

O-287-10

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2467774
BY THE SOCIETY OF VINTNERS LIMITED TO REGISTER A
TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 97749 BY VINA CARTA VIEJA S.A.**

BACKGROUND

1. On 25 September 2007, Nottingham Wine Buying Group Limited (Nottingham) applied to register **FINCA VIEJA** as a trade mark. Following examination, the application was accepted and published for opposition purposes on 9 May 2008 in Trade Marks Journal No.6734 for a specification of goods in class 33 which read: "alcoholic beverages". I note that on 11 August 2008 Nottingham filed a Form TM21 which explained that its name had been changed to The Society of Vintners Limited (Society); nothing appears to turn on this change of name and I need say no more about it in this decision.

2. On 11 August 2008, Vina Carta Vieja S.A. (VCV) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). In their Statement of Grounds VCV indicate that the opposition (which is based upon the following trade mark), is directed against all of the goods in the application for registration:

Trade Mark	No.	Application Date	Registration date	Goods
CARTA VIEJA The mark consists of the Spanish words meaning "Old Letter".	1490624	10/2/1992	11/2/1994	33 – Wines; all included in Class 33

3. On 1 September 2009, Society filed a counterstatement which consists, in essence, of a denial of the ground upon which the opposition is based. In their counterstatement Society say:

"The trade mark in question comprises the word FINCA, meaning farmhouse, and VIEJA meaning old. The mark on which the opposition is based comprises the words CARTA VIEJA and, therefore, the only common component to the two marks is the word VIEJA meaning old. When considered as a whole, both marks are clearly visually very different, in view of the first part of the respective marks being a completely different word. Furthermore, the marks, when considered as a whole, are also clearly phonetically different and also conceptually different. The word old, by itself, in relation to wines or other alcoholic beverages is commonly used. There are already many marks on the Register containing the element VIEJA or a derivative of this word and details of some of these marks are attached for reference."

4. I note that in box 5 of their counterstatement, Society ask VCV to provide proof of use.

5. Both parties filed evidence; neither asked to be heard or filed written submissions. After a careful consideration of all the material before me, I give this decision.

EVIDENCE

VCV's evidence

6. This consists of a witness statement, dated 3 December 2009, from Graham Farrington who is a Partner in the firm Ladas & Parry LLP, VCV's professional representatives in these proceedings; Mr Farrington confirms that he is authorised by VCV to make his statement on their behalf.

7. Mr Farrington explains that exhibit GF2:

“consists of representative invoices relating to the export of wines by the Opponent bearing the CARTA VIEJA mark from Chile to the Opponent's distributors in the UK, Pimlico Dozen Ltd... These are merely a selection rather than an exhaustive list of all sales which have taken place, but each invoice shows sales of at least 10,000 bottles of wines bearing the CARTA VIEJA trade mark.”

8. I note that all of the invoices are on the letter headed paper of Vina Carta Vieja S.A. and are addressed to Pimlico Dozen Ltd (Pimlico), 33 Churton Street, London, SW1. The headings on the invoices include, inter alia, numbers of cases, numbers of bottles, a description of the goods, unit price and total price. Although other brand names are mentioned in the invoices, for example, TOLVA WINES, DONA FLORECIA, DONA FLORENCIA, the vast majority of the references in the invoices are to CARTA VIEJA and refer to grape varieties such as Merlot, Chardonnay, Sauvignon Blanc and Pinot Noir. The total number of bottles and the value in what appears to me to be pounds sterling of the various invoices is as follows:

Invoice date	No of bottles/£
23 July 2003	14040 - 13,702.50
23 October 2003	14,400 - 14,260
26 May 2004	11,400 - 11,900
27 October 2004	11316 - 11,646
14 June 2005	14520 - 16,940
31 October 2005	14076 - 16,494
28 February 2006	1437 (cases) - 17,716
30 June 2006	1,728 (cases) - 16,220
30 April 2007	1,964 (cases) - 14,313
30 June 2007	2,880 (cases) - 19,872
29 April 2008	2,054 (cases) - 14,624

9. Mr Farrington explains that Pimlico have been appointed as VCV's exclusive distributor in the United Kingdom, adding that Pimlico operate a website at www.pimlicodozen.com. Exhibit GF3 consists of, inter alia, a page downloaded from www.webarchive.org which indicates that the website mentioned was created in 2004; also included are archived pages from 11 April 2004 which contain, inter alia, the following text:

“Welcome to Pimlico Dozen Ltd

The company was set up in 1981 in Pimlico to supply local restaurants and inhabitants alike with fine wines at wholesale prices. Since then, the company has expanded and evolved and is now primarily an agency company representing wine producers, large and small, on an exclusive basis in the United Kingdom.

Pimlico Cellars Agencies, as we are now known, sells to **the trade** only on either an ex-cellar or under bond basis however, we are happy to recommend outlets that stock our wines in the UK....”

10. I note that on the final page of the exhibit it says, inter alia:

“Pimlico Cellars Agencies represents the interests of the following wine producers in the United Kingdom.

Vina Carta Vieja, Loncomilla Valley, Chile

Vina Carta Vieja is located 280 km south of Santiago, in the Loncomilla Valley...The first vineyard was planted in 1825 by the first generation of the del Pedregal family, who still own and run it. Currently there are over 700 hectares under vine..”

11. Mr Farrington goes on to say that Pimlico distributes the wine to restaurants and the off licence trade and that the wines are promoted on the website of Oddbins which he describes as “the well known off licence chain”; he adds the wines are currently, i.e. at the time of his statement, on the Pullman drinks menu of Great Western trains.

12. Exhibit GF4 consists of a brochure promoting the premises of the Honourable Artillery Company (in central London) as a venue for Christmas festivities entitled “Winter Wonderland 2006”. He notes that on the final page of the brochure under the heading “Christmas drinks upgrade options”, Carta Vieja Chardonnay and Carta Vieja Sauvignon Blanc are mentioned in the white wine category and Carta Vieja Merlot in the red wine category.

13. Exhibit GF5 consists of photographs of four wine labels all bearing VCV's trade mark albeit with the two words presented in title case i.e. Carta Vieja. The labels which

Mr Farrington says are “typical of the way in which the mark has been used for both red and white wines” are in relation to wines produced in 2001, 2003, 2006 and 2007.

Society’s evidence

14. This consist of a statutory declaration, dated 2 March 2010, from John Mansfield who is Society’s Chief Executive, a position he has held since 2005; Mr Mansfield confirms he is authorised to make his declaration on Society’s behalf. He states that FINCA VIEJA means “old farmhouse” in Spanish, whereas CARTA VIEJA means “old map” in Spanish (I note that the Trade Marks Register records the meaning of CARTA VIEJA as “old letter” in Spanish). Mr Mansfield explains that the word “old” is common:

“in describing alcoholic beverages and wines, generally in the language of origin of the wine in question.”

15. Exhibit JM1 is said to consist of details of trade marks for wine which include the word “old” in various languages, including those which include the Spanish words vieja or viejo. Exhibit JMII is said to consist of a list of known wine names including the word vieja. Mr Mansfield says of the word vieja:

“This term is, in terms of wines, clearly used descriptively.”

16. He goes on to say:

“5. Customers buying wines would be well used to seeing the word “old” in various languages and wine connoisseurs purchasing Spanish or South American wines would be well aware that the tem vieja or viejo means “old” and is used for many different wines. There would be absolutely no reason to believe that there was any relationship between the manufacturers or distributors of two different wines both including, in their names, “vieja” if the rest of the name were completely different.”

17. I shall return to these exhibits later in this decision.

18. Having explained that Society have been selling wines under the FINCA VIEJA trade mark since 2007 with no instances of confusion coming to light, Mr Mansfield concludes his declaration in the following terms:

“7. As far as we can ascertain from the information we have about the opponent, their mark CARTA VIEJA is only ever used in respect of wines from Chile and they have not provided any evidence of use of their mark in relation to a broader range of wines as protected under their registration. We believe, therefore, that the scope of their registration is too broad.”

19. That concludes my summary of the evidence filed to the extent that I consider it necessary.

DECISION

20. Section 5(2)(b) of the Act reads as follows:

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

(a)....

(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, or

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

21. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

22. In these proceedings VCV are relying on the registered trade mark shown in paragraph 2 above, which has an application date of 10 February 1992 which is prior to that of the application for registration which was filed on 25 September 2007; as such, it qualifies as an earlier trade mark under the above provisions. The application for registration was published for opposition purposes on 9 May 2008 and VCV’s earlier trade mark was registered on 11 February 1994. As a result, VCV’s earlier trade mark is subject to The Trade Marks (Proof of Use, etc) Regulations 2004. As I noted in paragraph 4 above, in their counterstatement Society ask VCV to provide evidence of the use they have made of their earlier trade mark. The relevant sections of the Proof of Use Regulations read as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

- (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if –
- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes –
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.
- (7) Nothing in this section affects –
- (a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

Proof of use

23. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of Society’s application for registration i.e. 10 May 2003 to 9 May 2008.

24. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);
- the use must be ‘on the market’ and not just internal to the undertaking concerned (*Ansul*, paragraph 37);
- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);

- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);

- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

25. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his

mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

26. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

27. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (Espana), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

28. I note that in his declaration Mr Mansfield does not take issue with either the genuineness of VCV's use or the form in which their earlier trade mark has been used. Given the guidance provided in the cases mentioned above, that is, in my view, a sensible approach. The totality of VCV's evidence indicates that wines bearing their CARTA VIEJA trade mark have been exported by them to Pimlico on a regular basis during the relevant period and that of the example invoices provided (which in total amount to some £168k), the vast majority of the entries relate to wines sold under the CARTA VIEJA trade mark. Consequently, I have no hesitation concluding that VCV's use of their CARTA VIEJA trade mark was genuine.

29. However, Mr Mansfield does take issue with the breadth of the specification for which VCV's earlier trade mark stands registered. For the sake of convenience he said:

"7. As far as we can ascertain from the information we have about the opponent, their mark CARTA VIEJA is only ever used in respect of wines from Chile and they have not provided any evidence of use of their mark in relation to a broader range of wines as protected under their registration. We believe, therefore, that the scope of their registration is too broad."

30. VCV's earlier trade mark is registered in respect of "Wines; all included in Class 33". If I have understood Mr Mansfield correctly, the substance of his criticism appears to be that as VCV have only used their CARTA VIEJA trade mark on wines the produce of Chile, their specification should be limited to reflect this fact.

31. If my understanding is correct, I disagree. In arriving at a fair specification I must, as the case law above indicates, first identify as a matter of fact what use VCV have made of their CARTA VIEJA trade mark; I accept that their use has been in relation to wines the produce of Chile. However, I must then go on and determine how the average consumer would describe VCV's goods. Having done so, and while I accept that the origin of the goods will be a factor of which the average consumer will be conscious when selecting the goods, I am equally sure that when asked to describe VCV's goods the average consumer would refer to them simply as wines.

32. In summary, I have concluded that VCV's use of their CARTA VIEJA trade mark has been genuine, and that the average consumer would refer to the goods on which the trade mark has been used as wines. I will conduct the comparison under section 5(2)(b) of the Act with that conclusion in mind.

Section 5(2)(b) – case law

33. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments germane to this issue. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05),

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;

(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; *Sabel BV v. Puma AG*, paragraph 23;

(e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;

(f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;

(h) 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; *Sabel BV v. Puma AG*, paragraph 24;

(i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;

(j) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;

(k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing decision

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods, and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The competing goods are alcoholic beverages at large and wines in class 33 (the former includes the latter). Alcoholic beverages will be bought by members of the general public over the age of 18; they then are the average consumer for such goods.

35. I have no evidence as to how the goods are likely to be purchased. However, in my experience the selection of the goods at issue is most likely to consist of a visual act made on the basis of self selection in, for example, a retail environment such as a supermarket or off-licence. I am equally aware that visual considerations will also apply to establishments where orders for the goods may also be placed orally, for example, public houses and restaurants.

36. Although I have no evidence to assist me, I am aware that the cost of the goods at issue can vary from very small amounts (a few pounds for a basic bottle of wine) to many hundreds or even thousands of pounds for, for example, an exclusive bottle of champagne or whisky. The wide variance in the price of the goods is likely to be reflected in the level of attention the average consumer pays to their selection. That said, in my experience the average consumer may well have a particular wine (be it brand, grape variety or origin) they prefer, and in those circumstances they can, I think, be expected to exercise a little more care when making their selection. Overall, the

average consumer who is assumed to be reasonably well informed, circumspect and observant will, I think, pay a reasonable level of attention to the selection of the goods at issue. However, that level of attention will, in my view, vary depending on the cost of the goods and the circumstances prevailing at the time of purchase. For example, one would not expect the average consumer to pay as much attention to the selection of a £6 bottle of wine chosen during the weekly “supermarket dash”, as they would spend selecting a bottle of wine costing £100 for a special occasion such as a birthday or anniversary.

Comparison of goods

37. At no point have Society argued that the competing goods at issue are not identical. In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-133/05, at paragraph 29 the General Court said:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42.”

38. Applying the conclusion reached in the first part of that quotation to these proceedings i.e. where VCV’s goods (wines) are included in a more general category in Society’s application (alcoholic beverages), it is clear that the respective goods at issue in these proceedings are identical.

Comparison of trade marks

39. For the sake of convenience, the trade marks to be compared are as follows:

VCV’s trade mark	Society’s trade mark
CARTA VIEJA	FINCA VIEJA

40. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his or her mind. In reaching a conclusion on similarity I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must, as the case law

dictates, then go on and compare the respective trade marks from the visual, aural and conceptual perspectives

Distinctive and dominant components

41. Both parties trade marks consist of two separate five letter words presented in upper case. Both consist of a combination of Spanish words which are said to mean “old letter” (or “old map”) and “old farmhouse” respectively. While I accept that Spanish is one of the most widely understood languages in the United Kingdom and that the average consumer in this country will have an understanding of some of the words in this language, this falls a long way short of the average consumer being fluent in Spanish.

42. Society have provided evidence which in their view demonstrates that the Spanish word VIEJA will be understood by the average consumer as meaning “old”, and that as a consequence the word should be considered descriptive and non-distinctive for the goods at issue. Turning first to exhibit JMI, this consists of state-of-the-register evidence which shows, inter alia, the words VIEJO or VIEJA appearing as an element in a number of trade marks for, inter alia, wines in class 33. In *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-135/04* the General Court (GC) stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

43. This was a view re-iterated by the GC in *Zero Industry Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-400/06.* While I am aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court, in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24, in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG*. I also note that in his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of some significance. The GC cases referred to above are relative grounds cases; clearly the GC considered that the principle of not giving weight to state-of-the-register evidence also applies in cases involving relative grounds issues. As in the *GfK* case mentioned above, no evidence has been provided by Society to show that the trade marks identified by them are actually being used in relation to the goods concerned.

44. Similarly, by reference to exhibit JMII Mr Mansfield provides a list of 24 (what he describes as “known wine names”) which include the word VIEJA (or VIEJAS). This evidence suffers from a number of defects e.g. it does not identify the owners of the

various brand names, but even if that information has been supplied, it also suffers from the same defect mentioned above i.e. there is no evidence that these names are actually being used. The cumulative effect of these defects in Society's evidence is that it fails to establish that the word VIEJA is one commonly used in relation to the goods at issue and is as a result descriptive and non-distinctive in relation to them.

45. Having reached that conclusion, both elements of the competing trade marks are, in my view, distinctive as are the totalities they create. The words CARTA and FINCA appearing as they do as the first word in each trade mark are (purely by virtue of their positioning) likely, in my view, to be considered the dominant element of each trade mark. I will now compare the respective trade marks with those conclusions in mind.

Visual/Aural similarity

46. I have described the competing trade marks above. Both consist of two five letters words presented in upper case; the first words differ the second words are identical. Considering the similarities and differences as a whole, there is, in my view, a reasonable degree of both visual and aural similarity between the competing trade marks.

Conceptual similarity

47. When considered as totalities both trade marks appear to have different meanings in Spanish and may well convey different conceptual messages to a consumer fluent in that language. However, as the average consumer does not fall into this category, neither trade mark (i.e. the separate elements or the totalities) is likely, in my view, to convey any conceptual message to the average consumer in the United Kingdom. For the average consumer in the United Kingdom, these are effectively invented words.

Distinctive character of VCV's CARTA VIEJA trade mark

48. As the case law dictates, I must also assess the distinctive character of VCV's trade mark. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which it has been registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

49. As I indicated above, VCV's trade mark is unlikely, in my view, to convey any meaning to the average consumer. However, even if the average consumer was aware of the meaning of the trade mark i.e. either "old letter" or "old map", this combination does not, as far as I am aware, have any meaning for wine. Consequently, in either of

those circumstances I would consider VCV's CARTA VIEJA trade mark to possess a high level of inherent distinctive character. While this trade mark has been used in the United Kingdom, the level of use with which I have been presented can only be considered modest and does nothing, in my view, to improve upon the trade mark's inherent characteristics.

Likelihood of confusion

50. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of VCV's trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them they have retained in their mind.

51. Although Mr Mansfield mentions that Society's FINCA VIEJA trade mark has been used by them since 2007 with no instances of confusion occurring, this does not assist them as no evidence has been provided which indicates, for example, the nature and extent of the use that has taken place. In summary, I have concluded that the goods at issue are identical, that there is a reasonable degree of both aural and visual similarity, that neither trade mark is likely to convey any conceptual message and that both elements of VCV's CARTA VIEJA trade mark are distinctive; the absence of any conceptual hook will increase the potential effects of imperfect recollection. While I have also concluded that by virtue of its positioning as the first element of VCV's trade mark the word CARTA is likely to be considered the dominant element, it is clear from the case law mentioned at paragraph 33(f) that an element of a trade mark may play an independent distinctive role within it without necessarily constituting the dominant element; that, in my view, is the position here. While the differences in the competing trade marks are, I think, sufficient to suggest that the average consumer is unlikely to mistake Society's FINCA VIEJA trade mark for VCV's CARTA VIEJA trade mark i.e. there will be no direct confusion, the distinctive element VIEJA common to both trade marks is likely, in my view, to lead the average consumer to believe that the goods come from economically linked undertakings i.e. there will be indirect confusion.

52. In summary, the opposition succeeds and the application will be refused.

Costs

53. As VCV have been successful they are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to VCV on the following basis:

Preparing a statement and considering the other side's statement:	£200
Official fee:	£200
Preparing evidence and considering and commenting on the other side's evidence:	£500
Total:	£900

54. I order The Society of Vintners Limited to pay to Vina Carta Vieja S.A. the sum of £900. 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.

Dated this 12 day of August 2010

C J BOWEN
For the Registrar
The Comptroller-General