

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2029556  
BY CANTINE MEZZACORONA SCARL  
TO REGISTER A TRADE MARK IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 46049  
BY MIGUEL TORRES S.A.

## BACKGROUND

1) On 7 August 1995, Cantine Mezzacorona SCARL of Via 4 Novembre 127, 38016 Mezzacorona, Trento, Italy applied under the Trade Marks Act 1994 for registration of the following mark



The Italian words appearing in the mark mean “Half Crown”.

- 2) In respect of: “Wines, spirits and liqueurs” in Class 33.
- 3) An International Priority date of 21 July 1995 was claimed due to a registration in Italy.
- 3) On the 6 December 1996 Miguel Torres S.A. of Comercio 22, 08720 Vilafranca del Penedes, Barcelona, Spain filed notice of opposition to the application, subsequently amended. The amended grounds of opposition, are in summary:
  - a) The opponent is the proprietor of two registered trade marks detailed at Annex A. The opponent also claims unregistered rights for the mark CORONAS by virtue of long and substantial use of the trade marks CORONAS, GRAN CORONAS and GRAN CORONAS Mas La Plana
  - b) The mark applied for therefore offends against Sections 3(6), 5(2), & 5(4) of the Trade Marks Act 1994.
  - c) The opponent is also aware of other earlier registrations, detailed at Annex B, for which the opponent is not the proprietor but which are similar to the mark in suit. Registration of the mark in suit would offend against Section 5(2).
  - d) The opponent also claims that the mark applied for offends against Sections 1(1) and 3(1) as it is not capable of distinguishing the goods of the applicant.

e) Further, that the mark incorporates the word “Mezzacorona” which is very similar both phonetically and verbally to the name “Mezzocorona” a town in Italy noted for wine making and therefore offends against Section 3(3) of the Act as the mark in suit will deceive the public as to the geographical origin of the goods. In incorporating a word which is indistinguishable from the town name of MEZZOCORONA the mark also offends against the Act by Council Regulation (EEC) No. 2392 / 89 of 24 July 1989 and therefore Section 3(4) of the Act

4) The applicant subsequently filed a counterstatement denying the opponent’s claims.

5) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. The matter came to be heard on 17 August 2001 when the applicant was represented by Mr Tritton of Counsel instructed by Messrs Murgitroyds, and the opponent by Mrs Heal of Counsel instructed by Messrs Raworth Moss & Cook.

#### OPPONENT’S EVIDENCE

6) The opponent filed two declarations. The first, dated 22 July 1997, is by Angel De La Rubia Perez the Manager of Miguel Torres S. A. a position he has held since June 1989. Senor Perez confirms that he is fully conversant with the English language.

7) The opponent company produces wines, spirits and liqueurs in Spain, Chile and California. The company exports to over eighty countries and is claimed to be the 12<sup>th</sup> largest producer and exporter of Spanish wines. At exhibit ARP-01 Senor Perez provides a booklet and leaflet produced by his company which shows a number of different labels used by the company. He states that :

“Each bottle produced and sold bears a distinctive label with the word Torres and/ or the name Miguel Torres, as well as my company’s three-tower device which is registered in the UK under registration No. 1134608. Some of the labels also bear distinctive “crowns”- in particular bottles bearing the marks CORONAS and GRAN CORONAS.”

“I am now produced and shown exhibit ARP-02 which consists of a number of labels from bottles produced by my company. It will be observed that most bear the distinctive graphical gold “crown” logos referred to in the latter part of paragraph 5 above, whereas all also contain the word Torres. My company has used these specific marks over a large number of years as a means of establishing a particular identity, a reputation, and as a means of letting my company’s customers know the origin of wines, spirits and liqueurs.”

8) The Spanish wines all have the word TORRES prominently printed at the top of the bottle label. Underneath in much smaller print are the other identifiers such as Coronas, Gran Coronas and Gran Coronas Mas La Plana. The Chilean wines are all labelled with MIGUEL TORRES in large print. Whilst the Californian wines bear the name MARIMAR TORRES. Most have the device of three towers whilst two also have three crowns. These two labels are the “Coronas” and “Gran Coronas” labels. The label for “Gran Coronas Mas La Plana” has the three towers device but not the crowns.

9) Senor Perez provides a list of twenty-one UK trade mark registrations owned by his company. These include inter alia Torres (with and without devices), Tres Torres, Miguel Torres, Torres Milmanda, Don Miguel, Sangredetoro, Vina Sol, Old Tower, De Casta, Fontenec, Vina Brava, San Valentin & Mas Borrás.

10) Senor Perez provides sales figures under all of these marks. He also provides sales figures in the UK for goods bearing the mark Coronas in its various forms. These are as follows:

Mark	1991	1992	1993	1994	1995	1996
Coronas	£1,120	£1,728	£356	£806	£8,702	£4,964
Coronas	£143,949	£121,340	£254,756	£32,581	£193,754	£273,552
Gran Coronas	£88,651	£70,023	£337,262	£294	£589	£361
Gran Coronas	-	-	-	£49,343	£181,140	£142,293
Gran Coronas Mas La Plana	£47,143	£88,239	£21,517	£8,585	£48,871	£57,328

11) Senor Perez does not explain why there are two entries for the “Coronas” and “Gran Coronas” marks. He does explain that local agents in each country where the products are sold are responsible for marketing although his company provides some materials to the agents.

12) At exhibit ARP-03 Senor Perez provides a copy of a wine list (dated 1997) produced by the wine distribution company G Belloni & Co Ltd based in London. The applicant’s wine is listed at page 5 under the region called “Trentino Alto Adige”. It states “Mezzacorona is located in the Adige valley in the Dolomite mountains”. At exhibit ARP-04 is a single page said to be from the same company listing but dated from 1995. This is in the same format as exhibit ARP-03 but the trade mark is shown as two words “Mezza Corona” and the description shows the same split “Mezza Corona is located in the Adige valley .....” . In both documents the initial sentence tends to refer to the producer of the wines. The entry underneath is an example. It is headed “MASI AGRICOLA, Verona”. The description then begins “Masi has played an important role in the resurgence and improved reputation of Veronese wines.”

13) At exhibit ARP-05 Senor Perez provides copies of the applicant’s labels which shows the name MEZZACORONA printed between two lines. The letters M and C are in larger type and the letter C is printed across the bottom line. Senor Perez states that this shows the mark is being used in the form of two words.

14) Senor Perez expresses his concerns that the public will confuse the products of the two parties due to the presence of the word Coronas in the mark in suit and also because both sides use crowns on their labels. He states that in the UK most wine sold in retail outlets is

displayed on shelves. The proximity of the goods of both parties will lead, he believes, to confusion, particularly as only part of the label may be visible.

15) Senor Perez also voices his concern over the geographical origin of the applicant's wine. He states that Mezzocorona is a town in Trentino region in Northern Italy which has a reputation for the production of wines. He accepts that "Mezzocorona is not officially recognised as a geographical name (Vino do Tavola con indicazione geografica)". He also mentions the existence of a local co-operative in the region but this appears irrelevant.

16) The second declaration, dated 12 August 1997, is by William Briston the Marketing Director of John E Fells & Sons Ltd, a position he has held for seven years. His company acts as the UK distribution agent for the opponent company. He states that:

"Whilst knowledgeable wine purchasers may not confuse wines originating from our producers with an Italian wine, non-discerning members of the public might buy the goods originating from our producers by simply identifying them as a "CORONAS" wine. It is therefore possible that members of the public will be confused as to whether a "CORONAS" wine, which can often be pronounced "CORONA", is a MEZZACORONA wine or one originating from our producers."

17) Mr Briston also refers to the possibility of the labels on bottles being obscured on a shelf, leading to confusion.

#### APPLICANT'S EVIDENCE

18) The applicant has filed six declarations. The first, dated 11 March 1998, is by Eileen Anne Millar who is the Stevenson Professor of Italian at Glasgow University a post she has held since 1992, having been a lecturer in Italian since 1968.

19) Ms Millar states that she has been asked to provide her views on the confusability between the marks of the two parties. She states that the words would be pronounced differently and that they have different meanings, the applicant's mark meaning "half crown" which she recognises as a coin, the opponent's mark meaning "crown".

20) The next declaration, dated 11 March 1998, is by Harry Brian Crook the Managing Director of The Vintage Malt Whisky Company Limited a position he has held since 1992. He provides his opinion that the marks are not confusable.

21) The next declaration, dated 11 March 1998, is by Pierpaolo A M E Pacitti an employee of the applicant's Trade Mark Attorney. He states that the marks each has a meaning the applicant's being "half crown" and the opponent's "crown". He too claims that he would not be confused between the two marks.

22) The next declaration, dated 24 February 1998, is by William Laurence Page the Managing Director of Ehrmanns Group Plc a company involved in the wine trade. Mr Page states that his company is the distributor of the applicant's products and that he is unaware of any instances of confusion with the opponent's products. He also provides his views on the confusability of the marks.

23) The next declaration, dated 4 March 1998, is by Stefano Fambri an executive of the applicant company. He has been employed by the applicant company since 1993. He states that the mark has been used in the UK since 1988 in relation to Italian wines, and that sales have been made throughout the UK. An attached brochure in English bottles of wine, with vintages between 1991-1994, under the mark in suit can be seen. The brochure would appear to be aimed at the UK rather than the USA as the word “colour” is spelt correctly.

24) The last declaration, dated 4 March 1998, is by Guido Conci the President of the applicant company. Signor Conci states that as a result of various mergers the company needed a common name and trade mark that would be representative of all the wine growers. Thus in 1983 the name MezzaCorona was adopted.

25) He states:

“The province is located in the heart of the Italian Alps (see enclosure No1); an area renowned [sic] for the production of quality wines, and with a tradition of vine growth that dates back to 700 AC (within our cellars archeological remains were found of a Roman farm from 200 BC, including wine making utensils, grape-stones, and coins which are a testimony of the wine-making tradition in our area) (see enclosure No2).”

26) Enclosure number 1 show details of the “Trentino” area. Enclosure number two is in Italian.

27) Sr. Conci continues:

“The choice of the name “Cantine MezzaCorona” was not only logical but also extremely representative of the historical reality of our company. The origin of the name is obviously strictly derived from, and related to, the company’s geographical location and the associated growers vineyards. The village - Mezzacorona, is situated in the Piana Rotaliana in the province of Trento and is populated by approximately 5,000 inhabitants. During the period between 1889 and 1918 this territory was governed by the Austrian Empire and was called Mezzacorona; in fact the name Mezzacorona appears in all documents from that period (particularly in the Municipalities of Mezzacorona and Trento).”

28) Sr. Conci states that the mark has been used since 1983 and has been registered in many countries including Italy. He states that exports to the UK began in 1988 utilizing the trade mark Cantine Mezzacorona. A number of enclosures are provided which show evidence of use of the mark Cantine Mezzacorona. These include at enclosure 10 an advertisement showing bottles of wine with the mark in suit in the “Wine & Spirit International” magazine dated April 1989. Also at enclosure 11 an article from Italian Wines & Spirits dated May 1991 states that approximately 6% of the applicant’s production is exported to the UK. There is also an article from *Decanter* magazine dated May 1991 which describes both the history and wines produced by the applicant company.

#### OPPONENT’S EVIDENCE IN REPLY

29) The opponent filed a declaration, dated 13 November 1998, by Luis De Javier the Manager

of the Legal Dept of the opponent company, a post he has held since 1991. Senor Javier confirms that he is fully conversant with the English language.

30) Senor Javier points out that the applicant's evidence does not show use of the mark in suit. He also claims that the applicant's registrations in Spain and the United States have been refused on appeal and that his company have opposed registrations in most of the other countries mentioned. He also claims:

"8. As a result of my careful studies of EEC regulations governing the labelling of wines and the protection of established trade marks in the EEC, I have concluded that the name MEZZACORONA may not, within the European Union, be used as a trade mark to identify products of Class 33 of the International Classification System.

9. The trade mark MEZZACORONA in the UK is intended to be registered by the company Cantina Sociale MEZZACORONA whose registered office is in the town of MEZZOCORONA in the region of Trentino in Italy. By a decree of the President of the Italian Republic dated 12 February 1985, the "Denominazione de Origine Controllata dei Vini - Tretino" was founded. Therefore all the wines that bear the name "D.O.Trentino" on their label are subject to the requirements of the above-mentioned Decree and also to the extensive European Union regulations governing the viticultural sector, that begins with the R.(EEC) No 822 /87 of the Council by which the Common Organisation of the Viticultural Market is established, and includes Regulations such as 2393 /89 and 3201/90, now produced and shown to me marked LDJ1 and LDJ2 respectively

10. As well as the Decree of the founding of the Trentino Appellation of Origin, Regulation (EEC) No 2392 /89 of the Council, dated 24 July 1989, also applies under which the general rules were established for the naming and presenting of wines and grape musts. Article 3 of the Decree of the President of the Italian Republic, founder of the Trentino Appellation of Origin includes, amongst the villages of the production area of the referenced Appellation, the commune of MEZZOCORONA. The effects of the inclusion of this commune within the production area of the Trentino Appellation of Origin are established in the above -mentioned Regulation (EEC) No 2392 / 89 Article 11.2.1) under the general title of the naming of the Quality Wines Produced in a Specific Region - referred to hereinafter as "qwpsr" - states that:

Art 11

2. For the qwpsr, it will be possible to complete the naming of the label by stating:

(1) the name of the geographical unit which is smaller than the specified region, in accordance with the conditions laid down in Art.13.

Art 13 defines what is to be understood by "smaller geographic unit". In this way, the said article perceives that

Art13,1. To name a qwpsr on the label, it shall be understood by the name of "geographical unit smaller than the specified region," mentioned programme (1) of section 2 of Article 11, the name of:

- a small locality or group of localities.

A copy of the Decree with translations of relevant parts of Articles 3 and 11 is now produced and shown to me marked LJD3.”

31) Senor Javier states that the consequence of the above is that in order to use the name of a small locality on the labelling of a qwpsr it is necessary to obtain permission and also to only use grapes from the locality in question. Thus to use the word MEZZOCORONA all the grapes used in the production of wines must originate from the commune of Mezzocorona.

32) In the United States the opponent’s objection to the mark in suit was upheld. In this case the applicant acknowledged that not all the grapes used to produce the applicant’s wines come from the town of Mezzocorona. A copy of the relevant pages from this deposition are provided at exhibit LDJ5. Senor Javier states that difference between the mark in suit and the name of the town is so small that confusion is inevitable and the regulations regarding the labelling of wine were drawn up in order to avoid confusing the consumer.

#### APPLICANT’S EVIDENCE IN REPLY

33) The applicant filed another three declarations. The first by Pierpaolo A M Pacitti, who provided an earlier declaration, is dated 18 February 2000. He refutes the opinions expressed in Senor Javier’s declaration regarding the regulations on labelling of wine. Mr Pacitti states that he is fully conversant with both the English and Italian languages. He refers to a number of documents which are in Italian, exhibits PAMP1-4. Specifically he states:

a) The decree by the President of the Italian Republic referred to by Senor Javier makes mention of the commune of Mezzocorona only in relation to it being one source of grapes for the production of wines which can use the Denomination of Origin (DOC) “Trentino”.

b) EEC regulation 823/87 states at Article 18 at P13/14 that imposition by individual member States of more strict standards on a DOC is discretionary.

c) Italian State Law number 164 states that a denomination of a sub-zone must be expressly mentioned in a positive list or exhaustive list for the avoidance of doubt of the consumer. The exhaustive Italian list of DOC’s does not include Mezzocorona.

d) The applicant is not seeking to register a mark which comprises a DOC.

34) The second is by Armando Botteon who describes himself as an Italian citizen, journalist and consultant. He is the author of “Codice di Legislation Vinicola” (Wine Legislation), “Codice dei VQPRD” (Quality Wines Produced in Determined Regions) and other publications. He is also the head of a monthly magazine entitled “Legislazione Vinicola e delle Bevande” (Wine and Beverages Legislation), in which he says he often writes as an expert on wine and foodstuffs legislation. He provides his opinion on Italian law in relation to DOC’s which briefly summarised are:

1) As far as Italy is concerned, the name of a sub-zone is protected only if the sub-zone

is positively listed in Italian D.O.C. listings;

2) There are 313 recognised regulations of D.O.C. or D.O.C.G. wines in Italy, which safeguard 104 names of listed and more strictly regulated sub-zones;

3) Mezzocorona is not listed;

4) It is unlikely that there would be a single consumer outside Italy (and perhaps in Italy except in the Trento region) who would be aware that among the 8102 communes in Italy, there is one called Mezzocorona.

35) The third declaration, dated 8 November 2000, Alberto Antonio Pacitti. He states that he is qualified to translate documents from the Italian language into the English language. At exhibits AAP1 - 4 he provides translations of exhibits PAMP1-4 of Pierpaolo A M Pacitti.

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

## DECISION

37) Mrs Heal raised as a preliminary point the admissibility of certain parts of the applicant's evidence. Although this was not dealt with in her skeleton submission she sought to have the exhibits PAMP 1-4 attached to the declaration of Pierpaolo A M Pacitti and his views upon these exhibits struck out as the exhibits are in Italian and Mr Pacitti is the agent for the applicant. She also requested that the evidence of Alberto Antonio Pacitti be struck out as it consisted of translations of the exhibits PAMP 1-4 but the declarant is not a certified translator. However, towards the end of the hearing Mrs Heal withdrew these requests.

38) The first ground of opposition is under Section 5(2)(b) of the Act which states:-

*5.- (2) A trade mark shall not be registered if because -  
(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier mark is protected,*

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

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

*6.- (1) In this Act an 'earlier trade mark' means -*

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

*(b)...*

*(c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of*



*the application, was entitled to protection under the Paris Convention as a well known trade mark.”*

40) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel Bv v Puma AG* [1998 RPC 199], *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 723. It is clear from these cases that: -

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel Bv v Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer, of the goods / services in question; *Sabel Bv v Puma AG* page 224, 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; *Lloyd Schfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel Bv v Puma AG* page 224;
- (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; *Sabel Bv v Puma AG* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 7 paragraph 17;
- (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; *Sabel Bv v Puma AG* page 8, paragraph 24;
- (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); *Sabel Bv v Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG* page 732, paragraph 41;
- (i) 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; *Canon Kabushiki Kaisha v Metro-Goldwyn-Meyer Inc.* page 9, paragraph 29.

41) As is clear from the Annex to this decision the opponents are relying on two of their own registrations, and three belonging to other proprietors. One of the opponent's marks is TORRES CORONAS with device elements, the other the word CORONAS alone. The three

marks of other proprietors all have device elements, two have the word EXTRA and all have the word CORONA in them. At the hearing Mrs Heal relied only upon the marks of the opponent, presumably because two of the marks registered to other proprietors for goods similar to the applicant's specification, disclaim the word "CORONA", whilst the other mark is for services in class 42. In my view the opponent's strongest case is registration B1425412 (CORONAS), although I will also consider their other registered mark 891250 (TORRES CORONAS and devices).

42) When comparing the mark in suit to CORONAS, visually they both include the word CORONA but are quite different in their overall length and appearance. These differences far outweigh the commonality. Aurally the words are quite different and unlikely to be confused. The opponents' mark consists of three syllables whilst the applicants' mark has five syllables. It is accepted that the beginnings of words are more important for the purpose of distinction (see Tripcastroid [1925] RPC 264), and even allowing for the notion of imperfect recollection I do not consider there is a likelihood of the two marks being confused aurally. The opponent's mark apparently means "crown" whereas the mark in suit means "half a crown". However, I doubt that either signification would be apparent to the average UK consumer.

43) When considering the opponent's TORRES CORONAS mark to the mark in suit, again it is clear that they have the word CORONA in common. The marks are of similar length and both have five syllables. What is significant is the differences in the last first two syllables of the two marks. They are totally different and in my view far outweigh any similarities. Aurally the marks have completely different beginnings, share similar endings albeit the opponent's mark in a plural form of the word CORONA. Again, the beginnings of marks being more important there is, in my view, no likelihood of them being confused aurally. Neither has a conceptual meaning apparent to the average UK consumer. I must also take into account that the word "CORONAS" has been disclaimed in the opponent's registration.

44) It has also been suggested that confusion will arise from the proximity of the goods of each party on shelves in retail outlets, and also that when placed on said shelves the labels will be partly obscured. Whilst the goods may be in close proximity, I do not agree with the contention that the labels would be obscured and so confuse customers. Bottles of wine are not, I would suggest, chosen without some consideration. The average consumer of such products would, in my opinion, exercise some care in the selection. Even so allowance must be made for the notion of imperfect recollection

45) Mrs Heal also referred to the use by the applicant of a crown device, similar to that of the opponent. However, given that the mark in suit shows half a crown or coronet whilst the opponent's mark 891250 has three crowns, three towers and a pair of crossed palm leaves I do not accept that this adds to the likelihood of confusion, especially given the dictum that words speak louder than devices. It was also claimed that the "C" in the mark in suit has been enlarged and printed in such a way as to draw attention to it and break the mark into two words, thereby emphasising the word CORONA. I do not accept this view. The mark in suit starts with a large "M" and ends with a large "A". If anything is made of this by the general public it would be to pick out the letters "MCA". However, I do not believe that the average consumer will take much note of the use of these letters in larger print. The average consumer will still see the word element as MEZZACORONA (one word).

46) At the hearing Mrs Heal also submitted that:

“It is tempting in these cases to assume that the trader applying for a mark like MEZZACORONA will use the stylisation in their mark forever and a day. The application is for a stylised device, but it is quite clear that in 1965 Torres applied for a label and thereafter was able through evidence of use to apply for the mark on its own, and there is no reason to believe that MEZZACORONA may not try to do the same. They have already changed the get-up of their label, even though they say it was only thought of in the mid 1990's, and they have had several label changes since then, so there is, in my submission, a concern that they may make even greater use of indicia used by Torres.”

47) Speculation on the future commercial decisions and behaviour of the applicant is not something which can be taken into account in considering the application currently before the Registry.

48) Clearly the applicant's specification encompasses the goods for which the opponent's marks are registered. For the purposes of the comparison the goods must therefore be regarded as identical.

49) I also have to consider whether the opponent's mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. The opponent has provided sales figures for goods bearing the mark CORONAS in a variety of forms. I also note that the name TORRES appears prominently on all the illustrations of Spanish wines. Similarly Chilean wines have MIGUEL TORRES, whilst Californian wine has MARIMAR TORRES. Even if I disregard the presence of these prominent marks the average sales figures shown for the “family” of CORONAS marks in the four years prior to the relevant date is approximately £315,000 per annum. The opponent has not provided an indication of the total UK market for wine. In such circumstances the opponent's CORONAS marks cannot be regarded as enjoying an above average reputation at the relevant date because of use. However, I must also consider any inherent distinctiveness. On the face of it the mark CORONAS is a distinctive mark per se in the UK, but not exceptionally so.

50) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 7 August 1995. Consequently, the opposition under Section 5(2)(b) fails.

51) I next consider the ground of opposition under Section 5(4) which reads:

*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*

(b) *.....*

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

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

52) It is claimed that the public would be confused as to the source of the applicant's goods believing them to originate from the opponent. The opponent states that their products are well-known in the UK under the CORONAS names. However, the evidence provided does not substantiate this claim. The opponent's sales in the four years prior to the application were approximately £315,000 per annum. Although no evidence has been provided as to the total size of the market for wines in the UK it would clearly run in many millions.

53) The opponent also contended that they had a "family" of CORONAS marks which enhanced their goodwill beyond that enjoyed by any single mark. Whether or not the CORONAS marks are "well known", there is no doubt that the scale of the opponent's use would have resulted in a common law right protecting the goodwill in their trade in wines under the names TORRES CORONAS or TORRES GRAN CORONAS. The opponent contends that MEZZACORONA will be seen as another member of the same "stable", that is from the same producer. However, that seems very unlikely because:

a) Although GRAN CORONAS could be seen (because of the resemblance of GRAN to "GRAND") to designate a superior CORONAS wine, MEZZA has no similar connotation;

b) The second word in the opponent's marks is CORONAS whereas the applicant's mark (which is a single word) ends CORONA;

c) Consumers aware of the CORONAS and GRAN CORONAS marks would be aware that they are generally used with the house name TORRES rather than the coin device in the applicant's mark.

54) For the applicant Mr Tritton contended that confusion would also be unlikely to occur as the opponent's wines were Spanish whereas the applicant's wines were Italian. I reject this contention. Although the opponent's specifications are for Spanish wines there is no such limitation upon the applicant to use the mark only on Italian wine.

55) I have already compared the two marks and found the opponent's marks CORONAS and TORRES CORONAS are not similar to the applicant's mark MEZZACORONA. In my view the lack of similarity will prevent the public believing that the products of the applicant originate from the opponent. The opposition under Section 5(4) therefore fails.

56) In case I am wrong about the above, I should also note that the applicant raises a degree of antecedent use and rights in the name MEZZACORONA in the UK going back to 1988 (as opposed to the opponent's first use in 1991). Both Signor Fambri and Signor Conci in their evidence claim that sales began in the UK in 1988, and certain enclosures appear to support use in the UK from 1989. The opponent has not commented on these claims other than Senor Javier's contention in his declaration dated 13 November 1998 that the "first sales of wine by the applicants into the UK were in bulk form and not in individual bottles".

57) Although the Section 5(4)(a) claim has to be established at the date of the application, it is

clear that the opponent could have had no such right if, the applicant's use is protected in the UK from an earlier date or if, by the relevant date, the applicant had established its own actionable goodwill in the UK, (*Habib Bank* 1982 RPC at 24).

58) There is evidence of use of the applicant's mark from 1988. There is support in the enclosures to Signor Conci's evidence (particularly the copy of *Decanter* magazine from 1991) which demonstrates a trade in the UK in bottled wine by that date. Consequently, even if the opponent had presented an arguable case for passing off at the relevant date on the basis of its own goodwill, this case is bound to fail once the applicant's use is factored in because the applicant's use was plainly not a misrepresentation in 1995.

59) I next consider the grounds of opposition under Section 1(1) and 3(1) of the Act.

60) Section 1(1) of the Act is in the following terms:

*"1 (1) In this Act a "trade mark" means any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings".*

*"A trade mark may, in particular, consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging."*

61) Section 3(1) of the Act is in the following terms:

*3 (1) The following shall not be registered -*

- (a) signs which do not satisfy the requirements of section 1(1),*
- (b) trade marks which are devoid of any distinctive character,*
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

*(d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.*

*Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.*

62) The opponent contends that as there are earlier trade marks on the Register which it claims are similar to those of the applicant then the mark in suit is not capable of distinguishing the goods of the applicant.

63) These Sections are annotated with the words “Absolute grounds”, thus precluding a comparison with other trade marks. The opponent did not file any evidence in support of this ground, and did not pursue it at the hearing. The opposition under this section fails.

64) I next turn to the grounds of opposition under Section 3(3)(b) which reads:

3. (3) A trade mark shall not be registered if it is -

(a) .....

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

65) The opponent’s claim that the mark in suit will be seen as referring to the town of Mezzocorona. The town of Mezzocorona is in the Trentino Appellation of Origin which the opponent claims has a reputation for quality wines. The opponent also claims that not all of the grapes used by the applicant come from the village of Mezzocorona and so the use of the mark in suit would deceive consumers.

66) In considering this question I take into account the views expressed by the European Court of Justice in the case of *Windsurfing Chiemsee Produktions v Huber [1999] EMTR* page 587, in which the Court laid down the following guidance on the application of Article 3(1)(c) of the Directive (Section 3(1)(c) of the Act) with regard to the registrability of geographical names as trade marks.

- “Where there is currently no association in the mind of the relevant class of person between the geographical name and the category of goods in question, the competent authority must assess whether it is reasonable to assume that such a name is, in the mind of the relevant class of persons, capable of designating the geographical origin of that category of goods; and
- in making that assessment, particular consideration should be given to the degree of familiarity amongst the relevant class of persons with the geographical name in question, with the characteristics of the place designated by that name, and with the category of goods concerned.”

67) The opponent has not objected to the registration of this mark under Section 3(1)(c). Nevertheless, I believe that the above point about the public’s familiarity with the place is relevant to the Section 3(3)(b) objection. In support of this point, I note that in order to ensure that all Community legislation is in accordance with the TRIPS Agreement, Council Regulation 3288/94 (Kerly’s page 1036 & 1087 refers) introduced an additional absolute ground of refusal to the CTMR 40/94 (Article 7(1)(j) in order to comply with Article 23(20) of TRIPS. The additional ground requires the refusal of trade marks consisting of or containing false geographical indications for wines and spirits “without the condition that they are of such a nature as to deceive the public”.

68) The CMTR already contained a provision (Article 7(1)(a)) in identical terms to Section 3(3)(b) of the Act. It is apparent that this was not considered sufficient to refuse the registration as trade marks of false geographical designations in the absence of potential to deceive the public. That must depend, in part, on the public recognition of the geographical

name in question.

69) I accept that the name of the town was for a period of twenty nine years spelt as MEZZACORONA rather than MEZZOCORONA. However, this was when the town was ruled by the Austrian Empire during the period 1889 - 1918. It is not clear if this change in the spelling was due to an idiosyncrasy in the Austrian language or whether other reasons prevailed. Whatever the reason it the town's name was changed for a relatively short period of time whilst occupied by a foreign country before reverting to its original form. I must also take into account that for seventy seven years prior to the relevant date the town's name has been spelt as Mezzocorona. The opponent has shown no evidence that the town of Mezzocorona has a reputation for wine or is known to the UK consumer. Nor have they shown that it is likely that the name will become known to the average UK consumer.

70) I note that the town of Mezzocorona is in the "Trentino" Denomination of Origin, and in my view it is this which the average consumer will either know or will become aware of through use. In this connection, although there is a claim that as a result of a Presidential decree in Italy, producers in Mezzocorona have the right to add the name of the commune to the D.O.C. name, there is no evidence that this has happened in Italy, and there is no evidence of use of MEZZOCORONA in the UK, except in one or two press articles describing the activities of the applicant.

71) Turning to the claim that the public would be deceived as the grapes used by the applicant do not come from the town of Mezzocorona. I have already stated that, in my view, the mark in suit is not and would not be seen as a geographical reference. However, in case I am wrong on this point I will consider the issue of where the grapes used by the applicant are grown.

72) Mrs Heal contended that the grapes used in the applicant's product were not all grown in the village of Mezzocorona. To corroborate this point I was referred to exhibit LDJ5 to the declaration of Senor De Javier dated 13 November 1998. The exhibit consists of part of Court Transcript relating to a similar action between the two parties in the USA. In the transcript Mr Rizoli the Chief Executive Officer of the applicant company was giving evidence. He states that the company has wineries which take in the grapes of the 1300 farmers that own the company. The farmers he states do not all live in the village of Mezzocorona, he states that "the majority are located in Trentino and a very small minority is located in the Alto Adige region, which is just five miles from the city of the Mezzocorona but up north".

73) Mrs Heal also referred to the evidence of Signor Conci where in his declaration dated 4 March 1998 he states "Mezzacorona is for us the name of the company itself and it is the trademark of the company...". Mrs Heal contended that this statement made it clear that all the wine produced by the applicant company carried the mark in suit. However, I note that the sentence prior to that quoted by Mrs Heal from Signor Conci's statement says; "For over ten years the name of the company Mezzacorona appears on the labels of our most precious wine production". Earlier in his declaration he also spoke of the company owning wineries, and that only approximately 50% of the annual production of the company has a Trentino DOC denomination.

74) In my view, the opponent has not shown conclusively that all of the grapes produced by the 1300 farmers who own the applicant company are sold under the trade mark MEZZACORONA. Therefore, even if I were to accept that some of the farmers live outside

the immediate surrounding of the town of Mezzocorona, it is not clear that their grapes are sold under the Mezzacorona mark. The opponent has failed to prove that the public would be deceived as to the geographical origin of the product.

75) Further, the opponent has not shown that the limits of the area of grape production entitled to add MEZZOCORONA to any label have been defined. Consequently, even if consumers in the UK knew of the place, they would not be deceived if some of the grapes included in a blend under the name MEZZACORONA originated five miles from the actual village of the name Mezzocorona. No-one would, for example, be surprised to know that an A.C.Bordeaux wine was made five (or even twenty) miles from the City itself, provided that it was in the delimited area of production.

76) I next turn to the ground of opposition under Section 3(4) which reads:

*(4) A trade mark shall not be registered if or to the extent that its use is prohibited in the United Kingdom by any enactment or rule of law or by any provision of Community law.*

77) Mrs Heal referred me to several recent cases which she claimed made it clear that in interpreting the Trade Marks Act EC law and its provisions are given full force and effect. The cases referred to were, inter alia, *Marleasing* C-106/89 [1990] ECR I-4135, *Angclopharm v Freje und Hansestadt Hamburg* C-212/91 [1994] I-0171 & *Webb v EMO Air Cargo (UK) Ltd* [1993] 1 WLR 49. Mr Tritton, for the applicant, supported this view accepting that through the European Communities Act 1972, Community law forms part of UK law.

78) Mrs Heal referred me to EC Regulations 1576 / 89 & 2392 /89, a decree of the President of the Italian Republic dated 12 February 1985 referred to in the evidence of Senor Javier and translations of the Presidential decree, EC Regulation 823/87, Italian State Law Number 164, and a list of Italian Denominations of Origin which were included in the evidence of Mr Paccitti. The latter being evidence which she herself had earlier sought to have struck out from the proceedings as being a translation by an individual who was not suitably qualified.

79) The principal Regulation upon which the opponent relies is Council Regulation No 2392/89. The Regulation lays down general rules for the description and presentation of wines and grape musts. The Regulation harmonises, inter alia, the information that may appear on wine labels in the single market. These regulations related particularly to quality wines psr. A "quality wine psr" means a wine that complies with Council Regulation No 823/87 which contains a definition of "qwsr". This states that the term applies to quality wines produced from a region which because of its various characteristics, produces a characteristic quality wine. It requires this area to be delimited, if possible, by vineyard. It is common ground that D.O.C. Trentino wines fall within this definition.

80) It may be assumed from this, that the provision for naming sub-zones within specified regions is to allow member states to identify areas within the specified region whose wines, whilst sharing the characteristics of the specified region have their own particular character or are of superior quality to the general standard of the region.

81) The opponent relies upon the labelling requirements described in Articles 11 and 13 of the Regulation 2392/89. The relevant parts are re-produced below:



*“Article 11*

*1. In the case of quality wine psr, the description on the labelling shall include the following information;*

*(a) the name of the specified region or origin;*

*(b) – (f) -----*

*2. In the case of quality psr, the description on the labelling may be supplemented by the following additional information:*

*(a) - (k) -----*

*(l) the name of a geographical unit which is smaller than the specified region, in accordance with the conditions laid down in Article 13;*

*(m) - (u) ----*

*Article 13*

*1. In the description of a quality wine psr on the labelling, the name of a ‘geographical unit which is smaller than the specified region’ as referred to in Article 11(2)(l), shall be taken to mean the name of:*

*– a small locality or group of localities,*

*– a local administrative area or part thereof,*

*– a wine-growing subregion or part thereof.*

*2. Producer Member States may allocate the name of a geographical unit which is smaller than the specified region in question to quality wine psr provided that:*

*– this geographical unit is well defined,*

*– all the grapes from which the wines have been produced originate in that unit.”*

82) The opponent’s case is that the commune of Mezzocorona falls within Article 13(1) and the use of that name on labels is subject to Article 13(2). However, the opponent says that the applicant’s use does not satisfy the second indent of Article 13(2).

83) Both the applicant and the opponent have filed translations of an Italian Presidential Decree dated 12 February 1995, which the opponent claims has the effect of allocating Mezzacorona as the name of a geographical unit which is smaller than the specified region of Trentino. The opponent says that the Italian law must therefore be interpreted insofar as necessary to determine the applicability of the Community law described above.

84) The Presidential Decree in question modifies and substitutes for earlier decrees governing

the operation of the D.O.C. Trentino. Article 3 lists Mezzocorona as one of 46 administrative territories which are entitled, subject to certain conditions, to produce wines under the D.O.C. Trentino. Article 11 is (in the applicant's translation) as follows:

*“It is forbidden to add any other qualification to the appellation Controlled Denomination of Origin “Trentino” which differs from those provided by this regulatory provision, including the adjectives extra, fine, selected, chosen, superior, old and so on.*

*It is however permitted to use indications which refer to names, firm names or private trademarks, provided they have no laudatory connotation and do not deceive the buyer: also indications which refer to as towns , villages, farms, zones and localities included in the region defined in Article 3 and where the grapes from which the so-qualified wine are actually grown.”*

85) The opponent's translation is slightly different but not materially so.

86) The Presidential Decree appears to allow any area or even farm within the Trentino D.O.C. to add its name to the label. If this is correct, it is inherently unlikely that every area or farm entitled to the Trentino D.O.C. would produce wine which would justify the addition of the name of the smaller area to the label.

87) The Italian law is irrelevant except to the extent that it represents the application of Community law. The first question is therefore whether the second paragraph of Article 11 of the Decree allocates Mezzocorona as the name of a geographical unit which is smaller than the specified region of Trentino.

88) Luis de Javier, for the opponent contends that it does. The applicant has filed evidence of Armando Botteon, who is the author of “Codice di Legislazione Vinicola” (Wine Legislation), “Codice dei VQPRD” (Quality Wines Produced in Determined Regions) and other publications. He is also the head of a monthly magazine entitled “Legislazione Vinicola e delle Bevande” (Wine and Beverages Legislation), in which he says he often writes as an expert. He is therefore put forward by the applicant as an expert witness.

89) Armando Botteon says that:

1) As far as Italy is concerned, the name of a sub-zone is protected only if the sub-zone is positively listed in Italian D.O.C. listings;

2) There are 313 recognised regulations of D.O.C. or D.O.C.G. wines in Italy, which safeguard 104 names of listed and more strictly regulated sub-zones;

3) Mezzocorona is not listed;

4) It is unlikely that there would be a single consumer outside Italy (and perhaps in Italy except in the Trento region) who would be aware that among the 8102 communes in Italy, there is one called Mezzocorona.

90) Mr Tritton submitted that if the opponent wished to pursue their objection based upon the interaction of Italian and Community law they should at the very least have filed expert

witness evidence. I believe that there is force in this criticism.

91) The closest I have to expert evidence is that of Armando Botteon. His evidence supports the applicant, although it is directed at Italian law in general rather than the specific point of whether Article 11 of the Presidential Decree “allocates” Mezzocorona for the purposes of Article 13 of Council Regulation 2392/89.

92) I note that one of the requirements under Article 13 of the Community law is that the smaller geographical unit is well defined. The requirement that all the grapes in the wines originate in that unit is plainly linked to the first requirement and inoperable without it. There is nothing in the Presidential Decree which serves to define any of the localities, farms etc listed in Article 3. This suggests that the purpose of the Presidential Decree was not to allocate smaller well defined units for the purposes of Article 13 of the Council Regulation 2392/89. This is consistent with the evidence of Armando Botteon. And even if this was the intention, the Decree plainly fails to meet the requirements of Article 13(2) and consequently has not been shown to have the effect the opponent claims under Community law.

93) As Mezzocorona has not been shown to fall within the descriptions entitled to be applied to labels etc under Community law, there is no need for me to consider whether the use of the mark applied for, including the word MezzaCorona is liable to be prevented by Article 40 of Regulation 2392/89, which I note includes provisions relating to the use of brand names.

94) This provision appears to prohibit the use of brand names identical to a description of a quality wine psr, or one that is liable to confuse or mislead the persons to whom they are addressed with all or part of the description of a quality wine psr whose description is governed by Community provisions. I have already found that the description Mezzocorona has not been shown to be covered by Community provisions.

95) If, contrary to my primary finding, Mezzocorona does fall within Article 13 and is therefore protected under Article 40 of Regulation 2392/89, it does not follow that, in considering whether the use of similar brand names is liable to confuse the customer, that I am required to assume the familiarity of the public with the name of the protected sub-zone. Unlike a conflict between two trade marks everything turns on the facts. Mrs Heal contended that the regulations could not be circumvented simply by misspelling of designations and gave as an instance “Ouzzo” for Ouzo. Mrs Heal may be correct in submitting that “Ouzzo” would be confused with Ouzo and that use of the former would therefore be caught by Article 40.

96) Mezzocorona is not the name of a specified region but just a commune within such an area. There is no evidence that Mezzocorona has any recognition as the name of a sub-zone. In these circumstances, it does not follow that, even if “incorrect” or “false” use of Mezzocorona as a brand name is prevented, that use of the applicant’s mark incorporating the word “Mezzacorona” is liable to mislead the consumer.

97) If I am found to be wrong about these provisions I record here that the conventional means for an applicant to meet such an objection is to restrict the specification of goods to those products from the area in question. However, the applicant has not suggested this and it would not be possible unless the area concerned is defined.

98) The opposition under Section 3(4) fails.

99) The last ground of opposition is under Section 3(6) which states:

*“ A trade mark shall not be registered if or to the extent that the application is made in bad faith. ”*

100) Mrs Heal sought to amend this ground of opposition at the hearing in order to refer to EC Regulation 2392 / 89. However, as it was raised only during her closing remarks I declined to allow the amendment requested. I accept that the skeleton submission did refer to the regulation but did not include a request to amend the ground of opposition originally filed.

101) The Act does not define the term bad faith, leaving it to the Tribunal or the Court to determine whether an application was made in bad faith based upon the circumstances of a particular case. The Notes on Sections, published by the Patent office, and based upon the Notes on Clauses provided to Parliament during the passage of the Trade Marks Bill in relation to Section 3(6) provides examples of where bad faith might be found, these are:

(i) where the applicant had no bona fide intention to use the mark, or intended to use it, but not for the whole range of goods and services listed in the application;

(ii) where the applicant was aware that someone else intends to use and /or register the mark, particularly where the applicant has a relationship, for example as employee or agent, with that other person, or where the applicant has copied a mark being used abroad with the intention of pre-empting the proprietor who intends to trade in the United Kingdom;

(iii) where the mark incorporates the name or image of a well-known person without his agreement. (This should not be taken as meaning that this provision is legislating for the protection of a personal name or reputation - these remain unprotected under English law, but the nexus between unregistrability and the name of a well-known person is that of bad faith in which the application is made.)

102) I also take account of the views of Lindsay.J. in *Gromax Plasticulture Ltd v Don and Low Nonwovens Ltd* (1999 RPC 367 at page 379) where the learned judge said:

*“I shall not attempt to define bad faith in this context. Plainly it includes dishonesty and, as I would hold, includes also some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”*

103) It is well established that in an opposition under Section 3(6) of the Act the onus is on the opponent, reflecting the usual approach under English law that he who asserts must prove. The original ground of opposition merely stated that the opponent has made the applicant aware of their objection to the mark being registered but the applicant has persisted with the application. This is not sufficient to sustain an objection to registration under this head.


104) For the sake of completeness I will deal with the amendment sought by Mrs Heal. This was that the applicant should have been aware of EC Regulation 2392 / 89 and known that the mark in suit offended against the regulation. Clearly the applicant does not agree that the mark in suit offends against the Regulation and was therefore entitled to seek registration. It was for



the opponent to prove to the Registry that the mark was not entitled, under EC law, to be registered. This they have failed to achieve. The opposition under Section 3(6) fails.

105) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1635. This sum 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 4<sup>th</sup> day of February 2002

George W Salthouse  
For the Registrar  
The Comptroller General

Mark	Number	Effective Date	Class	Specification
 <p data-bbox="296 723 730 792">Registration of this Trade Mark shall give no right to the exclusive use of the word "Torres", the letter "C" and the word "Coronas".</p>	891250	25/2/66	33	Spanish Wines
<p data-bbox="169 931 419 969"><b>CORONAS</b></p> <p data-bbox="169 1012 624 1037">Used claimed from the year 1965. Section 12(2).</p> <p data-bbox="169 1046 767 1093">It is a condition of registration that the mark shall be used in relation only to red wines the produce of Spain.</p> <p data-bbox="169 1102 600 1126">To be associated with No. 891250 (4629,643).</p>	1425412	16/5/90	33	Red Wines, all included in Class 33

Mark	Number	Effective Date	Class	Specification
 <p data-bbox="60 1008 753 1052">Registration of this Trade Mark shall give no right to the exclusive use of the word "Corona".</p>	967446	10/11/70	33	Wines, Spirits (beverages) and liqueurs.
 <p data-bbox="98 1765 697 1821">Previously accepted on 1st December 1988 and advertised in Journal 5756, page 336.</p> <p data-bbox="98 1832 697 1915">It is a condition of registration that the blank space in the mark shall, when in use, be occupied only by matter of a wholly descriptive and non-trade mark matter.</p> <p data-bbox="98 1930 697 1986">Registration of this mark shall give no right to the exclusive use of the words "Corona" and "Extra".</p>	1269333	16/6/86	32	Beer



Registration of this mark shall give no right to the exclusive use of the word "Extra".

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Restaurant services; bar and catering services; all included in Class 42; but not including any such services relating to the provision of non-alcoholic drinks.