

O-327-13

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK REGISTRATION 2607314
IN THE NAME OF BIBENDUM WINE LIMITED
OF THE FOLLOWING TRADE MARK IN CLASS 33:**

PONTE EMILIANO

AND

**AN APPLICATION FOR INVALIDITY (UNDER NO 84505)
BY CONSORZIO PER LA PROMOZIONE DEL MARCHIO DE LAMBRUSCO
REGGIANO & CONSORZIO MARCHIO STORICO DEL LAMBRUSCHI
MODENESI**

The background and the pleadings

1) The trade mark PONTE EMILIANO was filed on 19 January 2012 by Bibendum Wine Limited (“Bibendum”) and it completed its registration procedure on 15 June 2012. The mark is registered in respect of “alcoholic beverages, wines” in class 33 of the Nice Classification.

2) Consorzio Per La Promozione Del Marchio De Lambrusco Reggiano and Consorzio Marchio Storico Del Lambruschi Modenesi have jointly applied to invalidate Bibendum’s registration; save when it is necessary to do so, I will refer to them jointly as “the Applicants”. Three grounds are relied upon under the Trade Marks Act 1994 (“the Act”). All of the grounds are based, to some extent, on the existence of the Protected Geographical Indication (“PGI”): EMILIA. The applicants are two consortia responsible for the protection and promotion of the PGI and an equivalent PGI named Dell ‘Emilia. The grounds for invalidation are:

- i) Under section 3(1)(c) of the Act because PONTE EMILIANO contains the entire word EMILIA and the consumer would assume that the wine in question complies with the product specification of the EMILIA PGI and, thus, the trade mark serves in trade to designate the kind, quality and geographical origin of the goods.
- ii) Under section 3(3)(b) of the Act because, for similar reasons, the mark would deceive the public if used on goods that were not entitled to use the PGI.
- iii) Under section 3(4) of the Act because the registration of PONTE EMILIANO was, on account of the existence of the PGI, contrary to the provisions of EC Regulation 1234/2007 which relates to “Designations of Origin, geographical indications and traditional terms in the wine sector”.

3) Bibendum denies the claims. Only the Applicants filed evidence. A hearing took place before me on 16 July 2013 at which Bibendum was represented by Mr James Fish of JA Kemp; the Applicants were represented by Mr Michael Kiernan of Tomkins & Co.

The evidence

4) The Applicants evidence is given by Mr Simon Gray, a trade mark attorney at Tomkins & Co. Much of Mr Gray’s evidence consists of submission as to the merits of the case together with various extracts from the relevant EC regulation. I will, of course, come on to these regulations (and submissions) shortly, but need not summarise them here. Extracts (and accompanying submissions) are also provided from the IPO’s Manual of Trade Mark Practice which, again, are borne in mind, but not summarised here. Also provided are extracts from the Trips Agreement (Articles 22 & 23) to which the UK is party; as the relevant

articles relate to the protection of geographical indicators, I do not see how this materially advances the Applicants' case (beyond its section 3(4) claim) so I do not consider it necessary to summarise this material further (although it is borne in mind). In terms of the PGI itself, Mr Gray explains that Emilia-Romagna is an area in Italy which produces the famous red wine Lambrusco, a name which designates a wine and a grape. The six most common Lambrusco grape varieties are indigenous to the Emilia region of Italy. Mr Gray states that in recognition of the special characteristics attributable to wines originating in the Emilia-Romagna area of Italy, such wines are identified for consumers by the name EMILIA; details from an EC website E-Bacchus show that EMILIA has been a protected PGI in respect of wine since 1995.

5) Late evidence was also provided by the Applicants showing that the trade mark PONTE EMILIANO is used in relation to a trebbiano/chardonnay variety of wine which is produced in the region of Emilia-Romagna; I admitted this evidence into the proceedings with no objection from Bibendum.

Section 3(4) – Use contrary to law?

6) It is convenient to first consider the ground under section 3(4) of the Act which states that:

“(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.”

7) The Applicants rely on EC Regulation 1234/2007 (as amended) (“the Regulation”), which governs the use of protected designations of origin for wine and the relationship between protected designations for wine and trade marks. The relevant articles are as follows.

“118l - Relationship with trademarks

1. Where a designation of origin or a geographical indication is protected under this Regulation, the registration of a trademark corresponding to one of the situations referred to in Article 118m(2) and relating to a product falling under one of the categories listed in Annex XIb shall be refused if the application for registration of the trademark is submitted after the date of submission of the application for protection of the designation of origin or geographical indication to the Commission and the designation of origin or geographical indication is subsequently protected.

Trademarks registered in breach of the first subparagraph shall be invalidated.

2. Without prejudice to Article 118k(2), a trademark the use of which corresponds to one of the situations referred to in Article 118m(2), which has been applied for, registered or established by use, if that possibility is provided for by the legislation concerned, in the territory of the Community before the date on which the application for protection of the designation of origin or geographical indication is submitted to the Commission, may continue to be used and renewed notwithstanding the protection of a designation of origin or geographical indication, provided that no grounds for the trademark's invalidity or revocation exist as specified by the First Council Directive 89/104/EEC of 21 December 1988 to Approximate the Laws of the Member States relating to Trade Marks or by Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark.

In such cases the use of the designation of origin or geographical indication shall be permitted alongside the relevant trademarks.

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118m - Protection

1. Protected designations of origins and protected geographical indications may be used by any operator marketing a wine which has been produced in conformity with the corresponding product specification.

2. Protected designations of origins and protected geographical indications and the wines using those protected names in conformity with the product specification shall be protected against:

(a) any direct or indirect commercial use of a protected name:

(i) by comparable products not complying with the product specification of the protected name; or

(ii) in so far as such use exploits the reputation of a designation of origin or a geographical indication;

(b) any misuse, imitation or evocation, even if the true origin of the product or service is indicated or if the protected name is translated or accompanied by an expression such as 'style', 'type', 'method', 'as produced in', 'imitation', 'flavour', 'like' or similar;

(c) any other false or misleading indication as to the provenance, origin, nature or essential qualities of the product, on the inner or outer packaging, advertising material or documents relating to the wine product concerned, and the packing of the product in a container liable to convey a false impression as to its origin;

(d) any other practice liable to mislead the consumer as to the true origin of the product.

3. Protected designations of origin or protected geographical indications shall not become generic in the Community within the meaning of Article 118k(1).

4. Member States shall take the steps necessary to stop unlawful use of protected designations of origin and protected geographical indications as referred to in paragraph 2.”

8) Both parties have referred to the judgment of the Court of Justice of the European Union (“CJEU”) in case C-87/97 *Gorgonzola* where it was stated:

“25 ‘Evocation’, as referred to in Article 13(1)(b) of Regulation No 2081/92, covers a situation where the term used to designate a product incorporates part of a protected designation, so that when the consumer is confronted with the name of the product, the image triggered in his mind is that of the product whose designation is protected.

26 As the Advocate General states in points 37 and 38 of his Opinion, it is possible, contrary to the view taken by the defendants, for a protected designation to be evoked where there is no likelihood of confusion between the products concerned and even where no Community protection extends to the parts of that designation which are echoed in the term or terms at issue.”

9) Evocation is covered by Article 188m(2)(b) of the Regulation. I will firstly consider this aspect because if I am not persuaded that PONTE EMILIANO will evoke the EMILIA PGI then I struggle to see how the Applicants can be in any better position under any other aspect of the Regulation. At the hearing Mr Kiernan criticised Mr Fish’s reliance on case-law relating to the similarity of trade marks under section 5 of the Act. I reject this criticism. Whilst a ground under section 3(4) is an absolute as opposed to a relative ground of objection, the relevant EC law being relied upon is one where it is necessary to make some form of comparison between the mark the subject of the dispute and the PGI it is said to contravene. Put simply, if one cannot objectively compare the trade mark with the PGI then how can a finding of evocation be made? As Mr Fish pointed out, in the *Gorgonzola* case the Court commented upon the similarities between the trade mark and the PGI the subject of that case:

“27 Since the product at issue is a soft blue cheese which is not dissimilar in appearance to ‘Gorgonzola’, it would seem reasonable to conclude that a protected name is indeed evoked where the term used to designate that product ends in the same two syllables and contains the same number of

syllables, with the result that the phonetic and visual similarity between the two terms is obvious.”

10) The context of these proceedings relates to a registered UK trade mark. The relevant public to be considered is the wine buying public in the UK. A consequence of this is that Mr Kiernan’s point that PONTE EMILIANO translates as EMILIA BRIDGE or A BRIDGE IN EMILIA is of little relevance; the translation is certainly not something that will be known by average consumers in the UK. Mr Kiernan also highlighted that the entirety of the PGI is contained within PONTE EMILIANO (my emphasis). Mr Fish highlighted the fairly obvious differences (the additional word PONTE and the additional letters NO at the end of the second word of the trade mark) and he highlighted that EMILIA neither stands alone nor stands out in the trade mark. A further point is that I consider the most likely concept that will be taken from EMILIA will be of a girl’s forename whereas PONTE EMILIANO will be seen as some form of foreign, possibly Italian, name or place, but one whose meaning will not be known. None of what I have assessed so far presents a compelling case that the PGI will be evoked. It is of course possible for a PGI to be particularly well-known which could, in certain circumstances, mean a greater propensity for it to stand out. However, there is no evidence that the PGI falls into this category. **All things considered, my finding is that PONTE EMILIANO does not evoke the PGI. Notwithstanding that EMILIA is subsumed within PONTE EMILIANO it is, effectively, lost within it.** In coming to this finding I have not ignored the evidence that Bibendum sells a wine under the trade mark from the Emilia-Romagna region, however, I share Mr Fish’s view that this does not matter and that the PGI for the word EMILIA would still not be evoked.

11) In terms of the other aspects of the Regulation that could potentially give rise to an adverse finding, the Applicants are in no stronger position. If the trade mark does not even evoke the PGI then it cannot possibly be seen as a “direct or indirect use of the protected name” (Article 118m(2)(a)), nor could it be described as a misuse or imitation of the PGI (the other aspects of 118m(2)(b)), nor could the use of the trade mark be classed as any “other false or misleading indication” or “any other practice liable to mislead the consumer” (Articles 118m(2)(c) and (d) respectively). Whilst I bear in mind Mr Kiernan’s submission that some of these other aspects of Article 118m(2) are broad in scope, for the reasons I have already given, I do not consider that the grounds are made out. Mr Kiernan also argued that the absence of any evidence as to why the trade mark was coined was instructive and that this could be a factor in deciding whether, for example, the trade mark was liable to mislead the consumer. Mr Fish argued that Bibendum did not have to file any evidence because no claim to bad faith had been made against it. I agree with Mr Fish that the lack of evidence is not telling in this case, however, irrespective of this, the fact that the trade mark does not evoke the PGI is, in my view, the end of the matter.

12) The ground of invalidation under section 3(4) is dismissed.

Other grounds of invalidation

13) Although different in nature, the reasoning I have given above assists with the determination of the other grounds. Under section 3(3)(b) the claim is that the mark would deceive the public unless the wine sold under it was entitled to use the PGI. However, as the trade mark does not even evoke the PGI then there can be no such deception. **The ground under section 3(3)(b) is dismissed.**

14) Under section 3(1)(c) the position is even starker because not only does the trade mark fail to send any form of descriptive message (because it does not even evoke the PGI), even if this were not the case, the trade mark would not consist "exclusively of signs or indications which may serve, in trade, to designate.." because of the totality of the trade mark which is registered (my emphasis) due to its other elements. **The ground under section 3(1)(c) is dismissed.**

15) In view of the above, and although shortly stated, the other grounds of invalidation are hereby dismissed with the consequence that the invalidation claim as a whole fails.

Costs

16) Bibendum has been successful and is entitled to a contribution towards its costs. I hereby order Consorzio Per La Promozione Del Marchio De Lambrusco Reggiano and Consorzio Marchio Storico Del Lambruschi Modenesi, being jointly and severally liable, to pay Bibendum Wine Limited the sum of £1200. This sum is calculated as follows:

Preparing a statement and considering the other side's statement - £300

Considering the Applicants' evidence - £300

Attending the hearing - £600

17) The above sum should 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 13th day of August 2013

**Oliver Morris
For the Registrar,
The Comptroller-General**