

O-093-11

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 1004342
IN THE NAME OF
TORREVENTO S.R.L.**

IN RESPECT OF THE TRADE MARK



IN CLASS 33

AND

**THE OPPOSITION THERETO
UNDER NO 72053
BY
MIGUEL TORRES, S.A.**

Trade Marks Act 1994

**In the matter of
international registration no. 1004342
in the name of Torrevento s.r.l.**

in respect of the trade mark:



**in class 33
and the opposition thereto
under no. 72053
by Miguel Torres, S.A.**

Introduction

1. Torrevento s.r.l. is the holder of the above international registration ('the IR'). Protection in the United Kingdom was requested on 5 May 2009 (claiming a priority date of 10 March 2009 from the Italian Office of Origin). The request for protection was published in the United Kingdom, for opposition purposes, in *The Trade Marks Journal* on 31 July 2009. Protection is sought in respect of the following goods¹:

Class 33: *Alcoholic beverages, namely, wines and sparkling wines.*

2. Miguel Torres, S.A. ('the opponent') filed notice of opposition to the granting of protection in the United Kingdom, claiming that protection would be contrary to section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Section 5(2)(b) of the Act states:

“(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,

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

¹ Classified according to the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

The opponent relies upon all the goods of its four earlier trade marks, the relevant details of which are as follows:

(i) 1039853

TORRES

Class 33: *Table wines for sale in England and Scotland.*

Date of application: 17 December 1974

Date of completion of registration procedure: 25 July 1979²

(ii) 1298955

TORRES

Class 33: *Wines, brandy and brandy-based orange liqueurs.*

Date of application: 21 January 1987

Date of completion of registration procedure: 27 July 1990

(iii) Community Trade Mark ('CTM') 1752526

TORRES

Class 33: *Alcoholic beverages (except beers).*

Date of application: 14 July 2000

Date of completion of registration procedure: 1 October 2001

(iv) CTM 2783

TORRES



Class 33: *alcoholic beverages (except beers).*

Date of application: 1 April 1996

² As per the notice in Journal 5725, which confirmed that, prior to June 1986, the date of the Journal in which the fact of registration was recorded in the list of trade marks registered was the actual date of registration; see the decision of Geoffrey Hobbs Q.C., as the appointed person, in *WISI* [2006] RPC 17.

Date of completion of registration procedure: 1 February 1999

4. All the marks relied upon by the opponent were registered more than five years prior to the date the IR was published (31 July 2009). Consequently, they are all subject to the proof of use regulations³. Although the opponent relies upon all the registered goods, it has made a statement of use only in respect of wines (1039853 is, in any event, only registered for wines). The opponent claims that the dominant feature of the IR is TORREVENTO which is similar to its marks and that the goods are identical, so that there exists a likelihood of confusion.

5. The holder filed a counterstatement, putting the opponent to proof of use of its registered marks in respect of wines. It denies that the marks are similar (it is unclear whether it also denies a similarity between the goods) and consequently denies that there is a likelihood of confusion. The holder claims that the name 'Torre vento' (it spells it this way) coincides with the territorial area where the 'Torrevento' (this time spelled this way) company has its headquarters and production. The counterstatement contains submissions which I will bear in mind in reaching a decision.

6. Only the opponent filed evidence; the holder filed formal submissions during the evidence rounds which, again I bear in mind, but which I will not record in the evidence summary because they do not constitute factual evidence. Neither side asked for a hearing, both being content for a decision to be made from the papers on file. Both parties filed written submissions in lieu of attending a hearing.

The opponent's first set of evidence

7. Witness statement from Luis de Javier, dated 15 June 2010

Mr de Javier is director of the opponent's legal department, a position he has held since 1991. He states that the facts in his witness statement are, unless otherwise stated, from his knowledge, from the opponent's book or records (to which he has full and free access) and from information given to him directly from his colleagues. Mr de Javier also states that he is fully conversant in the English language.

8. Mr de Javier states that the opponent is owned by the Torres family, whose winemaking history goes back some three centuries. TORRES was first used as a mark in 1964. According to Mr de Javier, the opponent is the twelfth largest producer and exporter of Spanish wines, selling 50 million bottles a year of wines, spirits and liqueurs in 150 countries. Exhibit LJ02 contains copies of all the labels that have been used on the opponent's wines, brandies and liqueurs in the UK. These are undated, although some of the pages have been annotated to

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

show that they were used as evidence in 2002 opposition proceedings. Some of the wine labels have vintage dates: 1970, 1971, 1972, 1976, 1981, 1982, 1985, 1989, 1990, 1992 and 1993 (the date of a wine's availability for sale does not, of course, have to correspond with its vintage date). TORRES and the TORRES and device marks are shown on the various labels. They are also shown in the various brochures and literature (exhibit LJ03) which Mr de Javier states shows the range of goods supplied and distributed in the UK; however, there are no dates later than the year 2000 for any of the literature. Many of the documents are undated and the text does not give any clues as to when they might have been distributed (judging by the styling in some of the leaflets, they may date from several years ago).

9. Mr de Javier gives the following turnover figures for the UK from 2004 to 2009 for the mark TORRES. These are aggregate figures for wines, brandies and liqueurs: there is no breakdown to show a figure solely for wines.

Year	Turnover (£)
2004	6,512,804
2005	6,550,609
2006	6,769,850
2007	7,162,946
2008	5,086,965
2009	5,675,170

Mr de Javier states that exhibit LJ04 shows copies of invoices relating to the UK of goods bearing the mark TORRES. These all date from the years 1975 to 1977.

10. Mr de Javier states that the opponent's wines, brandies and liqueurs bearing the TORRES mark are stocked in UK off-licences (Augustus Barnett, Bottoms Up, Majestic Wines Warehouse, Threshers and Unwins) and UK supermarkets (Asda, Morrisons, Safeway, Sainsbury, Tesco and Waitrose). Exhibit LJ05 is said to be a complete listing of the opponent's UK customers. In addition to the above names, various hotels, restaurants and large department stores (Selfridges, Fenwicks and House of Fraser) are listed. The list is undated. Whilst the phone numbers of some of the London-based customers have telephone numbers beginning with the '020' code, others have 081 codes (081 codes date from some years ago, the current code being 020). A further customer list dates from 1976 and another from "c1977". The extracts from the wine lists of customers who stock the opponent's goods (which show the TORRES marks) are either undated or are dated 1973, 1974, 1975, 1976, 1978, 1986, 1987, 1989, 1993 (Threshers, 081 telephone number), 1993 (Oddbins), 1997 (Tesco).

11. Mr de Javier gives some UK advertising expenditure figures; for the years 2004 to 2009, these were £541,537, £539,100, £575,491, £607, 860, £428,318

and £497,723. He also states that the opponent does not place direct advertisements for its wines; most of its publicity is through reviews in the local, national and trade press. Mr de Javier refers to the following lists of publications:

The Times
The Times Saturday Review
The Financial Times
The Daily Telegraph
The Observer Magazine
The Daily Mail
The Daily Express
The Sunday Express
The Standard
BBC Good Food Magazine
Sainsbury's Magazine
Wine & Spirit International
Decanter Magazine

Articles (with their respective dates) appear in exhibit LJ06 from the Financial Times (1977), The Telegraph (1973), the Sunday Times (1978), The Times (1983), The Times Saturday Review (1977), The Standard (1992) and BBC Good Food (1992). There is an article from The Morning Advertiser dated 1970. There are a good many copies of foreign language trade publications (wine and dining). Publications from the USA and Australia also feature (dating from 2001). This exhibit consists of 251 pages, all of which have required individual examination. The vast majority are dated prior to the current century. However, there are a few notable exceptions which fall within the five year period prior to 2009.

12. The first of these is an extract (pages 481 to 482 of the evidence) from the April 2005 edition of a publication called "The Drinks Business" which refers to Torres; however, it is unclear from the context whether this refers to the company name or a trade mark. A 2006 edition of the publication refers to "famous labels such as Torres". The 2006/2007 "Spanish Report" of 'The Drinks Business' shows TORRES on wine bottles. It appears with the three towers device beneath it, as in the earlier mark CTM 2783. There is a line above and below TORRES which may give the impression that it is separated from the three towers device; however, the picture is too indistinct to be conclusive about this. On the same page (496) it gives details for the UK distributor. On page 497 there is a league table of the "leading brands" for Spanish wine sales in the UK. TORRES is listed as fifth out of twenty, selling 302,168 cases between September 2005/2006 at an average price of £4.69 per 75cl bottle (page 498 of the exhibit).

13. The only other page which is relevant in terms of being placeable in the five year period prior to 2009 is page 465 which is from a document from Waitrose supermarket. It is undated, but it refers to Torres Viña Esmeralda with a 2003

vintage. Presumably, as a 2003 vintage, the wine was for sale after 2003. The bottle shows the word TORRES, this time completely separately from the three towers device.

14. Exhibit LJ07 contains copies of awards to the opponent for TORRES wines; the earlier marks are not shown and the awards all date from 1971.

15. The opponent's further witness statements

The opponent has also filed witness statements from Emma Christina Anne Hodson and Ms Puravee Shah who are both trade mark attorneys in the firm of Murgitroyd & Company Limited, the opponent's professional representatives in these proceedings. Ms Hodson's witness statement consists of submissions in relation to the claimed likelihood of confusion, together with dictionary references. Ms Shah's witness statement is in reply to submissions made by the applicant. I will refer to these witness statements later in this decision, as necessary.

Decision

16. Proof of use

Section 6(A) of the Trade Marks Act 1994 ("the Act") states:

"(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).”

In addition to section 6A of the Act, section 100 states:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

17. To rely upon its earlier trade marks for ‘wine’ (because the opponent has made a statement of use in respect of wine only), the opponent has to prove that it has made genuine use of the trade marks, or that there are proper reasons for non-use, in the relevant period. The relevant period is the five years prior to and ending on the date of publication of the IR, i.e. from 1 August 2004 to 31 July 2009, as per section 6A(3) of the Act.

18. Ms Anna Carboni, sitting as the appointed person in *BreadTalk*, O-070-10, summarised a set of principles from the following leading Court of Justice of the European Union (‘CJEU’) genuine use cases: *Ansul BV v AjaxBrandbeveiliging*

BV, Case C-40/01, [2003] ETMR 85 (“ECJ”); *La Mer Technology Inc v Laboratoires Goemar SA*, Case C-259/02, [2004] FSR 38 (ECJ); and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C-495/07, [2009] ETMR. I gratefully adopt her summary:

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely “token”, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] - [23].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that

such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25].”

19. The evidence of Mr de Javier reveals that the Torres family wine business has a long and successful history. He has filed evidence showing a business which, principally, is based on wine. However, only a handful of these pages can be placed within the relevant period: those which I have described above in paragraphs 12 and 13. The vast majority of the exhibits date from the 1970s and 1980s. Whilst it is possible that a wine label may stay the same for decades, this is too much of an assumption to make since many trade marks evolve and ‘modernise’ so that they no longer look the same as they did thirty years ago. In any case, it is for the opponent to prove use in the relevant period.

20. Whilst Mr de Javier’s turnover figures have not been particularised as to wine, the league table for 2005 to 2006 on page 496, which I have referred to above, places the opponent’s position in the UK as fifth out of twenty companies for wine sales, giving an average price of £4.96 per 75cl bottle. The ‘flavour’ of the evidence is that wine is the principal business rather than brandy and spirits. The opponent’s turnover figures in the UK have been consistent and show real commercial exploitation that is aimed at maintaining or creating an outlet for wine. The remaining question is whether the opponent has shown that its use has been of the marks relied upon, in the relevant period. On page 497 of the evidence, which is the ‘Drinks Business Spanish Report 06/07’, an advertorial for the opponent shows bottles of wine which display the vintage years as 2004 and 2005 with the words TORRES above the three towers device, as in CTM 2783. There is a slight difference between the representation on the bottle and the CTM in that there is a faint horizontal line above and beneath TORRES, but without a clearer representation it is not possible to say whether the lines have the effect of separating TORRES from the device. The lines are barely discernable in the exhibit. On page 465, which is the undated Waitrose leaflet, the 2003 vintage of Torres Viña Esmeralda is listed; by analogy with the aforesaid advertorial, in which 2004/5 vintages were for sale in 2006/7, presumably the 2003 vintage was for sale in the two or three years after 2003, which could place it in the relevant period. The Waitrose list refers to the TORRES wine both in the text and by way of a photograph of the bottle of TORRES Viña Esmeralda; the bottle shows the word TORRES separately to the rest of the label’s contents. The combination of textual and photographic representations of TORRES in the Waitrose pages is use of the TORRES word-only mark. The representations of the bottles in the advertorial is use of the composite word and device mark.

21. As a result of the above, whilst the majority of the evidence does not support a claim to genuine use in the relevant period, the combination of pages 465 and 496 to 497 of the evidence (the Waitrose and Drinks Business pages), together with the contents of the witness statement which has come from the opponent itself, showing that the marks have been used by or with the consent of the

proprietor, means that the opponent has satisfied the burden placed upon it under section 6A(3) of the Act. It may therefore rely upon the earlier marks in respect of *wine*.

Section 5(2)(b)

22. The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

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

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(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*,

(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*,

e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(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*,

(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*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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*.

Comparison of goods

23. The opponent's goods are *wine*. The goods of the IR are *alcoholic beverages, namely, wines and sparkling wines*. Sparkling wines are a subset of wines; wines are common to both parties' specifications. The effect of the word 'namely' in the IR's specification, according to the guidance in the Trade Mark Registry's Classification Examination Work Manual, is to limit the coverage to those goods which follow 'namely'; therefore the IR has coverage only for wines and sparkling wines. Clearly, the goods of the parties are identical. Even if 'alcoholic beverages' could be taken into account, the goods would still be identical because if a term (wine) falls within the ambit of the competing specification (alcoholic beverages), the goods are held to be identical⁴.

Average consumer and the purchasing process

24. The average consumer of wine is the adult general public. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of

⁴ See *Gérard Meric v Office for Harmonization of the Internal Market*, General Court ('GC'), case T-133/05.

goods or services. The inspection prior to purchase of wine is likely to focus on some or all of the following factors: whether the wine is red, white or rosé; dry, medium or sweet; the country or origin; the vintage; whether it is still or sparkling; the grape variety; and the price. Only in the case of very expensive or rare wines will a very high level of attention be paid; for the average consumer, a reasonable amount of care will be taken in a relatively frequent, not highly expensive, purchasing process. Most wine is bought from supermarkets and other retail outlets. In the case of mail order, brochures and listings are consulted visually. The purchasing process is largely a visual process of self-selection. Even in the case of ordering wine in a restaurant or a bar, the bottle is still likely to be seen⁵ so that there is still a visual element to the purchase in addition to the oral/aural method of selection⁶.

Comparison of trade marks

25. The authorities direct that, in making a comparison between the marks, I must have regard to each mark’s visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

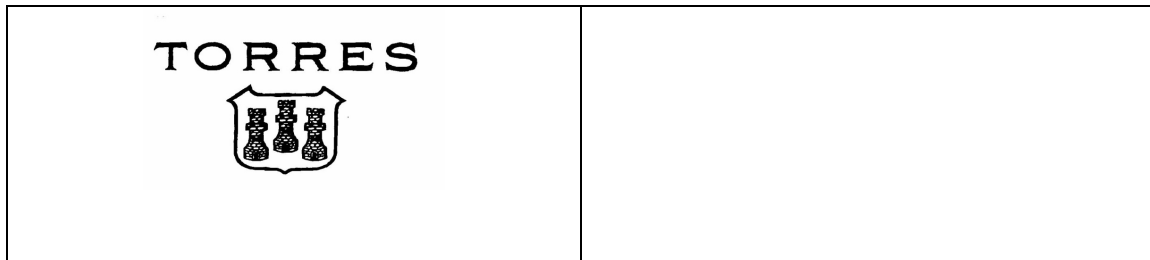
26. The marks to be compared are:

Opponent’s marks	IR
TORRES	

⁵ in *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (OHIM) Case T-3/04* said: “58 In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves, although they may not find those marks side by side.”

⁶ *Codorniu Napa, Inc. v OHIM*, case T-35/08.



27. I shall begin by comparing the opponent's word-only TORRES mark against the IR. The opponent's mark is a single word which does not separate into distinctive and dominant components. In her witness statement, Ms Hodson submits (or states) that the middle letter V in TORREVENTO (as it appears in the IR) slants away from the preceding letter E creating an impression that VENTO is a separate element. It takes a close examination of the mark to lead to this conclusion; the average consumer does not analyse marks to this degree. The letters in TORREVENTO are of varying size, but this would also not be a significant feature in the average consumer's overall impression of the mark. Realistically, there is no separation of the elements TORRE and VENTO. Ms Hodson further submits that "words speak louder than devices" so that the prominent and distinctive element of the IR is TORREVENTO. Whilst it may be true in this case that TORREVENTO is the distinctive/dominant element, which is an assessment I will come to shortly, the reason is not simply because it is the word element in the mark. Each case must be assessed on its merits. The CJEU stated in *L&D SA v OHIM* [2008] E.T.M.R. 62:

"55 Furthermore, inasmuch as L & D further submits that the assessment of the Court of First Instance, according to which the silhouette of a fir tree plays a predominant role in the ARBRE MAGIQUE mark, diverges from the case-law of the Court of Justice, it need only be stated that, contrary to what the appellant asserts, that case-law does not in any way show that, in the case of mixed trade marks comprising both graphic and word elements, the word elements must systematically be regarded as dominant."

The device in the IR consists of three interlocking outlines of hexagons. Whilst the device is positioned above the word element, that word element extends either side of the device by three letters each way. Its portion of the overall combination of word and device is the larger. Both the device and the word are distinctive but the word element is the dominant element of the IR.

28. Ms Hodson submits that the first part of the mark is most important for comparison purposes. This is a rule of thumb. She also submits that "TORRE is the first part of the written element of the opposed mark and TORRES is the earlier mark. As these words differ by only one letter, there is a high level of [visual] similarity". This submission ignores the VENTO part of TORREVENTO.

Far from only differing by one letter, the totality of the word elements differs by five letters. The earlier mark is six letters in length, the IR is ten; only the first half of the IR is the same as the first five letters of the earlier mark. The holder, in its submissions, has referred to a previous decision of the registrar which compared TORRES with TORREMAR, BL O/247/00, where it was said:

“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.”⁷

I note the reference but must consider the case before me according to its own particular representation. In addition to the word element, the IR contains the hexagonal device. Ms Shah, in her witness statement, submits that the device may go unnoticed by the customer. Having regard to *Shaker*, the device is certainly not negligible and cannot be ignored in the comparison. It is a further visually distinguishing feature of the IR. There is only a low degree of visual similarity between the marks.

29. Ms Hodson presents a similar argument in relation to the phonetic comparison; i.e. that TORRE is a two syllable mark and TORRES is also two syllables, ignoring VENTO. Her further argument, this time not ignoring VENTO, is that “endings of marks tend to be slurred”. I think it highly unlikely that, as two syllables, VENTO would be slurred. The IR is twice as many syllables long as the opponent’s mark; that is a considerable difference. Allowing, again, for the superficial similarity of the first five letters (TORRE) coinciding in both marks, there is only a low degree of phonetic similarity between the marks.

30. Both parties have made submissions in relation to conceptual similarity. Ms Hodson has exhibited references from Spanish and Italian language dictionaries which show that ‘torres’ means ‘towers’. The holder submits that it is a common Spanish and Portuguese surname. There is no evidence as to the perception of the average consumer and I should guard against taking too readily an assumption that the average consumer would be familiar with either of these meanings⁸. Ms Shah submits that the average consumer in the UK would not be

⁷ On appeal, BL O/207/02, the appointed person (Mr Geoffrey Hobbs QC) upheld the decision, stating that TORREMAR is a mark “out of which the element TORRE can only be extracted by a process of dismemberment that the average consumer of the goods concerned would not be likely to engage in.”

⁸ As per the comments of Ms Anna Carboni, sitting as the Appointed Person, in *CHORKEE Trade Mark*, O-048-08: “Judicial notice may be taken of facts that are too notorious to be the subject of serious dispute...37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this.”

aware of TORRES as a surname. Ms Hodson, in her witness statement, submits that the 'towers' meaning is reinforced in the opponent's composite mark by the presence of the three towers device. If a meaning is to be reinforced it has to be there in the first place. If the average consumer is aware of the Spanish and Italian meanings of TORRES, the IR will present no such meaning. TORREVENTO, to the average UK consumer, will be an invented word. The holder submits that it is a nod to TORRE DEL VENTO, the name of the place in Apulia where the holder has its headquarters. As Ms Shah submits, the average consumer in the UK would be unaware of this. Consequently, the holder's mark is without conceptual significance. So, whether TORRES and TORREVENTO are both seen as invented words, or whether TORRES is seen as meaning 'towers' or even a surname, there is no conceptual similarity between the marks. I note that, in a parallel action between the parties before OHIM to which the holder has referred, in which the same marks were being compared as in these proceedings, the opposition decision (B1442286) refers to neither of the signs having a meaning outside Spain, Portugal and Italy. In my view, both marks will be seen by the average UK consumer as invented words.

31. Having found only low levels of visual and phonetic similarity and no conceptual similarity, the overall similarity between the marks is very low.

Distinctiveness of TORRES

32. It is necessary to consider the distinctive character of TORRES because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion⁹. The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public¹⁰. TORRES is likely to be seen in the UK as an invented word, so that its inherent distinctive character is already high. Even if it will be seen as meaning 'towers' or as a Spanish surname, its distinctive character in relation to wine is still high. The exhibits, with the exception of the few pages that get the opponent past the proof of use hurdle, date from several (even many) years prior to the date of application which makes it difficult to evaluate the extent of the reputation, even with the turnover figures, that has any currency at the relevant date. For the purposes of the global comparison, bearing in mind the inherent distinctive character, the distinctive character of TORRES is high.

⁹ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁰ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

Likelihood of confusion

33. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified and also bear in mind the principle of interdependency, whereby a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon*). The goods of the parties are identical. I keep in mind the whole mark comparison and the effect which the predominantly visual and reasonably careful purchasing process has upon the weight of these elements. Ms Hodson submits that the average consumer, whilst reasonably well informed, circumspect and observant is, nevertheless, in such a hurry doing the shopping in a supermarket that a high level of attention will not be paid. That does not mean that a reasonable level of attention will not be paid, which is the level I have decided is appropriate. Even if a low degree of attention will be paid, and allowing for the fact that the average consumer rarely has the opportunity to compare marks side by side, relying instead upon the imperfect picture he has of them in his mind, the likelihood of imperfect recollection in this case is unlikely unless one dissects TORREVENTO in a way which is alien to the purchasing process and the way the average consumer perceives trade marks. The position would not be any different even if I had been able to make a finding in relation to enhanced distinctive character. Despite a high level of distinctive character and identity of goods, there is insufficient similarity between the marks to cause a likelihood of confusion.

34. The opponent is not in any more favourable a position in relation to its composite mark. Although both marks contain a device consisting of three components, the IR's device is composed of hexagons whilst the opponent's device is composed of three towers. They look entirely different and share no concept so that the only point of any similarity is the word element, which I have already decided will not lead to a likelihood of confusion, all the other factors in the global comparison being equal.

35. The opposition fails.

Costs

36. The holder has been successful and is entitled to an award of costs. It is the registrar's practice to award costs to litigants-in-person at half the rate that he awards them where a party has had legal representation. The opponent filed 569 pages of evidence, all of which required individual examination and most of which were so out-of-date as to be irrelevant to the grounds and issues to be determined. I award the holder costs on the following basis¹¹:

¹¹ As per the scale in Tribunal Practice Notice 4/2007.

Considering the other side's statement and preparing a counterstatement:	£200
Considering and commenting on the other side's evidence:	£400
Written submissions in lieu of a hearing:	£150
Total:	£750

37. I order to pay Miguel Torres, S.A. to pay to Torrevento s.r.l. the sum of £750. 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 8 day of March 2011

**Judi Pike
For the Registrar,
the Comptroller-General**