

O-070-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION 2520343  
BY RENU SOOD  
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33:**

**RONDO HILLS**

**AND**

**OPPOSITION THERETO (NO 99760) BY  
CANTINE RIONDO S.P.A.**

## **TRADE MARKS ACT 1994**

**In the matter of Renu Sood's application (no 2520343) to register the trade mark RONDO HILLS in class 33**

**and**

**opposition thereto (no 99760) by Cantine Riondo S.P.A.**

### **The background and the pleadings**

1) Mrs Renu Sood filed the trade mark RONDO HILLS on 6 July 2009. The application was published in the Trade Marks Journal on 14 August 2009. Mrs Sood seeks registration in respect of: "WINES, ALCOHOLIC DRINKS OTHER THAN BEER" in class 33.

2) On 18 November 2009 Cantine Riondo S.P.A. ("Cantine") opposed the registration of Mrs Sood's application. It opposes all of the goods sought to be registered. The opposition is under section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Cantine relies on a single trade mark of which it is the proprietor, namely: Community trade mark ("CTM") registration 1330232 for the mark RIONDO. It is not in dispute that Cantine's CTM is subject to the proof of use provisions contained in section 6A of the Act<sup>1</sup>. Cantine made a statement of use that it had used its mark in relation to all of the class 33 goods upon which it relies in the opposition, namely:

"Alcoholic beverages (except beer)"

3) Mrs Rood filed a counterstatement denying the grounds of opposition. Mrs Sood asked Cantine to provide proof of use in respect of Cantine's earlier registered CTM. The defence is based upon RONDO being a variety of grape (although this aspect of the defence was not really followed through) and that the comparison must be made between the whole of the respective marks. A reference is made to Cantine's mark being CANTINE RIONDO. The earlier mark is, of course, RIONDO on its own so the only comparison I can make is between RIONDO and RONDO HILLS.

4) Both sides filed evidence. Neither party asked to be heard and neither party filed written submissions.

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<sup>1</sup> The requirements relating to proof of use are contained in section 6A of the Act, which was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004.

## The evidence

5) Both sides' evidence contains a mixture of fact and submission. The submissions will be borne in mind but will not form part of the evidence summary.

### Witness statement of Abele Casagrande dated 18 May 2010

6) Mr Casagrande is Cantine's general manager. Although he is Italian, he confirms that he has a reasonable knowledge of English and he is confident of the content of his witness statement. The following facts emerge from Mr Casagrande's evidence:

- That Cantine (or its predecessors) have over 11 years of experience in wine production and distribution. It is claimed that Cantine is one of the leading suppliers of still and sparkling wines that emanate from Monteforte d'Alpone in the Soave country of Northwest Italy.
- RIONDO was first used in the UK in 2005. Annual sales in the UK have amounted to (in Euros): 11,716 in 2005, 20,143 in 2006, 9,967 in 2007, 14,295 in 2009 and 6,058 in 2010.
- Example invoices to UK companies have been provided in respect of wine sales. Of the 9 provided, two are from after the relevant date<sup>2</sup> and the relevant period<sup>3</sup>. Of the 7 which are relevant, they include goods described as SPAGO RIONDO, PROSECCO RIONDO, CUVÉE EXCELSA RIONDO ROSE BRUT, RIONDO PINK PROSECO RABOSO. Two of the relevant invoices are headed with the word RIONDO shown just below a crest. Cantine's name and address is also shown.
- Booklets and catalogues are provided which are said to depict many of the RIONDO branded wines offered for sale in the UK and Europe. Much of this makes prominent use of the word RIONDO. Some of this use is between a crest and words such as PROSECCO/ROSE/EXCELSIA. The word itself retains independence from those other elements. Other uses show the word with a stylized S.
- Two example wine labels are provided one showing RIONDO in a heavily stylised form, the other showing RIONDO in a plain form.
- 59 marks are on the register containing the word HILLS, the argument being that such a word is non-distinctive in relation to class 33 goods.

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<sup>2</sup> The relevant date for assessing whether there exists a likelihood of confusion is the filing date of Mrs Sood's application, namely 6 July 2009.

<sup>3</sup> The relevant period for proof of use purposes is the five year period ending on the day on which Mrs Sood's application was published, namely 15 August 2005–14 August 2009.

Witness statement of Kamaljit Singh Sood dated 9 August 2010

7) Mr Sood has been acting as an agent on behalf of his wife, Mrs Sood. Much of his evidence is submission rather than evidence of fact. In terms of evidence of fact, this is limited to:

- That the UK market for wine is around 1.5 billion bottles. Based on Cantine's evidence only around 5000 bottles were sold. On the other hand, Mrs Sood's first lot of wine (which has sold out) equated to 51,840 bottles so Mrs Sood's business is already bigger than that of Cantine's by a factor of over 21:1.
- That if Cantine's sales were to be made at an average supermarket, this would equate to just 3 bottles per annum on the shelves of such stores.

2<sup>nd</sup> witness statement of Abele Casagrande dated 7 October 2010

8) This is in reply to Mr Sood's evidence. In terms of factual evidence this is included in four exhibits, the contents of which are:

- An export sheet for RIONDO wines. Although not translated, it is clear that in terms of export to the UK, 985 cases were exported in 2009 equating to a cost of 14,295 euro. Figures for other EU countries are provided (it is important to bear in mind that Cantine's earlier mark is a CTM) including 760 cases to France (9,500 euro) and 1,316 cases to Germany (20,000 euro). Figures are also provided for 2010 but this is after the relevant date and after the relevant period.
- Evidence showing that RIONDO SPAGO PROSECCO was awarded a silver medal at the International Wine and Spirit Competition (in London) on 4 March 2009 and a similar award in 2010.
- Un-translated entries in magazines relating to various RIONDO wines. They are in the Italian language and it is fair to assume that they come from Italian publications. Whilst some are from after the relevant date/relevant period, a good deal of them are within date. A variety of labels are shown in line with the variety of labels referred to when I summarized Mr Casagrande's first witness statement.

Witness statement of Leslie S Pritchard (of Potts, Kerr & Co, Cantine's representatives) dated 8 October 2010

9) Much of this evidence is, again, submission. In terms of the more factual evidence, this can be summarised as:

- Other than the respective marks the subject of this dispute, there are no marks on the register in class 33 that contain the words RONDO or RIONDO.
- It is claimed that there are many well-known wines that refer to geographical formations as a noun in the second aspect of the mark e.g. CREEK, VALLEY, MOUNT, HILL etc. The claim is that this supports the view that HILLS is non-distinctive.

### **The proof of use provisions**

10) As stated in paragraph 2, the proof of use provisions apply to Cantine's earlier mark. The relevant legislation reads:

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

(1) This section applies where –

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, ...

...

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

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

11) Section 100 is also relevant which reads:

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

12) In view of the above, Cantine must show that it has genuinely used its trade mark in the EC in the relevant period of 15 August 2005 to 14 August 2009. When considering whether genuine use has been shown, I bear in mind the leading authorities on the principles to be applied namely, the judgments of the European Court of Justice ("ECJ") in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 ("*Ansul*") and *Laboratoire de la Mer Trade Marks C-259/02* ("*La Mer*"). It is also worth noting the Court of Appeal's ("COA") judgment ([2006] F.S.R. 5) in the latter of these cases when it had to apply the guidance given by the ECJ. From these judgments the following points are of particular importance:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);

- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*La Mer* (COA), paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*La Mer* (COA), paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*La Mer* (COA), paragraph 44).

13) It is clear from Cantine's evidence that it has produced and sold various types of wine during the relevant period. This is supported by the invoices provided, the case/sales figures for the UK and the subsequently provided export (from Italy) figures for cases/sales to other countries including other EC countries. Even ignoring the fact that some of the subsequently provided figures are from after the relevant period, this evidence shows that trade has taken place in more than one country of the EC within the relevant period. RIONDO wine has also won an award from a trade body which is further indication of a genuinely used mark. Further support comes from the many extracts taken from various Italian publications. Although not translated, they clearly show RIONDO wines mainly in the context of reviews and recommendations. This supports that the goods were also available on the market in Italy. It is argued by Mrs Sood, in the submissions on her behalf, that the number of cases sold equates to only a tiny market penetration. The argument was made primarily in relation to reputation rather than proof of use, but it is important that I also address the point here. The case-law stresses that the test for genuine use is a qualitative one rather than a quantitative one. There is, therefore, no de minimis level of use to establish genuine use. In *Ansul* the ECJ held that it is necessary to establish whether the use "is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of the goods or services at issue, the characteristics of the market and the scale and frequency of use of the mark". In *Il Ponte Finanziaria SpA v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case C-234/06 P the ECJ stated:

“73 The question whether use is sufficient to maintain or create market share for the goods or services protected by the mark thus depends on several factors and on a case-by-case assessment. The frequency or regularity of the use of the trade mark is one of the factors which may be taken into account (see *Sunrider v OHIM*, paragraph 71; see also, to that effect, *La Mer Technology*, paragraph 22).”

14) The use set out is small but it strikes me as reasonably consistent. Whilst the evidence focuses more of the UK position, it is clear from the evidence as a whole that there has been use in a number of EC countries. Therefore, the problem of use in only one member state does not arise<sup>4</sup>. Whilst many wine brands have large amounts of sales, some wines are no doubt sold in small quantities stemming from a more exclusive marketing strategy. I come to the view that the level of use demonstrated is sufficient to constitute genuine use in the EC. It can certainly not be described as token use merely to preserve the rights in the mark. In terms of the mark itself, whilst some uses are in a highly stylized font, it is often used with only a small degree of stylization or with no real stylization at all. I have no doubt that these latter forms of use constitute use of the trade mark RIONDO per se. In some of these uses the mark is presented in close proximity to a crest or to other words (Rose, Prosecco etc), but the nature of such use is that RIONDO is being used independently (the other verbal elements are often simply descriptions of types of wine).

15) The final aspect to consider relates to the goods. It is necessary to decide upon a fair description for the goods for which genuine use has been shown and which falls within the parameters of the specification. The description must not be over pernickety<sup>5</sup>. It is necessary to consider how the relevant public, which for these goods would be the public at large, describe the goods<sup>6</sup>. The General Court (“GC”) in *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03* held:

“43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2)

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<sup>4</sup> The Court of Appeal of the Hague has referred to the ECJ a number of questions relating to genuine use in a single Member State (*ONEL/OMEL case 200.057.983/01*). Given the facts of the case before me, it is not necessary to await the ECJ’s guidance.

<sup>5</sup> See *Animal Trade Mark* [2004] FSR 19.

<sup>6</sup> See *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32.



to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.

53 First, although the last sentence of Article 43(2) of Regulation No 40/94 is indeed intended to prevent artificial conflicts between an earlier trade mark and a mark for which registration is sought, it must also be observed that the pursuit of that legitimate objective must not result in an unjustified limitation on the scope of the protection conferred by the earlier trade mark

where the goods or services to which the registration relates represent, as in this instance, a sufficiently restricted category.”

16) Cantine’s specification covers “alcoholic beverages except beers”. The only product sold by Cantine is wine. Different types of wine have been sold but not every conceivable variety and style. It would be too picky to reduce the specification to only those types of wines sold or to try to describe particular sub-categories in which the wines may fall. The consumer would likely describe the goods sold simply as wine. I consider a fair specification for the use shown to be “wine”. Alcoholic beverages at large is too broad a specification given the wide variety of products that would fall within that definition.

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

17) This section reads:

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

(a) .....

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

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

18) In reaching my decision I have taken into account the guidance provided by the ECJ in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

19) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as assessing whether the respective marks and the respective goods are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person’s eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the

imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of “imperfect recollection”;

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

### Comparison of goods

20) Cantine’s goods are “wine”. Mrs Sood seeks registration for wine, the term “alcoholic drinks” is also listed. Wine is clearly identical to wine. In terms of the term “alcoholic drinks”, wine falls within the ambit of this term. Mrs Sood has not sought to limit this term so as to exclude wine or to list other alcoholic beverages which are not wine. If a term falls within the ambit of a term in the competing specification then identical goods must be held to be in play<sup>7</sup>. It is sufficient, therefore, to hold that identical goods are in play in respect of both terms.

### The average consumer

21) Wine is bought by the public at large, albeit those of drinking age. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on the particular goods in question (see, for example, the judgment of the GC in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). In respect of wine, the average consumer may inspect it for colour (white, rose or red), whether it is still or sparkling, perhaps the grape variety, style, country of origin, dryness etc. However, not all of these factors will be considered on every occasion with a less considered approach sometimes being displayed. Wine is unlikely, however, to ever be classed as a product of a grab and go nature. For those that drink it, wine is purchased relatively frequently and, although cost can vary, it is, generally speaking, not a highly expensive purchase. Taking all of this into account, the purchasing process is not significantly higher or lower than the norm. The purchase is also likely, in the main, to be a visual act as most wine is likely to be purchased following self-selection from a shelf in a supermarket, an off-licence, or wine merchant, or

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<sup>7</sup> See *Gérard Meric v OHIM* Case T-133/05.

online. Aural similarity will not, though, be ignored completely and is still a relevant factor.

#### Comparison of marks

22) The competing marks, for ease of reference, can be seen in the table below:

Cantine's mark	Mrs Sood's mark
RIONDO	RONDO HILLS

23) 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. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

24) Mrs Sood stresses the whole mark comparison whereas Cantine stresses the dominant and distinctive aspect. In terms of distinctive and dominant components, the trade mark RIONDO does not separate into distinctive and dominant components. It has only one constituent part. On the other hand, the trade mark RONDO HILLS has two elements. There is an argument from Cantine that the word HILLS is a non-distinctive element given its common use as part of trade marks in class 33 and that geographical features (hills, creeks, rivers etc) are often featured as part of wine names. Cantine's evidence can be criticized because it is merely state of the register evidence<sup>8</sup> but putting that to one side, the fact of the matter is that RONDO HILLS forms a complete phrase. Whilst there may well be other "hills" marks on the register, the word HILLS nevertheless play an important role in the mark. It gives the mark a concept – a range of hills named RONDO or a range of hills in a location called RONDO. The latter concept is possible even though the average consumer may not know of a place called Rondo – they may simply assume that it is one. The word RONDO qualifies the word HILLS. Mr Pritchard submitted in his evidence that the word HILLS would go unnoticed by the average consumer. I roundly reject this submission. It is, though, true that the RONDO element is at the beginning of the mark and that it is an unusual and distinctive word. This may mean that that it has a greater degree of dominance. I will bear this in mind but, that being said, the word RONDO does not play an independent role in the trade mark, it is tied in concept to the word HILLS and this would follow through when the mark is

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<sup>8</sup> See *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

visually and aurally appreciated. The word HILLS still, therefore, plays an important role whether it is non-distinctive or not.

25) In terms of the visual comparison, whilst there is a reasonably high degree of similarity between RIONDO and the first element of RONDO HILLS, and that this creates a degree of similarity, I consider that when considered as a whole any degree of similarity is at only a moderate level. From an aural perspective, RIONDO is likely to be pronounced as RE-ON-DOUGH whereas RONDO HILLS is likely to be pronounced as RON-DOUGH HILLS. There is one more word in Mrs Sood's mark and one less syllable when considering the first element of her mark compared to Cantine's mark. I consider that any similarity, bearing all this in mind, is of only a low to moderate degree.

26) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp<sup>9</sup>. A conceptual difference can counteract, to a degree, visual and aural similarities. From the point of view of the average consumer in the UK, RIONDO will have no meaning. RONDO HILLS, as alluded to earlier, will be perceived as a reference to a particular range of hills called RONDO or in RONDO. This creates something of a conceptual difference. I consider that the net effect of all this is that there is only a low degree of similarity between the marks.

#### Distinctiveness of the earlier mark

27) The degree of distinctiveness of the earlier mark is an important factor to consider. This is because the more distinctive the earlier mark (based either on its inherent qualities or because of the use made of it), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In terms of inherent qualities the mark is high in distinctive character given that it is an invented word. In relation to Cantine's use, I have already commented on its scale - whilst it is sufficient for the purposes of establishing genuine use, I agree with Mrs Sood that it falls a long way short of establishing any reputation so as to further enhance the mark's distinctive character.

#### Conclusions on the likelihood of confusion

28) It is clear that all the relevant factors have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

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<sup>9</sup> This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIM* [2006] e.c.r. -I-643; [2006] E.T.M.R. 29.

29) The goods are identical but there is only a low degree of similarity between the marks. The earlier mark is, though, high in inherent distinctive character and I must bear in mind the concept of imperfect recollection. All that being said, it is my view that the reasonably observant and circumspect average consumer undertaking a purchasing process with a normal degree of attention will not directly confuse the marks in question. The conceptual difference that results from the inclusion of the word HILLS (a word that will be noticed and recalled by the average consumer) together with the visual and aural differences between the marks, mitigates strongly against the marks from being mistaken for one another. Even considering the position from the perspective of indirect confusion (whereby the consumer will believe that the goods being offered under the respective marks are the responsibility of the same or an economically linked undertaking<sup>10</sup>) then there is still no likelihood of confusion. I see no reason why the average consumer will assume an economic connection on the basis of the degree of similarity that exists between the marks bearing in mind the differences between them and the conceptual significance of Mrs Sood's mark compared to Cantine's mark with no conceptual significance at all. The opposition fails.

### **Costs**

30) Mrs Sood has been successful and is entitled to a contribution towards her costs. Mrs Sood has not, though, been professionally represented in these proceedings so I reduce by 50% what I may otherwise have awarded I hereby order Cantine Riondo S.P.A. to pay Mrs Renu Sood the sum of £700. This sum is calculated as follows:

Preparing a statement and considering the other side's statement  
£300

Filing evidence (which included making submissions) and considering the other side's evidence (and submissions)  
£400

31) The above sum should 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 23 day of February 2011**

**Oliver Morris  
For the Registrar,  
The Comptroller-General**

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<sup>10</sup> This is a relevant form of confusion – see *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*.