

**O-352-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3282529  
BY CONSORZIO PRIOGRIGIO  
TO REGISTER THE TRADE MARK**

**PRIOGRIGIO**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 412421  
BY FELIX SOLIS AVANTIS UK LTD AND FELIX SOLIS, S.L.**

## **Background and pleadings**

1. On 15 January 2018, Consorzio Priogrigio (“the applicant”) applied to register the trade mark **PRIOGRIGIO** under number 3282529 (“the contested mark”). It was published on 30 March 2018 in respect of the following goods:

Class 33: Alcoholic beverages (except beers); wine; wine-based drinks; mulled wine; sparkling wine; still wine; cooking wine; fortified wines; wine-based aperitifs; wine coolers [drinks]; beverages containing wine [spritzers]; sparkling fruit wine; spirits and liquors; sweet wines.

2. The application is opposed, jointly, by Felix Solis Avantis UK Ltd and Felix Solis, S.L. (“the opponents”). The opposition is based upon s. 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application. The opponents rely upon the following trade marks, and all of the goods for which the marks are registered:

- i) UK trade mark number 3035135 (series of two) **Ponte Grigio** and **Ponti Grigio**  
Filing date: 16 December 2013; registration date: 4 April 2014  
Class 33: Wine
- ii) European Union trade mark (“EUTM”) 12390126 **PONTI GRIGIO**  
Filing date: 2 December 2013; registration date: 21 March 2014  
Class 33: Alcoholic beverages (except beers).

3. The opponents claim that the marks are highly similar and that the goods are identical or highly similar. They also claim that the marks share the same dominant and distinctive ending “Grigio”/“GRIGIO” and that there is a likelihood of confusion, including the likelihood of association.

4. The applicant filed a counterstatement in which it denies that the marks are sufficiently similar to give rise to a likelihood of confusion.

5. Given their filing dates, the opponents' marks qualify as earlier marks in accordance with section 6 of the Act. As neither mark had completed its registration process more than 5 years before the publication date of the application in suit, they are not subject to the proof of use provisions contained in s. 6A of the Act. The opponents may rely upon all of the goods they have identified, without showing that they have used the marks.

6. Both parties filed evidence. The matter came to be heard before me, by videoconference, on 3 June 2019. The applicant was represented by Julius Stobbs, for Stobbs. The opponents did not attend but filed written submissions in lieu, which I will keep in mind. It has been represented throughout by HGF Limited.

## **Evidence**

### Opponents' evidence

7. This consists of the witness statement of Jonathan Thurgood, who is a trade mark attorney and partner at the opponents' professional representatives.

8. Mr Thurgood provides an undated copy of a page from the *Concise Oxford Dictionary* which shows no entry for "grigio".<sup>1</sup> He also provides a print of a webpage from the *Cambridge Dictionary Online* which shows that "grigio" was not found in the English dictionary.<sup>2</sup>

9. Mr Thurgood also provides copies of a decision of the EUIPO, along with other documents detailing the actions of the applicant in relation to EU trade mark applications.<sup>3</sup> There is no need for me to repeat the contents here.

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<sup>1</sup> Exhibit JMT1.

<sup>2</sup> JMT2.

<sup>3</sup> JMT3- JMT5

## Applicant's evidence

10. Two witnesses give evidence. Louise Goodsell, a trade mark attorney at the applicant's representatives of record provides copies of trade mark registration details for other UK and EU marks containing the word "GRIGIO" and registered in class 33.<sup>4</sup> There is no need for me to record the specifics.

11. The bulk of the applicant's evidence is provided by Giorgio Pizzolo, who gives his title as President and Legal Representative of the applicant. Mr Pizzolo states that "GRIGIO" has a clear and direct meaning and that it is a variety of grape grown in Italy.<sup>5</sup> He states that it is also used by the public as an abbreviation of "PINOT GRIGIO".<sup>6</sup> A number of dictionary definitions are adduced. The first is an undated definition of "grigio" taken from Wiktionary.org.<sup>7</sup> It reads "*(informal)* A Pinot Grigio wine".

12. There is also an undated definition from wordnik.com which repeats the Wiktionary definition.<sup>8</sup> It includes some examples of the term in use; only two of these feature "grigio" solus. These are: "The 2007 is when the label changed from "grigio" to "gris", and it had soft pear and peach notes"; and "In general I prefer the 'grigio' style but that's mostly because I so often dislike pinot gris".

13. A print from urbandictionary.com is provided, which defines "grigio" as an "Italian sweet white wine made from pinot grapes".<sup>9</sup> It appears that this definition was created in 2008.

14. Finally, there is a print of the *Collins* online dictionary definition of "Pinot Grigio", which defines the term as a variety of grape or a wine made from that grape.<sup>10</sup>

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<sup>4</sup> Exhibits 1-5.

<sup>5</sup> §1.

<sup>6</sup> Ibid.

<sup>7</sup> Exhibit 1.

<sup>8</sup> Exhibit 2.

<sup>9</sup> Exhibit 3

<sup>10</sup> Exhibit 4.

15. Undated prints of a Google search for “grigio wine” are exhibited.<sup>11</sup> With one exception (at p. 21, a reference to the “grigio side. But head to Alsace in...”), the results all show the combination “pinot grigio”.

16. There is produced an article from *Stylist*, dated “4 years ago”, which includes Pinot Grigio at number 9 of the top ten grape varieties in the UK.<sup>12</sup> An article from the Virgin Wines blog dated 14 March 2017 describes Pinot Grigio as one of the most popular varieties in the range.<sup>13</sup> A 2011 article from the *Guardian* comments on the popularity at supermarket tastings of Pinot Grigio wine, while a *Good Housekeeping* article from 2016 describes Pinot Grigio as a popular grape.<sup>14</sup> A post in *Wine Spectator* from 2006, however, appears to relate to the US market.<sup>15</sup>

17. Mr Pizzolo also exhibits an extract from a Nielsen market research report dated September 2018.<sup>16</sup> The report indicates that 66.6% of UK households bought wine in the previous year and that Pinot Grigio is the third most popular white wine variety in the UK off-trade.

18. That completes my summary of the evidence, to the extent I consider necessary.

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

19. I will begin by considering the position in respect of the EUTM and will return to the UK mark if necessary.

20. Section 5(2)(b) of the Act reads as follows:

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

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<sup>11</sup> Exhibit 5.

<sup>12</sup> Exhibit 6.

<sup>13</sup> Exhibit 7.

<sup>14</sup> Exhibits 9 and 10, respectively.

<sup>15</sup> Exhibit 8.

<sup>16</sup> Exhibit 11.

[...]

(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 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”.

21. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

(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 or 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, and whose attention varies according to the category of goods or services in question;

(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 normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

## **Comparison of goods**

22. There is, sensibly, no dispute that the earlier specification is identical to the later specification, either being identical terms or because the goods are encompassed under the umbrella term “alcoholic beverages (except beers)”.

## **The average consumer and the nature of the purchasing act**

23. It is necessary for me to determine both who the average consumer is for the respective parties’ goods and the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

24. The average consumer of the goods at issue is likely to be an adult member of the public. The goods are likely to be purchased through selection from the shelves of retailers such as supermarkets and off-licences, or from online equivalents. There is also potential for the goods to be purchased in licensed premises, which will usually follow inspection of drinks menus or bottles, typically behind the bar. The purchasing process is, therefore, likely to be dominated by visual considerations, though I do not rule out an aural component.

25. Although there will be some variation across the category, none of the goods is particularly expensive. Some care will be taken, however, to ensure that, for example, the correct variety, strength or flavour is chosen. The goods will, in general, be purchased with a medium level of attention.

### **Distinctive character of the earlier trade mark**

26. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public: *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In *Lloyd Schuhfabrik*, the Court of Justice of the European Union (“CJEU”) stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)".

27. There is considerable dispute between the parties as to the role of "GRIGIO" in the marks. Mr Stobbs argued that the word "GRIGIO" is non-distinctive and that no brand significance would be accorded to the term. In the alternative, he posited that "GRIGIO" was weakly distinctive because "pinot grigio" is well known, and that the consumer will perceive "GRIGIO" as having allusive or descriptive connotations. The opponents, in contrast, submit that "GRIGIO" has no meaning in English.

28. The applicant has filed evidence regarding the popularity of pinot grigio wine. Although not extensive, the evidence suggests that the wine has been a popular variety in the UK for several years. The marketing report at exhibit 11 to Mr Pizzolo's statement does not clearly give the dates of its research, and the report itself is dated after the relevant date, but Pinot Grigio is put at number 3 of white grape varieties, outstripping the most popular red grape variety. Given that the change only represents a 1.4% increase in year-on-year figures, the situation at the date of application is unlikely to have been vastly different. The applicant's evidence as to the popularity of pinot grigio wine also accords with my own view, namely that the wine is a popular one in the UK with which the average consumer is likely to be familiar.

29. However, the applicant's evidence does not persuade me that "GRIGIO" alone has a meaning in English which will be known to the UK consumer. I acknowledge Mr Pizzolo's claim that the term has a clear and direct meaning but that is an unsupported statement. The dictionary definitions of "grigio" exhibited by the applicant are from minor dictionaries whose weight in determining how the average consumer will perceive a term is, in my view, relatively limited. The only other uses of "grigio" solus appear to be concerned with distinguishing it from the pinot gris variety of wine. The opponents have produced evidence that "grigio" is not a term recognised in two major dictionaries, whilst it is well established that mere "state of the register" evidence offers no assistance in

establishing weakened distinctiveness.<sup>17</sup> Though I accept that the consumer may recognise the term “grigio” as one which also features in the wine variety “pinot grigio”, it is still likely, in my view, to be perceived as a word with no clear meaning, albeit often encountered within a known term. I do not consider that the notoriously monolingual UK consumer will know the meaning of “PONTI”. The mark “PONTI GRIGIO” will be viewed as an invented whole, with a resultingly high level of inherent distinctive character. There is no claim to and no evidence of enhanced distinctiveness.

### **Comparison of trade marks**

30. It is clear from *Sabel* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, that:

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

31. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks.

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<sup>17</sup> See *Henkel KGaA v Deutsches Patent- und Markenamt*, Case C-218/01 at [65] and *Zero Industry Srl v OHIM*, Case T-400/06 at [73].

32. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are:

<b>Earlier mark</b>	<b>Contested mark</b>
PONTI GRIGIO	PRIOGRIGIO

33. The opponents submit that the marks are highly similar, stressing their similar length and the shared string “GRIGIO”. They also point out that the first parts of the mark both include the letters “P”, “O” and “I” in similar positions and submit that the element “GRIGIO” has an independent distinctive role in both marks. The opponents have filed an opposition decision of the EUIPO, which they ask me to take into account. I have read it but it is not binding on me, nor indeed of particular persuasive value. Mr Stobbs accepted that there is some limited visual and aural similarity between the marks. However, he stressed that, as the differences are at the beginning of the marks, they will have greater impact. He also argued that the marks are conceptually dissimilar.

34. The earlier mark consists of the words “PONTI GRIGIO”, presented in capital letters. As I indicated above, neither word will be perceived as having a particular meaning and neither dominates the other in the overall impression. The later mark consists of the single word “PRIOGRIGIO”, again presented in capital letters. The overall impression rests in this word as a whole.

35. In terms of the visual comparison, both marks begin with the letter “P” and end in “GRIGIO”. There is also an overlap because both include the letters “I” and “O”, in the first five letters of the earlier mark and among the first four of the later mark. However, there are differences because the order of the shared letters “I” and “O” is reversed and the earlier mark includes the letters “N” and “T”, which appear between the “O” and “I”.

The earlier mark is also composed of two separate words, whilst the later mark is a single word. Taking into account all of the similarities and differences, as well as their positions in the marks, I consider that there is a fairly low (i.e. between low and medium) level of visual similarity.

36. The earlier mark is liable to be articulated as “PON-TEE GREE-JOH”. The later mark will be verbalised as “PREE-OH-GREE-JOH”. The consonant “P” at the beginning of the marks is shared, and the last two syllables of both are identical. However, there are obvious differences in the first two syllables. Overall, there is a fairly low degree of aural similarity.

37. I have already rejected the claim that any part of “PONTI GRIGIO” has a meaning for the UK consumer. I do not consider that “PRIOGRIGIO” has a conceptual meaning either. With neither mark having a clear meaning, the conceptual position is neutral.

### **Likelihood of confusion**

38. The factors considered above have a degree of interdependency and must be weighed against one another in a global assessment (*Canon* at [17]; *Sabel* at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

40. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

41. Mr Stobbs appeared to suggest at the hearing that, as the opponents claimed in their pleadings that the marks shared the same “distinctive and dominant ending”, confusion should only be considered on that basis. I do not accept that submission. The question to which the opponents were responding was “use this space to supply any further information about why you consider there is a likelihood of confusion [...]”. It would, in my view, be inappropriate to construe what is provided as further information as the entirety of the opponents’ case.

42. Mr Stobbs also argued that the principles outlined in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH* and subject to further exposition in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* are not applicable to the instant

case. I agree. Whilst “GRIGIO” does have an independent distinctive role in the earlier mark, the later mark will be perceived as a single invented word which will not be broken down into component parts; that is more particularly the case as the UK consumer is unlikely to accord any meaning to the word “GRIGIO” solus and will not see that word as a distinct, independent element of the later mark.

43. I bear in mind that the earlier mark is highly distinctive and that neither mark has a concept, both of which are points in the opponents’ favour. There is a fairly low level of visual and aural similarity between the marks. Bearing in mind the competing factors, including that the goods will be purchased with a medium degree of attention, I do not consider that confusion is likely. It is possible that there may be a bringing to mind of the earlier mark but the visual and aural differences are, in my view, sufficient to avoid direct confusion. Nor can I see a logical step which would lead the consumer, in the absence of direct confusion, to conclude that the one mark is a sub-brand or brand extension of the other. There is no likelihood of confusion, whether direct or indirect.

44. The opposition based on the EUTM has failed. As for the UK trade mark, the first mark in the series is identical to the EUTM considered above; the second mark is less visually and aurally similar to the application, as it shares fewer common letters. Some of the goods are identical; others specified in the application are plainly not identical to “wine”. Even proceeding on the assumption of identity between the goods, and the other factors being the same for essentially identical reasons to those given above, the opposition based on the UK mark would fail, for the same reasons as given above, compounded in relation to the second mark in the series by a lesser degree of similarity. The opposition under s. 5(2)(b) is dismissed.

### **Conclusion**

45. The opposition has failed. Subject to appeal, the application will be registered.

## **Costs**

46. The applicant has been successful and is entitled to an award of costs, which are sought on the usual scale (contained in Tribunal Practice Notice 2/2016). Given the issues involved, the light evidence and the brevity of the hearing (45 minutes) I award costs to the applicant as follows:

Considering the notice of opposition and preparing the counterstatement: £200

Preparing evidence and considering the other party's evidence: £500

Preparing for and attending a hearing: £600

Total: £1,300

47. I order Felix Solis Avantis UK Ltd and Felix Solis, S.L., jointly and severally, to pay Consorzio Priogrigo the sum of **£1,300**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24th day of June 2019**

**Heather Harrison**

**For the Registrar**

**The Comptroller-General**