

O/407/21

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3217920

BY

VIÑEDOS EMILIANA S.A

TO REGISTER THE FOLLOWING TRADEMARK IN CLASS 33

EMILIANA

AND OPPOSITION THERETO UNDER NUMBER 409347

BY

CONSORZIO TUTELA VINI EMILIA,

CHIARLI 1860 - PR.I.V.I. SRL

MEDICI ERMETE E FIGLI SRL

## Background and Pleadings

1. On 10 March 2017 Viñedos Emiliana S.A (“the Applicant”) applied to register the trade mark EMILIANA in the UK under number 3217920 for goods in class 33 namely “wines”. It was accepted and published on the 24 March 2017.

2. On 19 May 2017, Consorzio Tutela Vini Emilia, Chiarli 1860 - Pr.I.V.I.Srl and Medici Ermete E Figli Srl (“the first, second and third Opponents”) opposed the application under sections under 3(3)(b), 3(4) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under section 3(4) of the Act, the Opponents claim that the contested mark contains the Protected Geographical Indication (“PGI”) EMILIA and its use in relation to wines other than wines entitled to use the PGI would be contrary to law and in particular to Articles 102 and 103(2) of the European Parliament and Council Regulation (EU) no.1308/2013 (“the Regulation”).

4. Under Section 3(3)(b) of the Act the Opponents claim that the use of the contested mark in relation to wines other than wines entitled to use the PGI would be liable to deceive the public as to the nature, quality and geographical origin of the goods. Such application for registration should therefore be refused.

5. Under section 5(4)(a) the Opponents claim that they have goodwill attached to EMILIA, which has been used throughout the UK since 1999 in relation to wines, in particular stating that the sign:

“EMILIA is a protected geographical indication which is only permitted to be used in relation to wines produced in a particular region under certain conditions. The First Opponent is the consortium responsible for the guardianship regulation and oversight of the EMILIA indication and the Second and Third Opponents are wine producers that use the indication in relation to

wines exported for sale in the UK. There is a protectable goodwill in the UK associated with these activities.

The use of the Applicant's mark EMILIANA is likely to misrepresent to consumers that the Applicant is a producer of wine entitled to use the protected geographical indication or is economically associated with such a producer that use is likely to cause damage to the opponents and is liable to be prevented under the law of passing off."

6. The Applicant filed a defence and counterstatement denying all the grounds and in particular denying that:

- the name EMILIA enjoys a protectable goodwill in the UK.
- the Opponents are the owners of any such goodwill.
- the use of EMILIANA would constitute a misrepresentation.
- the existence and ownership of a PGI for the name EMILIA.
- the use of EMILIANA would be contrary to the law pertaining to PGIs.
- EMILIANA would be deceptive.

7. The Opponents are represented by Haseltine Lake Kempner LLP whereby the Applicant is represented by Burges Salmon LLP. Both parties filed evidence during the evidence rounds. Neither party filed additional submissions. A hearing took place before me on 30 March 2021 by video conference. At the hearing the Opponents were represented by Mr Michael Conway from Haseltine Lake Kempner and the Applicant was represented by counsel Ms Fiona Clark instructed by Burgess Salmon. Both parties filed skeleton arguments prior to the hearing. 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 Trade Marks Act relied on in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts on trade mark matters.

## Evidence

### Opponents' evidence

9. The Opponents' evidence is in the form of four witness statements accompanied by a number of exhibits. A summary of each statement is set out below.

#### **First witness statement of Mr Anselmo Chiarli dated 26 January 2018**

10. Mr Chiarli is the chief executive officer of Chiarli 1860 (the second Opponent) a position he has held since 2002. He confirms that the information provided in his statement is true to the best of his knowledge and belief.

11. A summary of the key information is outlined below:

- Mr Chiarli provides a background to the history of the second Opponent taken from "www.chiarli.it" a company which dates back to 1860 and which focuses on making Lambrusco wines.<sup>1</sup>
- The second Opponent is a family owned business producing Lambrusco wine to the highest quality including varieties entitled to use the PGI "EMILIA" and "DELL'EMILIA".
- Chiarli 1860 is a member of the 'Tutela Vini Emilia' consortium which regulates the use of the PGI in relation to wines.
- Chiarli 1860 exports and sells bottles of Lambrusco wines into the UK which conform to the PGI and which carry the indication DELL' EMILIA on their labels.
- The following table sets out the approximate number of bottles exported to the UK conforming to the PGI between 2013 and 2017

Year	No of bottles exported to UK
2013	1,000,000
2014	700,000
2015	400,000
2016	180,000

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<sup>1</sup> AC1

2017	15,000
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- Sample labels are produced bearing the indication DELL' EMILIA applied to wines exported to the UK for retail sale during 2009 in Sainsbury's and Tesco supermarkets.<sup>2</sup>
- Sample labels are produced bearing the indication DELL' EMILIA applied to wines exported to the UK for retail sale during 2014 in Sainsbury's and Tesco supermarkets.<sup>3</sup>
- Six sample invoices are produced dated between 2013 and 2015 said to relate to the exports of wines bearing the indication DELL' EMILIA for sale in Sainsbury's and Tesco:<sup>4</sup>
  - Five invoices dated 2/12/2015, 12/3/2015, 11/12/2014, 30/4/2014 and 19/12/2013 are produced all addressed to ENOTRIA WINECELLARS LTD and include a description of the goods as follows: "Mosto LAMBR ROSATO/BIANCO/ROSSA at either 4% or 5.5% DELL' EMILIA SAINSBURY" typically the quantities are displayed as for example "3.360 bottles" or "15.120 litres on 24 chep pallets"
  - The invoice dated 30/12/2013 is addressed to TESCO STORES LTD and displays the following quantities; 8400 bottles of BIANCO DEL EMILIA TESCO; 6720 bottles of ROSATO and 3360 bottles of ROSSO.

### **Second witness statement of Mr Anselmo Chiarli dated 20 December 2019**

12. The purpose of Mr Chiarli's second witness statement is to confirm that Chiarli 1860 first exported wines bearing the EMILIA and DELL'EMILIA indications into the UK in 1975 and states that it has done so continuously since.

[REDACTED]

[REDACTED]

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<sup>2</sup> Exh AC2

<sup>3</sup> Exh AC3

<sup>4</sup> Exh AC4



		[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]
[REDACTED]	[REDACTED]	[REDACTED]

**Witness statement of Mr Giorgio Medici dated 30 January 2018**

14. Mr Medici is the president and partner of “Medici Ermete”, a position he has held since 1961. The contents of his statement are taken from his personal knowledge and from documents available to him. A summary of his statement is as follows:

- An extract of the history and origins of Medici Ermete dating back to the nineteenth century is produced taken from the website [www.medici.it](http://www.medici.it).<sup>6</sup>
- Medici Ermete is a family owned business producing wines of the highest quality including, in particular, Lambrusco wines, some of which are produced in accordance with the PGI specifications for EMILIA and DELL’ EMILIA. Medici Ermete is a member of the Tutela Vini Emilia consortium which regulates the use of the PGI in relation to wines.
- Medici Ermete exports wines bearing and conforming to the PGI to the UK. The wines typically carry the indication EMILIA or DELL’ EMILIA on their label.
- Two undated sample labels are produced bearing the indication DELL’ EMILIA said to demonstrate the export of wines to the UK for retail sale by Marks and Spencer during 2008-2017.<sup>7</sup>

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

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<sup>6</sup> GM1

<sup>7</sup> GM2

<sup>8</sup> [REDACTED]



## **First witness statement of Michael Conway dated 30 January 2018**

15. Mr Conway is trade mark attorney at Haseltine Lake LLP the Opponents' representatives. A summary of the main points taken from Mr Conway's statement are as follows:

"[4] The first Opponent the consortium is a voluntary consortium founded on a not for profit basis and is in charge of the protection enhancement and promotion of the protected geographical indications EMILIA and DELL' EMILIA (PGIs). Membership is open to producers of wine entitled to use the PGI.

[5] Chiarli and Medici are wine producers and members of the consortium which market wines under the PGI including in the UK.

[6] The Consortium's website [www.consorzioviniemilia.it](http://www.consorzioviniemilia.it) sets out the consortium's functions and activities in relation to the PGI.

- Protection promotion enhancement consumer information and general care of the PGI
- Establishing marketing rules for the offer of wines by reference to the PGI
- Contributing to the management of grape and wine yields by the producers of wines marketed by reference to the PGI.
- Management of the registration of areas under vine in the vineyard register.
- Selection of a control body."

16. Mr Conway produces the following documents:

- copy company registration certificate for the consortium.<sup>12</sup>
- copy of Minutes of Board of Directors meeting 10 July 2012 annexing the consortium's bylaws with English translation.<sup>13</sup>
- copy Registration details of the PGI from the E-Bacchus database of the EU. The database includes the register of designation of origin and

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<sup>12</sup> MC1

<sup>13</sup> MC2

geographical indications protected in the EU in accordance with Regulation (EU) no 1308/2013 which repealed and replaced Council Regulation (EC) no 1234/2007.<sup>14</sup>

- copy extracts from the Regulation relevant to the opposition.<sup>15</sup>
- copy of the product specification for the PGI as referred to in Article 94 of the Regulation translated into English.
- Undated screenshots (save for a print date of 30 January 2018) of various supermarket and wine retailer websites illustrating the marketing of wines bearing the PGI in the UK. A summary of those screenshots are as follows:
  - Marks and Spencer [www.marksandspencerfoodhall.co.uk](http://www.marksandspencerfoodhall.co.uk) for Lambrusco Dell'Emilia at a price of £3.
  - [nwww.groceries.morrisons.com](http://nwww.groceries.morrisons.com) - for Lambrusco Rosato DELL'EMILIA at price of £2.50. The producer is described as Medici Ermete & Figli srl, a family owned company who bottle approx. 8.5 million bottles pa.
  - [www.sainsburys.co.uk](http://www.sainsburys.co.uk) - for Lambrusco dell'Emilia Rosato.
  - [www.tesco.com](http://www.tesco.com) – for Lambrusco rosso dell'Emilia from Emilia Romagna region. The producer is named as Fratelli Martini Secondo Luigi SPA.
- Copies of press articles commenting on the popularity of Lambrusco wines in the UK taken from:<sup>16</sup>
  - “[www.standard.co.uk/news](http://www.standard.co.uk/news)” dated 17 November 2016 headed “Lambrusco is back”.
  - “[www.theguardian.com](http://www.theguardian.com)” dated 5 April 2014 headed “Give Lambrusco a chance great glories of Emilia Romagna.”
  - “[www.independent.co.uk](http://www.independent.co.uk)” dated 28 July 2014 headed “Lambrusco is back on the menu”.

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<sup>14</sup> MC3

<sup>15</sup> MC4

<sup>16</sup> MC7

**Second witness statement of Michael Conway dated 2 January 2020.**

17. The main purpose of Mr Conway's' second statement is to exhibit materials obtained through his own internet research or supplied by the joint Opponents.

18. Mr Conway produces extracts taken from Wikipedia and Wikisource websites setting out information about the Emilia region of Italy. The print outs are undated save for a print date of 2 January 2020.<sup>17</sup>

19. At Exhibit MC9 Mr Conway produces a print out of an article dated 22 July 2016 taken from the website www.greatitalianchefs.com said to be a guide to the wines of the Emilia Romagna region. Reference is made to the Emilia Romagna region producing a number of DOC/DOCG wines but only two references are made to "Emilia"; the first "Emilia a DOCG formed in 1997 to enhance the Pignoletto an ancient variety" and the second "Lambrusco DOC a province of Modena, Reggio Emilia..."

**Applicant's Evidence**

**Witness statement Alejandro Mitarakis Guilisasti dated 4 June 2018**

20. Mr Guilisasti is the marketing manager of the Applicant Viñedos Emiliana SA, a position he has held since 2011.

21. Background information regarding the name of the vineyard is produced outlining the change of name from Bodegas y Viñedos Santa Emiliana SA to Viñedos Emiliana SA agreed at an Extraordinary Meeting of the General Board of Shareholders on 3 May 2004.<sup>18</sup>

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<sup>17</sup> Exh MC18

<sup>18</sup> Exh 01

22. Mr Guilisasti states that the mark EMILIANA was first used in connection with wines produced by Bodegas y Viñedos Santa Emiliana SA in 1986. Emiliana's main activities are the processing and marketing of export wines from both owned and leased vineyards. In the late 1990's the company started converting the winery into the production of organic wine. In 2016 Emiliana invested a 33% stake in a bottling plant under the name Wine Packaging and Logistic SA to serve both EMILIANA and the industry in general.

23. Mr Guilisasti states that Emiliana has acquired a consolidated portfolio of wines known for its quality and environmentally friendly products which have been endorsed by major national and international awards. EMILIANA's range of wines consists of six lines namely "Ge, Coyam, Signos De Origen, Organic Sparkling Wine, Novas, Natura, Adobe and late Harvest." Specifications for each are produced including the current bottle labels which have remained essentially the same since 2015 (apart from the year of vintage).<sup>19</sup> Sample labels used before 2015 displaying the mark Emiliana are produced.<sup>20</sup>

24. Mr Guilisasti contends that Emiliana is a global organic vineyard leader and as a result of its agriculture production has the capacity to produce 24 million litres from its own cellars.<sup>21</sup>

25. The following table is produced displaying the global turnover figures for the sale and export of wines bearing the EMILIANA mark.<sup>22</sup>

<b>Year</b>	<b>Global turnover in USD</b>
2007	24.521.413,58
2008	22.163.237,11
2009	24.992879,55

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<sup>19</sup> Exh 02

<sup>20</sup> Exh 03

<sup>21</sup> Para 14 and 16

<sup>22</sup> Para 17

2010	30.678.487,06
2011	30.268.162,11
2012	29.506.586,91
2013	29.962.934,35
2014	33.475.094,87
2015	29.057.020,97
2016	32.547.827,29
2017	35.722.889,89

26. The approximate volume of sales of bottles of wines bearing the EMILIANA mark exported to the UK are produced as follows:

<b>Year</b>	<b>Number of boxes (12 bottles per box) exported to the UK</b>
2007	124.670
2008	177.665
2009	155.461
2010	201.722
2011	171.409
2012	131.266
2013	77.958
2014	66.637
2015	66.220
2016	53.423
2017	48.075

27. Wines bearing the mark EMILIANA have been available to the UK public through the following retailers (both physically in store and online): <sup>23</sup>

The Wine Society; M&S supermarkets, Booths Virgin Wines, ND John Independents, Stone, Vine and Sons Independents, Whole Foods UK, Boutinot, Vintage Roots and Tivoli Wines.

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<sup>23</sup> Para 19

28. Printouts from My M&S; [www.tivoliwines.co.uk](http://www.tivoliwines.co.uk); <https://bountinot.com> and Rannoch Scott wines are produced (all undated save for the latter dated April 2014) said to be examples of Emiliana wines being offered for sale by UK retailers. <sup>24</sup>

29. Undated and unspecified photographs of Emiliana wines on shelves, being offered for sale in Booths, D Byrne and Co and Keelham Farm Shop are produced said to be taken from 2011 until 2018.<sup>25</sup>

30. Sample invoices between 2005 and 2017 are produced to demonstrate the export of Emiliana wines to the UK for retail. The majority of the invoices are addressed to Boutinot and whilst invoices from various dates are produced the earliest is from December 2006 and are predominantly for the years 2006, 2007, 2015, 2016 and 2017.<sup>26</sup>

31. Emiliana wines have received a number of awards and certifications (a selection of which are produced) to include;<sup>27</sup>

- 2001 - the first winery in Chile to receive the environmental management certification "ISO 14001"
- 2001 - the organic certification of the company IMO (Switzerland) one of the most prestigious agencies in the world for the inspection, certification and quality assurance of organic products
- 2006 - Ge 2003 vintage was certified by Demeter (Germany) as the first biodynamic wine from Chile and Latin America to enter the market.
- 2007 (renewed annually) - certification of Social Responsibility by IMO for Life (Switzerland)
- 2009 – carbon neutral certification
- 2010 - FLOCERT - Fairtrade producer certification

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<sup>24</sup> Exh 04

<sup>25</sup> Exh 05

<sup>26</sup> Exh 06

<sup>27</sup> Exh 07

- 2012 - Green Winery of the Year award by British magazine The Drinks Business.
- 2012 - the Chilean Ministry of the Environment appointed the then General Manager as an environmental leader
- 2015 – launch of first certified organic sparkling wine of Chile “Emiliana Organic Sparkling wine”.
- November 2015 – “Mejor Vina del Ano” (Best Winery of the Year) award granted by Vinos de Chile (an association of 90 vineyards within the trade).

32. Sample reviews and articles taken from various sources are included for example:

- [www.independent.co.uk](http://www.independent.co.uk) - 20 April 2014 – Headed “10 best organic wines” – Emiliana Organico is listed at number 7.
- [www.telegraph.co.uk](http://www.telegraph.co.uk) - Illegible date – Headed “3 of the best Viognier wines” – and includes 2014 Emiliana Organic Viognier Casablanca Valley Chile £10, M&S
- [www.thewinesociety.com](http://www.thewinesociety.com) - Undated — grower profile - Emiliana
- [www.johnhwines.co.uk](http://www.johnhwines.co.uk) - Undated — blog post headed “Emiliana Winery of the Year 2015!”
- [www.thedrinksbusiness.com](http://www.thedrinksbusiness.com) - 1 December 2015 – Emiliana named winery of the year by Wines of Chile Awards; 23 July 2012 – Emiliana embraces concrete eggs. “Although Signos de Origen already has a small presence in the UK , Emiliana a Concho y Toro subsidiary plans to launch the range officially in the UK next March”; 11 January 2017 Q&A article with Sebastian Tramon Emiliana’s sustainability manager; 19 March 2012 – Shortlist and Winner - Green Company of the year 2012

33. In conclusion Mr Guilisasti states that “as a result of the longstanding and intensive sales of bottled wines bearing the mark Emiliana in the UK, as well as the numerous awards and prizes won, Emiliana has enjoyed independent recognition in the UK and

the public associates Emiliana solely with Vinedos Emiliana SA. It has built up an independent goodwill and reputation as expressed by the mark EMILIANA in the UK... I am not aware of any instances of confusion between the mark EMILIANA and the PGI EMILIA and DELL' EMILIA...there is no risk to the public believing that the EMILIANA wines originate from or are associated in any way with the wines produced in the Emilia region of Italy.”<sup>28</sup>

### **Witness statement of Ms Grazyna Poplawska dated 4 June 2018**

34. Ms Poplawska is trade mark attorney at Burges Salmon LLP. Ms Poplawska produces a print out dated May 2018 (after the relevant date) taken from [www.markets.ft.com](http://www.markets.ft.com) (Financial Times) showing the profile of Viñedos Emiliana SA as a “Chile based company...primarily engaged in the production, ageing, distribution and selling of wines”<sup>29</sup> In addition Ms Poplawska produces a copy of the Applicant’s Articles of Association in Spanish (with translation) taken from [www.emiliana.cl](http://www.emiliana.cl).<sup>30</sup>

35. This concludes the summary of the evidence.

### **Preliminary issues**

36. At the hearing, as a preliminary issue, the Opponents made an application to amend their pleadings specifically identifying the second and third Opponents as per the wording as set out in paragraph 3 above. Following submissions from both parties, the application was granted on the basis that the proposed amendment brought the pleadings in line with the case advanced in the Opponents’ evidence and did not materially affect the way in which the Applicant would have defended the matter. No prejudice to the Applicant was demonstrated as it was already aware of the Opponents’ case and had been put on notice of the proposed amendment prior to the hearing. Consequently, the pleadings were amended.

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<sup>28</sup> Para 37

<sup>29</sup> GKP01

<sup>30</sup> GKP02

37. A request was made by the Opponents under cover letter dated 30 January 2018 for exhibits GM3 and GM5 of Mr Medici's witness statement and exhibit AC5 of Mr Chiarli's second statement to remain confidential from the public. No objection having been raised by the Applicant the orders were granted on the 19 March 2018 and 5 May 2020 respectively. Following an administration error, the order dated 19 March 2018 inadvertently attached confidentiality to exhibit GM4, no request having been made for this exhibit. Following clarification at the hearing all parties agreed that it did not need to remain confidential. At the hearing a further query was made regarding exhibit AC5 contained within Mr Chiarli's second statement. It was unclear at the hearing whether a request had been made and an order granted. I confirmed at the hearing that if an order was granted then it shall remain confidential from the public however if no such order was made then it would not be so covered. I note having re-examined the records that a request for confidentiality regarding this exhibit was made and granted on 5 May 2020 again no objection having been raised at the time by the Applicant. On this basis exhibits GM3, GM5 and AC5 will not be disclosed to the public.

38. Ms Clark indicated at the hearing and within her skeleton argument that should any part of the present opposition be determined against the Applicant on the basis of the specification of goods as it presently stood, then it would be prepared to limit the goods for which registration was sought to "wines produced in Chile". The wording was not acceptable to the Opponents. The Opponents say that the limitation is not sufficient to overcome the grounds of opposition following the wording of the Article 103(2)(b) of the regulation which provides protection "...*even if the true origin of the product or service is indicated.*" Therefore, even if it was clear that the goods were labelled as produced in Chile this would make little difference to the scope of the PGI.

39. At the hearing Ms Clark raised issues as to the alleged similarities between Mr Chiarli and Mr Medici's statements and the relative weight I should attach to each on the basis that the similarities appeared to indicate that the statements for each was a pre-prepared document. In this regard, I note that it is customary for witness statements to be completed by legal representatives usually prepared from

instructions and information provided by their clients and this is normal practice. The statements are not identical, the preambles to both include fairly standard wording and both are in an acceptable format addressing the same grounds of opposition and covering the same or similar information. I take note that they are accompanied by a statement of truth, signed and dated by the author. In this regard therefore I take no issue with the way in which they have been drafted and take no adverse inference from any similarities that may exist between them. The veracity of the contents of the statements and whether they support the grounds of opposition are matters for me to assess in my decision.

40. In their skeleton arguments and at the hearing, the parties brought to my attention the amendments to section 3, which came into force on 14 January 2019 by virtue of The Trade Marks Regulations 2018 (SI 2018/825). The effect of these amendments was to introduce a new section 3(4A) and to amend the wording of section 3(4). Both accepted that these changes did not materially affect the proceedings. Since these proceedings commenced on 19 May 2017 (prior to the SI coming into force) I do not consider that the amended wording introduced to section 3(4) and section 3(4A) apply and the decision will proceed based on the law as it stood as at the commencement of proceedings.

## **Decision**

41. I shall deal with the grounds of opposition and follow the order in which Mr Conway addressed me at the hearing. At the hearing Mr Conway accepted that the opposition under s.3(3)(b) followed his s.3(4) arguments and therefore these two grounds fell or succeeded together accepting that if the application does not offend section 3(4) then no deception is likely to follow and vice versa. I shall therefore deal with section 3(4) first.

### **Section 3(4)**

42. For the purposes of this opposition section 3(4), as it stood before the amendments, reads as follows:

“a trade mark shall not be registered if or to the extent that its use is prohibited in the UK by any enactment or rule of law or by any provision of EU law.”

43. Section 3(4) covers any breaches to Articles 102 and 103(2) of the Regulation being the appropriate EU law relating to trade marks.

44. Article 102 reads as follows:

“1. The registration of a trade mark that contains or consists of a protected designation of origin or a geographical indication which does not comply with the product specification concerned or the use of which falls under Article 103(2), and that relates to a product falling under one of the categories listed in Part II of Annex VII shall be:

(a) refused if the application for registration of the trade mark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected; or

(b) invalidated.

2. Without prejudice to Article 101(2), a trade mark referred to in paragraph 1 of this Article which has been applied for, registered or established by use in good faith, if that possibility is provided for by the law concerned, in the territory of the Union either before the date of protection of the designation of origin or geographical indication in the country of origin, or before 1 January 1996, may continue to be used and renewed notwithstanding the protection of a designation of origin or geographical indication, provided that no grounds for the trade mark's invalidity or revocation exist under Directive 2008/95/EC of the

European Parliament and of the Council or under Council Regulation (EC) No 207/2009.

In such cases, the use of the designation of origin or geographical indication shall be permitted alongside the relevant trade marks.”

45. Article 103(2) reads:

“2. A protected designation of origin and a protected geographical indication, as well as the wine using that protected name in conformity with the product specifications, shall be protected against:

(a) any direct or indirect commercial use of that protected name:

(i) by comparable products not complying with the product specification of the protected name; or

(ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;

(b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated, transcribed or transliterated or accompanied by an expression such as "style", "type", "method", "as produced in", "imitation", "flavour", "like" or similar;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, as well as the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the consumer as to the true origin of the product.

46. Paragraph 97 of the recital to the Regulation states:

“97. Registered designations of origin and geographical indications should be protected against uses which take advantage of the reputation enjoyed by complying products. So as to promote fair competition and not to mislead consumers, that protection should also extend to products and services not covered by this Regulation, including those not found in Annex I to the Treaties.”

47. The relevant date is the filing date of the contested mark namely 10 March 2017.

48. The Opponents have filed evidence which demonstrates that the first Opponent is the legal entity in charge of the promotion, enhancement and protection of wines entitled to use the PGI EMILIA/ DELL'EMILIA and is therefore the consortium authorised and recognised under EU law to regulate the PGI EMILIA of which the second and third Opponents are members.<sup>31</sup> The date of registration of the Emilia PGI is 19 February 1999 and it protects wines, including the grape variety, produced in accordance with certain specifications originating from the Emilia Romagna region of Italy. Whilst the Applicant puts the Opponents to proof regarding the existence of the PGI I am unclear whether the Applicant is formally disputing the PGI itself. At the hearing and in her skeleton arguments Ms Clark focused on the Opponents not identifying any breaches of Articles 102 and 103 rather than the existence of the PGI per se.

49. Although Mr Guilisasti stated in his evidence that the mark in the form Santa Emiliana had been used since 1986 there is no evidence that that use was within the UK or for that matter the Union. In fact, Ms Clark conceded that whilst the Applicant had been marketing and selling “its wines in the UK since at least 2005” no evidence was put before me of use of the mark (as applied for) before 1 January 1996 (when the application for the PGI was sent to the Commission) or 1999 (when the PGI was registered), namely before the existence of the PGI. I shall return to the latter date later in my decision in so far as it relates to the Opponents' claim under section 5(4)(a).

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<sup>31</sup> Exh MC1, MC2 and MC3

There is no suggestion therefore nor was one advanced at the hearing by Ms Clark that the Applicant had an earlier right established by use in good faith in the territory of the Union at the date of the PGI which would give rise to a defence under Article 102(2). I am satisfied from the evidence produced that the PGI has existed since 19 February 1999 and that the Opponents are entitled to rely on it and enforce its conditions.

50. In his submissions Mr Conway appeared to deal with both Article 102 and 103 collectively arguing that “EMILIANA self-evidently contains, imitates and is evocative of the PGI.” At the hearing he submitted that “the application relates to wine which is a product falling under one of the categories listed in PART II of Annex VII. The application is not limited to wines that comply with the product specification required under the PGI. Therefore, notional and fair use of the application would contravene the provisions of Article 102(1).” Ms Clark argues that “the name EMILIANA is not a name which consists of the PGI EMILIA nor does it contain EMILIA either.. the fact that you have to extract it for the middle of a different word means it is clearly not covered. It is a different word and it is quite distinctive” therefore, it is not in breach of Article 102.

51. Article 102(1) prohibits registration of a trade mark which “contains or consists of a protected ....geographical indication.” Whether there is a breach of Article 102(1) firstly depends on the interpretation of the words “contains and consists”. The first six letters of the application are identical to the PGI and the whole of the PGI is subsumed in the application albeit to form another word. Therefore, if I were to interpret the words “contains and consists” in the strictest sense taking their ordinary meaning to be “*to be made up of; comprise of or including*” the application appears to contain the PGI; the only difference being in the addition of two letters “NA”. However, I must consider Article 102(1) in the spirit in which it was intended namely as consisting of the PGI standing alone without modification. On this basis I do not find that the contested mark contains or consists the PGI as it is subsumed within it in such a way that consumers would not perceive EMILIA as an independent element within EMILIANA. The application therefore does not offend Article 102(1).

52. Moving to Article 103(2) I shall consider Article 103(2)(b) first as Mr Conway's submissions were predominantly directed towards this section. Article 103(2)(b) affords protection to the PGI from any "misuse, imitation or evocation" even if the true origin of the product is indicated.

53. The Court of Justice of the European Union ("CJEU") in *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister & Eduard Bracharz GmbH*, case C-87/97, EU:C:1999:115 defined the concept of evocation as:

"25 'Evocation', as referred to in Article 13(1)(b) of Regulation No 2081/92. Covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected.

26.....it is possible, contrary to the view taken by the defendants, for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue.

27. Since the product at issue is a soft blue cheese which is not dissimilar in appearance to 'Gorgonzola', it would seem reasonable to conclude that protected name is indeed evoked where the term used to designate that product ends in the same two syllables and contains the same number of syllables with the result that the phonetic and visual similarity between the two terms is obvious."

54. Mr Conway submitted that since the first six letters of the application were identical to the PGI only differing in the last two letters and taking the general principle that the beginnings of marks have greater aural and visual impact than they do their ends, and also that the first three syllables are identical; the image triggered in the mind of the consumer when confronted with the name EMILIANA would be the product whose geographical indication is protected. He argued that "Emiliana will be seen as simply an adjectival form of Emilia, perhaps in a foreign language, perhaps Italian."

Furthermore, it was submitted that it is not necessary for there to be confusion between the marks for the designation to be evoked. Mr Conway referred me to several EUIPO Cancellation Division decisions where the word EMILIANA had been found to be evocative of the PGI EMILIA/ dell' EMILIA. In particular my attention was drawn to an extract from the decision in invalidity proceedings number 0000121077 C reproduced below:

## EMILIANA

*In particular, the sign in question, , contains the word 'Emiliana', meaning 'from Emilia' in Italian, which is evocative of the PGI 'DELL'EMILIA', as 'Emiliana' and 'DELL' EMILIA' are synonymous (both meaning 'from Emilia'). In addition, the word 'Emiliana' fully incorporates the PGI for wines 'EMILIA' and also refers semantically to that territory. 'Emiliana' is the feminine-gender adjective used to refer to people or products from the Italian historical region of Emilia, and is understood by both the Italian and the Spanish public. The word 'Emiliana', as well as incorporating the PGI 'EMILIA', also refers to the geographical location in question. When the public sees a trade mark contains nouns or their corresponding adjectives relating to a given territory, it will believe that mark is providing information on the geographical location where the goods are produced or processed. The inclusion of a figurative element in the sign does not prevent the incorporation and evocation of the geographical indication 'EMILIA'.*

55. Ms Clark argued that there cannot be any real basis that there is any “triggering” in the present case, submitting that “The word EMILIANA is quite obviously different, especially since EMILIA will readily be recognised as a girls first name and there is nothing in EMILIANA which would even give rise to the immediate impression that it is a place name.” Whilst accepting and conceding that the application “may be alleged to show some visual similarity to EMILIA, aurally it is quite different in that the stress will be placed on the last two vowels. The differences in the marks make them readily distinguishable”. Furthermore, “no association of ideas regarding the origin of the products can be created in the minds of the public and even if it were the Applicant cannot be said to take advantage of the reputation of the PGI.” When consumers are confronted with the mark applied for, Ms Clark argued that there is no reason to suppose that the image triggered directly in the mind will be that of any product of the Opponents or any of them.

56. Both marks are for the specification wines. Ms Clark argues that the Opponents' registered specification for EMILIA includes a minimum alcohol content and the Lambrusco wines shown in the evidence do not appear to meet that requirement or are even wines, being "fermented grape must". These arguments as advanced by Ms Clark make little difference to the section 3(4) ground because the enforcement of the PGI does not depend on qualifying use of the PGI in the UK. The PGI can be enforced even if no qualifying wines had been sold under it.

57. Evocation must be judged from the perspective of the UK consumer who is reasonably observant and circumspect. The consumer of the contested goods is a member of the general public having attained 18 years of age or those in the trade such as wine merchants or bar/restaurant owners. The purchasing process will be via self-selection from display shelves of retail outlets such as supermarkets or their online equivalents where visual considerations would dominate. The goods may also be consumed in public houses, bars and restaurants where aural considerations would play a part following a request made to serving staff. Even in bars and restaurants, however, visual considerations will still dominate since the goods are likely to be requested following a perusal of a menu or from a display cabinet behind the counter.<sup>32</sup> Notwithstanding that some wines are expensive and bought by specialist collectors on the whole they are reasonably priced at the lower end of the scale and consumed fairly frequently. For the wine buying consumer whether an ordinary member of the public or from the trade, considerations such as personal taste, grape variety and country of origin as well as price may play a part in the purchasing process which in my view would be average, no higher or lower than the norm for such goods.

58. The EUIPO cancellation division decisions referred to by Mr Conway are not binding on me. I note particularly that the question of evocation within these decisions was taken from the viewpoint of the Spanish and Italian public where the addition of the letters/word NA and DELL means "from" in Italian which it was contended

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<sup>32</sup> *Simonds Farson Cisk Plc v OHIM* T-3/04

supported the argument put forward at the EUIPO that Emiliana was “the feminine gender adjective used to refer to people or products from the historical Italian region of Emilia.” This is not the case before me. I must consider matters from the viewpoint of the UK consumer. There is no equivalent grammatical rule in the English language for the addition of the letter NA to a word/name to mean ‘from’ and I do not consider that the average UK consumer will understand the word ‘Dell’ to mean ‘from’ either. I do not agree that the average UK consumer will regard the word Emiliana as the adjectival form of Emilia or see it as meaning “from Emilia” in the same way as the Italian or Spanish public would.

59. The visual considerations mean that there is a medium degree of similarity between the PGI and the mark as a result the whole of the PGI being identical with the first six letters of the application differing only in the additional letters NA at the end. Both end with the same vowel A. I do, however, agree with Ms Clark (even accounting for different pronunciations) that the pronouncement of the respective words will differ as a result of the emphasis being placed on different syllables. I consider EMILIA will be pronounced as EM-EEL-EE-IA whereas the application will be pronounced as EM-IL-IAH-NA. The verbal emphasis will therefore be on the second and third vowel sounds in the PGI and the third and fourth syllables in the application. The aural similarity is therefore low.

60. Conceptually the Opponents’ case is that the average consumer will only perceive the name Emilia in the way in which it has been used, namely as a PGI. Mr Conway submitted that I should be cautious against taking judicial notice that Emilia is a girl’s name in absence of evidence, arguing that it was not a notoriously known fact to the average wine consumer in the UK which would enable me to do so. Mr Conway referred me to Ms Anna Carboni’s decision (on appeal)<sup>33</sup> in relation to the conceptual meaning of Cherokee. Ms Carboni found that it was not correct for the hearing officer to take judicial notice of the meaning of the word Cherokee (being understood to mean a native American tribe) without evidence; she considered that it was not sufficiently a

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<sup>33</sup> BL/O/048/08

known fact to the average consumer of casual clothing. Ms Carboni however, did state that “judicial notice may be taken of facts that are too notorious to be the subject of serious dispute”. In this regard I consider that in the UK a sufficient proportion of the UK public will perceive Emilia as a girl’s forename that it cannot be the subject of serious dispute. The actress Emilia Clarke, for example, is known to millions as the female lead in the Game of Thrones blockbuster series. I do not consider therefore, that evidence was necessary for me also to come to this conclusion.

61. The Applicant has given no indication as to the origin of the name EMILIANA. However, I note that previously it was used in the form SANTA EMILIANA which implies it has at one time been associated with a saint’s name. I consider that the meaning of Emiliana would be unclear to UK consumers. Consumers may perceive it as a personal name, a place or purely as a made up name. Even if it is perceived as a personal foreign name, I do to consider that it is likely to be perceived as a common name in the UK, unlike Emilia. Conceptually therefore, the PGI is to a great proportion of the average UK consumer composed of a girl’s name, whereas the mark covered by the application has no clear meaning and could either be a place or, at most, a name with a foreign origin. Notwithstanding that some UK consumers may be aware of the use/meaning of the name Emilia as a PGI, I consider that even amongst this group most will also recognise it as a common girl’s name and which to them will help to distinguish it from Emiliana.

62. Ms Clark argued that when comparing the PGI and the mark, I must also have regard to the preamble in recital 97 of the Regulation when assessing whether Emiliana breaches Articles 102 or 103 submitting that these provisions must be read with the purpose behind them in mind. Ms Clark submits that recital 97 to the Regulation shows that the provisions are intended to protect against unfair competition based upon the exploitation of the reputation of the PGI or PDO.

63. Mr Conway argued that reputation within recital 97:

“pertains to the reputation of PGIs in a relatively general and relatively loose sense, and in no way imposes a requirement for a reputation to be established within the same meaning attributed to that word under, for example, section 5(3) of the Trade Marks Act. The word "reputation" does appear in the preamble to the regulation, but the operative provisions of the regulation place no requirement for a PGI to have a reputation in a section 5(3) sense in order to be protected. Our submission is that a PGI is protected against the forms of harm stipulated in, particularly, Articles 102 and 103 of the regulation, effectively, irrespective of its use or reputation in a particular territory.”

64. Whilst accepting that reputation is not a stipulated requirement of Article 103(2)(b) it is still a matter to be taken into account in my assessment, given that, in my view, there is a direct correlation between how well known the PGI is to the UK consumer and whether it will be evoked or not. If the PGI has a high reputation in the UK then this increases the likelihood of a similar sign evoking the PGI. Otherwise its degree of protection must be determined on a notional assessment of the likelihood of evocation etc. based on the degree of similarity between the PGI and the mark and the identity/similarity of the goods.

65. Therefore, in order to consider whether the PGI would be evoked I must go on to consider the reputation of the PGI with the UK consumer as at the relevant date. The evidence of Mr Chiarli and Mr Medici provide me with the clearest indication as to how widespread and how well known the PGI was to UK consumers at that time. I place the greatest evidential weight on the export figures produced by Mr Chiarli which show that only 15,000 bottles were exported to the UK in 2017. No export figures were produced by Mr Medici. No turnover figures, advertising costs or actual sales figures are produced by either Opponent. Notwithstanding that a number of the articles referred to in evidence are national publications, very few are dated in 2017 and little reference is made within the text to the PGI itself; the main focus being on Lambrusco. Of significance is the article published in the Guardian in 2014 which stated that Lambrusco wine was popular in the 70s and 80s but that the writer couldn't find a single supermarket that stocked a bottle. I note that the majority of the Opponents' evidence is in the form of invoices said to be to UK retailers. Even though they are

sample invoices very few are produced in 2017 and without corroborative evidence such as turnover figures they are of little evidential value when assessing the extent consumers would bring the PGI to mind when seeing the mark EMILIANA. I consider that the lack of cogent evidence is a clear indication that the PGI Emilia would not have been particularly well known to UK consumers as at 2017. Therefore, when coming across the mark Emiliana I do not consider that there is sufficient similarities between it and the PGI, for the reasons already outlined, for Emilia to be evoked or brought to mind at the date of the trade mark application.

66. I bear in mind that the test for evocation is different to likelihood of confusion.<sup>34</sup> Despite the identity with the goods, I consider that there are sufficient differences between the PGI and the mark for it not to be evoked especially in light of the evidence which has not demonstrated a strong reputation or familiarity amongst the UK public for wines bearing the Emilia PGI.

67. I am fortified in this finding by the fact that, the Applicant's evidence demonstrates that Emiliana has established its own identity as a trade mark and its own reputation for wines, especially for organic wines, in the UK, which has been attained completely independently of the Opponents and is, therefore, even less likely to evoke the PGI Emilia.

68. At the hearing brief submissions were made in relation to Article 103(2)(a). In order for this section to be contravened then it would be necessary for the offending use to be of "that protected name". I do not consider that Emiliana is "that protected name" Emilia or a translation or imitation of it. Therefore, there can be no contravention on the basis of misuse or imitation.

69. For these reasons the opposition under section 3(4) fails.

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<sup>34</sup> *Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister & Eduard Bracharz GmbH* as before

### **Section 3(3)(b)**

70. Section 3(3)(b) of the Act reads as follows:

“A trade mark shall not be registered if it is-

...

(b) of such a nature as to deceive the public (for instance as to the nature, quality or geographical origin of the goods or service).”

71. The section 3(3)(b) ground was briefly addressed in the Opponents original pleadings and in Mr Conway’s skeleton arguments thus:

“use of the mark in relation to wines other than wines entitled to use the PGI would be liable to deceive the public as to the nature quality and geographical origin of the goods and as such would offend section 3(3)(b) of the Act.”

“since the application is likely to be associated with the PGI EMILIA Dell’EMILIA in the minds of consumers ( who must rely on the imperfect recollection) if the mark were used in relation to wines other than wines entitled to use the indication it would be liable to deceive the public as to the geographical origin of the goods.”

72. At the hearing Mr Conway accepted that the opposition under s.3(3)(b) followed his s.3(4) arguments and therefore these two grounds fell or succeeded together in so far as “if the deception to consumers would not arise from the PGI being evoked or invoked by the Applicant’s mark under section 3(4) then its 3(3)(b) ground would not place it in any better position”. Mr Conway did not expand further or advance any additional submissions other than those as outlined above. Ms Clark submitted that the Opponent had not made clear precisely what the average consumer would be deceived about. Furthermore, she argued that the term Emilia had not become a term that through use indicates wines of any particular nature or quality. There was no evidence filed as to market penetration or that consumers when ordering Emilia wine were expecting wines of a particular quality, which, it was submitted, was in contrast

to the various Champagne and Prosecco cases. On this basis Ms Clark argued there could be no deception.

73. In *TWG Tea Company Pte Ltd v Mariage Frères SA*, BL O/358/17, Mr Phillip Johnson, sitting as the Appointed Person, conveniently summarised the case law as follows:

“(a) it is necessary to establish that the mark will create actual deceit or a sufficiently serious risk that the consumer will be deceived: C-87/97 *Consortio per la tutela del formaggio Gorgonzola*, ECLI:EU:C:1999:115, paragraph 41; C-259/04 *Emanuel*, ECLI:EU:C:2006:2015, paragraph 47; C-689/15 *W.F. Gözze Frottierweberei*, EU:C:2017:434, paragraph 54;

(b) the deception must arise from the use of the mark itself (i.e. the use per se will deceive the consumer): *Gorgonzola*, paragraph 43; *Emanuel*, paragraph 49; *Gözze Frottierweberei*, paragraph 55;

(c) the assessment of whether a mark is deceptive should be made at the date of filing or priority date and so cannot be remedied by subsequent corrective statements: *Axle Associates v Gloucestershire Old Spots Pig Breeder’s Club* [2010] ETMR 12, paragraph 25 and 26;

(d) the deception must have some material effect on consumer behaviour: *CFA Institute’s Application* [2007] ETMR, paragraph 40;

(e) where the use of a mark, in particular a collective mark, suggests certain quality requirements apply to goods sold under the mark, the failure to meet such requirements does not make use of the mark deceptive: *Gözze Frottierweberei*, paragraphs 57 and 58;

(f) only where the targeted consumer is made to believe that the goods and services possess certain characteristics which they do not in fact possess will the consumer be deceived by the trade mark: T-248/05, *HUP Usługi Polska v OHIM*, ECLI:EU:T:2008:396, paragraph 65;

(g) where a mark does not convey a sufficient specific and clear message concerning the protected goods and services or their characteristics but, at the

very most, hints at them, there can be no deception in relation to those goods and services: HUP, paragraph 67 and 68; T-327/16, Aldi v EUIPO ECLI:EU:T:2017:439, paragraph 51;

(h) once the existence of actual deceit, or a sufficiently serious risk that the consumer will be deceived, has been established, it becomes irrelevant that the mark applied for might also be perceived in a way that is not misleading: T-29/16 Caffè Nero Group v EUIPO, ECLI:EU:T:2016:635, paragraph 48;

(i) where a trade mark contains information which is likely to deceive the public it is unable to perform its function of indicating the origin of goods: T-41/05 SIMS – École de ski internationale v OHIM, EU:T:2991:200, paragraph 50; Caffè Nero, paragraph 47.”

74. No evidence was submitted of actual deceit. However, it is still incumbent on me to consider whether there would be a sufficiently serious risk of the consumer being deceived in the future as to the nature, quality or geographical origin of the goods.

75. The Opponents arguments appear to overlap with those submitted under 3(4) namely and in so far as Emiliana will evoke Emilia and deceive the public that they are wines originating from the Emilia Romagna region of Italy. No further evidence was submitted as to the public's view as to the quality of the wines in the minds of the average consumer. The articles in evidence do not assist as they are predominantly directed towards the term Lambrusco with only a small number of passing references to Emilia. No indication is given as to the number of consumers who viewed the various websites to give an indication as to how widespread the term Emilia was known to UK consumers. The invoices do not assist since they are historical and are not supported by recent sales or turnover figures. Clearly as at March 2017 only 15,000 bottles were exported to the UK by Chiarli 1860 which, in my view, is insufficient to demonstrate that the term Emilia alone would be widely perceived by consumers as an indication of geographical origin. There is no evidence to support the contention that consumers would know that Emilia wines come only from the Emilia Romagna region of Italy. A number of the articles make reference to Lambrusco and I consider

that this term would be familiar to the UK consumer, but I am not convinced that this extends to the name Emilia.

76. In any event if the PGI is not evoked when purchasing the Applicant's wine it follows that those consumers cannot be deceived as to their nature, quality or geographical origin. Consequently, I do not find that the applied trade mark would be of such a nature as to deceive the public. Taking account of Mr Conway's position that if the Opponents failed under section 3(4) then they were in no better position under 3(3)(b), the opposition under section 3(3)(b) also fails.

#### **Section 5(4)(a)**

77. Section 5(4)(a) of the Act states as follows:

“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, where the condition in subsection (4A) is met,

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.”

78. The second and third Opponents rely upon the law of passing off and in particular the extended form of passing off. In this regard they argue that “protection is given to a name or word which has come to mean a particular product rather than a product from a particular trader”. Mr Conway argued that the Opponents “represent a class of trader entitled to bring an action under the extended form off passing off since they are producers of wine entitled to use the EMILIA/DELL'EMILIA PGI who sell those products in the UK.”

79. The Opponents' case is that "the goods are clearly defined since the indication can only be used in respect of wines produced in the Emilia Romagna region of Italy in compliance with tightly controlled conditions governing such use as overseen by the First Opponent."

80. Ms Clark submitted that

"Extended passing off protects the goodwill in the accuracy and distinctive character of a term that describes a class of product. It is essential for this purpose (i) that the product must, by name, have acquired a distinctive reputation and therefore goodwill as a particular kind of wine or other form of alcoholic drink with recognisable characteristics distinguishing it from other products or it would not qualify for protection, and (ii) purchasers must be motivated to buy those products because of those characteristics and rely upon that name to identify products with those characteristics from those of other traders.

There is no evidence in the present case that customers seeing the word Emilia in use on or in relation to wine regard it as indicating that the wine in relation to which it is used as any particular characteristic, or even that it comes from any particular area. Moreover, there is no evidence that consumers act on or rely upon that word to ensure that the wine they purchase has any such characteristics or comes from any particular area.

No misrepresentation of any kind is made out either...the wines of the Applicant, second and third Opponents have been on sale now for many years without any evidence of any confusion and without either any damage or even any allegation of any damage having been sustained thus far."

81. Ordinarily goodwill arises out of trading activities, however, the courts have been prepared to recognise and prevent the use of names that are distinctive of a discernible class of products under the extended form of passing off. In such cases the extended form of passing off arises where, as a result of a quality or a characteristic of the goods,

they have acquired goodwill in the name itself rather than as a result of the brand name associated with the goods.

82. The case of *J Bollinger SA v Costa Brava Wine Co Ltd* [1960] Ch 262 first established and recognised the extended form of passing off in relation to Champagne. This decision has been reaffirmed in a number of subsequent cases.

83. In *Erven Warnink BV v J Townend & Sons (Hull) Ltd* [1979] A.C. 731 (*Advocaat* case) Lord Diplock identified the five characteristics that must be present in order for a claim under the extended form to succeed and furthermore in the same decision Lord Fraser of Tullybelton stated:

“[753] The novelty and importance of the decision [*in Bollinger*] lay in the nature of the misrepresentation against which the plaintiffs were held to be entitled to protection. The misrepresentation was not that the defendants' product was the product of the plaintiffs, or even that it came from France. The misrepresentation was that "Spanish champagne" was wine of the kind that enjoyed the reputation and goodwill which attached to genuine champagne, and in which the plaintiffs had a property right.

[...]

[755] It is essential for the plaintiff in a passing-off action to show at least the following facts:

- (1) That his business consists of, or includes, selling in England a class of goods to which the particular trade name applies;
- (2) That the class of goods is clearly defined, and that in the minds of the public, or a section of the public, in England, the trade name distinguishes that class from other similar goods;
- (3) That because of the reputation of the goods, there is goodwill attached to the name;

(4) That he, the plaintiff, as a member of the class of those who sell the goods, is the owner of goodwill in England which is of substantial value;

(5) That he has suffered or is *really likely* to suffer, substantial damage to his property in the goodwill by reason of the defendants selling goods which are falsely described by the trade name to which the goodwill is attached.”

84. The protection provided under the law of passing off therefore extends to the name Emilia, only if the Opponents are able to identify Emilia wines as a distinct and recognisable product and that consumers select the products as a result of its defined characteristics. In *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1999] RPC 826 it was determined that not only do the goods have to be clearly defined but they also have to possess a reputation and goodwill such that the public are motivated to buy them, by virtue of the characteristics which define the class. Mr Justice Laddie stated in this regard:

The words "Swiss chocolate" are clearly descriptive. It is only if they are taken by a significant part of the public to be used in relation to and indicating a particular group of products having a discrete reputation as a group that a case of passing off can get off the ground. I have had to bear this in mind when assessing the evidence of what the words mean to members of the public. If they convey nothing more than their descriptive meaning, the action must fail. The point can be illustrated by an example. If a trader used the expression "French ball-bearings" or "Italian pencils" neither would convey to most members of the public anything other than that the ball-bearings and the pencils came from France and Italy respectively. There is, as far as I am aware, no public perception that ball-bearings from France or pencils from Italy form a discrete group of products having any particular reputation. These expressions would therefore be taken as indicating nothing about the goods in respect of which they are used save that they come from a particular geographical location.”

85. Subsequent cases endorsed the “principles” established in these cases but made it clear that any consideration was fact dependent. Whilst the historical nature of the cases appeared to suggest a requirement for the goods identified to have a particular cachet (these cases related to Champagne, Advocaat, Sherry and Scotch whisky), Lord Justice Patten rejected this argument in *Diageo North America Inc v Intercontinental Brands (ICB) Ltd C of A* [2010] EWCA Civ 920 (*Vodkat*) stating as follows:

“[51] there is no support in the authorities ....that in cases of extended passing off some cachet must be found in the sense of the product being a superior or luxury brand. Of course if, by a cachet, one means no more than distinctiveness then there is no difficulty. But I endorse the view of the judge that the argument that the product must be a premium or luxury one is in fact contrary to the principle which underlies all these cases. So-called premium brands are likely (perhaps more likely) in many cases to acquire the distinctiveness required. But goodwill may attach to a product simply because consumers come to like and value it for its inherent qualities rather than its status.”

[52] Whether or not any particular product had acquired the requisite public reputation was a question of fact for the trial judge. One of the dangers about highlighting the references in cases on champagne, sherry and advocaat to the product having superior or special qualities is that it risks elevating the facts of those cases into a principle.

[53] [Vodka's] qualities as a clear, tasteless, distilled, high strength spirit have given vodka a following which has created significant goodwill in the name..... That is sufficient in my view to entitle Diageo to protection for their product against VODKAT which, on the judge's findings, passes itself off as the same product. Mr Wyand's difficulty in formulating a precise definition of the level of distinctiveness necessary to create the cachet he contends for is because the concept of distinctiveness which is effective to produce the necessary goodwill provides a sufficient and comprehensive yardstick for deciding which products qualify for protection.”

86. It is clear therefore, that when considering the quality or characteristics of the goods there is no need to establish they are of a superior quality. It was happenchance that the reported cases in the last 30 years were in relation to goods of a certain type.<sup>35</sup>

87. In *Fage UK Ltd v Chobani Ltd* [2014] ETMR 26 CA the term Greek Yoghurt was shown on the evidence to denote a distinct class of product to a substantial proportion of the relevant public namely a thick and creamy yoghurt originating from Greece. The term Greek yoghurt was no longer a purely descriptive term to Greek yoghurt buyers but had come to denote a product of a particular kind.

88. For the Opponents to succeed it is necessary for them to establish that they are a group of traders who produce a product under a particular mark with a collective interest in protecting the goodwill associated with the product. I am satisfied that the second and third Opponents are members of a class of traders who are entitled to bring an action under an extended form of passing off as having a collective interest in the goods traded under the designation EMILIA.

89. It is also necessary for them, firstly, to establish that EMILIA has a qualifying reputation for wines which can be protected by an extended passing off claim. Secondly it is necessary for the Opponents to demonstrate that a misrepresentation would occur, namely that a significant number of the public would be, or would likely to be, confused or deceived by the Applicant's trade mark believing it to be an example of the goods distinguished by the Opponents' PGI for comparable goods, in this case wine. Thirdly, it is necessary for the Opponents to show that such a misrepresentation would cause real damage to the goodwill in which they have a share. Since goodwill is territorial it must be assessed from the viewpoint of the UK consumer.

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<sup>35</sup> *Vodkat*

90. Ordinarily the relevant date is the date of filing of the trade mark application. However, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TMO-212-06* Mr Allan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

91. For the purposes of my assessment the first relevant date at which goodwill must be established is the date the contested mark was applied for, namely 10 March 2017. However, if the essential ingredients of passing off are established as at that date, it is also necessary for me to consider what the position would have been at the start of the behaviour complained of. In this case it appears that this date will be from when the Applicant first began using the applied for mark in the UK.

92. Mr Guilisasti states that the Applicant has been marketing and selling its wine in the UK since at least 2005. Ms Clark argued at the hearing that this date was earlier given that the Applicant adopted its present name in May 2004. However, there is no evidence that the Applicant was using the mark in the UK prior to this date.

93. The earliest reference to sales within the UK bearing the EMILIANA mark is on labels of wines carrying the vintages in or after 2005. The first invoice relating to third

party stockists is December 2006. I note that Mr Guilisasti's evidence of the commencement date of use in relation to wine does not appear to have been challenged by the Opponents. From the evidence filed it appears that this earlier date is sometime in 2006. On this basis the first relevant date for consideration is December 2006.

94. I note that neither Mr Chiarli nor Mr Medici provide any advertising expenditure, turnover figures, market share or more importantly sales. The only evidence that I am clearly able to identify which comes close to demonstrating a market presence in the UK is in the form of the sample invoices and a handful of labels filed by both Mr Chiarli and Mr Medici. Mr Medici produces no evidence dating back before 2008. Mr Chiarli produces very little evidence in his first statement before 2013. The labels referred to by Mr Chiarli, said to demonstrate those typically displayed on bottles during 2009 and 2014 are no more than 5 in total and no date or year of vintage is displayed on the labels themselves. At best the only evidence of sales produced by Mr Chiarli relates to sample invoices to UK retailers between 2013 and 2015, but when read in conjunction with the table displaying the number of bottles exported to the UK, I note that these figures diminish considerably; from 1,000,000 bottles in 2013 to only 15,000 in 2017. The sample invoices produced in Mr Chiarli's second statement are dated between 1995 and 2005 but are of little evidential value without additional supporting evidence during this period. No export figures are provided by Mr Medici at all. Considering the goodwill as at March 2017, no invoices during 2017, or in the years preceding or proceeding the relevant date are produced by Mr Chiarli. Mr Medici produces seven sample invoices for 2017, but none make any reference to the sign Emilia in the description, describing the goods as Lambrusco. Whilst there is evidence produced of screenshots from UK retailers' websites offering the Opponents' wine for sale (Sainsbury's, Morrisons, Asda and Marks and Spencer), these are dated 30 January 2018 and are therefore of little evidential value. Even if I were to assume that these screenshots accurately reflected the position as at March 2017, I take note of the diminishing number of bottles exported to the UK in the table produced by Mr Chiarli as a true reflection of the position of sales leading to this date. The sample invoices do not demonstrate extensive volumes and by themselves do not provide me with a clear picture of actual sales. The articles in the national publications do not

assist either as they support the contention that Lambrusco was popular in the 70s and 80s but had not achieved that level of prominence since. If any goodwill is shown then it is only in the name LAMBRUSCO.

95. At the hearing, Mr Conway argued that the Opponents belong to a group of traders whose product have become so well known that it is distinctive and associated only to them. He argued that Emilia is not only recognisable as the type of wine itself but also as a name to denote the geographical origin of the wine namely that it originates from a particular region in Italy.

96. Ms Clark refutes this argument. She contends that it is highly unlikely that consumers would recognise “Emilia” as wines of a particular quality or characteristic. It is highly unlikely that anyone would order or ask for a “glass of Emilia” as they would with champagne or prosecco for example.

97. Even if the Opponents have sufficiently demonstrated that they trade in a class of wines which can be defined with reasonable precision, the name by which the products are known is, in my view, Lambrusco and not Emilia – this is how they are described on the invoices which make up a substantial part of the Opponents’ evidence. Even accepting that the labels display the PGI EMILIA/ Dell’ EMILIA sign, there is no indication that consumers would associate it with a particular characteristic of the wines beyond their geographical origin. Therefore, when taking the evidence as at March 2017, insufficient evidence has been produced to demonstrate that EMILIA was distinctive of a protectable goodwill. As the Opponents’ case depends on showing that they had an actionable case at both of the relevant dates, there is no need to further consider the position in 2006. The opposition under section 5(4) fails.

98. In the event that I am wrong in my primary finding above, I do not consider that a significant proportion of consumers would identify goods marketed under EMILIANA to denote goods from the Emilia Romagna region of Italy. Even though the contested

goods are within the same field of activity, I consider that consumers would not purchase the Applicant's goods in the mistaken belief that they are the goods of the Opponents. Therefore, I do not consider that there would be any misrepresentation or damage in any event.

## **Conclusion**

99. Based on my findings the opposition fails in its entirety on all three grounds. Subject to any appeal, the application may proceed to registration.

## **Costs**

100. As the Applicant has been successful it is entitled to a contribution towards its costs. Ms Clark made an application for costs on the standard basis according to the scale published in Tribunal Practice Notice 2/2016. Taking this into account and applying this guidance I award costs to the Applicant on the following basis:

Considering the notice of opposition and preparing a defence and counterstatement	£500
Preparing evidence and considering the Opponents evidence	£1000
Preparing for and attending a hearing	£1000
<b>Total</b>	<b>£2,500</b>

101. I order Consorzio Tutela Vini Emilia, Chiarli 1860 - Pr.I.V.I. Srl and Medici Ermete E Figli Srl, to pay Viñedos Emiliana S.A the sum of £2,500 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or

within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 1<sup>st</sup> day of June 2021

Leisa Davies

For the Registrar