

DECISION
of the Second Board of Appeal
of 6 February 2023

In case R 380/2022-2

Dittmeyer's-Valensina GmbH

Ruckes 90
41238 Mönchengladbach
Germany

Applicant / Appellant

represented by BALDER IP LAW, S.L., Paseo de la Castellana 93, 28046 Madrid,
Spain

v

CASA ERMELINDA FREITAS - VINHOS, LDA.

Fernando Pó,
2501 Águas de Moura
Portugal

Opponent / Defendant

represented by GASTÃO DA CUNHA FERREIRA, LDA., Rua dos Bacalhoeiros,
nº. 4, 1100-070 Lisboa, Portugal

APPEAL relating to Opposition Proceedings No B 3 134 978 (European Union trade
mark application No 18 282 244)

THE SECOND BOARD OF APPEAL

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

Registrar: H. Dijkema

gives the following

Decision

Summary of the facts

- 1 By an application filed on 4 August 2020, Dittmeyer's-Valensina GmbH ('the applicant') sought to register the figurative mark



for the following list of goods as limited on 9 March 2021:

Class 29: Meat, fish, not live, shellfish, poultry, game, charcuterie, ham, including the aforesaid goods in preserved form; meat extracts; preserved, frozen, dried and cooked fruits and vegetables; vegetable and delicatessen salads (included in class 29); dried and prepared nuts and fruits; soya beans, preserved, for food; jellies for food; jams; compotes; fruit spreads; eggs; milk and dairy products (included in class 29);

Class 30: Coffee; tea; cocoa; sugar; rice; tapioca; sago; artificial coffee; flour; soya flour; pasta; bread; pastry and confectionery (other than with a base of cereals); chocolate goods; chocolates; pralines filled with alcohol; confections; sweetmeats [candy]; marzipan; edible ices; honey; golden syrup; yeast; baking powder; salt; mustard; vinegar; sauces [condiments]; spices; ice for refreshment; foodstuffs, included in class 30, manufactured using the aforesaid goods, including prepared and semi-prepared meals;

Class 31: Agricultural, horticultural and forestry products (included in class 31); live animals; fresh fruits and vegetables; seeds, live plants and flowers; dried flowers and plants for decorative and craftwork purposes; animal foodstuffs; malt;

Class 32: Soft drinks; mineral, table and spring waters; juices; fruit drinks; syrups and other preparations for making non-alcoholic beverages; non-alcoholic mixed drinks; non-alcoholic beverages produced from fruit and vegetable juices, spices and sauces; vegetable juices (including tomato juice); cocktails, non-alcoholic; energy drinks; sports drinks; fruit flavored soft drinks; lemonades; cola drinks; malt beer; whey beverages; smoothies; non-alcoholic honey-based beverages; grape must, unfermented;

Class 33: Alcoholic beverages (except beers), with the exception of wines and sparkling wines.

- 2 The application was published on 18 September 2020.
- 3 On 17 November 2020, Casa Ermelinda Freitas - Vinhos, Lda. ('the opponent') filed an opposition against the registration of the published trade mark application for part of the goods, namely against some of the goods in Class 32 and all the goods in Class 33.
- 4 After limitation by the applicant the opposition was maintained for all the goods in Class 33, namely *alcoholic beverages (except beers), with the exception of wines and sparkling wines*.
- 5 The grounds of opposition were those laid down in Article 8(1)(b) EUTMR.
- 6 The opposition was based on EUTM Registration No 13 001 946 'VINHA DA VALENTINA' filed on 16 June 2014 and registered on 27 January 2017 for the following goods:

Class 33: *Alcoholic beverages (except beer)*.
- 7 By decision of 17 February 2022 ('the contested decision'), the Opposition Division upheld the opposition for all the contested goods, namely:

Class 33: *Alcoholic beverages (except beers), with the exception of wines and sparkling wines*.
- 8 The Opposition Division gave, in particular, the following grounds for its decision:
 - The goods are identical and target the general public that will display an average degree of attention. The earlier mark's distinctiveness is normal.
 - The signs are aurally and conceptually similar to an average degree, while visually they are similar to a below-average degree. These similarities could be established due to the almost identical elements of the signs Valentina/Valensina where the only different letters 't' v 's' occupy a non-prominent position in the middle of the words and may easily be overlooked. Moreover, these words may be perceived by the analysed public as two versions of the same name.
 - The contested sign is a figurative mark; however, the depiction of fruits in relation to the relevant goods does not add a distinctive characteristic of the sign, neither the remaining graphical features such as the colours and the oval shape do that. It is common today for companies to make small variations of their brands, for example, by altering their font or colour, or by adding terms or elements, to name new product lines or create a modernised version of the brand.
 - The relevant consumers may perceive the contested sign as a new version of the previous brand, designating a new line of fruit-based or fruit-flavoured

alcoholic drinks, given the identity of the goods in question and the fact that both signs may be linked with the same foreign name.

- For the analysed public ‘Valentina’ plays an independent and distinctive role in the earlier mark and ‘Valensina’ is the element with the biggest impact in the contested sign. Since ‘Valentina’ is the only word in the earlier sign that may be linked with a concept by this public, it will remain in their minds the longest. Therefore, though being the last element in the earlier sign, its role should not be diminished.
 - The applicant refers to previous decisions of the Office to support its arguments. 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.
 - Even though previous decisions of the Office are not binding, their reasoning and outcome should still be duly considered when deciding upon a particular case.
 - In the present case, the previous cases referred to by the applicant are not relevant to the present proceedings since in none of them the similar words in the signs differ only by one letter placed in the middle or could be linked with same foreign name by the analysed public or at least part of it.
 - Considering all the above, there is a likelihood of confusion on the part of the Polish-speaking part of the public that will perceive the single verbal element ‘Valensina’ of the contested sign as another version or a misspelling of the foreign name ‘VALENTINA’ (contained as an independent and distinctive element in the earlier mark).
 - Since a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application, the opposition is well founded on the basis of the opponent’s EUTM registration No 13 001 946. It follows that the contested trade mark must be rejected for all the contested goods.
- 9 On 9 March 2022, the applicant filed an appeal against the contested decision, requesting that the decision be entirely set aside. The statement of grounds of the appeal was received on 16 June 2022.
- 10 In its response received on 16 August 2022, the opponent requested that the appeal be dismissed.
- 11 On 30 August 2022, the applicant requested that the proceedings be suspended due to a pending cancellation action against the earlier mark.
- 12 On 25 November 2022, the Registry of the Boards of Appeal informed the applicant that the request for a suspension of the appeal proceedings was rejected as the Board was of the opinion it could still decide on the opposition based on the remaining goods of the earlier mark.

Submissions and arguments of the parties

- 13 The arguments raised in the statement of grounds may be summarised as follows:
- The marks at stake are dissimilar since their length, structure and pronunciation are totally different. Their similarity is not more than below average.
 - ‘VALENSINA’ conveys no meaning for EU consumers since they will consider it a fancy name.
 - It has not been proven that the relevant public considers the words ‘VALENTINA’ and ‘VALENSINA’ as the same name written in different languages.
 - The Opposition Division compared the marks by focusing only on the terms ‘VALENTINA’ vs. ‘VALENSINA’, i.e. without considering the other verbal elements included in the earlier mark as well as the graphic elements contained in the contested sign. These other elements are important for comparison purposes and cannot be ignored. The Office artificially decomposed the opponent’s earlier trade mark ‘VINHA DA VALENTINA’ and discarded the term ‘VINHA DA’ even though they were at the beginning of the mark, simply because the Polish-speaking consumers might not understand their meaning.
 - The consumers who understand Portuguese will perceive the conceptual differences between the confronted signs ‘VINHA DA VALENTINA’ and ‘VALENSINA’. They will associate the earlier mark with a vineyard, an area of land where grape vines are grown in order to produce wine, which in connection with alcoholic beverages, will make them think about wine and similar beverages. The same consumers will associate the contested sign with oranges and therefore with other beverages not using grapes as ingredient. The goods *wines and sparkling wines* were expressly excluded by the applicant from the list of goods claimed in Class 33. This underlines the different nature of the confronted goods and, consequently, the different conceptual associations that both signs evoke in the consumer.
 - The element ‘VINHA’ will be the first term in contact with consumers which will not be confused with the challenged application.
 - Due to its size and the attractive colours the figurative element of the contested sign will not be overlooked. It is eye-catching and has a strong visual impact within the mark. The juice drop falling from the orange cut into half is part of the letter ‘I’ from the word ‘VALENSINA’ as it substitutes the upper point of this letter. Because the graphic elements are part of the word element, consumers will establish a direct mental association with oranges.
 - There are plenty of liqueurs with orange taste being commercialised on the EU market by different companies and which include the graphic of oranges



on their labels: . When comparing any of these drinks with the opponent's wine sold under the mark 'VINHA DA VALENTINA', consumers will not be confused about the type of alcoholic beverage and its origin thanks to the orange graphic, which will immediately suggest a different meaning and different ingredients of the beverage than those suggested by the beverage distinguished with the mark 'VINHA DA VALENTINA'.

- The relevant public will associate the contested sign with the city of Valencia which is well-known for its oranges. The applicant is using oranges from Valencia in its products. The term 'VALENSINA' in combination with the prominent graphic of oranges will make consumers automatically associate the mark with the region Valencia and its oranges. Consumers confronted with the mark 'VINHA DA VALENTINA' will, on the contrary, not associate it with Valencia nor with oranges for the reasons already given.
- The applicant insists on a former case 05/09/2016, R 1815/2015-5, VINHA DA VALENTINA/SAN VALENTIN.

14 The arguments raised in response may be summarised as follows:

- It is clear that the identity of the goods was not contested in the appeal.
- It is beyond doubt that 'VINHA DE' has no distinctive character. As a consequence, consumers will focus on the dominant element – the female name VALENTINA.
- The same occurs with the sign at issue – VALENSINA, of which the dominant element is undoubtedly the verbal part VALENSINA considering the weak distinctiveness of the oranges logo and the triviality of the remaining shapes that form this logo.
- VALENSINA and VALENTINA are practically identical.
- The allegation of the applicant regarding the city of VALENCIA are irrelevant. The city of Valencia is not well-known for oranges. Consumers will never make such an association. Spain may have good oranges just like Portugal. But that does not mean that the country, much less Valencia, is known for oranges. Ambrosia database does not show any protected citrus fruits coming from these regions. People from Valencia are called Valencianos, not valensinos
- The case invoked has nothing to do with the present case considering that the trade mark SAN VALENTIN was composed of other verbal elements and the degree of similarity when compared to VALENSINA is reduced.

Reasons

Admissibility of the appeal

- 15 The appeal complies with Articles 66, 67 and Article 68(1) EUTMR. It is admissible.

On the request for suspension

- 16 On 30 August 2022, the applicant requested that the proceedings be suspended due to a pending revocation action against the earlier mark.
- 17 Pursuant to Article 71(1)(b) EUTMDR and Article 44(1)(a), (4), (5) BoA RoP, the Board may suspend proceedings ‘at the reasoned request of one of the parties in inter partes proceedings where a suspension is appropriate under the circumstances of the case, taking into account the interest of the parties and the stage of the proceedings’.
- 18 The suspension request was not granted by the Board of Appeal.
- 19 The Board observes that the applicant filed an application for partial revocation of the earlier mark based on Article 58(1)(a) EUTMR (cancellation case No 55 256 C). In particular, the applicant requested that EUTM No 13 001 946 be partially revoked due to non-use in relation to *alcoholic beverages (except beer) excluding wines*.
- 20 The earlier mark is only partially subject to revocation. In order to avoid undue delay of the present proceedings, the Board is of the opinion that the appeal proceedings may continue taking into account the fact that even if the revocation action is upheld by the Cancellation Division, the earlier mark would still remain registered for *wines* in Class 33.
- 21 It follows that, for the comparison of the goods at issue, the Board will take into consideration only *wines* in Class 33 protected under the earlier mark.

Evidence filed for the first time before the Board of Appeal

- 22 The applicant submitted additional documents in the current appeal proceedings. This includes six Annexes with information on orange liqueurs and their bottles, the opponent’s wines, the oranges of the Valencian region in Spain, the applicant’s goods, and the cocktail ‘*agua de Valencia*’.
- 23 Pursuant to Article 95(2) EUTMR, the Office may disregard facts or evidence which are not submitted in due time by the parties concerned.
- 24 According to the case-law of the Court of Justice, it results from the wording of Article 95(2) EUTMR that, as a general rule and unless otherwise specified, the submission of facts and evidence by the parties remains possible after the expiry of the time limits to which such submission is subject under the provisions of the

EUTMR and that the Office is in no way prohibited from taking account of facts and evidence which are submitted or produced later (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 42; 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 22; 03/10/2013, C-122/12 P, Protiactive, EU:C:2013:628, § 23).

- 25 In stating that the Office ‘may’, in such a case, decide to disregard evidence, this provision grants the Office a wide discretion to decide, while giving reasons for its decision in that regard, whether or not to take such information into account (13/03/2007, C-29/05 P, Arcol, EU:C:2007:162, § 43; 18/07/2013, C-621/11 P, Fishbone, EU:C:2013:484, § 23; 03/10/2013, C-122/12 P, Protiactive, EU:C:2013:628, § 24).
- 26 The granting of discretion enables the Office to conduct the proceedings in a manner that gives due consideration to legal certainty and sound administration, by allowing account to be taken of relevant documents, albeit submitted too late, in the interests of reaching a decision in the case without unnecessary hearings.
- 27 As a general rule, the Board may accept facts or evidence submitted for the first time before it only where those facts or evidence are on the face of it, likely to be relevant for the outcome of the case and they have not been produced in due time for valid reasons, in particular where they are merely supplementing relevant facts and evidence which had already been submitted in due time, or are filed to contest findings made or examined by the first instance of its own motion in the decision subject to appeal.
- 28 In the present case, the requirements for taking into account the documents submitted in the appeal proceedings pursuant to Article 95(2) EUTMR are met.
- 29 The evidence was filed to support the applicant’s arguments that challenge the findings of the Opposition Division. It also appears to be relevant *prima facie* for the outcome of the case.
- 30 There is no evidence to suggest that the submission of further documents would represent a delaying tactic or that the legal time limits were deliberately being abused.
- 31 Bearing in mind the above circumstances, the Board finds the evidence submitted by the applicant at the appeal stage to be admissible.

Article 8(1)(b) EUTMR

- 32 According to Article 8(1)(b) EUTMR, the trade mark applied for will not be registered if, because of its identity with, or similarity to, an earlier trade mark, and the identity or similarity of the goods or services covered by the two 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.
- 33 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).

- 34 A likelihood of confusion must be assessed globally, taking into account all factors relevant to the circumstances of the case. That global assessment implies some interdependence between the factors taken into account and in particular similarity between the trade marks and between the goods and services covered. Accordingly, a lesser degree of similarity between these goods and services may be offset by a greater degree of similarity between the marks, and vice versa (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 22; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17; 22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 19).

Relevant public

- 35 The earlier mark is an EUTM. Therefore, the relevant territory for the assessment of a likelihood of confusion is the entire EU. For an EUTM application to be refused registration, it is sufficient that the relative ground of Article 8(1)(b) EUTMR exists in only part of the European Union (06/04/2022, T-370/22, Nutrifem Agnubalance, EU:T:2022:215, § 39, 45; 08/08/2020, T-659/2019, Kix, EU:T:2020:328, § 56). For there to be a likelihood of confusion, it is sufficient, even within a Member State, that only a distinct and relevant part of the public is affected, for example because of its variable knowledge of languages or its degree of attention (29/04/2015, T-717/13, Shadow Complex, EU:T:2015:242, § 27).
- 36 The goods under comparison in Class 33 are in general alcoholic beverages. They can be purchased in specialised liquor or wine stores, but also in supermarkets, restaurants or online (20/11/2007, T-149/06, Castellani, EU:T:2007:350, § 58). They address primarily the public at large (14/05/2013, T-393/11, Ca' Marina, EU:T:2013:241, § 24; 12/07/2018, T-774/16, CAVE DE TAIN (fig.), EU:T:2018:441, § 93; 17/01/2019, T-576/17, EL SEÑORITO / SEÑORITA, EU:T:2019:16, § 33; 24/09/2019, T-68/18, FORM EINER FLASCHE (3D), EU:T:2019:677, § 24; 13/04/2022, R 964/2020-G, ZORAYA / VIÑA ZORAYA, § 26). The degree of attention demonstrated by the general public when purchasing alcohol is average (23/09/2020, T-601/19, in.fi.ni.tu.de / Infinite et al., EU:T:2020:422, § 96; 10/01/2023, R 651/2022-5 and R 685/2022-5, WYNE / WYNNS, § 24).

Comparison of the goods

- 37 In assessing the similarity of the goods, all the relevant factors relating to those goods and services should be taken into account, including, inter alia, their nature, their intended purpose, and their method of use and whether they are in competition with each other or are complementary (29/09/1998, C-39/97, Canon, EU:C:1998:442, § 23). Other factors may also be taken into account such as, for example, the usual origin and the relevant public of the goods.

- 38 The reference point is whether the relevant public would perceive the goods concerned as having the same commercial origin (04/11/2003, T-85/02, Castillo, EU:T:2003:288, § 38) and whether consumers consider it normal that the goods are marketed under the same trade mark, which normally implies that a large number of producers are the same (11/07/2007, T-150/04, Tosca Blu, EU:T:2007:214, § 37).
- 39 The system for bringing opposition proceedings on the basis of a relative ground of refusal is based on the principle enshrined in Article 95(1) EUTMR, according to which in proceedings relating to relative grounds for refusal of registration, the Office shall be restricted in this examination to the facts, evidence, and arguments provided by the parties and the relief sought. The Board may not, merely on the ground that the comparison of the contested goods and services constitutes a matter of law, examine the underlying legal framework by relying on facts which have not been raised by the parties. However, nothing prevents the Office from taking account of facts which are well known, that is, which are likely to be known by anyone or which may be learnt from generally accessible sources (22/06/2004, T-185/02, PICARO, EU:T:2004:189, § 29), or which stem from the practical experience generally acquired from the marketing of general consumer goods, which facts are likely to be known by any person and are in particular known by consumers of those goods. In such a case, the Board of Appeal is, additionally, not even required to submit examples of that practical experience (03/02/2011, T-299/09 & T-300/09, Gelb-Grau, EU:T:2011:28, § 36 and the case-law cited).
- 40 Notwithstanding the above, this does not imply that the Board is allowed to carry out extensive research in order to be completely sure that its finding regarding the comparison of goods is correct. In fact, the Board is prohibited from doing so (09/02/2011, T-222/09, Alpharen, EU:T:2011:36, § 28-37).
- 41 In the context of opposition proceedings, it is only the list of goods applied for as it appears in the trade mark application concerned that can be taken into account, and it is inappropriate to take the particular circumstances in which the goods in question are provided and marketed into account in the prospective analysis of the likelihood of confusion between the marks, since those circumstances may vary over time and depend on the wishes of the proprietors of the marks at issue (21/01/2016, T-846/14, SPOKeY, EU:T:2016:24, § 27; 13/04/2005, T-286/03, Right Guard Xtreme Sport, EU:T:2005:126, § 33; 21/05/2005, T-55/13, F1H20 / F1 et al., EU:T:2015:309, § 42; 15/03/2007, C-171/06 P, Quantum, EU:C:2007:171, § 59; 07/04/2016, T-613/14, Polycart A Whole Cart Full of Benefits, EU:T:2016:198, § 27; 30/04/2019, R 1571/2018-5, Paola Maria / Paola, § 37). Therefore, evidence in relation to the applicant's goods, in particular what they contain or how they are marketed are not relevant.
- 42 The goods to be compared are the following:

Class 33: <i>Wine</i> .	Class 33: <i>Alcoholic beverages (except beers), with the exception of wines and sparkling</i>
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	<i>wines.</i>
<i>Goods under the earlier EUTM</i>	<i>Contested goods</i>

- 43 The applicant has expressly excluded from its list of goods products like *wines and sparkling wines*. The claimed goods in Class 33 cover a wide variety of alcoholic beverages from which only beers, wine, and sparkling wine are excluded. Therefore, the applicant's goods also cover alcoholic beverages like brandy, pisco, grappa, vermouth, vodka, etc. and premixed cocktails, such as for instance Bellini or Mimosa, which contain sparkling wine.
- 44 There is plethora of decisions of the Court and the Boards of Appeal that have found different types of alcoholic beverages similar to *wines*. In the judgment of 8 May 2019, T-358/18, JAUME CODORNÍU / JAUME SERRA et al., EU:T:2019:304, the General Court upheld the finding of the Board of Appeal that *liqueurs; spirits; brandy* are similar to *wines and cavas* (§ 33). In the decision of 18/05/2022, R 1113/2021-5, bistro Régent (fig.) / Regent, it was found that *wine* and *brandy* were similar to a low degree. In the decision of 12/04/2022, R 1119/2021-1, GOYA TEQUILA/G GOYA (fig.) et al., it was found that there was a low degree of similarity between *wine* and *tequila* (§ 28). In the decision of 21/09/2020, R 2249/2019-4, Silarus (fig.) / Silanus, it was concluded that *potable spirits; liqueurs; schnapps; grappa; spirits and liquors* are similar to an average degree to the earlier *wines* (§ 33). Also, in the decision of 28/03/2022, R 1780/2020-4, NICOLAS (fig.) / Nicolaus, it was found that goods such as *wines, sparkling wines, ciders, natural sweet wines, liqueur wines, vermouths* are all similar to an average degree to *spirits* (§ 64). Recently, the Board of Appeal found that *brandy* and *wine* are similar (28/11/2022, R 2002/2021-4, FAM. DI CARLO / Carlos I et al., § 30). Finally, the Grand Board, in the decision of 18/07/2013, R 233/2012-G, PAPAGAYO ORGANIC, found that *rum* and *wine* were similar to a very low degree. The Board cannot simply disregard this extended case-law.
- 45 Although in many cases the production processes of wines and other alcoholic drinks may be different, these goods belong to the same category of alcoholic beverages. Indeed, they may be further divided by their alcohol content, by grape, grain, fruit-based nature, and flavour, etc. However, their method of use and consumption pattern are similar, since they can be served on the same occasions and in the same establishments. They also target the same public (the public at large) and have the same distribution channels (can be served in bars and restaurants, sold in supermarkets and liquor stores). In restaurants and bars, both wine and alcoholic spirits may be drunk at the same time; especially in bars where they are in competition, since one may order a glass of wine or an alcoholic spirit, which includes rum, vodka, or whisky. Those made from grapes can be even manufactured by the same entities.
- 46 To conclude the Board is of the opinion that the opponent's goods are similar to the contested goods.

Comparison of the marks

- 47 The global appreciation of the likelihood of confusion, as regards the visual, aural, or conceptual similarities between the marks at issue, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components.
- 48 In general, two marks are similar when, from the point of view of the relevant public, they are at least identical as regards one or more relevant aspect, that is, the visual, aural or conceptual aspects (09/03/2006, C-421/04, Matratzen, EU:C:2006:164, § 30; 12/07/2006, T-97/05, Marcorossi, EU:T:2006:203, § 39; 22/06/2005, T-34/04, Turkish Power, EU:T:2005:248, § 43; 01/06/2006, C-324/05 P, Turkish Power, EU:C:2006:368).
- 49 With regard to the assessment of the dominant character of one or more given components of a complex trade mark, account must be taken, in particular, of the intrinsic qualities of each of those components by comparing them with those of other components. In addition, account may be taken of the relative position of the various components within the arrangement of the complex mark (23/10/2002, T-6/01, Matratzen, EU:T:2002:261, § 35). Although that comparison must be based on the overall impression made by those signs on the relevant public, account must nevertheless be taken of the intrinsic qualities of the signs at issue (04/03/2020, C-328/18, Black Label by Equivalenza, EU:C:2020:156, § 71).
- 50 The Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (13/10/2016, C-285/16 P, BIMBO, EU:C:2016:773, § 21 and the case-law cited including 06/10/2005, C-120/04, Thomson Life, EU:C:2005:594, § 30, 36).
- 51 Nonetheless, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (13/10/2016, C-285/16 P, BIMBO, EU:C:2016:773, § 25 and case-law cited).

52 The signs to be compared are:

VINHA DA VALENTINA	
<i>Earlier EUTM</i>	<i>Contested sign</i>

53 The Opposition Division examined the similarity of the marks from the perspective of the Polish-speaking consumers. However, the Board will assess the similarity between the marks from the perspective of the Portuguese-speaking consumers who will understand the meaning of the words ‘VINHA DA’ of the earlier mark.

54 Before examining whether there are any visual, phonetic or conceptual similarities between the marks at issue, the Board will make an assessment of the distinctive and dominant elements of the marks at issue (12/11/2015, T-449/13, WISENT / ŻUBRÓWKA BISON BRAND VODKA, EU:T:2015:839, § 60-61).

55 The distinctive character of a sign or a component thereof must be assessed, first, by reference to the goods in respect of which registration has been sought and, secondly, by reference to the perception that the relevant public, which consists of the consumers of those goods, has of that sign or component (see, by analogy, (12/12/2018, T-743/17, CARACTÈRE, EU:T:2018:911, § 50).

Earlier EUTM

56 The earlier mark is a word mark. Therefore, it has no element that can be considered as the dominant (visually eye-catching) one.

57 None of the parties has contested the fact that, in Portuguese, the words ‘VINHA DA’ mean ‘wine from’. The Portuguese-speaking part of the public will therefore directly and immediately establish a link between these terms and the opponent’s *wine*. For this part of the relevant public, these words are not distinctive (11/01/2022, R 640/2021-2, Vinea domini / Dominus, § 64; 12/07/2012, R 618/2011-1, VIÑA MONTY (fig.) / VINHA DO MONTE).

58 As to the position of the element ‘VINHA DA’ which forms the beginning of the earlier mark and the subsequent element ‘VALENTINA’, it is true that consumers generally pay more attention to the beginning of a mark than to its end and that the word at the beginning of the sign is likely to create a more significant impression than the rest of the sign. However, that rule cannot be applied in

isolation from the circumstances of the specific case, in particular the specific characteristics of the earlier mark (18/11/2020, T-378/19, Tc Carl / carl touch (fig) et al., EU:T:2020:544, § 47 and case-law cited therein; 11/01/2022, R 640/2021-2, Vinea domini / Dominus, § 65).

- 59 The term ‘VALENTINA’ will be perceived as a female name. This name is distinctive in relation to *wine* and therefore possesses a higher degree of distinctiveness than the words ‘VINHA DA’.
- 60 In light of the foregoing, within the overall impression of the earlier mark, the words ‘VINHA DA’ cannot be attributed more weight than the word ‘VALENTINA’ by the Portuguese-speaking consumers. The term ‘VALENTINA’ is the most distinctive element of the earlier mark.

Contested sign

- 61 The contested sign is a figurative mark consisting of a label embellished with depictions of oranges and their leaves in orange and green hues in which the verbal element ‘VALENSINA’ is written in slightly stylised black letters.
- 62 When signs consist of both verbal and figurative components, in principle, the verbal component usually has a stronger impact on the consumer than the figurative component (23/05/2019, T-837/17, SkyPrivate, EU:T:2019:351, § 39).
- 63 In relation to the goods in question the relevant public is likely to perceive the figurative elements of the oranges as indicating the flavour of the alcoholic beverages (by analogy, 21/09/2020, R 2249/2019-4, Silarus (fig.) / Silanus, § 43). The representation of the oranges and their leaves is realistic. It has no elements that could make this figurative element memorable for consumers. In addition, this is further confirmed by the examples of bottles of alcoholic beverages with orange flavour submitted by the applicant as Annex 1. Those bottles have realistic representations of oranges (whole or cut in half, with leaves or without) which do not differ greatly from the figurative element of the oranges in the contested



sign: . Therefore, these figurative elements will primarily be perceived as simply decorative compared to the verbal element ‘VALENSINA’ (by analogy, 07/11/2019, R 839/2019-4, Native Coco BIO-KOKOSÖL (fig.) / Nativa (fig.) et al., § 38; 20/09/2012, R 1618/2011-2, PURE VIA (fig.) / PURVIVA; 14/12/2021, R 1266/2021-1, FRU YAMMY (fig.) / Yammy, § 41). The applicant’s argument that the figurative element of the contested mark is as important as the word elements in the overall appreciation of the mark should be rejected.

- 64 The word element ‘VALENSINA’ does not have any meaning for the relevant public. The applicant notes that it is a fancy name. However, the Board cannot

exclude the possibility that it might be perceived as a female name by part of the relevant public. For the remaining part of the public the term ‘VALENSINA’ does not carry any meaning.

- 65 The Board cannot agree with the applicant’s argument that the term ‘VALENSINA’ will automatically conjure up images of the Spanish region of Valencia in the minds of relevant consumers. Whether or not the public is aware of the intensive orange production in the Valencia region, the applicant’s argument is too far-fetched. First, as rightly noted by the opponent, the adjective to indicate that a product comes from Valencia is not ‘valensino’, but ‘valenciano’ or ‘valencian’. Moreover, Valencia is not the only region in Europe that may be well-known for its orange production, and not all orange-flavoured beverages, alcoholic or not, use oranges from Valencia.
- 66 To conclude, the verbal element ‘VALENSINA’ is the most distinctive element of the contested sign.

Visual comparison

- 67 Visually, according to settled case-law, where a figurative mark containing word elements is compared visually to a word mark, the marks are held to be visually similar if they have a significant number of letters in the same position in common and if the word element of the figurative sign is not highly stylised, notwithstanding the graphic representation of the letters in different fonts, in italics or bold, in lower-case or upper-case lettering, or in colour (09/09/2019, T-680/18, LUMIN8 (fig.) / LUMI et al., EU:T:2019:565, § 32; 24/10/2017, T-202/16, Coffee In (coffee inn), EU:T:2017:750, § 101 and the case-law cited).
- 68 The Opposition Division found that the marks are visually similar to a below-average degree. The applicant contends that the Opposition Division erroneously focus the comparison of the marks on the elements ‘VALENTINA’ and ‘VALENSINA’ and it ignored the remaining elements of the respective marks. However, this is not true. The Opposition Division admitted that the marks under comparison differed in the figurative elements and the additional verbal elements of the earlier mark. However, it was concluded that these differences cannot cancel out the similarities between the marks.
- 69 The signs coincide to the extent that their most distinctive elements, ‘VALENTINA’ and ‘VALENSINA’, differ in only one letter ‘-T-’ in the earlier mark and ‘-S-’ in the contested sign – while they coincide in that they have eight out of nine letters in common (‘V-A-L-E-N-*-I-N-A’). They differ in the term ‘VINHA DA’ included in the earlier mark and in the figurative elements of the contested sign. However, as analysed above, these elements have less impact on the overall impression of the marks. Therefore, the differentiating elements of the signs are not capable of offsetting the visual similarity resulting from the almost identical distinctive elements ‘VALENTINA’ and ‘VALENSINA’. Consequently, the Board considers that the signs are visually similar to an average degree and not dissimilar as claimed by the applicant (by analogy, 14/12/2022, R 1214/2022-5, FATTORIA FERRARO (fig.) / FERRERO (fig) et al., § 57-58; 27/10/2022,

R 840/2022-5, LA FAMIGLIA FIORELLI (fig.) / FIORINI (fig.) et al., § 54; 21/09/2020, R 2249/2019-4, Silarus (fig.) / Silanus, § 44).

- 70 For the sake of completeness, the additional element ‘VINHA DA’ forms the beginning of the earlier mark. However, taking into account the above assessment regarding the weak distinctiveness of this element, the fact that it is placed at the beginning of the mark cannot have a decisive impact on the overall perception of the latter. The fact remains that the coincidences between the marks are located in the most distinctive elements of them.

Phonetic comparison

- 71 The Board concurs with the Opposition Division in that the marks are phonetically similar to an average degree. The pronunciation of the signs coincides in the sound of the string of the letters ‘V-A-L-E-N-*-I-N-A’ in the distinctive elements of the respective marks. The pronunciation differs in the pronunciation of the weak element ‘VINHA DA’ of the earlier mark, which has no counterpart in the contested sign. However, due to economy of language, the public is more likely to omit the pronunciation of the expression ‘VINHA DA’ (11/01/2013, T-568/11, *interdit de me gronder IDMG*, EU:T:2013:5, § 44). This is due to the fact that a trade mark which includes several words will generally be abbreviated orally to something easier to pronounce (02/02/2011, T-437/09, *Oyster cosmetics*, EU:T:2011:23, § 45 and the case-law cited therein). Moreover, consumers generally refer to the distinctive elements while weaker elements are not pronounced (by analogy, 03/07/2013, T-206/12, *LIBERTE american blend*, EU:T:2013:342, § 44; 27/10/2022, R 840/2022-5, LA FAMIGLIA FIORELLI (fig.) / FIORINI (fig.) et al., § 55).
- 72 Also, the Board notes that in its statement of grounds of the appeal the applicant has stated the following: ‘Bearing in mind the phonetical differences between ‘VIN-HA-DA-VA-LEN-TI-NA’ and ‘VA-LEN-SI-NA’ as described before, their similarity is not higher than a below-average degree’. This shows that the applicant itself admits that there is some phonetic similarity between the marks.

Conceptual comparison

- 73 Conceptually, reference is made to the previous assertions concerning the semantic content conveyed by the marks. The Board notes that, although for part of the relevant public both signs will be perceived as referring to a female name this is not sufficient to bring them closer conceptually (11/07/2018, T-707/16, *ANTONIO RUBINI / RUTINI (fig.) et al.*, EU:T:2018:424, § 64). The signs moreover contain further elements which, albeit weak or non-distinctive, will be linked to different concepts, namely the concept of a vineyard and the concept of oranges. Therefore, the signs are not conceptually similar, as noted by the applicant and contrary to the findings of the contested decision.
- 74 In any event, the difference resulting from the presence of the expression ‘VINHA DA’ in the earlier mark and the representation of the oranges in the contested sign

cannot be given much weight, because of their weakly distinctive character in relation to the relevant goods. The impact of these elements will be limited in the assessment of the likelihood of confusion.

Distinctive character of the earlier mark

- 75 The earlier mark, as a whole, is inherently distinctive. This has been supported by the applicant as well.

Overall assessment of the likelihood of confusion

- 76 A global assessment of a likelihood of confusion implies some interdependence between the relevant factors, and in particular, the similarity between the trade marks and between the goods or services. Accordingly, a greater degree of similarity between the goods may be offset by a lower degree of similarity between the marks, and vice versa (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 20; 11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 24; 29/09/1998, C-39/97, Canon, EU:C:1998:442, § 17).
- 77 The goods at issue are similar to an average degree. The marks have been found visually and phonetically similar to an average degree. Conceptually, the signs are not similar. The distinctiveness of the earlier mark is normal. The relevant public includes the public at large throughout the entire European Union, in particular the Portuguese-speaking consumers, displaying an average level of attention.
- 78 Account should be taken of the fact that the average consumer rarely has the chance to make a direct comparison between different marks but must place his trust in his imperfect recollection of them (22/06/1999, C-342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).
- 79 Considering all the above, the Board finds that there is a likelihood of confusion on the part of the Portuguese-speaking public, because the differences between the marks are mostly confined to elements with limited distinctiveness and to secondary aspects, as well as to only one letter in the less eye-catching middle parts of their most distinctive elements ‘VALENTINA’ and ‘VALENSINA’. Indeed, the signs share the vast majority of letters in these most distinctive elements.
- 80 In light of all the foregoing, and taking into account the relevant factors and their mutual interdependence and the imperfect recollection of the public at issue, there is reason to assume that a significant part of the relevant public in the European Union, namely the Portuguese-speaking consumers, may be misled into thinking that the similar goods bearing the similar conflicting marks come from the same undertaking or, as the case may be, from undertakings that are economically linked.
- 81 The cases referred to by the applicant cannot change the outcome of the appeal. In this respect, it should firstly be noted that the Office is in no way bound by

previous decisions (12/02/2009, C-39/08 & C-43/08, Volks.Handy Schwabenpost, EU:C:2009:91, § 17).

- 82 According to settled case-law, the decision of the Office concerning likelihood of confusion is adopted in the exercise of circumscribed powers and is not a matter of discretion. Accordingly, the legality of that decision must be assessed solely on the basis of the EUTMR as interpreted by the European Union judicature and not on the basis of a previous decision-making practice (10/03/2011, C-51/10 P, 1000, EU:C:2011:139, § 74; 25/10/2012, T-552/10, vital & fit, EU:T:2012:576, § 25).
- 83 The Board observes that in the decision of 31/01/2017, R 1223/2016-1, PAZO DE MIRAFLORES / MILFLORES, all the elements of the respective marks were found to be distinctive. Therefore, the comparison was made taking into account all the elements. The marks differed in their beginnings. Also, the similar elements ‘miraflores’ and ‘milflores’ presented differences in their initial syllables. In 05/09/2016, R 1815/2015-5, VINHA DA VALENTINA / SAN VALENTIN, there was more conceptual distance between the marks, as one referred to a female name, while the other to a name of a saint.
- 84 In addition, the fact that other EUTM owners, whose marks contain the words ‘VALENTINI’ or ‘VALENTIN’, have filed an opposition against the sign applied for does not allow the Board to reach any conclusion as to the likelihood of confusion between the marks under comparison in the present appeal proceedings.
- 85 The appeal is dismissed.

Costs

- 86 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.
- 87 As to the appeal proceedings, these consist of the opponent’s costs of professional representation of EUR 550.
- 88 As to the opposition proceedings, the Opposition Division ordered the applicant to bear the opposition fee of EUR 320 and the opponent’s representation costs which were fixed at EUR 300. This decision remains unaffected. The total amount for both proceedings is therefore EUR 1 170.

Order

On those grounds,

THE BOARD

hereby:

- 1. Dismisses the appeal;**
- 2. Orders the applicant to bear the opponent's costs in the appeal proceedings, which are fixed at EUR 550. The total amount to be paid by the applicant in the opposition and appeal proceedings is EUR 1 170.**

Signed

S. Stürmann

Signed

H. Salmi

Signed

C. Negro

Registrar:

Signed

H. Dijkema

