

O-032-07

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2385094
BY REINALDO DE LUCCA GALERATO
TO REGISTER THE TRADE MARK:**

R. De Lucca



Vino de El Colorado

IN CLASS 33

AND

**THE OPPOSITION THERETO
UNDER NO 93775
BY
WESTERN WINES LIMITED**

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by Western Wines Limited**

BACKGROUND

1) On 22 February 2005 Reinaldo De Lucca Galerato applied to register the above trade mark (the trade mark). The application was published for opposition purposes in the *Trade Marks Journal* on 24 June 2005 with the following specification:

alcoholic beverages (except beers); wines; all being the produce of Uruguay.

The above goods are in class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 26 September 2005 Western Wines Limited, which I will refer to as Western, filed a notice of opposition to the application. Western is the owner of the following trade mark registrations:

- United Kingdom registration no 2298257 of the trade mark **DA LUCA**. The application for registration was filed on 18 April 2002 and the registration process was completed upon 25 October 2002. It is registered for:

wine; table wine.

The above goods are in class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- Community trade mark registration no 4088852 of the trade mark **DA LUCA**. The application was filed on 26 October 2004 and registration process was completed upon 28 June 2006. It is registered for the following goods:

wine; table wine.

The above goods are in class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

Western states that the dominant and distinctive element of the trade mark is the signature R De Lucca. It states that this is particularly so as the rest of the trade mark comprises a crest and words explaining the provenance of the wine; the consumer would use the R De Lucca element to refer to the goods. The surname De Lucca differs from Western's trade mark by the presence of the second letter c and by the presence of De rather than Da. Western claims that, consequently, its trade mark is almost identical visually and phonetically to the dominant and distinctive element of Mr De Lucca's trade mark. Western states that it is not aware of DA LUCA or De Lucca having any meaning and so the meanings of the trade marks do not have to be considered. Western states that the specification of the trade mark includes wines, which are identical to the goods of its registrations. It suggests that the other goods of the specification of the trade mark are similar. Consequently, there is a likelihood of confusion and registration of the trade mark should be refused under section 5(2)(b) of the Trade Marks Act 1994 (the Act).

3) Western states that it has acquired goodwill in its business. This goodwill has derived, inter alia, from use of the trade mark DA LUCA. Western claims that use of the trade mark would mislead customers and damage its goodwill. Consequently, use of the trade mark is liable to be prevented by the law of passing-off and its registration would be contrary to section 5(4)(a) of the Act.

4) Western seeks the refusal of the application in its entirety and an award of costs.

5) Mr De Lucca filed a counterstatement. He accepts that wines included in the specification of his application are identical to the goods of the earlier registration. He does not admit that the other goods in the specification are identical or similar. Mr De Lucca denies that the trade marks are sufficiently similar for there to be a likelihood of confusion, particularly when taking into account the nature of the goods. Mr De Lucca denies that use of his trade mark is liable to be prevented by the law of passing-off. Western is put to proof in relation to its claim to goodwill.

6) Only Western filed evidence.

7) The sides were advised that they had a right to a hearing and that if neither side requested a hearing a decision would be made from the papers and any written submissions that were received. Neither side requested a hearing; nor did they file any written submissions in relation to the substantive issues of the case.

EVIDENCE

8) This consists of a witness statement by Donald Edward Michael Dychuck. Mr Dychuck is the finance director of Western. Mr Dychuck states that Western has sold wines under the name DA LUCA since 2002. DA LUCA appears on the face and back labels of each bottle as well as upon the neck. He goes on to give the number of 9 litre cases of DA LUCA wine sold in the United Kingdom since the first full year of sale in 2003:

2003	29,653
2004	60,706
2005	52,476

(The 2005 figure will, for the most part, be for a period after the date of application, the material date.)

9) Mr Dychuck states that according to research conducted by AC Nielsen DA LUCA had retail sales of £2.1 million in the 12 month period ending 29 January 2006 and is ranked as one of the top 20 best selling Italian wines in the United Kingdom. (A 12 month period ending 29 January 2006 will for the most part be after the material date.) Mr Dychuck states that according to AC Nielsen, DA LUCA is distributed to 35% of the off-trade market. This, he states, places DA LUCA amongst the top 5 Italian wines in terms of distribution. (None of the AC Nielsen material that Mr Dychuck refers to has been exhibited.) He states that distribution of DA LUCA is higher than many well-known wines such as Chianti. Mr Dychuck states that retail stockists of DA LUCA wine include Waitrose, Tesco, Co-op, Somerfield and Sainsbury's. He exhibits a page downloaded from the Tesco website showing DA LUCA wines. The page was downloaded on 27 April 2006 and so well after the material date, however, I note that the wines were being sold at £3.60 a bottle.

10) Mr Dychuck states that Western has spent the following amounts on promotion of the wine:

2003	£50,000
2004	£180,000
2005	£166,000

(Most of the 2005 figure will relate to a period after the material date.)

11) Mr Dychuck states that Western has received considerable press coverage in relation to DA LUCA wine across national and regional newspaper titles, include *The Times* and *The Observer*. Mr Dychuck exhibits examples of these gleaned from the DA LUCA website; a good number emanate from after the material date. The press coverage is in the form of reviews, which tend to be quite short.

12) Mr Dychuck states that Western organises special offers and promotions within shops selling DA LUCA products. He states that where such promotions take place DA LUCA appears prominently on the point-of sale around where the bottles are placed, as well as at the front of the store or in their promotional materials. He exhibits an envelope and a picture showing a plastic bag, a hat and a pen, all bearing the trade mark DA LUCA. There is no indication as to from when these items emanate.

DECISION

Likelihood of confusion – section 5(2)(b) of the Act

13) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“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.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark 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”

The two registered trade marks are earlier trade marks within the meaning of the Act.

14) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77, *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723 and *Vedial SA v Office for the Harmonization of the Internal Market (trade marks, designs and models) (OHIM)* C-106/03 P.

Comparison of goods

15) The goods of the earlier trade marks are: *wine; table wine*. The goods of the application are: *alcoholic beverages (except beers); wines; all being the produce of Uruguay*. Mr De Lucca accepts that the wines of his application are identical to the goods of the earlier registrations. He does not admit that the other goods are identical or similar. *Alcoholic beverages* include wines; the fact that this means that there is an element of tautology in the specification is neither here nor there. It is common to have tautologous specifications; applicants adopting a belt and braces approach, covering the goods in general and in particular. In *Gérard Meric v Office for Harmonization in the*

Internal Market (Trade Marks and Designs) (OHIM) Case T-133/05 the Court of First Instance (CFI) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

As *alcoholic beverages* include *wine* and *table wine*, they must be considered to represent identical goods.

16) **The respective goods are identical.**

Average consumer and nature of purchasing decision

17) The respective goods are likely to be bought by anyone who is over eighteen years of age and does not have moral objections to alcohol. In effect, the average consumer is the adult public at large. There are experts and persons with a great interest in wines and other alcoholic beverages. However, there are also purchasers who will have little knowledge or interest in them, possibly only purchasing them infrequently for special occasions or to take to parties. There will be those whose only interest is in getting drunk. I do not consider that the purchasing decision will necessarily involve particularly careful and educated consideration.

Comparison of trade marks

18) The trade marks to be compared are:

Western’s trade mark:

DA LUCA

Mr De Lucca’s trade mark:

R. De Lucca



Vino de El Colorado

19) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall

impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (*Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

20) The device element of the trade mark is in colour. There has been no claim to colour or limitation to colour; I do not consider that anything turns upon the device part of the trade mark being in colour.

21) There is now a good deal of case law in relation to the consideration and comparison of composite and complex trade marks:

Shaker di L Laudaato & C Sas v Office for Harmonization in the Internal Market Trade Marks and Designs (*OHIM*) Case T-7/04

“54 However, if the trade mark claimed is a complex mark which is visual in nature, the assessment of the overall impression created by that mark and the determination as to whether there is any dominant element must be carried out on the basis of a visual analysis. Accordingly, in such a case, it is only to the extent to which a potentially dominant element includes non-visual semantic aspects that it may become necessary to compare that element with the earlier mark, also taking into account those other semantic aspects, such as for example phonetic factors or relevant abstract concepts.”

Inex SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (*OHIM*) Case T-153/03

“27 Furthermore, it is settled case-law that a complex mark and another mark which is identical or similar to one of the components of the complex mark may be regarded as being similar where that component forms the dominant element within the overall impression given by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression given by it (*MATRATZEN*, paragraph 33, and Case T-359/02 *Chum v OHIM – Star TV (STAR TV)* [2005] ECR II-0000, paragraph 44). That approach does not amount, however, to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by

examining the marks in question, each considered as a whole (*MATRATZEN*, paragraph 34).

32 In that respect, the argument of the Office that the weak distinctive character of the cowhide design precludes that design from being regarded as a dominant element cannot be accepted in all circumstances. Although it is settled case-law that, as a general rule, the public will not consider a descriptive element forming part of a complex mark as the distinctive and dominant element of the overall impression conveyed by that mark (*BUDMEN*, paragraph 53, and Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look v OHIM – Naulover (NLSPORT, NLJEANS, NLACTIVE and NLCollection)* [2004] ECR II-0000, paragraph 34), the weak distinctive character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element since, because, in particular, of its position in the sign or its size, it may make an impression on consumers and be remembered by them (see, to that effect, Case T-115/02 *AVEX v OHIM – Ahlers (a)* [2004] ECR II-2907, paragraph 20).

33 It must none the less be pointed out that, since the comparison between marks must be based on the overall impression given by them having regard, in particular, to the distinctive character of their elements in relation to the goods or services concerned, it does not suffice, in order to find a similarity between marks, that an element essential to the visual impression of a complex mark and the sole element of the other sign are identical or similar. On the other hand, it should be concluded that there is a similarity where, considered as a whole, the impression given by a complex mark is dominated by one of its elements in such a way that the other components of that mark appear negligible in the image of that mark which the relevant public remembers, in the light of the goods or services designated.”

Camper, SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-43/05

“60 In the assessment of the dominant character of one or more given components of a compound trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of the other components. In addition and accessorially, account may be taken of the relative position of the various components within the arrangement of the compound mark (*MATRATZEN*, paragraph 35).”

GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04

“59. It should be noted in this connection that the fact that one component of the signs at issue is identical does not lead to the conclusion that the signs are similar unless it constitutes the dominant element in the overall impression created by

each of those signs, such that all the other components are insignificant (*MATRATZEN*, paragraph 33).”

Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-3/04

“45. It must be stated that, contrary to what the applicant maintains, where a sign consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant.

47. It is also apparent from the case-law of the Court of First Instance that, in a compound sign, the figurative element may occupy a position equivalent to the verbal element (see Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 53).

48. In addition, even in circumstances where two conflicting marks are composed of similar verbal elements – which is not the case here – that fact does not, by itself, support the conclusion that there is a visual similarity between the signs. The presence, in one of the signs, of figurative elements set out in a specific and original way can have the effect that the overall impression conveyed by each sign is different (see, to that effect, Case T-156/01 *Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO AIRE)* [2003] ECR II-2789, paragraph 74).

56. As OHIM has wisely observed, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 55).

58. 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.”

Société des produits Nestlé SA v Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI) Case T-74/04

“49 En l’espèce, il convient d’analyser la similitude visuelle entre les éléments verbaux « QUICKIES » et « QUICKY », puis, au cas où une telle similitude serait constatée, de vérifier si l’élément graphique ou figuratif additionnel, propre à la

marque demandée, est susceptible de constituer un élément de différenciation suffisant pour écarter l'existence d'une similitude visuelle des signes en conflit aux yeux du public de référence (voir, en ce sens, arrêt Faber, précité, point 39). En d'autres termes, il est nécessaire de déterminer si, d'un point de vue visuel, le dessin du lapin constitue l'élément dominant de la marque demandée, c'est-à-dire domine à lui seul l'image que le public pertinent garde en mémoire, ou si, au contraire, il est un élément distinctif d'intensité égale ou inférieure à l'élément verbal constitué par le mot « quicky ».

50....En effet, lorsqu'une marque est composée d'éléments verbaux et figuratifs, les premiers sont, en principe, plus distinctifs que les seconds, car le consommateur moyen fera plus facilement référence au produit en cause en citant le nom qu'en décrivant l'élément figuratif de la marque [voir, en ce sens, arrêts du Tribunal Fifties, précité, point 47, et du 14 juillet 2005, Wassen International/OHMI – Stroschein Gesundkost (SELENIUM-ACE), T-312/03, non encore publié au Recueil, point 37].....

51 Ensuite, il y a lieu de relever que l'élément figuratif de la marque demandée, à savoir le dessin d'un lapin, pourrait être perçu par le public davantage comme un élément décoratif de l'étiquette des produits désignés que comme le signe indiquant l'origine des produits. En effet, comme la requérante l'a admis lors de l'audience en réponse à une question du Tribunal, l'utilisation d'un animal jovial et animé, par exemple un dinosaure ou un lapin ressemblant à un personnage de dessin animé, est un procédé qui est utilisé par les fabricants de produits alimentaires pour capter un public jeune, notamment les enfants. Cette utilisation fréquente de différents animaux pour ce type de produits a pour conséquence une banalisation de leur usage et de leur caractère distinctif, lequel, ce faisant, tend à être considérablement diminué.”

The Royal County of Berkshire Polo Club Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-214/04

“39 Next, it must be recalled that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).”

Athinaiki Oikogeniaki Artopoiia AVEE v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-35/04

“52 The Court takes the view that the word ‘ferró’ prevails over the figurative element of the mark applied for and predominates, effectively, at the time of its perception because of its large size and superimposition on the banner which, having only a purely background decorative function, cannot be regarded as the dominant element of the mark applied for. It follows that the Board of Appeal made no error of assessment in holding that ‘ferró’ was the dominant element of the mark applied for and that the banner was of secondary importance. In those circumstances, the signs can be compared using the verbal elements alone, without infringing the principle that the assessment of the likelihood of confusion, as regards the similarity of the signs, must be based on the overall impression they produce (see, to that effect, order of 10 December 2004 in Case T-261/03 *Euro Style v OHIM – RCN-Companhia de Importação e Exportação de Texteis (GLOVE)*), not published in the ECR, paragraph 38).”

Chum Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-359/02

“44 In that connection, it is appropriate to state at the outset that the words ‘star TV’ constitute both the mark applied for and the verbal element of the earlier mark. In similar circumstances, the Court of First Instance held that a complex word and figurative mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).”

Miles Handelsgesellschaft International mbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-385/03

“39 Furthermore, a complex mark and another mark which is identical to one of the components of the complex mark can be considered to be similar only if that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it (Case T-6/01 *Matratzen Concord v OHIM – Hukla Germany (MATRATZEN)* [2002] ECR II-4335, paragraph 33).”

40 Such an assessment does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark.

However, that does not mean that the overall impression conveyed by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components. As regards the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components (*MATRATZEN*, paragraphs 34 and 35).”

Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case C-3/03P

“32 The Court rightly pointed out, in paragraph 34 of the contested judgment, that the assessment of the similarity between two marks does not amount to taking into consideration only one component of a complex trade mark and comparing it with another mark. On the contrary, such a comparison must be made by examining the marks in question, each considered as a whole. It also held that that does not mean that the overall impression created in the mind of the relevant public by a complex trade mark may not, in certain circumstances, be dominated by one or more of its components.”

22) In considering whether the trade marks are similar it is necessary to bear in mind the perception of the average consumer; this perception will, to some extent, be affected by the nature of the goods.

23) The public are used to seeing crests and coats of arms on alcoholic beverages. In my experience little attention is given to such matter on a bottle or a tin. I consider that the device element, taking into account the nature of the goods, will have a negligible effect when the average consumer remembers the trade mark. (It is, to some extent, like the rabbit in *Société des produits Nestlé SA v Office de l'harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)*.) The vino element of the *Vino de El Colorado* element of the trade mark is quite likely to be identified as meaning wine, even amongst non Castellano speakers. However, the *de El Colorado* will in my view have some significance as identifying the goods. The *R. de Lucca* element of the trade mark is, however, in my view dominant both visually and perceptually. This is the element that, in my view, that the relevant public will keep in mind. It is the dominant and distinctive component of the trade mark. *Lucca* and *Luca* are likely to be pronounced in the same way. Imperfect recollection, in terms of visual recognition, is likely to militate against distinguishing between the words because of the additional *c* in the trade mark. The *De* and *DA* elements begin with the same letter; they also create a similar pattern in the word element. There is nothing to suggest that for the average consumer there are any conceptual associations. The name of the applicant shows that *De Lucca* is a surname but there is nothing to indicate that the average consumer would know this. I have no idea if *Da Luca* is a surname. Consequently, there is no conceptual similarity or dissimilarity between the trade marks and, of importance, no convenient conceptual hook for the consumer's memory; thus making the consumer more likely to be the prey of imperfect recollection. I am of the view that the *De Lucca* element of the trade mark and *DA LUCA* are very similar.

24) Of course I have to consider the trade mark in its entirety, not just the De Lucca element. Taking into account the nature of the goods, the likely perception of the average consumer and the dominant and distinctive elements of the trade marks, I have come to the conclusion that they are similar.

Conclusion

25) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical. It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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] ETMR 585). There is no evidence to suggest that DA LUCA is in anyway descriptive of or even allusive to wines. Therefore, it enjoys a reasonable degree of inherent distinctiveness. Western has put in evidence in relation to establishing a goodwill. There has been no claim to its trade mark enjoying a reputation in the context of likelihood of confusion. There is clearly evidence of use of the trade mark. There is no indication as to what proportion of the wine market goods sold under the trade mark DA LUCA. There is an indication of the position in the Italian wine market but I consider that it would be necessary to know the position in relation to the wine market at large if it were to benefit from reputation. At 27 April 2006 bottles of DA LUCA wine were selling at £3.60, so the goods are in the popular, bulk end of the market and so reputation will be very much based on extent of sales and promotion. There are references to AC Nielsen surveys but none of the surveys has been exhibited. The expenditure on publicity does not appear to have been very large. Print promotion appears to have been through wine review columns rather than actual advertisements. Taking these factors into account I do not consider that Western could have benefited from any enhanced protection arising from a reputation, if this had been pleaded. Even if there were a reputation I don't think it would have significantly improved Western's position. Reputation can make a trade mark that does not enjoy a great deal of distinctiveness more distinctive and so cause a greater likelihood of confusion (*Sabel BV v Puma AG*). I have decided that Western's trade mark enjoys a reasonable degree of distinctiveness. Reputation can also have an effect where there is only a limited degree of similarity between goods or services (*Canon Kabushiki Kaisha v*

Metro-Goldwyn-Mayer Inc). In this case the goods are identical. The goods could well be purchased without a great deal of care or could be the subject of sporadic purchase; increasing the possibility of the purchaser being the victim of imperfect recollection. Some wine purchasers will be exceptionally discerning and careful in their purchasing decision; others will not. I have to consider the average consumer and not the atypical wine connoisseur. As I have stated above, I consider that the respective trade marks are similar. In their entirety neither mark has a meaning and so there is no conceptual hook for the memory of the consumer. The respective goods are identical. **I find that there is a likelihood of confusion and that the application should be refused in its entirety.**

Passing-off – section 5(4)(a) of the Act

26) I cannot see that Western could be in any better position in relation to passing-off than it is in relation to likelihood of confusion and so will make no decision upon this aspect of the opposition.

COSTS

27) Western Wines Limited having been successful is entitled to a contribution towards its costs. Western considers that it should receive additional costs as:

1. Mr De Lucca requested an extension of time on 10 August 2006 for the filing of evidence. No evidence was subsequently filed.
2. The preliminary indication was in favour of the opponent.

It is not uncommon for parties to consider filing evidence but in the end decide that it would serve no purpose and desist from so doing. I do not see that the extension of time request deserves additional costs. If the additional costs were to be given because a decision and a preliminary indication came to the same conclusion, then there would be a de facto penalty for those who did not accept a preliminary indication in such circumstances. This would be a pressure for a party to accept the preliminary indication, which is, of course, neither binding nor a legal decision. I cannot see that it would be appropriate or helpful to adopt such a practice. The costs will be on the normal scale as follows:

Opposition fee	£200
Notice of opposition and statement of grounds	£300
Considering counterstatement	£200
Preparing and filing of evidence	£200
Total	£900

I order Reinaldo De Lucca Galerato to pay Western Wines Limited the sum of £900. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 30th day of January 2007

**David Landau
For the Registrar
the Comptroller-General**