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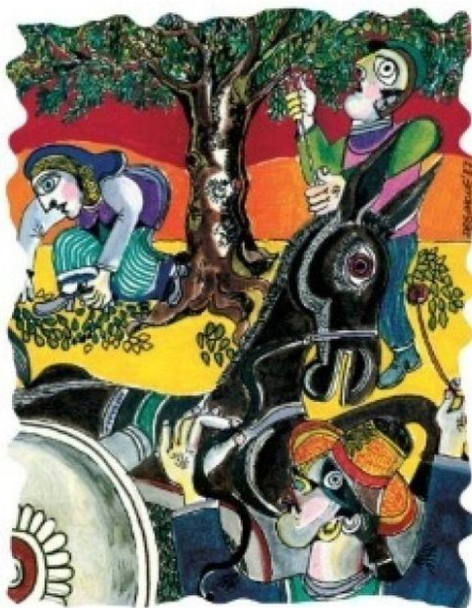
TRADE MARKS ACT 1994

IN THE MATTER OF UK DESIGNATION OF
INTERNATIONAL REGISTRATION

NO. WO0000001680109

BY CARMELA DI CARO S.R.L. SOCIETÀ CON UNICO SOCIO
FOR THE PROTECTION OF THE FOLLOWING TRADE MARK:

Rustico



IN CLASS 29

AND

OPPOSITION THERETO
UNDER NO. 439075 BY
CARAPELLI FIRENZE, S.P.A.

BACKGROUND & PLEADINGS

1. Carmela Di Caro S.r.l. Società con unico socio (“**the applicant**”) is the holder of the International Registration WO0000001680109 in respect of the mark shown on the front page of this decision with a UK designation date of 20 June 2022 (“**the contested mark**”). The following details were also entered on the designation:

Colours claimed: Yellow, red, orange, green, brown and white.

2. The designation was accepted and published in the Trade Marks Journal on 9 December 2022 for the following goods:

Class 29: Edible oils and fats.

3. On 7 February 2023, CARAPELLI FIRENZE, S.p.A. (“**the opponent**”) fully opposed the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)¹. The opponent is the proprietor of the UK registration number 917819954² for the following three-dimensional mark:

¹ The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM. As a result, the opponent’s earlier EUTM was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.



4. The opponent's mark was filed on 15 February 2018 and registered on 14 June 2018 for the following goods:

Class 29: Oils and fats.

5. The opponent in its notice of opposition claims that the contested mark is highly similar visually and phonetically to the opponent's mark. Also, it claims that the competing goods are identical, and there exists a likelihood of confusion.
6. In summary, the applicant filed a defence and counterstatement admitting that the competing goods are essentially identical while denying the rest of the claims made by the opponent.

Papers filed and Representation

The opponent's evidence

7. The opponent's evidence consists of a witness statement dated 8 July 2024 from Leona Walker, Chartered Trade Mark Attorney of the representative of the opponent in these proceedings. Ms Walker's

evidence is accompanied by 4 Exhibits (LMW1-LMW4). The evidence includes the extracts from the Collins English Dictionary entry on “RUSTICO”; the state of the register; definitions of olive oils; and examples of olive oil bottles available in the UK.

The applicant’s evidence

8. The applicant’s evidence consists of a witness statement dated 7 May 2024 from Jessica Vallis, a Chartered Trade Mark Attorney of the representative of the applicant. Mr Vallis’s evidence is accompanied by 17 Exhibits (JMV1-JMV17). The evidence is extensive and revolves around the get up of olive oil products and the use of the word “rustico” in relation to Italian food products, including olive oils. It includes screenshots of various olive oil products found in both online and physical supermarkets, highlighting products offered by the opponent and third-party traders. In addition, the evidence is focusing on the use of the terms “rustico,” “rustic,” and “rustica” in connection with a range of Italian food products, which can be found on restaurant menus, in UK supermarkets, and in the names of various restaurants in the UK. The evidence also includes an entry for ‘rustico’ from the Collins Italian-English Dictionary. Lastly, extracts from the state of the register are provided with the evidence.
9. Whilst I have read the evidence in full, I do not propose to reproduce or summarise it here but will refer to the salient points below, to the extent that it is considered appropriate.
10. The opponent filed written submissions on 16 February 2024 in these proceedings.
11. The matter came to be heard by me via video conference on 12 February 2025. The applicant was represented by Jessica Vallis of Beck Greener LLP. The opponent did not attend the hearing.

Preliminary Remarks

12. As mentioned above, I note that both parties have filed ‘state of the register’ evidence. The fact that there may be either a multitude of trade marks on the register with Class 29 goods that contain the word “RUSTICO” or similar words, such as “RUSTICA”, is not a relevant factor to the assessment of this present case. Although such evidence is admissible, the outcome of this opposition will be determined based on the merits of the case and the assessment of similarity between the marks at issue. The mere presence of these trade marks on the register cannot be said to demonstrate that there has or has not been confusion in the marketplace.³ Even though the applicant has provided screenshots with a printout date of either 5 March 2024 or 7 May 2024, which allegedly exemplify use of the registered marks under the registered goods, these postdate the relevant date for these proceedings (which is the designation date of the contested mark, being 20 June 2022). In any event, the state of the register is “irrelevant”⁴ to this assessment, and it is established that evidence of the state of the register is of little assistance or even “worthless”⁵ in the context of an opposition of this nature.

DECISION

Section 5(2)(b)

13. Section 5(2)(b) of the Act is as follows:

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

[...]

³ See *Zero Industry Srl v OHIM*, Case T-400/06.

⁴ (*BREXIT* (O/262/18) at [10]; *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305).

⁵ *Lifestyle Equities CV v Royal County of Berkshire Polo Club Ltd* [2022] EWHC 1244 (Ch).

(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”.

14. By virtue of its earlier filing date, the trade mark upon which the opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act. Further, as registration of the opponent’s earlier mark was completed less than five years before the designation date of the contested mark, proof of use is not relevant in these proceedings as per Section 6A of the Act.
15. The principles considered in this opposition stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):
 - 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

16. The opponent's goods are "*oils and fats*" in Class 29. The applicant's goods are "*edible oils and fats*" in Class 29. The applicant has accepted that the goods at issue are identical. I agree, and I note that although the earlier goods are not expressly referred to as edible, they are goods in Class 29, so it follows that they are edible. As such, the goods are self-evidently identical.

Average Consumer and the Purchasing Act

17. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

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

18. The goods at issue would be purchased and consumed by members of the general public. These are, for the most part, inexpensive goods purchased through primarily visual means, most often selected from shops or supermarket shelves or on their online equivalents. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Whilst the average consumer will

predominantly purchase them following a visual inspection, I do not discount aural recommendations. Given the primarily low cost of the goods, the level of care and attention paid when purchasing them will be no more than medium as the average consumer is likely to consider dietary requirements, flavour and/or nutritional information.

Comparison of Trade Marks

19. 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 Court of Justice of the European Union (“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.”

20. 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.
21. The marks to be compared are:

Opponent's Mark	Applicant's Mark
	

Overall Impression

22. There is disagreement between the parties as to the overall impression of the competing marks. Although I have taken into consideration their lengthy submissions, I do not propose to reproduce them here in full.
23. In summary, the applicant submits that the word element “CARAPELLI” in the earlier mark would be perceived as the main distinctive element and badge of origin together with the patterned glass bottle, which includes the words “CARAPELLI 1893” engraved at the bottom of it. At the hearing, Ms Vallis submitted that the word “RUSTICO” will communicate to the consumer that this is “a natural, authentic, unprocessed, rustic product”⁶ and that “this is unrefined, simple, unfiltered olive oil”⁷, while concluding that “it would just be seen as a descriptive element, descriptive of those qualities of the product itself, at least in the Opponent's mark, where it is

⁶ See page 5 of the transcript.

⁷ See page 6 of the transcript.

*clear that the other elements are meant to provide the trade mark value*⁸. She also highlighted in her skeleton argument that *“the red font on a brown bottle creates a muted effect, while the contrasting black font on the bottom label is more likely to draw the eye of the consumer.”* Conversely, the opponent submits that the dominant part of the earlier mark is the word “IL RUSTICO” due to its size and position in the bottle, while asserting that the shape of the bottle itself will be perceived *“as a mere functional feature”*.

24. The applicant has adduced evidence⁹ with which it makes various claims about the use of specific font and large capital letters on oil bottles, alleging that these are typically employed as descriptive elements for the respective products. It also provided images of oil bottles from third-party retailers sold in UK supermarkets,¹⁰ as well as close-up images depicting what are purported to be popular oil brands in the UK¹¹. Similarly, the opponent provided examples of olive oil bottles sold in the UK with its evidence.¹² Although I acknowledge that certain examples within the applicant’s evidence illustrate that the words in prominent font size could be descriptive elements, I note that there are also instances, such as with “FILIPPO BERIO” (which has been referenced by Ms Vallis in her witness statement as one of the two bestselling brands in the UK) where the descriptive words appear in a smaller font.¹³ Consequently, the evidence presented does not conclusively establish that there exists a standardised practice where font size is indicative of the characteristics or qualities of such products. On the contrary, the various pieces of evidence illustrate that different brands utilise a diverse range of font types, varying not only

⁸ See page 13 of the transcript.

⁹ See Exhibits JMV2, JMV7 and JMV15.

¹⁰ See Exhibit JMV1.

¹¹ See Exhibit JMV2.

¹² See Exhibit LMW4.

¹³ See Exhibit JMV2.

in size but also in typeface, and other stylistic elements on their packaging. Ultimately, the evidence fails to show how consumers perceive these various elements, nor does it indicate whether the presentation of such elements has become customary in the mind of consumers, particularly in relation to the earlier mark.

25. Further, the applicant has also submitted evidence regarding other olive oil products from the opponent, such as ‘the unfiltered extra virgin olive oil’,¹⁴ which features the same patterned bottle and colour schemes. Ms Vallis contended that the use of red font on the opponent’s olive oil bottles, as depicted in Exhibits JMV2, JMV7, JMV15, effectively communicates a key characteristic of the product. Even though I have to carry out a notional assessment by taking into account the marks before me, I note that the evidence put forth does not demonstrate how consumers are likely to perceive the presentation of the goods in the marketplace. As such, it is irrelevant to the assessment whether the opponent’s other products (including those exhibited with JMV7 and JMV15) or those from third-party traders employ red font to highlight the quality of their goods. Notably, the applicant has not provided any evidence to support the assertion that the black font used in the bottom label of the earlier mark in question will attract the consumers’ attention. Bearing all the above in mind, I will proceed to evaluate the overall impression of the competing marks in question.

26. The earlier mark is a three-dimensional mark, which is a graphic representation of a round brown bottle adorned with a pattern of diagonal lines/ribs,¹⁵ with verbal and non-verbal elements applied to it. The bottle features two labels. The top label consists of the prominent words “IL RUSTICO” in a standard typeface and in red upper case font on a beige background. The bottom label contains both word and figurative elements,

¹⁴ See Exhibit JMV7.

¹⁵ I have also taken into account that the mark is classified under the Vienna Classification for the following categories: “19.7.1 Bottles or flasks in circular or elliptical horizontal cross section; 19.7.2 Bottles or flasks in horizontal cross section other than circular or elliptical; 19.7.22 Bottles or flasks with vertical, horizontal or other ribs”.

similarly, on a beige background. The word element “CARAPELLI” appears larger than the words “CASA OLEARIA” and “FIRENZE 1893”, with the letter ‘C’ surrounding the letter ‘A’ emphasising its prominence. Whilst all the words appear in a standard typeface and a black upper case font, the word element “CARAPELLI” appears in a bold font. I note that an olive branch device sits on the top of the second ‘L’ letter in the word “CARAPELLI”, embellishing the right corner of the label. There are also the words “CARAPELLI 1893” engraved at the very bottom of the bottle.

27. While I consider that the shape of the bottle, including its pattern, may impact on the overall impression of the mark somewhat, it does not dominate the mark’s overall impression. Instead, I find that the words “IL RUSTICO” and “CARAPELLI” in the depicted bottle will dominate on the basis that they act as indicators of trade origin, with “IL RUSTICO” potentially denoting the product made by “CARAPELLI”. The top label will attract the most focus from the average consumer, primarily due to the position and prominence of the words “IL RUSTICO”, making it the most dominant element in the overall impression. Although the applicant claims that the word “RUSTICO” may be regarded as descriptive of the qualities of the goods, I disagree and will expound on this aspect later in this decision. As to the bottom label, the word “CARAPELLI” does not carry the same weight as “IL RUSTICO”, as it appears in a smaller font and occupies a smaller space in the mark, thus playing a lesser role in the overall impression. In considering the words “CASA OLEARIA” and “FIRENZE 1893” as potential indicators of trade origin, while they will play a role, it is my view that they will not signify trade origin, as they are comparatively the smallest elements in the mark, thereby contributing only minimally to the overall impression. Due to the somewhat limited legibility and placement at the bottom of the bottle, the engraved verbal elements “CARAPELLI 1893” will contribute minimally, if at all, to the overall impression. Lastly, the olive branch device will be seen as being descriptive of the goods, playing a minimal role in the overall impression.

28. The contested mark is a composite mark consisting of the slightly stylised word element “Rustico” and a figurative element, i.e. drawing. The word element “Rustico” is at the top of the mark, underlined, in title case and green. The letter ‘R’ is larger and has a descending leg beneath the letter ‘u’, with an olive device replacing the tittle in the ‘i’. Below the word element, there is a colourful drawing, which is prominent in size, depicting people gathering something from a tree with a horse at the centre. Whilst it is often the case that word elements of a mark have more impact on the overall impression, I note that, in this present case, the drawing is a significant part of the mark. Thus, the word element “Rustico” and the drawing make a roughly equal contribution to the overall impression, with both being equally dominant elements in the mark.

Visual Comparison

29. The earlier mark is a three-dimensional shape of a patterned bottle with two labels, which has no counterpart in the contested mark. Nevertheless, as mentioned above, the top label containing the words “IL RUSTICO” in the earlier mark will have the greatest weight in the overall impression. The competing marks share the identical word “RUSTICO”. The elements of the bottom label in the earlier mark are not present in the contested mark and, thus, are all points of visual difference. Also, the marks differ in the presence/absence of the graphic representation of a bottle and the figurative elements (i.e. drawing and olive/olive branch devices) together with the stylisation of the marks. Thus, considering the overall impression of the marks and weighing the various points of similarity and difference, I find the competing marks to be visually similar to a low degree.

Aural Comparison

30. In her oral submissions, Ms Vallis contended that “[t]here are just so many verbal elements to this mark that the phonetic comparison just does not

work.”¹⁶ However, I note that a slightly different argument is articulated in her skeleton argument as follows:

“Phonetically, there is no real risk of confusion, as it would be extremely unlikely for olive oil to be purchased or ordered by phone simply by one or two words. Nonetheless, taking account of the points raised above, and the fact that the Opponent’s Mark is not a word mark, it is reasonable to expect that the verbal elements will be noted in the order ‘CARAPELLI – IL RUSTICO – CASA OLEARIA – FIRENZE – 1893 – CARAPELLI 1893’. If the mark were to be spoken, it would most likely be shortened to simply ‘Carapelli’ as the most distinctive element. In either scenario, the average consumer can easily distinguish between this and the single word ‘Rustico’.”

During the hearing, I sought clarification from Ms Vallis on how the average consumer would be able to aurally distinguish the marks, given the presence of the common word element “RUSTICO” in the marks. In response, Ms Vallis asserted that the earlier mark would be shortened to the word element “CARAPELLI”, compared to the word element (“RUSTICO”) in the contested mark.

31. I disagree. Bearing in mind the weight of the shared word element in the overall impressions, the average consumer will articulate the word “RUSS-TI-KO” identically across the competing marks. I note that the word element “IL” precedes the word “RUSS-TI-KO” in the earlier mark being a point of aural difference. Further, the competing marks will differ in the presence/absence of the verbal element “CA-RA-PE-LLI”. Whilst there is no phonetic counterpart of the additional word elements “CASA OLEARIA”, “FIRENZE 1893” and the engraved word elements “CARAPELLI 1893” in the contested mark, I do not consider that the average consumer will attempt to articulate them, including the olive devices in the marks. This is due to their minimal role in the overall

¹⁶ See page 13 of the transcript.

impression, whereby the average consumer will focus on the dominant elements, “RUSS-TI-KO”/“IL RUSS-TI-KO” and “CA-RA-PE-LLI”, in the competing marks to refer to the goods. I also note that the drawing in the contested mark will not be verbalised. Consequently, I find that the marks are aurally similar to between a low and medium degree (though lower where the words “CASA OLEARIA” and “FIRENZE 1893” are spoken).

Conceptual Comparison

32. At the hearing, Ms Vallis submitted that the word “RUSTICO” will be understood to mean “*natural, authentic, unprocessed, rustic*”¹⁷. She also referred me to Exhibit JMV3, which includes a translated definition of “rustico” from the Online Collins Italian-English Dictionary together with the equivalent terms in other foreign languages (e.g. Portuguese, Spanish, French, German etc). Against this background, Ms Vallis argued that:

“There is no other way of saying the word “rustic”. It has to start with “rustic”, regardless of the ending. I think people will be able to understand that “rustico” and “rustic” mean the same thing. Even if they did not grasp that, it is inconceivable really that you would look at the word “Rustico” and not think “rustic”. It is just the word “rustic” with an “o” added on to the end...”.¹⁸

Further, Ms Vallis posited that even though consumers would not speak Italian, they are familiar with the term, which is well known to the public “*in relation to Italian food and particularly olive oils*”¹⁹. To that extent, Ms Vallis walked me through Exhibits JMV4-JMV17, which show instances of the words “rustic”, “rustico”, and “rustica” appearing in various Italian food products (including olive oils, pizzas, and bread) and in the names of restaurants. Ms Vallis concluded that “*there will be no concept conveyed*

¹⁷ See page 5 of the transcript.

¹⁸ Ibid.

¹⁹ See page 6 of the transcript.

by the word *RUSTICO* itself”²⁰. In this regard, I sought clarification on Ms Vallis’s position regarding whether the term “rustico” imparts any conceptual meaning, given that throughout her oral submissions she indicated that the term would be understood by the average consumer in light of the definitions she had provided. She clarified that the word “rustico” does indeed convey the aforementioned meaning, but it is to be regarded as being descriptive in both marks.

33. On the other hand, the opponent submitted that:

“The words “IL RUSTICO” and “CARAPELLI” are foreign words, and the UK consumer would not understand the meaning of either of these words. It is incorrect for the Applicant to state that the relevant consumer would know that the word “CARAPELLI” was a trade mark and that the words “IL RUSTICO” are there to indicate the quality of the oil. The relevant consumer, who would not have an understanding of the foreign language, would not know whether one of the words on the bottle was describing the contents of the bottle.”

I also note that the opponent with Exhibit LMW1 highlighted that there is no entry for the term “rustico” in the Online Collins English Dictionary.

34. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the General Court and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.
35. Whilst the shared word “RUSTICO” may be well known in Italy, the average consumer in this case is a member of the UK general public. I note that the applicant’s evidence is focusing on the use of words “rustic”, “rustico”, and “rustica” on various third-party goods or restaurant names associated with

²⁰ See page 12 of the transcript.

Italian food and/or oils. However, on this basis alone, I am unwilling to conclude that the entirety of the relevant public in the UK will be aware of and immediately grasp the meaning (or the structural connotation) of the term “RUSTICO”. Thus, it is my view that although a minority of consumers may be familiar with the term, this will not make up a significant proportion of consumers. Instead, I find that the majority of consumers will perceive it as a foreign word to which the UK public will attribute no particular meaning.²¹ Therefore, the conceptual interplay in relation to the common element is neutral.

36. The earlier mark also contains the word element “IL” preceding the word “RUSTICO” in the earlier mark, which could be recognised as ‘the’ in a foreign language, but no further meaning will be attributed to it. Further, the word element “CARAPELLI” is likely to be viewed as a foreign term or possibly a name devoid of a clear or retrievable concept. In addition, the earlier mark contains the words “CASA OLEARIA” and “FIRENZE 1893”, which play a minimal role in the overall impression. It is my view that although some consumers may recognise the word “CASA” as meaning ‘house’, others may not. Moreover, the average consumer would only extract the year from “FIRENZE 1893”. On the other hand, no immediate meaning will be attributed to the words “OLEARIA” and “FIRENZE”, which will likely be seen as foreign words. For completeness, I note that none of the word elements in the earlier mark will be viewed as forming a unit.
37. As to the contested mark, Ms Vallis submitted that the figurative element would stand out due to its striking nature. As noted earlier in this decision, the drawing will be conceptualised as a depiction of a horse and of people gathering something from a tree. Weighing all considerations, I find the marks’ conceptual position is that, overall, the marks are conceptually dissimilar (with the shared “RUSTICO” element being conceptually neutral).

²¹ See *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch).

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

39. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
40. The opponent has not provided any evidence of use of its mark, and therefore I only have the inherent distinctiveness of the mark to consider.

I have already made my findings above regarding both the overall impression of the earlier mark and the conceptual impression its elements are likely to convey. I bear in mind that only the common elements between the respective marks should be considered to evaluate the relevant distinctiveness; this is because *“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.”*²² The olive branch device will be descriptive of the goods. However, the rest of the verbal and non-verbal constituent elements of the graphic representation of the bottle, including its shape and pattern, will add to the distinctiveness of the mark. With respect to the word element “RUSTICO”, which is the only element that the competing marks have in common, it will be perceived by a significant proportion of the consumers as a foreign word having no identifiable meaning, with no suggestive or descriptive relevance to the goods. As such, I consider that it enjoys a high degree of distinctive character. Consequently, I find that the level of inherent distinctiveness of the mark as a whole will be high.

LIKELIHOOD OF CONFUSION

41. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa.²³ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater may be the likelihood of confusion. I must also keep in mind that the average consumer rarely has the

²² See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13.

²³ See *Canon Kabushiki Kaisha*, paragraph 17.

opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.²⁴

42. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
43. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis QC (as he then was) as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"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."

44. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., (as he then was) sitting as the Appointed Person, explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that

²⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.²⁵

45. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a

²⁵ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

46. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor QC (as he then was), sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.
47. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign “American Eagle”. In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Mr Mellor went on to say that, if there is no likelihood of direct confusion, “one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion”. I would prefer to say that there must be a proper

basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

48. Earlier in this decision I have concluded that:

- the competing goods at issue are identical;
- the average consumer of the goods will be members of the general public. The selection process is predominantly visual without discounting aural considerations, and the degree of attention will be no more than medium;
- the competing marks are visually similar to a low degree, aurally similar to between a low and medium degree (though aurally lower where the words “CASA OLEARIA” and “FIRENZE 1893” are spoken), while there is no conceptual similarity (with the shared “RUSTICO” element being conceptually neutral);
- the earlier mark has a high degree of inherent distinctive character.

49. Taking into account my findings earlier in this decision, I find that there is no likelihood of direct confusion for identical goods. Notwithstanding the principle of imperfect recollection, the average consumer would not overlook the presence/absence of the prominent and additional verbal and nonverbal elements by virtue of their position and size in the competing marks. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.

50. Turning now to indirect confusion, I bear in mind that there should be a “*proper basis*” for a finding of a likelihood of indirect confusion. The categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur. I also remind myself that a finding of indirect confusion should not follow merely because two marks share a common element or because one mark causes another to be called to mind. In the case before me, I find that the average consumer (or

a significant proportion thereof)²⁶ is likely to believe that identical goods come from the same or linked undertakings. Bearing in mind the principles set out in *Whyte and Mackay Ltd*, I note that the word elements “IL RUSTICO” and “CARAPELLI” in the earlier mark, acting as indicators of trade origin, each will have a distinctive significance which is independent of the significance of the whole. I also note that the various other elements of the competing marks are unconnected, and the word element “IL” in the earlier mark may be overlooked due to imperfect recollection. The common element, “RUSTICO”, is highly distinctive and does not have a meaning for the majority of consumers. This is important because, as observed by Arnold J. (as he then was) in *Whyte and Mackay Ltd*,²⁷ if the only similarity between the competing marks arises from an element which has low distinctiveness, that points away from a likelihood of confusion. However, the opposite applies in the present case since the common element is of high distinctiveness. In this respect, the average consumer will see that the contested mark “*is different from the earlier mark, but also has something in common with it*”²⁸ and that that common element also has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the similarity of that sign to the earlier mark. Therefore, this would lead them (or a significant proportion thereof) to conclude that the differences in the marks are attributable to perhaps being an updated version of the earlier mark and, therefore, indicative of re-branding. I consider that it is not uncommon for undertakings to re-brand themselves from time to time to accommodate changes in marketing considerations. There is, therefore, a likelihood of indirect confusion between the marks in respect of such goods.

²⁶ See *Interflora Inc & Anor v Marks and Spencer Plc* [2014] EWCA Civ 1403 at [129].

²⁷ See paragraph 44 of the judgement.

²⁸ *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, paragraph 16.

OUTCOME

51. The opposition succeeds, and, subject to any successful appeal against this decision, the application will be refused.

COSTS

52. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 1/2023. I award costs as follows:

Official fee	£100
Preparing a statement and considering the other side's statement	£250
Preparing evidence and considering and commenting on the other side's evidence	£350
Filing submissions	£500
Total	£1,200

53. I, therefore, order Carmela Di Caro S.r.l. Società con unico socio to pay to CARAPELLI FIRENZE, S.p.A. the sum of £1,200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 30th day of April 2025

Dr Stylianos Alexandridis

For the Registrar,

The Comptroller General