

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2007814
IN THE NAME OF IÑIGO CAVERO LATAILLADE**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 43934 IN THE NAME OF
MIGUEL TORRES S.A.**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2007814 in the name of
Iñigo Cavero Lataillade**

5

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**IN THE MATTER OF opposition thereto under No 43934
in the name of Miguel Torres S.A.**

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15 **Background**

On 14 January 1995, Iñigo Cavero Lataillade, of Torrelaguna 67, Bajo, 28027 Madrid, Spain, applied to register the trade mark BARON DE LA TORRE in Class 33 in respect of the following goods:

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Wines.

On 18 January 1996, Miguel Torres S.A. filed notice of opposition to this application. The grounds of opposition are in summary:-

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1. The opponents are the proprietors of 10 earlier trade marks. The mark applied for is so similar to these earlier trade marks and is to be registered for goods identical with or so similar to those for which the earlier trade marks are protected that there exists a likelihood of confusion and association. Details of the marks referred to are set as an annex to this decision.
2. The mark applied for is so similar to the opponents' earlier trade marks and is to be registered for goods which are not so similar to those for which the earlier trade mark is protected that use of the trade mark applied for without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade marks.

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The opponents ask that the application be refused and that costs be awarded in their favour.

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The applicants filed a counterstatement in which they deny the grounds of opposition, and ask that the application be allowed to proceed to registration and that costs be awarded in their favour.

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Both sides filed evidence in these proceedings. The matter came to be heard on 29 November 1999, when the applicants were represented by Mr Thomas Mitcheson of Counsel, instructed by Castles, their trade mark attorneys, the opponents were represented by Ms Madeline Heal of Counsel, instructed by Raworth Moss & Cook, their trade mark attorneys.

Opponents' evidence

5 This consists of two Statutory Declarations. The first is dated 6 November 1996, and comes from Senor Angel de la Rubia Perez, the Manager of Miguel Torres S.A., a position he has held since 28 June 1989.

10 Mr Perez begins by outlining the commercial history of his company, which he says began with a trade in wine in 1870, and which has subsequently been extended to include spirits and liqueurs which are exported to over 80 countries. He says that his company produces over 40 different wines, spirits and liqueurs; he believes it is the 21st largest producer and exporter of these goods, the 12th largest producer and exporter of Spanish wines and the leading producer of quality wines with an Appellation of Origin. He refers to exhibit ARP1 which consists of booklets and leaflets depicting a range of wines, brandy and a liqueur. Mr Perez highlights the labels which bear the word TORRES, MIGUEL TORRES and his company's THREE TOWER device which is a trade mark registered in the United Kingdom under number 1134608, and goes on to refer to exhibit 15 ARP2 which consists of a selection of labels from wine bottles, the earliest dating from 1964, and containing the TORRES name and tower device.

20 Mr Perez goes on to set out a list of trade marks his company has registered in the United Kingdom, highlighting those which contain the word TORRES. He gives his, and his company's reaction to the application to register BARON DE LA TORRE, which he says is similar to some of his company's registered marks. He sets out his company's trade in the United Kingdom from 1990 onwards and which ranges from approximately 54,000 cases sold in 1990 to approximately 25 72,000 cases in 1995 although he does not say whether this relates to sales under a TORRES trade mark.

30 Mr Perez next refers to his company's promotional activities which he says are handled by local agents although his company provides promotional materials, and has spent approximately 15% of the value of its sales on promotion. He refers again to exhibit ARP1, and in particular, to the bold way in which the words TORRES and MIGUEL TORRES is shown on the labels.

35 He next refers to exhibit ARP3 which consists of extracts from The Bottoms Up Wine Guide for 1996 in which he notes the way in which the name of his company's and the applicants' wines are shown, The Nicolas wine list for Summer 1996 in which his company's Gran Sangre De Torro is listed, and the Odd Bins List Summer 1995 in which TORRE is used to identify his company as a producer. Mr Perez says that the inclusion of the name of the applicants' wine in these lists would cause confusion, which would in part be caused by the way in which the name would be shown. He goes on to say that in November 1995 his company had contacted the applicants and notified them of their objections, and refers to the opposition which was subsequently filed. 40

45 Mr Perez says that he is aware that in the United Kingdom wines are mainly sold through specific wine shops and supermarkets. He says that where wines are displayed for sale on shelves they are grouped by their region or country of origin, and consequently, his company's TORRES or TORRE wines will be displayed in close proximity to the applicants' wines, and that the public will associate and confuse the two. He also says that when bottles are placed on a shelf, part of the label will be hidden from view which could lead to only the TORRE part of the applicants' label being visible and that the applicants' wine will be mistakenly purchased in place of the

opponents' wine. He refers to his company's attempts to obtain a sample of the labels used by the applicants to compare the script used on these with that on their own labels. He says that they have not been able to obtain a sample which he says is because the wines are not yet on sale.

5 Mr Perez goes on to state his company's approach to other traders trying to register a trade mark with the word TORRES or TORRE as an element. He refers in particular to an application to register the mark TORRE NOVA, which was opposed by the current opponents but was nonetheless allowed to proceed and is now registered. He says that the TORRE NOVA case can be distinguished from the current proceedings because the application had been for a less
10 expensive wine from a different geographical region (Italy) and that they appeared in different locations in retail establishments and on wholesale wine lists.

The second Statutory Declaration is dated 12 November 1996, and comes from Alison Dillon, the Brand Manager of John E Fells & Sons Limited, a position she has held for approximately 3 years.
15 Ms Dillon says that she has worked in the wine trade for 9 years but does not say where or in what capacity.

Ms Dillon refers to the mark sought to be registered, and goes on to give her view that the use of the word TORRE in the trade mark will lead to confusion. She says that she is aware that most
20 retailer of wine in the United Kingdom stock wines on shelves by the country of origin, and consequently, the applicants' and the opponents' wines will appear in the same area and will lead to confusion. Ms Dillon says that up to 60% of a label may be obscured when placed on a shelf and it is possible that only the TORRE part of the applicants' mark will be visible and will lead to confusion. She concludes by giving her views on the consequences should an unscrupulous
25 trader sell a cheaper BARON DE LA TORRE wine, which she says would lead to deception.

Applicants' evidence

This consists of two Statutory Declarations. The first is dated 7 July 1997, and executed by Iñigo
30 Cavero Lataillade, President of the Counsel of State, a position he has held since 24 May 1996; he is also the current Barón de la Torre, a title which was granted to his family on 28 July 1750. He refers to exhibit ICL1 which is a copy of the Royal letter of succession to the title.

Senor Lataillade says that he has granted Bodegas Julian Chivite the exclusive right to use the words Barón de la Torre in connection with wines produced by that company, and in order to
35 secure statutory protection for the name as a trade mark, has made an application for the registration of the words Barón de la Torre in many countries, including the United Kingdom. He refers to exhibit ICL2 which is a copy of the publication of the acceptance of his trade mark in the Trade Marks Journal, and which has been opposed by Miguel Torres S.A. He concludes by
40 saying that by Royal Decree he is fully entitled to the ownership and use of the title Barón de la Torre.

The second Statutory Declaration is dated 2 July 1997 and comes from Julian Chivite, General
45 Manager of Herederos de Julain Chivite Marco, which owns and runs the Estate Chivite in Navarra, Spain. Mr Chivite confirms that he has held his current position since 1970.

Mr Chivite says that the wine has been produced on the Estate Chivite since 1647 and is now the

largest wine producer in the region of Navarra, and with its associated vineyards accounts for more than 60% of the wine exported from that region. He sets out his family connections with the family of Barón de la Torre, and confirms that his company has been granted exclusive rights to use the name as a trade mark on wines.

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Mr Chivite sets out the chronology of events from the filing of the trade mark application, the publication of the acceptance in the Trade Marks Journal and the subsequent opposition filed by Miguel Torres S.A. He refers to the opponents' evidence starting with their claims to exclusive rights in the word TORRES, (which he agrees is the Spanish for "towers") saying that the word is only ever used with a three tower device which is how the mark would be remembered by the British buying public. He says that the opponents do not say that the labels shown in exhibit ARP2 or the trade marks which they have registered are being used in the United Kingdom, or the date of first use, and he notes that in some instances the word TORRES has been disclaimed. He gives his views on the lack of similarity of specified trade marks with the mark applied for, asserting that they are consequently irrelevant, and in one case he says that the goods covered are not the same.

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Mr Chivite refers to Mr Perez's Declaration in which he gives details of the opponents' sales, noting that he does not give details of the trade marks that the sales and promotion relate to, or the figure in paragraph 4 of which the 15% referred to is said to have been spent on promotional activities, nor does it say how many and to whom the leaflets referred to in paragraph 12 were distributed. He says that the price lists in exhibit ARP3 are dated after the relevant date and should be disregarded. Mr Chivite comments on the way in which BARON DE LA TORRE may appear in an alphabetical listing of wines which he says would be by company name, or should the listing be by wine, would be categorised under the letter B, whereas the opponents wine would be under the letter T.

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He gives his view that taking into account imperfect recollection, his company's wine would be recalled by the first part BARON, a known English word meaning a title, whereas the opponents' mark would be remembered by the word TORRE which, when used with their tower device would bring to mind a tower.

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Mr Chivite denies Mr Perez's assertion of a similarity in the respective marks and his claim to the likelihood of confusion, referring to other opposition proceedings and noting the outcome. He refers to exhibit JC1 which is a copy of a treaty signed between Switzerland and Spain on the protection of Appellations, and which shows Utiel Requena as a protected Appellation and La Torre as a commune pertaining to that Appellation.

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Mr Chivite again refutes the suggestion that the mark applied for is similar to the opponents' marks listed in paragraphs 7 and 8 of Mr Perez's Declaration, particularly when viewed in their totality. He refers to information given to him by his United Kingdom trade mark attorneys.

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Mr Chivite says that he does not believe that confusion will arise should the respective wines be sold in close proximity. He says this is because the majority of the label will be seen by the purchaser, either when on display or after removing the bottle from the shelf, because of the cost of wine and that the bottle will not be selected without reading the label. He goes on to refer to his understanding of the popularity and knowledge of wine in the United Kingdom, which he says

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he has been told is a result of coverage in the media. Mr Chivite also says that he has been told that most wine in the United Kingdom is purchased from supermarkets where employees are specially qualified to give advice, and he draws the conclusion that this eliminates the likelihood of confusion.

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Mr Chivite returns to Mr Perez's Declaration, and in particular to his statement that the opponents have been unable to obtain samples of the applicants' labels, which he says is because at the date of the Declaration (1996) his company had not sold any wine in the United Kingdom under the BARON DE LA TORRE name. He goes on to comment on paragraph 20 in which Mr Perez refers to his company's opposition to applications to register trade marks incorporating the word TORRE or TORRES. Mr Chivite refers to details of trade mark registrations incorporating the word TORRE, details of which he shows at exhibit JC2. He refers to the opposition involving the trade mark TORRE NOVA and to the decision by the Hearing Officer in that case.

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Mr Chivite next refers to the Statutory Declaration by Alison Dillon, and in particular, to paragraph 6 in which she states that purchasers of wine from her company will recognise the wines from the opponents and will recognise it as TORRES wine. He comments that Ms Dillon's company are wine specialists and not representative of the public, and that purchasers who recognise the wine by TORRES are likely to have some prior knowledge and this reduces the likelihood of confusion.

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Mr Chivite next comments on Ms Dillon's claim that when displayed on a shelf up to 60% of a label on a bottle will be obscured by other bottles. This he says is a high estimate and refers to exhibit JC3 which consists of a photograph of three wine bottles placed side by side. He denies that his company is trying to trade on the opponents' reputation, noting that the name BARON DE LA TORRE is the title of a member of the nobility who has authorised its use.

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Mr Chivite goes on to set out details of his company's intended use of the trade mark, which, he says, will be on a wine of higher retail cost than the opponents, and which in turn will reduce the likelihood of confusion. He concludes his Declaration by reiterating why he considers that the opposition should be refused.

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That concludes my review of the evidence insofar as it is relevant to these proceedings.

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Decision

Prior to the hearing on the substantive issues, a preliminary point was considered. The Statement of Grounds does not particularise the sections of the Act to which the objections related, although it was reasonably clear that the first ground of opposition was founded under Section 5(2)(b). The language of the second ground suggested this to be an objection under Section 5(3), although at the hearing Ms Heal sought to bring this under Section 5(4)(a) and asked for leave to amend the grounds to include that section. After hearing submissions from both sides and a short adjournment to allow the respective clients to be consulted, Ms Heal withdrew the second ground of opposition, and consequently the opposition falls to be decided on Section 5(2)(b) alone. That section reads as follows:

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

- (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

5 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

An earlier right is defined in Section 6 the relevant parts of which state:

10 **6. (1)** In this Act an “earlier trade mark” means -

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

The opponents rely on ten trade mark registrations, eight of which mention wines in the specification of goods, and which are the self same goods for which the applicants seek to register their mark. The remaining two trade mark registration are registered in respect of brandy, and scotch whiskey, which given the decision of Geoffrey Hobbs QC sitting as the Appointed Person in the Balmoral trade mark case (1999) RPC 8) must be considered to be similar goods to wine. The issue will therefore be determined on a comparison of the respective marks, and I propose to consider the matter on the basis of the approach adopted by the European Court of Justice in SABEL v. PUMA 1998 RPC 199. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that:

“..... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore 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 wording of Article 4(1)(b) of the Directive- ‘..... there exists a likelihood of confusion on the part of the public’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (Case C-39/97) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

5 “A global assessment of the likelihood of confusion implies some interdependence
between the relevant factors, and in particular a similarity between the trade marks and
between these goods or services. Accordingly, a lesser degree of similarity between these
goods or services may be offset by a greater degree of similarity between the marks, and
vice versa. The interdependence of these factors is expressly mentioned in the tenth
recital of the preamble to the Directive, which states that it is indispensable to give an
interpretation of the concept of similarity in relation to the likelihood of confusion, the
appreciation of which depends, in particular, on the recognition of the trade mark on the
market and the degree of similarity between the mark and the sign and between the goods
or services identified.”

10 Finally, the court gave the following judgement on the interpretation of Article 4(1)(b):

15 “On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21
December 1988 to approximate the laws of the Member States relating to trade marks,
the distinctive character of the earlier trade mark, and in particular its reputation, must be
taken into account when determining whether the similarity between the goods or services
covered by the two trade marks is sufficient to give rise to the likelihood of confusion.

20 While the consideration of the likelihood of confusion requires a composite approach, it is
inevitable that in reaching a decision reference will be made to the similarity of individual elements
of the marks. It is self evident that any degree of similarity must rest in the word TORRE forming
the terminal word of the applicants’ trade mark and which is said to be the Spanish word meaning
TOWER. Eight of the opponents’ earlier trade marks consist of, or include the word TORRES
and in respect of these marks there must be at least some degree of visual and aural similarity.

25 The remainder of the opponents’ earlier trade marks consist of the words OLD TOWER or the
device of THREE TOWERS which are visually very different and for there to be any degree of
aural similarity requires a person on seeing them to refer to them in Spanish. Bearing in mind that
I am considering the position as it is likely to exist within the United Kingdom, I see no reason
why this should be the case and I am led to the conclusion that in respect of these marks there is
no aural similarity.

30 The applicants’ trade mark is the words BARON DE LA TORRE and conveys the idea of an
aristocratic title which is what the evidence shows it to be. The opponents’ earlier trade marks,
and in particular, those that incorporate or consist of the opponents’ TOWER device bring to
mind the idea of a structure, or in the case of mark number 1404075 for the mark MIGUEL
TORRES, a persons name. The most that can be said is that individually the words TORRE and
TORRES are conceptually similar, but when the marks are considered as a whole this conceptual
similarity is considerably reduced.

35 In my view the evidence establishes that the opponents are likely to have built a reputation for
their TORRES marks in respect of wines. They may also have done so in respect of the THREE
TOWERS device although as this appears to primarily be used in conjunction with other trade
mark matter this cannot be taken as having been established by the evidence in these proceedings.

40 The opponent’s case appears to be based upon the likelihood of there being confusion through




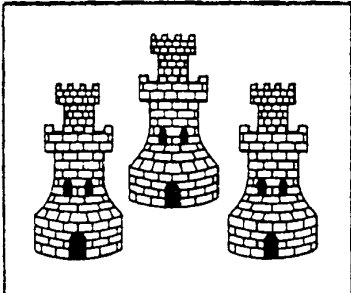
imperfect recollection, and relies upon the argument that the inclusion of the words BARON DE LA in the applicants' mark will be insufficient to indicate a different trade origin to the public, but also that the term TORRE will be picked out of the applicants' mark, and through imperfect recollection, confused with the opponents' mark. The word TORRE in the applicants' trade mark is no more the essential feature than the word BARON. If anything, it could be argued that being at the end of the mark which is generally regarded as the least important element of a mark (see TRIPCASTROID 42 RPC 72) it is of lesser importance and it is the preceding words which serve to create the identity of the mark. I also have regard to the SABEL- PUMA case in which it was said "The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details." which, if applied to this case would support the view that there is little real likelihood of confusion.

It was argued that as the applicants' and opponents' wines both originate from Spain, they would be displayed in close proximity on shelves, and that confusion would arise should part of the applicants' trade mark be obscured. My attention was also drawn to the manner in which the names of wines are recorded in the wine lists of various merchants. Where as in this case a producer makes a variety of different type of wines, it seems unlikely that a bottle will be purchased by reference to the name alone. Selection will be made with a degree of care, often by removing the bottle from the shelf and studying the label in some detail. In Case C-342-97, Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V., Advocate General Jacobs concluded that he doubted "whether the average consumer of the goods in question who is reasonably well informed and reasonably observant and circumspect" would be misled. This is a fair assessment of my conclusions in this case, and I find that I have no difficulty in reaching the view that the trade mark applied for and the opponents' earlier trade marks are not so similar as to create a likelihood of confusion, and that the opposition under Section 5(2)(b) founded on these marks fails.

The opposition having failed on all grounds I order the opponents to pay the applicants the sum of £635 as a contribution towards their costs.

Dated this 24 day of February 2000

**Mike Foley
for the Registrar
The Comptroller General**

| Number | Mark | Class | Specification |
|---|---|---|----------------|
| 5 | 857391 | 33 | Wines. |
| 10 |  | | |
| 15 | 891250 | 33 | Spanish wines. |
| 20 |  | | |
| 25 | 1039853 | TORRES | 33 |
| Table wines for sale in England and Scotland. | | | |
| 30 | 1039854 |  | 33 |
| Brandy | | | |
| 35 | 1079971 | OLD TOWER | 33 |
| Scotch whiskey. | | | |
| 40 | 1123105 | TRES TORRES | 33 |
| Wines, liqueurs and spirits (beverages). | | | |
| 45 | 1134608 |  | 33 |
| Wines, spirits (beverages) and liqueurs. | | | |

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|---|---------|-----------------|----|---|
| | 1298955 | TORRES | 33 | Wines, brandy and brandy based orange liqueurs; all included in Class 33. |
| 5 | 1404075 | MIGUEL TORRES | 33 | Wines, sparkling wine, brandy and liqueurs; all included in Class 33. |
| | 1404528 | TORRES MILMANDA | 33 | Wines included in Class 33. |