

O-221-16

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL REGISTRATION NO. 1248227

IN THE NAME OF NACHTMANN GMBH

TO REGISTER:

Vivino

IN CLASS 21

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 404825 BY KAUFLAND WARENHANDEL GMBH & CO. KG**

BACKGROUND & PLEADINGS

1. On 28 March 2015, claiming an International Convention priority date of 27 February 2015 from an earlier filing in Germany, Nachtmann GmbH (“the applicant”), requested protection in the United Kingdom of the International Registration (“IR”) of the trade mark shown on the cover page of this decision. The United Kingdom Trade Marks Registry (“TMR”) considered the request satisfied the requirements for protection and particulars of the IR were published on 5 June 2015 for the following goods in class 21:

Glassware, porcelain and earthenware, not included in other classes; drinking glasses, mugs, bowls, plates, crockery, vases, pitchers, bottles, wine decanters and candelabras, all the aforesaid goods, included in this class.

2. The designation of the IR is opposed by Kaufland Warenhandel GmbH & Co. KG (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”); the opposition is directed against all of the goods in the IR. Although the opponent relies upon all of the goods in the two IRs designating the European Union (“EU”) shown below, it is only necessary for me to refer to the goods in class 21:

No. 1241464 for the trade mark: **VAVIENO** which designated the EU on 13 May 2014 (claiming an International Convention priority date of 15 November 2013 from an earlier filing in Germany) and which was granted protection in the EU on 9 February 2016:

Glassware, porcelain and earthenware, included in this class; pots; pans; kitchen utensils; dishes (household utensils); serving platters; mugs, bottle openers; bone china; crystal goods; bottles; dishes, bread boards; bread baskets and bread bins; cabarets (trays), cake moulds; waffle moulds; baking moulds; baking tins; baking mats; juicers (non-electric); baskets for domestic use; graters for kitchen use; candle extinguishers, candle rings; candlesticks; tins for sweets; goods of bone china; chopsticks; coasters (table utensils); cocktail mixers; coffee filters; coffee grinders; coffee percolators; coffee services, coffee pots; cooking skewers; ice buckets; portable coolers, isothermic bags and cooling boxes; food cooling devices containing liquids for household purposes; corkscrews; cups; cutting boards for the kitchen; decanters; drinking bottles; glasses, containers; egg cups; goblets; graters; insulating jars; heat-insulated pots; ice cube moulds; pitchers and jugs; knife rests; lazy susans; liqueur sets; food containers; menu card holders; mixing spoons; napkin holders; napkin rings; paper plates; pastry cutters; salt mills and pepper grinders; salt shakers; pepper pots; saucers; spice sets; strainers; tableware; tankards; round tea infusers; tea caddies; tea infusers; tea services; teapots; toothpick holders, not of precious metals; toothpicks; trays for household purposes; trivets; thermally insulated flasks (insulating flasks); vases; works of art of porcelain, terracotta or glass; decorative ornaments for windows and doors of ceramic, bone china, glass, crystal, earthenware, terracotta or porcelain; fresh storage boxes or containers or food storage boxes or containers (except those of precious metal); refrigerating bottles; glass containers; butter dishes; butter dish covers; portable isothermic bags and boxes,

non-electric; cookie jars; coffee tins; insulating flasks; shakers (mixers); tea strainers, not of precious metal; cruet stands for household purposes; spice racks; cocktail shakers; cocktail stirrers; disposable table plates; canteens (portable water bottles); straws for drinking; paper and plastic cups; tea cosies; milk jugs and cream jugs; carafes; cocktail sticks; kitchen utensils, in particular cake servers and cake slicers, salad servers, ladles, spatulas (food turners), spatulas (scrapers), mixing spoons, sauce spoons, spaghetti spoons, spaghetti portions; basting ladles; whisks, non-electric; garlic presses, hand operated; étagères (serving stands); bottle coolers and champagne buckets; vacuum jugs; pot holders; oven gloves; tins of enamel, earthenware, ceramic, bone china; knife blocks (empty); table refuse bins; cheese dish covers; stove top cover boards; confectioners' decorating bags (pastry bags); brushes (except for painting); cookie (biscuit) cutters; cream dispensers; hand tools for grinding and pressing of fruit; jar openers; cans not of metal; sugar sprinklers; all aforementioned goods included in this class.

No. 1241464 for the trade mark:



which designated the EU on 13 may 2014 (claiming an International Convention priority date of 15 November 2013 from an earlier filing in Germany) and which was granted protection in the EU on 11 February 2016:

Glassware, porcelain and earthenware, included in this class; pots; pans; kitchen utensils; dishes (household utensils); serving platters; mugs, bottle openers; bone china; crystal goods; bottles; dishes, bread boards; bread baskets and bread bins; cabarets (trays), cake moulds; waffle moulds; baking moulds; baking tins; baking mats; juicers (non-electric); baskets for domestic use; graters for kitchen use; candle extinguishers, candle rings; candlesticks; tins for sweets; goods of bone china; chopsticks; coasters (table utensils); cocktail mixers; coffee filters; coffee grinders; coffee percolators; coffee services, coffee pots; cooking skewers; ice buckets; portable coolers, isothermic bags and cooling boxes; food cooling devices containing liquids for household purposes; corkscrews; cups; cutting boards for the kitchen; decanters; drinking bottles; glasses, containers; egg cups; goblets; graters; insulating jars; heat-insulated pots; ice cube moulds; pitchers and jugs; knife rests; lazy susans; liqueur sets; food containers; menu card holders; mixing spoons; napkin holders; napkin rings; paper plates; pastry cutters; salt mills and pepper grinders; salt shakers; pepper pots; saucers; spice sets; strainers; tableware; tankards; round tea infusers; tea caddies; tea infusers;

tea services; teapots; toothpick holders, not of precious metals; toothpicks; trays for household purposes; trivets; thermally insulated flasks (insulating flasks); vases; works of art of porcelain, terracotta or glass; decorative ornaments for windows and doors of ceramic, bone china, glass, crystal, earthenware, terracotta or porcelain; fresh storage boxes or containers or food storage boxes or containers (except those of precious metal); refrigerating bottles; glass containers; butter dishes; butter dish covers; portable isothermic bags and boxes, non-electric; cookie jars; coffee tins; insulating flasks; shakers (mixers); tea strainers, not of precious metal; cruet stands for household purposes; spice racks; cocktail shakers; cocktail stirrers; disposable table plates; canteens (portable water bottles); straws for drinking; paper and plastic cups; tea cosies; milk jugs and cream jugs; carafes; cocktail sticks; kitchen utensils, in particular cake servers and cake slicers, salad servers, ladles, spatulas (food turners), spatulas (scrapers), mixing spoons, sauce spoons, spaghetti spoons, spaghetti portions; basting ladles; whisks, non-electric; garlic presses, hand operated; étagères (serving stands); bottle coolers and champagne buckets; vacuum jugs; pot holders; oven gloves; tins of enamel, earthenware, ceramic, bone china; knife blocks (empty); table refuse bins; cheese dish covers; stove top cover boards; confectioners' decorating bags (pastry bags); brushes (except for painting); cookie (biscuit) cutters; cream dispensers; hand tools for grinding and pressing of fruit; all aforementioned goods included in this class; jar openers; cans not of metal; sugar sprinklers.

3. The applicant filed a counterstatement in which the basis of the opposition is denied. It does, however, admit that its goods "are identical or at least similar to the opponent's goods in class 21."

4. Although neither party filed evidence, the applicant filed written submissions during the course of the evidence rounds. Whilst neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing. I will bear all of these submissions in mind and refer to them, as necessary, later in this decision.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(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."

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

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

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

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

7. In these proceedings the opponent is relying upon the two trade marks shown in paragraph 2 above, both of which qualify as earlier trade marks under the above provisions. As neither of these trade marks completed their registration process more than 5 years before the publication date of the IR in suit they are not subject to proof of use, as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods it has identified.

Section 5(2)(b) – case law

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

The principles:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The opponent's best case

9. In its submissions, the opponent states:

“As the closer of the two trade mark is the word registration, we focus in these submissions on that mark...”

10. As I agree with the opponent that it is the word only trade mark that offers it the best prospect of success, it is upon this trade mark that I will conduct the comparison.

Comparison of goods

11. In its submissions, the applicant admits that the competing goods are “identical or at least highly similar.” In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

12. The competing specifications can be seen above. As “Glassware, porcelain and earthenware”, “mugs”, “vases”, “pitchers” and “bottles” appear in both parties’ specifications, these goods are literally identical. As “drinking glasses”, “plates” and “wine decanters” in the applicant’s specification would be included within the more general phrases “glasses”, “paper plates” and “decanters” respectively in the opponent’s specification, these goods are identical on the principle outlined in *Meric*. Similarly, as “bowls” and “crockery” in the application may be made of, for example, “porcelain” and “earthenware” and as “candelabras” in the application may be made of, for example, “glass”, these goods are identical to “glassware, porcelain and earthenware” in the opponent’s specification on the *Meric* principle.

The average consumer and the nature of the purchasing act

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

14. The average consumer of the identical goods at issue is a member of the general public. As my own experience tells me that such goods are typically selected from the shelves of a bricks and mortar retail outlet (such as a supermarket or department store) or from the equivalent pages of a website, visual considerations are likely to dominate the selection process. As the goods at issue may, however, also be the subject of word-of-mouth recommendations or oral requests (both in store and by telephone), I must not lose sight of the fact that aural considerations will also play their part. As to the degree of care that the average consumer will exercise during the purchasing act, once again my own experience tells me that the cost of the identical goods at issue can vary widely (from a few pounds for a mug for every-day use to many thousands of pounds for a set

of crockery). While the degree of attention paid to the former will be low and the latter high, when considered in relation to the goods at issue whose price falls within those two extremes, as the average consumer will still be considering factors such as size, material, colour and compatibility with existing items, I would expect them to pay an average degree of attention to their selection.

Comparison of trade marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

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

Opponent's trade mark	Applicant's trade mark
VAVIENO	ViVino

17. As the opponent's trade mark consists of a single word presented in upper case no part of which is highlighted or emphasised in any way that is the overall impression it will convey.

18. The applicant's trade mark consists of six letters presented in a bold typeface; the first and third letters are in upper case and the remaining letters are in lower case. In its submissions filed during the evidence rounds, the applicant stated:

“VIVINIO is also an invented word coined by the applicant. However, VINO is a word meaning or referring to “wine.” VINO is a word which is widely recognised and its meaning understood by the average consumer in the United Kingdom.”

In its submissions filed in lieu of attendance at a hearing, the applicant states:

“The word VINO, which is widely understood as an informal word for wine, is a dominant and recognisable part of the applicant’s trade mark. The pre-fix VI almost serves to emphasise the following word VINO. It is arguable that the VI part will go relatively unnoticed by the average consumer and that the applicant’s trade mark will be perceived as a VINO mark and its/concept meaning will therefore be immediately perceived by the average consumer.”

In its submissions, the opponent states:

“...it is unlikely that consumers would break the mark down into its alleged constituent parts VI and VINO. Rather the mark is likely to be perceived as a whole invented word...”

19. As the average consumer in this country is most likely to read from left to right, I see no reason why the letters “Vi” in its trade mark may, as the applicant suggests, “go relatively unnoticed.” I do, however, accept that the presentation of its trade mark i.e. in which the first and third letters are presented in upper case, is likely (given the type of goods for which registration is sought), to result in a not insignificant number of average consumers recognising that the last four letters spell the word “Vino” (which I accept the average consumer will be very familiar with as an informal word meaning wine). In those circumstances, the “Vino” element may have a greater relative weight in the overall impression the applicant’s trade mark conveys. However, if, despite its presentation, the average consumer construes the applicant’s trade mark as “a whole invented word” as the opponent suggests (which in my view is equally likely), that is the overall impression it will convey.

Visual comparison

20. The competing trade marks consist of six and seven letters respectively. The letters “V”, “V”, “I/i” appear in the first, third and fourth letter positions in both trade marks and the letters “O/o” appear at the end of the competing trade marks. In addition, both trade marks contain a letter “N/n”, albeit in slightly different positions (the sixth and fifth letter positions respectively). They differ to the extent that the opponent’s trade mark contains a letter “A” in the second letter position (whereas the applicant’s trade mark contains a letter “i” in these same position and the opponent’s trade mark contains a letter “E” in the fifth letter position). Keeping in mind the manner in which the applicant’s trade mark is presented and balancing the similarities and differences I have identified, results, in my view, in at least a medium degree of visual similarity between them.

Aural comparison

21. In its submissions filed during the evidence rounds, the applicant states:

“The phonetic pattern and rhythm of the marks is different. The beginning of each mark is highly dissimilar phonetically – VIV/VAV, and the second part of each mark is again highly dissimilar – IN/IENO. Overall the marks are in their entirety phonetically dissimilar.”

And in its submissions filed in lieu of a hearing:

“Phonetically the “A” and “IE” parts of the mark VAVIENO have a strong and distinctive sound which serves to further distinguish the mark VAVIENO from VIVINO.”

In its submissions, the opponent states:

“With regard to the aural comparison, neither mark is a dictionary word or established in common parlance so the pronunciation of both marks will be determined by individual consumers on an *ad hoc* basis.

It is likely that the first letter “i” in the mark applied for would be pronounced using a short “i” sound (as in “tin”) and the second letter “i” with a longer “ee” sound: V-I-V-EE-NO.

With regard to the earlier mark VAVIENO, the combined letters IE could be sounded as either a long “ee” sound (as in “piece”), or a short “i-yuh” sound as in “pier”. Similarly, the “a” in the earlier mark could be pronounced as either a hard “a” (as in “pad”) or a softer “uh” sound (as in “Bavarian”). The earlier mark VAVIENO could therefore be pronounced in four different ways: V-UH-V-EE-NO, V-A-V-EE-NO, V-UH-V-IYUH-NO, V-A-V-IYUH-NO.

As none of the possible pronunciations of the earlier mark is obviously preferable to the others, we contend consumers are just as likely to adopt any one of them. Whilst all the possible pronunciations are closely similar to [that of the applicant’s trade mark], the first proposed pronunciation V-UH-V-EE-NO renders the mark almost aurally indistinguishable from the applied for V-IV-EE-NO.”

22. I agree with the opponent that the pronunciation of the competing trade marks is difficult to predict and will vary from consumer to consumer. In my view, the applicant’s trade mark is, most likely, to be pronounced as VIV-EE-NO whereas the opponent’s trade mark is most likely to be pronounced as VAV-E-A-NO. However even if I am wrong in this regard, the fact that both trade marks differ by only one syllable and begin and end in a similar fashion, is likely to result in (at least) a no lower than medium degree of aural similarity between them.

Conceptual similarity

23. In its submissions filed during the evidence rounds, the applicant states:

“The mark VAVIENO has no meaning in the English language, it is a word coined by the opponent.”

By reference to the letters “Vino” appearing in its trade mark, the applicant states:

“...the applicant’s mark VIVINO will convey a meaning and concept to the average consumer evoking the idea that the mark and related goods refer to “wine”. The opponent’s mark has no such meaning and therefore conceptually the respective marks are highly dissimilar.”

In its submissions, the opponent states:

“Although both marks are invented words with no particular meaning for relevant consumers, they both have a similar Spanish or Italian “feel” to them, which leads to a degree of conceptual similarity. Otherwise, the conceptual position between the marks is neutral and neither weighs in favour of nor against a likelihood of confusion.”

24. Even if the opponent is correct and both trade marks convey a similar “Spanish or Italian “feel”, that is, in my view, too flimsy a basis upon which to establish a similarity in concept between them. In my view, the opponent’s trade mark will convey no conceptual message to the average consumer. As to the applicant’s trade mark, I have already concluded it may be seen in one of two ways. For those average consumers who construe it as a “whole invented word”, it will convey no meaning and the conceptual position is neutral. However for those average consumers who recognise that it contains the word “Vino”, that will create a concrete conceptual message which is absent from the opponent’s trade mark.

Distinctive character of the earlier trade mark

25. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

26. As I mentioned above, the applicant accepts that the earlier trade mark consists of a word coined by the opponent with no meaning in the English language. As I agree with

that conclusion, it follows that the earlier trade mark is possessed of a high degree of inherent distinctive character.

Likelihood of confusion

27. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded, *inter alia*, that:

- The competing goods are identical;
- The average consumer is a member of the general public who will select the goods by predominantly visual means (but not to the extent that aural considerations can be ignored) and will typically pay an average degree of attention whilst doing so;
- The overall impression created by the opponent's trade mark is of a single word;
- If the average consumer recognises that the applicant's trade mark contains the word "Vino", it may have a greater relative weight in the overall impression the trade mark conveys, whereas for some average consumers the applicant's trade mark will be construed as a single word;
- The competing trade marks are visually and aurally similar to a medium degree;
- If the average consumer recognises that the applicant's trade mark contains the word "Vino" it will send a concrete conceptual message which is absent from the opponent's trade mark; if they do not, the conceptual position is neutral;
- The opponent's trade mark is possessed of a high degree of inherent distinctive character.

28. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

"20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities

between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

29. In *Nokia Oyj v OHIM*, Case T-460/07, the GC stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

30. Given its presentation and the goods for which registration is sought, I have no doubt that a not-insignificant number of average consumers will identify that the applicant’s trade mark contains the word “Vino”. For those average consumers, this conceptual message is, in my view, likely to be sufficient to “counteract the visual and phonetic similarities” between the competing trade marks and in so doing will avoid a likelihood of confusion.

31. However, within the average consumer group there will, in my view, be a similarly not insignificant group who treat the applicant’s trade mark as a single invented word and accord no significance to the word “Vino” within it. For those average consumers there will be no conceptual “hook” to assist them to distinguish between the competing invented words, words which I have already concluded, are visually and aurally similar to a medium degree. This is important, because the opposition may still succeed if a sufficiently significant percentage of relevant consumers (which may not necessarily be the majority of consumers) are confused. To illustrate the point, in *J.W.Spear & Sons Ltd and Others v Zynga Inc.* [2015] EWCA Civ 290, Floyd L.J. summed up the Court of Appeal’s earlier judgment in *Interflora Inc. and another v Marks and Spencer plc* [2014] EWCA Civ 1403 like this:

“37. In relation to what the court described as the crucial question, namely whether the average consumer, as a hypothetical person, necessarily has a single reaction and so precludes a consideration of the perceptions of a proportion of the relevant public the court in *Interflora* identified the following propositions:

i) the average consumer test provides the court with a perspective from which to assess the particular question it has to decide, for example whether a statement is liable to mislead purchasers.

ii) a national court may be able to assess this question without the benefit of a survey or expert evidence.

iii) a national court may nevertheless decide, in accordance with its own national law, that it is necessary to have recourse to an expert’s opinion or a survey for the purpose of assisting it to decide whether the statement is misleading or not.

iv) absent any provision of EU law dealing with the issue, it is then for the national court to determine, in accordance with its own national law, the percentage of consumers misled by the statement that, in its view, is sufficiently significant in order to justify banning its use.”

32. I remind myself that identical goods are involved. Having done so, the average degree of attention that will be paid during the selection process is not, in my view, sufficient to avoid the very real likelihood that a “sufficiently significant” percentage of average consumers will, in the absence of a conceptual hook to assist them, imperfectly recall one trade mark for the other, which in turn will lead to a likelihood of direct confusion.

33. For the sake of completeness, I should point out that in reaching the above conclusion, I have not overlooked either the applicant’s “state of the register” evidence or its references to two other decisions of this Tribunal. Suffice to say that “state of the register” evidence is rarely of assistance (that being the case here) and my decision in these proceedings must be based on the facts and submissions as they relate to the trade marks at issue rather than by analogy with different trade marks.

Conclusion

34. The opposition has succeeded and, subject to any successful appeal, the application will be refused.

Costs

35. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the other side’s statement:	£200
Fling of written submissions:	£300
Official fee:	£100
Total:	£600

36. I order Nachtmann GmbH to pay to Kaufland Warenhandel GmbH & Co. KG the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4th day of May 2016

C J BOWEN
For the Registrar
The Comptroller-General