

O-558-17

TRADE MARKS ACT 1994

IN THE MATTER OF UK REGISTRATION NO 3175184
BY10 INTERNATIONAL LTD TO REGISTER:

Arcata Di Luce

AND

THE OPPOSITION THERETO UNDER NO 407840 BY
TENUTE DI CASTELGIOCONDO E DI LUCE DELLA
VITE SOCIETÀ AGRICOLA S.R.L.

BACKGROUND

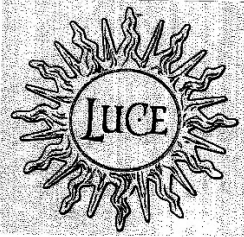
1. On 18 July 2016, 10 International Ltd (the applicant) applied to register the above trade mark in the following class:¹

Class 33

Wine

2. The application was published on 5 August 2016, following which Tenute di Castelgiocondo e di Luce della Vite Società Agricola S.r.l. (the opponent) filed notice of opposition against all of the goods in the application.

3. The opponent bases its case on sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Under section 5(2)(b) the opponent relies upon the following European Union trade marks (EUTMs):

| Mark details and relevant dates | Goods relied upon |
|--|---------------------------------|
| <p>EUTM639732</p> <p>LUCE DELLA VITE</p> <p>Priority date: 27 March 1997 (USA) Filed: 26 September 1997 Registered: 18 March 1999</p> | <p>Class 33 Wine</p> |
| <p>EUTM680041</p>  <p>Filed: 19 November 1997 Registered: 22 April 1999</p> | <p>Class 33 Wine</p> |

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

4. With regard to the opposition under section 5(2)(b) the opponent submits that the goods are identical, LUCE has no meaning in English and is a strong mark entitled to a broad penumbra of protection. It concludes:

“5. The Applicant’s mark would be seen as an extension of the Opponent’s range of LUCE wines, perhaps in a different price bracket, perhaps used on a different type of wine, but having the same ‘LUCE’ common origin.

This view will be held because the word LUCE dominates the Opponent’s marks. In [respect of the first mark shown] above it dominates because it is the first part of the mark which will be the part most readily remembered, through imperfect recollection it may be the only part of the mark remembered. In [respect of the second mark shown above], it is the only word appearing in the design, and is the word that would be used by consumers to ask for the wine, or to assist in looking for the Opponent’s wine in a shop, online or in a catalogue.

The word LUCE appearing in each of the Opponent’s marks is identical in spelling, appearance and pronunciation to the word chosen by the applicant.”

5. Under the section 5(4)(a) ground, the opponent relies on the sign LUCE DELLA VITE, first used in the UK in 1997. It states that it has goodwill in the UK in respect of wine and that use by the applicant of such a similar mark:

“...is a misrepresentation that the Opponent and the Applicant are commercially linked, and the Opponent will suffer damage in (for example) lost sales, dilution of its rights, a loss of goodwill or otherwise.”

6. The applicant filed a counterstatement in which it denied the grounds raised by the opponent and requested the opponent prove use. It accepts that the opponent uses both of the marks on which it relies in respect of wine but submits that it can find no reference to the “Opponent’s mark being sold currently in the UK”. It concludes:

“10...Therefore, to suggest [the applicant] is attempting to pass off the Opponent’s brand as its own is an unreasonable notion, as there would be very limited value in doing so.”

7. Neither party requested to be heard. The opponent filed evidence and submissions in lieu of a hearing. The applicant filed submissions during the period allowed for filing evidence. I will refer to the submissions where necessary in this decision. Both sides seek an award of costs.

The earlier marks

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The marks relied upon by the opponent are earlier marks which are subject to proof of use as per Section 6A of the Act which reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, 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 Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2)(application on relative grounds where no consent to registration).”

10. The relevant period is the five year period ending on the date of publication of the application, namely 6 August 2011 to 5 August 2016. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

EVIDENCE

Opponent’s evidence

Witness statement of Lamberto Frescobaldi and exhibits LF1-LF14

11. Mr Frescobaldi is the President of the opponent, a position he has held since 2009. His witness statement is dated 12 April 2017.

12. The salient points from his evidence are as follows:

- The earlier marks relied upon by the opponent were first used in Europe in 1997 or 1998² and have been used continuously since then.

² Paragraph 2 of Mr Frescobaldi’s statement gives 1997 as the date of first use in Europe but the end of the same paragraph states it is 1998. Nothing turns on the accuracy of this date.

- The opponent has a website LUCEDELLAVITE.COM, which the opponent states, makes use of both earlier marks and is available in the Italian, English, German, Japanese, Russian and Chinese languages.

13. Exhibit LF1 includes a number of pages printed from the opponent's website. These are not dated. The following is shown under the heading 'Estate':

"Lying at elevations ranging from 350 to 420 meters, the Luce della Vite estate is one of the highest in Montalcino."

14. Within the pages printed from the opponent's websites are examples of the marks used on a wine bottle. They are shown in the following forms:



15. Mr Frescobaldi states that the list of PDF files shown in the exhibit are pictures of the identical bottle to the one pictured above with a different year/vintage on each. They range from 1993 to 2014.

16. The 'NEWS' section of the opponent's website³ shows a number of events in Rome, Milan, Florence and New York between 2007 and 2015. For example, a wine tasting at the Baryshnikov Arts Centre in New York on 5 May 2015 to celebrate the opponent's 20th vintage.⁴ Page 8 of the exhibit is titled, 'TWENTY YEARS OF LUCE TRAVEL THE WORLD' and includes the following image:



17. Exhibit LF4 includes a page from the website www.wineman.co.uk which shows three bottles of wine for sale. The prices are shown in GBP. The wines are listed as 'Tenuta Luce della Vite – Lucente IGT', 'Tenuta Luce della Vite – Luce IGT' and 'Tenuta Luce della Vite – Luce Brunello di'. The print is of poor quality and I am unable to read the writing on the labels. The bottles appear to show three variations of a 'sunburst' device. Only the mark shown on the second bottle looks to be the same shape as that which the opponent relies on. The print date of the exhibit is 29 March 2017.

18. The second part of exhibit LF4 is printed from www.wine-searcher.com on 29 March 2017. The search carried out on the site is shown at the top of the page, namely, '2012 Luce

³ See Exhibit LF3.

⁴ *Op. cit.*, page 6.

della Vite 'Luce' Toscana IGT, Tuscany, Italy'. The returned results show two London stockists and one in Scotland with wines available which include the words 'Luce Della Vite'. A further two London stockists list the wines as 'Luce'. The prices are shown in GBP and range from £72.22 a bottle to £1085 for 6 magnum sized bottles. The print date of the exhibit is 29 March 2017.

19. The opponent has provided extracts from a catalogue for 'Decanter Fine Wine Encounter 2016'⁵ which took place on 12-13 November 2016 at The Landmark Hotel, London. Mr Frescobaldi states that this is 'a yearly event and is one of the most important in the wine field'. Page 6 of the exhibit shows 'Luce Della Vite' as the first producer listed under the heading 'Tuscany'. Attached to the exhibit is a 'Catalogue Form' for the event. The winery/exhibitor is shown as 'Luce Della Vite'. The UK agent and principal UK stockist is given as Hallgarten Druitt, Luton.

20. Exhibit LF6 is described as, 'a publication detailing the celebration of the 20th Anniversary of Luce della Vite at Frescobaldi's Restaurant in London'. It is not possible to determine where this 'publication' originated nor whether it was publicly available. It is written in Italian and English and includes the following:

"To celebrate its 20th anniversary, Luce Della Vite picked Ristorante Frescobaldi in Mayfair...Following the reception, the guests were invited to feast on the Chef's magnificent five course dinner of premium Tuscan and North Italian delicacies accompanied by the 2012 Luce della Vite anniversary vintage, Lucente 2012, and a rare Luce 2000 Mathusalem."

21. Mr Frescobaldi states that exhibits LF7-LF12 are invoices showing sales of the opponent's wine to the UK in 2011-2016. All of the invoices are addressed to the same company, Hallgarten Wines Limited in Bedfordshire. Mr Frescobaldi provides the total sales for each year demonstrated by the invoices. I note that he states that the sales are for wine "featuring the marks LUCE, LUCE DELLA VITE and LUCE with sunburst logo..." They are as follows:

| Year | Total (€) |
|-------------|------------------|
| 2011 | 96,775.56 |

⁵ See exhibit LF5

| | |
|------|------------|
| 2012 | 73,221.59 |
| 2013 | 61,097.16 |
| 2014 | 56,635.95 |
| 2015 | 302,852.53 |
| 2016 | 92,529.40 |

22. Mr Frescobaldi states that the largest market for the opponent's wine is Germany with turnover since 2011 in excess of €200,000 per calendar year.

23. Exhibit LF14 includes a number of invoices from 2015 which Mr Frescobaldi states show sales of LUCE branded wine in the EU. The invoices show sales to Belgium, The Netherlands, Denmark, Germany, Poland and the Czech Republic. In each case the relevant wine is listed as 'LUCE'.

24. Exhibit LF13 is described by Mr Frescobaldi as LUCE DELLA VITE and LUCE (with sunburst logo) marks, which are said to show the marks used in Germany and the wider EU. The following mark is shown in the exhibit:



Preliminary issues

Marketing considerations and current use

25. In its submissions filed on 9 June 2017 the applicant submits that the unit price of the opponent's wines, based on the invoices it provided in evidence, is considerably higher than the applicant's wine. It concludes:

“One cannot overemphasise how important this point is as it highlights how different the target markets are for the Opponent's wine and [the applicant's] wine”.

26. The applicant also makes reference to the particular grapes used in the parties' respective wines and concludes:

“9...This is an Important difference and serves to demonstrate yet another factor that lessens the likelihood of confusion between the brands for both experienced consumers and those with less knowledge on the subject.”

27. In addition, it points to differences in the label style, method of bottle closure and style of bottle used for the parties' respective wines.⁶

28. So far as the applicant's current use of his mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*⁷ the Court of Justice of the European Union (“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.

29. Furthermore, in *Devinlec Développement Innovation Leclerc SA v OHIM*,⁸ the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the

⁶ Paragraph 3 of its submissions dated 9 June 2017.

⁷ Case C533/06

⁸ Case C-171/06P

wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

30. In other words, the way in which the applicant is actually using its trade mark or the way in which its goods are marketed at this point are not factors which are relevant to this decision. Rather I must consider all normal and fair uses of the applicant’s mark for wines.

Other registered marks

31. In paragraph 4 of its submissions the applicant makes reference to “*a large number of existing and historic trade marks registered within Europe in Classification 33*” which contain ‘LUCE’. It provides nineteen examples attached to its submissions. Seventeen of the marks referred to are registered in France, Italy and Belgium. One is registered internationally, with no indication of the designated countries given and the only other mark referred to has expired. I cannot be sure if any of these marks are relevant to the UK market. In *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01, the Court of Justice of the European Union found that:

“65...the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

32. Furthermore, even if the listed marks were relevant to the UK, the applicant has not indicated which goods in class the 33 the marks stand registered for, whether the marks are used and if they are, how they are used. Consequently, I will say no more about this submission.

Proof of use

33. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*,⁹ Arnold J. summarised the case law on genuine use of trade marks. He said:

⁹ [2016] EWHC 52

“I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, 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]; *Centrotherm* at [71]; *Leno* 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]; *Centrotherm* at [71]; *Leno* at [29].

(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]. 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].

(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]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(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]; *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].”

34. In considering the applicant’s evidence, it is a matter of viewing the picture as a whole. In *Dosenbach-Ochsner AG Schuhe und Sport v Continental Shelf 128 Ltd*, Mr Geoffrey Hobbs Q.C.¹⁰, sitting as the Appointed Person, stated:

“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,

¹⁰ *BL O/404/13*

in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. V. Comptroller- General of Patents*¹¹:

[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.”

35. In *Awareness Limited v Plymouth City Council*¹², 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

¹¹ [2008] EWHC 2071 (Pat); [2008] R.P.C. 35

¹² BL O/230/13

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.”

36. Since both earlier rights relied upon by the opponent are EUTMs, I also bear in mind *Leno Merken BV v Hagelkruis Beheer BV*,¹³ in which the Court of Justice of the European Union noted that:

“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.”

¹³ Case C-149/11

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).”

37. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

38. With regard to the extent of use necessary to show genuine use in the Community I bear in mind the guidance in *London Taxi*¹⁴, in which Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one

¹⁴ See footnote 9.

Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- v) The geographical extent of the use shown

Acceptance of the opponent's use by the applicant

39. In its submissions dated 4 August 2017 the opponent submits that the applicant has explicitly accepted in its counterstatement that the opponent is using its marks and indicates that the applicant's request that the opponent proves its use of the marks, 'appears to be a mistake'. It concludes:

"We accept this statement and, therefore, the Opposition must be considered in respect of the opponent's earlier registrations...in respect of wine, both in class 33."

40. As I have stated above at paragraph 6, it is clear to me, from the applicant's submissions, that the applicant accepts the opponent uses its earlier trade marks in respect of wine. It does not accept that the opponent has proved its use of those marks, for those goods in the UK.

The opponent's evidence of use

41. The applicant has criticised the opponent's sales figures on the basis that not all of the wines listed in the invoices include LUCE in the product title. Mr Rolfe further submits that some of the sales figures are irrelevant. I presume that he is referring to the fact that the figures for the latter part of 2016 are outside the relevant date. I bear this in mind.

42. The applicant has provided a revised table, having assessed the opponent's invoices, with annual figures ranging from €41,396 to €98,163, which is said to reflect 'UK sales of the Opponent's brands with 'LUCE' in the title. This is not particularly helpful as the opponent is not relying on the plain word LUCE in these proceedings. The earlier rights relied on are those that I have indicated above, namely LUCE DELLA VITE and the 'LUCE in a sunburst' mark.

43. The invoices and supporting figures provided by Mr Frescobaldi are not without issue. Some of the 'LUCE' wines listed will no doubt relate to wine sold under the sunburst logo mark on which the opponent relies and may include the words LUCE DELLA VITE as shown on the pictured bottle provided in evidence,¹⁵ but, in both cases, I cannot conclude to what extent.

¹⁵ Filed by the opponent in exhibit LF1 and reproduced at paragraph x of this decision.

44. The opponent's evidence is somewhat ambiguous, for example, I note that the image taken from the opponent's website at paragraph 13, shows the opponent's wine with a number of different sunburst designs on the bottles. It is not clear the extent of sales which relate to these other marks, not relied on for the purposes of these proceedings.¹⁶

45. There is evidence of the opponent's wine for sale online, but the pages were printed after the relevant date. The opponent's attendance at the Decanter Fine Wine Event in London was also after the relevant date.

46. Evidence within the relevant period includes the 20th anniversary party for Luce Della Vite which was held in London. It is clear that wines using the marks relied on were served, however, I cannot be sure if the wines were on sale there. In addition, two invoices from the relevant period show wine listed as Luce Della Vite. These are from February and May 2016 and relate to sales of one bottle and six bottles respectively.

47. In total, the UK sales figures for 2011-2016 amount to €683,112.19. The sales were made to the company listed in the Decanter catalogue as the opponent's UK stockist. The invoices support sales of wine to that address throughout the relevant period.

48. In *Laboratoire de la Mer Trade Mark*¹⁷, the Court of Appeal held that sales under the mark to the trade may qualify as genuine use. Neuberger L.J. stated that:

“48. I turn to the suggestion, which appears to have found favour with the judge, that in order to be “genuine”, the use of the mark has to be such as to be communicated to the ultimate consumers of the goods to which it is used. Although it has some attraction, I can see no warrant for such a requirement, whether in the words of the directive, the jurisprudence of the European Court, or in principle. Of course, the more limited the use of the mark in terms of the person or persons to whom it is communicated, the more doubtful any tribunal may be as to whether the use is genuine as opposed to token. However, once the mark is communicated to a third party in such a way as can be said to be “consistent

¹⁶ *Reproduction of the relevant images is very poor and does not allow for an assessment of those marks as the details are not clear.*

¹⁷ [2006] FSR 5

with the essential function of a trademark” as explained in [36] and [37] of the judgment in *Ansul* , it appears to me that genuine use for the purpose of the directive will be established.

49. A wholesale purchaser of goods bearing a particular trademark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler.”

49. The applicant has not challenged the opponent’s evidence with regard to its use in Germany or other countries in the EU for which invoices have been provided. Mr Frescobaldi states that Germany is the opponent’s largest market with sales amounting to more than €200,000 per year. The invoices provided at exhibit LF14 all relate to 2015. Three are provided for the Netherlands, Denmark, Belgium and Germany and two each are provided for Poland, Austria and the Czech Republic. As is the case with the UK invoices, the opponent appears to sell to a single business in each country. The same caveats apply to the invoices for these countries as was the case with the UK invoices.

50. The opponent’s news pages from its website refer to a number of 20th anniversary events in Italy, held in Milan, Florence, Verona and Rome in 2015. The photographs show the stylised mark used on bottles and wine lists at those events.¹⁸

51. Taking into account that some of the sales figures for 2016 will fall outside the relevant period (i.e. sales made after 5 August 2016) and some will no doubt relate to wine not branded with the opponent’s earlier marks relied on here, I find that even with considerable adjustments to reflect these issues, the figures provided are not insignificant. In its totality the evidence is just sufficient to show use of the opponent’s marks in the EU, including the UK, during the relevant period.

52. Whilst I have found that the evidence is sufficient to show use of the earlier marks, I do not consider it shows that the earlier marks benefit from any enhanced distinctiveness.

¹⁸ See exhibit LF3

Furthermore, the earlier marks relied upon are EUTMs and, whilst the totality of the use shown is sufficient to satisfy the requirements of section 6A of the Act, for the purposes of the 5(2)(b) ground, I do not find that the evidence supports a finding of the necessary goodwill in the UK to support the opponent's 5(4) ground.

53. With regard to a fair specification for the goods, the opponent has shown use in respect of wines.

DECISION

54. Section 5(2)(b) of the Act states:

“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, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 5(2)(b) case law

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

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make

direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

Comparison of goods

56. The applicant's specification is wine in class 33. The opponent's two earlier rights stand registered for wine in class 33. Clearly the parties' respective goods are identical.

The average consumer and the nature of the purchasing act

57. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

58. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*¹⁹, Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

59. The average consumer is a member of the general public.²⁰ Wines are made available through a variety of trade channels. They may be bought in a supermarket, wholesaler or off-licence, where the selection is likely to be made by the consumer from a shelf. They may also be bought from a website or mail-order catalogue, where the consumer will also select the goods visually. They may also be sold through bars, restaurants, clubs and public houses, where the goods may be requested orally, from a member of staff. However, in considering this point, I bear in mind the comments of the Court of First Instance (now the

¹⁹ [2014] EWHC 439 (Ch)

²⁰ For goods where the alcohol content exceeds 0.5% ABV the average consumer will be over 18 years of age.

General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*²¹ when it said:

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

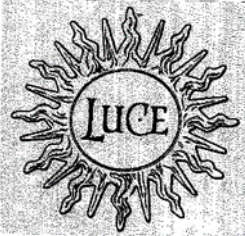
60. Consequently, even though the purchase of the goods in a bar or restaurant (and so on) may involve an aural element, the selection will be made, primarily, from the display of goods e.g. on shelves, in fridges and on wine/drink menus. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element.

61. The level of attention paid to the purchase will vary depending on the nature of the goods. The parties’ specifications for wine will include both modestly priced wines, which may be purchased fairly often and will require a lower level of attention to be paid; as well as expensive, rare and vintage wines which are likely to be sold at a higher price and which may give rise to a higher level of attention being paid. In any event the level of attention paid will be that necessary to achieve, inter alia, the correct flavour, age and variety. Accordingly, the average consumer will pay at least a reasonable level of attention to the purchase of the goods.

²¹ T-3/04

Comparison of marks

62. The marks to be compared are as follows:

| The opponent's marks | The applicant's mark |
|--|--|
| <p data-bbox="295 454 710 499">LUCE DELLA VITE</p>  | <p data-bbox="927 454 1273 499">Arcata Di Luce</p> |

63. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components²², but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

64. With regard to the comparison to be made between the respective marks, the opponent states:²³

“8. In summary, the marks being compared are LUCE DELLA VITE and ARCATA DI LUCE, and LUCE (logo) and ARCATA DI LUCE. The comparison is therefore LUCE vs LUCE.”

65. This position is repeated throughout the opponent's submissions regarding the visual, aural and conceptual comparisons to be made between the marks. In each case the opponent concludes with an assessment of the likelihood of confusion. It is not clear why the opponent believes that I only need consider the third word in the applicant's mark in both

²² *Sabel v Puma AG, para.23*

²³ *See the opponent's submissions filed on 4 August 2017.*

of the necessary comparisons. With regard to its own marks, the opponent has made reference in evidence to the fact that its own company is referred to as LUCE and indicates that the comparison of marks should be made on that basis. It relies, in support of the submission, on exhibit LF3 which is made up of prints from the news pages on its own website. Those pages do, in part, refer to the opponent as LUCE, but they were created by the opponent and it is not clear whether they were intended for internal or external use. There is no evidence which shows the opponent routinely referred to as LUCE by third parties. In any event, for the purposes of a comparison under section 5(2)(b) of the Act the opponent is relying on two EUTMs shown above and I will make the comparison as the relevant authorities require, by taking into account the marks as wholes bearing in mind their distinctive and dominant elements and the overall impressions created by them.

66. Given the differences between the two earlier rights, I will make the each comparison with the application separately and in turn. The first comparison is as follows:

| Opponent | Applicant |
|-----------------|------------------|
| LUCE DELLA VITE | Arcata Di Luce |

67. Both parties' marks consist of three words which will have no meaning to the average consumer in the UK who will consider them to be words of another language or invented words.

68. In reaching this conclusion, I have borne in mind both parties' submissions concerning the Italian meanings given to each of their respective marks, and the conclusions they have made on that basis. I do not consider these to be 'everyday' meanings of the type readily understood by the average consumer in the UK.

69. The overall impression of both marks rests in their totalities.

Visual similarity

70. The opponent states that the construction of its mark means that emphasis is given to the first word. The applicant submits that the marks have only one word in common, which has a different placement in each case and the additional words are 'similar in no respect'.

71. Similarities between these marks rest in the fact that both parties' marks are three words long and the first word of the opponent's mark is the same as the third word of the applicant's mark.

72. The differences between the word combinations are noticeable. The first two words of the application, which come before the common element 'Luce', are 'Arcata Di', neither of these words are contained in the earlier mark. The earlier mark has the additional words 'DELLA' and 'VITE' after the word 'LUCE', neither of which are contained in the application.

73. Visually, I find these marks to have a low to medium degree of visual similarity.

Aural similarity

74. Phonetic similarity rests in the common element 'LUCE', which is contained in both marks, though in different positions, along with the fact that the second word in each mark begins with 'D'.

75. There are a number of differences, including the fact that the applicant's mark begins with the letter 'A' which may have a hard or soft pronunciation, but in either case differs from the sound made by the consonant 'L' at the beginning of the opponent's earlier mark.

76. In addition, the first word of the application is longer, being three syllables long, compared to the one or two syllables (depending on pronunciation) of the first word in the opponent's mark. The second word of the application is one syllable and only two letters long, compared to the five letter, two syllable second word in the opponent's mark.

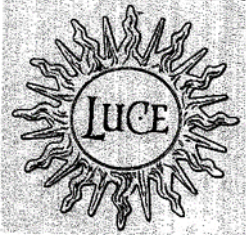
77. Overall, I find there to be a low to medium degree of aural similarity between these marks.

Conceptual similarity

78. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.²⁴ The assessment must be made from the point of view of the average consumer.

79. Some may be familiar with both parties' marks being of Italian origin and may even know the meaning of some of the individual words. However, it is highly unlikely that the average consumer of wine in the UK would know the specific meanings of both marks, in their totalities. It is far more likely that both marks will simply be seen as words of foreign origin with no particular meaning such that the conceptual position is neutral.

80. The second comparison is as follows:

| Opponent | Applicant |
|--|-----------------------|
|  | Arcata di Luce |

81. As I have concluded above, the overall impression of the applicant's mark rests in its totality.

82. The opponent describes its mark as LUCE with sunburst logo. The LUCE part of the mark has a minimal degree of stylization, the capital 'L' being slightly longer than the remaining letters with an additional dot in the middle of the letter 'C'. Neither of these embellishments are likely to be given any particular origin significance by the average consumer.

83. The opponent submits that the logo in its mark will be noticed, but that the strongest visual element of the mark is the word LUCE. I disagree. Given their respective sizes and

²⁴ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

overall contribution to the mark, I find the sun device and the single word LUCE to play equal parts within the opponent's mark as a whole.

Visual similarity

84. The applicant's mark consists of the three words Arcata Di Luce, the third word of which is the single word, presented in capital letters, within the sun device in the opponent's earlier mark. The absence of 'Arcata Di' and the addition of the large sun device result in significant visual differences between them. The marks have a low degree of visual similarity.

Aural similarity

85. The only part of the opponent's mark which will be articulated by the average consumer is the single word LUCE. The mark applied for consists of the words 'Arcata Di Luce'. These are words which are not commonly understood by the average consumer and there are a number of ways in which they may be pronounced. The way in which the average consumer pronounces the common element 'LUCE' will be the same in respect of both marks. The addition of 'Arcata Di' in the application results in a noticeable aural difference between the marks. Overall, I find there to be a medium degree of aural similarity.

Conceptual similarity

86. As I have already found, earlier in this decision, the applicant's mark will not be readily understood by the average UK consumer and will likely be seen as words from another language. The central word in the opponent's mark is also likely to be seen as a word from another language or, given the fact that it is four letters long and has no other words around it to give context, it may be seen as an invented word. In either case it does not convey a meaning which would be readily understood. In contrast, the device in the opponent's mark has a clear and immediate meaning, namely, a sun – and it is this meaning which the average consumer will take away from the mark.

87. Taking all of these factors into account, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier marks

88. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been used as

coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.²⁵

89. The opponent claims an enhanced level of distinctiveness as a result of the extensive use which has been made of its mark in relation to the goods listed in the registration. For reasons which I have outlined above, the evidence provided by the opponent falls short of showing an enhanced level of distinctive character for the relevant marks and I will only consider the marks' inherent distinctiveness.

90. The first of the opponent's earlier marks is LUCE DELLA VITE. In terms of its inherent distinctiveness it makes no descriptive nor allusive reference to the goods and is most likely to be seen by the average consumer as a combination of words from another language with an unknown meaning. Consequently, it possesses a fairly high degree of inherent distinctive character.

91. The opponent's second earlier right is the word LUCE contained within a substantial 'sunburst' or sun device. LUCE makes no descriptive nor allusive reference to the goods and is most likely to be seen by the average consumer as an invented word or a word from another language with an unknown meaning. The word in combination with the sunburst device results in a mark which possesses a high degree of inherent distinctive character.

Likelihood of confusion

92. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.²⁶ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

²⁵ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

²⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

93. I have made the following findings:

- The average consumer is a member of the general public, over 18 years of age.
- The level of attention paid to the purchase will vary. That said, the goods will require at least a reasonable degree of attention to be paid as the average consumer will need to consider, inter alia, flavour, age and variety.
- The purchase will be primarily a visual one, though I do not discount an aural element.
- The respective marks possess the following degrees of similarity when compared with the applicant's mark:

LUCE DELLA VITE

Low to medium visual similarity

Low to medium aural similarity

Conceptually neutral

Stylised Sun LUCE mark

Low visual similarity

Medium aural similarity

Conceptually dissimilar

- The earlier mark LUCE DELLA VITE has a fairly high level of inherent distinctive character. The stylised sun LUCE mark has a high degree of inherent distinctive character.

94. I note that throughout its submissions the opponent has sought to show that LUCE is the distinctive and dominant element in both of its marks and has gone as far as submitting that it is the only element I should compare to the application. In making a finding, I bear in mind the comments of Mr Iain Purvis Q.C. as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*,²⁷ in which he pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

²⁷ *BL O-075-13*

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, 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.”

95. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

96. The distinctive character of the earlier marks rests in the first instance in the combination of three words LUCE DELLA VITE, in which LUCE does not have an independent distinctive role. It is the first word, which is different to saying that it is independently distinctive. The other two words do not feature in the application and the first two words of the application do not appear in the earlier mark.

97. In the second instance, the word LUCE is the only word element and is distinctive but the mark is clearly the combination of the significantly sized sun device with the word LUCE. The significant sun device has no equivalent in the application and the application is made up of three words, two of which have no counterpart in the earlier right.

98. The earlier marks, respectively, have a low to medium, and a low level of visual similarity compared to the application and the purchase is primarily a visual one, though I have not discounted the aural element in making the overall assessment. Bearing in mind that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (which is clearly the case here with regard to all of the parties’ marks) and

bearing in mind the nature of the purchase and the level of attention paid, I find the differences between the opponent's marks and the application are too great to give rise to a likelihood of confusion, either directly, where one mark is mistaken for the other, or indirectly, by virtue of a belief that the marks originate from economically linked undertakings.

CONCLUSION

99. The opposition fails under section 5(2)(b).

The grounds under section 5(4)

100. The opponent relies on LUCE DELLA VITE under this section of the Act. I have already found in my assessment of the evidence that the opponent has not shown sufficient goodwill in the UK to get an opposition started under this ground. Even if I am found to be wrong in this and the opponent could show the goodwill required to begin a case under section 5(4) of the Act, the differences between the respective marks is such that there would not be the necessary misrepresentation.²⁸

101. The opposition fails under section 5(4)(b) of the Act.

COSTS

102. The applicant has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2 of 2016. As the applicant was unrepresented, at the conclusion of the evidence rounds the tribunal invited it to indicate whether it intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition.

²⁸ *Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in Reckitt & Colman Products Ltd v. Borden Inc. [1990] R.P.C. 341 and Erven Warnink BV v. J. Townend & Sons (Hull) Ltd [1979] AC 731.*

103. The applicant completed a pro-forma listing the following time spent on its case:

| | |
|---|------------|
| Completing the notice of defence: | 7.5 hours |
| Considering forms filed by the other party: | 2 hours |
| Considering other side's evidence: | 1.5 hours |
| Analysing and commenting on other side's evidence: | 12 hours |
| Drafting and filing written submissions of defence: | 10.5 hours |
| Total: | 33.5 hours |

104. As an unrepresented party, I accept it was necessary for the applicant to familiarise itself with the Notice of Opposition and having done so, to research the position and to formulate an appropriate response. This is likely to have taken the applicant some time.

105. A claim in respect of 33.5 hours in total is not unreasonable, bearing in mind the nature and volume of evidence filed by the opponent. In particular, the applicant's claim for 12.5 hours to analyse the opponent's evidence, draft and file its response is supported by the detailed nature of that response, including the obvious scrutiny of the opponent's invoices.

106. I award costs to the applicant in the amount of £603 i.e. 33.5hrs x £18, the latter being the minimum level of compensation for litigants in person in The Litigants in Person (Costs and Expenses) Act 1975.

107. I order Tenute di Castelgiocondo e di Luce della Vite Società Agricola S.r.l. to pay 10 International Ltd the sum of **£603**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of November 2017

Ms Al Skilton

For the Registrar,

The Comptroller-General