# O-341-21

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3388943**

**BY OWEN WARREN**

**TO REGISTER AS A TRADE MARK:**


**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 417036**

**BY CONSORZIO DI TUTELA DELLA DENOMINAZIONE DI ORIGINE CONTROLLATA PROSECCO**

## Background and pleadings

1. The application to register trade mark application number 3388943 was filed on 2 April 2019 by Owen Warren. Registration is sought for the trade mark shown below:


2. The application is made in respect of "Wines; British Sparkling Wines; Sparkling Wines" in class 33.

3. The application is opposed by the Consorzio di Tutela della Denominazione di Origine Controllata Prosecco ("the opponent"). The opposition is based upon ss. 3(3)(b), 3(4), 3(6), 5(2)(b), 5(3), and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The opposition is, under each of these grounds, directed against all of the goods in the application.

4. Under s. 3(3)(b), the opponent claims that, due to the high degree of similarity between the signs at issue, consumers will connect the contested mark with PROSECCO. The contested mark is, therefore, liable to deceive the public as to the quality, characteristics and origin of the goods sold under that mark and to cause the consumer to believe that the goods offered under the contested mark are compliant with or licensed by the PDO.

5. Under s. 3(4), the opponent contends that the contested mark should be refused in light of Articles 102 and 103(2) of Regulation (EU) 1308/2013 of the European Parliament and of the Council of 17 December 2013 ("the Regulation").

6. Under s. 3(6), the opponent claims that Mr Warren has no genuine connection with PROSECCO and/or the opponent and that the contested mark was chosen for opportunistic reasons in the full knowledge that consumers will associate the contested mark with the Protected Designation of Origin ("PDO") Prosecco and with the reputation enjoyed in the UK.

7. Under ss. 5(2)(b) and 5(3), the opponent relies upon its UK trade mark number 3257427 for the word “PROSECCO”, which has a filing date of 18 September 2017 and was registered on 5 October 2018. It is a certification mark. Under these grounds, the opponent relies upon all of the goods for which the mark stands registered, namely “wines complying with the specification of the PDO Prosecco” in class 33. As the opponent’s trade mark had not been registered for five years at the date on which the contested mark was filed, it is not subject to the use provisions at s. 6A of the Act and the opponent may rely upon it without demonstrating that it has used the mark.

8. The claim under s. 5(2)(b), is that the contested mark is similar to the opponent’s marks and that the goods and services at issue are identical or similar. The opponent asserts that there is a likelihood of confusion, including the likelihood of association. It says that the relevant public is likely to consider that the goods are provided by the same or a connected undertaking. It claims the likelihood of confusion is increased because of the enhanced distinctive character of the earlier mark.

9. Under s. 5(3), the opponent claims that the mark has a reputation for all of the goods for which it is registered, such that use of the contested mark would cause the relevant public to believe that there is an economic connection between the parties, where no such connection exists. The opponent claims that use of the contested mark would give an unfair advantage to Mr Warren, who would free ride on the reputation and/or prestige of the earlier mark, deriving an illegitimate benefit and/or illegitimately exploiting the marketing efforts of the opponent. It also claims that the reputation of the earlier mark would be tarnished, because the opponent cannot control the manner in which the contested mark is used and because the goods sold under the contested mark may appeal to the public’s senses in such a way that the earlier mark’s power of attraction is diminished. It is alleged that the similarity between the respective marks may have a negative influence on the image of the earlier mark. It is also claimed that the distinctive character of the earlier mark would be damaged, its capacity to arouse an immediate association with the opponent’s goods being reduced, diluting the value and reputation of the earlier mark and adversely affecting the economic behaviour of the relevant public.

10. Under s. 5(4)(a), the opponent claims that it has used the sign PROSECCO throughout the UK since December 2009. It is said that the sign has been used in respect of "development and support of information, educational, cultural and sporting initiatives and events to promote the Controlled Designation of Origin Prosecco and to promote its image and reputation". The opponent's claim under this ground is put as follows:

> "The Opponent and its members have built up valuable goodwill in the UK. As a result, the use of the Opposed Mark is liable to be prevented by the law of passing off. This is because the Applicant's potential customers or licensees would be falsely led to believe that producers of PROSECCO have endorsed or licensed the Applicant's goods. Use of the Opposed Mark would:
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> (a) erode the exclusive goodwill of the PROSECCO producers;
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> (b) result in the PROSECCO producers losing control of their goodwill being prevented from launching products of their own in the Applicant's field of trade; and
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> (c) cheapen and debase the reputation of the PROSECCO producers".

11. Mr Warren filed a counterstatement denying each of the grounds of opposition. In particular:

- The differences in spelling, typeface, font and script between the trade marks are highlighted;
- It is accepted that sales may be affected "as in any competitive market by giving the consumer another choice of product, but that is not a sound reason to oppose the application";
- There is no dispute that PROSECCO has a reputation for wines;[1]

[1] Mr Warren confirmed at the hearing that the opponent's reputation is accepted.

- The rationale behind the contested mark (and the goods sold under it) is said to be that it is British made, from British produce, in Britain and that it will set itself apart from British and English wines, as well as Prosecco;

- Deception is denied, as "anyone who has heard of Prosecco knows where it comes from and what they expect from it. Anyone who doesn't is fair game in terms of trade";

- The application is said to have been made to provide a product which "differs completely" from Prosecco and Cava "or any other Foreign Prosecco", with marketing focusing on its British origins.

12. Both parties filed evidence. A hearing was held before me, by videoconference, on 9 March 2021, attended by both parties. The opponent was represented at the hearing by Fiona Clark of Counsel, instructed by Bird & Bird LLP. Mr Warren represented himself.

13. 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.

**Preliminary issue**

14. At the hearing, Ms Clark made a formal application, which had been foreshadowed in her skeleton argument, to amend the opponent's pleadings to include reliance upon s. 3(4A). The request was characterised by Ms Clark as an application made "for the avoidance of doubt", in case the view was taken that s. 3(4) no longer covered claims based upon PDOs. That is because, on 14 January 2019, the Trade Mark Regulations 2018 ("the 2018 Regulations") came into force, which amended section 3(4) of the Act and introduced a new s. 3(4A). In Ms Clark's submission, the basis of the opponent's claim had always been clear, and the amendment would have no effect on the arguments

or evidence. Mr Warren objected to the request on the basis that the grounds should have been made clear at the outset.

15. I accept that the opponent ought to have recognised the potential implications of the amendments in January 2019 and that it is incumbent on an opponent to identify correctly the applicable law upon which it intends to rely. The ground could plainly have been pleaded from the start. However, it has been clear from the outset that the opponent's claim was based upon the contravention of directly effective EU laws regarding PDOs. The substance of the claim itself has not changed at all. Furthermore, there would be no prejudice to Mr Warren and no delay in allowing the amendment. I granted the opponent's request, so that the claim is now brought under the provisions of s. 3(4) and/or s. 3(4A).

**Witnesses**

16. For the opponent, evidence is provided by Stefano Zanette, President of the opponent, in a witness statement with fourteen accompanying exhibits. Mr Zanette provides information about the opponent's activities in the UK and about the popularity of Prosecco wine in the UK. He also gives evidence concerning the PDO for Prosecco wine.

17. Mr Warren, in his capacity as applicant, has provided a witness statement in his own name, with two exhibits. He gives evidence about the design process and intended use of the contested trade mark.

18. Neither witness was cross-examined. I will return to the details of the evidence as necessary later in this decision.

**Relevant date**

19. Each of the grounds pleaded must be assessed at a particular point in time. In this case, as Mr Warren has not filed any evidence of the mark in use, nor has he made any claim to such use before the date of application, there is no need to consider the potential relevance of an earlier date of first use under s. 5(4)(a).[2] That being the case, the relevant

[2] See *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, approving the decision in *SWORDERS Trade Mark*, BL O/212/06.

date for the assessment under each of the grounds pleaded in this case is the date of application for the contested trade mark, i.e. 2 April 2019.

**Sections 3(4) and 3(4A)**

20. It is convenient to begin with the claims under ss. 3(4) and 3(4A). At the relevant date, the law read as follows:

> "3. — (4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of EU law other than law relating to trade marks.
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> (4A) A trade mark is not to be registered if its registration is prohibited by or under—
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> (a) any enactment or rule of law,
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> (b) any provision of EU law, or
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> (c) any international agreement to which the United Kingdom or the EU is a party,
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> providing for the protection of designations of origin or geographical indications".

Is section 3(4) applicable?

21. The opponent's position appears to be that there is an overlap between the provisions of s. 3(4) and those of s. 3(4A) and that the scope of both provisions is wide enough to catch any breach of Articles 102 and 103(2) of the Regulation. I acknowledge that s. 3(4), as it stood before the amendments made on 14 January 2019, has been relied upon in similar proceedings where the claimant has invoked a PDO and Articles 102/103(2). Section 3(4), as amended, offers protection on the basis of laws or enactments "other than law relating to trade marks". Article 102 of the Regulation is a provision of EU law

relating to trade marks and cannot, therefore, be invoked under s. 3(4). Further, the alterations made in January 2019 introduced a specific provision for the protection of PDOs at s. 3(4A). That provision is a rule of law, in a piece of Trade Marks legislation. I conclude that as s. 3(4) does not permit reliance on the law of trade marks and as s. 3(4A) is trade mark law which concerns the protection of PDOs, the opponent cannot rely upon s. 3(4) to invoke a breach of Articles 102 and 103(2). It can, however, rely upon s. 3(4A), the express purpose of which is the protection of PDOs in accordance with the rule of law or other provision identified. I turn now to merits of the case under the provisions of EU law identified by the opponent.

Section 3(4A) and Articles 102 and 103(2)

22. The law said to be contravened under s. 3(4A) is Articles 102 and 103(2) of the Regulation. Article 102, so far as is relevant, reads as follows:

> "1. The registration of a trade mark that contains or consists of a protected designation of origin or a geographical indication which does not comply with the product specification concerned or the use of which falls under Article 103(2), and that relates to a product falling under one of the categories listed in Part II of Annex VII shall be:
>
> (a) refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected […]".

23. Article 103(2) reads:

> "2. A protected designation of origin and a protected geographical indication, as well as the wine using that protected name in conformity with the product specifications, shall be protected against:
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> (a) any direct or indirect commercial use of that protected name:

(i) by comparable products not complying with the product specification of the protected name; or

(ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;

(b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcripted or transliterated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation", "flavour", "like" or similar;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, as well as the packing of the product in a container liable to convey a false impression as to its origin;

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

24. The evidence shows that the opponent is the institution officially recognised under EU law which coordinates and manages the PDO Prosecco.[3] The PDO itself has been in effect since August 2009 and concerns wines which meet certain conditions of production and composition, including that grapes are of a particular variety grown in a defined area.[4] None of this appears to be in dispute but, for the avoidance of doubt, had I been required to determine the issue I would have been satisfied on the evidence that the PDO has existed since 2009 and that the opponent is entitled to enforce it.

25. Article 102 prohibits registration of a trade mark which “contains or consists of a protected designation of origin or a geographical indication […]”. The contested mark is

[3] Exhibits SZ1, SZ2.
[4] Zanette, §§11-14 and SZ4-SZ5.

the stylised word “BROSECCO” and, whilst similar to PROSECCO, it is not and does not contain the PDO. The opposition based upon infringement of Article 102 must fail.

26. Turning to Article 103(2), Ms Clark focused her submissions on Article 103(2)(b). I shall follow her example.

27. “Evocation” was considered by the Court of Justice of the European Union (“CJEU”) in *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister & Eduard Bracharz GmbH*, case C-87/97, EU:C:1999:115. The Court said:

> “25 ‘Evocation’, as referred to in Article 13(1)(b) of Regulation No 2081/92. Covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected.
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> 26 […] it is possible, contrary to the view taken by the defendants, for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue”.

28. Both the contested specification and the products protected by the PDO are wines: even where they are not strictly identical (“British sparkling wines” in the contested specification cannot be regarded as identical to the goods sold under the PDO, due to the geographical restrictions imposed by the PDO) the goods differ only in their specific geographical origin and remain highly similar.

29. Whether there is an evocation must be judged from the perspective of the consumer, who is reasonably well informed and reasonably observant and circumspect.[5] The consumer of wines is a member of the general public, most likely to select the goods visually, from shelves in retail premises or their online equivalents, or from menus in

[5] *Viiniverla Oy v Sosiaali- ja ter veysalan lupa- ja valvontavirasto*, case C-75/15, EU:C:2016:35, at [28].

licensed premises. There may be an oral aspect to the purchase. The goods are not, in the main, terribly expensive or infrequent purchases but some attention will be paid to, for example, the wine style or grape variety, resulting in a medium degree of attention.

30. Mr Warren submitted that "BROSECCO" was devised to evoke Britishness. It may be that some consumers view it that way. It may be that some see it as intended to be masculine or "blokey", as posited by Ms Clark. I consider the latter more probable as the letters "BR" are, without other indicia, unlikely to convey the idea of Britain or Britishness. It is, however, equally if not more plausible that the consumer will not attempt to divine any particular meaning from what s/he perceives as a foreign word. "PROSECCO" is also likely to be perceived as a foreign word of unknown meaning, resulting in a neutral conceptual position.

31. There are obvious visual and aural similarities between the PDO and the mark, which coincide in the letters "-ROSECCO" and differ only in the first letter ("B" and "P", respectively) and the particular stylisation of the contested mark. They are highly similar visually. The stylisation of the contested mark will not be verbalised and the letters "P" and "B" are very similar in sound (both are bilabial plosives, one voiced the other not). Aurally, the mark and the PDO are similar to a very high degree.

32. The high degree of similarity between the contested mark and the sign, and the high degree of similarity or identity between the respective parties' products, are, in my view, bound to lead to the PDO being evoked, particularly when the considerable reputation of Prosecco is borne in mind: the UK consumer's familiarity with that name makes it likely that there will be an evocation of the PDO, rather than that the mark will be seen as wholly unconnected. Even if the consumer does discern the meanings suggested by Mr Warren and/or Ms Clark, evocation is not the same as confusion and such is the similarity between the mark and the PDO, both used on wines, that the contested mark will still trigger in the consumer's mind the image of Prosecco.[6]

[6] That there can be evocation without confusion was confirmed in *Gorgonzola* (at [26]) and reaffirmed in *Viiniverla* at [45]. *Viiniverla* is also authority for the proposition that even if there is an absence of confusion the use of a name which evokes a PDO may not be authorised.

33. Paragraph 97 of the recital to the Regulation states:

> "Registered designations of origin and geographical indications should be protected against uses which take advantage of the reputation enjoyed by complying products. So as to promote fair competition and not to mislead consumers, that protection should also extend to products and services not covered by this Regulation, including those not found in Annex I to the Treaties."

34. This means that, even though I have found that there will be an evocation, if the ground is to succeed it must be established that an unfair advantage would be gained from the PDO's reputation for wine. In *L'Oréal SA and others v Bellure NV and others*, Case C-487/07, EU:C:2009:378, the CJEU considered the taking of an unfair advantage of a mark's reputation. Although a case under s. 5(3), I see no reason why the Court's comments would not be relevant by analogy. It said:

> "The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

35. I should point out that it is not necessary for the opponent to establish that there was an actual intention to take unfair advantage: it is only necessary that there be an unfair advantage when assessed objectively, though clearly if there were evidence of such a subjective intention it would be material. Consequently, the evidence and submissions given by Mr Warren as to the concept behind the brand and the proposed marketing and packaging do not assist him in showing that, objectively, there would be no unfair advantage were the mark used. Although Mr Warren argued that the concept behind the

brand is of a British sparkling wine, originally to celebrate Brexit, he was not entirely successful at the hearing in avoiding reference to the product as a British Prosecco. Of course, that is not determinative of the consumer's reaction to a product. However, it reveals the essential problem with the contested mark. The evocation of the PDO will convey to consumers that the wine is a sparkling wine, authorised by the opponent or at least similar to wines sold under the aegis of the opponent's organisation. That constitutes a marketing advantage and it is one which is unfair, because it would not be possible without the reputation of the opponent: the contested mark rides upon the coat tails of the substantial reputation of the opponent. The opposition based upon Article 103(2)(b) and s. 3(4A) succeeds.

36. Ms Clark made brief submissions on art. 103(2)(a). It can be shortly dealt with. The provision requires use "of that protected name", i.e. PROSECCO. "BROSECCO" is plainly not "PROSECCO". Article 103(2)a) does not apply. No submissions were made concerning Articles 103(2)(c) or (d) and, in view of what I consider to be a very clear finding under Article 103(2)(b), I do not propose to consider them.

**Section 3(3)(b)**

37. The relevant section of the Act reads:

> "3. — (3) A trade mark shall not be registered if it is-
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> […]
>
> (b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service)".

38. In *Elizabeth Florence Emanuel v Continental Shelf 128 Ltd Case C-259/04*, the CJEU stated:

> "47 Nevertheless, the circumstances for refusing registration referred to in Article 3(1)(g) of Directive 89/104 presuppose the existence of actual deceit or a sufficiently serious risk that the consumer will be deceived (Case C-87/97

> Consorzio per la tutela del formaggio Gorgonzola [1999] ECR I-1301, paragraph 41)".

39. I have already found that the marks are highly similar and that the goods are all wines which are identical or highly similar. The British sparkling wines in the contested specification cannot be compliant with the PDO, whilst both "wines" and "sparkling wines" include wines which may not be compliant with the PDO. The average UK consumer will, however, on account of the reputation garnered through high levels of sales, be very familiar with the opponent's Prosecco wines. I find that these factors taken together would have resulted at the relevant date in a sufficiently serious risk that the average consumer would be deceived into thinking that the contested mark indicated wines which were compliant with the PDO PROSECCO or that they were authorised by the opponent. The opposition based on s. 3(3)(b) therefore succeeds.

**Section 3(6)**

40. Section 3(6) of the Act states:

> "(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith".

41. The relevant case-law covering trade mark applications made in bad faith can be found in the following cases: *Chocoladefabriken Lindt & Sprüngli,* CJEU, Case C-529/07, *Malaysia Dairy Industries,* CJEU, Case C-320/12, *Koton,* CJEU, Case C-104/18P, *Sky* v *Skykick,* CJEU, Case C-371/18, *Hotel Cipriani SRL and others v Cipriani (Grosvenor Street) Limited* and others, [2009] RPC 9 (approved by the Court of Appeal in England and Wales: [2010] RPC 16), *Trump International Limited v DDTM Operations LLC*, [2019] EWHC 769 (Ch), *Copernicus-Trademarks v EUIPO,* General Court of the EU, Case T-82/14, *Daawat* Trade Mark, The Appointed Person, [2003] RPC 11, *Saxon Trade Mark,* [2003] EWHC 295 (Ch), *Mouldpro ApS v EUIPO*, General Court of the EU, Case T-796/17, *Alexander Trade Mark*, The Appointed Person, BL O/036/18, *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch) and *Sky v Skykick* [2020] EWHC, 990 (Ch).

42. The law appears to be as follows:

(a) While in everyday language the concept of ‘bad faith’ involves a dishonest state of mind or intention, the concept of bad faith in trade mark law must be understood in the context of trade: *Sky* CJEU.

(b) Applying to register a trade mark without an intention to use it is not bad faith *per se*. Therefore, it is not necessary for the trade mark applicant to be using, or have plans to use, the mark in relation to all the goods/services covered by the specification: *Sky CJEU.*

(c) The bad faith of the trade mark applicant cannot, therefore, be presumed on the basis of the mere finding that, at the time of filing his or her application, that applicant had no economic activity corresponding to the goods and services referred to in that application: *Sky CJEU.*

(d) However, where the trade mark application is filed without an intention to use it in relation to the specified goods and services, and there is no rationale for the application under trade mark law, it may constitute bad faith. Such bad faith may be established where there are objective, relevant and consistent indications showing that the applicant had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: *Sky CJEU.*

(e) This may be the case where the exclusive right was sought as part of a strategy of using widely cast trade mark registrations as legal weapons for use against others in opposition proceedings and/or for the purposes of blocking applications by third parties: *Sky* EWHC and *Copernicus-Trademarks v EUIPO*.

(f) A trade mark may be applied for in good faith in relation to some of the goods/services covered by the application, and in bad faith as regards others: *Sky* CJEU.

(g) This may be the case where the applicant has included a specific term in the specification, such as ‘computer games’, with no intention of using the mark in relation to any such goods, simply to obstruct third parties from using or registering the same mark, or similar marks. It may also be the case where the applicant has included a broad term, such as ‘computer software’, with the intention of using the mark in relation to a particular sub-category of such goods/services, but no intention of using the mark in relation to all the other (sometimes very different) sub-categories of goods/services covered by the broad term, with the objective of obstructing third parties from using or registering the mark in relation to such goods/services: *Sky* EWHC.

(h) In deciding whether there was a rationale for registering the trade mark in relation to any particular term, it is necessary to bear in mind that trade mark proprietors have a legitimate interest in seeking protection in respect of goods or services in relation to which they may wish to use the trade mark in future (even if were no plans to use the mark in relation to the goods/services at issue at the time of filing the application): *Sky* EWHC. It is therefore relevant to consider whether the goods/services in the contested application are related to those for which the mark has been used, or for which the applicant had plans to use the mark.

43. The following points are apparent from the pre-*Sky* case-law about registering trade marks in bad faith:

(a) Although it may be a relevant factor, the mere fact that the applicant knew that another party was using the trade mark in another territory does not establish bad faith: *Malaysia Dairy Industries*.

(b) Similarly, the mere fact that the applicant knew that another party used the trade mark in the UK does not establish bad faith: *Lindt, Koton* (paragraph 55). The applicant may have reasonably believed that it was entitled to apply to register the mark, e.g. where there had been honest concurrent use of the marks: *Hotel Cipriani*.

(c) However, an application to register a mark is likely to have been filed in bad faith where the applicant knew that a third party used the mark in the UK, or had reason to believe that it may wish to do so in future, and intended to use the trade mark registration to extract payment/consideration from the third party, e.g. to lever a UK licence from an overseas trader: *Daawat,* or to gain an unfair advantage by exploiting the reputation of a well-known name: *Trump International Limited.*

(d) An application may also have been filed in bad faith where the applicant acted in breach of a general duty of trust as regards the interests of another party, including his or her own (ex) company or (ex) partners, or a party with whom there is, or had recently been, a contractual or pre-contractual relationship, such as a licensor, prospective licensor or overseas principal: *Saxon, Mouldpro;* or where a legal agreement prohibits such a filing.

44. The correct approach to the assessment of bad faith claims is as follows. According to *Alexander Trade Mark,* the key questions for determination in such a case are:

(a) What, in concrete terms, was the objective that the applicant has been accused of pursuing?

(b) (b) Was that an objective for the purposes of which the contested application could not be properly filed?

(c) Was it established that the contested application was filed in pursuit of that objective?

45. I begin by reminding myself that bad faith is a serious allegation which must be distinctly proved and it is not enough for an opponent to prove facts which are also consistent with good faith. The burden, and it is a heavy one, is on the opponent to show that Mr Warren acted in bad faith.

46. The claim under this ground is that the mark was filed for opportunistic reasons, in the knowledge that consumers would associate the trade mark with the PDO. On its face, that is not fertile ground for a claim of bad faith. Copying in and of itself does not constitute bad faith; even proven knowledge of another party using the sign is but one factor in the overall assessment: *Lindt* at [53], *Koton* at [55]. Mr Warren has explained in his evidence that the concept behind the trade mark was of a British product.[7] There is also some evidence which shows the design process and the prominence given to the Union Jack in the branding.[8] Although this evidence is not dated, there was no cross-examination to cast doubt on Mr Warren's written evidence. More pertinently, the opponent has furnished no evidence to show that either at the relevant date or subsequently Mr Warren had any intention other than to market his product; there is no evidence of any aggravating factors such as an intention to impede the opponent's (or its members') activities or to extract financial compensation for the contested mark. The evidence establishes, at best, that Mr Warren was sailing close to the wind in his choice of brand name. The bad faith ground is not made out.

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

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

> "5 (2) A trade mark shall not be registered if because -
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> […]

[7] See, in particular, Warren, §§6-10, 13.
[8] OW2.

(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".

48. Section 5A states:

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

49. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

50. I pause at this point to note that Mr Warren's evidence and submissions concerning the way in which the contested mark would be used in the marketplace cannot, as a

matter of law, assist him under this ground. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited,* Case C-533/06, EU:C:2008:339*,* the CJEU stated at paragraph 66 of its judgment that when assessing the likelihood of confusion in the context of registering a new trade mark it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the mark applied for (and its specification) in determining any potential conflict with the earlier trade mark. When assessing the likelihood of confusion, any differences between the goods provided by the parties, their marketing, or differences in their trading styles, are irrelevant unless those differences are apparent from the contested and registered marks.

51. Mr Warren has also made reference to an earlier trade mark for the word BROSECCO. There is no evidence before me concerning this mark. However, even if there was, the mere existence of another trade mark, even one which predates the opponent's trade mark, would not affect the outcome of this decision: the reasons behind any decision by the opponent not to object could be myriad and any effect on Mr Warren's rights would not necessarily undermine the opponent's right to object in the instant proceedings.

**Comparison of goods and services**

52. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

> "In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

53. Other relevant factors are the users of the goods and the trade channels through which they reach the market: *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case) [1996] EWHC 387 (Ch).

54. Where goods or services in the specification of the contested mark are included within a more general category designated by the goods/services of the earlier mark, or vice versa, such goods and services can be considered identical: *Gérard Meric v Office for Harmonisation in the Internal Market,* Case T- 133/05, EU:T:2006:247.

55. “Wines” and “sparkling wines” in the contested specification include “wines complying with the specification of the PDO Prosecco” are therefore identical under the principle outlined in *Meric* to the earlier specification*.* “British sparkling wines” are highly similar to the earlier goods because there are slight differences in nature (i.e. their specific composition and geographic origin) but they coincide in all other material respects.

**The average consumer and the nature of the purchasing act**

56. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik.*

57. The average consumer is, for the reasons given at paragraph 29, above, a member of the public who will purchase the goods mainly through visual means and with a medium degree of attention.

**Distinctive character of the earlier trade mark**

58. In *Lloyd Schuhfabrik*, the CJEU stated that:

> “22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an

overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *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)".

59. The average consumer is unlikely to know that "PROSECCO" means a particular region of Italy. It is likely to be perceived by the average consumer as a foreign word of imprecise meaning. It is inherently highly distinctive.

60. The evidence shows that significant amounts of Prosecco were consumed in the UK to 2016. Between 2011 and 2014, exports of Prosecco to the UK rose dramatically, the UK overtaking both the United States and Germany in the Prosecco export market.[9] Invoices in evidence, dated between 2013 and 2016, show sales, some for substantial sums, to UK companies of Prosecco wine from various members of the opponent's organisation.[10] Press articles report the growth in sales of Prosecco at major UK supermarkets and wine retailers from 2013.[11] In 2016, over 112 million bottles were

[9] SZ8
[10] SZ9 and Zanette, §23.
[11] SZ10.

consumed in the UK.[12] Although the evidence after 2016 is more limited, commentators as late as August 2018 observe the popularity of the drink, and the market for Prosecco in the UK appears to have been expected to grow to 2020.[13] Notwithstanding the absence of more current sales figures, taking the evidence as a whole and noting in particular the large quantities sold up to 2016 (almost 2 bottles per person in the UK), I am satisfied that the distinctiveness of the earlier mark had, by the relevant date, been materially enhanced.

**Comparison of trade marks**

61. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

> "[…] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion".

62. It would be wrong, therefore, artificially to dissect the marks, although it is necessary to take into account the distinctive and dominant components of the marks. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

[12] SZ10, pp. 25, 27.
[13] See, for example, SZ10, pp. 12-13 ann28-29.

| Earlier mark | Contested mark |
|---|---|
| PROSECCO |  |

63. For the reasons given at paragraphs 30 to 31, above, the marks are visually similar to a high degree, aurally similar to a very high degree and conceptually neutral.

**Likelihood of confusion**

64. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel* at [22]), from the perspective of the average consumer. In making my assessment, I must keep in mind 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 (*Lloyd Schuhfabrik* at [26]). The factors considered above have a degree of interdependency (*Canon* at [17]): for example, 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.

65. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *LA SUGAR Trade Mark*, BL O/375/10, where Iain Purvis Q.C., sitting 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”.

66. In *EDEN CHOCOLAT Trade Mark,* BL O/547/17, James Mellor Q.C. (as he then was), sitting 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 another mark to mind. This is mere association not indirect confusion.

67. Bearing in mind the considerable levels of visual and aural similarity between the marks, the highly similar or identical goods and the very high level of factual distinctiveness of the earlier mark, it is my view that the average consumer would consider the contested mark to be endorsed by the opponent, whether through a licensing arrangement or other economic link. There is a likelihood of indirect confusion. I also find that, notwithstanding the mainly visual purchasing process, such is the aural similarity between the marks that there is likely to be a material degree of direct aural confusion. The opposition under this ground succeeds. For the record, I would have come to the same conclusions even had the earlier mark’s distinctiveness not been enhanced though use.

**Final remarks under s. 5(2)(b)**

68. Mr Warren made a number of comments concerning the ability of the average consumer to recognise the word “PROSECCO” and submitted that, as the UK consumer is likely to very familiar with “PROSECCO” when used for wines, they will easily differentiate it from other similar marks. It is a rather counter-intuitive aspect of trade mark law that a brand can increase its distinctiveness through extensive use but that its subsequent fame cannot then be held against it. It is no defence to a trade mark opposition to argue that because a mark is famous, the average consumer will instantly recognise any differences between that trade mark and any other similar marks which

resemble it. That is why submissions of that ilk have not assisted Mr Warren under this ground.

**Section 5(3)**

69. Section 5(3) states:

> "(3) A trade mark which-
>
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark".

70. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel,* [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon,* [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L'Oreal v Bellure* [2009] ETMR 55; and Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora.* The law appears to be as follows:

> a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered: *General Motors*, paragraph 24;
>
> (b) The trade mark for which protection is sought must be known by a significant part of that relevant public: G*eneral Motors*, paragraph 26;
>
> (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel,* paragraph 63;

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel,* paragraph 42;

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel,* paragraph 79;

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel,* paragraphs 76 and 77;

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel,* paragraph 74;

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oreal v Bellure NV,* paragraph 40;

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and

the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora,* paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure).*

**Reputation**

71. There is no dispute that the earlier mark had a reputation at the relevant date. The nature of the reputation appears to be, as would be expected from a certification mark, that the products conform to certain characteristics, i.e. that it is a particular type of Italian sparkling wine. The evidence is not sufficient to establish that it is seen as a premium product or particularly high quality; on the contrary, there is some evidence that it is perceived as a cheaper alternative to Champagne.[14]

**Link**

72. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

73. I adopt the findings made at paragraphs 30 to 31, above. There is a high degree of visual and a very high degree of aural similarity. There is neither conceptual similarity nor dissimilarity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

[14] See, for example, SZ10, pp. 12-13, 21, 22.

74. For the reasons given at paragraph 55, above, the goods are highly similar or identical. I adopt my findings at paragraph 29 in respect of the average consumer, who is a member of the public paying a medium degree of attention to a predominantly visual purchase.

The strength of the earlier mark's reputation

75. The earlier mark has a strong reputation.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

76. For the reasons given at paragraph 60, above, the earlier mark is factually distinctive to a very high degree.

Whether there is a likelihood of confusion

77. There is a likelihood of, at least, indirect confusion.

78. Bearing in mind all of the above, I have no hesitation in finding that the earlier mark would be brought to mind. The closeness of the marks and the goods, coupled with the level of distinctiveness of the earlier mark, are more than sufficient for the earlier mark to be brought to mind, for all of the contested goods.

**Damage**

Unfair advantage

79. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice

interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

80. I have already found that an unfair advantage would accrue to Mr Warren through the use of the contested mark, which would ride on the coat tails of the established reputation enjoyed by the opponent's mark. I see no reason for a different finding under s. 5(3). The association in the minds of the relevant public with the earlier mark will constitute an unfair marketing advantage, obviating the need for Mr Warren to educate the public through his own marketing efforts about the nature of his product and riding on the coat tails of the reputation of the opponent for a particular type of wine. This head of damage is made out.

81. The opponent has now succeeded under four of its pleaded grounds. I do not consider it proportionate to consider the remaining heads of damage under this ground. The opposition under s. 5(3) is successful.

**Section 5(4)(a)**

82. Section 5(4)(a) states:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

> A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark".

83. The elements of the tort which must be established in order for an action in passing off to succeed were set out in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341, p. 406. In outline, the opponent must establish first, that he has a goodwill attached to the goods/services and that the sign associated with the goodwill is recognised as distinctive of his business by the public; secondly, that there is a misrepresentation to the public that the goods and/or services of the applicant are the goods and/or services of the opponent; and thirdly, that the opponent suffers, or is likely to suffer, damage as a result of the erroneous belief engendered by the misrepresentation.

**Goodwill**

84. The House of Lords considered goodwill in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217, saying:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start".

85. Ms Clark indicated that it did not appear to be in dispute that the opponent had built up a significant goodwill in relation to Prosecco. However, the ground was only touched upon briefly at the hearing, Ms Clark accepting that it took her no further than the s. 5(2)(b) case. It is not at all clear to me that Mr Warren has accepted the claimed goodwill. Given that Mr Warren is a litigant in person and that (i) a reputation is not the same as goodwill, (ii) the opponent does not rely upon wines but upon particular services under s. 5(4)(a) and (iii) that the point was not addressed directly at the hearing, I think it would be unsafe for me to conclude that Mr Warren has admitted that the necessary goodwill has been shown, absent a concession in terms that the opponent has a protectable goodwill in relation to the services claimed.

86. The evidence shows brochures said to be from the opponent, which show information about Prosecco in 2012 and between 2014 and 2018.[15] A bottle bearing the words "CONSORZIO TUTELA PROSECCO DOC" is visible in each, as is the email address info@consorzioprosecco.it. There is also an "alert" about wine being misdescribed as Prosecco, said to be part of a presentation about the opponent's promotional activities from April 2016.[16] Three advertisements placed by the opponent in the national press in December 2017 to promote Prosecco wine are in evidence.[17] There is also some documentary evidence of sponsorship of the SBK Superbike World Championships from 2014 to 2019, including British rounds.[18] "PROSECCO DOC" is visible on hoardings and promotional items such as umbrellas. The opponent attended various food and wine fairs between 2014 and 2019, "PROSECCO DOC" appearing prominently on the stands at the 2018 events.[19] The 2019 events where the date is given in English post-date the relevant date in these proceedings. The opponent sponsored five events in the relevant period, which involved Prosecco being served to guests and, at least on three occasions, a promotional stand.[20] There is also evidence of a media tasting event in November 2018 and a wine tasting masterclass in London on 2 April 2019.[21] The remaining events are after the relevant date.

87. I consider this evidence is too flimsy to show that the opponent had a protectable goodwill in the services claimed at the relevant date. I recognise that the nature of the opponent is not one likely to generate sales figures and turnover but, in my view, more would be needed in terms of demonstrable reach and duration of the opponent's activities in order to establish a passing-off right in these services. The opposition under s. 5(4)(a) is dismissed.

[15] SZ6
[16] SZ7.
[17] SZ11.
[18] SZ11.
[19] SZ11, pp. 20-28. The exhibit numbering is out of step with Mr Zanette's statement.
[20] SZ13.
[21] SZ14.

## Conclusion

88. The opposition has been successful. The application will be refused.

## Costs

89. The opponent has been successful and is entitled to an award of costs. There is no request that I depart from the normal Registry scale (Tribunal Practice Notice 2/2016 refers). I award costs to the opponent as follows:

| | |
|---|---|
| Official fee: | £200 |
| Preparing the notice of opposition and considering the counterstatement: | £300 |
| Filing evidence and considering the other party's evidence | £600 |
| Preparation for and attendance at a hearing: | £600 |
| **Total:** | **£1,700** |

90. I order Owen Warren to pay the Consorzio di Tutela della Denominazione di Origine Controllata Prosecco the sum of **£1,700**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 6th day of May 2021**

**Heather Harrison**
**For the Registrar**
**The Comptroller-General**