

TRADE MARKS ACT 1994  
IN THE MATTER OF INTERNATIONAL REGISTRATION No 677877  
AND THE REQUEST BY CONVINCA, SDAD, COOP  
TO PROTECT A TRADE MARK  
IN CLASS 33

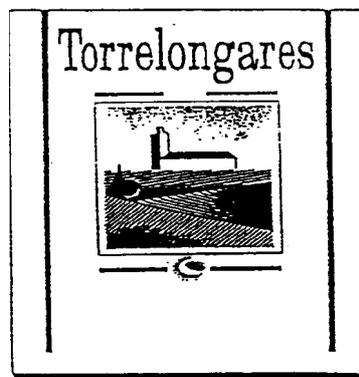
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UNDER No 70049  
BY MIGUEL TORRES S.A.

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## BACKGROUND

On 3 April 1997, Convinca, SDAD, COOP, of Ctra. De Valencia, s/no, E-50460 Longares (Zaragoza), Spain, on the basis of a registration held in Spain, requested protection in the United Kingdom of the trade mark depicted below under the provisions of the Madrid Protocol.



The mark consists of the fanciful word “Torrelongares” written in special lettering on the upper part of a rectangular area that includes at the center [sic] several straight lines and a schematic representation of a countryside scene with a building in the background.

The international registration is numbered 677877 and protection was sought in Class 33 for “Alcoholic Wine and beverages (except beers)”.

The United Kingdom Trade Marks Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

On 27 April 1998 Miguel Torres S.A. filed notice of opposition to the conferring of protection on this international registration based on their proprietorship of the marks set out in the Annex to this decision. The grounds of opposition are based upon Sections 5(2) and 5(3). Although no direct reference to the sections of the Act is made, the wording of the objections closely follows the wording of the Act. At least one of the opponents’ marks is said to have been used since 1964 and to have a reputation in the UK.

The applicants subsequently filed a counterstatement denying the above grounds.

Both sides ask for an award of costs.

Both sides filed evidence in these proceedings and the matter came to be heard on 24 October 2000, when the applicants were represented by Mr Carpmael of Messrs Carpmaels & Ransford, whilst the opponents were represented by Mr Wise of Messrs Raworth Moss & Cook.

#### OPPONENTS' EVIDENCE

This opponents filed a declaration dated 3 November 1998 by Angel De La Rubia Perez, the manager of Miguel Torres S.A, a position he has held since 1989. He confirms that he is conversant with the English language.

Senor Perez provides a potted history of his company's business in the following terms:

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

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

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

He also exhibits, at ARP-2, copies of a number of labels used by his company containing the words TORRES or MIGUEL TORRES and three-tower device and confirms the existence of various trade mark registrations.

World-wide, European and UK sales volumes are provided, I have chosen to show only the

UK figures below:

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

Each case contains 12 bottles.

Product promotion is handled by local agents with an average of 15% of the sales revenue being spent on advertising. This takes the form of leaflets, information booklets, wine tasting and talks to the public and distributors. At exhibit ARP-3 are extracts from three UK wine merchants' price lists where the goods are referred to. It is suggested that because of the format of these lists that the applicants' goods and mark would be listed alongside those of the opponents.

Senor Perez also provides claims that confusion could occur because of the following:

- wine lists would shorten the applicants mark to TORRE when referring to the producer.
- customers are more likely to look for the word TORRES or TORRE and so confuse the applicants TORRELONGARES mark for that of the opponents.
- As the word TORRE or TORRES means "tower" customers are likely to be confused as to the origin of the goods.
- wines are normally stacked on shelves in retail outlets according to their geographical area of origin and so the goods will be in close proximity to each other.
- because bottles are circular in shape, when placed on a shelf the labels will be partly obscured.
- the opponents take action against attempts to use or register the words TORRE or

TORRES by other companies. Senor Perez distinguishes a recent case (TORRE NOVA) based on insufficient similarity between the respective marks and the fact that the goods were in a different price range and of Italian origin. He also mentions an opposition against the mark BARON DE LA TORRE.

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#### APPLICANTS' EVIDENCE

10 The applicants filed a declaration dated 23 February 1999 by Antonio Gasca Buil, the manager of Convinca, SDAD, COOP. He confirms that he is conversant with the English language.

In rejecting the claim that consumers will be confused, Senor Buil comments:

15 "I accept that knowledgeable purchasers of wines may well purchase wines according to the name marked on the bottle. Accordingly, a knowledgeable customer looking for a TORRES wine would only purchase a wine if the bottle was marked with that name. In my opinion, it is inconceivable that a knowledgeable customer would purchase a bottle of wine marked with my company's opposed trade mark thinking it was a wine of Miguel Torres, S.A. I submit that a customer going into an off-licence, supermarket  
20 or other store to purchase a bottle of wine would be unlikely to be influenced by the name of the wine manufacturer. Such a customer would be more likely to be influenced by the grape variety e.g Riesling, Sauvignon Blanc, Chardonnay or, in the case of a red wine, Cabernet Sauvignon, Shiraz or Syrah, Pinot Noir or perhaps even Grenache (Granacha) or Merlot, although perhaps it is even more likely that the  
25 customer would be influenced by the country of origin, or perhaps the region from which the wine came such as Burgundy, Rioja or Bordeaux."

He continues:

30 "I accept that wines are often placed on shelves in wine shops and supermarkets in a geographical context i.e. in regions or countries. I cannot accept, however, that if a Miguel Torres wine marked with the trade mark TORRES was placed alongside a wine marked with my company's opposed mark, that a customer would be confused into thinking the two bottles came from the same company. A knowledgeable  
35 customer would immediately know that this was not the case but a customer having little knowledge of wine would most unlikely to be confused. Such customers normally seek advice from the shop concerned where usually staff are extremely knowledgeable and, in any event, the opposed mark is quite different from the TORRES mark, as can be seen by a simple comparison between the opposed mark and exhibit ARP-2."

40

At exhibit AGB-1 Senor Buil provides a list of marks, in Class 33, from the UK registry which include the word TORRE. The existence of these marks is said to show that the opponents do not enjoy a monopoly in marks containing the word TORRE. He further claims that the word TORRE or TORRES or its French equivalent is commonly used in the wine  
45 industry, and he cites various examples, including Chateau Latour. Thus he claims the word TOWER is a word associated with wines throughout all the major wine producing regions in Europe.

## OPPONENTS EVIDENCE IN REPLY.

5 Senor Perez filed a second declaration, dated 7 July 1999. In this declaration he disputes the applicants claim that customers should rely on advice “extremely knowledgeable” staff, and claims that such comments support his contention that there is a real risk of confusion between the marks. He also claims that the average UK customer would not regard the words “La Tour” and “Torres” as similar.

10 That concludes my review of the evidence. I now turn to the decision.

## DECISION

15 At the hearing Mr Wise withdrew the grounds of opposition under Sections 5(2)(a) and 5(3). He also raised an issue as to whether the mark in suit was contrary to European laws regarding the use of appellation of origin. Whilst this forms no part of the decision of this Tribunal I agreed not to issue the decision for a period of two weeks whilst Mr Carpmael ascertained if the applicants wished to withdraw their application in view of this allegation. In the event the applicants confirmed in writing that they did not wish to withdraw as they  
20 believe the allegation to be without foundation. The other views expressed in their letter have not been taken into account in formulating my decision.

I turn first to the ground of opposition under Section 5(2)(b) which is as follows:

25 “5 .- (2) *A trade mark shall not be registered if because -*

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

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

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

35 6.- (1) *In this Act an ‘earlier trade mark’ means -*

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

45 I have to determine whether the marks are so similar that there exists a likelihood of confusion on the part of the relevant public. In deciding this issue I rely on the guidance of the European Court of Justice in *Sabel Bv v Puma AG [1998 RPC 199 at 224]*, *Canon v MGM [1999 ETMR 1]* and *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel BV [1999 ETMR*

690 at 698]. It is clear from these cases that: -

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

5

(b) the matter must be judged through the eyes of the average consumer, of the goods / services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind;

10

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

15

(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;

20

(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

25

(f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

30

(g) 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);

(h) 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.

I also take into account the recent case of *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723. The European Court of Justice said of Article 4(1)(b) (transposed into UK law in Section 5(2)(b):

35

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character.....Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

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45

The Court felt that the concept of association of marks in the global assessment of the likelihood of confusion was over emphasised. It is not sufficient for the average consumer to merely associate marks in the sense that if prompted a consumer will call to mind another mark. Thus a mere possibility of confusion, even in situations where a mark clearly has a

strong reputation, is not a valid ground for opposition to a trade mark.

At the hearing it was common ground that goods of both parties were identical or similar. It is clear from the above cases that in the overall assessment of a likelihood of confusion, the  
5 similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

As is clear from the Annex to this decision the opponents are relying on a number of  
10 registrations, some of them consisting of the word TORRES alone, others TORRES with additional words and yet others with devices. At the hearing Mr Wise for the opponents considered that the opponents' strongest case was under registrations B1039853 (Torres) and 1404528 (Torres Milmanda).

15 The mark applied for consists of the word TORRELONGARES together with a countryside scene which has a building in the background. The format of the mark is that of a wine bottle label, a view that was not disputed by the applicants. The opponents contended that the agricultural scene on the mark in suit would also be confused with their own labels which have  
20 countryside or agricultural scenes in them. I do not accept this contention as it is common to have such scenes on wine labels and the general public would not, in my view, attribute much importance to such devices. In my view the word TORRELONGARES would be taken to be a distinctive and dominant component of the mark.

When comparing the mark in suit to TORRES, visually the respective marks have the first five  
25 letters in common but are quite different in their overall length and appearance. These differences far outweigh the commonality. Aurally the words are quite different and unlikely to be confused. The opponents' mark consists of two syllables whilst the applicants' mark has five syllables. Even allowing that the endings of words can be slurred, I cannot see how TORRELONGARES can be sufficiently mangled to a point where there is a risk of confusion  
30 with TORRES. The opponents' mark is evidently a surname but it also means "tower". However, I doubt that either signification would be apparent to the average UK consumer. The applicants' mark is said to be fanciful and has no meaning other than perhaps as "Longares tower". Again this would not be apparent to the average UK consumer.

35 When considering the opponents' TORRES MILMANDA mark to the mark in suit, again it is clear that they have the first five letters in common. The marks are of similar length and both have five syllables. The fact that the opponents' mark is two words is not, to my mind, significant. What is significant is the differences in the last three syllables of the two marks. They are totally different and in my view far outweigh any similarities. Aurally the marks share  
40 an identical beginning but are very different thereafter. Again, even allowing for the concept of slurring word endings the marks cannot be made to sound even vaguely similar. Neither has a conceptual meaning apparent to the average UK consumer.

The opponents have suggested that the applicants' mark would be shortened to TORRES in  
45 wine lists although no evidence or basis for these views is offered. It is clear that the opponent's own wines are referred to as "TORRES from Spain" or Torres, Penedes" (Penedes being the appellation of origin). I accept that the wines would appear in the same

section of wine lists. It has also been suggested that confusion will arise from the proximity of the goods of each party on shelves in retail outlets, and also that when placed on said shelves the labels will be partly obscured. Whilst the goods may be in close proximity I do not agree with the contention that the labels would be obscured and so confuse customers. It is my opinion that the average consumer is likely to exercise some care when selecting such goods and, even allowing for the notion of imperfect recollection, is not likely to be confused.

I must also consider whether all or any of the opponents marks have a particularly distinctive character either arising from the inherent characteristics of the marks or because of the use made of them. The evidence of use of the marks filed shows that TORRES is normally accompanied by the three tower device, and frequently by other trade mark matter. The volume of sales relates to all the marks shown in the annex with no breakdown provided. Any enhanced level of reputation enjoyed by the opponents would rest in the mark "TORRES and three towers device".

With all of this in mind I come to the conclusion that while there are superficial similarities, they are more than counterbalanced by the differences, and when all factors are considered, that there was no realistic likelihood of confusion at 3 April 1997. Consequently, the opposition under Section 5(2)(b) fails.

Lastly, I consider the other ground of opposition under Section 5(4)(a) which states:

*(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -*

*(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade*

*(b) .....*

*A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.*

*(5) Nothing in this section prevents the registration of a trade mark where the proprietor of the earlier trade mark or other earlier right consents to the registration.*

The only potential "earlier right" which the opponent has identified arises under the common law of passing off. I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

"The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of

the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

5 A helpful summary of the elements of an action for passing off can be found in Halsbury's Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:

10 'The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

15 (1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

20 (2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

25 The date at which the matter must be judged is not entirely clear from Section 5(4)(a) of the Act. This provision is clearly intended to implement Article 4(4)(b) of Directive 89/104/EEC. It is now well settled that it is appropriate to look to the wording of the Directive in order to settle matters of doubt arising from the wording of equivalent provisions of the Act. It is clear from Article 4(4)(b) that the earlier right had to have been "acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed...". The relevant date is therefore 3 April 1997, the date of the application.

35 It is clear from the opponents' evidence that they do have goodwill in the UK. Earlier in this decision I found that the marks TORRELONGARES AND TORRES / TORRES MILMANDA were not confusable and so there would not be any misrepresentation. The evidence of the various wine labels and the claimed similarity of the scenes depicted upon them notwithstanding, I do not believe that members of the public would confuse the two trade marks, or believe that there was a trade connection between the users of the two marks. The opponent has filed no evidence that the trade or customers would expect TORRELONGARES to be economically linked to TORRES or TORRES MILMANDA, and the onus under Section 5(4)(a) is on the opponent.

40 In my opinion use of the applicant's trade mark would not amount to a misrepresentation resulting in the passing off of its products as those of the opponent. On this footing the opposition under Section 5(4)(a) of the Act must fail.

45 The opposition having failed the applicants are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £635. This sum to be paid within one

month of the expiry of the appeal period or within one month of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8 day of January 2001

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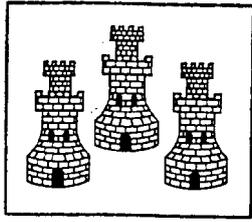
George W Salthouse  
For the Registrar  
The Comptroller General

10

# ANNEX A

	Trade Mark	Number	Class	Journal	Specification
5	TORRES	B1039853	33	5142 / 552	Table wines for sale in England and Scotland
	OLD TOWER	1079971	33	5204 / 1044	Scotch Whisky
	TRES TORRES	1123105	33	5408 / 1039	Wines, liqueurs and spirits (beverages)
	TORRES	B1298955	33	5814 / 1489	Wines, brandy and brandy based orange liqueurs; all included in Class 33
	MIGUEL TORRES	1404075	33	5910 / 1129	Wines, sparkling wine, brandy and liqueurs; all included in Class 33
10		857391	33	4490 / 1516	Wines
15					
20		891250	33	4629 / 643	Spanish Wines
25					
30		1039854	33	5221 / 2046	Brandy

5



1134608

33

5359 / 1260

Wines, spirits  
(beverages) and  
liqueurs.

10

TORRES  
MILMANDA

1404528

33

5894 / 5933

Wines included in Class  
33

15

TORRES  
*Milmanda*