

BL O/106/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION 3243880

BY

COPPOLA ITALIAN GOURMET FOOD LTD

TO REGISTER THE FOLLOWING TRADE MARK IN CLASSES 29 & 31:



AND

OPPOSITION THERETO (NO. 410676)

BY

GMYL, L.P.

## Background and pleadings

1. Coppola Italian Gourmet Food Ltd (the applicant) applied to register the trade mark:



in the UK on 15 July 2017. It was accepted and published in the Trade Marks Journal on 04 August 2017, in respect of the following goods:

**Class 29:** Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice. Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt. Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages. Alcoholic beverages; all of the aforementioned goods being the produce of Italy.

**Class 31:** Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats. Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice. Beers;

mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages. Alcoholic beverages; all of the aforementioned goods being the produce; all of the aforementioned goods being the produce of Italy.

2. It should be noted that there are certain goods listed in both classes above, which have been misclassified according to the Nice Classification system<sup>1</sup>. The opponent has referred to this matter in submissions and is correct in stating that the application includes goods that are proper not only to classes 29 and 31, but also to classes 30, 32 and 33. This administrative issue does not affect the material particulars of the matter at hand, and I will deal with this in more detail later in my decision, when making a full comparison of goods and services (see paragraph 15 below).
3. GMYL, L.P. (the opponent) opposes all of the goods in the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opposition is based on two earlier European Union Trade Marks (EUTMs), namely:

EUTM 10769164, filed on 29 March 2012 and registered on 05 June 2014, for the mark:

### **COPPOLA**

In respect of the following goods:

**Class 33:** Wines, spirits, liqueurs.

and

EUTM 15576184, filed on 27 June 2016 and registered on 27 October 2016, for the mark:

### **THE FAMILY COPPOLA**

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<sup>1</sup> <https://www.wipo.int/classifications/nice/en/>

In respect of the following services:

**Class 43:** Restaurant, bar and catering services and providing banquet and social-function facilities for special occasions; resort-lodging services; travel-agency services, namely, making reservations and booking for temporary lodging; providing winemaker dinners featuring wine.

4. The opponent claims that the goods at issue are the same or highly similar and the marks are highly similar.
5. In its counterstatement, the applicant denies all of the claims of the opponent.
6. The opponent provided evidence and written submissions which will not be summarised here, but will be referred to later in this decision if necessary.
7. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. Throughout the proceedings the applicant has been represented by Gennaro Eugenio Coppola. The opponent has been represented by Jeffrey Parker & Company.

## **Decision**

### **Section 5(2)(b) of the Act**

9. 5(2)(b) of the Act states:

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

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade

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

10. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“the CJEU”) 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.

### **The principles**

(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 and services**

11. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

12. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

13. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*, Case T- 133/05, the General Court stated that:

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

14. The parties' respective specifications are:

Earlier marks	Application
<p data-bbox="284 297 539 331"><b>EUTM 10769164</b></p> <p data-bbox="284 342 786 376"><b>Class 33:</b> Wines, spirits, liqueurs.</p> <p data-bbox="284 510 539 544"><b>EUTM 15576184</b></p> <p data-bbox="284 566 794 1037"><b>Class 43:</b> Restaurant, bar and catering services and providing banquet and social-function facilities for special occasions; resort-lodging services; travel-agency services, namely, making reservations and booking for temporary lodging; providing winemaker dinners featuring wine.</p>	<p data-bbox="810 297 1407 1485"><b>Class 29:</b> Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice. Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; malt. Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages. Alcoholic beverages; all of the aforementioned goods being the produce of Italy.</p> <p data-bbox="810 1552 1407 1975"><b>Class 31:</b> Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats. Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and</p>



	<p>confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice. Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages. Alcoholic beverages; all of the aforementioned goods being the produce of Italy.</p>
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15. The application at issue has been filed in classes 29 and 31. In submissions, the opponent has correctly stated that the specifications of goods in the application include a range of goods that are proper to classes other than 29 and 31. The application in fact contains goods that are proper to classes 29, 30, 31, 32 and 33.

16. If classified correctly, according to the Nice classification system, the application would have contained five classes, with correctly classified specifications of goods as follows:

**Class 29:** Meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; all of the aforementioned goods being the produce of Italy.

**Class 30:** Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; all of the aforementioned goods being the produce of Italy.

**Class 31:** Raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and

seeds for planting; live animals; foodstuffs and beverages for animals; malt; all of the aforementioned goods being the produce of Italy.

**Class 32:** Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; all of the aforementioned goods being the produce of Italy.

**Class 33:** Alcoholic beverages; all of the aforementioned goods being the produce of Italy.

17. The Nice classification system is an administrative tool intended to simplify matters in areas such as clearance searching, comparison of earlier rights etc. However, whilst each applicant must provide clear and precise lists of goods or services in an application, where the goods or services applied for have been misclassified and, in those instances, the applicant does not agree to revise their specifications, either by deletion of misclassified terms, or by adding classes to the application where appropriate, the IPO must consider all of the goods and services that have been filed with that application. In this instance, the applicant has been offered the opportunity to delete those goods not proper to classes 29 or 31, or to add classes 30, 32 and 33, to correctly reflect the scope of this application. Neither option has been taken up by the applicant. Consequently, the office must consider the application in classes 29 and 31, whilst taking due notice of the scope of the application for all of the goods originally filed with the application. This does not however, have any effect on the comparison that I will now undertake between the applied for goods and the earlier goods and services.

18. The application contains only classes 29 and 31, as mentioned above. Many of the goods applied for have been duplicated in both of those classes. For the purposes of the goods and services comparison, and to ensure clarity, I will address the applied for goods as if they had been classified correctly on filing, and fall within the five classes I have identified above.

19. I will start by comparing all of the applied for goods against the goods covered by the opponent's earlier EUTM 10769164, for the mark 'COPPOLA'.

20. I will begin with the applied for goods that have been identified as proper to Class 33, namely '*alcoholic beverages; all of the aforementioned goods being the produce of Italy*'.
21. The opponent's earlier EUTM 10769164 'COPPOLA' covers the goods '*wines, spirits, liqueurs*' which are alcoholic beverages. These goods are entirely encompassed within the '*alcoholic beverages; all of the aforementioned goods being the produce of Italy*', of the later mark and, applying *Meric*, are therefore identical. These applied for goods have been duplicated in classes 29 and 31 but, as set out above, fall correctly in class 33. The fact that they have been incorrectly listed is no reason for me not to conclude that they are identical in all respects to the earlier goods under EUTM 10769164, in class 33.
22. Turning to the applied for goods '*mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; all of the aforementioned goods being the produce of Italy*', which have been listed in both classes of the application, but are actually proper to class 32, as set out above. These goods are beverages intended to quench the thirst or to be enjoyed for their flavour. The earlier goods '*wines, spirits, liqueurs*' in class 33 are alcoholic beverages at large.
23. In *Wesergold Getränkeindustrie GmbH & bCo KG v EUIPO*, case T-278/10, the General Court held that '*spirits, particularly whisky*' was not similar to non-alcoholic beverages. Accepting that the respective goods were sometimes mixed together by consumers, the court nevertheless found that consumers would not expect the goods to originate from the same, or economically related, undertakings. Therefore, the goods were not complementary within the meaning of the case law.
24. I therefore find that, whilst these goods may be sold in the same establishments and their nature and purpose may share some similarity, the applied for goods '*mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages*' are dissimilar to the opponent's earlier '*wines, spirits, liqueurs*'.

25. The matter is less straightforward in respect of the applied for goods 'Beers'. Whilst the goods at issue are clearly not identical, and there are obvious and significant differences between the earlier 'spirits' and 'liqueurs'; consideration must be given as to whether there is any similarity at all between 'beers' and 'wine', and, if there is, how much.

26. When making a comparison, all relevant factors relating to the goods in issue should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union ("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."

27. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 it was stated:

"It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48)."

28. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

29. The General Court (“GC”) dealt with a comparison between beer (and ale and porter) and wine in *Coca-Cola v OHIM* (Case T-175/06) (“*Coca-Cola*”), concluding that there was little similarity between them. It stated in its judgment:

“Comparison between wine and beer

63 So far as concerns, first, the nature, end users and method of use of wines and beers, ale and porter, it is correct, as argued by the applicant, that those goods constitute alcoholic beverages obtained by a fermentation process and consumed during a meal or drunk as an aperitif.

64 However, it must be stated – as did the Board of Appeal – that the basic ingredients of those beverages do not have anything in common. Alcohol is not an ingredient used in the production of those beverages, but is one of the constituents generated by that production. Moreover, although the production of each of those beverages requires a fermentation process, their respective methods of production are not limited to fermentation and are fundamentally different. Thus, crushing grapes and pouring the must into barrels cannot be assimilated to the brewing processes of beer.

65 Moreover, the fact that beer is obtained through the fermentation of malt, whereas wine is produced through the fermentation of the must of grapes, means that the end products generated differ in colour, aroma and taste. That difference in colour, aroma and taste leads the relevant consumer to perceive those two products as being different.

66 In addition, despite the fact that wine and beer may, to a certain extent, satisfy the same need – enjoyment of a drink during a meal or as an aperitif – the Court considers that the relevant consumer perceives them as two distinct products. The Board of Appeal was therefore correct to consider that wines and beers do not belong to the same family of alcoholic beverages.

67 As regards, next, the complementary nature of wine and beer as referred to in the case-law cited in paragraph 61 above, it should be borne in mind that complementary goods are goods which are closely connected in the sense that one is indispensable or important for the use of the other (see Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60). In the present case, the Court considers that wine is neither indispensable nor important for the use of beer and vice versa. There is indeed nothing to support the conclusion that a purchaser of one of those products would be led to purchase the other.

68 As to whether wine and beer are in competition with each other, it has previously been held, in a different context, that there is a degree of competition between those goods. The Court of Justice thus considered that wine and beer are, to a certain extent, capable of meeting identical needs, which means that a certain measure of mutual substitutability must be acknowledged. Nevertheless, the Court of Justice pointed out that, in view of the significant differences in quality – and, accordingly, in price – between wines, the decisive competitive relationship between wine and beer, a popular and widely consumed beverage, must be established by reference to those wines which are the most accessible to the public at large, that is to say, generally speaking, the lightest and least expensive varieties (see, by Page 9 of 15 analogy, Case 356/85 Commission v Belgium [1987] ECR 3299,

paragraph 10; see also, Case 170/78 Commission v United Kingdom [1983] ECR 2265, paragraph 8, and Case C-166/98 Socridis [1999] ECR I-3791, paragraph 18). There appears to be nothing to indicate that that assessment does not also apply in the present case. Accordingly, it must be acknowledged, as the applicant indicates, that wine and beer are, to a certain extent, competing goods.

69 Finally, in accordance with the Board of Appeal's assessment, it must be accepted that the average Austrian consumer will consider it normal for wines, on the one hand, and beers, ale and porter, on the other, to come from different undertakings – and will therefore expect this – and that those beverages do not belong to the same family of alcoholic beverages. There is nothing to suggest that the Austrian public is not aware, and does not notice the characteristics distinguishing beer and wine as regards their composition and method of production. On the contrary, the Court considers that those differences are perceived as making it unlikely that the same undertaking would produce and market the two types of beverage at the same time. For the sake of completeness, it should be noted that it is well known that, in Austria, there is a tradition of producing both beer and wine, and that this is done by different undertakings. Consequently, the average Austrian consumer expects beers, ale and porter, on the one hand, and wines on the other, to come from different undertakings.

70 In the light of all of the preceding factors, the Court considers that, for average Austrian consumers, there is little similarity between wines and beers.”

30. The GC did not, in *Coca-Cola*, refer to proximity of sale, although it did in *Bodegas Montebello, SA v OHIM*, finding that the alcoholic content of the goods in that case (wine and rum) was very different and that even though they might share distribution channels, they will not generally be sold on the same shelves. In that case, despite the finding about shared distribution channels, the GC found that wine and rum were “manifestly different”. Shared distribution channels was a factor considered by Mr

Geoffrey Hobbs QC, sitting as the Appointed Person, in *Balmoral Trade Mark* [1999] RPC 297 in which he compared whisky to wine (for identical marks):

“At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different products which emanate (and are known to emanate) from producers specialising in different and distinct fields of commercial activity. This was said to render it unlikely that a producer of whisky would become (or be expected to become) a wine producer and unlikely that a producer of whisky who did become a wine producer would market (or be expected to market) his whisky and wines under the same trade mark. I was urged to accept that this made it possible for one producer to use a mark for whisky and another producer to use the same mark concurrently for wines without any real likelihood of confusion ensuing. I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the applicant over-emphasise the part played by producers and under-emphasise the part played by other traders in the business of buying and selling whisky and wines. It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of “own brand” or “merchant-specific” labelling. Those who supply retail customers may be licensed to do so under an “off licence” or a licence for “on and off sales” in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well. When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar*



case (uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines.”

31. Based on the authorities set out above, I believe that it would be wrong to say that there is no similarity at all between beer and wine. They are both alcoholic drinks consumed for social purposes and/or the intoxicating effects of the alcoholic content. They are both sold in similar outlets such as off-licences and the drinks area of a supermarket; they are both also sold in restaurants and bars. These goods can also be said to be in competition, as consumers may often be faced with a choice of both in a restaurant or bar. Overall, I conclude that these goods are similar, but to only a low degree.

32. With the exception of '*malt*', the remaining applied for goods listed above as being proper to classes 29, 30 and 31, are found to be dissimilar to the '*wines, spirits, liqueurs*' of the earlier EUTM 10769164 'COPPOLA'. The nature purpose, channels of trade, method of production and potential end-user, are different. Whilst the average consumer may enjoy drinking wine, spirits or a liqueur with a meal or snack product, that consumer will not expect the producer or manufacturer of e.g. wine or whisky, to also be in the business of manufacturing goods such as meat, fish, poultry and game; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals.

33. The applied for '*malt*' is a cereal product that is used in the production of whisky. The fact that malt is an ingredient of whisky does not necessarily result in a finding of similarity however. The nature, purpose, channels of trade and users are different. These goods are retailed in different types of outlet and would not be confused. It might possibly be argued that these goods could be complementary, however I would conclude that, although malt is essential in the production of malt whisky, I do not believe that the average consumer of whisky would assume that an undertaking producing malt whisky would also be responsible for the growing, processing and retail of malt cereal. Therefore, I find no similarity between these goods.
34. I will now compare the applied for goods against the opponent's second EUTM 15576184, for the mark 'THE FAMILY COPPOLA'.
35. The earlier mark covers services in class 43, namely: '*Restaurant, bar and catering services and providing banquet and social-function facilities for special occasions; resort-lodging services; travel-agency services, namely, making reservations and booking for temporary lodging; providing winemaker dinners featuring wine.*'
36. Goods and services may be considered similar if it is plausible that they have the same provenance, and especially if market reality shows that the provision of the services and the manufacture of the goods are commonly offered by the same undertaking under the same trade mark; therefore, consumers may think that responsibility lies with the same company.
37. I will begin by considering the goods applied for that fall correctly in class 29. The applied for '*meat, fish, poultry and game*' are considered to be similar to a low degree to the earlier '*Restaurant, bar and catering services; providing winemaker dinners featuring wine*'. Some butchers or charcuteries may roast chickens or other types of meat. Although those goods are not necessarily consumed on the premises, there is an overlap with the services of a fast food restaurant or take away. The same is true with regard to some fishmongers who offer their customers a selection of fish and seafood to take away or to be cooked and eaten on the premises (in an adjoining restaurant).

38. The Appointed Person found in *J Sainsbury Plc v Top Dog Eats Limited*<sup>2</sup>, that class 29 is concerned with goods, mainly foodstuffs of animal origin, that have been prepared for consumption or conservation, and that '*meat, fish, poultry and game*', forming a part of the class heading, could therefore encompass, as a subset, items such as hotdogs; meat pies; hamburgers; beef burgers and other snack foods, that the average consumer would expect to find on offer from a restaurant, bar or catering outlet. These goods and services are therefore found to be similar to a low degree.

39. The remaining goods applied for, and proper to class 29, '*meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; all of the aforementioned goods being the produce of Italy*' are goods used as foodstuffs or as part of a meal either as an ingredient or as a condiment or sauce, to add flavour.

40. In *Les Editions Albert Rene Sari v OHIM Case C-16/06 [2009] E.T.M/R. 21* it was held that

"the mere fact that a particular item is used as a part, element or component of another does not suffice to show that the finished goods containing that item are similar since their nature, intended purpose and intended customers may be completely different."

41. These goods do not share nature, purpose, channels of trade or method of production with the opponent's earlier services. They are dissimilar.

42. Turning to the goods applied for, and proper to class 30, the applied for '*Coffee, tea, cocoa and artificial coffee; preparations made from cereals; bread, pastries and confectionery; edible ices; all of the aforementioned goods being the produce of Italy*' are similar to a low degree to the opponent's services since they can have the same distribution channels and points of sale, are sometimes complementary and can originate from/be offered by the same undertaking.

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<sup>2</sup> *J Sainsbury Plc v Top Dog Eats Limited* (Appointed Person) O/044/16.

43. The applied for '*rice; tapioca and sago; flour; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; all of the aforementioned goods being the produce of Italy*' are items of food, ingredients or condiments intended to be used in the making of a finished product or as an additive or adornment to a meal or food product, to add flavour, texture or additional appeal to the consumer. I refer again to *Les Editions Albert Rene Sari v OHIM* Case C-16/06 [2009] E.T.M/R. 21 as above. Whilst these goods might be used as ingredients in a foodstuff, this does not make them similar to the earlier services.

44. Going on to consider the goods applied for that are proper to Class 31, the applied for '*raw and unprocessed agricultural products*' are products that result from the cultivation of the soil and farming, such as fresh fruits and vegetables. The applied for '*raw and unprocessed horticulture products*' are products that result from the cultivation, processing, and sale of fruits, nuts, vegetables, ornamental plants, and flowers, and the applied for '*raw and unprocessed forestry products*' include nontimber forest products such as mushrooms, berries, etc, and can also include fruits. The applied for '*raw and unprocessed aquacultural products*' cover crops grown using hydroponics methodology, which can be used for all types of crops, including green leaf vegetables. Consequently, all of these goods, as well as the applied for '*raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting*' may be used as ingredients in the creation of meals and finished food products and may be enjoyed on their own as a single item of fruit, nut or vegetable. However, these goods are not found to be similar to the earlier services of the opponent. The average consumer will not expect an undertaking providing catering or restaurant services to also be in the business of growing and harvesting crops, fruits and vegetables to be used in the meals that they provide under their services. These goods do not share nature, purpose or channels of trade with the earlier services. They are dissimilar.

45. The applied for '*live animals*' are dissimilar to the services of the opponent. They do not share method of production, channels of trade, nature, purpose, or end-user with the opponent's earlier services in class 43. Whilst live animals are often butchered to be used as meat, poultry, game or fish as part of a meal provided by a caterer or

restaurant, the average consumer will not expect a link between the providers of the live animals and the service provider, who will not generally raise live animals to be used in their establishments, but will source those goods through a retail outlet or specialist butcher. These goods and services are dissimilar.

46. The applied for '*foodstuffs and beverages for animals*' are specialised products intended for consumption by animals such as farm animals and domestic pets. These goods are not similar to the services provided by the opponent under its earlier EUTM. They do not share nature, purpose, channels of trade, method of production or end-user. These goods are dissimilar.

47. The applied for goods that are proper to Class 32 can be said to have some relation to the opponent's restaurant and bar services in Class 43. The goods in question are beers and non-alcoholic beverages consumed to quench thirst or for enjoyment. Notwithstanding the different natures of the goods and services under comparison, from the point of view of the consumer the abovementioned goods and the opponent's restaurant and bar services in Class 43 are complementary, in the sense that the contested goods are provided as part of the core services of restaurants and bars, which include the preparing and serving of drinks.

48. In *Group Lottus Corp., SL v OHIM*, Case T-161/07, the General Court held that there was a "lesser" [low] degree of similarity between beers and bar, nightclub and cocktail bar services. It is likely that bars may produce their own beers and as such, the average consumer may make a link or assume an economic connection between beers *per se* and bar services where beer is being served.

49. The relevant public would expect that in some cases the commercial origin and distribution channels of the earlier services and at least the applied for '*beers*' will coincide. There is also an element of competition between the applicant's non-alcoholic drinks in class 32, since a consumer may purchase a beverage as a product to enjoy at home, as an alternative to visiting premises and consuming a beverage onsite. Therefore, the goods and services under comparison are similar to a low degree.

50. The applied for goods proper to class 33 have previously been found to be identical to the opponent's earlier EUTM 10769164 'COPPOLA, in class 33, however these goods may also share similarity with the earlier services 'Restaurant and bar services; providing winemaker dinners featuring wine', as the providers of such services may also produce their own alcoholic beverages such as wine or aperitifs. These goods and services are therefore considered to be similar to a low degree.

51. In conclusion, the applied for goods have been found to be identical, similar to a low degree or dissimilar, as set out below:

**Identical:**

*Alcoholic beverages; all of the aforementioned goods being the produce of Italy*

**Similar to a low degree:**

*Meat, fish, poultry and game; Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; Coffee, tea, cocoa and artificial coffee; preparations made from cereals; bread, pastries and confectionery; edible ices; all of the aforementioned goods being the produce of Italy*

**Dissimilar:**

*Meat extracts; Preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; Rice; tapioca and sago; flour; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; malt; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; all of the aforementioned goods being the produce of Italy*

**Average consumer and the purchasing act**

52. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

53. 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*, [2014] EWHC 439 (Ch), 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 words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

54. To my mind, the average consumer of the goods and services at issue will be a member of the general public. Selection of these goods and services is likely to be primarily visual, involving inspection of products in retail establishments such as supermarkets, or their online equivalents, or following inspection of the retail outlets frontage on the high street, online via websites or through advertisements in print form or electronic and/or online. However, I do not discount that there may be an aural component to the selection of both the goods and the services. The level of attention paid is likely to vary but the consumer is likely to take some care to ensure, for example, that the flavour of the goods, type of cuisine and/or the potential venue, is suitable for their requirements and taste. They are all likely to be purchased with a medium degree of attention.

### **Comparison of marks**

55. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions

created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means 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.”

56. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The respective trade marks are shown below:

Earlier marks	Contested trade mark
<p><b>COPPOLA</b></p> <p><b>THE FAMILY COPPOLA</b></p>	

58. The opponent’s marks are the plain word marks ‘COPPOLA’ and ‘THE FAMILY COPPOLA’ presented in black capital lettering and standard font. The overall impression of the ‘COPPOLA’ mark lies in that single word.

59. The mark ‘THE FAMILY COPPOLA’ can be said to be dominated by the word ‘COPPOLA’. Whilst the sign is likely to be perceived as a unitary term indicating a



family group sharing the surname 'COPPOLA', the conceptual impact of that surname will be the aspect of the mark that will resonate with the relevant public.

60. The applicant's mark is a complex mark comprised of figurative and verbal elements. The verbal elements in the later mark consist of the Italian words 'tradizione italiana'; the word 'COPPOLA' and the words 'fine food'. The figurative aspects of the later mark consist of a gold outline of the country of Italy and the islands of Sardinia and Sicily; five gold stars and a very thin line at the base of the mark presented in the colours green, white and red. Whilst each of these elements play an integral part of the whole, the word 'COPPOLA' is presented at the centre of the mark and comprises the largest and most eye-catching element in the mark. As the other elements in the mark will be perceived to be descriptive and/or non-distinctive, it is arguable as to how much weight they will be given by the average consumer. Consequently, the overall impression of the applied for mark is dominated by the word 'COPPOLA'.

### **Visual similarity**

61. Visually, the respective marks are similar inasmuch as they share the word 'COPPOLA'. They differ visually in the words 'THE' and 'FAMILY' of the second earlier mark and in the words 'tradizione italiana' and 'fine food' of the later mark which have no counterpart in the earlier marks. The marks also differ in the figurative elements of the later mark, namely the outline of the country of Italy and the islands of Sardinia and Sicily presented in gold; five gold stars at the bottom of the mark; the thin line in green, white and red colour, and the gold rectangular border surrounding the mark. As the shared element 'COPPOLA' forms the entirety of one earlier mark and is the dominant and most prominent element in the other earlier mark and in the later mark, these marks are considered to be visually similar to a higher than average degree.

### **Aural similarity**

62. Aurally, the first earlier mark 'COPPOLA' is wholly contained within the later mark. The second earlier mark 'THE FAMILY COPPOLA' shares the term 'COPPOLA'

identically with the later mark. The marks differ aurally in the words 'THE FAMILY' of the second earlier mark, and in the words 'tradizione italiana' and 'fine food' of the later mark. Due to the descriptive and non-distinctive nature of the elements 'tradizione italiana' and 'fine food' in the later mark, it is likely that the average consumer will not articulate these terms. As the shared element 'COPPOLA' comprises the whole of the first earlier mark and comprises the dominant element of the second earlier mark and the later mark, the marks are considered to be aurally similar to a higher than average degree. For that part of the relevant public which would not articulate the words 'tradizione italiana' and 'fine food' of the later mark, the first earlier mark can be said to be aurally identical to the later mark. For that part of the public which would articulate all of the verbal elements in the applied for mark, it is likely that the dominant element 'COPPOLA' will be spoken first and, as such, despite the differences in the marks, the aural similarity can be said to be at least medium.

### **Conceptual similarity**

63. The first earlier mark is comprised solely of the word 'COPPOLA' which is an invented word and has no meaning in English or Italian, although to the average member of the UK general public, the word will likely be perceived to be Italian in origin and possibly a family surname. Due to the presence of the word 'FAMILY', the second earlier mark 'THE FAMILY COPPOLA' will be perceived to indicate a family group that shares the Italian surname 'COPPOLA'.
64. The later mark also contains the term 'COPPOLA'. The other verbal elements of the later mark, 'tradizione italiana' and 'fine food' are Italian and English words that have meaning. The Italian words 'tradizione italiana' mean 'Italian Tradition' in English and will be perceived as suggesting that the goods concerned are from Italy and are of a traditional style. The words 'fine food' suggest high quality food products or the provision of those quality products. In the later mark, the figurative element displaying the outline of Italy and the islands of Sardinia and Sicily will be perceived as indicating that the goods on offer are Italian in origin or style. The green, white and red line at the base of the mark may be perceived as alluding to the Italian flag, and where this is the case, will merely support the consumers perception as to the

Italian nature of the products on offer. The five gold stars in the later mark are of a globally understood nature and are commonly used to indicate the highest quality. This element will combine with the words 'fine food' to enforce the message to the relevant public that the goods on offer are of a very high quality.

65. As 'COPPOLA', the only common element between the marks at issue, has no meaning in Italian or English, but may allude to an Italian surname, for the reasons given above, the marks are conceptually identical for that part of the public which perceives a familial name. Where the term is not perceived as a surname, the element 'COPPOLA' has no concept and therefore no conceptual similarity can exist between the marks at issue.

### **Distinctive character of the earlier trade marks**

66. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from

chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

67. The opponent has made no claim that its earlier marks have acquired an enhanced degree of distinctive character. I must therefore assess the marks purely on their inherent distinctive character.

68. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, observed 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:

“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.”

69. The element ‘COPPOLA’, present in both of the earlier marks, and found to be the dominant element in the mark ‘THE FAMILY COPPOLA’, is a non-English word that has no obvious meaning or association within the context of the goods and services at issue. The word ‘COPPOLA’ is however, considered to be an Italian surname. As such, and taking the view that surnames are generally not found to be of high distinctive character, both of the opponent’s earlier marks are considered to be inherently distinctive to a medium degree.

## **Likelihood of Confusion**

70. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

71. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related).

72. I will turn firstly to the comparison between the earlier mark 'COPPOLA' (EUTM 10769164), covering goods in class 33, and the applied for mark.

73. The goods at issue have been found to be identical, similar to a low degree and dissimilar.

74. The marks have been found to be visually and aurally similar to a higher than average degree and either conceptually identical or conceptually dissimilar. The word 'COPPOLA' forms the dominant part of the later mark and the entirety of the earlier mark. It is also the case that 'COPPOLA' has been found to be a non-English word that is inherently distinctive to a medium degree. The elements in the later mark which may serve to distinguish these marks, i.e. the words 'tradizione italiana', 'fine food' and the various figurative elements, have all been found to be descriptive or lacking in distinctive character and will, therefore, carry little weight in the consumer's recollection of the mark as a whole.

75. Taking all of the aforesaid into account, I am satisfied that direct confusion will occur i.e. the relevant public will mistake the earlier mark 'COPPOLA' for the applied for mark, or vice-versa. However, if I am found to be wrong in this finding, I will go on to consider the matter in respect of indirect confusion, later in my decision.

76. I now turn to the comparison between the opponent's second earlier mark 'THE FAMILY COPPOLA' (EUTM 15576184) and the applied for mark. The earlier mark is registered for class 43 services.
77. The comparison between those services and the applied for goods has resulted in a finding that some of the applied for goods are similar to a low degree to the earlier services and some of the applied for goods are dissimilar. The marks have been found to be visually and aurally similar to a higher than average degree and either conceptually identical or conceptually dissimilar.
78. The similarities between the marks rest identically in the word 'COPPOLA', which has been found to be dominant in the applied for mark, and also the only distinctive element in that mark, whilst comprising the dominant element in the earlier mark 'THE FAMILY COPPOLA'. It is also the case that the element 'COPPOLA' has been found to be a non-English word that is inherently distinctive to a medium degree.
79. The additional verbal and figurative elements in the applied for mark serve only to provide a link to the quality and geographical origin of the goods on offer. The word 'COPPOLA', whilst having no meaning in Italian, may be perceived to be an Italian surname.
80. The average consumer of the goods and services at issue has been found to be a member of the general public, who will pay a reasonable degree of care and attention when selecting the relevant product. The purchase process will primarily follow a visual inspection of the goods or services.
81. Taking all of the aforesaid into account, I am satisfied that the differences between the earlier mark and the later application will not be overlooked entirely and are therefore sufficient to ensure that direct confusion will not occur i.e. the relevant public will not mistake the earlier mark for the later one, or vice-versa.
82. I must therefore now go on to consider the matter in respect of indirect confusion.

83. Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 noted that:

“16. ...Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

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

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

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

84. These examples are not exhaustive, but provide helpful focus.

85. For the relevant public that may notice the differences between the marks at issue, I find that the term ‘COPPOLA’ will be perceived to be a house mark. The addition of the non-distinctive and/or descriptive elements in the later mark will be perceived

merely as an evolution of that house mark or a brand extension from the same undertaking. Those elements in the later mark serve to indicate the Italian origin and quality of the goods on offer. The likely perception of the word 'COPPOLA', present in all of the marks, as an Italian surname, will create a common 'Italian' connection that will further serve to ensure that the average consumer will believe that the marks at hand are controlled by the same, or an economically linked undertaking. I find therefore that indirect confusion would arise between the earlier mark 'THE FAMILY COPPOLA' and the applied for mark. For the same reasons, I find that indirect confusion would also arise between the applied for mark and the earlier EUTM 'COPPOLA', for which I have previously found that direct confusion would occur.

86. My findings in respect of each of the earlier marks is based on two main points of reasoning. Firstly, I find that all of the elements in the applied for mark, with the exception of the word 'COPPOLA', are non-distinctive and/or descriptive and as such will be overlooked by the relevant public, not least because of the prominent and dominant positioning of the word 'COPPOLA', which overwhelms the mark. Secondly, I find that the average consumer will perceive a clear difference between the signs 'THE FAMILY COPPOLA' and 'COPPOLA'. I find that, irrespective of the number of verbal and figurative elements in the applied for mark, direct confusion will occur between that mark and the EUTM 'COPPOLA' but that the same cannot be said when comparing the later mark with 'THE FAMILY COPPOLA', as the average consumer will perceive something different, through the addition of the term 'THE FAMILY' in the earlier mark.

### **Conclusion**

87. As I have found that there is there is a likelihood of confusion, the opposition is successful for the applied for goods that have been found to be identical and similar to the earlier goods or services of the opponent. Subject to appeal, the application is refused for those goods.

88. The application may proceed for the goods that have been found to be dissimilar to the goods and services of the opponent's earlier marks.



89. The goods that are refused are:

*Meat, fish, poultry and game; alcoholic beverages; beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages; coffee, tea, cocoa and artificial coffee; preparations made from cereals; bread, pastries and confectionery; edible ices; all of the aforementioned goods being the produce of Italy.*

90. The goods that may proceed to registration are:

*Meat extracts; preserved, frozen, dried and cooked fruits and vegetables; jellies, jams, compotes; eggs; milk and milk products; edible oils and fats; rice; tapioca and sago; flour; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice; malt; raw and unprocessed agricultural, aquacultural, horticultural and forestry products; raw and unprocessed grains and seeds; fresh fruits and vegetables, fresh herbs; natural plants and flowers; bulbs, seedlings and seeds for planting; live animals; foodstuffs and beverages for animals; all of the aforementioned goods being the produce of Italy.*

### **Costs**

91. Since the opposition is successful for only some of the contested goods, both parties have succeeded on some heads and failed on others. Consequently, I order each party to bear its own costs.

**Dated this 21st day of February 2019**

**Andrew Feldon**

**For the Registrar**

**The Comptroller-General**