



World Intellectual Property
Organisation (WIPO)
International Bureau
34, Chemin des Colombettes
1211 Geneva 20
Switzerland

Your Reference:
International Registration No:
WO0000001259963
Examiner: Rachel Peebles
Direct Telephone: +44(0)1633813616
Date: 13 September 2019

Intl Reg No: WO0000001259963
Mark: Bonito (Figurative)
Holder: MLADEGS PAK d.o.o.
Class(es): 29, 30, 32

**Notification Of A Provisional Total Refusal Of Protection Based On An
Opposition By The United Kingdom Intellectual Property Office In
Accordance With Article 5 Of The Madrid Protocol**

I am writing to inform you that following receipt of an opposition to the above trade mark, it is necessary to issue this formal provisional refusal letter. This provisional refusal covers all of the goods of the International Registration.

Please find attached a copy of the TM7 'Notice of Opposition', which includes details of any marks referred to in the statement of case, which was received by the United Kingdom Trade Mark Registry. Copies of these documents have been sent to the holder informing them of this provisional refusal.

If the holder of the International Registration wishes to file a counterstatement, they must complete the form TM8 'Notice of defence and counterstatement', which is available at ipo.gov.uk/tmforms and **return it to this office** within **two months** of the date of this letter that is, on or before, **13 November 2019**. This period cannot be extended, except in the circumstances described below. The holder should note that failure to file a TM8 will result in the provisional refusal being upheld.

If both parties to this dispute wish to negotiate and want to enter a 'cooling off period' then the time for filing the TM8 can be extended for a further seven months by the filing the form TM9c 'Request for a cooling off period, which is available at ipo.gov.uk/tmforms

The TM8 should be received on or before the date requested above unless a cooling off period is entered into by the parties.

The holder of the International Registration must provide us with an address for correspondence in the United Kingdom, another EEA state or the Channel Islands on a form TM33 'Appointment or change of agent or contact address', which is available at ipo.gov.uk/tmforms within this two month period.

If one is not provided within this time the refusal will be made final.

Yours faithfully

Rachel Peebles

Trade Marks Registry

[Skip to main content](#)

Intellectual Property Office

Trade mark number

EU013175278

Status

Registered

Overview

Trade mark

BONITA

Dates

Filing date

14 August 2014

Date of entry in register

25 March 2016

Renewal date

14 August 2024

Goods and services

Classes and terms

Class 29

Class 30

Class 31

Class 32

Names and addresses

Holder's name

FRUIT SHIPPERS LIMITED

Third Floor, Charlotte House, Charlotte Street, Nassau, 10051, Bahamas

Representative**PONS CONSULTORES DE PROPIEDAD INDUSTRIAL, S.A.**

Glorieta Rubén Darío, 4, Madrid, 28010, Spain

Publications**First advert****Journal**

2014/182

Date of publication

29 September 2014

The information displayed is our version of the details supplied by EUIPO. For the official register of the case please refer to the [EUIPO website](#).

Intellectual Property Office is an operating name of the Patent Office



**Intellectual
Property
Office**

IPO
02 SEP 2019
RECEIVED BY FAX

J853187/ 0001 D04877 TM07.....
.02SEP19 100.00 ACCOUNT DP00041752

**TRADE MARK
REC.**
2 SEP 2019
TERM 1

Form TM7

Notice of opposition and statement of grounds

Fee ☒ £100

Opposition based on Section 5(1) and/or 5(2) ONLY

☐ £200

Opposition based on, or including, any other grounds

Note: If you wish to oppose under Section 5(1) and/or 5(2) and one or more other grounds, the fee will be £200

Use this form to notify of an opposition to a trade mark application or international registration and to set out the grounds on which you are basing this opposition.


Do not use this form if you wish to file a Fast Track opposition under Section 5(1) and/or 5(2): use Form TM7F.

1. Trade mark number Number of the trade mark you are opposing. If the opposition concerns an International Registration, help us identify the correct trade mark by adding "IR"	IR 1259963	
2. Full name of applicant/holder Whose trade mark you are opposing	MLADEGS PAK d.o.o.	
3. Full name of opponent	FRUIT SHIPPERS LIMITED	
Address If the address is not within the United Kingdom, European Economic Area (EEA – which includes the European Union) or the Channel Islands you must have a representative in one of these regions and complete section 4 below	Third Floor, Charlotte House	
	Charlotte Street	
	Nassau BS	
		Postcode
NOTE: It will no longer be possible for two (or more) parties to jointly oppose a trade mark based on earlier market rights that they each own, unless the parties jointly own the relevant earlier market rights. Separate oppositions will now be required. See section 38(2A) of the Act.		
Email address Complete if you have no representative and would like us to correspond with you by email		
4. Representative name If you have no representative, go to section 5.	Rapisardi Intellectual Property Limited	
Address The address provided in this section must be in the UK, European Economic Area (EEA) or the Channel Islands.	2A Collier House 163-169 Brompton Road	
	London SWR 1PY GB	
		Postcode
NOTE: We will communicate with the representative if this section has been completed.		
Email address Complete if you would like us to correspond with you by email	rapisardi@rapisardi.com	

5. Related proceedings If applicable, select location of any related proceedings and enter the case number allocated to the proceedings.	IPO Registry	UK Courts	EUIPO
	Number		

6. Opposition notification date If you have informed the applicant/holder of an intention to oppose the trade mark application, designation -- enter the date you notified them. [**See Note]	26/07/2019
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****Note:** An opposition launched without giving the applicant or holder a reasonable opportunity to withdraw the application, international designation or amendment may result in the opponent being ineligible for an award of costs.

7. Declaration	I believe that the facts stated in this form and the attached statement of grounds are true.
Signature	
Name (BLOCK CAPITALS)	ELENA CRISTOFORI
Date	30/08/2019

8. Your reference Complete if you would like us to quote this in communications with you, otherwise leave blank.	OA2370
Contact details Name, daytime telephone number of the person to contact in case of query.	ELENA CRISTOFORI 02074302998
Number of sheets attached to this form	

Checklist

Please make sure you have remembered to:

Sign and date the form

Complete fee sheet (Form FS2)

Enclose the fee and fee sheet. Make cheques payable to Intellectual Property Office

Where to send

Intellectual Property Office
Trade Marks Registry
Concept House
Cardiff Road
Newport
South Wales
NP10 8QQ

Please tick on what grounds you are opposing the trade mark and continue to the relevant section(s)



Opposition is based on Sections 5(1) or 5(2): The trade mark is either identical or similar to an earlier trade mark and is to be registered for identical and/or similar goods and services.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark.

> COMPLETE SECTION A



Opposition is based on Section 5(3): The trade mark is either identical or similar to an earlier trade mark which has a reputation. Using the later mark would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier trade mark. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION B



Opposition is based on Section 5(4)(a): Where the use of the applicant's trade mark would be contrary to law, in particular, the law of passing off.

Note: Opposition on these grounds must be made by the 'proprietor' (owner) of the earlier right. Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION C



Opposition is based on Section 3: The trade mark is excluded from registration because it describes the goods/services, or is not distinctive, or consists of signs that are customary within the trade, or the application was made in bad faith.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION D



Opposition is based on other grounds.

Note: Ticking this box means that the total fee for this form is £200.

> COMPLETE SECTION E

SECTION A: Opposition is based on sections 5(1) or 5(2) of the Trade Marks Act on the basis of an earlier registered or pending mark.

Please tick the relevant section(s) that apply.

<input type="checkbox"/>	5(1) It is identical with an earlier mark and for identical goods or services as the earlier mark
<input type="checkbox"/>	5(2)(a) It is identical with an earlier mark and for similar goods or services as the earlier mark.
<input checked="" type="checkbox"/>	5(2)(b) It is similar to an earlier mark and for identical or similar goods or services as the earlier mark.

You must use a separate sheet for each earlier mark, so copy this sheet as many times as you need.

ABOUT THE EARLIER TRADE MARK

Trade mark number
Your trade mark

013176278

Type of mark
Please tick

☐ UK



EUTM

☐ International

Representation of your trade mark

Enter your trade mark in the space provided - use a continuation sheet if necessary.

BONITA

Q1. Which goods or services covered by the earlier trade mark are relied upon for the opposition?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q2. STATEMENT OF USE - Was the registration or protection process for the earlier trade mark completed 5 years or more before the application date (or priority date, if applicable) of the application or international registration you wish to oppose?

☐ Yes



No > GO TO Q4

Q3. Has the trade mark been used in the 5-year period ending on the date of application (or priority date, if applicable) of the opposed mark?

☐ Yes



No > GO TO Q3b

Q3a. For which of the goods and services listed at Q1 is trade mark use being claimed?

<input type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

> GO TO Q4.

TM7

Q3b. Please state any proper reasons for non-use.

DETAILS OF THE TRADE MARK YOU ARE OPPOSING

Q4. Which goods or services in the application that you are opposing do you claim are identical or similar to those covered by the earlier mark which you have listed at Q1?

<input checked="" type="checkbox"/>	All goods and services
<input type="checkbox"/>	Some goods and services (please specify below, use a continuation sheet if necessary)

Q5. Use this space to supply any further information about why you consider there is a likelihood of confusion and e.g. why you consider the respective marks or goods and/or services to be similar.

Please see the attached statement of grounds.

OA2370

**IN THE MATTER OF IR TRADE
MARK No. 1259963 "BONITO"
(figurative) IN CLASSES 29, 30, 32
IN THE NAME OF MLADEGS
PAK d.o.o. AND OPPOSITION
THERETO BY FRUIT SHIPPERS
LIMITED**

STATEMENT OF GROUNDS OF OPPOSITION

1. The Opponent is FRUIT SHIPPERS LIMITED of Third Floor, Charlotte House, Charlotte Street, Nassau 10051, Bahamas.
2. The Opponent is the proprietor of, among others, the EUTM registration No. 013175278 "Bonita" which predates the IR trade mark no. 1259963 under opposition.
3. The trademark under opposition, IR no. 1259963, "Bonito" (figurative) designating the UK, was filed in the name of MLADEGS PAK d.o.o. for the following goods:

Class 29: Bouillons, beef soups, vegetable soups, bouillon concentrates; sour cream (dairy products); preserved fruit; dried vegetables; chocolate milk.

Class 30: Ketchup; cakes (powder for cakes), cakes (paste for cakes), mayonnaise; spices; sugar, malt (malt extract) for food, seasonings, vanilla; farinaceous food pastes; oat flakes; puddings.

Class 32: Fruit juices; non-alcoholic fruit extracts; non-alcoholic fruit juice beverages.

4. The applicant's sign is very similar to the Opponent's sign and covers goods that are identical or similar to the goods covered by the Opponent's prior registration. As a result, confusion on the part of

the average consumer is inevitable and the contested trademark should therefore be refused registration pursuant to Section 5(2)(b) of the UK Trade Marks Act 1994.

COMPARISON OF THE GOODS AND SERVICES

5. The opposition is directed against all the goods covered by the contested IR trademark.
6. The goods covered by the contested mark are effectively partly identical and partly similar to those covered by the Opponent's prior registration:

Class 29: Meat, fish, poultry and game except in frozen form; meat extracts except in frozen form; milk and milk products except in frozen form; eggs except in frozen form; preserved, dried, baked, cooked and preserved fruits and vegetables; jellies, jams, compotes; Fruit salads; Fruit-based snack food.

Class 30: Sugar except in frozen form; natural sweeteners except in frozen form; bakery products, bread, yeast except in frozen form; pasta, baking-powder, flour, spices, and flavourings except in frozen form; honey and honey substitutes except in frozen form; food products based on rice, flour or cereals, also in the form of cooked dishes except in frozen form; Coffee; coffee extracts and coffee-based preparations; coffee substitutes and extracts of coffee substitutes; coffee beans; unroasted coffee; ground coffee; decaffeinated coffee; instant coffee; coffee drinks; coffee beverages; coffee mixtures; flavoured coffee; roasted coffee beans; ground coffee beans; prepared coffee and coffee-based beverages; coffee based drinks; coffee in brewed; coffee in ground form; coffee beverages with milk; ice beverages with a coffee base; filters in the form of paper bags filled with coffee, tea, tea extracts and tea-based preparations; cocoa and preparations having a base of cocoa, chocolate, chocolate products; puddings; breakfast cereals, rice, pasta, also in the form of cooked dishes; fruit sauces; none of the afore-mentioned goods being confectionery, ice, ice cream, ice cream confections, chocolate spread, cakes, biscuits or mousses.

Class 31: Fresh fruits and vegetables live animals; seeds; foodstuffs for animals, malt; agricultural, horticultural and forestry products and grains not included in other classes and excluding natural plants and flowers.

Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages; fruit extracts; fruit nectars, non-alcoholic; smoothies.

COMPARISON OF SIGNS

7. According to the judgment of the European Court of November 11, 1997, in Case C251/95 SABEL BV v. PUMA AG, the global appreciation of the visual, aural and conceptual similarity of the signs in question must be based on the overall impression given by the signs, bearing in mind, in particular, their dominant and distinctive components.
8. The Applicant's sign consists of the word BONITO in fanciful frame. The Opponent's sign consists of the word BONITA.
9. Visually, the signs in comparison are clearly very similar, as they share five letters out of six in the same order; the only difference is in the last letter, which is not clearly recalled by the consumers.
10. Aurally, the words BONITO and BONITA are very similar (almost identical) since they share the same five letters "B-O-N-I-T".

CONCLUSION

13. Likelihood of confusion must be appreciated globally, taking into account all factors relevant to the case. The global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the signs and between the goods and services.
14. Taking into account all the relevant factors of the case, it is concluded that, because of the high similarity of the signs and similarity or identity of the goods, there is a likelihood of confusion in respect of all the contested goods.
15. The Applicant has had notice of the Opponent's intention to file this opposition.

16. We therefore respectfully request refusal of the IR trade mark no. 1259963 designating UK for all goods and an award of costs in the Opponent's favour.

Rapisardi Intellectual Property Limited