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Pellini Vs FELLINI



OPPOSITIONNo B 3 230 322

Pellini Caffe' S.P.A., Via I maggio 8, 37012Bussolengo (VR),Italy (opponent), represented by **Bugnion S.P.A.**, Via Pancaldo, 68, 37138Verona, Italy (professional representative)

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Casa del Gusto S.R.O., Příkop 843/4, 60200Brno, Czech Republic (applicant), represented by **Jakub Reitschmied**, Ponávka 2, 60200 Brno, Czech Republic (professional representative).

On 03/10/2025, the Opposition Division takes the following

DECISION:

1. Opposition No B 3 230 322 is upheld for all the contested goods and services.

2. European Union trade mark application No 18 977 646 is rejected in its entirety.

3. The applicant bears the costs, fixed at EUR 620.

REASONS

On 17/12/2024, the opponent filed an oppositionagainst all the goods and services of European Union trade mark application No 18 977646 CAFFÉ FELLINI (word mark). The opposition is based on EUTM registration No 3 758 182 Pellini (figurative mark). The opponent invoked Article 8(1)(b) EUTMR.

LIKELIHOOD OF CONFUSION — ARTICLE 8(1)(b) EUTMR

Pursuant to Article 8(1)(b) EUTMR, a likelihood of confusionexists if there is a risk that the public might believe that the goods or services in question,under the assumption that they bear the marks in question, come from the same undertakingor, as the case may be, from economically linked undertakings. Whether a likelihoodofconfusion exists depends on the appreciation in a global assessment of several factors,which are interdependent. These factors include the similarityof the signs, the similarityofthe goods and services, the distinctiveness of the earliermark, the distinctive and dominant elements of the conflicting signs, and the relevant public.

a) The goods and services

The goods on which the opposition is based are the following:

Class 30: *Coffee, tea, cocoa, sugar, rice, artificial coffee.*

The contested goods and services are the following:

Class 30: *Coffee; flavoured coffee; coffee in whole-bean form; decaffeinated coffee; unroasted coffee; freeze-dried coffee; instant coffee;chocolate coffee; coffee in brewed form; coffee [roasted, powdered, granulated, or in drinks]; coffee, teas and cocoa and substitutes therefor; ground coffee; malt coffee.*

Class 43: *Café services; serving food and drinks.*

As a preliminary remark, it is to be noted that according to Article 33(7) EUTMR, goods or services are not regarded as being similar to or dissimilar from each other on the ground that they appear in the same or different classes under the Nice Classification.

The relevant factors relating to the comparison of the goods or services include, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary ('the Canon criteria'). It is also necessary to take into account, besides the Canon criteria, other factors, namely distribution channels, the relevant public and the usual origin of the goods or services (02/06/2021, T-177/20, Hispano Suiza / Hispano Suiza, EU:T:2021:312, § 21-22).

Contested goods in Class 30

Coffee, tea[s] and cocoa are identically contained in both lists of goods. The contested

unroasted coffee; freeze-dried coffee; instant coffee; chocolate coffee; ground

coffee;flavouredcoffee; coffee in whole-bean form; decaffeinated coffee;coffeein brewed form;coffee[roasted,powdered, granulated, orin drinks]; maltcoffee are included in the broad category of the opponent's *coffee*. Therefore, they are identical.

The contested *substitutes* [of coffee, teas and cocoa] are similar to a high degree to the opponent's *coffee, tea, cocoa.* These goods usually coincide in producer, relevant public, distribution channels and method of use. Furthermore, they are in competition.

Contested services in Class 43

The contested *café services; serving food and drinks* and the opponent's *coffee* and *tea* are similar to a low degree. They can coincide in producer and distribution channels. Furthermore, they are complementary.

The goods and services found to be identical or similar target the public at large, whose degree of attention is average.

c) The signs

Pellini	CAFFÉ FELLINI
Earlier trade mark	Contested sign

The relevant territory is the European Union. The 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 (11/11/1997, C-251/95, Sabèl, EU:C:1997:528, § 23).

The unitary character of the European Union trade mark means that an earlier European Union trade mark can be relied on in opposition proceedings against any application for registration of a European Union trade mark that would adversely affect the protection of the first mark, even if only in relation to the perception of consumers in part of the European Union (18/09/2008, C-514/06 P, ARMAFOAM / NOMAFOAM, EU:C:2008:511, § 57). Therefore, a likelihood of confusion for only part of the relevant public of the European Union is sufficient to reject the contested application.

Although it is regrettable, it must be acknowledged that a significant portion of the public in the relevant territory would not recognise the term 'FELLINI' as referring to the world-famous Italian film director Federico Fellini and would consider it to be meaningless. The earlier mark also consists of a meaningless verbal element (‘PELLINI’). Focusing the assessment on the part of the public who would not attribute any meaning to 'FELLINI' seems to be the best scenario for the opponent, as the contested sign does not transmit any specific meaning to this part of the public that could neutralise the visual and aural similarity with the earlier mark. Both elements ‘PELLINI’ and ‘FELLINI’, being meaningless for the analyzed public, are distinctive to an average degree.

The element 'CAFFÉ' in the contested sign will be understood by the public under analysis to refer to 'coffee', a hot drink made with water and ground or powdered coffee beans. In relation to most of the relevant goods, this term is descriptive and non-distinctive. As regards the products that are not coffee, namely *teas and cocoa and substitutes therefor*, this term is at best weak because, although it does not directly indicate the nature of the products or describe their characteristics, it may refer to the fact that coffee is in any case the main object of the commercial activity of the undertaking in question. Finally, with regard to the services in Class 43, which relate to the provision of food or drink, the element 'CAFFÉ' is of limited distinctiveness, if any, because it describes the nature of the relevant services, namely that they relate to the provision of coffee.

Visually, the signs coincide in the sequence of letters '-ELLINI', which constitutes the ending part of both verbal elements 'Pellini' and 'FELLINI'. However, they differ in their initial letters ('P' versus 'F') and in the presence of the additional element 'CAFFÉ' at the beginning of the contested sign, which is weak or non-distinctive. Furthermore, the earlier mark has figurative elements consisting of stylized coffee beans integrated into the letter design, which are also,

at best, weak in term of distinctiveness.Takingintoaccountthevisualdominance of the verbal elements and the degreeofdistinctivenessofeachelementofthesigns, the latter are visually similar to an aboveaveragedegree.

Aurally, the pronunciationofthesignscoincidesinthesoundoftheletters '-ELLINI', which constitutes the ending partofbothverbalelements.However,theydifferinthe sound of their initial letters ('P' versus'F')andinthepresenceoftheadditionalelement 'CAFFÉ' at the beginning of the contestedsign.Theelement'CAFFÉ'isunlikelytobepronounced, since consumers do not tendtopronouncenon-distinctiveverbalelements(04/02/2013, T-159/11, WALICHNOWY MARKO(fig.)/MAR-KO,EU:T:2013:56,§44).Takinginto account these considerations, the signsareaurallysimilartoahighdegree.

Conceptually, referenceismadetothepreviousassertionsconcerning the semantic content conveyed by themarks.Whereasoneofthemarksismeaningless, the relevant public will perceive theconceptof‘coffee’intheotherone.Tothatextent, the marks are conceptually not similar.However,thisconceptualdifferenceisofverylimited relevance in the overall comparisonofsigns,asitstemsfromaweak/non-distinctivemeaning.

d) Distinctiveness oftheearliermark

The distinctiveness of the earlier markisoneofthefactorstobetakeninto account in the global assessment of likelihood of confusion.

The opponent did not explicitly claim thatitsmarkisparticularlydistinctive by virtue of intensive use or reputation.

Consequently, the assessment of the distinctiveness of the earlier mark will rest on its distinctiveness per se, which is normal.

e) Global assessment, other arguments and conclusion

The appreciation of likelihood of confusion on thepartofthepublic depends, inter alia, on the recognition of the earlier mark on the market,theassociation that can be made with the registered mark, and the degree of similarity betweenthemarks and between the goods or services identified. It must be appreciated globally,takingintoaccount all factors relevant to the circumstances of the case (22/06/1999, C342/97,LloydSchuhfabrik, EU:C:1999:323, § 18; 11/11/1997, C251/95, Sabèl, EU:C:1997:528,§22).

The goods and services are partly identical, partlysimilartoahigh degree and partly similar to a low degree. The relevant public is the publicatlarge,whose degree of attention is average. The earlier mark has a normal degree ofdistinctiveness.

The signs are visually similar to an above averagedegree,aurally similar to a high degree, and conceptually not similar, but this conceptualdifference stems from a weak/non-distinctive meaning.

Account is taken of the fact that average consumers rarely have the chance to make a direct comparison between different marks but must trust in their imperfect recollection of them (22/06/1999, C342/97, Lloyd Schuhfabrik, EU:C:1999:323, § 26).

The differences between the signs are confined to the initial letters ('P' versus 'F') and the presence of the additional (weak or non-distinctive) element 'CAFFÉ' at the beginning of the contested sign, as well as the figurative elements in the earlier mark, which are also (at best) weak. These differences are not sufficient to outweigh the similarities arising from the

identical sequenceofletters'-ELLINI',whichconstitutestheearliermark in almost its entirety and a substantialpartofthecontestedsign.

As regardsthecontestedservicesthathavebeenfoundsimilarto a low degree to the opponent’sgoods,itmustbeborneinmindthatevaluatinglikelihood of confusion implies some interdependencebetweentherelevantfactorsand,inparticular, a similarity between the marksandbetweenthegoodsorservices.Therefore,alesser degree of similarity between goodsandservicesmaybeoffsetbyagreaterdegreeof similarity between the marks andviceversa(29/09/1998,C-39/97,Canon,EU:C:1998:442, § 17). In the present case the visualandauraldegreeofsimilarityofthesignsisdeemed sufficient to offset the low degreeofsimilarityoftheservicesinquestion.

Consideringalltheabove,thereisalikelihoodofconfusiononthatunfortunate section of the publicwhowouldnotrecognisethecontestedsign’selement‘FELLINI' as a surname (in particularthesurnameoftheworld-famousItalianfilmdirectorFederico Fellini. As stated aboveinsectionc)ofthisdecision,alikelihoodofconfusionforonly part of the relevant publicoftheEuropeanUnionissufficienttorejectthecontestedapplication.
Therefore,theoppositioniswellfoundedonthebasisoftheopponent’s EUTM registration No3758182.Itfollowsthatthecontestedtrademarkmustberejected for all the contested goods and services.

COSTS

AccordingtoArticle109(1)EUTMR,thelosingpartyinoppositionproceedings must bear the fees and costs incurred by the other party.

Sincetheapplicantisthelosingparty,itmustbeartheoppositionfee as well as the costs incurred by the opponent in the course of these proceedings.

AccordingtoArticle109(1)and(7)EUTMRandArticle18(1)(c)(i)EUTMIR, the costs to be paid to theopponentaretheoppositionfeeandthecostsofrepresentation, which are to be fixed on thebasisofthemaximumratesettherein.

The Opposition Division

Chiara BORACE Vito PATI Paola ZUMBO

According to Article 67 EUTMR, any party adversely affected by this decision has a right to appeal against this decision. According to Article 68 EUTMR, notice of appeal must be filed in writing at the Office within two months of the date of notification of this decision. It must be filed in the language of the proceedings in which the decision subject to appeal was taken. Furthermore, a written statement of the grounds for appeal must be filed within four months of the same date. The notice of appeal will be deemed to have been filed only when the appeal fee of EUR 720 has been paid.