

**BL O-686-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3319162  
BY LA RURAL VIÑEDOS Y BODEGAS S.A. LTDA.**

**TO REGISTER:**

**SAN FELIPE**

**&**

**San Felipe**

**AS A SERIES OF TWO TRADE MARKS IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 414410  
BY VINA LUIS FELIPE EDWARDS LTDA**

## **BACKGROUND & PLEADINGS**

1. On 20 June 2018, La Rural Viñedos y Bodegas S.A. Ltda. (“the applicant”) applied to register **SAN FELIPE** and **San Felipe** as a series of two trade marks for: “Wine; sparkling wine” in class 33. The application was published for opposition purposes on 21 September 2018.

2. On 19 November 2018, the application was opposed in full by Vina Luis Felipe Edwards Ltda (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), in relation to which the opponent relies upon “Wines” in class 33 in the following UK registration:

No. 3078866 for the trade mark **CASA FELIPE** which was applied for on 27 October 2014 and which was entered in the register on 23 January 2015.

3. The applicant filed a counterstatement in which the basis of the opposition is denied.

4. In these proceedings, the opponent is represented by Marks & Clerk LLP (“MC”) and the applicant by Groom Wilkes & Wright LLP (“GWW”). Both parties filed evidence and submissions during the evidence rounds. While neither party requested a hearing, the applicant filed written submissions in lieu of attendance. I have read all of the submissions filed and will, to the extent I consider it necessary, refer to them later in this decision.

### **The evidence**

5. The applicant’s evidence consists of a witness statement from Robert Hawley, a trade mark attorney at GWW. Exhibit RJH-01 to his statement consists of extracts obtained from [www.spanishdict.com](http://www.spanishdict.com) on 17 June 2019 which provide definitions of the words “Felipe”, “San” and “casa”. I will return to this evidence below.

6. The opponent's evidence in reply consists of a witness statement from Hernan Rios of MC. Mr Rios provides information from the "2011 Census of England and Wales" which he suggests indicates that at that point in time only 0.2% of the total UK population were able to speak Spanish at least "well" (exhibit HR-1) and a 2006 statistical report from the European Commission entitled "Europeans and their Languages" indicating that at that point in time only 8% of the total UK population "could understand and/or speak Spanish" (exhibit HR-2). Mr Rios concludes:

"4...Given this low percentage, the opponent submits that the "more common words" understood by the "majority of UK consumers" would be those Spanish words that feature in common parlance in the UK."

7. He also provides screen prints downloaded on 19 August 2019 which feature third party wines which contain references to CASA or SAN and which appear on the following websites: laithwaites.co.uk, winebuyers.com, tesco.com, uvinum.co.uk, majestic.co.uk, 8wines.com, waitrosecellar.com (exhibit HR-3). Of this evidence, Mr Rios states:

"5...This evidence is demonstrative of the generic nature and common usage of both the words SAN and CASA for wines."

8. Exhibit HR-4 consists of screen prints obtained from the UK Trade Marks Register in relation to class 33 obtained on 19 August 2019, which Mr Rios notes contains 332 entries for the word SAN and 374 entries for the word CASA. Finally, exhibit HR-5 consists of screen prints obtained on 19 August 2019 from what Mr Rios explains are the websites of "online UK retailers of wines" and in relation to which he notes that goods sold under the competing trade marks are priced at £13.90 and £7.95 respectively.

## **DECISION**

9. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"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 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.”

10. An earlier trade mark is defined in section 6 of the Act, which states:

“6. - (1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

11. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was entered in the register and the publication date of the application for registration, the earlier trade mark is not subject to the proof of use provisions.

### **Case law**

12. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v.*

*Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(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 greater 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**

13. The applicant seeks registration in respect of “Wine; sparkling wine”, whereas the opponent’s specification reads “Wines”. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

14. The term “Wine” in the applicant’s specification is self-evidently identical to “Wines” in the opponent’s specification. Although not literally identical, as “sparkling wine” in the applicant’s specification would be encompassed by the term “Wines” in

the opponent's specification, such goods are to be regarded as identical on the inclusion principle outlined in *Meric*.

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

15. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue. I must then determine 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.”

16. The average consumer of wine is a member of the adult general public. Wine is sold through a range of channels, including retail premises such as supermarkets and off-licences (where it is normally displayed on shelves) and on-line; in such circumstances, the goods will be obtained by self-selection. Wine is also sold in public houses and bars (where it will be displayed on, for example, bottles and where the trade mark will appear on drinks lists etc.). When wine is sold in public houses and bars, there will be an oral component to the selection process. However, there is nothing to suggest that wine is sold in such a manner as to preclude a visual inspection. Consequently, while the goods may be ordered orally in public houses and bars, it is likely to be in the context of, for example, a visual inspection of the bottle or drinks lists prior to the order being placed. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part.

17. The parties appear to disagree on the level of attention that will be paid during the selection process, the opponent describing it as not an “especially high level” and the applicant as “reasonably high”. In relation to the latter, exhibit RH-5 to Mr Rios’ statement consists of screen prints from the websites of online retailers in relation to which he notes that as of 19 August 2019, goods sold under the competing trade marks were priced at £13.90 and £7.95 respectively. While from after the material date in these proceedings, this evidence does no more than confirm that some wines may be relatively inexpensive. Regardless, as an average consumer selecting even a low cost wine will wish to ensure they are selecting, for example, the correct type, origin and flavour of wine, they will, in my view, pay a medium degree of attention to their selection.

### **Comparison of trade marks**

18. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, 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.”

19. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:



Opponent's trade mark	Applicant's trade marks
CASA FELIPE	SAN FELIPE  San Felipe

20. It is this aspect of the case that attracted the vast majority of the parties' competing submissions. As I mentioned above, I have borne all of these submissions in mind in reaching the conclusions which follow.

21. The opponent's position is that it is the word FELIPE that "is a particularly distinctive term in respect of the trade marks as a whole" and will be perceived as having no meaning or as "pertaining to a surname or family name", whereas the words CASA and SAN will be perceived as "Spanish words" the meanings of which will not be understood by the "majority of consumers." Unsurprisingly, the applicant disagrees. By reference to the Trade Marks Registry's Examination Guide which it states reads:

**"The Most Commonly Understood European Languages**

Historically, the most widely understood European languages in the UK have been French, Spanish, Italian and German. However, the percentage of other European languages spoken in the UK is growing, with more than 3 million EU nationals living in the UK as of 2015. Whilst the majority of UK consumers cannot be assumed to be fluent in all or any of these languages, most of them will have an appreciation of some of their more common words",

the applicant submits:

"9...the words the subject of the parties' marks will readily be recognised by UK consumers as Spanish words, and that 'Felipe' will readily be understood as being, or primarily meaning, the Spanish equivalent of the forename 'Philip'; 'San' will readily be understood as meaning 'Saint'; 'Casa' will readily be understood as meaning 'House'."

22. The applicant's series of two trade marks consist of the words SAN and FELIPE presented in block capital letters and title case respectively. As registration in block capital letters is sufficient to protect the words concerned in a range of formats (including title case), it is on the basis of the trade mark presented in block capital letters I shall conduct the comparison. Like the applicant's trade mark, the opponent's trade mark also consists of two words presented in block capital letters. Although both words will contribute to the overall impression conveyed by both trade marks, the relative weights of the individual words will differ. I shall return to this point when I consider the likelihood of confusion.

### **Visual comparison**

23. The competing trade marks consist of two words containing a total of ten and nine letters respectively. Although the first word in each trade mark contains the letters "S" and "A" in the same order, considered realistically, the first words are quite different. The second word in each trade mark is identical. Weighing the similarities and differences between the competing trade marks, including the length of the differing first words and the shared word, results in what I regard as a medium degree of visual similarity.

### **Aural similarity**

24. The opponent's trade mark consists of four syllables, whereas the applicant's trade mark consists of three. Although the manner in which the first two syllables in the opponent's trade mark and the first syllable in the applicant's trade mark will be pronounced are quite different, the final two syllables in both trade marks are phonetically identical. Considered overall, that results in what I consider to be a medium degree of aural similarity.

### **Conceptual similarity**

25. This is the mostly hotly contested part of the comparison. In my view, the position is as follows. At the date the application was filed in June 2018, some average consumers in the UK may not have been familiar with the words CASA and SAN at

all, others may have been familiar with the words but not their precise meanings and others may have been familiar with both the words and their meanings.

26. Insofar as the word FELIPE is concerned, some average consumers may not accord the word any meaning at all. However, given, at least, its obvious aural similarity to the word PHILIP (whether as a surname or forename), I think it far more likely that a significant proportion of average consumers in the UK will treat it as a word in a foreign language which is, broadly speaking, equivalent to the word PHILIP.

27. Thus within the average consumer group for the goods at issue, there may be some who will accord the trade marks at issue no conceptual meaning; for these average consumers the conceptual position will be neutral. For those average consumers who recognise the words CASA and SAN as being of foreign origin but are not familiar with the meanings of the words, conceptual similarity will arise from the fact that both trade marks contain the identical word FELIPE. Finally, those average consumers who are familiar with the words CASA and SAN and their meanings are likely to conceptualise the opponent's trade mark as, broadly speaking, House of Felipe/Philip and the applicant's trade mark as Saint Felipe/Philip. For those average consumers, the specific conceptual imagery evoked will differ.

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

28. 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 determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings – *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

29. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. In its submissions, the opponent argues that its trade mark is:

“28...inherently highly distinctive...since the mark bears no meaning at all in relation to the goods.”

30. As the use of names (be it surnames, forenames or full names) is, in my experience, relatively commonplace in relation to those undertakings conducting a trade in wine, absent use, the earlier trade mark is distinctive to no more than a medium degree.

### **Likelihood of confusion**

31. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact 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.

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

33. Earlier in this decision I concluded that:

- the competing goods are identical;

- while aural considerations must be kept in mind, the average consumer will select the goods at issue by predominantly visual means whilst paying a medium degree of attention during that process;
- the competing trade marks are visually and aurally similar to a medium degree;
- the degree of conceptual similarity arising, will vary depending on the average consumers state-of-knowledge;
- the earlier trade mark is possessed of a no more than medium degree of inherent distinctive character.

34. In reaching a conclusion, it is important for me to keep the points above firmly in mind. I also remind myself of the comments of the GC in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, in which it noted that the beginnings of words tend to have more visual and aural impact than the ends.

35. In its submissions, the applicant referred me to the decision of the GC in Case T-268/18, *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*. Although that case also involved wines, as the trade marks at issue were Luciano Sandrone and DON LUCIANO, the findings in that case are, in my view, of only limited assistance to the applicant in these proceedings.

36. Although from after the material date, the evidence provided as exhibit HR-3 to Mr Rios' statement regarding the use on a range of websites of the word CASA and SAN in third party trade marks in relation to the goods at issue is unsurprising. The position at the material date is likely to have been much the same. That accords with my own experience of the matter and, more importantly, will, I am satisfied, accord with that of the average consumer. The same is true of the state-of-the-register evidence provided as exhibit HR-4, which indicates that as of 19 August 2019 class 33 of the UK Trade Marks Register contained 332 entries for the word SAN and 374 entries for the word CASA.

37. Although the first words in the competing trade marks differ, my own experience which, as above, I am satisfied is likely to be much the same as the average consumer, is that by June 2018, the average UK consumer for wines would have been exposed to the words CASA and SAN appearing in a range of third-party trade marks for a number of years. That being the case, I think it is likely that the word FELIPE would assume a greater relative weight in the overall impression the competing trade marks convey and their distinctiveness.

38. As I mentioned earlier, the conceptual position is mixed. While I accept that some average consumers will conceptualise the competing trade marks in the manner the applicant suggests, in my view, a significant proportion of average consumers who are familiar with the words CASA and SAN used in relation to wines will, nonetheless, be unfamiliar with their precise meanings. In those circumstances, the words in the competing trade marks will not create the distinct differing conceptual imagery in the mind of the consumer the applicant suggests. The average consumer will, instead, have to look to the other words in the competing trade marks to provide the indication of origin. In these proceedings that other word is identical i.e. FELIPE.

39. Despite the presence and positioning in the trade marks at issue of the words CASA and SAN, given their lower relative weight, when imperfect recollection is factored in, there is, in my view, a real likelihood of direct confusion. However, if that is considered to be unrealistic, I need to consider the likelihood of indirect confusion. In this regard, I look to the guidance provided by Mr Iain Purvis Q.C., as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, whilst reminding myself of the comments of Mr James Mellor Q.C., as the Appointed Person, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. In that latter case, Mr Mellor 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.

40. Having done so, I think it is highly likely that assuming an average consumer notices the differences between the competing trade marks, he/she will further note

that both trade marks contain the identical word FELIPE. Given the higher relative weight of this component in the overall impression conveyed, to use Mr Purvis' words, the average consumer is likely, in my view, to "conclude that it [i.e. the applicant's trade mark] is another brand of the owner of the earlier mark." As a finding of a likelihood of indirect confusion is sufficient, the opposition succeeds and the application will be refused.

## **Overall conclusion**

**41. The opposition has succeeded and, subject to any successful appeal, the application will be refused.**

## **Costs**

42. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice ("TPN") 2 of 2016. Applying the above guidance, I award costs to the opponent on the following basis:

Preparing the Notice of opposition and considering the counterstatement:	£200
Preparing evidence and considering the applicant's evidence:	£500
Written submissions (x2)	£300
Official fee:	£100
<b>Total:</b>	<b>£1100</b>

43. I order La Rural Viñedos y Bodegas S.A. Ltda to pay to Vina Luis Felipe Edwards Ltda the sum of **£1100**. This sum is to be paid within twenty one days of the expiry of the appeal period or within twenty one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 11<sup>th</sup> day of November 2019**

**C J BOWEN**

**For the Registrar**