

O-190-05

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2334935  
BY MAWS (WINE IMPORTERS)  
TO REGISTER THE TRADE MARK:**

**VILLA DEL SOL**

**IN CLASS 33**

**AND**

**THE OPPOSITION THERETO  
UNDER NO 92225  
BY MIGUEL TORRES SA**

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### **BACKGROUND**

1) On 14 June 2003 Maws (Wine Importers), which I will refer to as Maws, applied to register the trade mark **VILLE DEL SOL** (the trade mark). The application was published for opposition purposes in the “Trade Marks Journal” on 3 October 2003 with the following specification:

*wine.*

The above goods are in class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) On 30 December 2003 Miguel Torres SA, which I will refer to as Torres, filed a notice of opposition to the registration of the application.

3) Torres states that one of the principal trade marks for its wines is VIÑA SOL. Torres states the Spanish words in the trade mark mean vineyard and sun respectively. It states that VIÑA SOL wines have been sold in the United Kingdom since 1965 and are widely available in supermarkets and through specialist wine retailers. Torres states that the value of sales of wine under the VIÑA SOL trade mark in the United Kingdom exceeds £8 million.

4) Torres is the owner of two registered trade marks:

- United Kingdom registration no 988442 of the trade mark VINA SOL. It is registered for:

*wines produced from grapes grown in Spanish vineyards;*

- Community registration no 462523 of the trade mark VIÑA SOL. It is registered for:

*alcoholic beverages (except beers).*

The goods of both registrations are in class 33 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) Torres states that the goods of its registration are identical or similar to the goods of the application. Torres states that the respective trade marks are similar, especially when the reputation of the earlier trade marks is taken into account. Torres claims that there is a likelihood of confusion and that registration of the trade mark would be contrary to section 5(2)(b) of the Trade Marks Act 1994 (the Act).

6) Torres states that, as a result of the extensive use of its trade mark VIÑA SOL, it enjoys a substantial reputation and goodwill in its trade mark. Torres claims that use of the trade mark of Maws in the same area of business would constitute a misrepresentation and cause damage to it. Use of the trade mark is, therefore, liable to be prevented by the law of passing-off and registration of the application would be contrary to section 5(4)(a) of the Act.

7) Torres seeks the refusal of the application and an award of costs.

8) Maws filed a counterstatement. It denies that the respective goods are identical or similar. It does so on the basis that it claims that the wine of Torres is produced from grapes grown solely or mainly in Catalunya and the Penedès region of Spain, from Chile and California, whilst its wine is produced from grapes from the La Mancha region of Spain. Maws goes on to state that Torres's trade mark covers spirits and liquors whereas its trade mark does not. Maws denies that the reputation of Torres's trade mark is relevant to the similarity or dissimilarity of the respective trade marks. Maws states that its trade mark consists of three words, whereas Torres's trade mark consists of two words. Maws states that the "proper" translation of its trade mark is 'House of Sun', whereas the proper translation of Torres's trade mark is 'Vineyard of Sun'. Maws states that the respective goods will be marketed under widely differing labels, it attaches to its statement of grounds samples of its labels and those of Torres. Maws states that there will be a significant differential between the respective products. Maws states that its product is being aimed at the £2.99 threshold. Maws states that the trade marks VINA SOLEDAD (E1060524) and VILLA SOLENTO (E252387) have both been registered and are no less dissimilar to Torres's trade mark than its is. Maws denies that registration of the trade mark would be contrary to section 5(2)(b) of the Act. Maws does not admit that its trade mark will be used in the same area of business as that of Torres and denies that use of the trade mark would constitute a misrepresentation and cause damage to Torres. Maws denies that registration of the trade mark would be contrary to section 5(4)(a) of the Act.

9) Both sides furnished evidence.

10) Both sides were advised that it was believed that a decision could be made without recourse to a hearing. However, the sides were advised that they retained their rights to a hearing. Neither side requested a hearing. Torres furnished written submissions.

## EVIDENCE

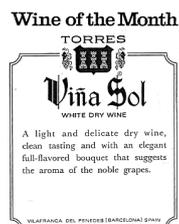
### Evidence of Torres

11) This consists of a declaration made by Luis de Javier. Mr de Javier is the manager of the legal department of Torres, a position which he has held since 1991.

12) Torres is owned by the Torres family, which has been producing wine in Vilafranca del Penedès for over three hundred years. It is the successor in title to Señor Miguel Torres Carbo, proprietor of the Torres vineyard from 1932, who traded under the name 'Miguel Torres'. Torres produces a variety of wines, spirits and Iqueurs, which have been sold in the United Kingdom since 1965. Torres is the twelfth largest producer and exporter of Spanish wines and the leading producer of quality bottled wines with appellation of origin. Torres currently produces over 40 different wines, spirits and liqueurs worldwide; selling 50 million bottles a year in 132 countries. Exhibited at LDJ1 are a magazine and leaflet produced by Torres. Amongst the wines shown in the leaflet are VIÑA SOL and GRAN VIÑA SOL.

13) All of the Torres wines and spirits bear the house mark TORRES but in other respects their labels are different and individual; each has its own name (generally registered as a trade mark) and its own identity, created through styling, colours and an individual font.

14) Mr de Javier states that one of the principal trade marks of Torres is VIÑA SOL, used for a Spanish white wine made from Parellada grapes and fermented in stainless steel. Torres also produces a premium version of the wine, containing Chardonnay grapes, under the trade mark GRAN VIÑA SOL, 'gran' indicating 'best'. Exhibited at LDJ2 are a technical information sheet and samples of a bottle and a neck label. These show the use of the trade mark in the forms below:



15) VIÑA SOL wines have been sold in the United Kingdom since 1965. The number of cases sold has steadily increased. In 2000 sales amounted to almost 60,000 cases, rising to over 90,000 the following year and to over 115,000 and 135,000 in 2002 and 2003 respectively, a case holds 12 bottles. Approximate annual turnover figures since 1983 are as follows:

<b>Year</b>	<b>Value £</b>
1983	55,500
1984	68,500
1985	95,000
1986	133,500
1987	143,000
1988	121,500
1989	134,500
1990	174,000
1991	138,000
1992	245,500
1993	265,000
1994	253,000
1995	216,000
1996	283,000
1997	278,000
1998	288,000
1999	364,500
2000	798,500
2001	1,205,000
2002	1,539,500
2003	1,966,500

Total turnover under the VIÑA SOL trade mark since its launch in 1965 is around £9,822,000.

16) Exhibited at LJD4 are copies of invoices and orders. These are exhibited to show early sales under the trade mark. These are from 1976 and 1977 (one order is from a company in Jersey and so is not relevant to this case). The documents refer to VIÑA SOL and GRAN VIÑA SOL with and without TORRES in front of it.

17) VIÑA SOL wines are widely stocked by retailers throughout the United Kingdom. They are available from major chains such as the Thresher Group, Majestic Wine Warehouse and Unwins. The wine is also sold in supermarkets, including Asda, WM Morrison, Safeway, Sainsbury, Tesco and Waitrose. Exhibited at LDJ5 is a list of the customers for VIÑA SOL wine from 1 February 2000 to 30 June 2004; national and regional stockists are listed. There are 207 stockists in total. Mr de Javier notes that the stockists include not only specialist wine retailers but also hotels, restaurants and department stores such as Selfridges, Fenwicks and House of Fraser. The exhibit also includes leaflets and flyers from wine stockists in the United Kingdom. These emanate

from 1973, 1978, 1986, 1996 and 1997. There are references to VIÑA SOL and GRAN VIÑA SOL. There is a clear identification in all cases with Torres.

18) Mr de Javier states that Torres does not believe in placing advertisements for its wines. Most of the publicity that Torres receives is through reviews in the local, national and trade press. Exhibited at LDJ6 is a selection of copies of articles featuring VIÑA SOL. The articles emanate from 1976, 1977, 1978, 1985, 1988, 1999, 2000, 2001, 2002, 2003 and 2004. They are taken from both the wine press, national newspapers and local newspapers and periodicals. There is invariably reference to Torres, on many occasions the reference is at some distance from the use of VIÑA SOL.

19) Mr de Javier states that there has been some expenditure upon advertising but this is not commensurate with the scale of sales under the trade mark. Approximate figures for the period 1993 to 2003 are given below:

<b>Year</b>	<b>Value £</b>
1993	24,500
1994	23,000
1995	20,000
1996	26,000
1997	25,000
1998	27,000
1999	33,500
2000	74,500
2001	112,500
2002	144,000
2003	169,500

20) Mr de Javier states that the wines of Torres also come to the notice of the trade and the public through awards at prestigious competitions, such as those hosted by the Club Oenologique. Exhibited at LDJ7 is material showing the award of a silver seal to Torres by the Club Oenologique in 1971 for the 1967 vintage of VIÑA SOL. (The Club is based in the United Kingdom.)

### **Evidence of Maws**

21) This consists of a statutory declaration by Mobray Frederick Trentham Maw. Mr Maw is the sales and marketing manager of Maws. He states that Maws is an agency which sources wines from around the world and creates wines for the exclusive use of its clients.

22) Mr Maw exhibits at MFTM1 copies of labelling that is proposed to be used in relation to the trade mark. Mr Maw states that the VILLA DEL SOL wine is produced in Spain. The winery creating the wine is Bodegas Verduguez in the La Mancha region of Spain. He states that VILLA DEL SOL is a table wine. Mr Maw states that Maws

intends to sell the wine through corner shops. It is proposed to sell the wine at £3.29 a bottle. Mr Maw states:

“The applicant notes the registration of existing trademarks, namely, VINA SOLEDAD (E1060524) and VILLA SOLENTO (E252387), both of which are no less dissimilar to the Vina Sol trade mark than the Applicant’s proposed trademark.”

No details of these trade marks are exhibited. I assume from the use of an E prefix that the registrations are Community trade marks.

23) Mr Maw states that the two wines are clearly different for the following reasons: VILLA DEL SOL wine retails at a considerably lower price than VIÑA SOL wine; the target market for VILLA DEL SOL wine is the lower end of the wine retail market, while VIÑA SOL is aimed at the mid-sector of the market; the respective vendors and consumers of the two wines are different; the two wines are unlikely to be found in the same retail outlets; the two wines are not in competition with each other.

## **DECISION**

### **Likelihood of confusion – section 5(2)(b) of the Act**

24) According to section 5(2)(b) of the Act a trade mark shall not be registered if because:

“it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Section 6(1)(a) of the Act defines an earlier trade mark as:

“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”

25) The trade marks upon which Torres relies are earlier trade marks as defined by the Act.

26) In determining the question under section 5(2)(b), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] ETMR 723.

27) Maws appears to have a misunderstanding of the nature of the tests and the considerations that need to be applied in relation to likelihood of confusion. Maws refers to how it intends to use the trade mark. I have to consider the trade mark as applied for, which is simply the words VILLA DEL SOL. I have to consider notional and fair use of that trade mark and notional and fair use of the trade marks of Torres. Maws comments upon the goods upon which it intends to use the wine. It also comments upon the nature of the wine upon which Torres uses VIÑA SOL. I have to consider the specifications of the respective trade marks. The application of Maws is for wine at large. It is not for any specific type of wine. I have to compare these goods with the goods of the earlier registrations. In the case of the Community trade mark this includes all types of alcoholic beverages in class 33, which encompasses all types of wine. In relation to the United Kingdom registration, the specification is limited to wine made from Spanish grapes. It covers any type of wine that is so produced. Maws itself states that it intends to use its trade mark upon wines made from Spanish grapes. So, even if Maws limited its wine to that it intends to use the trade upon, it would not change the position. The goods of the earlier registrations would encompass it. My job is not to consider upon which goods Torres uses its trade marks at the moment, in relation to section 5(2)(b) of the Act, but the goods for which it has cover; all the goods. The Community trade mark covers, amongst other things, every possible type of wine from the crudest table wine to the greatest grand cru. The United Kingdom registration covers every type of wine made from Spanish grapes.

28) Maws comments on its marketing strategy and that of Torres. This misses the point. The matters before me relate to any notional and fair use of the respective trade marks for all the goods that are encompassed. A specification cannot be defined by a marketing strategy. It stands and falls of itself. Specifications cover all the potentialities of use, not just current or intended type of use. In *Daimlerchrysler AG v. Office for Harmonisation In the Internal Market (Trade Marks and Designs)* [2003] ETMR 61 the Court of First Instance (CFI) stated:

“46 However, contrary to what the Office argues, the Court finds that a sign's descriptiveness must be assessed individually by reference to each of the categories of goods or service listed in the application for registration. For the purposes of assessing a sign's descriptiveness in respect of a particular category of goods or service, whether the applicant for the trade mark in question is contemplating using or is actually using a particular marketing concept involving goods and services in other categories in addition to the goods and services within that category is immaterial. Whether or not there is a marketing concept is of no consequence to the right conferred by the Community trade mark. Furthermore, since a marketing concept is purely a matter of choice for the undertaking concerned, it may change after a sign has been registered as a Community trade mark and it cannot therefore have any bearing on the assessment of the sign's registrability.”

This issue was also dealt with by Geoffrey Hobbs QC, sitting as the appointed person, in *Croom's Trade Mark Application* [2005] RPC 2, where he stated:

“31 When assessing the objections to registration in the present case, it is necessary to assume normal and fair use of the marks for which registered trade mark protection has been claimed. The context and manner in which the marks have actually been used by the applicant and the opponent in relation to goods of the kind specified may be treated as illustrative (not definitive) of the normal and fair use that must be taken into account. However, the protection claimed by the opponent independently of registration ( *i.e.* under s.5(4)(a) of the Act) must relate to the actual and anticipated use of the rival marks.”

29) Maws refers to two trade mark registrations which it claims are no less dissimilar to the trade marks of Torres than its trade mark. It is not my job to consider what other trade marks may or may not clash with those of Torres. Neither is it the job of Torres to explain why it has or has not taken action against other trade marks. I have to consider the trade mark of the application and those of Torres, the goods that they encompass, and upon the basis of the case law decide if there is a likelihood of confusion.

### **Comparison of goods**

30) As I have indicated above the goods of the Community trade mark registration must encompass the goods of the application and so the goods are identical. In the case of the United Kingdom registration, the application will encompass the goods of the earlier registration and so there will be a most definite overlap. In *Galileo International Technology LLC v Galileo Brand Architecture Limited* BL O/269/04 Professor Annand, sitting as the appointed person, stated:

“13. I agree with Mr. Onslow that the issue raised by this appeal is whether, when considering the test of identity for section 5(1), it is sufficient that goods or services overlap or must they be co-extensive. Like Mr. Onslow, I am unaware of any authority supporting a co-extensive test. Kerly’s Law of Trade Marks and Trade Names, 13th Edition, states at para. 8-10:

“... the goods or services must be the same as those the subject of the earlier trade mark. Although not explicit, it would seem that this provision can only sensibly be interpreted as prohibiting registration where there is an overlap of goods or services.”

A footnote indicates that such interpretation is in accordance with Article 13 of Council Directive 89/104/EEC. Although not expressly included, it is well established that the TMA must be read subject to Article 13, which provides:

“Where grounds for refusal of registration or for revocation or invalidity of a trade mark exist in respect of only some of the goods or services for which that trade mark has been applied for or registered, refusal of registration or revocation or invalidity shall cover those goods or services only.”

14. The equivalent to section 5(1) in Council Regulation (EC) No. 40/94 on the Community trade mark (“CTMR”) is Article 8(1)(a). Mr. Onslow referred me to two decisions of the Opposition Division of the Office for Harmonisation in the Internal Market (Trade Marks and Designs) (“OHIM”) concerning Article 8(1)(a) of the CTMR where identity of goods and services was found to subsist through overlaps in specifications. In WALLIS, Decision No. 1978/2004, identity was found *inter alia* between Class 14 specifications even though the contested CTM application covered additional goods in that class. The Opposition Division said:

“There is identity between the goods or services that are subject to comparison if they either have the same wording or can be considered synonyms. The identity is also found if the specification of the earlier mark includes a generic term that covers the specific goods of the contested application. Similarly if the goods specifically designated in the earlier mark are covered by a generic term used in the contested application, such goods are identical, to the degree that they are included in the broad category.

Finally, in case that the goods in question overlap in part they are also to be considered as identical.”

A similar decision was arrived at in PACE, Decision No. 1033/2003. Again, the Class 41 services in the CTM application were wider than those in the earlier CTM registration. In addition, there was held to be identity between some of the applicant’s Class 42 services namely, “computer programming; providing of expert opinion”. The opponent’s registration was in respect of “consulting services related to improving and expediting product development, industrial research services, computer programming services” in Class 42. The Opposition Division observed:

“In particular, the applicant’s expression providing of expert opinion in class 42, is broad enough to encompass any consulting services registered by the opponent in class 42, which makes them equivalent to the extent that the one includes the other.”

15. The overlap test for identity of goods and services is also applied by the OHIM in connection with priority and seniority claiming under Articles 29, and 34 and 35 of the CTMR respectively. Indeed, it is recognised that partial priority claiming (i.e. where the subsequent application is for a narrower or wider specification than in the application(s) from which priority is claimed) is a possibility under section 33 of the TMA, which speaks of a right of priority “for some or all of the same goods or services” in a Convention application.

16. I believe that overlapping specifications satisfy the test for identical goods or services in section 5(1) of the TMA. There is no necessity for such specifications to co-extend.”

Consequent upon the overlap in relation to the goods of the United Kingdom registration and the goods of the application, I find that the respective goods are identical.

31) As I have indicated above, if the specification of the application was limited to the goods upon which the trade mark is intended to be used, it would make no difference to the identity of the respective goods.

**32) The goods of the application are identical to those of both of the earlier registrations of Torres.**

### **Comparison of trade marks**

33) The trade marks to be compared are:

**Trade Marks of Torres**

**Trade Mark of Maws**

**VIÑA SOL**

**VILLA DEL SOL**

**VINA SOL**

34) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (*Sabel BV v Puma AG*). The visual, aural and conceptual similarities of the marks must, therefore, be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components (*Sabel BV v Puma AG*). Consequently, I must not indulge in an artificial dissection of the trade marks, although taking into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*). “The analysis of the similarity between the signs in question constitutes an essential element of the global assessment of the likelihood of confusion. It must therefore, like that assessment, be done in relation to the perception of the relevant public” (the Court of First Instance (CFI) in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02).

35) The CFI has held recently that “in general terms, that two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects” (*Faber Chimica Srl v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-211/03). This approach has appeared in other recent judgments of the CFI. The French concept of partial reproduction, having been thrown out of the front door in relation to identity of trade

marks by the ECJ in *LTJ Diffusion SA v Sadas Vertbaudet SA* (Case C-291/00) [2003] ETMR 83, appears to be sneaking in at the back door in relation to similarity of trade marks. This issue was recently dealt with by Richard Arnold QC, sitting as the appointed person, in *Buffalo Creek* BL O/169/05. Having surveyed the various case law Mr Arnold came to the following conclusion (at paragraph 37):

“The conclusion I draw from this review of the case law is that there are no special rules to be applied when comparing a composite mark which includes an earlier mark with the earlier mark. The principles laid down in *SABEL*, *Canon*, *Lloyd* and *Marca Mode* remain the applicable principles. In particular, the tribunal must consider the overall impression given by each mark as a whole bearing in mind its distinctive and dominant components. In some cases the overall impression given by a composite mark may be dominated by one component of that mark.”

I will start on the basis that because trade marks coincide in one particular element they are not necessarily similar, even if the element is a distinctive element. As Geoffrey Hobbs QC, sitting as the appointed person, stated in *Torremer* [2003] RPC 4:

“At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, *Wagamama Ltd v City Centre Restaurants Plc* [1995] FSR 713) or origin neutral (see, for example, *The European Ltd v The Economist Newspaper Ltd* [1988] FSR 283).”

36) As the CFI found in *Succession Picasso v OHIM - DaimlerChrysler (PICARO)*, in considering whether trade marks are similar the perception of the relevant public has to be taken into account. The goods in questions are wines. These goods are purchased by a large swath of the public. There are experts and persons with a great interest in wines. However, there are also purchasers who will have little knowledge or interest in wines, possibly only purchasing them infrequently for special occasions or to take to parties. There will be those whose only interest is in getting drunk. Other than that the purchaser is likely to be over eighteen, I consider that there is no particular relevant public but that the relevant public is the public at large.

37) In its statement of grounds Torres states:

“The Applicant’s Mark is similar to the Opponent’s Mark within the meaning of the Act, particularly when the reputation of the Opponent’s Mark is taken into account.”

According to *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* and *Sabel BV v Puma AG*, the reputation of a trade mark can have an effect in deciding if there is a likelihood of confusion. However, the reputation of a trade mark does not alter its

similarity, or lack of similarity, with another trade mark (see *Vedial SA v Office for the Harmonization of the Internal Market (marks, designs and models) (OHIM) C-106/03 P*).

38) All of the trade marks end with the word SOL, which is separated from the other word(s) in the trade mark. All of the trade marks start with a word that begins with the letters 'vi' and ends with the letter 'a'. Both sides have commented on the meanings of the trade marks. However, the meanings of the words can only have any relevance if the average consumer for the goods knows what they mean. There is an absence of evidence in relation to this. The British public are notorious for their absence of knowledge of other languages. Even if the public are aware of SOL and DEL SOL, from the fame of the Costa del Sol, there is no certainty that the average consumer will actually be aware of the meaning of SOL or DEL SOL. VINA, as far as I am aware, despite the translation in the United Kingdom registration, is not a Castellano word. The absence of the tilde does change the word. VIÑA is a Castellano word. However, there is no evidence that the average consumer will know that it means vineyard. VINA and VIÑA might be seen as alluding to wine owing to the presence of VIN at the beginning of each, and the nature of the goods in question. It is quite possible that the average consumer will have heard of vin and vino. However, it is not something, in the absence of any form of evidence, that I would wish to guess at. It is a possibility. VILLA, as well as having several meanings in Castellano, is a commonly used English word. It is my view that the average consumer will see this word as being simply that English word; especially as villa holidays are commonplace in the warmer climes. Taking the view that the words VINA and VIÑA will be meaningless to the average consumer, in the absence of any evidence to the contrary, there is a conceptual dissonance with VILLA; although not the extreme dissonance that arises where it is established that each word being compared has a meaning and that the meanings are different. The CFI in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH* Case T-292/01 [2004] ETMR 60 held:

“54. Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately. In this case that is the position in relation to the word mark BASS, as has just been pointed out in the previous paragraph. Contrary to the findings of the Board of Appeal in paragraph 25 of the contested decision, that view is not invalidated by the fact that that word mark does not refer to any characteristic of the goods in respect of which the registration of the marks in question has been made. That fact does not prevent the relevant public from immediately grasping the meaning of that word mark. It is also irrelevant that, since the dice game Pasch is not generally known, it is not certain that the word mark PASH has, from the point of view of the relevant public, a clear and specific meaning in the sense referred to above. The fact that one of the marks at issue has such a meaning is sufficient - where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

That case dealt with trade marks consisting of one word. In this case the trade marks contain other matter which is not the subject of conceptual dissonance. I do not assume that the average consumer will necessarily know the meaning of SOL. However, I do consider that owing to the fame of the Costa del Sol that the average consumer will associate the word SOL with Spain. In its submissions Torres claims that United Kingdom consumers are aware that words such as 'de' and DEL are "less important syllables, understanding them to be equivalent to the English word 'of'". I assume by "less important syllables" that Torres is arguing that less weight will be given to the word DEL than to the other elements of the trade mark. Again there is no evidence as to how the average consumer will perceive DEL, whether he or she will know that it means 'of the'. I am not going to assume that the average consumer will have this knowledge. However, because of the notoriety of the Costa del Sol, I consider that it is likely that it will be seen as a Castellano word.

39) There is nothing to suggest to me that the average consumer will pronounce the words forming the two trade marks other than in "an English fashion". I do not expect the average consumer will pronounce the 'v' as a 'b' or give a 'yir' sound to the double 'l'. Equally, there is nothing to suggest that the average consumer will be aware of the effect of the tilde over the 'n' in VIÑA. (The United Kingdom registration does not even have the tilde.)

40) Taking into account all the above I come to the following conclusions. The SOL elements of the trade marks is phonetically and visually identical. It is likely to engender an association with Spain. The VILLA and VINA and VIÑA elements have a certain visual and phonetic similarity. However, to be considered against this is the conceptual dissonance. Both trade marks have a "Spanish feel". As a whole there is a certain visual and phonetic similarity, both trade marks ending with SOL and beginning with 'vi', and the first word of each trade mark ending in the letter 'a'. The trade mark has the word DEL in its centre, which is totally alien to the earlier trade marks.

41) In considering the respective trade marks I need to consider the effects of the differences as well as the similarities (see *Croom's Trade Mark Application* [2005] RPC2). Owing to the nature of the goods, it is not necessary that a great deal of care will be taken in the purchasing decision. The goods are the sort that could be occasional purchase. These last two factors increase the propensity to imperfect recollection. It is also to be borne in mind that the trade marks must be considered and compared in their entirety. Consumers do not normally indulge in the philological dissection and analysis of trade marks; that is usually the preserve of trade mark professionals.

42) Taking all these factors into account, I have come to the conclusion that the respective trade marks are distinctively similar, if to a limited degree.

## **Conclusion**

43) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity

between trade marks may be offset by a greater degree of similarity between goods, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical. It is necessary to consider the distinctive character of the earlier trade marks; the more distinctive the earlier trade marks (either by nature or nurture) the greater the likelihood of confusion (*Sabel BV v Puma AG* ). The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (European Court of First Instance Case T-79/00 *Rewe Zentral v OHIM (LITE)* [2002] ETMR 91). 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] ETMR 585). It is possible that the VINA and VIÑA elements of the earlier trade marks will bring to mind wine. However, I have no evidence to that effect. Certainly, I cannot see that the SOL element is in anyway descriptive or even allusive to wine. Taking the earlier trade marks in their entirety, I consider that they have a greater capacity to identify the goods. Consequently, they enjoy a good deal of inherent distinctiveness. Torres has claimed a reputation in relation to its trade mark VIÑA SOL. Reputation can give rise to enhanced protection. The enhanced protection that comes with a reputation has two possible effects. It can make a trade mark that does not enjoy a great deal of distinctiveness more distinctive and so cause a greater likelihood of confusion (*Sabel BV v Puma AG*). Reputation can also have an effect where there is only a limited degree of similarity between goods and services (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*). In this case the respective goods are identical and I have decided that the earlier trade marks enjoy a good deal of inherent distinctiveness. I cannot, therefore, see that reputation could improve the case of Torres. The goods could well be purchased without a great deal of care and could be the subject of sporadic purchase; increasing the possibility of the purchaser being the victim of imperfect recollection. Some wine purchasers will be exceptionally discerning and careful in their purchasing decision. I have to consider the average consumer and not the atypical wine connoisseur. As I have stated above, I consider that the respective trade marks are similar, if to a limited degree. Taking into account all the other factors I come to the conclusion that there is a likelihood of confusion; that the average consumer will believe that the respective goods come from the same undertaking or an economically linked undertaking.

**44) Registration of the trade mark would be contrary to section 5(2)(b) of the Act and the application should be refused in its entirety.**

**Section 5(4)(a) of the Act**

45) Section 5(4)(a) of the Act 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,”

I cannot see that Torres could be in any better position under the law of passing-off and so I will refrain from giving a decision in relation to this ground of opposition.

**COSTS**

**46) I order Maws (Wine Importers) to pay Miguel Torres SA the sum of £1600. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.**

**Dated this 4th day of July 2005**

**David Landau  
For the Registrar  
the Comptroller-General**