

O/0217/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003662553

BY VIÑA UNDURRAGA S.A.

TO REGISTER:

ALTAMAR

AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 427787 BY

ACHAVAL-FERRER, S.A.

BACKGROUND AND PLEADINGS

1. On 30 June 2021, VIÑA UNDURRAGA S.A. (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 33: Wines and liquors.

2. The applicant’s mark was published for opposition purposes on 27 August 2021 and, on 27 October 2021, it was opposed by ACHAVAL-FERRER, S.A. (“the opponent”). The opposition is based on sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”).

3. Under both grounds, the opponent relies on the following mark:

FINCA ALTAMIRA

UK registration no: 906579338¹

Filing date 14 January 2008; registration date 24 November 2008

Relying on some goods, namely:

Class 33: Alcoholic beverages (except beers).

4. Under its 5(2)(b) ground, the opponent claims that, due to the similarities between the marks and the identity of the goods at issue, there exists an unavoidable likelihood of confusion on the part of the public, including an inevitable association between the marks.
5. In respect of the 5(3) ground, the opponent claims that its mark enjoys a reputation in the goods relied upon and, as a result of the similarity between the marks, English-speaking relevant consumers would believe that there is an economic link

¹ The opponent’s mark is a comparable trade mark. It is based on the opponent’s earlier EUTM, being registration number 006579338. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM.

between them. The opponent argues that use of the applicant's mark would, without due case, take unfair advantage of the opponent's mark or cause damage to its repute and distinctive character.

6. The applicant filed a counterstatement denying the claims made and put the opponent to proof of use for its mark for the goods relied upon.
7. The opponent is represented by Marks & Clerk LLP and the applicant is represented by IPOA Limited. Both parties filed evidence in chief with the opponent also electing to file evidence in reply. I also note that the applicant filed written submissions accompanying its evidence. No hearing was requested and only the opponent filed written submissions in lieu. This decision is taken following a careful perusal of the papers.
8. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

9. As above, both parties filed evidence. The opponent's evidence in chief came in the form of the witness statement of Julio Lasmartres dated 3 May 2022. Mr Lasmartres is the President of the opponent. His statement is accompanied by 17 exhibits, being those labelled Exhibits JL1 to JL17.
10. The applicant's evidence in chief came in the form of the witness statement of Jennifer Jane Hitchcock dated 4 July 2022. Ms Hitchcock is a Chartered Trade Mark Attorney at the applicant's representative and is, therefore, duly authorised to make the statement on behalf of the applicant. Ms Hitchcock's statement is accompanied by two exhibits, being those labelled Exhibits JJH1 and JJH2. As I

have set out above, the applicant's statement was accompanied by written submissions.

11. The opponent's evidence in reply came in the form of the witness statement of Samantha Collins dated 17 August 2022. Ms Collins is a Chartered Trade Mark Attorney and Partner at the opponent's representative and is, therefore, duly authorised to make the statement on behalf of the opponent. Ms Collins's witness statement is accompanied by one exhibit, being that labelled Exhibit SC1.

12. I will refer to points from the evidence or submissions where necessary.

PRELIMINARY ISSUES

Geographical Indication

13. In the applicant's evidence, it filed a print-out from the website www.parajealtamira.org which discusses the fact that 'PARAJE ALTAMIRA' was accepted by the National Institute of Viticulture as a geographical indication of Argentina in 2013.² The applicant also made mention of this point in its submissions wherein it simply referred to the fact 'PARAJE ALTAMIRA' is recognised as a Geographical Indication of the Argentine Republic. In response to this, the opponent filed evidence in reply that enclosed an extract from the UK government website, namely the section dedicated to 'Protected Geographical Food and Drink Names'³ which shows that there are no such entries for 'ALTAMIRA' as a protected geographical indication in the UK. In the present case, and bearing in mind the grounds at issue, it is not clear to me the point that the applicant is seeking to make in raising this issue. As pointed out by the opponent, there is no such protection for this term in the UK and, even so, the applicant's point relates to 'PARAJE ALTAMIRA' and not 'FINCA ALTAMIRA', being the mark at issue here. While the applicant's evidence and submissions are noted, they are of no relevance to the present case and I will say no more about them.

² Exhibit JJH1

³ Exhibit SC1

Use of 'ALTAMIRA' in the wine industry

14. A further point relied upon by the applicant is that 'ALTAMIRA' is a commonly used term by wine producers based in the Altamira region of Argentina and since those are able to co-exist in the market without confusion, the applicant's mark should be able to co-exist also, particularly given that it is different from 'ALTAMIRA'. In support of this point, the applicant has provided a print-out from www.wine-searcher.com.⁴ The print-out provides information regarding the Altamira wine region in Argentina and while it is undated, I can see that the page was last updated on 3 August 2021 and despite being after the relevant date, I accept the existence of this region. It also includes a list of over 20 wines from this region together with their prices in pounds. While noted, the list appears to be one that is updated monthly and, given that the print-out is undated, it is unclear what time period this list covers. In any event, I note that the labelling of the wines is not clear enough to suggest how they are actually branded. Further, the description of the wines seems to suggest that 'ALTAMIRA' is not used as a brand name but, instead, simply the origin of the wine. For example, the wines are described in formats such as "Familia Zuccardi 'Finca Piedra Infinita' Gravascal, Paraje Altamira, Argentina" and "Bodge TeHo 'Zaha' Toko Vineyard Malbec, Altamira, Argentina". In such instances, it appears to me that the use of Altamira here is merely as a descriptor of the geographical origin of the wine and not the brand origin. As a result, I fail to see how this evidence assists the applicant. In any event, even if 'ALTAMIRA' is featured in the branding, this is not evidence of lack of confusion on the marketplace.

15. I have also given consideration to the argument in the preceding paragraph on the basis that it may be said to point towards a weakening of the distinctive character of 'ALTAMIRA' due to its alleged common presence on the wine market. As was the case in the preceding paragraph, it is not clear whether the examples provided were available at the relevant date and there is no evidence that 'ALTAMIRA'

⁴ Exhibit JJH2

features on the branding and, even if it does, there is nothing to suggest how it is presented to the consumer or how it is used in the marketplace. To confirm, I have accepted that 'ALTAMIRA' is a location in Argentina, however, the evidence fails to demonstrate that the average consumer in the UK would be aware of such.

DECISION

Proof of use

16. 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.”

17. The relevant statutory provisions are as follows:

“Section 6A

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

18. Section 100 of the Act is also relevant, which reads:

“100. 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.”

19. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration procedure over five years prior to the filing date of the applicant’s mark and, as set out above, the applicant requested that the opponent provide proof of use for its mark. As a result, the opponent’s mark is subject to a proof of use assessment in respect of the goods relied upon.

20. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch)

Arnold J (as he then was) summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

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

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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 to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it

guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed

to be justified in the economic sector concerned for the purpose of creating or preserving 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. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent’s mark is the 5-year period ending with the filing date of the applicant’s mark, being 30 June 2021. Therefore, the relevant period for this assessment is 1 July 2016 to 30 June 2021.

22. The opponent’s mark is a comparable mark based upon an earlier EUTM. This means that use of the mark in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the present assessment.⁵ To confirm, I will consider use in the EU between 1 July 2016 and 31 December 2020 (during which time the UK was a part of the EU), however, between 1 January 2021 and 30 June 2021, I will consider UK use only. On this point, I refer to the case of *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, wherein the Court of Justice of the European Union (“CJEU”) noted that:

“It should, however, be observed that ... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for

⁵ See paragraph 4 of Tribunal Practice Notice 2/2020

all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

23. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”⁶ because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

24. I note that the applicant’s submissions only make one brief mention of the proof of use evidence filed by the opponent. This was in the form of the following comments regarding the comparison of the goods at issue:

“16. The contested goods “Wines and liquors.” in class 33 are identical and/or similar to the goods ‘wine’ which are covered by class 33 of the Earlier Trade Mark and for which the Opponent has filed proof of use.

17. The Opponent has not filed any proof of use of it’s mark in relation to any other alcoholic beverage in class 33.”

⁶ *Jumpman* BL O/222/16

25. In response to this point, I note that the opponent's submissions state:

"It is notable that in the Applicant's subsequent Submissions filed on 4 July 2022, they stated at paragraph 16 that the Opponent had filed proof of use in relation to "wine". Therefore, the Applicant has admitted that the Opponent has proved use of the Earlier Mark in relation to the relevant goods."

26. I agree with the opponent that the above submission from the applicant can be considered to constitute a concession that use has been shown. However, such a concession does not extend to "the relevant goods" as submitted by the opponent but to "wine" only. Even if I am wrong to interpret the submissions in this way, I am of the view that the opponent has provided sufficient evidence to warrant a finding that it has used its mark during the relevant period. This is on the basis that, over four years (being 2017 to 2020), the opponent has sold a total of \$75,000 worth of wine in the UK.⁷ The opponent has also provided a range of invoices from between 31 July 2017 and 26 October 2020 to Corney & Barrow, being its retailer in the UK, showing sales of approximately 1,610 bottles of 'FINCA ALTAMIRA' wine.⁸ While the turnover represents a very low market share when compared to what is an enormous market, I remind myself that use need not always be quantitatively significant for it to be deemed genuine and that even minimal use may qualify as genuine if it is deemed to be justified in the economic sector. Taking this into account, I am content to conclude that the British pound equivalent of the turnover provided is sufficient to demonstrate that the opponent has made a genuine attempt to preserve itself a market share for its goods in the relevant jurisdiction during the relevant period. That being said, there is nothing in the evidence to demonstrate use of any goods other than wine so have no hesitation in limiting the opponent's specification accordingly.

Section 5(2)(b): legislation and case law

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

⁷ Exhibit JL12

⁸ Exhibit JL13

“(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,

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

28. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

29. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (“OHIM”)*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or 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, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) 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;

- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

30. The competing goods are as follows:

The applicant's goods	The opponent's goods
Wines and liquors.	Wine.

31. When making the comparison assessing the similarity of the goods, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“[...] Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

32. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33. I note that the opponent's submissions on the comparison of the goods are based on the entirety of the opponent's specification, however, as mentioned above, the applicant's submissions are made on the basis of the opponent proving use for 'wine' only. The applicant accepts that the goods at issue are identical and/or similar but makes no mention as to what degree of similarity they are. I will, therefore, conduct a full goods comparison.

34. Despite being one term, I consider that the applicant's specification can be interpreted to cover separate goods, being "wines" and "liquors". "Wines" in the applicant's specification is clearly self-evidently identical to the opponent's good. As for "liquors" in the applicant's specification, I am of the view that although it may appeal to different tastes from the opponent's "wine", they have a similar nature, purpose and methods of use as they are both alcoholic drinks. While it might be true that liquors and wine are not usually produced by the same manufacturers or that they would normally emanate from the same geographic areas, they would be handled by the same distributors and would be sold through the identical retail outlets (and may even be displayed in the same aisles of larger retailers such as supermarkets, for example) to the same class of ultimate users. In my view, the goods are similar to a medium degree.

The average consumer and the nature of the purchasing act

35. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the

manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

36. The opponent submits that the average consumer is a member of the general public who exercises an average degree of attention. The opponent also submits that the average consumer will be a wine expert or someone with a greater knowledge of wine. While I agree with the opponent in respect of the identity of the consumer (albeit being limited to those over the age of 18), I consider that there is a distinction between the different groups of people identified. I am of the view that the majority of average consumers will be members of the general public that do not have any expert knowledge in relation to wine. In addition, I accept the presence of a smaller (but still significant) proportion of members of the general public that do possess such knowledge. As for the submissions regarding the level of attention paid, I agree for the most part that the level paid will be medium for the majority of average consumers on the basis that the goods are generally likely to be relatively inexpensive with consideration being paid to various factors such as flavour and alcoholic content. However, for the smaller group of consumers that are more knowledgeable with regards to wine, there will be additional factors that are considered such as vintage, classification as to the type of wine and its origin. This will, in my view, result in a higher than medium (but not high) degree of attention. To confirm, I find that the level of attention paid will be medium for the

majority of ordinary consumers but will be higher than medium (but not high) for those more knowledgeable with regards to wine.

37. As for the selection process of the goods, I am of the view that this will vary depending on where the goods are selected. Firstly, the goods will be sold in supermarkets, off-licences, specialist wine retailers and their online equivalents. This all suggests a more visual selection process. Secondly, the goods are also likely to be sold in restaurants, bars and public houses, where they may be requested orally, although this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount aural considerations.

Distinctive character of the opponent's mark

38. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as

originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

39. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. While the opponent argues that its mark enjoys an enhanced degree of distinctive character owing to the use made of it, I will first consider the inherent position.

40. With regard to the meaning of its own mark, I note that the opponent’s submissions are as follows:

“the ‘ALTAMIRA’ suffix is the dominant and distinctive element of the Earlier Mark because the relevant consumer is accustomed to encountering the wording ‘FINCA’ in the context of alcoholic beverages. As mentioned under paragraph 4 of the Witness Statement of Julio Lasmartres, “Finca wines” is an understood term that refers to wines from Estate-grown grapes.”

41. While the above submissions were made in respect of the overall impression of the marks, I consider that they are relevant here. I note the reference to paragraph 4 of Mr Lasmartres’s witness statement and reproduce the same here, for completeness:

“My Company produces Estate wines, which is the equivalent of “Finca” wines, in Spanish. For this reason, My Company has named its Estate wines as FINCA ALTAMIRA, FINCA MIRADOR and FINCA BELAVISTA. Each of these refers to their estate of origin, which reflects My Company’s values, in particular our respect for the soil and our vision that each wine expresses its terroir.”

42. I accept that there may be wine experts and Spanish speakers in the UK who may perceive a descriptive or allusive message in the word FINCA (as a reference to a type of 'estate' wine) and may also be aware of ALTMIRA being a wine growing region (as also submitted by the applicant and referred to as a preliminary issue above). For these consumers, the inherent distinctiveness of the opponent's mark will be low to medium. However, the overwhelmingly largest and significant proportion of wine consumers are ordinary members of the public over the age of 18 who will not have such expert knowledge or knowledge of the Spanish language. Consequently, I will restrict the remaining considerations of this decision to this latter group. In the event that I find a likelihood of confusion in respect of this group of consumers, then I may properly conclude that the applicant's mark offends the 5(2)(b) ground⁹ and the position regarding the specialist group of consumer is of no further assistance. In the event that I find no likelihood of confusion in respect of this group of consumers, I will proceed to consider the position regarding the specialist group of consumers at the conclusion of the 5(2)(b) ground.

43. While the evidence and submissions are noted, I have nothing before me by way of evidence to suggest that the non-specialist UK consumer have become accustomed to the word 'FINCA' in the context of wine. While I considered it appropriate to find that the specialist set of consumers would know this, I am not willing to do so for the present group on the basis that their level of knowledge will be significantly lower than those discussed above. Turning to 'ALTAMIRA', I see no reason why this group of consumers would understand it as a wine growing region or as a geographical location, for that matter. As a result, I consider that both words, when viewed together, will be understood as a combination of two made-up or foreign language words with no obvious meaning. The distinctiveness of the mark will lie equally in both words, with neither dominating the other. The opponent's mark is not allusive or descriptive of the goods at issue and, as such, I consider that for this group of consumers it enjoys a high degree of distinctive character with the distinctiveness lying in the words equally.

⁹ See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein it was found that if a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of a court then it may properly find infringement. While this case was an infringement case, the principles apply equally under 5(2) opposition cases.

44. I turn now to consider the evidence filed by the opponent in order to determine whether the distinctiveness of the opponent's mark has been enhanced due to the use made of it. The opponent's evidence sets out the background of its wine business in that its ambition is to create a prime wine in Argentina. The evidence confirms that the opponent produces what it refers to as 'Estates' wine which it states is the equivalent of 'Finca' wines, in Spanish. The evidence states that 'FINCA ALTAMIRA' refers to the estate of its origin and that it was the first wine that the opponent launched in 1999.

45. The evidence goes into detail to discuss a number of awards that the 'FINCA ALTAMIRA' wine has achieved over the years. The first award achieved was a 'Decanter Five Star' award in 1999 and the evidence states that it is the first and only Latin American wine to do so. The evidence states that this award is the most prestigious wine award and is trusted around the globe for its rigorous judging process but I have nothing before me to suggest how the award is decided, be that via a panel of critics or the wider public, for example. The evidence then discusses the fact that 'FINCA ALTAMIRA' was named as one of the 10 best wines of 2016 by Forbes.com. A print-out of an article confirming this is provided and I note that the article is dated 5 January 2017.¹⁰ While I accept that Forbes is a large international publication, the article provided appears to be the opinion of just one contributor (of who the qualifications and expertise are not stated) and is clearly aimed at the North American market due to the repeated use of US dollars throughout.

46. There is discussion surrounding the 'FINCA ALTAMIRA' wine featuring in a number of wine critics' recommendations. Of these I note that the opponent's wine achieved a score of 97 out of 100 from three critics, being Tim Atkin in 2016,¹¹ Robert Parker (of The Wine Advocate) in 2013¹² and 2015¹³ and James Suckling in 2018.¹⁴ The narrative evidence attests to these individuals as being some of the

¹⁰ Exhibit JL3

¹¹ Exhibit JL4

¹² Exhibit JL5

¹³ Exhibit JL6

¹⁴ Exhibit JL7

leading and most influential wine critics in the world. I note that the evidence confirms that Tim Atkin is a British writer. However, there is no evidence regarding Robert Parker and I note that the evidence regarding James Suckling's score sets out that it relates to a USA based event which, to me, indicates that he is an American critic.

47. There is also a print-out of a wine report from the 'Wine Spectator' showing scores from various wine reviewers between 1999 and 2011 which show an average score of 93.8 for 'FINCA ALTAMIRA' wines.¹⁵ The opponent states that this is a well-known and highly relevant magazine that specialises in wine. Lastly, I note an award from 'Wine & Spirits Magazine' from 2013 which named 'FINCA ALTAMIRA' the best Malbec wine.¹⁶ The opponent sets out that this is a magazine that was founded 40 years ago and is read by consumers as well as wine professionals.

48. Before proceeding to consider the remaining evidence, I consider it necessary to discuss a number of issues I have with the evidence discussed above. The first is that the evidence, save for the reference to Tim Atkin being British, does not appear to be targeted at the UK market. On this point, I note that the Forbes.com article is aimed at the US market and the evidence regarding James Suckling discusses a US based event. With regards to the remaining publications mentioned, being 'Wine Spectator', 'The Wine Advocate' and 'Wine and Spirits Magazine', there is no evidence suggesting their target territory. Without anything guiding me to suggest that these publications are sold in the UK, I do not consider it appropriate to make a simple inference that because they are 'well-known' or 'well-respected' publications, they must be known to consumers in the UK. The second issue I have with the above evidence is the supporting narrative evidence that attests to the prominence of the critics/publications in the wine industry. In my view, the statements made are fairly vague and while I accept that it may be the case that some consumers in the UK are aware of such publications, I have nothing before me to suggest the actual reach of these publications amongst the relevant consumer base. Given the size of the UK wine markets and without any evidence to the contrary, I suspect that if the publications does reach UK or EU consumers,

¹⁵ Exhibit JL8

¹⁶ Exhibit JL9

it would only reach a very limited number of them and I suspect that there will be experts or connoisseurs of wine. So while I do not dismiss the evidence summarised between paragraphs 45 and 47 altogether, I must bear these issues in mind and treat the evidence with caution when coming to make my overall assessment.

49. In addition to the recognition from critics, the opponent sets out that its wine has been well received by the wider public. This is evidenced by its current rating of 4.5 on 'Vivino', which the evidence confirms is an online wine marketplace and wine app, on which a majority of the world's wines have been rated by consumers. I note that the print-out confirming the score shows that this is an average score taken from 7,405 ratings.¹⁷ The print-out is dated 19 April 2022, being after the relevant date. While a number of reviews are likely to have come during the relevant period, I consider it inevitable that a number of them are from after the relevant date. As for the target audience of the website, I note that it is a '.com' website and while there is reference to products being shipped to the UK and prices in pounds, it is an international website and some reviews are likely to have come from outside of the UK. On this point, as an example, I note that there is a review shown from Abu Dhabi. I must, therefore, treat this evidence with caution.

50. Evidence regarding social media is then discussed and I note that the opponent confirms that it has consistently used its 'FINCA ALTAMIRA' brand on social media, particularly Facebook and Instagram, which are available worldwide. Extracts of the Facebook and Instagram accounts are provided that show the brand from 2015 until 2021.¹⁸ While the posts are noted, there is no evidence as to the follower count of these accounts during the relevant period. Further, I note that the Facebook posts show limited interaction with the posts garnering a small amount of 'likes' and 'shares' (for example, the most liked post from within the relevant period is 169 likes with the most shares being 16). The description of each post is written bilingually in English and Spanish. On this point, the descriptions on the Instagram posts have the letters 'US' before the English description and 'AR' before the Spanish. I consider it reasonable to infer that the 'US' is short for 'United

¹⁷ Exhibit JL10

¹⁸ Exhibit JL11

States' and 'AR' is short for 'Argentina'. To me, this indicates that the posts are targeted at the United States and Argentinian markets. That being said, I appreciate the international nature of social media accounts meaning that this does not exclude the UK market from viewing the posts, however I must still bear in mind the limited viewership figures of this evidence.

51. The evidence then discusses the UK market and confirms that the opponent produces an average of 800 cases of 'FINCA ALTAMIRA' wine per year that results in an average of 9,600 bottles a year. The opponent explains that it exports its wine to the UK via Corney & Barrow, being a long established independent wine merchant that has sales offices in London, Northumberland and Edinburgh that offer 'FINCA ALTAMIRA' wine to consumers in the UK on its website. A print-out showing the sales to Corney & Barrow in the UK is provided that shows the level of sales between 2017 and 2020.¹⁹ I note that the figures are provided in US Dollars and show sales figures of \$29,700 in 2017, \$35,800 in 2018, \$1,000 in 2019 and \$8,500 in 2020. This represents a total of \$75,000. The opponent has not sought to provide these figures in pounds and given the fluctuation of the exchange rate during the period for which the turnover covers, it is not possible for me to reach an accurate amount of turnover in pounds. On the point of the turnover, I consider it necessary to refer back to the claim that the opponent produces an average of 9,600 bottles of wine a year. I note that this was stated within the 'UNITED KINGDOM MARKET' section of the evidence, however, I do not consider that these figures equate to the UK turnover provided but are, instead, global production figures. For example, and as a rough estimate, such a level of production of wines sold in the UK would, when compared to the turnover of 2018, equate to a price of \$3.73 per bottle. Such a figure is inconsistent when cross referenced with other parts of the opponent's evidence (being the vivino.com print-out discussed at paragraph 49 for example) which shows that the opponent's wine is priced at £106 per bottle. Therefore, I conclude that the production figures discussed above relate to the entirety of the opponent's wine production and not just the UK.

¹⁹ Exhibit JL12

52. There are a number of invoices that have also been provided that confirm sales of 'FINCA ALTAMIRA' wine to Corney & Barrow prior to the relevant date.²⁰ I note that these show a total of 2,220 bottles of 'FINCA ALTAMIRA' being shipped to the UK.²¹ The opponent also confirms that other retailers also sell its wine in the UK. While no turnover for these retailers has been provided, I note that they include retailers based in West Yorkshire and London. Print-outs of websites for these retailers showing the 'FINCA ALTAMIRA' wine for sale are provided but I note that these print-outs are undated. Lastly, I note that the opponent has provided a number of photos of its wine taken in Mayfair, London on 4 March 2020.²²

53. No evidence or submissions have been provided in relation to the size of the market at issue. Even without such evidence, I am content to conclude that the market at issue (being the wine market) is enormous. Against such a market, I am of the view that a turnover of \$75,000 over four years, when approximated to pounds, is miniscule. Taking this into account together with the issues I have highlighted regarding the critics reviews, publications, social media and online reviews, I am not satisfied that the opponent has used its mark to the extent that its distinctiveness has been enhanced by any degree.

Comparison of the marks

54. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

55. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

²⁰ Exhibit JL13

²¹ The reference to these same invoices under the proof of use assessment was limited to the relevant period meaning that the invoices prior to that period were discounted. They are, however, relevant to the present issue.

²² Exhibit JL17

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

56. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

57. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
FINCA ALTAMIRA	ALTAMAR

58. I have submissions from both parties in respect of the comparison of the marks at issue. I have taken these into account and while I do not intend to reproduce them here I will, if necessary, refer to them below.

Overall Impression

59. The applicant's mark is a word only mark made up solely of the word 'ALTAMAR'. There are no other elements to contribute to the overall impression of the mark, which lies in the word as a whole. The opponent's mark is also a word only mark that consists of two words, being 'FINCA ALTAMIRA'. Following on from the reasoning set out in my distinctive character assessment above, I find that the overall impression of the opponent's mark lies in the words as a whole with the words playing equal roles.

Visual Comparison

60. The marks at issue are similar to the point that the words 'ALTAMAR' and 'ALTAMIRA' share the same first five letters and their seventh. However, the fourth letter of these words differs and the opponent's word consists of an eighth letter, which the applicant's does not. Further, and more noticeably, the marks differ in the presence of the word 'FINCA' that sits at the beginning of the opponent's mark. Taking all of this into account and bearing in mind that average consumers tend to focus on the beginnings of marks,²³ I find that the marks are visually similar to a medium degree.

Aural Comparison

61. I note that the opponent's submissions in respect of the aural comparison disregard the word 'FINCA' in its own mark. I do not accept such an approach and find that the entirety of the mark will be pronounced. Therefore, I consider that the opponent's mark consists of six syllables that will be pronounced as 'FIN-KA-AL-TA-MEE-RA'. The applicant's mark consists of three syllables that will be pronounced as 'AL-TA-MAR'. The first two syllables of the applicant's mark are identical to the third and fourth syllables in the opponent's mark. As for the third syllable in the applicant's mark and the fifth syllable of the opponent's mark, I accept that these are somewhat similar given their use of the letter 'M'. The remaining syllables in the opponent's mark (being the first, second and sixth) are different and share no counterpart in the applicant's mark. Aurally, I note that the opponent's mark is double the length of the applicant's mark. Taking all of this into account and, again, bearing in mind the different beginnings in the marks as wholes, I find that the marks are aurally similar to between a low and medium degree.

²³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual Comparison

62. I note that I have submissions from the parties regarding the conceptual comparison based on the Spanish language and the understanding of the word 'FINCA'. I have considered and dismissed the position regarding 'FINCA' under my distinctive character assessment and, for the same reasons, I make the same finding here. As for the reliance upon the Spanish language, I note that the applicant submits that the meanings of 'ALTAMAR' and 'ALTAMIRA' are "high sea" and "high sight", respectively. I appreciate that there are some consumers in the UK that speak Spanish and would, therefore, understand the meanings of the words. However, as per paragraph 42 above, I have limited my assessment to the ordinary consumer in the UK that neither has an expertise in wine, nor do they understand the Spanish language. Therefore, I do not consider that this argument is of any assistance to the applicant at present.

63. I have set out above that I consider the opponent's mark, 'FINCA ALTAMIRA', will be viewed by the relevant group of consumers as a combination of two made-up or foreign language words with no obvious meaning. I am of the view that a similar finding will apply to the applicant's mark, being 'ALTAMAR', in that it will be viewed as a single made-up or foreign language word which will also have no obvious meaning. As such, neither mark has any immediately graspable concept to the average consumer in the UK and, therefore, I do not consider it possible to make a conceptual comparison between them. As a result, I find the marks to be conceptually neutral.

Likelihood of confusion

64. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global

assessment where 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

65. I have found the parties' goods to be either identical or similar to a medium degree.

I have found the average consumer for the goods to be members of the general public (that do not possess any significant knowledge surrounding wine) who will select the goods at issue via primarily visual means, although I do not discount an aural component playing a part. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods at issue. In respect of the similarity of the marks at issue, I have found the marks to be visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually neutral. I have found that the opponent's mark is inherently distinctive to a high degree, being a factor that is in favour of the opponent.

66. The opponent has filed detailed submissions in favour of the existence of there being a likelihood of confusion in the present case. While I do not intend to address each and every point raised, I do wish to address the argument that 'FINCA' is non-distinctive and, therefore, more trade mark significance will be placed on 'ALTAMIRA'. I have found throughout this decision that, for the largest relevant group of consumers, 'FINCA' is not likely to be understood as a reference to a type of 'estate' wine and, as such, I do not consider that it will be viewed as non-distinctive. Such an argument is, therefore, dismissed.

67. In making my assessment of confusion, I bear in mind the case of *Aveda Corporation v Dabur India Limited* [2013] EWHC 589 (Ch) wherein Arnold J. (as he then was) considered the issue of confusion between 'AVEDA' and 'DABUR

UVEDA'.²⁴ The judge accepted that the assessment of a likelihood of confusion must be made by considering and comparing the marks at issue as wholes but, as per the case of *Medion v Thomson*,²⁵ the judge accepted that there are situations in which the average consumer, while perceiving the mark as a whole, will recognise that it consists of two signs, one or both of which having a significant which is independent of the composite whole. As such, the judge deemed that 'UVEDA' would be perceived to have significance independently of 'DABUR UVEDA'. Notably, at paragraph 48 of his decision, the judge found that:

"I think there can be little doubt that the average consumer who was familiar with AVEDA beauty products would be likely to be confused by the use of DABUR AVEDA in relation to identical goods. In particular, there would be a strong likelihood that the average consumer would think that it indicated some connection between DABUR and AVEDA. In my judgment it makes little difference that the second word in the composite mark is UVEDA rather than AVEDA. As the hearing officer rightly accepted, UVEDA is both visually and aurally very close to AVEDA. The human eye has a well-known tendency to see what it expects to see and the human ear to hear what it expects to hear. Thus it is likely that some consumers would misread or mishear UVEDA as AVEDA.

68. In the present case, I consider that a similar outcome will apply to the issue of confusion. Firstly, I am of the view that the average consumer would perceive 'ALTAMIRA' to have significance independently of 'FINCA ALTAMIRA' as a whole. I have found that neither word in the opponent's mark is more distinct than the other and the overall impression lies across both words equally. I do not consider that the words, when viewed together, form a unit and neither do I consider that either word informs the other on the basis that neither word has any obvious meaning to the relevant consumers. In this scenario, it is likely that 'FINCA' will be viewed as the indicator of the house brand and, therefore, the primary indicator of

²⁴ I note that the case law regarding the approach to *Medion* has developed since this case, namely the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch) (also determined by Arnold J. (as he then was)). That being said, the principles set out in the *Aveda* decision are still applicable to the present case.

²⁵ Case C-120/04

origin with 'ALTAMIRA' being the secondary indicator of origin. Secondly, while I appreciate that 'ALTAMIRA' and 'ALTAMAR' are not identical elements, I follow the same reasoning as set out in *Aveda* in that they are clearly highly similar elements that share the same first five letters and their seventh. This is further compounded by the fact that the similarities between these elements lie in their beginnings (which are identical) being where the average consumer tends to focus. In addition to the high level of similarity between these elements, I also bear in mind the fact that neither mark carries any obvious conceptual meaning. Without any immediately graspable concept across these elements, there is nothing to counteract the visual and aural similarities between them. Further, as I have set out above, the average consumer does not dissect trade marks and therefore I consider that they are less likely to spot the differences between these elements, especially considering the issue of imperfect recollection.

69. As a result of the above, I consider that the differences between 'ALTAMAR' and 'ALTAMIRA' are likely to be overlooked. Given that 'ALTAMIRA' plays a significant role in the opponent's mark and is an independent element within the mark as a whole, I consider that the difference in the presence of 'FINCA' is likely to be seen as reference to the undertaking's house mark (on the basis that it is the first element). As such, I consider that the applicant's use of 'ALTAMAR', without the presence of 'FINCA' and upon being confused for 'ALTAMIRA' will be viewed as an alternative mark used by the same or economically linked undertaking. This is on the basis that use of marks with or without their house branding is not particularly uncommon and the average consumers will not consider the admission or omission of 'FINCA' to be particularly surprising. On the contrary, I find that such an admission/omission is likely to be seen as logical and consistent with a brand extension or sub-brand. Whether the consumer is confused as to believe that the applicant's mark is a brand extension or sub-brand of the opponent's mark or vice versa, it is not relevant to the present assessment.²⁶ Consequently, I consider that

²⁶ See *Colloiseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, regarding "wrong way round confusion", referring to *Comic Enterprises* (cited above) at paragraphs 75-84. In that case Kitchin LJ explained that "right way round" or "wrong way round" confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. He explain further that in both instances the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

there exists a likelihood of indirect confusion, even for goods that are similar to a medium degree.

Final remarks regarding 5(2)(b)

70. As per my comments at paragraph 42 above, my assessment of confusion was based on the ordinary average consumers with no expert knowledge in wine or an understanding of the Spanish language. Given that I have found confusion for these consumers and bearing in mind the comments of Kitchin LJ in *Comic Enterprises* (cited above), it is not necessary to consider the remaining consumer base (being those with an expert level of knowledge of wine). As a result, the opposition under section 5(2)(b) succeeds in full. For the sake of completeness, I will proceed to consider the 5(3) ground.

Section 5(3)

71. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

72. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

73. The conditions of section 5(3) are cumulative. There must be similarity between the marks; the opponent must also show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. The opponent must also establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Assuming that these conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

74. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 30 June 2021.

Reputation

75. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

76. I remind myself that under the present ground, the opponent relies on the same mark and same set of goods as it did under its 5(2)(b) ground. Before proceeding, it is necessary to point out that as the opponent’s mark is a comparable mark based on a pre-existing EUTM, use of the same in the EU prior to IP Completion Day (being 31 December 2020) is relevant to the assessment of the existence of a reputation. As a result, I bear in mind the case of *Pago International GmbH v*

Tirolmilch registrierte GmbH, Case C-301/07, which set out that an EU trade mark may be considered to have a reputation if it is known by a substantial part of the territory of the European Community and that the territory of a single Member State alone may be considered as satisfying that requirement. Further, I note the case of *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC), wherein Geoffrey Hobbs Q.C. confirmed that when assessing reputation in the EU, the UK is a substantial part of the same. While these cases were determined prior to the UK's departure from the EU, they remain relevant insofar as use in the EU is a relevant factor.

77. I have produced a summary of the opponent's evidence at paragraphs 44 to 53 above. While this evidence was focused on the issue of enhanced distinctiveness, it represents the entirety of the evidence filed and is relevant to the issue of reputation also. I do not intend to reproduce the evidence summary here but remind myself of particular points that are relevant to the overall assessment of reputation. I note that no evidence of market share has been provided but given the likely size of the market at issue, I am of the view that a UK turnover of \$75,000 between 2017 and 2020 is miniscule and does not indicate that the use was particularly intensive throughout that period. Notwithstanding the issue with the size of the turnover, I note that it spans over four years and this is not, in my view, reflective of particularly longstanding use. Further, no evidence has been provided in respect of advertising expenditure. I consider that the low level of turnover and lack of advertising spend is a significant issue for the opponent. While I appreciate that the issue of reputation must be based on the evidence as whole, I refer to the issues with the remaining evidence that in that it is either international in nature or too vague or imprecise regarding its target territories and, as such, I consider it to be of very little probative value. Taking all of the evidence into account, I am not satisfied that the opponent's mark had established a reputation in a significant part of the relevant UK or EU public at the relevant date.

78. The lack of a reputation is fatal to the claim under section 5(3) and it is not necessary to proceed to consider the existence of a link between the marks or the issue of damage. As a result, the reliance upon the 5(3) ground fails.

CONCLUSION

79. The opposition succeeds in its entirety and the application is hereby refused.

COSTS

80. As the opponent has been successful, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,200** as a contribution towards its costs. The sum is calculated as follows:

Preparing the notice of opposition:	£200
Preparing evidence:	£500
Filing written submissions:	£300
Official fees:	£200
Total:	£1,200

81. I hereby order VIÑA UNDURRAGA S.A. to pay ACHAVAL-FERRER, S.A. the sum of £1,200. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 1st day of March 2023

A COOPER
For the Registrar