

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:**

**OPPOSITION No. 49512**

**IN THE NAME OF MIGUEL TORRES SA**

**TO APPLICATION No. 2178911**

**TO REGISTER A TRADE MARK**

**IN CLASS 33**

**IN THE NAME OF VINA TORREBLANCA SL**

---

**DECISION**

---

**Application No. 2178911**

1. On 6th October 1998 Vina Torreblanca SL (“**the Applicant**”) applied to register the following sign as a trade mark for use in relation to “*wines, spirits and liqueurs*” in Class 33:



The sign does not appear to have been used in the United Kingdom prior to the date of the application for registration.

### **Opposition No.49512**

2. On 25th February 1999 Miguel Torres SA (“**the Opponent**”) filed notice of opposition to the application.

3. For the purposes of this decision I need only refer to the Opponent’s contentions that registration should be refused: (i) on the basis that the application contemplated unauthorised use of the relevant sign within the area of protection afforded to a number of the Opponent’s “earlier trade marks” by Section 5(2)(b) of the 1994 Act; and (ii) under Section 5(4)(a) of the 1994 Act on the basis that unauthorised use of the relevant sign in relation to goods of the kind specified in the application would be actionable in passing off.

4. Eight “earlier trade marks” were cited by the Opponent in support of its objection under Section 5(2)(b):

(1) Trade Mark:



registered under number 857391 with effect from 3rd December 1963 for use in relation to “*wines*” in Class 33 with the right to exclusive use of the word TORRES disclaimed.



(2) Trade Mark:

registered under number 891250 with effect from 25th February 1966 for use in relation to “*Spanish wines*” in Class 33 with the right to exclusive use of the word TORRES disclaimed.

(3) Trade Mark: **TORRES**

registered under number 1039853 with effect from 17th December 1974 for use in relation to “*table wines for sale in England and Scotland*”.

(4) Trade Mark:



registered under number 1039854 with effect from 17th December 1974 for use in relation to “*brandy*” in Class 33 with the right to exclusive use of the word TORRES disclaimed.

(5) Trade Mark: **TRES TORRES**

registered under number 1123105 with effect from 27th October 1979 for use in relation to “*wines, liqueurs and spirits (beverages)*” in Class 33.

(6) Trade Mark: **TORRES**

registered under number 1298955 with effect from 27th January 1987 for use in relation to “*wines, brandy and brandy-based orange liqueurs; all included in Class 33*”.

(7) Trade Mark: **MIGUEL TORRES**

registered under number 1404075 with effect from 13th November 1989 for use in relation to “*wines, sparkling wine, brandy and liqueurs; all included in Class 33*”.

(8) Trade Mark:

TORRES  
MILMANDA

T O R R E S  
*Milmanda*

registered under 1404528 with effect from 20th November 1989 for use in relation to “*wines included in Class 33*” with the right to exclusive use of the word TORRES disclaimed.

5. The claim to an earlier right under Section 5(4)(a) was made upon the footing that the Opponent “has unregistered rights and an extensive reputation in the United Kingdom and abroad for trade marks consisting of or comprising the word TORRES in the form of dark rectangular labels incorporating heraldic shield devices by virtue of long and substantial use of such marks”.

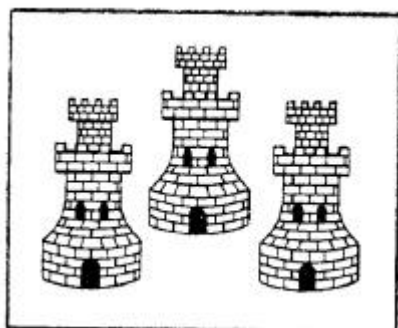
6. The Applicant joined issue with the Opponent on these objections in a counter-statement filed on 21st April 1999.

### **Opponent’s Evidence**

7. The evidence in support of the opposition consisted of a statutory declaration of Senor Angel de la Rubia Perez and 4 exhibits dated 5th October 1999.

8. It appears from this evidence that:

- (i) The Opponent is a company registered in Spain. It is owned by the Torres family. It has for many years traded in wines produced and bottled on the Torres family vineyards in the Penedès area of Spain near Barcelona. Its production areas now extend to other parts of Spain and to Chile and California. It also produces spirits and liqueurs. At the date of the statutory declaration it was producing and selling more than 40 different wines, spirits and liqueurs worldwide.
  
- (ii) The Opponent's wines, spirits and liqueurs are presented for sale and supply in bottles with labels bearing the name TORRES and/or the name MIGUEL TORRES as well as a three-tower device (separately registered in the United Kingdom under number 1134608 with effect from 30th May 1980):



These graphic elements have been used in the Opponent's labels for many 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".

- (iii) In the United Kingdom between 1990 and 1997 sales of the Opponent's wines increased year on year from 54,526 cases to 78,953 cases. Sales of its brandy and liqueurs rose from 162 cases in 1990 to 687 cases in 1996, with 580 cases being sold in 1997.
- (iv) The Opponent is concerned that confusion could ensue from use of the sign put forward for registration on the basis that: "The word TORREMAR which appears prominently in the mark could ... be easily mis-remembered as TORRESMAR and so could be thought of as one of my Company's TORRES wines, spirits or liqueurs" and also upon the basis that bottles bearing TORRES or TORREMAR labelling could be seen and remembered imperfectly as bottles of TORRE-prefixed wines, spirits and liqueurs.

### **Applicant's Evidence**

9. The Applicant's evidence in support of the application consisted of a statutory declaration of Dr. Michael Kern and 1 exhibit dated 27th April 2000. The declaration commented argumentatively upon the Opponent's evidence with a view to dismissing it as irrelevant, inadmissible, insufficient and unpersuasive. Exhibit MK1 pointed to the existence of trade marks containing the prefix TORRE registered by persons other than



the Opponent for use in relation to wines (and also, in some instances, spirits and liqueurs) in Class 33. It was suggested that the state of the register, as revealed by this Exhibit, supported the view that the marks in issue in the present opposition could be used concurrently without giving rise to confusion in the market place.

### **The Hearing Officer's Decision**

10. The opposition was rejected in a written decision issued on 17th July 2000 by Mr. M. Reynolds acting on behalf of the Registrar of Trade Marks.

11. The hearing officer noted that the Opponent was relying on a number of earlier trade mark registrations “some of them consisting of the word TORRES alone, others TORRES with additional words and yet others incorporating device elements”. He took the view that “where words or devices are present in addition to the words TORRES, the opponents are generally in a less favourable position as the other matter serves to further differentiate the opponents’ marks from the mark applied for. In other words, the registration of the word TORRES alone offers the opponents their best chance of success”.

12. He therefore based his consideration of the objection under Section 5(2)(b) of the Act upon the Opponent’s allegation of conflict with its earlier trade mark TORRES registered under number 1298955 for goods identical and closely similar to those of the application in suit.

13. He found the contested mark to be sufficiently distinguished from the earlier mark TORRES on the basis of the following comparison:

“The mark applied for is a composite one consisting of what is probably a label with a shield device surmounting the word TORREMAR and an abstract ‘splash’ across the bottom of the mark. It seems likely that the word TORREMAR would be taken to be a distinctive and dominant component of the mark. Whilst I do not forget the need to consider the mark as a whole, a finding that TORREMAR and TORRES were confusingly similar would be a strong indicator in the opponents’ favour.

Visually the respective words have some superficial similarity to the extent that they have the first five letters in common, but the differences in their overall length and appearance cancel out the initial point of similarity. Aurally the words are quite different and unlikely to be confused. Not only is one a two syllable word and the other three, but I can see no reason why the ending of TORREMAR should be slurred to the point where there is a risk of confusion with TORRES. In terms of the meaning of the words, TORRES is evidently a surname but also means ‘tower’. Whether either signification would be apparent to a UK audience is not clear. It is not suggested that TORREMAR has any particular meaning.”

14. More generally, he was unpersuaded by the Opponent’s evidence and contentions as to the existence of a likelihood of confusion resulting either from the distinctive character of its earlier trade marks in the aggregate or from the risk of imperfect perception and recollection on the part of consumers exposed to use of the rival marks.

15. He regarded the application as unobjectionable, for the same reasons, under Section 5(4)(a) of the Act.

## **The Appeal**

16. The Opponent gave notice of appeal to an Appointed Person contending: (i) that the hearing officer had wrongly determined the opposition on the basis that it was registration and use of the single word TORRES which gave the Opponent its best chance of success; and (ii) that the objections under Section 5(2)(b) and Section 5(4)(a) ought to have been upheld on the broader basis that confusion was likely because there was a “family resemblance” between the marks and labelling used by the Opponent and the sign put forward for registration by the Applicant.

17. By agreement between the parties the determination of the appeal was deferred to allow time for negotiations with a view to a compromise. However, lengthy negotiations failed to produce a solution to the dispute.

## **The Decision**

### ***Section 5(2)(b)***

18. Each of the earlier trade marks cited by the Opponent must be considered in turn for the purpose of determining whether it prevents acceptance of the contested application for registration under Section 5(2) of the Act.

19. In each case the question to be determined is whether there are similarities (in terms of marks and goods) which would combine to create a likelihood of confusion if the earlier trade mark and the sign subsequently presented for registration were used

concurrently in relation to the goods for which they are respectively registered and proposed to be registered.

20. The objection cannot be upheld if it does not appear that the public could believe that the goods supplied under the marks in contention come from the same undertaking or, as the case may be, from economically-linked undertakings: Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. [1998] ECR I-5507, paragraphs 26 to 30.

21. When (as contemplated by Section 5(2)(b) of the Act) the marks in issue are not identical, they need to be *distinctively similar* in order to be capable of inducing such a belief in the mind of the average consumer of the goods concerned.

22. At this point it is necessary to observe that marks which converge upon a particular mode or element of expression may or may not be found upon due consideration to be distinctively similar. The position varies according to the propensity of the particular mode or element of expression to be perceived, in the context of the marks as a whole, as origin specific (see, for example, Wagamama Ltd. v. City Centre Restaurants Plc [1995] FSR 713) or origin neutral (see, for example, The European Ltd v. The Economist Newspaper Ltd. [1998] FSR 283).

23. The relevant propensity may, on established principles, be inherent or acquired through use. This leaves room for evidence demonstrating that the mode or element of

expression in question has an established significance which the average consumer would take to have been carried through to the marks in issue.

24. The view that the established significance is origin specific may be supported by evidence directed to the way in which the mode or element of expression has been used as the basis for a “family” of distinctively similar marks: Duonebs Trade Mark 2nd January 2001 SRIS O/048/01 (Mr Simon Thorley QC); The Infamous Nut Company Ltd’s Application 17th September 2001 SRIS O/411/01 (Professor Ruth Annand); Lifeforce International Inc’s Application; Opposition of Novartis Nutrition AG [2001] ETMR 106, p. 1227 (Opposition Division, OHIM). The view that the established significance is origin neutral may be supported by evidence directed to the way in which the mode or element of expression has been used by traders and consumers more generally.

25. In neither case can the proposition in contention be substantiated simply by evidence of entries in the register of trade marks: entries in the register do not in themselves affect the way in which marks are perceived and remembered.

26. It nevertheless remains necessary to give effect to the limiting provisions of Section 13 of the Act in cases where the earlier trade mark is registered subject to a disclaimer.

27. When a trade mark is registered subject to a disclaimer of the right to exclusive use of a specified element of the registered mark, the rights conferred by registration and

the acts amounting to infringement, if done without the consent of the proprietor, are restricted accordingly: Section 13(1).

28. Objections under Section 5(2) are conceptually indistinguishable from actions under Section 10(2) of the Act: they serve to ensure that trade marks whose use could successfully be challenged before the courts are not registered: Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. [1998] ECR I-5507, paragraph 21.

29. It follows that an objection under Section 5(2) cannot succeed in a case where the resemblance between the marks in issue is attributable to nothing more than the presence in the earlier trade mark of an element for which protection has been disclaimed: Paco/Paco Life in Colour Trade Marks [2000] RPC 451.

30. I turn to consider the Opponent's objections under Section 5(2)(b) in the light of these considerations.

31. Four of the earlier trade marks cited by the Opponent are irrelevant because they are registered with the right to exclusive use of the word TORRES disclaimed and cannot be said to be similar to the Applicant's mark in any further or other respects.

32. Two of the remaining citations (i.e. numbers 1123105 and 1404075) build upon the significance of the word TORRES in different ways. The mark TRES TORRES draws upon the significance of the word TORRES as the plural of TORRE, the Spanish (also

Portuguese and Italian) word for tower, whereas the mark MIGUEL TORRES draws upon the significance of the word TORRES as a personal name.

33. The single word TORRES has been used and registered (under numbers 1039853 and 1298955) as a trade mark for goods of the kind specified in the contested application for registration. Standing alone, it might be perceived and remembered as a personal name or as the plural of the word TORRE (tower). In view of the manner in which the mark has been used, I think that the former was more likely than the latter at the date of the contested application.

34. The word TORREMAR is a prominent feature of the Applicant's mark. I consider that that average consumer of the goods concerned is likely to have thought of it at the relevant date as a brand name, not built upon the significance of the word TORRES as a personal name but perhaps linked to the concept of a tower (TORRE).

35. This rather tenuous link to the concept of a tower does not appear to me to be sufficient to justify the conclusion that there would be a likelihood of confusion if the Applicant's mark and the earlier trade mark TRES TORRES were to be used concurrently in relation to the goods of interest to the Applicant and the Opponent. There are, quite simply, too many differences between the Applicant's mark and the earlier trade mark TRES TORRES for that to be the case. They are not similar, let alone distinctively similar, marks.

36. The link with the concept of a tower is etymological rather than real in the case of the earlier trade mark MIGUEL TORRES and weak, if operative at all, in the case of the earlier trade mark TORRES. Those marks are apt to exploit the significance of TORRES as a personal name. The same cannot be said of the Applicant's mark. I do not consider the Applicant's mark to be distinctively similar to either of those earlier trade marks. The differences between the Applicant's mark and the earlier trade marks MIGUEL TORRES and TORRES are in each case real and substantial. They are sufficient in my view, to enable the Applicant's mark and each of those earlier trade marks to co-exist in the market place without giving rise to a likelihood of confusion.

37. I do not disagree with the hearing officer's view that it was registration and use of the single word TORRES which gave the Opponent its best chance of success.

38. More to the point, however, I disagree with the submission on behalf of the Opponent to the effect that its position can be improved by looking for a "family resemblance" between the Applicant's mark and the cited earlier trade marks.

39. For there to be substance in this point, it would have to be realistically possible to regard the marks in the hypothesised "family" as distinctively similar representations of the element TORRE.

40. However, the Opponent's earlier trade marks do not appear to me to lend themselves collectively to perception in that way. They add up to a cocktail of labels, devices and words with TORRES functioning sometimes as a personal name, sometimes



as the plural of TORRE and sometimes in a way that might be either. Moreover the Applicant's mark appears to me to be a mark out of which the element TORRE can only be extracted by a process of dismemberment that the average consumer of the goods concerned would not be likely to engage in.

41. I do not think it can realistically be said that the element TORRE has been used by the Opponent as the basis for a "family" of distinctively similar marks or that the Applicant's mark would be taken to form part of any such "family" if one existed.

42. The Applicant's evidence as to the existence of TORRE prefixed trade mark registrations takes the matter no further.

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

43. The pivotal issue in relation to the objection raised under Section 5(4)(a) is whether, at the date of the application for registration, normal and fair use of the contested mark in relation to the goods of interest to the Applicant would have been likely to deceive or cause confusion by reason of its resemblance to any identified mark or labelling previously used by the Opponent in the United Kingdom.

44. The unregistered rights enjoyed by the Opponent at that date were not necessarily co-extensive with the rights it had acquired by registration. Moreover, the existence of the disclaimers which limited the scope of its registered rights could not provide the Applicant with a defence it would not otherwise have possessed in answer to a claim for

passing off: Antec International v. South Western Chicks (Warren) Ltd [1998] FSR 738, 745.

45. However, the Applicant's mark contains nothing beyond the word TORREMAR which could be said to bring into conflict with any identified mark or labelling previously used by the Opponent. Moreover, the marks and labelling identified by the Opponent contain nothing beyond the word TORRES which could be said to have rendered the Applicant's mark deceptive or confusing at the relevant date.

46. In the circumstances there is no basis on which the Opponent's objection under Section 5(4)(a) could succeed independently of its objections under Section 5(2)(b). It therefore fails with those objections.

### **Conclusion**

47. For the reasons given above the appeal from the decision issued by the Registrar's hearing officer, Mr. M. Reynolds, on 17th July 2000 will be dismissed.

48. I direct the Opponent to pay the Applicant £535 as a contribution towards its costs of the unsuccessful appeal. That sum will be payable in addition to the sum of £435 that the Opponent was ordered to pay in respect of the proceedings before the Registrar.

49. The higher sum awarded in relation to the appeal takes account of the fact that the opposition was determined in the Registry without recourse to a hearing whereas the

parties were represented and presented oral argument at the hearing of the appeal before me.

Geoffrey Hobbs Q.C.

8th May 2002

Mr. S. J. Wise of Messrs. Raworth Moss & Cook appeared on behalf of the Opponent.

Mr. P. Kelly of Messrs. Venner Shipley & Co. appeared on behalf of the Applicant.

The Registrar was not represented at the hearing of the appeal.