O/0317/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003668612
IN THE NAME OF LINDSAY HOOPES
TO REGISTER THE FOLLOWING TRADE MARK:

NAPAÑAC

IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 428633
BY NAPA VALLEY VINTNERS

Preliminary remarks

1. This is the second decision related to an application to register the trade mark shown on the cover page of this decision ("the contested mark"). The application was the subject of two oppositions before this Tribunal. The first opposition culminated in the decision of 12 January 2024 ("my first decision") which was issued by myself under reference BL-O/0020/24. In that decision, I reached the conclusion that the opposition was successful based on grounds under Section 3(4A) of the Trade Marks Act 1994 ("the Act") and the contested mark should be refused registration.

2. Admittedly, as I will come to explain, there is some overlap between this case and the opposition I considered in my first decision in terms of the pleaded claims (as set out in statements of grounds) and the pleaded defences (as set out in the counterstatements). Further, the oppositions were heard on the same day, one following the other. However, the oppositions were brough by different and economically unconnected opponents who relied upon different trade mark rights and filed different evidence. That is a feature which lead to the cases not coming on together. To the extent that any matters (or evidence) concerning this opposition relates to matters (or evidence) which I have already recited in my first decision, this decision will reproduce *mutatis mutandis* some of the relevant paragraphs of the first decision. Having clarified the approach I am to adopt, I now turn to look at the second opposition.

Background and pleadings

3. On 14 July 2021, Lindsay Hoopes ("the applicant") applied to register the contested mark in the UK claiming a priority date of 29 January 2021 from the USA. The application was published for opposition purposes on 03 September 2021 and seeks registration for *Brandy; Fortified wines; Spirits* in class 33.

4. On 30 November 2021, the application was opposed by Napa Valley Vintners ("the opponent") and Bureau National Interprofessionnel du Cognac ("BNIC").

5. As I have said in my first decision, this case is unusual in that although the opponent and BNIC filed two separate oppositions against the contested mark, they are represented by the same legal team. It is also relevant that the two oppositions are practically identical in that they are primarily based on the claim that use of the contested mark NAPAÑAC amounted to an evocation of both the Protected Geographical Indication ("PGI") COGNAC and the Protected Designation of Origin ("PDO") NAPA VALLEY for all of the applied-for goods, and should be refused in relation to those goods.

6. It is important to stress at the outset that the opponent and BNIC lodged their notices of opposition individually and separately in their own names, relying on their trade mark rights as well as on the PGI and PDO designations mentioned above. Neither the opponent nor BNIC is a party to the proceedings launched by the other. They could not bring a joint opposition together and did not file a request to intervene in each other's opposition. Although they made a request for the proceedings to be consolidated and heard together, which was refused, they did so after the evidence rounds had been completed.

7. Nevertheless, as I have said in my first decision (and as I have anticipated above), the fact that the two oppositions are based primarily on the same argument that the contested mark NAPAÑAC evokes both the PDO NAPA VALLEY and the PGI COGNAC has resulted in a degree of overlap in the pleadings and submissions made in each case (and, to some extent, in the evidence filed).

8. In the present case, the opposition is primarily based on the PDO NAPA VALLEY. The opponent claims that registration of the contested mark is prohibited by reason of:

(i) **Regulation no. 1308/2013** of the European Parliament and of the Council of 17 December 2013 establishing a common organisation of the markets in agricultural products. This regulation is concerned with the protection of PDOs and PGIs for wines;

(ii) **Regulation no. 2019/787** of the European Parliament and of the Council of 17 April 2019 on the definition, description, presentation and labelling of spirit

drinks, the use of the names of spirit drinks in the presentation and labelling of other foodstuffs, the protection of geographical indications for spirit drinks, the use of ethyl alcohol and distillates of agricultural origin in alcoholic beverages and repealing Regulation (EC) No 110/2008. This regulation is concerned with the protection of PGIs for spirit drinks;

(iii) **Sections 3(4A), 5(4)(aa) and 3(3) of the Act.**

9. The grounds relied upon in support of the opposition also include **Sections 5(2)(b) and 5(3)** of the Act with the opponent relying on the earlier certification mark shown below ("the earlier mark"), designating goods in Class 33 and corresponding to the following description *"Wine*":

International registration no. WO0000001085952

NAPA VALLEY

International registration date: 05 July 2011
Designation date: 24 June 2016
Date of protection of the international registration in UK: 10 April 2018
Priority date: 10 January 2011
Priority country: United States of America
TM from which priority claimed: 85214493

10. The opponent submitted full and lengthy pleadings relying on the followings:

- The opponent is an association of producers of Napa Valley wines which is incorporated under the laws of the State of California, and whose functions include the legal defence of the appellation NAPA VALLEY, both in the USA and abroad. The opponent brings this opposition in its own name and as the representative of all the growers of grapes and producers of wine in the Napa Valley region of California;

- NAPA VALLEY is the name of a famous wine-producing district. It is a PDO protected by EU Regulations and is registered by the UK Department for the Environment, Food and Rural Affairs (DEFRA). Only wines produced in California in accordance with the product specification of the PDO NAPA VALLEY may be labelled with the designation NAPA VALLEY;

- The applicant is the owner or manager of a family business called “Hoopes Family Vineyard and Winery” which produces Napa Valley wines in the USA. An online article dated 4 October 2021 indicates that the applicant is already engaged in the production of brandy. Interviewed in September 2021, the applicant was quoted as indicating that she thought the product would be marketed at the end of 2021. The applicant has also indicated that she is open to using grapes produced by other producers and she intends to permit others to use the contested mark. Quoted in the interview from September 2021, the applicant said *"Cognac is brandy and brandy is made from wine and we had wine, so it was going to be some sort of brandy product"* thereby indicating the clear connection in the applicant's mind between her brandy product and Cognac. Interviewed on 22 January 2021, the applicant was described as reimagining wine into spirits, taking an innovative approach and teaming up with a distillery to distil "*wine into Napa's first "Cognac".* These public statements indicate that the contested mark is intended to be a combination of the words NAPA and COGNAC and that the applicant intends to use the mark for brandy produced from Napa Valley grapes or wines;

- The contested mark consists of the name NAPA with the addition of the suffix -ÑAC which is intended to be read and pronounced as the last part of the word COGNAC, i.e. -GNAC. If the applicant had intended the suffix to be pronounced like “nack” she would not have chosen the tilde symbol ~. The mark applied for consists of nothing more than these two distinctive and internationally known signs;

- The applicant’s mark was submitted after NAPA VALLEY was accorded protection as a PDO. The protection of wine PDOs under Articles 102 and 103 of Regulation 1308/2013 is applicable in this case and NAPA VALLEY wines

fall within Part II of Annex VII as wine under paragraph 5 thereof. Furthermore, Section 3(3) of the Act provides that a mark shall not be registered if it is of such a nature as to deceive the public as to the nature or geographical origin of the goods. The applicant's use of the contested mark constitutes 'direct or indirect commercial use' of the PDO NAPA VALLEY contrary to Article 103(1) of Regulation 1308/2013, since NAPA is identical to that indication and NAPAÑAC is phonetically, visually and conceptually similar to that indication. However, the applicant's *brandy, fortified wines and spirits* are not wines and cannot comply with the product specification of the PDO NAPA VALLEY. Furthermore, for that reason, such use exploits the reputation of the PDO as it trades on that name in relation to a product which is non-compliant;

- On 14 September 2021 the opponent's representatives made observations to the UKIPO. In its response dated 1 October 2021, the UKIPO rejected the objections and made various points including:

    a) that the mark NAPAÑAC is not formed solely of a registered PGO or PGI and consideration also should be given to whether the public may link both of these terms together and assume the goods are 'NAPA VALLEY COGNAC';

    b) Section 3(4) refers to marks which consist of a name of a registered PGO or PGI and no evidence has been provided to say that NAPAÑAC is entitled to such protection;

    c) A dictionary definition of NAPA refers to a type of leather or a vegetable in East Asia. According to an online dictionary, there are 201 words that also end in the letters NAC such as 'linac' or 'almanac'. The overall impression created by the combination of words is more than the sum of its parts in the context of the applied-for goods and the examiner did not believe that the public would understand them to mean that the goods are Cognac drinks from the Napa Valley.

The opponent contends that the line of argument advanced by the IPO conflicts with the decisions in *Gorgonzola,*[1] *Calvados,*[2] *Glen Buchenbach Whisky*[3] and *Konjakki*.[4] It points out that as it is made clear expressly by the EU courts in those cases, it is sufficient to establish evocation if the later name uses part of the earlier name. The decisions establish that Cambozola takes part of Gorgonzola; Verlados takes part of Calvados, Konjakki evokes Cognac; and even without specifically taking any part of the name Scotch, Glen Buchenbach evokes Scotch whisky because Glen evokes the idea of Scotch whisky in the mind of the consumer. In the same way, NAPAÑAC takes part of NAPA. It also takes the part of COGNAC by using the term ÑAC. To refer to other words ending in -NAC does not determine the point, because the applicant has deliberately chosen to apply for the mark using the tilde symbol ~ thereby emphasising that the applicant wants the mark to refer to -GNAC and hence COGNAC. NAPAÑAC evokes both NAPA and COGNAC;

- The applicant's use of the mark constitutes evocation or misuse contrary to Article 103(2) of Regulation 1308/2013 since when confronted with the name of the product, the image triggered in the consumer's mind is that of NAPA VALLEY, the product whose designation is protected;

- The combination of NAPA with any appellation from outside its designated area will be misleading because it is impossible for a wine or brandy to comply with the percentage origin requirements and production requirements attached to two different appellations. Consumers may infer that NAPA VALLEY grapes or wines were shipped to COGNAC to produce the applicant's brandy (or that COGNAC grapes were shipped to NAPA VALLEY), which of course would result in a product where neither NAPA nor COGNAC could be used, yet that is exactly what the contested mark intends to suggest;

[1] C-87 /97 *Consorzio per la Tutela del Formaggio Gorgonzola v (1) Kaserei Champignon Hofmeister & another [Cambozola]*
[2] C-75/15, *Viiniverla* [Verlados for a cider-based product]
[3] C-44/17, *The Scotch Whisky Association v Michael Klotz*
[4] C-4/10 and C-27/10 *Bureau national interprofessionnel du Cognac v Gust. Ranin Oy [Konjakki]*

- The producers of NAPA VALLEY wines have acquired an outstanding recognition and exceptional reputation, reflecting an image of excellence, reliability and quality. If the contested mark is registered, it would result in confusion and deception in the minds of the public to the detriment of such producers;

- The contested mark contains the name of a PDO and is applied for products which do not comply with the product specification concerned. Accordingly, registration and use of the contested mark would be prohibited by the EU Regulations and the mark must be refused registration under Sections 3(4), 5(4)(aa) and 3(3) of the Act;

- Further or in the alternative, the opponent is the registered owner of the certification mark NAPA VALLEY for *Wines* ("the earlier mark") and is also the party whose regulations determine what products may be so labelled. The opponent has undertaken significant marketing activity in the UK securing extensive publicity for Napa Valley wines in the press. The Napa Valley wines are well-known to UK consumers and have been sold, *inter alia,* by Majestic Wines, Tesco, Sainsbury's and Marks & Spencer, The Wine Society, Naked Wines, Laithwaites, Berry Bros & Rudd and Justerini & Brooks. The certification mark certifies wine which originates from the PDO of the Napa Valley, and which derives from grapes grown in the Napa Valley. The Product Specifications provide that goods may only be labelled with a viticultural area appellation if not less than 85% of the wine is derived from grapes grown within the boundaries of the viticultural area, and the wine has been fully finished within the State in which the labelled viticulture area is located. The applicant's product is not wine and is not therefore in accordance with the requirements of the certification mark;

- The opponent opposes the registration of the contested mark on the grounds that it is similar to the earlier mark, and is to be registered for goods that are similar to those for which the earlier trade mark is protected, and there exists a likelihood of confusion on the part of the public. Confronted with a mark

consisting of or referring to two different geographical indications, consumers would be confused or potentially confused as to the origin of the applicant's product and believe that the applicant's product is made with grapes or wines used to make COGNAC, or that the applicant's product is made or bottled in France, or that the product is made by producers of COGNAC. Accordingly, registration and use of the contested mark must be refused under Section 5(2)(b) of the Act;

- Further or in the alternative, the earlier mark has a reputation in the UK and the use of the contested mark is without due cause and would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. Accordingly, registration and use of the contested mark must be refused under Section 5(3) of the Act.

11. The applicant filed a counterstatement in which:

- She admits that COGNAC is a PGI pursuant to Article 37 of Regulation (EU) 2019/787 in conjunction with Annex Ill to Regulation (EC) No 110/2008;

- She admits that NAPA VALLEY is a PDO under the EU Commission's notice published in the Official Journal C106 on 10 May 2007;

- She denies that the application violates either the protection afforded to the PGI COGNAC under Articles 21 and 36 of Regulation (EU) 2019/787, or the protection afforded to the PDO NAPA VALLEY under Articles 102 and 103(2) of Regulation 1308/2013;

- She denies that the contested mark is of such nature as to deceive the public as to the nature or geographical origin of the goods pursuant to Section 3(3) of the Act. The applicant does not claim, either directly or indirectly, that the goods for which registration is sought, originate from NAPA VALLEY;

- She puts the opponent to strict proof of the alleged reputation of the term NAPA VALLEY;

- She denies that the contested mark would trigger the image of NAPA VALLEY or that there is use, misuse, imitation or evocation of the PDO;

- She agrees with the examiner's reasons set out in the letter of 1 October 2021;

- She requests that the opposition based on Sections 3(4A) and 5(4)(aa) of the Act in conjunction with Regulation (EU) 2019/787 and Regulation (EU) No 1308/2013 is rejected;

- She denies that the contested mark is visually, phonetically or conceptually similar to the earlier mark, that the competing goods are similar and that there is a likelihood of confusion and requests that the opposition based on Section 5(2) of the Act is rejected;

- She puts the opponent to proof of the alleged reputation of the earlier mark NAPA VALLEY in the UK and denies that the average consumer would make a link between the contested mark and the earlier mark;

- She denies that the contested mark would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark and requests that the opposition based on Section 5(3) of the Act is rejected;

- She denies that the applicant intends to cause confusion for consumers in the UK and states that the applicant strongly believes that such confusion would not exist due to the clear differences between the contested mark on one side, and the PGI, the PDO and the earlier mark on the other.

12. Unusually in this case, as part of its evidence, the opponent filed a copy of a response to a 'notice to admit facts' dated 26 May 2022 signed by Pinsent Masons

LLP on behalf of the applicant.[5] The document was served in response to a formal notice to admit certain facts – which was sent by the opponent to the applicant on 9 May 2022 - and contains the following admissions that are relevant to the present opposition:

- The applicant admits that NAPA VALLEY has a reputation with average consumers in the UK for wines originating from the Napa Valley in California. However, the applicant put the opponent to proof as to the nature and extent of that reputation and in particular whether it is averred that the reputation in NAPA VALLEY extends to products generally which are lawfully produced in Napa County and/or Napa City. The applicant avers that the said reputation is for the mark NAPA VALLEY as a whole and not parts thereof. The applicant denies that the average consumer will attribute high quality to all wines from the Napa Valley. It also argues that the opponent's claims are untenable because they would prevent use of the prefix NAPA by any party geographically located in Napa County and/or Napa City, and that third parties have successfully registered trade marks containing NAPA in the UK, for example Napanook (UK00003283259 and UK00901103274) NAPA VISTA (UK00001342322) and NAPA SMITH (UK00911264553). Accordingly, the applicant denies that the opponent has exclusive rights in the prefix NAPA;

- The applicant admits that COGNAC has a reputation in the UK with average consumers as a brandy from the Cognac region in Western France. However, the applicant puts the opponent to strict proof as to the nature and extent of that reputation given that the applicant avers that the said reputation is for the mark COGNAC as a whole and not parts thereof. The applicant denies that the average consumer will attribute quality to all brandies from the Cognac region in Western France. If and to the extent the opponent asserts reputation in, or confusion arising from the use of the suffix 'nac', the applicant avers that COGNAC is not the only brandy including the suffix 'nac'. For example, the average consumers in the UK will be familiar with 'Armagnac' which is a brandy produced in the Armagnac region in Gascony, Southwest France. There are

[5] Witness statement of Michael Christopher Anderson, MCA1 pp. 14-16

further distilled products from regions ending with the suffix ‘nac’, as Lourignac, Salignac, Sargargnac, Cariforngnaac, Louis D'Armagnac and Gavernac. Accordingly, it is denied that the opponent has exclusive rights in the suffix ‘nac’;

- The applicant admits that the applicant is the CEO of Hoopes Vineyard, the producer of Hoopes Napa Valley wines which are sold in the UK;

- The applicant admits that the applicant is engaged in the production of brandy 100% made from grapes grown in Napa Valley and that such grapes include grapes which may have been damaged or tainted by smoke;

- The applicant avers that using grapes which may have been damaged or tainted by smoke for the production of brandy is an innovative way of avoiding such grapes to go to waste. Wineries situated in the Napa Valley, California, are affected by wildfires. Where affected by fires, vines are incinerated, and remaining grapes are covered in soot. This fruit cannot be used for making wine, and hence using grapes which may have been damaged or tainted by smoke for the production of brandy offers an alternative that may help to ensure the financial stability of wineries in the Napa Valley region.

Representation and evidence

13. The applicant is represented by Pinsent Masons LLP and the opponent is represented by Lee Bolton Monier-Williams LLP. Both parties filed evidence-in-chief, with the opponent also filing evidence in reply.

14. The opponent initially filed five witness statements from the following:

- Linda Jane Reiff, the President and Chief Executive Officer of the opponent;
- James Clive Orrok Simpson, Master of Wine and Managing Director of Pol Roger Limited;

- James Rylett Hocking, the Founder and Managing Director of James Hocking Wine Limited;
- Elizabeth Pearce, Master of Wine and Buyer at Lay & Wheeler Limited;
- James Anthony Doidge, Master of Wine and Managing Director of The Wine Treasury Limited;
- Nicholas Room, a Director at RT Wince Solutions Ltd;
- Beth Novak Milliken, the President and Chief Executive Officer of Spottswoode Winer, Inc;
- David Raymond Duncan, the Chairman and Chief Executive Officer of Silver Oak Wine Cellar, LLC;
- Michael Christopher Anderson, a solicitor employed by the firm representing the opponent in these proceedings.

15. The applicant filed six witness statements from the following:

- Lindsay Hoopes, i.e. the applicant herself;
- James Bruton, the Chief Marketing Officer at DARCO Spirits;
- J. Smoke Wallin, the Managing Director and Partner at STS Capital Partners;
- Tim Gaiser, a member of the Court of Master Sommeliers, Americas;
- Désirée Vasantha Fields, the Legal Director at the firm representing the applicant in these proceedings;
- Florian Peter Traub, a partner at the firm representing the applicant in these proceedings.

16. In response to the applicant's evidence, the opponent filed five further witness statements from the following:

- Michael Christopher Anderson (second witness statement);
- Linda Jane Reiff (second witness statement);
- Michelle Novi, a Director, Industry Relations & Regulatory Affairs for the opponent;
- James Scott Gerien, a US IP attorney specialising in the wine and spirit sector;
- Rex Allen Stults, the Vice President of Industry Relations for the opponent.

17. I have read all the evidence in this case, and I will refer to it as and when necessary, in coming to my decision.

18. A hearing took place before me on 14 June 2023, by video conference. The applicant was represented by Florian Traub of Pinsent Masons LLP. The opponent was represented by Denise McFarland instructed Lee Bolton Monier-Williams LLP.

19. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

Sections 3(4A) and 5(4)(aa) of the Act read in conjunction with Regulation no.1308/2013 and Regulation no. 2019/787.

The legislative framework

20. Sections 3(4A) and 5(4)(aa) of the Act provide that marks will not be registered if their use is prohibited by any enactment or provision protecting PDOs and PGIs.

21. Section 3(4A) reads as follows:

> "3(4A) A trade mark is not to be registered if its registration is prohibited by or under—
>
> (a) any enactment or rule of law,
>
> (b) […]

(c) any international agreement to which the United Kingdom is a party, providing for the protection of designations of origin or geographical indications."

22. Section 5(4)(aa) reads as follows:

"5(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, where the condition in subsection (4A) is met, […]

(aa) by virtue of any enactment or rule of law, providing for protection of designations of origin or geographical indications, where the condition in subsection (4B) is met, or

(b) […]

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

(4A) […]

(4B) The condition mentioned in subsection 4(aa) is that—

(a) an application for a designation of origin or a geographical indication has been submitted prior to the date of application for registration of the trade mark or the date of the priority claimed for that application, and

(b) the designation of origin or (as the case may be) geographical indication is subsequently registered."

23. The relevant enactment or rule of law, providing for protection of designations of origin or geographical indications are Regulation 1308/2013 and Regulation no. 2019/787. However, as the contested mark is a post-Brexit trade mark application, I will refer to the amended versions of those regulations that have re-applied those regulations to the post-Brexit position.

Regulation no.1308/2013

24. The opponent relies on Article 103 of Regulation no.1308/2013 on PDOs and PGIs for wines which is as follows:

"**Article 103**
Protection

1. A protected designation of origin and a protected geographical indication may be used by any operator marketing a wine which has been produced in conformity with the corresponding product specification.

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, transcripted 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.

3. Protected designations of origin and protected geographical indications shall not become generic in the Great Britain within the meaning of Article 101(1)."

25. Article 102 of Regulation no.1308/2013 is also relevant. It reads:

"Article 102
Relationship with trade marks

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 Secretary of State 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 Great Britain 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 the Trade Marks Act 1994.

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

Regulation no. 2019/787

26. Although in this opposition the opponent focused primarily on Regulation no.1308/2013 for the obvious reason that that is the Regulation that governs the protection of wine PDOs (NAPA VALLEY being a wine PDO and the opponent being an association of producers of Napa Valley wines whose functions include the legal defence of the PDO NAPA VALLEY), the opponent's statement of grounds also contains a number of references to Regulation no. 2019/787,[6] which governs the protection of geographical spirit drink names (COGNAC being a PGI and a protected spirit drink name). In addition, the applicant's counterstatement also refers to the protection afforded to PGIs under Articles 21 and 36 of Regulation no. 2019/787, confirming the applicant's understanding of the opponent's case as being based on both Regulations. Leaving aside for a moment whether the opponent has actually pleaded reliance on Regulation no. 2019/787 (and whether it was entitled to do so), Articles 21 and 36 of that Regulation are as follows:

"Article 21

Protection of geographical indications

[6] See paragraph 4 which states: *"Article 103 (2) of Regulation 1308/2013 additionally protects against misuse of a PGI or PDQ (and Regulation 2019/787 similarly provides); and each regulation also protects against any direct or indirect commercial use"* and page 11 "*This is an exceptional case in that the use of the mark would be doubly unlawful under EU law, under Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 as regards the protection of wines; and Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 regarding the protection of spirits"*

1. Geographical indications protected under this Regulation may be used by any operator marketing a spirit drink produced in conformity with the corresponding product specification.

2. Geographical indications protected under this Regulation shall be protected against:

(a) any direct or indirect commercial use of a registered name in respect of products not covered by the registration where those products are comparable to the products registered under that name or where using the name exploits the reputation of the protected name, including where those products are used as an ingredient;

(b) any misuse, imitation or evocation, even if the true origin of the products or services is indicated or if the protected name is translated or accompanied by an expression such as ‘style’, ‘type’, ‘method’, ‘as produced in’, ‘imitation’, ‘flavour’, ‘like’ or similar, including when those products are used as an ingredient;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product in the description, presentation or labelling of the product liable to convey a false impression as to the origin of the product;

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

3. Geographical indications protected under this Regulation shall not become generic in Great Britain.

4.The protection referred to in paragraph 2 shall also apply with regard to goods entering Great Britain without being released for free circulation there”.

“Article 36

Relationship between trade marks and geographical indications

1. The registration of a trade mark the use of which corresponds or would correspond to one or more of the situations referred to in Article 21(2) shall be refused or invalidated.

2. A trade mark the use of which corresponds to one or more of the situations referred to in Article 21(2), which has been applied for, registered, or established by use, in good faith within the territory of the United Kingdom, before the date on which the application for protection of the geographical indication was submitted to the Secretary of State, may continue to be used and renewed notwithstanding the registration of a geographical indication, provided that no grounds for its invalidity or revocation exist in, or under, the Trade Marks Act 1994.”

27. The applicant does not dispute that COGNAC is a PGI. On the contrary, she expressly admits that COGNAC is a PGI pursuant to Article 37 of Regulation 2019/787 which states:

“Article 37

Established geographical indications

Established geographical indications shall automatically be protected as geographical indications under this Regulation. The Secretary of State shall list them in the register referred to in Article 33 of this Regulation and the registration takes effect on IP completion day.”

28. Article 33 of Regulation 2019/787 states:

“Article 33

Register of geographical indications of spirit drinks

1.The Secretary of State must establish and maintain a publicly accessible electronic register, which is kept up to date, of geographical indications of spirit drinks recognised under this scheme ('the register').

2.The name of a geographical indication shall be registered in its original script. Where the original script is not in Latin characters, a transcription or transliteration in Latin characters shall be registered together with the name in its original script.

For geographical indications registered under this Chapter, the register shall contain a copy of the single document and product specification for each geographical indication.

For geographical indications registered before 8 June 2019, the register shall provide direct access to the main specifications of the technical file as set out in Article 17(4) of Regulation (EC) No 110/2008.

The Secretary of State may make regulations laying down further detailed rules on the form and content of the register.

3. Geographical indications of spirit drinks produced in third countries that are protected in Great Britain pursuant to an international agreement to which the United Kingdom is a contracting party may be entered in the register as geographical indications.

The entry in the register is to be treated as taking effect:

(a) in a case where the register is established by the Secretary of State after IP completion day but before the end of the day following the day on which IP completion day falls and the entry is in the register as established during that period, on IP completion day;

(b) in any other case, immediately the entry is entered in the register.**"**

29. In my first decision, I referred to the explanatory memorandum to the Agricultural Products, Food and Drink (Amendment etc.) (EU Exit) Regulations 2020 (SI 2020/1637) which very helpfully explains that the statutory instrument amends retained EU legislation to introduce a comprehensive regulatory framework for Geographical Indication (GI) schemes in the UK after Brexit, i.e. after 31 December 2020. I do not intend to reproduce the same paragraphs here, but insofar as it is relevant, it must be noted that UK schemes for the protection of GIs were introduced with effect from 31 December 2020 and mirror the EU schemes, the main difference being that the statutory instrument amend the text of the relevant EU legislation with the replacement in all relevant places of "Union" by "Great Britain" (or "the United Kingdom"). Hence, from 31 December 2020, all EU PDOs and PGIs (including UK food names) recognised under the EU GI schemes were automatically placed on the UK register and protected as UK PDOs/ PGIs. [7]

The opponent's pleadings and the claim that the contested mark is a hybrid mark. Is the opponent relying on the PGI COGNAC and can it do that?

30. I have accessed the UK GI scheme registers at https://www.gov.uk/protected-food-drink-names.[8] This constitutes essentially the PDOs and PGIs Register established and maintained by the Secretary of State under Articles 33 and 37 of Regulation no. 2019/787 (set out above). As it can be seen below, it lists Cognac as a registered GI and Protected spirit drink name with the following details being registered:

Registered name: Eau-de-vie de Cognac/Eau-de-vie des Charentes/**Cognac**
Register: Spirit drinks
Status: Registered
Class or category of product: 4. Wine spirit
Protection type: Geographical Indication (GI)
Country of origin: France
Date of registration (UK scheme): 31 December 2020
Date of original registration with the EU: 12 June 1989
Reason for protection: EU agreement

[7] Kerly's Law of Trade Marks and Trade Names 17th Ed. §§13-005
[8] MCA1

31. The rules and procedures for GIs are laid down in four sector-specific EU regulations: GIs for agricultural products and foodstuffs (Regulation 1151/2012), GIs for wines (Regulation 1308/2013), GIs for spirit drinks (Regulation 2019/787) and GIs for aromatised wine products (Regulation 251/2014).

32. Since the PGI COGNAC is a spirit drink, the relevant provisions are contained in Regulation 2019/787; whereas since the PDO Napa Valley identifies a wine product, the relevant provisions are contained in Regulation 1308/2013.

33. In its statement of grounds, the opponent relies on Regulation no.1308/2013 (insofar as it claims that the NAPA part of the contested mark NAPAÑAC makes direct or indirect commercial use of or evokes the PDO NAPA VALLEY) but also on Regulation no. 2019/787 (insofar as it claims that the ÑAC part of the contested mark NAPAÑAC evokes the PGI COGNAC).

34. Admittedly, the opponent referred in its pleadings to Regulation no. 2019/787 without reference to the relevant articles; nevertheless, the reasoning is clearly that the ÑAC part of the contested mark NAPAÑAC evokes the PGI COGNAC and that the public may assume that the goods are Napa Valley Cognac. In its statement of grounds, the opponent, in fact, concludes:

> *"This is an exceptional case in that the use of the mark would be doubly unlawful under EU law, under Regulation (EU) No 1308/2013 of the European Parliament and of the Council of 17 December 2013 as regards the protection of wines; and Regulation (EU) 2019/787 of the European Parliament and of the Council of 17 April 2019 regarding the protection of spirits.*
>
> *And under the Trade Marks Act 1994*
>
> *The mark applied for appears to have been chosen to trade on the goodwill attaching to the names NAPA VALLEY and COGNAC and its use is likely to cause confusion for consumers as stated above. Accordingly, the Applicant's use of the mark cannot be regarded as being in accordance with honest practices in industrial or commercial matters."*

35. In his skeleton argument, Mr Traub argued that the opponent has no standing to enforce rights in the PGI COGNAC in this opposition, although he did not develop the argument at any length. However, in the course of the hearing he added:

> *"I think the trap here that we must not fall into, again to emphasise that point, is that NVV can only invoke rights - prior rights that they have rights in, meaning the Napa Valley PDO and the Napa Valley certification mark; and the Opponent this morning [i.e. BNIC] can only invoke rights in Cognac, so the hybrid element is really not something that I invite you not to look into. It is just not part of this opposition. It has to be taken separately and we have to really apply the statutory requirements for the protection of PGI's this morning or PDO's this afternoon, as well as for trade marks, to consider whether there is infringement. In my submission, looked at separately, there is not. This is very important, and I hope you can draw your own conclusions from that."*

36. The issue was briefly addressed by Ms McFarland in reply, referring to the same point she made in the course of the earlier hearing which had taken place on the morning of the same day in relation to the opposition brought by BNIC, namely that the opponent's case that the contested mark is a hybrid mark was clear from the outset. Further, the following statements which were identified by Ms McFarland in relation to the first opposition are identically contained in the statement of grounds filed in relation to the present opposition:

i. *"The mark applied for self-evidently consists of the primary element of the name Napa Valley and the suffix 'ñac', which apart from the obvious written similarity is clearly intended by the Applicant, using the tilde symbol to be read and pronounced as if it was the greater part of the name COGNAC, 'ñac'"* and

ii. *"The mark applied for consists of nothing more than two distinctive and internationally known signs NAPA and COGNAC".*

37. As I noted in my first decision, admittedly, the official letter of 7 March 2022 rejecting the opponent's request for the present opposition to be consolidated and/or heard together with that brought by BNIC stated:

"Although it is noted that the mark which is opposed in both proceedings is the same, and that in both oppositions you are the legal representative for the opponent, the opponents in each opposition are different unrelated entities (namely Napa Valley Vintners (NVV) and Bureau National Interprofessional du Cognac (BNIC), and so are the rights relied upon in each opposition (one being a registration for the mark COGNAC and one being a registration for the mark NAPA VALLEY which are a PGI and PDO respectively); this also means that the evidence filed by the opponent in each opposition is different. Further, although in both cases you have argued that the applicant's intention in applying for the mark NAPAÑAC is to make an association with the Napa Valley region and the brandy spirit Cognac, in each opposition the opponent can only rely on its own right (i.e. Bureau National Interprofessional du Cognac (BNIC) can rely on its COGNAC trade mark and Napa Valley Vintners (NVV) can rely only on its Napa Valley Vintners trade mark).

Finally, hearing the matter together would make the task of the hearing too onerous for all the parties involved as effectively, both parties would have to address the different evidence and grounds in relation to each case, because the matter must be assessed in each case only from the perspective of the right the opponent is entitled to protect, not on the right the other opponent relies upon in the other opposition, with the fact that you are representing both parties (which are unconnected) being irrelevant for the purpose of the proceedings. Hence the proceedings will be heard separately".

38. The same approach I adopted in my first decision applies here. Firstly, whilst the letter recognises that the matter must be assessed in each case only from the perspective of the rights the opponent is entitled to protect, the reasoning focuses on trade mark rights, and consequently on the claims based on Sections 5(2)(b) and 5(3). Secondly, the official letter was sent in response to the opponent's request to consolidate the cases or hear them together, request which was made after the evidence rounds had been completed. Thirdly, the point about whether the opponent in this case is entitled to rely on the PGI COGNAC (in light of the pleadings and the relevant provisions) under any legislative provisions was not specifically raised or brought to the Tribunal's attention. It is not surprising, therefore, that the Tribunal did

not give full consideration to the issue of the pleadings. Finally, Mr Traub did not argue that the letter of 7 March 2022 gave a preliminary view that the opponent is prevented from bringing a claim based on the PGI COGNAC and I do not consider that the refusal to consolidate the proceedings or hear them together for the reasons stated in the letter, prevents me from considering the issue now.

39. I now turn to the pleadings.

40. Whilst Article 103 of Regulation no.1308/2013 is most relevant to the present opposition, Regulation no. 2019/787, might still be relevant for present purposes because:

(a) part of the opponent's case is that the second portion of the contested mark NAPAÑAC, i.e. ÑAC, evokes the PGI COGNAC and Regulation no. 2019/787 lays down the rules on PGIs for spirit drinks;

(b) whilst the opponent cannot rely on the PGI COGNAC to oppose the contested mark on relative grounds (because it is not the proprietor of an earlier trade mark incorporating the name COGNAC and it does not have the right to use the PGI COGNAC), the opponent is nonetheless capable of bringing an opposition under Section 3(4A) because Section 3(4A) being an absolute ground, it can be raised by any person as a ground of opposition (or indeed of invalidity) and any restriction on registering a trade mark found in Regulation no. 2019/787 is an objection under Section 3(4A) of the 1994 Act;

(c) the opponent's pleadings include references to the PGI COGNAC, to Regulation no. 2019/787 and to Section 3(4A) of the Act;

(d) the argument about the contested mark being a hybrid mark is sufficiently particularised and the opponent has pleaded sufficient facts in support of its case.

41. Consequently, I conclude that the opponent's claim that the PGI COGNAC would make the use of the contested mark NAPAÑAC unlawful under Regulation No

2019/787 is a proper objection under Section 3(4A) of the Act and that, being it an objection based on an absolute ground for refusal (which can be relied upon by anyone), the opponent is entitled to argue the point (and did so in the pleadings) even if it has no right to use or enforce the PGI COGNAC relation to spirit drinks.

Bases of the assessment: Section 3(4A) and Section 5(4)(aa) of the Act

42. Section 3(4A) of the Act is an absolute ground for refusal. It prohibits registration of a trade mark in the UK if, or to the extent that, its use would be contrary to any enactment or rule of law, or international agreement to which the UK is a party, providing for the protection of designations of origin or geographical indications. The relevant enactments relied on by the opponent as prohibiting the use of the contested mark are Regulation no.1308/2013 and Regulation no. 2019/787 which provide for the protection of PDOs and PGIs for wines and spirits, respectively.

43. In my first decision, I concluded that BNIC could rely upon both the PDO NAPA VALLEY (in which it had no rights) and the PGI COGNAC (which was entitled to protect) relying on Section 3(4A) as a gateway, because Section 3(4A) is an absolute grounds for refusal and anyone can oppose an application based on it. The same logic applies here. The opponent can rely on Section 3(4A) to claim that use of the contested mark would be prohibited by Article 103 of Regulation no.1308/2013 insofar as it evokes the PDO NAPA VALLEY, regardless of whether it has any right to enforce it. It follows that the opponent can also rely on Section 3(4A) to claim that use of the contested mark would be prohibited by Regulation no. 2019/787 insofar as it evokes the PGI COGNAC, even if it has no right to enforce it. This is subject, indeed, to the PGI or PGO being validly registered.

44. Earlier in this decision, I found that Cognac is a registered GI and Protected spirit drink name that was protected in the EU since 1989 and continued to be protected in the UK under the post-Brexit UK GI schemes at the filing date of the contested mark, namely on 14th July 2021.[9]

[9] Although in this case there is also a priority date of 29 January 2021, it does not make any difference as the date of protection of the PGI is still earlier than the priority date of the application.

45. Turning to the PDO NAPA VALLEY, the applicant admitted in its counterstatement that NAPA VALLEY is a PDO under the EU Commission's notice published in the Official Journal C106 on 10 May 2007. The UK GI scheme register at https://www.gov.uk/protected-food-drink-names, also lists NAPA VALLEY as a Protected wine name with Protected Designation of Origin (PDO) with the following details being registered:

Registered name: Napa Valley
Register: Wines
Status: Registered
Class or category of product: Wine
Protection type: Protected Designation of Origin (PDO)
Country of origin: United States
Date of registration (UK scheme): 10 March 2021
Date of original registration with the EU: 10 May 2007
Reason for protection: EU agreement

46. Article 102 of Regulation no.1308/2013 requires that in order to be a ground for refusal of a trade mark which falls under Article 103(2), the PDO must be registered with a filing date (or priority date) that is earlier than the contested mark, which is the case here. Further, the explanatory memorandum to the Agricultural Products, Food and Drink (Amendment etc.) (EU Exit) Regulations 2020 (SI 2020/1637), explains that the purpose of each of the UK GI scheme register is to continue to protect GIs that were already protected under the EU GI schemes after Brexit.

47. **Accordingly, I find that Section 3(4A) of the Act being an absolute ground for refusal, the opponent can rely on both the PDO NAPA VALLEY and the PGI Cognac (which were validly protected in the UK prior to the filing date and priority date of the contested mark) and that the opponent's argument about the contested mark being a hybrid mark is sufficiently particularised to support these pleadings.**

48. As regards the opponent's reference to Section 5(4)(aa) of the Act, I note that the opponent did not expand upon it in the pleadings, but, in her skeleton argument, Ms

McFarland appears to equate it to an action for passing off inviting me to apply the relevant principle. Accordingly, I will leave this ground to one side for the moment, and I will return to it if necessary.

Section 3(4A): The requirement of reputation

49. In *EMILIANA TRADE MARK*, BL-O-54/22, Professor Phillip Johnson, sitting as the Appointed Person, clarified that reputation of a PGI is not a necessary pre-condition for its protection but it is relevant to establish the likelihood of evocation. He stated (emphasis added):

> "**Requirement to reputation**
>
> 63. The Appellants' challenge to the Hearing Officer's finding that the absence of a strong reputation or familiarity of the PGI in minds of the UK public is material to assessing whether it might be evoked by the average consumer (Decision, [66]). Ms Reid submits that it is entirely wrong to consider the reputation of the PGI when assessing evocation.
>
> 64. The Hearing Officer's reasons for including reputation were set out in Decision, [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. It is apparent that Regulation No 1308/2013 is intended to protect the reputation built up by the relevant PGIs (see Recital (97) and C-490/19 *Syndicat*

interprofessionnel de défense du fromage Morbier, EU:C:2020:1043, [35] and the cases cited therein).

66. It is also clearly the case that when assessing whether there is a link for the purposes of section 5(3) of the Trade Marks Act 1994 the extent of the reputation is material: C252/07 *Intel v CPM* [2008] ECR I-8823, [53]. The courts have expressly acknowledged that the image transfer that occurs with dilution is more likely to occur when the mark has a stronger reputation. Logically this too would apply to the evocation of geographical indications.

67. However, Ms Reid points to T-510/15 *Mengozzi*, EU:T:2017:54 where it was argued that the PGI at issue was not "well known" and so the average consumer would not confuse the PGI and the mark and so in turn it would not evoke the relevant PGI. The General Court rejected this succinctly:

> As for the applicant's argument that the PGI at issue is not well known, and assuming that such an argument would be admissible before the Court, it is irrelevant since, as EUIPO states in its pleadings, the reputation of a PGI is not a condition for its protection.

68. I do not take this to mean that the reputation of a geographical indication is entirely irrelevant for assessing evocation; rather, I take it to mean that it is not possible to argue there would be no evocation simply because an indication has no reputation.

69. The purpose of Article 103(2) is to protect reputation and so it would be odd if the extent of that reputation is entirely immaterial to assessments under it (whether it is expressly mentioned in the relevant paragraph of that provision or not). Furthermore, as a matter of fact, it is clear that an incredibly well-known indication (such as say Champagne) is likely to be evoked in a wider range of situations than one that is less well-known simply because the word is so familiar to the general public.

70. Therefore, I agree with the Hearing Officer, it would be wrong for the law to turn its back on the factual reality and adopt a notional assessment. Critically, and what I think Mengozzi tells us, is that reputation can increase the likelihood of evocation when confronted with a similar mark, but as already mentioned the converse is not true and it is not possible to argue that an indication with no reputation can never be evoked.

71. Accordingly, I think it was perfectly acceptable for the Hearing Officer to give some weight to the reputation of EMILIA when assessing evocation. It is true that the Hearing Officer gives a lot of weight to reputation (see Decision, [66]) but it is clear that it was only one of the factors she used to decide the PGI would not be evoked. The relevant weight to give to each factor is a value judgment and her assessment is not wrong on its face and so I do not think an appellate tribunal should interfere with it.

72. Finally, Ms Reid suggests that in the absence of reputation the Hearing Officer indicated that she should undertake a "notional" assessment (see Decision, [64] set out above). My reading of the passage is that a notional assessment is inappropriate, and actual reputation should be considered. Therefore, I do not consider this point to need further consideration.

73. Accordingly, I agree with the Hearing Officer that the use of EMILIA would not evoke EMILIANA. I therefore dismiss the Appellants' appeal based on Article 103(2) (whether it is under section 3(4) or under section 3(4A) of the 1994 Act)."

50. It follows that the established reputation of a PDO or PGI is relevant to a claim under Section 3(4A) based partly on evocation.

The applicant's concessions

51. The opponent filed only evidence aimed at establishing the reputation of the PDO NAPA VALLEY. Indeed, as the opponent does not have any right to use or enforce the PGI COGNAC, it did not file any evidence of its reputation.

52. During the course of his oral submissions, Mr Traub stated that the reputation of NAPA VALLEY and COGNAC is not contested. He stated:

> *"By the way, that reputation is not contested; it is accepted as in the other case but the conclusions drawn from that reputation is something that we question."*

53. Given the concessions made by the applicant, there is no need to examine the evidence in detail. I will only highlight the main points in order to assess the strength of the reputation of NAPA VALLEY, which as Professor Johnson observed in *EMILIANA*, may affect the scope of protection to which the designation is entitled.

The evidence of reputation of the PDO NAPA VALLEY

54. The main points emerging from the opponent's evidence are as follows:

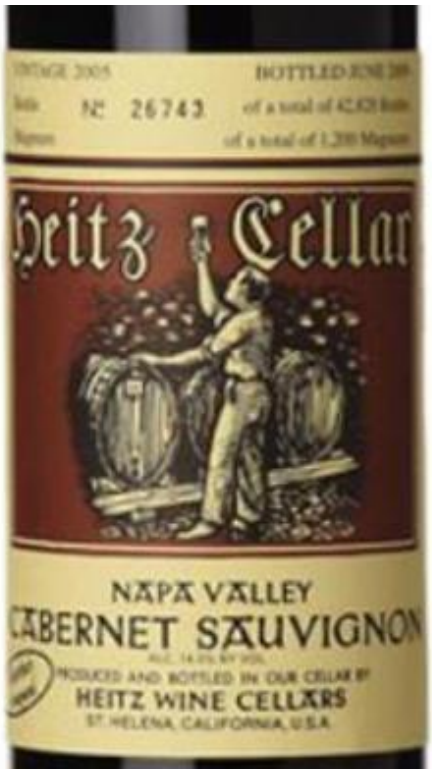
- The opponent was founded in 1944 and is a non-profit corporation under the law of California. It is also a voluntary regional trade group with an active membership of 550 wineries. The purpose of the opponent is to advance the wine industry of Napa Valley through programs and activities which promote the Napa Valley as the premier wine region of the world, and which protect its integrity. The opponent secured PDO status for wine for the name NAPA VALLEY with the EU on 10 May 2007. Such protection is further evidenced by the registration of the name NAPA VALLEY as a PDO on the register maintained by the DEFRA;

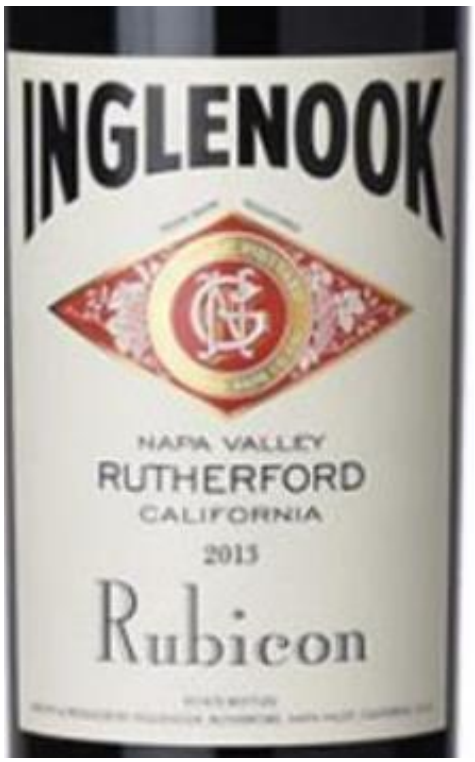
- The use of the name NAPA VALLEY has been established with UK consumers for over 25 years during which time Napa Valley wines have been sold in the UK. Ms Reiff says that the Wine Intelligence UK Wine Landscapes 2021 report (dated December 2020) indicates that Napa Valley wines have a substantial reputation with the UK consumers and that in 2020 of all UK regular wine drinkers, 64% knew Napa Valley as a wine producing region (compared, for example, to Champagne, Bordeaux and Prosecco, who held a score of 79%, 79% and 75% respectively and appears at the top of the list). In addition, 10%

had bought wine from Napa Valley in the past three months (compared, for example, to Champagne, Bordeaux and Prosecco who held a score of 16%, 20% and 31% respectively). The data for this report was collected in the UK in 2015, 2017, 2019 and 2020 and the report seems to indicate that there were 1,000 people being interviewed in 2015 and 2017, 1,012 in 2019 and 3,000 in 2020;[10]

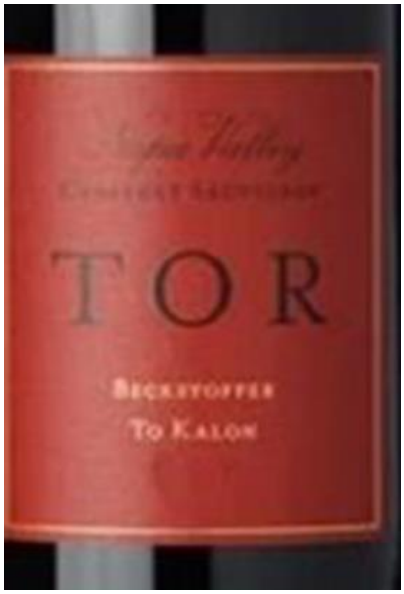
- Ms Reiff and other witnesses[11] says that the opponent regularly hosts or arranges Napa Valley wine tasting events in the UK. A number of events are mentioned, however, it is not said how many people attended these events;

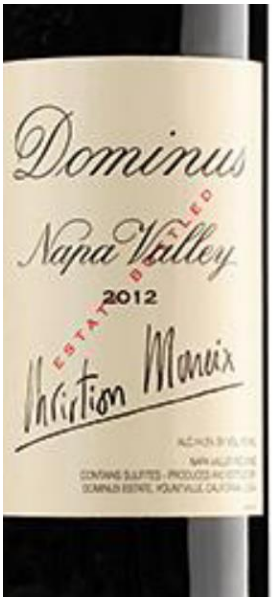
- NAPA VALLEY wines are sold in the UK under the name of the winemaker/producer/vineyard, but the designation NAPA VALLEY is visible on the bottles, as shown by the examples below:

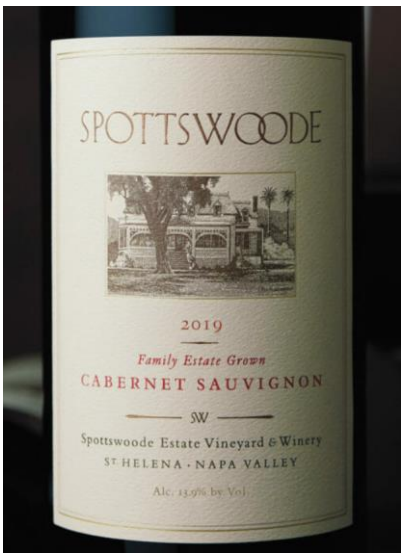


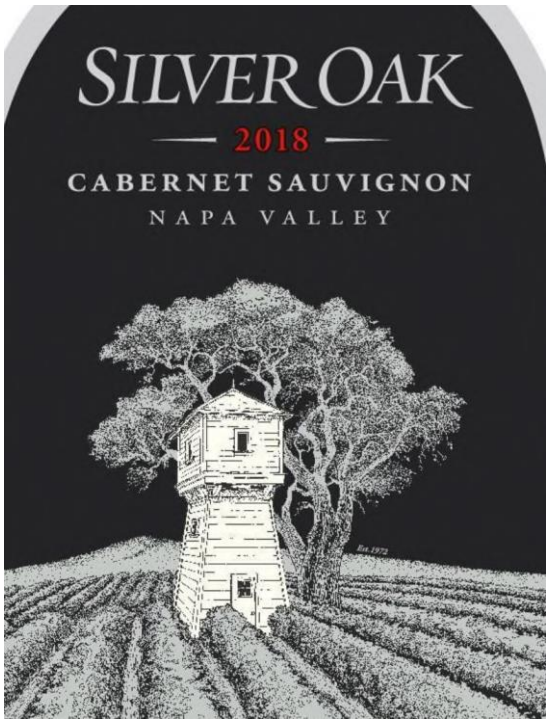


[10] LJR3
[11] Witness statements of James Clive Orrok Simpson, d James Rylett Hocking and Michael Christopher Anderson









- Mr Anderson states that NAPA VALLEY wines have been on sale through retailers in the UK for many years, with supermarkets such as Sainsbury's making reference to them in as early as 1993. An article from Decanter, a wine magazine for consumers, from 2013 shows that Napa Valley wines were on

sale through Tesco, Waitrose and 30 other retailers.[12] In 2014, Tesco was offering Robert Mondavi Napa Valley wine, in 2016 Waitrose was offering First Press from Napa Valley and in a 2020 report Sainsbury's referred to Napa Valley wines being world-famous. In November 2021, Napa Valley wines were on sale in Sainsbury's and Marks & Spencer. Mr Anderson mentions a number of "incidental" events in support of the reputation of NAPA VALLEY in the UK including Napa Valley wines featuring on the 'This Morning' show in February 2014, an article from Daily Mail dated December 2017 reporting Victoria Beckham buying a bottle of Napa Valley wine for a meal with her son Brooklyn, and NAPA VALLEY being mentioned in an article from Mail Online as *"some of the most popular wines".*

- Napa Valley wines are not inexpensive, with some vintage wine being priced at nearly £584 per bottle. According to Mr Doidge, who works in the wine trade, the relatively high price of Napa Valley wines is typically an indication of its quality. Less expensive options mentioned in evidence are around £30-40 and are said to be available only in more premium supermarkets like Waitrose – though Ms Pearce, who also works in the wine trade, says that almost all Napa Valley wines would be significantly higher than this. Mr Room, who used to work as a senior buyer at Waitrose, says that Napa Valley wines are *"more aspirational products and are in the mid-tier point from £10 to £15 or more, and upwards*" and that "*at Waitrose [they] carry NAPA VALLEY wines from producers up to £50 or more".* Mr Simpson, another witness who works in the wine trade, says that the larger UK supermarkets such as Tesco and Sainsburys might have one or two wines from the Napa Valley whilst Waitrose could have up to half a dozen. He also says that Napa Valley wines are not sold in significant volume throughout Europe and that historically, the UK has been a significant importer of wines from all over the world and tends to be rather more adventurous that the rest of Europe, although no UK specific total turnover figures are given. Some buyers of NAPA VALLEY in the UK are Americans living in the UK, typically American lawyers who are resident in the UK;[13]

[12] MCA1
[13] LJR1, page 19 and witness statement of James Clive Orrok Simpson

- The value of the UK sales of Napa Valley wines by Pol Roger, a UK importer of wine, was £496,000 in 2021, rising from £357,000 in 2020, £151,000 in 2019 and £146,000 in 2018.[14] Mr Hocking says that it sold around £5 million worth of Napa Valley wines in the last 20 years although the figures are not broken down in any way;

- Ms Pearce says that the Napa Valley estates are quite small and sell a lot of their production directly in the USA. She also says that the product is high value, and that the vineyards could sell all of their wine to locals and tourist visitors. However, Ms Pearce says, some Napa Valley vineyards choose to sell some wine in the UK rather than in California, as selling locally is not the same as being listed with a historic wine merchant or being known to sell to high-end restaurants. Ms Pearce also says that some Napa Valley vineyards are selling in the UK to build on the reputation that has been built in the UK and explains that being seen to be in a bigger pool helps Napa Valley vineyards' reputation in the longer term;

- Ms Novak Milliken, who is the CEO of Spottswoode Winery, Inc, a producer of Napa Valle wines, says that the UK is a very important market to her business, and that Harrod's was the successful buyer of their Premier Napa Valley wines. According to Ms Novak Milliken, her business has regularly exported their range of Napa Valley wines to the UK for retail sale and sale to hotels and restaurants since 1990, and has since that date sold eight hundred and ninety-seven (897) nine-litre cases (the equivalent of 10,764 bottles (750ml)), which amounts to just under one million U.S. dollars in historic retail value at the time of shipment (i.e., not factoring for appreciation or inflation);

- Mr Duncan, who is the CEO of Silver Oak Wine Cellars, LLC, another producer of Napa Valley wines, says that in the five years preceding 2022, his business sold one-hundred and ninety-seven (197) nine-litre cases of Napa Valley wines in the UK for over $150,000.00 in sales.

[14] Witness statement of James Clive Orrok Simpson

55. Although no total turnover or marketing figures have been provided, the applicant has conceded that the designation NAPA VALLEY benefits from reputation in the UK. Further, the evidence indicates that Napa Valley wines are sold and marketed as wine of high quality and the evidence about the price point is of particular significance in showing that Napa Valley wines have a reputation for high quality wines. Significantly, the data from the Wine Intelligence UK Wine Landscapes 2021 report also shows that, of the UK regular wine drinkers interviewed, 64% knew Napa Valley as a wine producing region (compared, for example, to Champagne, Bordeaux and Prosecco, who held a score of 79%, 79% and 75% respectively and appears at the top of the list) and 10% had bought wine from Napa Valley in the past three months (compared, for example, to Champagne, Bordeaux and Prosecco who held a score of 16%, 20% and 31% respectively). The evidence as a whole seems, therefore, to corroborate some of witnesses' opinions that even though many average members of the public would not buy Napa Valley wines (because they are so expensive), as far as wine drinkers are concerned, a substantial number of people in the UK will have heard of the designation NAPA VALLEY and bought such wines. However, the sale figures provided are partial and scattered throughout the evidence; further, they do not appear to be particularly high especially taking into account the higher cost of the goods and the fact that in some instances they cover a period of 20-40 years. On that basis, I am satisfied that, at the relevant date, the designation NAPA VALLEY had a reasonable reputation in the UK for high quality wines.

56. The evidence shows that NAPA VALLEY wines are marketed with the name of the winemaker/producer/vineyard, and that the denomination NAPA VALLEY is used in conjunction with other geographical denominations referring to the country where the wine is produced such as St Helena, California and USA. Further, I note the applicant's concession that NAPA VALLEY has a reputation in the UK as a geographical location. Taking into account all of these facts, I am satisfied that NAPA VALLEY in the UK means the wine produced in the NAPA VALLEY region of California by the opponent and the growers of that region.

The reputation of the PGI COGNAC

57. In this opposition the opponent did not file any evidence regarding the reputation of the PGI COGNAC. However, as I have found above, the absence of evidence establishing reputation of a PDO or a PGI is not fatal to a claim under Section 3(4A) in order to establish evocation plus, in this case, the applicant has expressly admitted that COGNAC has a reputation with average consumers in the UK as a brandy from the Cognac region in Western France.

The opponent's best case

58. As I noted in my first decision, admittedly, the opponent has, to an extent, taken a kitchen sink approach to these proceedings in the sense that it has pleaded every type of misuse set out in Regulation no. 2019/787 and Regulation no. 1308/2013 (as well as deception, likelihood of confusion, damage and detriment to the distinctive character and reputation of a collective mark). However, at the hearing, both Ms McFarland and Mr Traub concentrated on the concept of evocation[15] which is set out in Article 21(2)(b) of Regulation no. 2019/787 and Article 103(2)(b) of Regulation no. 1308/2013.

59. Accordingly, I will first assess whether the name NAPAÑAC for brandy, fortified wines and spirits constitutes an 'evocation' (a) of the PDO NAPA VALLEY within the meaning of Article 103(2)(b) of Regulation no. 1308/2013 and (b) of the PGI COGNAC within the meaning of Articles 21(2)(b) of Regulation no. 2019/787. I will return to the other claims, which do not appear to me to be likely to succeed to any greater extent than that based on the concept of evocation, later.

Evocation

The evidence relied upon by the opponent.

[15] Although the other grounds were included in the skeleton arguments they were hardly touched upon in the course of the oral submissions.

60. In her skeleton arguments, Ms McFarland relied upon a number of authorities, particularly the recent High Court judgment ***Les Grands Chais De France SAS v Consorzio Di Tutela Della Denominazione Di Origine Controllata Prosecco*** [2020] EWHC 1633 (Ch). In that case, the protected name was the PDO Prosecco, and the disputed trade mark was NOSECCO, applied-for in relation to non-alcoholic sparkling wine. In its decision, the High Court found that use of 'NOSECCO' was contrary to EU law under Section 3(4) of the Act and went on to uphold the Hearing Officer's decision that the applicant's use of 'Nosecco' breached Article 103(2)(b) of Regulation 1308/2013, which protects PDOs against *"misuse, imitation or evocation".* Significantly, in that case, the applicant tried to argue that evidence was required from consumers to establish a link between the contested term and the protected name for the purpose of establishing evocation, but the argument was rejected by the Court which reiterated that national courts should base their decisions on the *"presumed reaction of consumers*". Even more significantly, the Court relied upon the evidence that the applicant had referred to 'Nosecco' as a "parody of Prosecco". It stated:

> "As to the suggestion that it would also convey the message that the product was not Prosecco, I do not think that invalidates the point made by the Hearing Officer at [26]. That is that the effect of the aural and visual similarity between Nosecco and Prosecco, in combination with the initial "No-" would cause average consumers to consider it to be a reference to Prosecco or a Prosecco-like drink with no alcohol. I do not see how that could be said to be an unrealistic or unjustified view: indeed Ms Lickel's reference to the name as a "parody of Prosecco", and to its "witty nature" or "clever concept", seems to me to come very close to accepting that the intent behind the name, or at least its effect, was to make consumers think of Prosecco, and to contrast Nosecco with it because Nosecco was alcohol-free. That by itself in my view would make the case that Nosecco evokes Prosecco within the meaning of Art 103(2)(b) as expounded by the Court of Justice, because it triggers in the mind of consumers an image of Prosecco. It is not necessary that the consumer should believe the Appellant's product actually to be Prosecco, as it is clear from the terms of Art 103(2)(b) that it would cover such formulations as "Prosecco-like" or "in the style of Prosecco" or even "imitation Prosecco". The average consumer would

understand that products so labelled were not actually Prosecco, but this does not prevent them being examples of evocation".

61. Similarly to what I found in my first decision, I think the point about the court taking into account advertising material published by the applicant which suggested that any similarity between the signs was not fortuitous is particularly relevant in this case. This is because the opponent filed evidence aimed at establishing that the applicant chose the name NAPAÑAC intentionally to create an association with both designations COGNAC and NAPA VALLEY. I refer in particular to the following evidence:

- The evidence from an online article titled *"The Genius Idea for Making Drinks with Smoke-Damaged Grapes"* (undated) which talks about the applicant's intention to use the mark NAPAÑAC to *"establish an identity for brandy made in NAPA VALLEY";*[16]

- The evidence from an online article titled "*How Vintner Lindsay Hoopes Found a Silver Lining from the Epic Napa Fires"* dated July 2021 which reports some statements made by the applicant in an interview. In answer to the question *"How did you find a way to repurposing [wine made from smoke taint grapes]?"* the applicant stated: *"I was looking at all options and new technologies. Then in May of 2019, I was in Kentucky and met Marianne Eaves, the first woman to earn the title Master Distiller, at Castle and Key. We were at a Female Tastemakers dinner. We have a lot in common. She's a female in a very heavily male-dominated industry too. I loved meeting her and was joking around. I told her, "I've got a little problem. I've got some pretty smoky grapes. Do you think you can do anything with them?" She was interested and I said, "Let's try to make something beautiful out of this. They're [illegible].* ***Cognac is brandy and brandy is made from wine and we had wine, so it was going to be some sort of brandy product.*** *And people are constantly trying to add smokiness to spirits.* ***Maybe we can marry these two seemingly conflicting worlds and create something interesting?*** *We kept in touch and decided to play around*

[16] MCA1-80

with it and got along extraordinarily well. And we're really excited about the product. ***It's actually a new category that we're calling Napanac"****;*[17]

- The evidence from an online article titled *"Lindsay Hoopes: Creating Economic Viability and Attracting the Next Generation of Consumers to Napa"* dated January 2021 which describes the applicant as one of the wine's most inspiring people 2021. The article states: *"Lindsay was raised with no barriers if someone tells her no she will ask them how no becomes yes. Nothing can stop her. She thinks differently than everyone else in the room. Her creativity knows no bounds" says Hoopes Vineyards' star consulting winemaker, Aaron Pott of Pott Wine and Huis Clos Consulting. "She is constantly thinking how she can make things better when others have the feeling that they are the best they can be. She is always changing, evolving, rethinking, reshaping and recreating and does not stop."* [Illegible] *meets crises head on with creative solutions. No stranger to pivoting plans, 2017 laid another big challenge at Hoopes feet; smoke from Napa Valley wildfires tainted the grapes in their vineyards making them useless for premium wine.* ***When crop insurance did not cover the losses, she took an innovative approach and teamed up with Master Distiller Marianne Barnes to distil the tainted wine into Napa's first "Cognac"****;*[18]

- The evidence that in an episode of the podcast entitled "The Kara Goldin Show" which was released on 25 November 2020, the applicant stated: *"We started aging them in different barrels and ultimately came up with a product that is* ***kind of the Cognac of Napa****, if you will";*[19]

- The evidence that in an episode of the podcast "The Birdies & Bourbon" of October 2020 available on YouTube, the applicant made the following statements during an interview: "*actually, well* ***a brandy umm, you know is mostly made from grapes as is Cognac*** *– it's made from wine I should say,*

[17] MCA1-83
[18] MAC1-88
[19] A transcription of relevant parts of The Kara Goldin Show broadcast is attached to Mr Anderson's second witness statement (MCA NV2 #2, pp. 29-32)

….. so it's going to be extraordinarily limited so we produced umm, a significant – well I should say the distillation process reduces the volume substantially you know, turns into about 15% so in 2017 50% of my harvest was affected and of that now we only have 15% that is converted into brandy - it's super rare, super small quantities and then obviously every year that we make it, it sort of depends on what was affected by the fire right? […] ***I mean look at Cognac right?*** *oh but that's not how you think about it right? like when you say Napa doesn't have to do it - and look at Cognac right?* ***why is Cognac unique? Napa has that same ability.*** *I remember one of the biggest lessons I learned you know with all this with this stuff taint what's interesting is smoke taint doesn't undo the quality of what you put into the still because the grapes themselves are still ultra-premium quality, they're still grown under the best conditions with the care you would put in for ultra-premium grapes, so I'll hand harvest it and all of those things that make great wine so the input is actually high for an ultra-premium spirit and that's how I like to think of it because you know when you think about* ***Cognac*** *yeah it's great from a region. Why is that important - because of how they handle them, because of the type of grape that goes into it so you know I actually think that* ***Napa*** *is probably the prime destination for* ***creating this new category****, in my mind very effective…."*;[20]

- The evidence that in an email dated 13 May 2021 to Napa Valley Vintners the applicant stated: "*I wanted to inquire about the appropriate contract at Napa Valley re: our trademark application.* ***We have filed a trademark application for Napañac (Napa + Cognac) for our Brandy produced from smoke tainted grapes,*** *as I think we've discussed, and the trademark office returned a comment that a potential conflict exists with Napa Green & Napa Valley. While I don't think that our trademark is similar for a number of reasons, I figured it would be best to discuss with your counsel to discuss the NVV position on the topic first";*[21]

[20] A transcription of parts of the Birdies & Bourbon podcast is attached to Mr Anderson's second witness statement (MCA C2 #2, pp. 21 - 24).
[21] MCA C2 #3, pp. 26 - 27

62. Another case in which intention to create a link between the contested mark and the protected name was considered to be relevant is Case C-75-15 *Viniiverla Oy v Sosiaali-ja terveysalan lupa-ja valvontavirasto ("Viniiverla").* Here the protected name was Calvados, and the disputed designation was Verlados, used on a cider spirit produced in the Finnish town of Verla. The relevant protection was that found in Article 16(b) of Regulation 110/2008. The CJEU said (in the context of evocation):

> "37. In this case, it must be noted that, according to the referring court, it is not disputed that the name ‘Verlados’ is used in Finland for products similar to those with the protected geographical indication ‘Calvados’, that those products have objective characteristics in common, and they are consumed, from the point of view of the relevant public, on occasions which are largely identical.
>
> 38. As regards the visual and phonetic relationship between the names ‘Verlados’ and ‘Calvados’, the referring court must take into account the fact that they both contain eight letters, the last four of which are identical, and the same number of syllables, and that they share the suffix ‘dos’, which confers on them a certain visual and phonetic similarity.
>
> 39. It is also for the referring court to take into account, in accordance with the Court’s case-law, possible information capable of indicating that the visual and phonetic relationship between the two names is not fortuitous (see, to that effect, judgment in Consorzio per la tutela del formaggio Gorgonzola, C-87/97, EU:C:1999:115, paragraph 28).
>
> 40. In that regard, the French Government contends that the product ‘Verlados’ was originally named ‘Verla’, the suffix ‘dos’ being added only later, following a significant growth in exports of ‘Calvados’ to Finland between 1990 and 2001. Moreover, that government observes that the syllable ‘dos’ has no particular meaning in the Finnish language. Those facts, which are to be established by the referring court, are capable of constituting evidence from which it may be concluded that the relationship referred to in paragraph 38 of the present judgment is not fortuitous”.

63. Finally, the relevance of possible information capable of indicating that the visual and phonetic similarity between the competing names is not fortuitous was also made clear in Case C-87/97 ***Consorzio per la Tutela del Formaggio Gorgonzola v Käserei Champignon Hofmeister GmbH&Co. KG.***[22] Here the protected name was Gorgonzola, and the disputed designation was Cambozola, used for a German blue cheese. Furthermore, the CJEU rejected the defendant's argument that there was no "evocation" if there was no likelihood of confusion. It stated:

> "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. As the Advocate General states in points 37 and 38 of his Opinion, 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 a 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.
>
> 28. In that connection, it would also seem appropriate for the national court to take into account advertising material published by Käserei Champignon and placed before the courts by the plaintiff, which suggests that the phonetic similarity between the two names is not fortuitous".

[22] Paragraph 28: "In that connection, it would also seem appropriate for the national court to take into account advertising material published by Käserei Champignon and placed before the courts by the plaintiff, which suggests that the phonetic similarity between the two names is not fortuitous".

64. In so finding, the Court followed the opinion of Advocate General that when assessing evocation intention is relevant:

> “35. On the question of intention, I would add that, although as indicated above I consider that 'evocation’ is an objective concept, that does not mean that intention is necessarily irrelevant. Although Article 13(1)(b) would be applicable even to a name chosen at random with no intent to evoke, if that name in fact evoked a registered name, nevertheless the intention of the owner of the mark in choosing that mark may be relevant. In this case, for example, where common sense suggests that the name 'Cambozola‘ was chosen not because 'zola‘ was a common Italian geographical suffix, which would be an unlikely reason in the context of a German cheese not purporting to be Italian, but because it evoked the idea of an established cheese of a similar type, that circumstance supports the existence of evocation. Moreover the advertisement referred to above, albeit a single instance, strongly supports this inference as to the derivation of the name.
>
> 36. I cannot in any event accept the defendants' argument that the alleged fact that the suffix 'zola‘ is a common suffix in Italian place names could in itself prevent its being an evocation in the context in which it is used: the fact that it might be common in some parts of Italy cannot prevent it from being an evocation elsewhere, where names ending in -zola are rare.”

The applicant’s arguments

65. In her witness statement, the applicant explains that as a result of the present application, her family business was expelled by the opponent from membership. She states that as a Napa Valley winery owner, her entire financial wellbeing is dependent upon the success and reputation of Napa Valley wines both domestically and internationally, the suggestion being that it would go against the applicant’s own interests to damage the reputation of the designation NAPA VALLEY.

66. The applicant also states that she does not agree that NAPAÑAC poses any threat to the reputation of NAPA VALLEY, putting forward a number of arguments about the

risks of narrowly focusing Napa Valley economy on wine alone, and the need to evolve. She says that she considers it inappropriate for the opponent, as a Napa Valley-based trade organization, or for its affiants, to evaluate whether a brand name is a "good business idea" or not, and to comment on the quality of the NAPAÑAC product, which, she argues, is wholly irrelevant to what a consumer will think about the product, if it enters the UK marketplace. In this connection, the applicant argues that the opponent's affiants have never discussed the product, distribution strategies, planned marketing, or product placement, so all lack any foundation to allege how the consumer would encounter the product in the marketplace, or how that placement could or would affect Napa Valley wines.

67. In the circumstances, whilst I understand the applicant's arguments, they are irrelevant when it comes to the question of evocation, because the protection of the PDO NAPA VALLEY must be determined on the basis of the similarity between the PDO and the applicant's mark, the identity/similarity of the goods, and the actual reputation of the PDO; hence, any marketing consideration that could mitigate the likelihood of evocation - as those to which the applicant refers - is not part of the assessment I am required to make.

68. Other parts of the applicant's witness statement replicate some of the evidence and submissions given in the first opposition, namely:

a) That the name NAPAÑAC was created by the applicant to pay homage to the "Spanish" origins of brandy in California, that use of the suffix "nac" was to *"build a bridge to high end grape brandies from all over the world"* and that COGNAC is not the only spirit including the suffix "nac". In this connection, the applicant claims that average consumers in the UK will be familiar with ARMAGNAC which is a brandy produced in the Armagnac region in France, and that there are further distilled products from regions ending with the suffix "nac", such as LOURIGNAC, SALIGNAC, SARGARGNAC, CARIFORNGNAAC, LOUIS D'ARMAGNAC, VINJAK, SAUVRIGNAC, LAURIGNAC and GAVERNAC;

b) That the product was intended to recall Napa to the extent that the brandy comes from Napa as opposed to any other part of California.

69. In relation to point (a) first, as I noted in my first decision, there is no evidence about how well-know the designations Armagnac, Lourignac, Salignac, Sargargnac, Cariforngnaac, Louis d'Armagnac, VInjak, Sauvrignac, Laurignac and Gavernac are in the UK. Second, the alleged fact that the suffix 'nac' is incorporated in other protected spirit drink names, even if proven (which is not), would not prevent the suffix 'nac' from being an evocation of Cognac within the name NAPAÑAC as it is sufficient that the mark evokes Cognac. The mere fact that it may also evoke (say) Armagnac to some consumers does not prevent it evoking Cognac too.

70. As regard point (b), the applicant's main defence in this opposition is that the opponent has no right in Napa alone, that Napa is a geographical location and that since NAPAÑAC is a product from Napa-grown grapes, produced in Napa, the association with Napa, California, is a fair, descriptive use of a geographic place in which the product is made. I quote below some extracts from the applicant's witness statement (emphasis added):

> *"The wines do satisfy the NAPA VALLEY appellation requirements, but the name is not NAPAVALLEYNAC. The PDO that [the opponent] has rights to is not part of the name."*
>
> *"Use of NAPA similarly does not immediately invoke NAPA VALLEY. [The opponent] does not own the mark "NAPA" in any jurisdiction. NAPA is not the legal equivalent of the PDO NAPA VALLEY, even in context of PDOs covered by the UKIPO, in Class 33, or as to wine and/or wine consumers, generally. NAPAREULI is a registered PDO in CLASS 33 (PS040001405), as is PDO NAPA COUNTY (PS040000877, PS040000878). Thus, NAPA is necessarily a weak component of the significance of the PDO NAPA VALLEY as both words, together, are necessary to define the geographic location of interest to [the opponent]. Further, registration and existence of the above three PDOs, with the shared component of NAPA, all for wine, itself indicates that wine consumers can distinguish between these PDOs with sufficient clarity to enable distinction between any one of those PDOs and the fanciful term NAPAÑAC."*

"[The opponent]'s mark is only concerned with where wine grapes are grown. [The opponent] does [not?] exert qualitative control over wine production of any kind over the wines produced in Napa Valley."

"In the United States, [the opponent] has registered NAPA VALLEY as a certification mark. ***Certification marks are distinct from trademarks, and from UK and European PDOs or PGIs.*** *In applying for the mark NAPA VALLEY, [the opponent] limited the mark to "certifying" wines comprised of 85% grapes grown in the American Viticultural Area of Napa Valley, California. Although [the opponent] could have created quality parameters for the certification mark, they did not do so. [The opponent] has no influence over production methods, ageing, or even grape quality.*

The NAPA VALLEY certification mark was not registered until 2015 in the U.S. and upon registration, it was originally rejected under a likelihood of confusion test and for being too generically descriptive. [The opponent] was required to secure agreement from over 40 existing trademarks including NAPA VALLEY to proceed to registration in the U.S. The reputation of Napa Valley wines long predates [the opponent]'s registration of the NAPA VALLEY mark."

"In sum, the control granted to [the opponent] through the NAPA VALLEY certification mark in the US is limited to whether a winery's brand name can include NAPA VALLEY, not whether a product can designate Napa Valley as the origin of the product, or the origin of agricultural products from which a wine product is made. As is the case with wine products, alcohol products, and various other agricultural products, the geographic origin is a distinct legal labelling requirement wholly unrelated (and beyond) [the opponent]'s sphere of intellectual property control.

The relevance here is that whether or not NAPANAC is approved as a brand name, I would be legally entitled, and in many cases legally required, to list NAPA VALLEY as the geographic origin of the NAPANAC product on the label. *In other words, the asserted potential for diminution of value through "association" with PDO NAPA VALLEY is a red herring: any ruling*

here with will have no bearing on whether or not the product will be "associated" with Napa, California, Napa County, or the Napa Valley, AVA through the packaging or product label. This is true for products sold in the UK, as they are subject to compliance with US and UK requirements.

The affiants Ms. Millikan and Mr. Duncan, as wine producers in Napa Valley, and subject to the same labelling laws as all others, know this, and yet have failed to disclose this in their witness statements. The opposition to my brand name, even if associated with the location of Napa, California, will have no impact on whether NAPA VALLEY appears on the label of the product or can be associated with that product."

71. The applicant also argues that the opponent's arguments contradict the opponent's previous admissions that the NAPAÑAC product met the certification criteria as it is made from wine 85% of which is from Napa Valley. Copy of an email dated 24 May 2021, from Rex Stults, forwarding an email from J. Scott Garien, the opponent's US attorney, is exhibited,[23] which states as follows (emphasis added):

"You can let Ms. Hoopes know that so long as the brandy with which she wants to use "Napa" as part of the name is made from grape juice 75% of which is from Napa County grapes, then such use complies with [the opponent]'s NAPA VALLEY certification mark. ***If she wants to use "Napa Valley" as part of the name, then the brandy must be made from grape juice 85% of which is from Napa Valley AVA grapes in order to comply with the certification mark****."*

72. In this connection, the applicant contends that in the USA the opponent may not deny, under any circumstance, use of the mark on goods that they admit comply with the certification standards, such as, she says, NAPAÑAC. Further, the applicant argues that if the NAPA VALLEY appellation "cannot" apply to the NAPAÑAC product, the opponent's argument must rest on the premise that *"nothing other than wine"* can ever include NAPA VALLEY in the product or brand name, which is not the law.

[23] LBH-02

Further, the applicant refers to the opponent having signed consent agreements[24] allowing use of NAPA or NAPA VALLEY on products other than wine (including beer and vinegar) and not having objected to the use of NAPA and NAPA VALLEY in other trade marks covering non-wine products (including cannabis); this, the applicant claims, demonstrates that the opponent does not think that the association with products other than wine diminishes the quality perception of NAPA VALLEY wines or dilute the PDO, a position which undermines the opponent's own argument in this opposition. Finally, the applicant claims that the opponent's argument that it would be unfair to associate a NAPA VALLEY product with a French wine contradicts the opponent's public association or comparison to French wine appellations when describing the quality, flavour and inspiration of *"Napa wines".*

73. It appears to me that the applicant's arguments rely upon considerations which are irrelevant to the points I need to decide. I will now explain why I reach that view.

74. By virtue of NAPA VALLEY being a validly registered PDO and Article 103 of Regulation no. 1308/2013 being applicable to it, the opponent is entitled to protect the registered PDO NAPA VALLEY against (a) any commercial use of the protected name on products "comparable" to those for which it is registered or where using the name exploits the reputation of the PDO, and (b) any misuse, imitation or evocation, even if the true origin of the product is indicated. However, it is important to keep in mind the distinction between PDOs and certification marks (and their scope of protection) and not to blur the arguments when considering whether NAPAÑAC evokes the PDO NAPA VALLEY.

75. Article 2 of Regulation 510/2006 on the protection of geographical indications and designations of origin for agricultural products and foodstuffs states:

> "Article 2
> **"Designation of origin and geographical indication**
>
> 1. For the purpose of this Regulation:

[24] LBH03-05

(a) ‘designation of origin’ means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- originating in that region, specific place or country,
- the quality or characteristics of which are essentially or exclusively due to a particular geographical environment with its inherent natural and human factors, and
- the production, processing and preparation of which take place in the defined geographical area;

(b) ‘geographical indication’ means the name of a region, a specific place or, in exceptional cases, a country, used to describe an agricultural product or a foodstuff:

- originating in that region, specific place or country, and
- which possesses a specific quality, reputation or other characteristics attributable to that geographical origin, and
- the production and/or processing and/or preparation of which take place in the defined geographical area.

(2) Traditional geographical or non-geographical names designating an agricultural product or a foodstuff which fulfil the conditions referred to in paragraph 1 shall also be considered as designations of origin or geographical indications.
[…]”

76. Accordingly, a PDO is, by definition, a geographical name. Though PDOs can also be traditional non-geographical names, that is an exception rather than the norm.

77. Conversely, a certification mark is defined in Section 50(1) of the Act as:

> "A certification mark is a mark indicating that the goods and services in connection with which it is used are certified by the proprietor of the mark in respect of origin**,** material, mode of manufacture of goods or performance of services, quality, accuracy or other characteristics."

78. The UKIPO Manual of trade marks practice contains the following guidance about registration of GIs as certification marks:

> "Protected geographical indications (GI's)
>
> Certain geographical names are protected in England, Scotland and Wales by GB regulations whilst EU regulations offer the same protection in Northern Ireland in respect of agricultural products and foodstuffs, drinks, wines and spirits. The purpose of these regulations is to prevent the misappropriation or misuse of the names which are used by the trade to establish a connection between certain goods and their geographical origin normally in order to evoke a quality standard.
>
> An application to register an ordinary trade mark which consists solely of a GI will face insurmountable objections. This is because the registration of a GI to one single trader would amount to misappropriation and misuse of the GI the purpose of which is to guarantee geographical origin and not trade origin.
>
> However, an application to register a GI as a certification mark will not be regarded as misappropriation or misuse. The function of certification marks can be seen as complimentary to a GI as opposed to an ordinary trade mark which is antagonistic to it. For example, a certification mark for a geographical name sends a message to the consumer that the goods are certified as being the produce of the particular location, this, therefore, supports the function of a GI."

79. Geographical names can therefore be registered both as GIs (and PDOs) and certification marks, like in this case. However, the issue of whether the applicant's **goods** meet the certification requirements for use of the certification mark NAPA VALLEY, cannot be confused with the question of whether the use of the **name**

NAPAÑAC constitutes evocation of the PDO NAPA VALLEY. Regulation no.1308/2013 does not provide, as a defence, that the goods in relation to which the infringing sign is used meet the certification requirements in circumstances where the PDO is also registered as a certification mark. In other words, even if the applicant's goods had met the certification requirements for the use of the certification mark, that does not resolve the question of whether the trade mark NAPAÑAC evokes the PDO NAPA VALLEY. This takes me back to the point about consent. As I understand it, the opponent's position, as it was explained by Ms McFarland at the hearing, was that the opponent was happy to consent to the applicant using the certification mark NAPA VALLEY if her product met the certification requirements of being made from wine 85% of which is from Napa Valley, and was also happy for the applicant to use NAPA VALLEY as part of her brand. In this connection, Ms McFarland referred to Mr Stults' evidence that in his meeting with the applicant, the applicant was encouraged to use a different name such as NAPA VALLEY BRANDY, in which case, the opponent could provide her with the requested consent. However, what the opponent did not agree to, was the use of NAPA within NAPAÑAC because it felt that the use of two designations was deceiving.

80. Ms McFarland's arguments are clearly supported by the evidence. Mr Stults also stated that the issue of consent was raised with the opponent's committee that deals with the name issues, as well as with the opponent's CEO and the President but was rejected because, as Ms Reef said in her second witness statement, merging the PDO NAPA VALLEY with another appellation, i.e. COGNAC, would create a mark that is deceptive and would dilute or devalue the PDO.

81. In any event, the applicant's allegation that the opponent's decision to oppose her application for the mark NAPAÑAC may have been influenced by Cognac's desire to oppose, is neither here nor there. Whatever the reasons for the opponent opposing the contested mark, the applicant did not suggest that it is unreasonable behaviour and did not argue that the case should have been struck out for want of any reasonable chance of success. Further, there is no evidence that the opponent has ever agreed to the registration of the applicant's mark, and Mr Traub accepted this point at the hearing.

82. Equally, the fact that the opponent might have agreed to the registration or use of third-party marks incorporating the PDO NAPA VALLEY or part of it, is not a matter that I can (or should) take into account as it does not affect the protection granted by the registration of the PDO. It is up to the opponent to decide how to enforce its rights deriving from that registration.

83. Another point which Mr Traub developed at the hearing was that the element "NAPA" is descriptive and non-distinctive because it refers to a geographical region and indicates the geographical origin of the goods. In support of this argument, Mr Traub contended that "NAPA COUNTY", where Ms Hoopes' grapes to be used in the NAPAÑAC product are grown, is recorded on the register for *"American viticultural areas and US spirit drink names of origin".* He also provided (as an annex to his skeleton arguments) an extract from the GB register which shows that registration. Further, Mr Traub argued that 'Napa wines' are both Napa County wines and Napa Valley wines and stated that they are both protected geographical names in the UK, and both refer to Napa wines as a geographical indication of the region. Finally, Mr Traub referred to the evidence from Désirée Fields that there are 103 active trade marks in the UK for marks consisting of or incorporating NAPA (or close variations thereof) across all classes of goods and services, and 25 active trade marks in the UK for marks consisting of or incorporating NAPA (or close variations thereof) in class 33, including the opponent's mark and the contested application.

84. I am not persuaded by Mr Traub's arguments. The whole point of having a registered PDO is that the rights deriving from it can be protected. As PDOs are protected geographical names, the protection covers the geographical name NAPA VALLEY in its entirety. Hence, I do not accept that NAPA lacks distinctiveness because it is the name of a geographical area including NAPA VALLEY and NAPA COUNTRY and that the most distinctive element of the PDO is VALLEY. I say this for the following reasons:

1. The extract showing the registration on the GB register of NAPA COUNTY as *"American viticultural areas and US spirit names of origin"* was not filed as evidence during the opposition proceedings, and Mr Traub did not ask for leave to introduce that exhibit as evidence; consequently, it is not evidence the

applicant can rely upon. In any event, even if the exhibit was part of the applicant's evidence, the only thing it can show is that NAPA COUNTY is a registered name that can be protected in the UK. There is no evidence that NAPA COUNTY has a reputation in the UK in relation to wines or that it is known by the UK consumers. Further, the mere fact that NAPAÑAC may also evoke NAPA COUNTRY to some consumers does not prevent it evoking NAPA VALLEY too.

2. Mr Simpson, on behalf of the opponent, gave evidence that there are several producers of wines which are sold in the UK under names that include VALLEY, such as Barrosa Valley, Loire Valley, Camel Valley, Hattingley and Bride Valley. Although this evidence does not establish to what extent UK consumers are aware of these brand names, it suggests that denominations consisting of an expression including a word followed by 'valley' are not uncommon in the wine sector. But even without this evidence, it seems to me that Mr Traub's statement that 'Napa wines' are both Napa County wines and Napa Valley wines contains an implied acceptance that NAPA is commonly used in the wine sector to mean NAPA VALLEY wine, a point which is also supported by the opponent's evidence that NAPA VALLEY wines are referred to in the UK press as NAPA wines.[25]

85. Hence, I reject all of the applicant's arguments.

Decision

86. As I observed in my first decision, it is difficult not to agree with the opponent that its evidence (which is unchallenged) clearly indicates that the applicant intends to use the mark NAPAÑAC in relation to a brandy product that is going to be marketed as a new product comparable to a Cognac but made from grapes produced in Napa Valley. In this connection, it is particularly pertinent that the applicant herself referred to the mark NAPAÑAC as a combination of the designations Napa and Cognac. This directly

[25] LJR1

shows, in my view, that the intention has always been that consumers establish a link between the mark NAPAÑAC and the protected names Cognac and Napa Valley.

87. As it will be recalled, the case law that I have set out above tells me that the intention on the part of an applicant is relevant. However, that is not the only factor I need to consider, the other factors being the similarity of the goods, the similarity of the signs and their reputation.

88. Before turning to these factors, I will briefly comment on the evidence filed by the parties about the likely reaction of the UK average consumers.

The likely reaction of the average consumer

89. As I observed in my first decision, both parties filed evidence about the likely reaction of the average consumer to the trade mark NAPAÑAC. The individuals giving the evidence are not expert witnesses. They do not refer to any special features of the spirit and wine market of which I might otherwise be ignorant, and which may be relevant to the question of whether the contested mark will evoke the protected designations. Further, most of the opinion evidence which has been provided refers to different tests, including the likelihood of confusion, and the likely damage to reputation, which are not relevant here. What is required is that the protected designation is evoked. I will therefore give no weight to that evidence.

90. I now turn to the crux of the matter, which is whether there is evocation of the PDO and PGI.

Similarity of the goods

91. I repeat below my findings in relation to the similarity of the goods, as set out in my fist decision (which apply equally to this case):

Cognac

"The goods applied for under the contested application are *Brandy; Fortified wines; Spirits.* Cognac is a type of brandy which is a strong alcoholic spirit distilled from wine. As the term *spirits* in the contested specification notionally include brandy, *Brandy* and *Spirits* in the application are both identical to the goods protected by the PGI Cognac.

The opponent also claims that *Fortified wines* are identical to Cognac. [Cambridge][26] online dictionary defines *Fortified wines* as *"a wine that contains more alcohol than wines usually do"* referring to sherry and Martini as examples of fortified wines. Whilst the goods are not identical, I consider that fortified wines are similar to a medium to high degree to Cognac as they are both strong alcoholic drinks made from, or consisting of, wine. The goods target the same users, have the same purpose and methods of use and are sold in close proximity to each other in supermarkets. However, they are not complementary and any degree of competition which might exist between the goods is limited to the fact that consumers can chose an alcoholic wine-based drink over another.

Napa Valley

The goods protected by the PDO *Napa Valley* are wines at large. Since Fortified wines are wines with a higher percentage of alcohol than usual, I find that they are identical to Napa Valley wines (which are unlimited and cover fortified wines). Applying the same reasoning I have adopted above, and bearing in mind that wines have a lower percentage of alcohol than brandy and spirits, I find that the contested *Brandy* and *Spirits* are similar to a medium degree to *Napa Valley* wines."

[26] The correct reference is to the Cambridge online dictionary – the previous decision refers to Collins. The definition of fortified wine from https://dictionary.cambridge.org/dictionary/english/fortified-wine is "a wine that contains more alcohol than wines usually do: Sherry and Martini are fortified wines". The definition from https://www.collinsdictionary.com/dictionary/english/fortified-wine is "in British English - wine treated by the addition of brandy or alcohol, such as port, marsala, and sherry"

Similarity of the signs

92. I repeat below my findings in relation to the similarity of the signs, as set out in my first decision (which apply equally to this case):

> *"Napa Valley*
>
> Visually and aurally, the signs NAPA VALLEY and NAPAÑAC consist of two words and one word respectively and are made up of ten and seven letters respectively. The signs coincide in the first four letters which are clearly identifiable at the beginning of the mark. The word NAPA corresponds to a geographical location in the USA and is the main identifier of such location and the most distinctive element of the designation. The word VALLEY, although is part of the geographical name, will be perceived by the UK consumer as descriptive, indicating a characteristic of the geographical area, i.e. that is a low area of land between hills or mountains, and will have less weight in the overall impression. The signs differ in the less distinctive element VALLEY in the protected PDO and in the last three letters ÑAC in the contested mark. In my view the signs are visually and aurally similar to a high degree."

93. Further, in this case Mr Traub accepted that there is some conceptual similarity on account of the coinciding element Napa, which is a is a geographical indicator. Although Mr Traub argued that this element is descriptive of a geographical location and that it cannot give rise to any right under NAPA VALLEY as a whole, I have already rejected these arguments. In any event, as I have noted in my first decision the question of the conceptual similarity is essentially in this case a question of evocation.

94. As regards to Cognac I said:[27]

> *"Cognac*

[27] In my first decision I have dealt with the applicant's evidence about the likely pronunciation of the element ÑAC. Copy of that evidence was filed in these proceedings as an attachment to Mr Traub's witness statement, however, as I said in my first decision, I did not find that evidence particularly helpful in deciding what will be the likely pronunciation of the UK average consumer.

Visually, the signs COGNAC and NAPAÑAC are made up of six and seven letters respectively so they are of similar in length and coincide in the last three letters NAC/ÑAC. However, the initial part of the signs is different, i.e. COG versus NAPA and the tilde on the letter N has no counterpart in COGNAC. Overall, the signs are similar to a low to medium degree.

Aurally, COGNAC will be pronounced by UK consumers as KONYAK. NAPAÑAC will be pronounced by most average consumer as NAPA-NNAK, the tilde attracting some emphasis on the letter N, whilst some consumers might use the Spanish pronunciation NAPANYAK - this would be, in my view, the British version of the Spanish pronunciation given that the English language does not use the 'GN' sound. In the first scenario, the signs are aurally similar to a low to medium degree, in the second one the aural similarity is increased to a medium degree.

In this case, I am not convinced that the conceptual similarity or dissimilarity between the signs adds much to the question of whether the contested sign evokes the PGI COGNAC. This is because to the extent that NAPAÑAC is an invented word and COGNAC designates a PGI, the only conceptual proximity between the sign depends on whether NAPAÑAC evokes COGNAC in the sense that the average consumer will link the suffix ÑAC to COGNAC".

The average consumer

95. As I noted in my first decision, in assessing whether there is an 'evocation' within the meaning of Article 103(2)(b) of Regulation no.1308/2013 and Article 21(2)(b) of Regulation no. 2019/787 I must determine whether, when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product protected by the PGI and/or PDO.[28] In making that assessment I must refer to the perception of an average UK consumer who is reasonably well informed and reasonably observant and circumspect. In the present case, it is necessary to assess

[28] *Viiniverla*, C-75/15, paragraph 25

to what extent the mark NAPAÑAC used in relation to brandy, fortified wines and spirits is capable of evoking the PGI Cognac and the PDO Napa Valley in the mind of the average UK consumers, having regard to the similarities between the signs and the goods at issue.

96. The average consumer in this case who would be any adult over the of 18 who would consider purchasing brandy, spirits or fortified wines for consumption at home, or in a restaurant, café, bar, nightclub or other place of entertainment.

97. As it will be recalled, I have concluded that being that Section 3(4A) is an absolute ground for refusal, the opponent does not have to be owner of an earlier right or the user of a protected name to rely on it, and so the opponent can rely on both the PDO NAPA VALLEY and the PGI COGNAC. The relevant enactments relied on by the opponent as prohibiting the use of the contested mark are Regulation no.1308/2013 (which governs the protection of the PDO Napa Valley) and Regulation no. 2019/787 (which governs the protection of the PGI Cognac). Although the opponent claimed that the contested mark is a hybrid mark and will evoke both designations contemporaneously, it seems to me that for the claim based on evocation to be made out, it is sufficient that one of the designations is evoked in the context of each set of goods.

Evocation

98. Before I proceed any further, I should briefly say that the office's initial acceptance of the contested mark was not a final decision, it has no bearing upon the present opposition proceedings, and I am not bound by it (and the applicant did not argue otherwise).[29] Hence, I shall say no more about it.

Does NAPAÑAC evokes NAPA VALLEY?

99. In my first decision I adopted the view that the opponent's strongest case is in relation to fortified wines because these goods are identical to NAPA VALLEY wines.

[29] This point was not expressly addressed in my first decision, but the applicant did not argue the contrary.

In assessing whether the contested mark evokes the PDO NAPA VALLEY, I adopt the same approach I have adopted in my first decision and I consider the following:

A. That the signs NAPAÑAC and NAPA VALLEY are similar to a high degree;

B. That the signs share a characteristic beginning, and that consumers tend to focus on the beginning of trade marks;[30]

C. That the goods concerned are identical, all being wines. The identity of the goods is an element in support of evocation;

D. That the PDO NAPA VALLEY had a reasonable reputation for high quality wines.

100. Taking all of the above into account, I conclude that use of NAPAÑAC in relation to fortified wines evokes the PDO NAPA VALLEY. In this connection, I bear in mind that whilst fortified wines contain more alcohol than regular wines (which are the core products in relation to which NAPA VALLEY has a reputation), they are still classed as wines and, as such, are sufficiently close to the goods for which NAPA VALLEY have been used to trigger in the mind of the public the image of the PDO, due to the familiarity with the PDO NAPA VALLEY in the particular context of wines.

101. Turning to the other goods, in my first decision I concluded that NAPAÑAC for brandy and spirits will not evoke the PDO NAPA VALLEY because when account is taken of the differences between wines and brandy/spirits the fact that the PDO NAPA VALLEY is not fully reproduced in the trade mark is likely to result in the relevant consumers not establishing a link between brandy and spirits marketed under the trade mark NAPAÑAC and wines protected by the PDO NAPA VALLEY. It is true that in that case Mr Traub argued that the signs were conceptually dissimilar (on the basis that Cognac refers to the region in France, in south-western France, and Napa refers to a geographical region in California), whereas in this case, he accepted that there is a degree of conceptual similarity between the signs insofar as they both convey the

[30] *Parmesan/Parmigiano Reggiano* C-132/05

concept of the geographical location NAPA. However, Mr Traub's concession does not necessarily mean that he accepted that NAPAÑAC would evoke Napa Valley (as opposed to NAPA generally). In those circumstances, I see no reason to reach a different outcome to that I reached in my first decision, and I find that the trade mark NAPAÑAC will *not* evoke the PDO NAPA VALLEY in relation to brandy and spirits.

101. Accordingly, I conclude that the PDO NAPA VALLEY would be evoked by the trade mark NAPAÑAC within the meaning of Article 103(2)(b) of Regulation no. 1308/2013 if used in relation to fortified wines. The opposition under Section 3(4A) is successful to this extent.

Does NAPAÑAC evokes COGNAC?

102. In my first decision I adopted the view that the opponent's strongest case is in relation to brandy and spirits because these goods are either self-evidently, or at least notionally, identical to COGNAC.

103. I remind myself that evocation is not assessed in the same way as likelihood of confusion. As the CJEU has held, there can be 'evocation' even in the absence of any likelihood of confusion. The relevant test is whether, when the average consumer who is reasonably well informed and reasonably observant and circumspect is confronted with the mark NAPAÑAC, the image triggered directly in his mind is that of the product whose PGI COGNAC is protected. There is no requirement for the relevant consumer to be confused.

104. In assessing whether such the contested mark evokes the PGI COGNAC I adopt the same approach I have adopted in my first decision and I consider the following:

A. The signs NAPAÑAC and COGNAC have a low to medium degree of visual similarity. Aurally, most consumers will pronounce the mark as NAPA-NNAK; for those consumers there is a low to medium degree of similarity with the designation COGNAC. For the smaller group of consumers who will use the Spanish pronunciation NAPANYAK there is a medium degree of aural similarity;

B. Although the signs have different beginnings, they share a characteristic ending that has no particular meaning;[31]

C. NAPAÑAC and COGNAC share a similar number of letters, being seven and six letter long respectively;

D. The goods concerned are identical, all being (or notionally including) brandy;

E. Although 'evocation' is objective in the sense that there is no need to show that the owner of the contested mark intended to evoke the earlier PGI, evidence which suggests that the similarity between the two names is not fortuitous is relevant. In this case, the evidence establishes that the name NAPAÑAC was chosen to convey the message that the product was a Cognac-type of product from Napa Valley. Hence, even if the applicant intended to present the product as originating from Napa Valley rather than from the Cognac region of France, the fact that it evoked the idea of a brandy of a similar type to COGNAC, is sufficient to supports the existence of evocation.

105. Taking all of the above into account, I conclude that even in circumstances where the mark is articulated as NAPA-NNAK, the low to medium degree of visual and aural similarity between the signs is offset by the considerations I made at points at B, C, D and E and by the reputation of the PGI COGNAC (which has been admitted), all of which are elements in support of evocation. The contested mark NAPAÑAC for brandy and spirits evokes the PGI COGNAC.

106. However, I consider that that the contested mark NAPAÑAC for fortified wine does not evoke the PGI COGNAC, considering the differences between fortified wines and brandy. In other words, given the differences between fortified wines and brandy (e.g. different characteristics, ingredients and taste) and the fact that the PGI COGNAC is not fully reproduced in the mark NAPAÑAC, the relevant consumers will not establish a link between a bottle of fortified wines marketed under the trade mark NAPAÑAC and the brandy protected by the PGI COGNAC.

[31] See *Gorgonzola/Cambozola* C-87/97 and *Verlados/Calvados* C-75/15, *Viiniverla.*

107. I therefore conclude that the PGI COGNAC would be evoked by the trade mark NAPAÑAC within the meaning of Article 21(2)(b) of Regulation no. 2019/787 if used in relation to brandy and spirits. The opposition under Section 3(4A) is successful to this extent.

OTHER GROUNDS

108. As the opposition has been successful under Section 3(4A) there is no need for me to consider the other grounds in any detail. I shall not say anything other than it appears to me that if I am wrong that the contested mark will evoke the PGI COGNAC and the PDO NAPA VALLEY, the other pleaded grounds cannot succeed. This is because:

(a) the opponent cannot rely on the PGI COGNAC in the context of the remaining relative grounds, namely Sections 5(2)(b), 5(3) and 5(4)(aa);

(b) for the purpose of finding there to be an 'evocation', the courts must determine whether, when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose indication is protected. As the test for finding evocation is less strict than that for finding likelihood of confusion, misrepresentation and damage to goodwill, and damage to reputation, the opposition under Sections 5(2)(b), 5(3) and 5(4)(aa) cannot succeed to any greater extent than that based on Section 3(4A);

(c) the opponent's claim under Section 3(3) is that the trade mark shall not be registered because it is of such a nature as to deceive the public as to the nature, quality or geographical origin of the goods. If I am wrong that the contested mark will evoke the PDO NAPA VALLEY and the PGI COGNAC, I cannot see how it can deceive anyone.

OVERALL CONCLUSION

109. The opposition is successful in its entirety under Section 3(4A) of the Act. The applicant's mark will be refused.

COSTS

110. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award costs to the opponent as follows:

Official fee:	£200
Filing the opposition and considering the Counterstatement:	£500
Filing evidence and considering the applicant's evidence:	£2,000
Preparing for and attending a hearing	£800
Total:	£3,500

111. I therefore order Lindsay Hoopes to pay Napa Valley Vintners the sum of £3,500. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of the proceedings if any appeal against this decision is unsuccessful.

Dated this 9th day of April 2024

Teresa Perks
For the Registrar