

**DECISION
of the Second Board of Appeal
of 26 February 2018**

In case R 1207/2017-2

J. Garcia Carrion, S.A.

Carretera de Murcia, s/n
30520 Jumilla (Murcia)
Spain

Opponent / Appellant

represented by Carlos Aymat Escalada, Hortaleza, 37, 28004 Madrid, Spain

v

Sandrone Luciano

via Pugnane 4
12060 Barolo
Italy

Applicant / Defendant

represented by Antonio Borra, via Assietta 27, 10128 Torino, Italy

APPEAL relating to Opposition Proceedings No B 2 609 744 (European Union trade mark application No 14 416 598)

THE SECOND BOARD OF APPEAL

composed of S. Stürmann (Chairperson), C. Negro (Rapporteur) and S. Martin (Member)

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 27 July 2015, the individual company, Sandrone Luciano ('the applicant') sought to register the word mark

Luciano Sandrone

for the following list of goods and services:

Class 16 – Gums [adhesives] for stationery or household purposes; paper and cardboard; stationery and educational supplies; decoration and art materials and media; filtering materials of paper; money holders; disposable paper products; works of art and figurines of paper and cardboard, and architects' models; bags and articles for packaging, wrapping and storage of paper, cardboard or plastics;

Class 33 – Alcoholic beverages (except beer); preparations for making alcoholic beverages;

Class 35 – Business assistance, management and administrative services; business analysis, research and information services; commercial trading and consumer information services; advertising, marketing and promotional services.

- 2 The application was published on 18 August 2015.
- 3 On 16 November 2015, J. Garcia Carrion, S.A. ('the opponent') filed an opposition against the registration of the published trade mark application for part of the goods and services, namely all goods in Class 33.
- 4 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 5 The opposition was based on the following earlier right:
 - European trade mark registration No 2 211 357 for the word mark

DON LUCIANO

filed on 27 April 2001, registered on 5 July 2002 and duly renewed for among others the following goods on which the opposition is based:

Class 33 – Alcoholic beverages (except beer).

- 6 The applicant requested that the opponent submit proof of use of the earlier mark on which the opposition was based. The opponent submitted documents as evidence of use.
- 7 By decision of 12 April 2017 ('the contested decision'), the Opposition Division rejected the opposition in its entirety and ordered the opponent to bear the costs. It gave, in particular, the following grounds for its decision:

- The contested ‘alcoholic beverages (except beer)’ are identically contained in both lists of goods.
- The contested ‘preparations for making alcoholic beverages’ are similar to a low degree to the opponent’s ‘alcoholic beverages (except beer)’. They can be found in the same distribution channels, they can be produced by the same providers and they target the same relevant public.
- The goods found to be identical or similar to a low degree are directed at the public at large and at business customers with specific professional knowledge or expertise. The degree of attention is considered to be average.
- Conceptually, the common element ‘Luciano’ is a relatively well-known Italian first name that will be recognized as such by the public, thanks in particular to the well-known Italian tenor Luciano Pavarotti. Consequently, the contested mark, ‘Luciano Sandrone’, will be perceived by consumers as a combination of a first name and a surname. Since first names may belong to a great number of people who do not have anything in common, the degree of distinctiveness of this element is lower than the other word in the contested mark, which will be recognized as a surname, and, as such, has a higher intrinsic value.
- The element ‘DON’ in the earlier mark is a Spanish title noun standing for ‘Sir/Mister’ that will also be recognized as such by the public in the relevant territory especially when it is followed by a first name.
- In view of the above, the signs are conceptually similar to a low degree.
- Visually and aurally, the signs coincide in the word ‘LUCIANO’, and in its corresponding sound, but differ in the additional words ‘DON’ of the earlier mark and ‘SANDRONE’ of the contested sign and in their sounds.
- The opponent argues that the word ‘DON’ is entirely reproduced in the surname ‘SANDRONE’. However, since the alphabet is made up of a limited number of letters, which, moreover, are not all used with the same frequency, it is inevitable that many words will share some of them, but they cannot, for that reason alone, be regarded as visually or aurally similar.
- Since the coincidence between the signs lies in a first name which intrinsic distinctive character is lower than surnames, the signs are visually and aurally similar to a low degree.
- The inherent distinctiveness of the earlier mark must be seen as normal.
- Even if the contested goods have been found to be identical and similar to a low degree to the opponent’s goods, the signs are visually, aurally and conceptually similar to a low degree. The mere coincidence in an element that will clearly be recognized by consumers as a first name is not, per se, particularly conclusive. This is particularly true when, in the contested sign, the first name is followed by an element that will be recognized as a surname, intrinsic distinctive character of which is automatically higher. As a direct consequence, consumers will not focus as much attention on the first name,

but rather on the surname. This difference is of a particular importance since it puts conceptual distance between the signs and will therefore help consumers to differentiate them.

- It is not likely that consumers, even when displaying an average degree of attention, would be misled as regards the commercial origin of the goods assumed to be identical merely because of the coincidence in a first name.
 - The opponent refers to previous decisions of the Office to support its arguments, in particular to Opposition Division decision No B 2 242 009. However, the Office is not bound by its previous decisions as each case has to be dealt with separately and with regard to its particularities.
 - The previous Opposition Division decision No B 1 873 341, referred to by the opponent, is not relevant to the present proceedings because, for the Spanish-speaking part of the public, the common verbal element ‘SERRA’ is a surname and, as such, has a higher intrinsic value.
 - Given that the opposition is not well founded under Article 8(1) EUTMR it is unnecessary to examine the evidence of use filed by the opponent.
- 8 On 6 June 2017, the opponent filed an appeal against the contested decision in its entirety. The statement of grounds of the appeal was received on 2 August 2017.
- 9 On 2 October 2017, the applicant filed its observations in reply.

Submissions and arguments of the parties

- 10 The arguments raised in the statement of grounds may be summarised as follows:
- The signs coincide in the word ‘LUCIANO’ and although they differ in the other word, the element with greater phonetic force is ‘LUCIANO’.
 - The contested decision mentions that the signs have a low degree of visual and aural similarity. This is contested. Of the two words that compose the marks, one is the same (‘Luciano’), and all the letters of ‘don’ are included in the second word of the contested mark ‘sanDrONE’.
 - ‘Luciano’ is placed at the beginning of the contested mark. Consumers generally tend to focus on the first element of a sign when being confronted with a trade mark.
 - The contested decision states that the common element ‘LUCIANO’ is a relatively well-known Italian first name. This conclusion is only an assumption. However, it will only be considered this way by the Italian public. The non-Latin consumer will see two marks with a high degree of similarity.
 - Conceptually, neither of the signs has a meaning for the public in other territories. The risk of confusion with respect to only one part of the public of the EU is sufficient.

- The difference of the other words of the marks does not avoid the similarity of the signs compared. The phonetic difference can be blurred in noisy environments such as bars or restaurants.
- The words ‘Luciano Sandrone’ are fanciful terms which do not refer to a name or a surname for many consumers, such as, for example, German or Greek consumers. For them the degree of similarity between the signs is high.
- The goods are identical or similar; the marks display a high degree of phonetic and visual similarity, due to the coincidence of the first element ‘Luciano’ and conceptually none of the signs has a meaning.
- The differences between the signs are not sufficient to counter the similarities between them, so that the consumer can conclude that the signs referred to in respect of identical or similar products have the same business origin, taking into account the principle of interdependence. In addition, the relevant public may associate the marks and consider that the contested sign refers to a new line of products of the same company which shares with the earlier mark an identical initial element in common ‘Luciano’, which will not relate to a proper name.

11 The arguments raised in reply to the appeal may be summarised as follows:

- The dominant element in the marks is not the word ‘Luciano’. The Opposition Division applied a consolidated case-law principle, whereby the first name ‘Luciano’ must be excluded as a distinctive and dominant element of the contested mark.
- Consumers attribute greater attention to family names (surnames) than they do to first names insofar as the variety of family names is more varied (01/03/2005, T’185/03, Enzo Fusco). Consumers would only focus their attention on the first name in the event that it is really special.
- Moreover, in the wine sector, a family name acquires considerable importance. It is customary to indicate a winery or a vineyard from which the produce originates by a family name.
- In 2009 J. Garcia Carrion S.A. (the opponent) filed an opposition (No B 1 472 929) against the registration of the EUTM registration ‘LUCIANO ARDUINI’ (No 7 254 014) in Classes 29, 32 and 33. That opposition is identical to the one being brought against the contested mark and it was based on the same preceding trade marks and on the same defensive arguments. The Opposition Division rejected the arguments presented by J. Garcia Carrion, S.A. and declared the opposition unfounded.
- ‘SANDRONE’ and ‘DON LUCIANO’ products are different wines. The former have a shelf price that commences from EUR 70 per bottle while the latter have a price of EUR 2/3 per bottle. They are marketed with very different labels that exclude any risk of confusion.
- The applicant applied for the contested mark on the basis of the indications provided by the Opposition Division in the decision that granted opposition

No B 2 242 009. With its ruling of 17 April 2015 the Opposition Division held that the signs ‘DON LUCIANO’ and ‘SANDRONE LUCIANO’ would be confused by the public because the wording ‘LUCIANO’ occupies a second position in both marks. According to the Opposition Division this would be of crucial importance as the relevant public would perceive the word ‘LUCIANO’ as a surname in both marks. For this reason, the applicant applied for the EUTM registration ‘LUCIANO SANDRONE’ - taking due account of the Opposition Division’s indications and placing the name ‘LUCIANO’ as the first word – thus, all risks of confusion between the two marks have been eliminated. Consequently, the reasons cited in the proceeding No B 2 242 009 which upheld the opposition by J. Garcia Carrion S.A cannot apply to the case at hand.

Reasons

- 12 All references made in this decision should be seen as reference to the EUTMR 2017/1001 (OJ L 154, 16.6.2017, p. 1), codifying EUTMR 207/2009 as amended, unless specifically stated otherwise in this decision.
- 13 According to Article 80 EUTMDR, the CTMIR and BoA RoP were repealed. However, as a transitional measure, Article 80 foresees that the CTMIR and BoA RoP shall continue to apply to ongoing proceedings until such proceedings are completed, provided that the EUTMDR does not apply in accordance with Article 81 thereof. According to Article 81(2)(d), in the present case the CTMIR has to be applied.
- 14 The appeal complies with Articles 66, 67 and 68(1) EUTMR. It is, therefore, admissible.

Proof of use

- 15 The Opposition Division held that given that the opposition was not well founded under Article 8(1)(b) EUTMR it was unnecessary to examine the evidence of use filed by the opponent.
- 16 However, considering that the assessment of proof of use is a pre-requisite to the assessment of the likelihood of confusion, the Board considers that it is necessary to examine first whether genuine use of the earlier mark was proven.
- 17 The opposition was filed on 16 November 2015. Consequently Article 47(2) and (3) EUTMR is applicable in its version of Regulation 207/2009.
- 18 In accordance with Article 47(2) and (3) EUTMR (in the version in force at the time of filing of the opposition), if the applicant so requests, the opponent must furnish proof that, during the five-year period preceding the date of publication of the contested trade mark, the earlier trade mark has been put to genuine use in the territories in which it is protected in connection with the goods or services for which it is registered and which the opponent cites as justification for its opposition, or that there are proper reasons for non-use. The earlier mark is

subject to the use obligation if, at that date, it has been registered for at least five years.

- 19 There is genuine use of a trade mark where the mark is used in accordance with its essential function as a trade mark, which is to guarantee the identity of the origin of goods or services for which it is registered, in order to create or preserve an outlet for those goods and services; genuine use does not include token use for the sole purpose of preserving the rights conferred by the mark (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 43). Moreover, the condition relating to genuine use of the trade mark requires that the mark, as protected on the relevant territory, be used publicly and outwardly (11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 37; 30/04/2008, T-131/06, *Sonia Sonia Rykiel*, EU:T:2008:135, § 38; 18/01/2011, T-382/08, *Vogue*, EU:T:2011:9, § 27).
- 20 Genuine use of a trade mark must be understood to denote real use that is not merely token, serving solely to preserve the rights conferred by the mark (fictitious use). Genuine use of the mark entails use of the mark on the relevant market and not just internal use by the undertaking concerned (27/09/2007, T-418/03, *La Mer*, EU:T:2007:299, § 54; 11/03/2003, C-40/01, *Minimax*, EU:C:2003:145, § 36-37). Genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (12/12/2002, T-39/01, *Hiwatt*, EU:T:2002:316, § 47).
- 21 As to the criteria for assessing genuine use, under Rule 40(5) CTMIR, account must be taken of the facts and circumstances of each case, regard being had to the wording of Rule 22(3) CTMIR which states that the indications and evidence for the furnishing of proof of use are to consist of indications concerning the place, time, extent and nature of use.
- 22 Lastly, it must be noted that, under the provisions of point (a) of the second subparagraph of Article 18(1) EUTMR, proof of genuine use of an EU trade mark also includes proof of use of the mark in a form differing in elements which do not alter the distinctive character of that mark in the form under which it was registered (see, by analogy, 08/12/2005, T-29/04, *Cristal Castellblanch*, EU:T:2005:438, § 30 and the case-law cited).
- 23 The purpose of Article 18(1)(a) EUTMR, which avoids imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, is to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned. In accordance with its purpose, the material scope of that provision must be regarded as being limited to situations in which the sign actually used by the proprietor of a trade mark to identify the goods or services in respect of which the mark was registered constitutes the form in which that same mark is commercially exploited. In such situations, where the sign used in trade differs from the form in which it was registered only in negligible elements, so that the two signs can be regarded as broadly equivalent, the above-mentioned provision envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in

which it is used in trade (28/02/2017, T-766/15, REPRÉSENTATION DE SEMIS DE POISSONS DORÉS SUR FOND BLEU (fig.), EU:T:2017:123, § 20; 23/02/2006, T-194/03, Bainbridge, EU:T:2006:65, § 50).

- 24 In the present case, the opponent had to prove use of its earlier mark in the five-year period preceding the publication date of the contested mark, i.e. from 18 August 2010 to 17 August 2015, inclusive.
- 25 It is settled case-law that the documents submitted in order to prove use must be assessed all together.
- 26 The opponent filed the following evidence:
 - Annex 1: 54 invoices dated 2011-2015 sent to various clients in Spain or other EU countries;
 - Annex 2: an announcement of the wine 'DON LUCIANO 2009 D.O. La Mancha' (1 euro) in the wine catalogue of the company Auchan dated 15 to 31 October 2010;
 - Annex 3: pictures of wine bottles 'don Luciano' in an undated brochure and in a printout from the opponent's website dated 2014.
- 27 As to the time period, the invoices cover the period 2011-2015, the catalogue is dated October 2010 and the printout from the opponent's website is dated 2014. Therefore, the evidence falls within the relevant period. The applicant argued before the Opposition Division that the material submitted did not show use during the entire five-year period as required by law. However, no such obligation exists. The provisions on the use requirement do not require continuous use (16/12/2008, T-86/07, Deitech, EU:T:2008:577, § 52).
- 28 The undated brochure shows the nature of use. Although it is not dated, the fact nevertheless remains that, in the context of a global assessment, it may be taken into consideration in conjunction with other pieces of evidence which are dated in order to prove that the goods are indeed produced and marketed by the opponent (see, by analogy, 17/02/2011, T'324/09, Friboi, EU:T:2011:47, § 33).
- 29 As to the place of use, the evidence refers to the relevant territory (EU) since the invoices were addressed to various customers mainly in Spain, but also in Greece, Germany, Estonia, Ireland, the Netherlands, Portugal, France, Austria, the Czech Republic and Italy.
- 30 On the invoices the product is identified as 'VI DON LUCIANO' or 'VINO D. LUCIANO' followed by descriptive indications in relation to wines: 'TEMPRANILLO', 'TINTO CRIANZA', 'ROSADO', 'BLANCO', 'CABERNET' or 'RESERVA' or 'RESERV'. The opponent explained that on some invoices the mark 'Don Luciano' appears as 'D. Luciano' for lack of space and that in Spanish 'D.' is the abbreviation for 'Don'. These allegations are plausible. The space on the invoices is limited and 'VINO D. LUCIANO' is accompanied by several other terms indicating the nature of the products in question. Furthermore, there is no indication that another wine would be sold by

the opponent under the mark 'D. LUCIANO' (see, in that sense, 28/04/2016, R 1151/2015-1, SANDRONE LUCIANO / DON LUCIANO, § 21).

- 31 Furthermore, on the brochure and the printout from the opponent's website, the labels on the wine bottle bear the mark 'don Luciano'. It is represented in a handwritten style which does not alter the distinctive character of the mark as registered since the verbal element 'don Luciano' remains easily legible and the lettering is a common handwritten-like typeface (see, in that sense, 28/04/2016, R 1151/2015-1, SANDRONE LUCIANO / DON LUCIANO, § 28).
- 32 The frequency and regularity of use during the relevant period is demonstrated by the invoices covering the period 2011-2015. This shows continuous business activity in the EU.
- 33 As for the extent of use, the 54 invoices submitted may be considered as samples and do not represent the total sales, as it can be inferred from their non-consecutive numbering.
- 34 The quantities sold are far from being negligible. They vary depending on the invoices from 30, 150, 600, 750, 1500, 1772, 1800, 3000, 3500, 3908, 9611, 9402, 9450, and up to 12 000 bottles. Therefore, the invoices show a turnover which shows effective and sufficient use of the trade mark on the market.
- 35 The Board finds that when viewed as a whole the evidence does in fact sufficiently show that the earlier mark has been put to genuine use for 'wines'. No evidence refers to any use of the mark in respect of other alcoholic beverages. Therefore, genuine use has been proven in respect of 'wines' in Class 33 which are a sub-category of 'alcoholic beverages (except beer)' for which the earlier mark is registered.

Likelihood of confusion

- 36 In accordance with Article 8(1)(b) EUTMR, upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered if, because of its similarity to the earlier trade mark and the identity or similarity of the goods covered by the trade marks, there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected.
- 37 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of that article (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 16-18; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 30).
- 38 It is clear from that provision that a likelihood of confusion presupposes both that the mark applied for and the earlier mark are identical or similar, and that the goods or services covered by the application for registration are identical or similar to those in respect of which the earlier mark is registered. Those conditions are cumulative (12/10/2004, C-106/03, Hubert, EU:C:2004:611, § 51).

- 39 The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22-24).

Relevant public

- 40 In the present case, so far as concerns the relevant consumer, it should be borne in mind that, as the Opposition Division rightly found in the contested decision, the likelihood of confusion between the signs in question must be assessed by having regard to the consumers in the European Union, as the earlier mark is an EU mark and, in view of the nature of the goods in Class 33 covered by the signs at issue, the relevant public includes the general public whose level of attention is average.

Comparison of the goods

- 41 As regards the comparison of the goods, the Board of Appeal notes that the parties do not dispute the Opposition Division's assessment that the contested goods and the goods covered by the earlier mark are identical and similar to a low degree.
- 42 Now that the Board has examined the proof of use, it is recalled that the protection of the earlier mark is limited to 'wines' in Class 33, instead of the whole category 'alcoholic beverages (except beer)' taken into account by the Opposition Division.
- 43 The contested 'alcoholic beverages (except beer)' include 'wines' covered by the earlier mark. Therefore, they are identical.
- 44 Furthermore, the contested 'preparations for making alcoholic beverages' (which include inter alia, for example, mulled wine concentrates, preparations for making mulled wine) are similar to an average degree to 'wines'. They differ in that 'preparations for making alcoholic beverages' cannot be consumed directly contrary to wines, but they can be found in the same distribution channels, they can be produced by the same providers and they target the same relevant public.

Comparison of the marks

- 45 Regarding the comparison of the marks, it should be recalled that, according to case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 30, and 18/10/2007, T-28/05, Omega 3, EU:T:2007:312, § 54). The global assessment of the likelihood of confusion must be based, in so far as the visual, phonetic or conceptual similarities between of the marks at issue are concerned, on the overall impression given by

the marks, bearing in mind, in particular, their distinctive and dominant components (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

- 46 In the present case, the contested mark is composed of the words ‘Luciano Sandrone’. The words will be probably perceived as a combination of a first name and a surname by the relevant public in all the EU territory, as held in the contested decision.
- 47 While, on the one hand, ‘Sandrone’ will not be perceived as a common surname, including in Italy, on the other, ‘Luciano’ will be perceived as a very common first name in Italy, Portugal and Spain, as well as in France where the equivalent name ‘Lucien’ is also similar.
- 48 For the public in those territories, the degree of distinctiveness of ‘Luciano’ is lower than ‘Sandrone’, which will be recognized as a rare surname, and, as such, has a higher intrinsic value. However, this is not true in all EU territories. The perception of signs made up of personal names may vary from country to country within the European Union. In Germany or Finland, for example, ‘Luciano’ will be perceived as a rare first name. The contested decision took into account in particular the fact that ‘Luciano Pavarotti’ is a worldwide renowned tenor to conclude that ‘Luciano’ is a relatively well-known Italian first name. However, to the Board’s knowledge, it is the tenor’s surname, ‘Pavarotti’, that is well known rather than his full name ‘Luciano Pavarotti’. A significant part of the public in the EU would not remember his first name.
- 49 Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character (24/06/2010, C-51/09 P, Barbara Becker, EU:C:2010:368, § 36).
- 50 In the present case, both the first name ‘Luciano’ and the surname ‘Sandrone’ are rare for the German and Finnish public in particular. Therefore, for that public ‘Luciano’ is as distinctive as ‘Sandrone’ in the contested mark (see, by analogy, 05/10/2011, T-421/10, Rosalia de Castro, EU:T:2011:565, § 51, confirmed by 03/10/2012, C-649/11 P, Rosalia de Castro, EU:C:2012:603).
- 51 The earlier mark ‘DON LUCIANO’ is composed of the first name ‘Luciano’, as seen above, preceded by the term ‘Don’ which will be understood as a Spanish title noun standing for ‘Sir/Mister’, as found in the contested decision, or as an Italian title for priests. It will be recognized as such by a significant part of the public in the EU, and in particular by the German and Finnish public, especially when it is followed by a first name like in the present case. The above meanings are even mentioned in the German dictionary *Duden* (https://www.duden.de/rechtschreibung/Don_Herr_Adelstitel#Bedeutunga). For that public, ‘LUCIANO’ is more distinctive than ‘DON’ in the earlier mark.
- 52 From a conceptual point of view, the relevant public will associate the contested mark ‘Luciano Sandrone’ with a first name and a surname; thus a specific person (whether virtual or real) named Luciano, member of the ‘Sandrone’ family. On the other hand, ‘Don Luciano’ will be perceived as referring to a person named

Luciano. Thus consumers in particular in Germany and Finland might interpret the marks at issue as referring to the same person (whether virtual or real) characterized by the uncommon name 'Luciano'. In light of the above, the degree of conceptual similarity between the signs at issue must be described as at least average, and not low contrary to what was found in the contested decision.

- 53 Visually, the first word 'Luciano' of the contested mark 'Luciano Sandrone' is identical to the second word element 'LUCIANO' of the earlier mark 'DON LUCIANO'. The two marks differ in the presence of the second word 'Sandrone' which occupies half of the contested mark and in the first word 'DON' in the earlier mark. Thus, the identical term is not in the same place in each sign. Nevertheless, 'DON' is a very short word so that the attention is drawn to the longer word 'LUCIANO' which is identical to the first word of the contested mark on which the attention also focuses. Therefore, on account of their coincidence in the element 'LUCIANO', the marks at issue are visually similar to a degree that would at least be classified as low.
- 54 Aurally, the signs share the pronunciation of the word 'LUCIANO'. However, the contested mark 'Luciano Sandrone' is longer than the earlier mark 'DON LUCIANO' and the signs begin and end with different syllables. Therefore, the signs at issue are aurally similar at least to a low degree.

Overall assessment of the likelihood of confusion

- 55 It is undisputed that the earlier mark 'DON LUCIANO' has inherently a normal distinctive character for the goods for which it is registered. The opponent has not claimed that its earlier mark enjoys an enhanced distinctive character acquired through use.
- 56 In view of all the circumstances of the case at hand, applying the principle of interdependence, considering that the inherent distinctiveness of the earlier mark is average, and that the signs are visually and aurally similar at least to a low degree and conceptually similar at least to an average degree, the Board finds that there is a likelihood of confusion for at least the German and Finnish relevant public in the EU, whose degree of attention is average, in relation to all of the contested goods at issue which are identical and similar to an average degree to the goods covered by the earlier mark.
- 57 Since part of the public in the EU, in particular the German and Finnish public, regards the first name 'Luciano' as rare, the presence of this uncommon element is likely to focus the consumers' attention and they could be misled into attributing a common origin to the goods concerned.
- 58 The above conclusion is also in line with the Board of Appeal decision of 28/04/2016, R 1151/2015-1, SANDRONE LUCIANO / DON LUCIANO (relating to opposition proceedings No B 2 242 009) where it was found there was a likelihood of confusion for identical goods. The inversion of the order of the words 'SANDRONE' and 'LUCIANO' in the present contested mark is not sufficient to exclude any likelihood of confusion, at least as far as the German and Finnish public in the EU is concerned.

- 59 Finally, the particular circumstances in which the goods covered by the marks are actually marketed have, as a matter of principle, no impact on the assessment of the likelihood of confusion because they may vary in time depending on the wishes of the proprietors of the trade marks (15/03/2007, C-171/06 P, Quantum, EU:C:2007:171, § 59; 22/03/2012, C-354/11 P, G, EU:C:2012:167, § 73; 21/06/2012, T-276/09, Yakut, EU:T:2012:313, § 58). The fact that the applicant offers its wines for sale at a higher price than the opponent is a purely subjective marketing factor that is, as such, irrelevant when assessing the likelihood of confusion (14/11/2007, T-101/06, Castell del Remei Oda, EU:T:2007:340, § 52).
- 60 In light of the foregoing, the appeal is upheld, the contested decision is annulled in its entirety, the opposition is upheld and the contested trade mark application is rejected for all of the contested goods, namely ‘alcoholic beverages (except beer); preparations for making alcoholic beverages’ in Class 33.

Costs

- 61 Pursuant to Article 109(1) EUTMR and Article 18 EUTMIR, the applicant, as the losing party, must bear the opponent’s costs of the opposition and appeal proceedings.
- 62 As to the appeal proceedings, these consist of the appeal fee of EUR 720 and the opponent’s costs of professional representation of EUR 550.
- 63 As to the opposition proceedings, the applicant must reimburse the opposition fee of EUR 350 and the opponent’s cost of professional representation of EUR 300. The total amount is fixed at EUR 1 920.

Order

On those grounds,

THE BOARD

hereby:

- 1. Annuls the contested decision;**
- 2. Rejects the application for all the contested goods, namely:**
Class 33 – Alcoholic beverages (except beer); preparations for making alcoholic beverages;
- 3. Orders the applicant to bear the opponent's costs incurred in the appeal and opposition proceedings in the amount of EUR 1 920.**

Signed

S. Stürmann

Signed

C. Negro

Signed

S. Martin

Registrar:

Signed

H. Dijkema

