I do not find any cause to doubt that in the instances where BELLA BELLINA appears on the invoices and goods within the relevant time period it is indeed being used as an indicator of trade origin.[9] In addition, the evidence before me indicates actual use in so far as the trade mark has been used for marketing[10] *white, rosé* and *sparkling wines*.

67. The evidence of use must also show that it has been more than merely token[11], i.e. being more than serving solely to preserve rights. In addition, the use must be in accordance with the commercial raison d'être of the mark, which is to create or preserve an outlet for the goods or services that bear the mark.[12] I do not consider the evidence to be merely 'token', as the use has not displayed sporadic instances of sales following gaps of inactivity, which could suggest a tokenistic approach. Instead, the evidence has shown periods of consistency followed by a steady decrease in sales. In the UK the sales decreased from €28,514 in 2015, to €16,926 in 2016, to €3,906 in 2017, followed by a two year period of complete inactivity. The pattern in the EU was not identical, with total gross increasing from €51,095 in 2015 to €60,970 in 2016. However, this was followed by a decrease to €50,430 in 2017, and a significant reduction to €1,109 in 2018. The pattern of sales in the EU was similar to that of the UK insofar as the years of 2019 and 2020 showed (by a lack of evidence to suggest otherwise) a complete lack of activity. This leaves me to question whether the outlet for the goods bearing the mark has in fact been preserved, as required.

68. I appreciate that use need not always be quantitively significant for it to be deemed genuine, and even minimal use may qualify as genuine use if it is deemed justified in

[7] *Ansul* paragraph 35.
[8] *Ibid* paragraph 36.
[9] Limited to *wines; sparkling/still wines; prosecco* based on the 'Fair Specification' analysis.
[10] *Ansul* paragraph 37.
[11] *Ibid* paragraph 36.
[12] *Reber* paragraph 29.

the economic sector of the relevant goods.[13] Putting to one side for the moment the fact that the evidence has not indicated any sales in either the UK or EU for the better part of 2-3 years, I find it difficult to acknowledge that the evidence before me indicates genuine use when assessing the factor of sales. It is clear that there is no *de minimis* rule on what is or is not considered quantifiable use.[14] However, I must consider the relevant sector, which is the trade of wine in the EU. No information has been provided by either party to suggest what the annual turnover of such an industry in the relevant territory is, however by using judicial notice and common knowledge I can say with confidence it is a multi-billion euro industry. The opponent itself enjoyed total revenue exceeding €170 million in 2017, and yet its total sales of BELLA BELLINA wine products amounted to €49,346 between 2015-2017 in the UK, and €163,603 between 2015-2018 in the EU.

69. In *Jumpman* BL O/222/16, Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar's decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the European Union within the relevant five-year period. The evidence before me is not identically comparable, as it indicates use over a larger area of the territory, and more units have been sold (102,677). However, I would argue that the number of units sold is equally insufficient when considering the size of the relevant market, i.e. the multi-billion euro wine sector.

70. In order to help decide if the use indicated is sufficient, I have considered *Nazneen Investments Ltd v OHIM, C-252/15 P*:

> "56 It should be recalled that, as the General Court stated correctly in paragraphs 25 and 26 of the judgment under appeal, there is genuine use of a trade mark where the mark is used in accordance with its essential function, which is to guarantee the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark. When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances

[13] Ansul paragraph 39.
[14] *Leno Merken* paragraph 55; and *Ansul* paragraph 39

relevant to establishing whether the commercial exploitation of the mark in the course of trade is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of 17 the mark (judgment in Reber Holding v OHIM, C-141/13 P, EU:C:2014:2089, paragraph 29 and the case-law cited)."

71. It must be borne in mind that the relevant market of wine in the EU is enormous, to the degree that it is a multi-billion euro industry. It is also worth considering the claimed significant position of the opponent. According to the opponent, it is the largest privately owned winery in Italy, and produced 97 million bottles of wine and other alcoholic beverages in 2017 alone, which led to an annual total revenue exceeding €170 million. And yet, during the relevant five-year period its gross revenue total for BELLA BELLINA products sold in the UK and EU combines was €212,949. This does not appear to me to indicate that the commercial exploitation of the sign in the relevant market is 'real' (at least any longer), to the degree or extent that its use maintains a share in the market for the registered goods.

72. Turnover and sales cannot be assessed in absolute terms when considering the presence of genuine use,[15] but instead "must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking using the trade mark and the characteristics of the goods or services on the relevant market". The evidence submitted has not provided clear or detailed information relating to these particular considerations. Although examples of the goods appearing in wine lists have been provided,[16] as has an example of the goods appearing in an advertising pamphlet and Christmas brochure,[17] such examples are limited in number and, in my opinion, are also limited in probative value. In addition, no information has been provided relating to advertising expenditure which could assist in assessing commercial activity or marketing capacities etc.

[15] *Naazneen Investments Ltd v OHIM*, Case T-250/13, paragraph 49
[16] GP17 2017/18; GP18 2020/21.
[17] Gp19 and GP21 respectively.

73. It is clear that the burden to prove genuine use lies with the registered proprietor of the earlier rights subject to the proof of use request.[18] The evidence does not include some of the factors that I would consider to be essential information for the purpose of proving genuine use. As previously considered, some of the opponent's evidence relates to a territory outside of the EU, and from dates not relevant to the five-year period. Also, the evidence does not sufficiently indicate either commercial activity or preservatory sales. If the opponent was truly putting the sign to genuine use, I cannot understand why evidence from outside the relevant time period or relevant territory would be provided, when relevant alternatives should be readily available. Considering the size of the market and claimed repute of the opponent, I am generally sceptical as to why information which should be easily available has not been evidenced to a sufficiently solid degree.

74. I do not simply dismiss all of the evidence, and I acknowledge that a degree of commercial use of the mark existed at the start of the relevant period before tailing off. However, it is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use.[19]

75. I shall hereby briefly compare the use against the relevant factors identified in *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno:*

- I am satisfied that the territorial extent of the use has been sufficiently proven, and the mark was used for marketing some of the relevant goods. [(e) and (f)]

- However, I am not convinced that the use maintains a share in the market for the relevant goods, especially as it seems to me that the use slowed before stopping completely in 2018. [(a) and (d)]

- Further, I am aware of the nature of the goods and characteristic of the market, and would expect more use especially given the opponent's position in such a market. [(b) and (c)]

[18] *Plymouth Life Centre*
[19] *Reber* paragraph 32.

- Furthermore, I am sceptical as to why evidence which should have been easy to show (and could have been provided if the opponent was able) was not proven to a greater degree.

76. Based on the above, it does not appear to me that genuine use has been made out for the earlier mark BELLA BELLINA. As the opponent has failed to establish genuine use of the earlier mark BELLA BELLINA within the relevant period, it cannot be relied upon for the purposes of this opposition, and the opposition fails at the first hurdle in relation to this particular earlier right.

77. However, if in the event I am found to be wrong in this assessment, I shall nevertheless conduct a comparison of the '-254' mark BELLA BELLINA with the contested mark under Section 5(2(b).

Section 5(2)(b)

78. Section 5(2)(b) of the Act is as follows:

> 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".

79. The following principles are gleaned from the decisions of the CJEU:[20]

> (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

[20] *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

(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 might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the goods

80. In *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, the General Court stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

81. The general category '*Alcoholic beverages (except beers)'* of the earlier '-254' mark BELLA BELLINA encompasses the entire specification of the contested mark. The goods at issue are therefore considered to be identical.

Comparison of the marks

82. 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.[21] It would be wrong, therefore, to dissect the trade marks artificially, 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.

[21] Case C-591/12P, *Bimbo SA v OHIM*, paragraph 34:

".....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."

83. The respective trade marks are shown below:

Earlier '-254' trade mark	Contested trade mark
BELLA BELLINA	

84. The overall impression of the opponent's earlier mark derives from the combination of the two word elements, 'BELLA' and 'BELLINA'. The words are presented in standard typeface and are of equal size. Because of this, neither element can be considered to be more eye-catching or dominant than the other. Neither word has a meaning in the English language. However, I consider 'BELLA' to be generally understood by the UK consumer either as meaning 'Beautiful' in the Italian and Spanish languages, or as a female forename, as contended by the applicant.

85. Neither side offered a meaning for 'BELLINA' in any language. Therefore, by way of it being an apparently invented term, I consider 'BELLINA' to be the more distinctive aspect of the two elements. However, the overall impression of the earlier mark lies in its totality. The elements hang together, and in instances where the consumer considers 'BELLA' to be a forename, the totality is likely be perceived as a person's full name, with 'BELLINA' acting as a surname.

86. The contested mark can be said to comprise three elements: 1) the device of a flower; 2) the strapline 'VINO BY BELLA PRINCIPESSA'; and 3) the centralised larger word 'BELLA'.

87. 1) The flower device element sits above the word 'BELLA'. It is of a reasonable size and is in a central position. It has no counterpart in the earlier mark.

88. 2) The strapline element sits below the larger word 'BELLA', and is a combination of the Italian words 'VINO', 'BELLA' and 'PRINCIPESSA' and the English word 'BY'. Although the opponent submitted that the strapline was a secondary element, it did

not argue that it would not be spoken. Therefore, I consider it to be an element which the average consumer will fully take into consideration, not least because of the conceptual impact of the words 'VINO BY…' which will be readily understood. I believe the word 'VINO' will be widely recognised by the average UK consumer in general as meaning 'wine', and even more so by the relevant consumer of alcoholic beverages, particularly those who favour consuming wine. As a result, it will be recognised as having a descriptive meaning in the strapline. The word 'PRINCIPESSA' is Italian for 'Princess'. 'PRINCIPESSA' would likely be less well-known by the average UK consumer than the terms 'VINO' and 'BELLA', because, generally speaking, it is not as familiar a term. It is possible that some consumers may connect 'PRINCIPESSA' to the English language version 'Princess' due to the similarity between the words, and as a result perceive the combination 'BELLA PRINCIPESSA' as meaning 'Beautiful Princess'. However, I consider it more likely that the consumer will view the combination 'BELLA PRINCIPESSA' as a combination that serves to create a full name. This is due in part to the position and use of the English word 'BY' in the strapline, serving to indicate that whatever follows it is the entity that produced the 'VINO'. Considering that 'BELLA' will be recognised as a forename, I believe it likely that the term 'PRINCIPESSA' will be perceived as playing the role of a surname.

89. 3) The central, larger word element 'BELLA' has the same meaning as its counterpart in the earlier mark, i.e. 'Beautiful' or a female forename. It plays the greater role in the overall impression of the mark. This is for a number of reasons, including the fact that it comprises the largest element in the mark. It is generally the case that the eye is naturally drawn to elements that can be read, and as such, the flower device will subsequently play a lesser role in the mark. However, due to its reasonable size and central position it certainly cannot be ignored. Of the two verbal elements, the central word 'BELLA' is the larger and so will be read first. Whilst the central word 'BELLA' may be the more eye-catching element, neither the flower device nor the strapline should be dismissed, and they both play an integral part in the overall impression of the sign, which lies in its totality.[22]

[22] C-193/06 P *Nestlé* v *OHIM* paragraph 36

Visual similarity

90. Visually, the marks are similar in so far as they coincide in the word ‘BELLA’, which appears twice in the contested mark. This is the limit of the visual similarity, as the flower device and strapline of the contested mark, and the word BELLINA of the earlier mark, are points of visual difference. The visual differences outnumber the visual similarities, and I therefore consider the marks to be visually similar to a degree that is somewhere between low and medium.

Aural similarity

91. The opponent’s earlier mark will be articulated as the two words ‘BELLA’ and ‘BELLINA’. As I have already stated, I consider that the word ‘BELLA’ will generally be recognised by the UK consumer, who will pronounce it as two syllables ‘BEL’ and ‘LA’, with the final ‘A’ being an open vowel, like the ‘A’ in ‘Apple’. The first syllable in the word BELLINA will be pronounced identically to the ‘BEL’ in ‘BELLA’, with the second syllable ‘LIN’ being pronounced ‘LEAN’, and the third syllable being pronounced as an open vowel ‘A’.

92. The combination ‘VINO BY BELLA PRINCIPESSA’ would likely be pronounced as ‘VEE-NO’, plus the standard pronunciation of the English language word ‘BY’, plus the above established pronunciation of ‘BELLA’, and ‘PRINCE-EE-PES-A’, with an open vowel ‘A’. The figurative element will not be articulated, and therefore has no aural impact.

93. The contested mark shares two syllables with the earlier right (BEL-LA), which would be articulated twice (including its presence in the strapline). However, the contested mark contains the additional seven syllables VEE-NO-BY-PRINCE-EE-PES-A, which are not contained in the earlier right. In addition, the earlier right has the additional three syllables BEL-LEAN-A, which are not contained in the contested mark. Taking all of this into account, and notwithstanding the fact that the shared syllables form the beginnings of each mark, I consider the marks to be aurally similar to only a low degree due to the numerous differences.

Conceptual similarity

94. The term ‘BELLA’ in the earlier mark has two possible meanings. The first is that it means ‘Beautiful’ in Italian and Spanish. Although this is not an English language term, I consider it to be generally understood by the UK consumer as meaning ‘Beautiful’. The second meaning of ‘BELLA’ is that it is a female forename. This was first argued by the applicant, and has not contested by the opponent.

95. Neither party has proffered a meaning for ‘BELLINA’ in the earlier right. I shall therefore proceed on the basis that it has no concept in and of itself. However, when used in combination with the term ‘BELLA’, and as a direct result of being used in this way, I believe that the mark as a whole conveys the concept of a full female name, in which the term ‘BELLINA’ will be perceived as a surname.

96. The conceptual impact of the word ‘BELLA’ in the contested sign is also that of the Italian/Spanish word for ‘Beautiful’, or a female forename. This is the extent of the conceptual similarity between the two marks. I consider the combination of words ‘VINO BY BELLA PRINCIPESSA’ to be perceived as a strapline. Due to the meaning and positioning of the word ‘BY’ in the strapline, it is my opinion that whatever comes after it will be perceived by the consumer as a combination that hangs together, with the purpose being to indicate the name of the producer of the ‘VINO’ (which will largely be recognised as meaning ‘wine’). Because ‘BELLA’ is recognised as a forename, and because the combination hangs together, I believe the word ‘PRINCIPESSA’ will be perceived as fulfilling the role of a surname. The result is that the consumer will perceive ‘BELLA PRINCIPESSA’ to be the name of the individual or undertaking that produced the wine.

97. The strapline provides an obvious conceptual difference between the two marks, as does the figurative device of a flower which has no comparable counterpart in the earlier mark. However, as both marks contain the identical term ‘BELLA’, which shares a concept of meaning ‘Beautiful’ and a female forename, the marks can be said to be conceptually similar to no more than a medium degree. The conceptual similarity could have been said to be have been higher than medium degree were it not for the additional elements ‘BELLINA’ and ‘PRINCIPESSA’ respectively. This is because these elements will be considered to act as surnames, thereby serving to set the marks

apart conceptually when being perceived as the full female names BELLA BELLINA and BELLA PRINCIPESSA.

Average consumer and the purchasing act

98. The average consumer is a typical person,[23] who is deemed to be reasonably well informed and reasonably observant and circumspect, whose level of attention will likely vary depending on the category of goods in question.[24] All of the contested goods are forms of alcoholic beverage. The average consumer will therefore be an adult, of the legal drinking age of 18 or over. The goods are everyday products, falling within a generally affordable price range of inexpensive goods. The goods will primarily be purchased in self-service stores such as supermarkets and off-licences, which is a form of visual purchase. The goods will also likely be sold online using websites, which will also enable a visual purchase. The goods may also be asked for in a bar or restaurant, and so I do not discount the possibility that there may be an aural element to the purchasing process. However, I consider the purchasing process to be predominantly visual. Although certain alcoholic beverages are more expensive than others, in general the level of attention paid during the purchase process will be somewhere between low and medium.

Distinctive character of the earlier trade mark

99. 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-

[23] 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)
[24] *Lloyd Schuhfabrik Meyer*, Case C-342/97

108/97 and C-109/97 *WindsurfingChiemsee* 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)."

100. The opponent has made no claim that its earlier mark has acquired an enhanced degree of distinctive character. Although evidence was provided in response to the proof of use request, it is my opinion that the evidence was not successful in proving genuine use. With that in mind, it cannot be the case that the evidence has in any way enhanced the distinctive character of the earlier sign. My assessment of the degree of distinctive character of the earlier mark is therefore to be made only on the basis of its inherent features.

101. As a whole, the earlier mark may be perceived in one of two ways. The first is as the full female name 'BELLA BELLINA'. This perception will occur when the first element 'BELLA' is understood to be a female forename, which influences the perception of the second element 'BELLINA' as being a surname. In such instances, the earlier mark is considered to be inherently distinctive to at least a medium degree. The second way to perceive the sign is as the combination of the Italian or Spanish word for 'Beautiful', and the invented term 'BELLINA'. As such the element 'BELLINA' will be perceived to be the more distinctive of the two elements by way of being an invented word. In such instances, the earlier mark is considered to be inherently distinctive to at least a medium degree. In my opinion, the first scenario will be the more likely of the two perceptions. Either way, the earlier mark is considered to possess at least a medium degree of distinctive character.

Likelihood of confusion

102. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, whilst indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind.[25] The factors include 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 services and vice versa.[26] It is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the services and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

103. I have found the contested mark and the earlier '-254' mark BELLA BELLINA to be visually similar to between a low and a medium degree, aurally similar to a low degree, and conceptually similar to no more than a medium degree. It is important to keep in mind that in the global assessment of the likelihood of confusion, the visual, aural and conceptual aspects do not always have the same weight, and it is appropriate and necessary to examine the conditions under which the goods are marketed.[27] The contested goods will predominantly be purchased in self-service stores and online, where consumers choose the product themselves, and must therefore rely primarily on the image of the trade mark applied to the product. As such, the visual similarity between the signs will as a general rule be more important.[28]

104. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. acting as the Appointed Person, identified the following in paragraph 39:

[25] *Sabel*, C-251/95, para 22
[26] *Canon*, C-39/97, para 17
[27] *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03
[28] *Quelle AG v OHIM,* Case T-88/05

> "…if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it"

105. As I have previously established, the earlier right will be perceived in one of two ways. I shall consider first those instances in which the earlier right is perceived as the Italian/Spanish word for 'Beautiful' ('BELLA') plus the invented term 'BELLINA'. In such circumstances, it is my opinion that the more distinctive aspect of the earlier mark is the term 'BELLINA' by way of it being an invented word. This invented word has no counterpart in the contested mark, in terms of a verbal element of equal size, positioning or dominance. The presence of the word element 'BELLINA' in the earlier mark is therefore a point of difference between the two signs. The contested mark also has elements which are a point of difference between the two signs. Although the figurative element is secondary, and the strapline is smaller, it should be remembered that just because an element is not dominant it in no way means that it is negligible.[29] These two elements indisputably play a role in the overall impact of the contested mark, and are themselves inherently distinctive. They have no counterpart in the earlier mark, and as a result go some way to creating a distance between the two marks not only from the visual perspective, which in this assessment is the most relevant, but from an aural and conceptual perspective also. Bearing in mind that the purchasing process will be predominantly visual, it is my opinion that the numerous visual differences in the marks prevent a finding of direct confusion.

106. It is also quite possible that the earlier mark will be perceived as hanging together to create the full female name 'BELLA BELLINA'. The concept of a full female name has an actual counterpart in the contested mark, as affected by the use of the word 'BY' in the strapline 'VINO BY BELLA PRINCIPESSA'. The applicant has argued that "as a rule of thumb" the mere coincidence in a first name will in general not lead to a likelihood of confusion, especially if the signs have a different surname or other word/s (see *LAURA/LAURA MERGER)*.[30] In instances where the consumer considers the

[29] C-193/06 P *Nestlé* v *OHIM* paragraph 36
[30] Judgment of 10/12/1999, R 95/2000-2 '*LAURA/LAURA MERGER'*

term ‘BELLA’ to be a female forename, then the surname would by default be ‘BELLINA’ in the earlier mark, and ‘PRINCIPESSA’ in the contested mark.

107. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

> “54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).
>
> 55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSSI), not published in the ECR, paragraph 45). **In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character**. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.” [emphasis added]

108. If ‘BELLINA’ and ‘PRINCIPESSA’ are perceived as surnames, which in my opinion is the likely scenario due to the fact that neither word is more dominant nor eye catching and thus hangs together with ‘BELLA’ to create a name, then both surnames can be considered to be unusual and ipso facto distinctive, which would consequentially go against a finding of direct confusion. Although in *El Corte Inglés*

the GC referred to the Italian and Spanish consumers, I nevertheless consider the analysis to apply equally to the UK consumer. For example, I consider that there would be a greater likelihood of confusion between David Beckham and Darren Beckham than there would be between David Beckham and David Jones, due to the fact that the surname Beckham is less common than the forename David.

109. In its submissions, the opponent argued that it is the beginning of a sign which has a significant influence on the general impression made by the mark (see *Trubion*). The opponent's argument is a similar point to that which was made by the GC when comparing the trade marks MUNDICOLOR and MUNDICOR,[31] whereby the GC stated that the consumer normally attaches more importance to the first part of words. However, it is important to keep in mind that a global assessment of the likelihood of confusion must be based on the overall impression given by the signs, bearing in mind their distinctive and dominant elements. In addition, and especially during an assessment of similarity including composite marks, the assessment can only focus on one particular element over another when that other element is itself negligible.[32] Neither 'BELLINA' in the earlier right, nor the figurative element nor strapline in the contested mark can be considered to be 'negligible', and the overall impression of each mark therefore lies in its totality.

110. Based on all of the above, I do not believe it likely that the average consumer would mistake the contested mark for the earlier right or vice versa, and subsequently direct confusion will not occur.

111. I shall now consider the possibility of indirect confusion. It should be borne in mind that a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.[33] Further, 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.[34]

[31] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[32] *Nestlé v OHIM* paragraph 36
[33] In *Liverpool Gin Distillery Limited v Sazerac Brands LLC [2021] EWCH Civ 2017,* paragraph 13, Arnold LJ approved this "consolation prize statement" as made by James Mellor QC's (sitting as the Appointed Person) statement in *Cheeky Italian Ltd v Sutaria* (O/219/16) paragraph 16.
[34] *Ibid, Arnold LJ's words at paragraph 13.*

112. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."
>
> 17. Instances where one may expect the average consumer to reach such a conclusion 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)."

113. For the avoidance of doubt, I acknowledge that these examples are not exhaustive, but are nevertheless illustrative of the kind of instances where indirect

confusion ‘tends to fall’. These examples may be considered to provide a helpful focus, and are certainly relevant in relation to the current comparison. The two marks share only one element, which is the word ‘BELLA’. I do not consider the word ‘BELLA’ to be so ‘strikingly distinctive’ to the extent that the average consumer of wine and alcoholic beverages would assume no-one else but the brand owner would be using it in a trade mark.

114. The contested mark contains the additional elements of a flower device and the strapline ‘VINO BY BELLA PRINCIPESSA’, which are inherently distinctive in their own right. I do not, therefore, consider it to be the case that the latter mark has simply added non-distinctive elements which one would expect to find in a sub-brand or brand extension. I do not believe it likely that any reasonably well informed, circumspect and observant consumer would interpret the numerous and distinctive additional elements present in the contested mark to be either an expected sub-brand or entirely logical brand extension of the earlier right. Further, I do not consider the ‘removal’ of the distinctive element ‘BELLINA’ from the earlier mark, in favour of the aforementioned additional distinctive elements present in the contested mark, to follow a logical brand extension or an obvious brand variation either.

115. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. The fact that the contested and earlier marks only share the element ‘BELLA’ does not, therefore, lead to indirect confusion. At best, it may lead to mere association (which is insufficient for a finding of indirect confusion), although in my opinion even this is unlikely due to the prevalence of additional distinctive elements within each mark that have no counterpart in the other.

116. According to the interdependency principle, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa[35]. The visual perception is the most important in relation to the current assessment due to the purchasing process of the

[35] *Canon* paragraph 17

respective goods, and the marks have to found to be visually similar to somewhere between a low and medium degree. The goods at issue have been found to be identical. If one were to follow the principle of interdependency as a formula, then the relatively low degree of visual similarity might be offset by the identity between the goods, thus concluding that there is indeed a likelihood of indirect confusion. However, such a conclusion in these proceedings would appear to me to be an overly artificial and manufactured conclusion. The similarity between the marks lies entirely in the shared element 'BELLA'. The remaining differentials affect the perception of this element in each of the two marks, to the degree that the consumer would not expect them to come from the same undertaking. Arguably the more distinctive elements of each mark are wholly different, and in my opinion the overall impressions of each mark are certainly unalike. As a result, I find that there is no likelihood of indirect confusion.

117. The opposition, insofar as it is based on the earlier '-254' mark 'BELLA BELLINA' has failed under Section 5(2)(b) of the Trade Marks Act 1994.

118. I now turn to consider the two remaining earlier marks relied upon by the opponent. I do not consider it to be necessary to undertake a full comparison between the contested mark and either of EUTM 003147006 'BELLINO' or EUTM 003171915 'BELVINO' for the following reasons. The earlier mark 'BELLA BELLINA' is clearly the closest of the three earlier rights to the contested mark, on the basis that it at least includes the whole term 'BELLA'. Neither of the two remaining earlier marks contain this element. The extent of the remaining two earlier marks' similarity with the contested mark would lie in the sharing of either the four letters 'BELL' (-006) or the three letters 'BEL' (-915). Having found that the earlier mark 'BELLA BELLINA' (-254) would not be directly or indirectly confused with the contested mark, despite containing the whole term 'BELLA', it appears to me to be clear and obvious that the two remaining earlier rights with even less shared letters/elements would fail also.

119. The issue of proof of use in respect of the two earlier rights -006 and -915 is therefore a moot point and does not need to be assessed. Even if genuine use were to have been proven for the two remaining earlier marks, they would not be found to be similar under Section 5(2)(b).

120. Having fully considered the opponent's strongest position under Section 5(2)(b) (even though I found that genuine use had not been proven in respect of the earlier mark -254), it is my finding that the opposition fails in its entirety.

Costs

121. The applicant has been successful and is entitled to a contribution towards its costs. I bear in mind that the relevant scale is contained in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £1,000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Considering the statement of grounds and preparing a counterstatement	£250
Considering and commenting on the Opponent's evidence	£750
Total	£1,000

122. I therefore order Enoitalia S.p.A to pay Prosecco International Limited the sum of £1,000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 24th day of January 2022

Dafydd Collins

For the Registrar