

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2178911 BY
VINA TORREBLANCA S.L. TO REGISTER A MARK
IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 49512
BY MIGUEL TORRES S.A.**

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DECISION

On 6 October 1998 Vina Torreblanca S.L. applied to register the following mark for a specification of "wines, spirits and liqueurs" in Class 33:



The application is numbered 2178911.

On 25 February 1999 Miguel Torres SA filed notice of opposition to this application based on their proprietorship of the marks set out in the Annex to this decision.

It is said that objections arise as follows:

- (i) under Section 5(2). (Although not expressly referred to the wording of the objection closely follows the wording of the Section)
- (ii) under Section 5(3). Again the Section is not mentioned but the wording suggests that this Section provides an alternative basis for objection in the event that I find the goods are not similar. Moreover at least one of the opponents' marks is said to have been used since 1965 and to have a reputation in the UK

- (iii) under Section 5(4) having regard to the opponents' use of the word TORRES in the form of dark rectangular labels incorporating heraldic shield devices.

5 The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour.

10 Both sides filed evidence. The parties have agreed that a decision should be taken from the papers on file and without recourse to a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

15 The opponents filed a declaration dated 5 October 1999 by Angel de La Rubia Perez, the Manager of Miguel Torres S.A. He confirms that he is fully conversant with the English language.

20 Senor Perez describes the background to his company's business in the following terms:

"My Company is registered in Spain and owned by the TORRES family, a family who have owned vineyards in Spain in one capacity or another for over three centuries. During the last century the wines produced and bottled on the TORRES family vineyards in Spain have been particular to the Penedès area of Spain near Barcelona - which comprise of a number of vineyards in the town of Vilafranca del Penedès. The wines and beverages from this region made their début onto the world wine market as long ago as 1870, since which time my Company has extended their range of produce to include wines, spirits, and liqueurs (hereinafter referred to as "the Goods"), whereas the production areas have also extended into other parts of Spain, as well as to Chile in 1980 and to California, U.S.A., in 1982. By "my Company" I am including its Chilean and Californian branches.

35 My Company now exports to over 80 countries in the world where it has established a substantial reputation for the Goods. I believe that my Company is the 21st largest producer and exporter of Spanish wines, spirits and liqueurs and the 12th largest producer and exporter of Spanish wines. Moreover, my Company, is the leading producer of quality bottled wines with Appellation of Origin. Currently my Company produces over 40 different wines, spirits and liqueurs worldwide.

40 I am now produced and shown Exhibit-ARP1 which comprises true copies of a set of booklets and leaflets produced by my Company. In each of the documents is depicted a part of the range of the goods offered by my Company. Each bottle produced and sold bears a distinctive label with the word TORRES and/or the name MIGUEL TORRES, as well as my Company's three-tower device which is registered in the UK
45 under Registration No. 1134608."

He also exhibits (ARP-2) copies of a number of labels used by his company containing the

words TORRES or MIGUEL TORRES and three tower device and confirms the existence of various trade mark registrations.

Sale of goods are said to have been as follows (worldwide and European sales are also given but I will concentrate on UK sales for present purposes).

| | | Cases | | |
|----|----------------------|--------|--------|--------|
| | | Wine | Brandy | Total |
| 10 | 1990 | 54,526 | 162 | 54,688 |
| | 1991 | 59,320 | 355 | 59,675 |
| | 1992 | 60,004 | 544 | 60,548 |
| | 1993 | 64,702 | 502 | 65,204 |
| 15 | 1994 | 68,915 | 588 | 69,503 |
| | 1995 | 72,275 | 486 | 72,761 |
| | 1996 | 76,498 | 687 | 77,185 |
| | 1997 | 78,953 | 580 | 79,533 |
| 20 | 1998 (9 months only) | 62,527 | 368 | 62,895 |

Promotion of the goods is handled by local agents with about 15 per cent of total revenue spent on advertising by means of leaflets, information booklets etc. Senor Perez also exhibits (ARP-3) extracts from three UK wine merchants' price lists where the goods are referred to. He suggests that the applicants' mark would be listed alongside these. Much of the remainder of the declaration is in the nature of submissions as to why confusion could occur. The main points are:

S the word TORREMAR appearing in the mark could be mis-remembered as TORRESMAR and so be thought of as goods from the TORRES stable

S the applicants' name includes the prefix TORRE with the descriptive elements VINA and BLANCA

S wines are normally stacked on shelves in retail outlets by reference to the geographical area of origin which would increase the likelihood of the goods appearing in close proximity to each other

S labels can be partially obscured when placed on shelves

S the opponents take action against attempts to use or register the words TORRE or TORRES by other companies. Senor Perez distinguishes a recent case (TORRE NOVA) based on insufficient similarity between the respective marks and the fact that the goods were in a different price range and of Italian origin

S reference is made to oppositions filed against two other applications and a declaration (ARP - 4) filed by a UK wine stockist in support of one of these oppositions.

5 **Applicants' evidence**

The applicants filed a declaration dated 27 April 2000 by Dr Martin Kern, their General Manager. He confirms that he is familiar with the English language.

10 In the main Dr Kern's evidence is in the nature of submissions in relation to Senor Perez's declaration. His main points are that:

S the opponents' evidence does not substantiate the claim to a substantial reputation or relate any such claim to particular marks

15

S Exhibit ARP - 1 is in part in Spanish and not relevant to these proceedings. Similarly the references to the 'three tower device' are not relevant

S other TORRE prefixed registrations exist on the UK register (Exhibit MK 1)

20

S the comments regarding advertising and promotion of the opponents' marks relate to the position throughout the world and not the UK alone

S the extracts from wine merchants' price lists are not in themselves evidence of a likelihood of confusion.

25

That concludes my review of the evidence.

Section 5(2) appears to be the main ground of attack. The Section reads as follows:

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

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

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(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,

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

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As identical marks are not involved sub paragraph (b) applies here.

I take into account the guidance provided by the European Court of Justice in Sabel BV v Puma AG (1998 RPC 199 at 224), Canon v MGM (1999 RPC 117) and Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BC (1999 ETMR 690 at 698).

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It is clear from these cases that:-

- 5
- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- 10
- (b) the matter must be judged through the eyes of the average consumer, of the goods/services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;
- 15
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- 20
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;
- 25
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it.

30

It will be apparent from the Annex to this decision that the opponents rely on a number of registrations, some of them consisting of the word TORRES alone, others TORRES with additional words and yet others incorporating device elements. I have considered all the marks referred to in the statement of grounds and take the view that where words or devices are present in addition to the word TORRES the opponents are generally in a less favourable position as the other matter serves to further differentiate the opponents' marks from the mark applied for. In other words the registration of the word TORRES alone offers the opponents their best chance of success. This also appears to be the primary basis on which Senor Perez puts his company's case.

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I propose, therefore to base my consideration of the matter on No. 1298955 which is for the word TORRES solus and has a specification for wines, brandy and brandy-based orange liqueurs. It is, I think, beyond dispute that the goods of the applicants' specification are identical or closely similar to those of No. 1298955. The matter, therefore, turns on my view of the marks themselves.

40

The mark applied for is a composite one consisting of what is probably a label with a shield device surmounting the word TORREMAR and an abstract 'splash' across the bottom of the mark. It seems likely that the word TORREMAR would be taken to be a distinctive and dominant component of the mark. Whilst I do not forget the need to consider the mark as a whole a finding that TORREMAR and TORRES were confusingly similar would be a strong indicator in the opponents' favour.

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Visually the respective words have some superficial similarity to the extent that they have the first five letters in common but the differences in their overall length and appearance cancel out the initial point of similarity. Aurally the words are quite different and unlikely to be confused. Not only is one a two syllable word and the other three but I can see no reason why
5 the ending of TORREMAR should be slurred to the point where there is a risk of confusion with TORRES. In terms of the meaning of the words TORRES is evidently a surname but also means 'tower'. Whether either signification would be apparent to a UK audience is not clear. It is not suggested that TORREMAR has any particular meaning.

10 Senor Perez says that "the word TORREMAR which appears prominently in the mark could, in my opinion, be easily mis-remembered as TORRESMAR and so could be thought of as one of my company's TORRES wines, spirits or liqueurs. Furthermore the mark as a whole has a striking resemblance to some of my company's bottle labels.....". No explanation or basis is offered for these views. The former effectively invites me to consider a different mark and the
15 latter does not accord with my view of the labels in question. I also reject the opponents' arguments in so far as they are based on the applicant company's name (Vina Torreblanca S.L.) which it is suggested incorporate the descriptive elements 'vina' and 'blanca'. I am not dealing with an application for the company name.

20 It has also been suggested that confusion will arise if two Spanish wines with similar names happen to be placed together or in close proximity on shelves in retail outlets. However I take the view that the average person is likely to exercise some care when selecting such goods and is unlikely to be confused. Even making due allowance also for imperfect recollection I have little hesitation in concluding that on a straightforward comparison of the marks there is no
25 likelihood of confusion.

However, I must also consider whether all or any of the opponents' marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them (criteria (f) above) and, if so, whether this suggests a different outcome.
30 On the basis of the evidence I find that:

S there has been a not insignificant volume of sales but that there is no disaggregation of the sales as between the various marks claimed

35 S the most likely position is that the word TORRES is a common feature but used almost exclusively it would seem with the three tower device

S to the extent that Exhibit ARP-1 contains a Spanish language brochure I assume it is not directed towards the UK market

40 S to the extent that ARP-1 contains English text it shows TORRES with the three tower device and often with other trade mark matter featuring on bottle labels

45 S ARP-2 consists of bottle labels with TORRES and (without exception) the three tower device in various forms. Other trade mark matter is often present (TRES TORRES, CORONAS, SAN VALENTIN etc.)

S the wine merchant lists (ARP-3) whilst not displaying labels generally show TORRES in combination with other trade mark matter

5 S Ms Dillon's declaration (ARP-4) was prepared for an opposition to a different mark and is of little assistance.

10 I conclude that any enhanced level of reputation enjoyed by the opponents is likely to be in the mark TORRES with the three tower device but that without a more detailed breakdown of the trade even this much is not beyond dispute. I have, however, come to the view that the evidence as to any enhanced distinctive character acquired through use does not displace my prima facie view. The opposition thus fails under Section 5(2)(b).

15 In the light of my finding that identical and/or closely similar goods are involved I do not need to consider the opponents' alternative position based on Section 5(3). That ground, therefore, falls away.

20 In relation to Section 5(4)(a) the opponents refer to unregistered rights for "trade marks consisting of or comprising the word TORRES in the form of dark rectangular labels incorporating heraldic shield devices". It is not clear to me precisely what marks or signs are being referred to beyond those contained in the Exhibits which show a variety of marks based on the word TORRES and three towers device and a variety of supporting indicia (both devices and words). I am not persuaded on the strength of this evidence that the opponents are in a better position on the basis of their common law rights than they were on the basis of their 'earlier trade marks' under Section 5(2). Even assuming that I accept goodwill in TORRES and three towers device, for the reasons given earlier in this decision I would have some difficulty in accepting that the applied for mark would constitute a misrepresentation. The Section 5(4)(a) ground fails.

30 As the opposition has failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

35 **Dated this 17 day of July 2000**

40 **M REYNOLDS
For the Registrar
the Comptroller General**

ANNEX

| No. | Mark | Class | Journal | Specification |
|-----|--------|-------|------------|---------------|
| 5 | 857391 | 33 | 4490/01516 | Wines |

10



891250

33

4629/643

Spanish wines

15



20

1039853

TORRES

33

5142/552

Table wines for
sale in England
and Scotland

25

1039854

33

5221/2046

Brandy.

30



35

| | | | | | |
|----|---------|---------------|----|-----------|---|
| | 1123105 | TRES TORRES | 33 | 5408/1039 | Wines, liqueurs and spirits (beverages). |
| 5 | 1298955 | TORRES | 33 | 5814/1489 | Wines, brandy and brandy-based orange liqueurs; all included in Class 33. |
| 10 | 1404075 | MIGUEL TORRES | 33 | 5910/1129 | Wines, sparkling wine, brandy and liqueurs; all included in Class 33. |
| 15 | 1404528 | | 33 | 5894/5933 | Wines included in Class 33. |

20 **TORRES MILMANDA**

25 **TORRES**
Milmanda