TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 2147650 BY HALEWOOD INTERNATIONAL LIMITED TO REGISTER A MARK IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO UNDER No. 49031 BY GRUPPO ITALIANO VINI S.C.A.R.L.

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DECISION

On 9 October 1997 Halewood International Limited applied to register the series of three marks shown in the Annex to this decision for perry in Class 33. I will for convenience call it the LAMBRINI mark. For the sake of completeness I should record that the application was published in the Trade Marks Journal with the following clause:

> "The marks consists of a 3 dimensional shape with the words/devices appearing on them. The applicant claims the colours yellow, gold, orange, brown, red, blue, green, white and black, as shown on the form of representation, as elements of the second and third marks in the series."

The application is numbered 2147650.

On 24 September 1998 Gruppo Italiano Vini S.C.A.R.L. filed notice of opposition to this application citing grounds based on Section 3(6), 5(2)(b), 5(3) and 5(4) of the Act. In support of this they refer to the following earlier trade marks:

No.	Mark	Class	Journal	Specification
1057091	LAMBERTI	33	5180/2503	Wines, but not including fortified wines
1106149		33	5394/227	Valpolicella wines

The applicants filed a counterstatement denying the above grounds.

Both sides ask for an award of costs in their favour.

Only the opponents filed evidence. The parties were offered an opportunity to be heard. Neither side asked for a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

The opponents filed statutory declarations by Gian Alfonso Negretti and Jan Montagu Vleck. Sr. Negretti is the opponents' Commercial Director. He gives evidence as to his company's trade in the UK.

Briefly his evidence shows that:

- the company sells wines to the multiple retailer, Majestic Wine Warehouse and a company called Mondial Wine Ltd
- turnover has increased steadily from £414,000 in 1993 to just over £1 million in 1997.
- modest sums have been spent on promoting wines sold under the mark and they have been advertised in magazines such as Harpers and Decanter
- the LAMBERTI range of wines have been displayed at "The Restaurant Show" in the years 1996 to 1998. Price lists are sent to over 1000 restaurants every year

Exhibits GAN 1 to 5 are provided in support of the above. The remainder of his declaration is in the nature of submissions.

Mr Vleck is a registered Trade Mark Attorney. He exhibits details of the opponents' registrations. I should say in passing that registration No. 1106149 is currently shown as expired but at the time of writing this decision continues to be taken into account under the provisions of Section 6(3). The currency or otherwise of this registration is not, however, critical to the opponents' case as their other registration, No. 1057091, is for the word LAMBERTI solus and offers them their best chance of success.

Section 5(2) appears to be the main ground of attack. The section reads as follows:

"5.-(2) A trade mark shall not be registered if because -

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

identical with or similar to those for which the earlier trade mark is protected,

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

As identical marks are not involved sub paragraph (b) applies here.

I take into account the guidance provided by the European Court of Justice in Sabel BV v Puma AG (1998 RPC 199 at 224), Canon v MGM (1999 RPC 117) and Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BC (1999 ETMR 690 at 698).

It is clear from these cases that:-

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

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

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

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components;

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

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

(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

(h) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section.

The applicants' specification indicates that the goods of interest are perry. My understanding is that perry is a wine made from pears. The specification of the opponents' registration No. 1057091 is 'wine but not including fortified wines'. Allowing for the full notional breadth of

that specification I take the view that it covers perry. On that basis identical goods are involved and the matter, therefore, turns on the marks themselves.

The above guidance requires me to consider the inherent characteristics of the opponents' earlier trade mark and the extent to which its distinctive character may have been enhanced through use. In the absence of evidence to the contrary I take LAMBERTI to be an invented word. The sales figures referred to in the evidence summary relate to retail values. Unit sales range from 53,500 bottles in 1993 to 120,000 bottles in 1997 suggesting an approximate retail price of £8 per bottle. No information is given as to the size of the UK market for wine or the types of wine sold by the opponents. I am unable, therefore, to gauge the likely impact of their mark on the market. Clearly the opponents' trade is not of negligible proportions but equally I am not prepared to conclude on the basis of the evidence before me that the mark LAMBERTI has more than a modest amount of reputation. I note also that (in contrast to the notional coverage of their specification) the opponents' use has been in relation to grape wines.

Turning to the marks the applicants' mark is not simply the word LAMBRINI. It is a bottle with the words and device appearing thereon and certain colour combinations in the second and third marks in the series. The opponents rightly say that the shape itself is in common use for wine bottles. The device element is indistinct but appears to include buildings. Whilst the device must not be ignored I find that the word LAMBRINI is the most distinctive and dominant component of the mark. It is likely to be the element by which the applicants' goods are purchased.

Both LAMBRINI and LAMBERTI are, it would seem, invented words. Visually they are of equal length and, self evidently, have the first four letters in common. They also consist of three syllables. The terminations of the words are different but the presence of the concluding letter 'I' will strike many people in this country as indicating that both are Italian words (or at least not a frequently encountered English ending). Aurally the words can be distinguished but the common first element and terminal 'I' are likely to leave an impression. Conceptually they appear to share nothing apart from the fact that they are invented. But equally they would not be distinguished in the way that dictionary words with similar appearances but different meanings would be. The visual characteristics of the marks are, therefore, particularly important. I bear in mind also that, although wines are generally purchased with a modicum of care, due allowance must also be made for imperfect recollection.

Taking the above factors into account I consider that there is a likelihood of confusion and the opposition succeeds under Section 5(2).

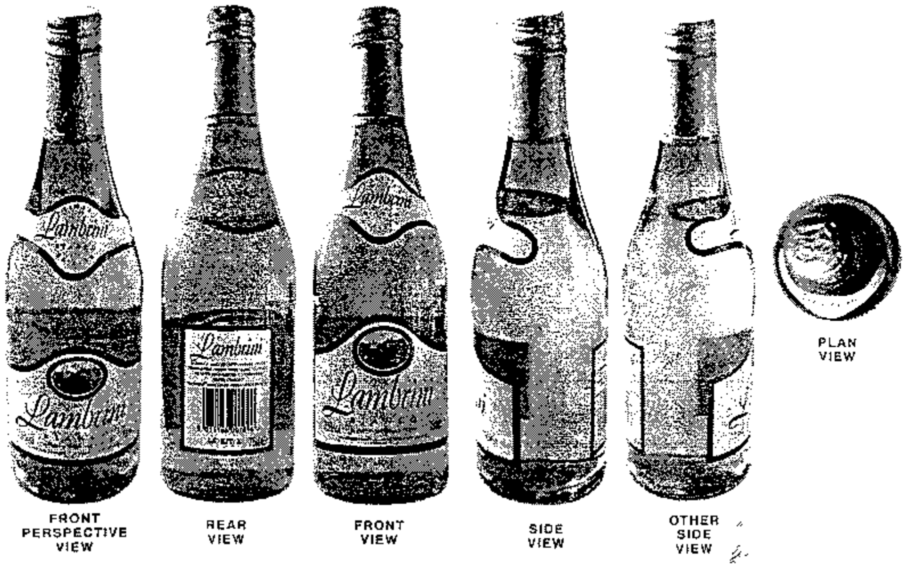
On the basis of this finding I do not propose to give detailed consideration to the other grounds of opposition. The Section 3(6) and 5(3) grounds have not been explained and must, I think, fail. The opponents' position under Section 5(4) (assuming it to be based on the law of passing off) is unlikely to be any better than under Section 5(2) and arguably worse given that the opponents' use and goodwill relates to grape wines whilst the applicant's goods are perry and there is no evidence pointing to a link between what are prima facie rather different areas of the wine trade.

As the opponents have been successful they are entitled to a contribution towards their costs. I order the applicants to pay them the sum of £535. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21 day of November 2000

M REYNOLDS
For the Registrar
the Comptroller-General

ANNEX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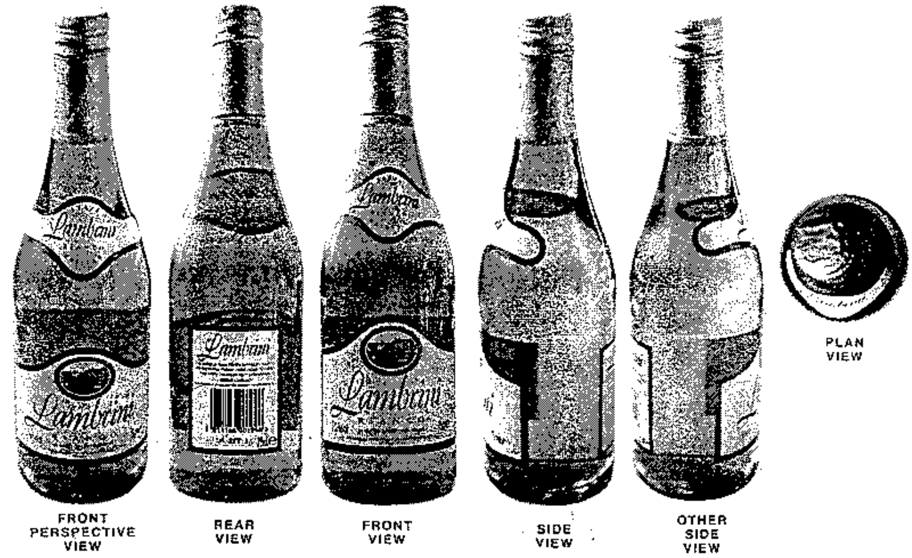
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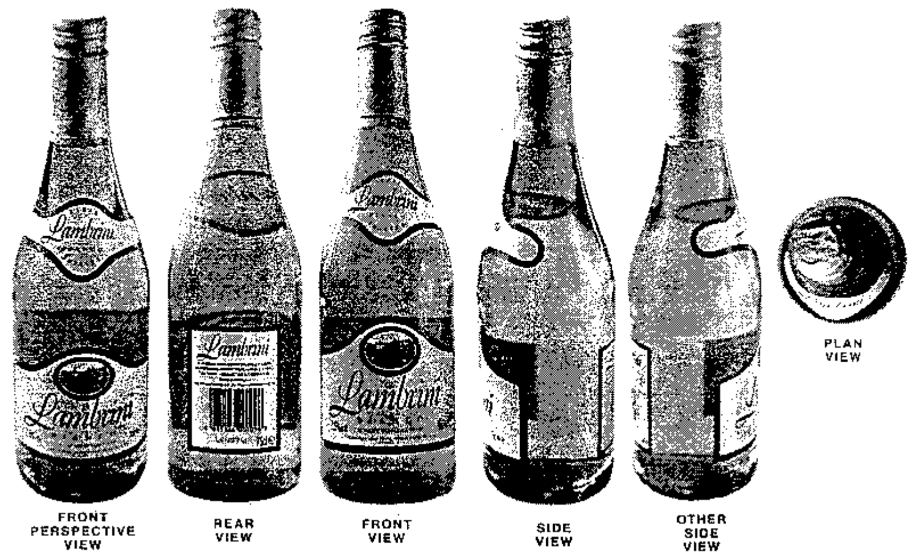
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