

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE MARKS
IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

In the matter of an application for registration of Trade Mark No. 254154 and in the matter of an Opposition thereto.

Cantina Broglie 1 S.R.L.

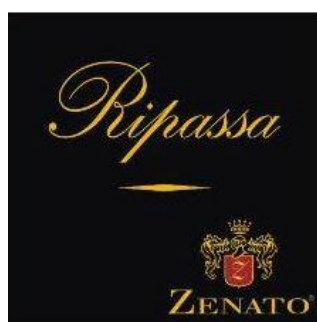
Applicant

Camera di Commercio Industria, Artigianato e Agricoltura di Verona

Opponent

The Application

1. On 14 January, 2016 CANTINA BROGLIE 1 S.R.L of Via Dell l'Artigianato 16, I-37019 Peschiera Del Garda, Fraz Broglie (VR), Italy (hereinafter “the Applicant”) made an application to convert its European Union Trade Mark (EUTM) application, in respect of the sign depicted below (hereinafter “RIPASSA ZENATO”), to an Irish trade mark for “Alcoholic beverages (except beers)” in Class 33. The application date is deemed to be the original EUTM application date of 7 May, 2007.



2. The application was accepted for registration and advertised accordingly under No. 254154 in Journal No. 2302 dated 9 March, 2016.
3. Notice of Opposition to the registration of the mark pursuant to Section 43 of the Act was filed on 7 June, 2016 by Camera di Commercio Industria, Artigianato e Agricoltura di Verona of Corso Posta Nuova 96, I-37122 Verona, Italy (hereinafter “the Opponent”). The Applicant filed a counter-statement on 2 September, 2016 and evidence was, in due course, filed by the parties under Rules 20 and 21 of the Trade Marks Rules, 1996 (“the Rules”).
4. No further evidence was filed and neither party elected to be heard or to file written submissions in lieu of being heard. So, respecting the wishes of both parties, I decided the matter on the

materials filed up to and including Rule 21 stage. The parties were notified on 24 April, 2019 that I had decided to dismiss the opposition and to allow the mark to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2).

The Grounds of Opposition

5. In its Notice of Opposition, the Opponent identifies itself as the Chamber of Commerce for the province of Verona in Italy (part of the Italian Chamber of Commerce system), whose mission is to deal with the general interests of local production, to promote local development, market regulation and transparency and to provide links between businesses and the Public Authorities.

6. The Opponent says it is the owner of European Collective Trade Mark Registration No. 005054606 VALPOLICELLA RIPASSO registered in Class 32 for “*alcoholic beverages (except beers) and wine from the Valpolicella region*”. It then raises objection to the present application under various Sections of the Act, which I summarise as follows:

- Section 10(2)(b) – *likelihood of confusion on the part of the public, including a likelihood of association with the Opponent’s earlier trade mark;*
- Section 10(3) – *use of the applied for mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s Trade Marks;*
- Section 10(4)(a) – *use of the Applicant’s mark in the State is liable to be prevented 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.*

7. In its Counter-Statement the Applicant denies all the grounds of opposition and puts the Opponent on proof to substantiate each and all of the allegations claimed in its Notice of Opposition.

The Opponent’s Evidence Under Rule 20

8. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration and supporting evidence, by way of eight exhibits labelled “GR1” to “GR8”, dated 17 November, 2017 of Giuseppe Riello, President of the Opponent.

9. Mr Riello refers to the Opponent's proprietorship of its Collective EUTM and explains the functioning of a collective mark and how it distinguishes the goods of members of an association who use the mark from those of competitors. Collective marks are often used to identify products which share certain characteristics, and in this case the mark identifies a very specific type of Italian red wine conforming to certain production criteria and characteristics and originating in a particular geographic area. The mark was registered to give members of the Opponent's association the exclusive right to use VALPOLICELLA RIPASSO for alcoholic beverages (except beers) and wine from the Valpolicella region and to prevent other traders from using the mark or any confusingly similar mark on identical or similar goods without authorisation. He attaches at Exhibit "GR1" full particulars of the earlier mark taken from the European Union Intellectual Property Office (EUIPO) database.
10. Mr Riello explains that Valpolicella is a grape producing zone that is famous for its wines. Testament to this is that Valpolicella ranks just after Chianti in total Italian Denominazione di Origin Controllata (D.O.C.) wine production. He says the red wine known as "Valpolicella" is typically made from three specific grape varieties. A variety of wine styles is produced in the area, including a "*recioto*" dessert wine and "*Amarone*", a strong wine made from dried grapes. There is the standard Valpolicella Classico, a Valpolicella Superiore (which is aged at least one year and has an alcohol content of at least 12 percent) and Valpolicella Ripasso, a form of Valpolicella Superiore made with partially dried grape skins that have been left over from fermentation of Amarone or recioto. He says the tradition of using partially dried grapes in the Veneto region dates from the time of the ancient Greeks and the wines produced were made in what was known as the "Greco" or "Greek" style.
11. Mr Riello says in the late 20th century a new style of wine known as "ripasso" (meaning "repassed") emerged. The first Valpolicella producer to commercially market a "ripasso" did so in the early 1980s. In 2009, Ripasso della Valpolicella received its own D.O.C. designation. He attaches at Exhibit "GR2" the decree, published in the Official Gazette in 2010, which stipulates the production criteria wines must meet in order to carry the designation "Valpolicella Ripasso".
12. He explains SIQURIA S.p.A. is the Italian body responsible for the quality and traceability of foodstuffs and attaches at Exhibit "GR3" three certificates from SIQURIA S.p.A. (for 2011, 2012 and 2013) for the wine D.O.C. Valpolicella Ripasso Superiore. These certify that the wines conform to the production specifications and therefore can legitimately use the Protected Geographical Indication "D.O.C. Valpolicella Ripasso" and the European Union Collective

Trade Mark “Valpolicella Ripasso” in documentation and labelling. Accordingly, to legitimately use the word “Ripasso” strict controls on production and quality are necessary and which can only be certified by the official Italian body.

13. Mr Riello states Valpolicella Ripasso wines are extremely well known throughout Europe and the world. He provides statistics (by way of Exhibit “GR4”) in respect of production volumes of the wines for the years 2012 to 2016, which range from 180,000 to 210,000 hectolitres.
14. He attaches at Exhibit “GR5” extracts from the website of the Concours Mondial de Bruxelles (a prestigious international wine competition) showing the gold and silver medals awarded to producers of Valpolicella Ripasso wines since 2006.
15. Mr Riello says wines bearing the trade mark Valpolicella Ripasso are widely available in Ireland and he attaches at Exhibit “GR6” a selection of offerings from the websites of a number of well-known Irish wine suppliers, including SuperValu, Wines Direct, O’Briens, Aldi, Centra and Wineonline.ie.
16. He then speaks about the damage to the renown and reputation of Valpolicella Ripasso wines and the confusion being caused to consumers by the Applicant’s use of the disputed mark. He says the Opponent has assiduously sought to promote and educate the purchasing public about the sub-category of Valpolicella wines which are sold under the very specific D.O.C. Valpolicella Ripasso. He says the Applicant’s mark contains the word RIPASSA which is an obvious and wilful corruption of the word RIPASSO, which will undoubtedly confuse the public and damage the accrued distinctive character and reputation of the Opponent’s earlier mark. He states evidence of such confusion can be seen already in the Irish market and he attaches at Exhibit “GR7” materials available in Ireland in respect of the Applicant’s mark, which include an advertisement from the online off licence www.drinkstore.ie for ZENATO RIPASSA wine, which states:

“Zenato gives the name ‘Ripassa’ to this wine, which shares many of the characteristics of their Amarone. As soon as the fermentation is completed of the dried grapes for the Amarone, selected lots of Valpolicella are then ‘repassed’ on the Amarone pomace, thus initiating a second fermentation which increases slightly the alcohol content and gives the wine deeper colour, increased extract, and more complex aromas. After 6 months bottle-ageing, the result is a rounded, velvet-textured wine with rich, complex aromas of berries and an impressively lengthy finish that seems to linger forever.”

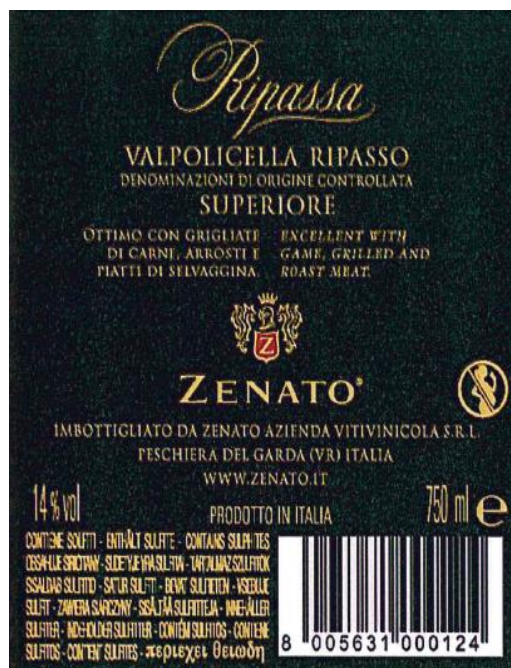
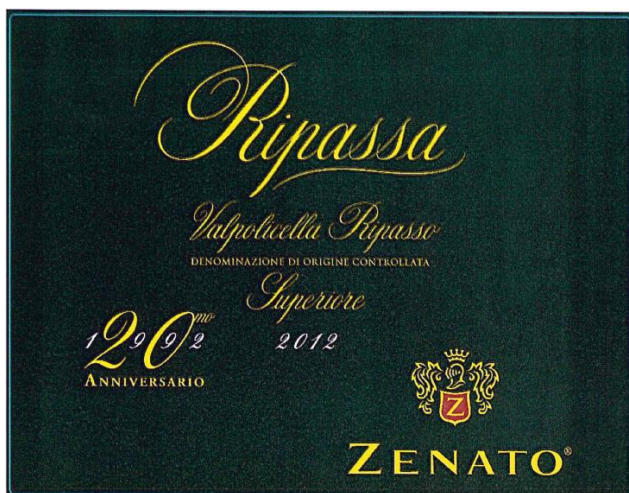
17. Mr Riello says the Irish retailer does not realise that the word RIPASSA is not the correct term for the type of wine made from the “repassed” procedure and which is the subject of the D.O.C. Valpolicella Ripasso and this type of confusion over the correct name for the wine variety will then be passed on to the wine purchaser. If the general public begin to use the word “Ripassa” instead of the word “Ripasso” then both the earlier mark and the D.O.C. for these wines will be greatly damaged and undermined. He mentions extracts from advertisements of well-established wine retailers (McCabe Wines and Donnybrook Fair) wherein “Ripassa” is interchanged for “Ripasso” and extracts from reviews of wine critics which also confuse “Ripassa” for “Ripasso”.
18. The final piece of evidence submitted by Mr Riello is attached at Exhibit “GR8” and contains copies of hundreds of invoices and other material which support the Opponent’s claimed extensive worldwide use and renown of its earlier mark.

The Applicant’s Evidence Under Rule 21

19. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration and supporting evidence, by way of nineteen exhibits labelled “NZ1” to “NZ19”, dated 20 July, 2018 of Nadia Zenato, sole Director of the Applicant.
20. Ms Zenato attaches at Exhibit “NZ1” extracts from the European Commission Register of Protected Designation of Origin and protected Geographical Indications showing the protected designations VALPOLICELLA, VALPOLICELLA RIPASSO, AMARONE DELLA VALPOLICELLA and RECIOTO DELLA VALPOLICELLA. She says SIQURIA S.p.A. issues certificates to companies and individuals attesting that their goods comply with the production specifications of these four Denominazione di Origine Controllatas. She attaches at Exhibit “NZ2” the accreditation certificate of SIQURIA S.p.A. which states the organisation is the official certifier of products within the agricultural sector in Italy, including wines.
21. Ms Zenato states her company is 100% owned by Zenato Azienda Vitivinicola S.r.l. and attaches at Exhibit “NZ3” an extract from the company register relating to both companies. She says her company has received certification from SIQURIA S.p.A. stating that its wines comply with the production specifications of the D.O.C. VALPOLICELLA RIPASSO SUPERIORE in respect of a number of batches of over 1 million hectolitres of wine and attaches at Exhibit “NZ4” certificates to that effect for the years 2012, 2013, 2014, 2015 and 2016, all in the name of Zenato Azienda Vitivinicola S.r.l.

22. Ms Zenato explains that the certificates are dated after the grapes have been harvested, so that, for example, the certificate dated 2016 relates to grapes harvested in 2013. This reflects the fact that, due to the fermentation technique used, it takes some time for the product to be bottled, packaged and commercialised, all of which must happen within two years of the certification having been issued.

23. She states that since her company is certified by SIQURIA, it naturally describes the product it sells as VALPOLICELLA RIPASSO SUPERIORE, as it is entitled to do. She attaches at Exhibit “NZ5” examples of the front and back labels applied to her company’s VALPOLICELLA RIPASSO SUPERIORE wine, which I reproduce below.



24. Ms Zenato explains that for the purposes of registration as a trade mark the descriptive parts of the label were deleted. What remains are the dominant and distinctive parts of the label which serve as the trade mark for her company’s D.O.C. VALPOLICELLA RIPASSO SUPERIORE wine. She states it is her understanding that this is common practice when filing trade mark applications for drink/wine labels.

25. Ms Zenato states the Applicant has never been a licensee of the Opponent, and therefore is not subject to the regulations governing the use of the collective trade mark. However, the Applicant is authorised to use the term VALPOLICELLA RIPASSO SUPERIORE, as shown by the certificates provided by SIQURIA S.p.A., and does so. Notwithstanding that, Ms Zenato points to the Regulations relating to the Opponent’s Collective Trade Mark No. 5054606, a copy of which she attaches at Exhibit “NZ6” and claims her company’s mark is not in breach of

the Regulations by virtue of the provision which states: *“The provisions of this Article [relating to beneficiaries using their own trade marks] shall not apply to the filing, as a figurative mark, of labels to be used on bottles, where those figurative marks expressly contain the name or the company name of the Beneficiary and are related to products authorised in the License”*.

26. Ms Zenato states trade marks and/or company names are consistently used alongside the D.O.C. in various forms. In this case Zenato is her family name and the house brand. It is the more distinctive and dominant element of the mark. She says the “RIPASSA” element is secondary. She states many Italian wine producers use the sign “ripasso” in reference to a method of wine production, as it is the term used to describe the “repassed” refermentation process. In this regard, she attaches at Exhibit “NZ7” a less selective extract from Wikipedia than that quoted by Mr Riello in his Statutory Declaration relating to “Valpolicella”, the viticulture zone of the province of Verona, Italy, which includes the following:

When the [ripasso] style first became popular in the late 20th century, it was rarely noted on the wine label. There was also debate about whether it was even permitted to be included under DOC regulations. If it was mentioned at all it was relegated to the back label wine description notes. Today the term ripasso is freely permitted to be used, with several examples on the wine market labelled as being made in the ripasso style.

27. In support of her claims that “ripasso” is a descriptive term, Ms Zenato refers to the endeavours of Masi Agricola S.p.A. who applied to register the word “RIPASSO” as a EUTM at the EUIPO on 22 May, 1996 under No. 270843. The application was refused on the basis that the term was *“a word used to refer to a method of refermenting Valpolicella on the fermented lees of dried grapes... As such, the word is descriptive... and is not capable of distinguishing the applicant’s wines, thus produced, from the wines of other companies having the same characteristics”*. She states that in reaching its decision the Board of Appeal performed various internet searches that resulted in many references to “ripasso wines” not produced by the applicant and also found many generic references to the “ripasso process” and articles about the “ripasso method”. She attaches at Exhibit “NZ8” an extract from the EUIPO Register for the refused application No. 270843, together with a copy of the decision of the Second Board of Appeal dated 3 August, 2004.
28. Ms Zenato attached at Exhibits “NZ9”, “NZ10”, “NZ11” and “NZ12” materials from a variety of sources that refer to “ripasso” as meaning “repassed”, all of which use the term in a descriptive sense.

29. She takes issue with what she sees as Mr Riello's highly selective evidence that the terms Ripasso and Ripassa are being used interchangeably. She says this is not the case and that her company's use of the term Ripassa is never in the generic sense but always in connection with the Applicant's trade mark for its wine. She states this is reflected in the evidence submitted by Mr Riello wherein he references extracts from websites of various wine retailers and the reviews of a number of wine critics. She maintains the relevant consumer is aware of the reputation for her company's wine in Ireland for D.O.C. Valpolicella Ripasso Superiore wine – the only type of wine on which her company uses its RIPASSA ZENATO trade mark.
30. Ms Zenato states her company's mark was first used in Italy in 1995. She says ZENATO RIPASSA and a RIPASSA ZENATO logo mark were registered in 2007 in Italy under No's. 1060394 and 1060395 respectively and have co-existed alongside the Opponent's registrations. In support of this statement she attaches at Exhibit "NZ13" extracts from the Italian Trade Mark Register.
31. Ms Zenato says her company's trade mark has been used in Ireland since 2001, being 5 years before the Opponent's collective trade mark was applied for as a EUTM on 3 May, 2006. Ms Zenato explains that, although the disputed mark has been used in Ireland since 2001, she has only been able to source copies of sales invoices from her Irish distributor for the period 2006 to 2017. She provides estimates for the volume of sales and turnover for each of these years which point to over 220,000 bottles being sold and turnover in excess of €1.3 million. Exhibit "NZ14" contains dozens of invoices evidencing sales in Ireland from 2006 to date.
32. Ms Zenato attaches at Exhibit "NZ15" photographs of product labels that appear on the Irish market, together with product information, and listings within local wine catalogues and brochures. At Exhibit "NZ16" she attaches an extract from her company's website which includes a product description for her company's wine and lists the many awards that have been granted to that wine since as early as 2004. She notes her company's D.O.C. VALPOLICELLA RIPASSO SUPERIORE wine was included in the evidence submitted by Mr Riello detailing the awards won by producers of DOC wines in the Valpolicella region.
33. Ms Zenato states the present application results from the conversion of former EUTM application No. 5877865 dated 7 May, 2007. The original application was opposed by the Opponent based solely on an earlier Italian registration for the word "RIPASSO" dated 15 May,

1996 and not based on the collective mark “VALPOLICELLA RIPASSO” upon which the present opposition is grounded. The EUIPO initially rejected the opposition on the basis that the earlier trade mark had a low degree of visual similarity, aurally the marks were similar to a certain degree, but there was no conceptual similarity between them. In rejecting the opposition, the Opposition Division cited the decision of the Second Board of Appeal to refuse the earlier mentioned Masi Agricola S.p.A. application to register the word “RIPASSO”. On appeal, the Board of Appeal held in favour of the Opponent, solely on the basis of the Opponent’s earlier Italian registration for “RIPASSO” and rejected her company’s application. She attaches at Exhibit “NZ17” an extract from the EUIPO Register for her company’s EUTM application together with a copy of the decision of the Second Board of Appeal. However, she says there is no similarity with the position in the instant case where the opposition is based on the composite mark VALPOLICELLA RIPASSO.

34. Ms Zenato provides details of the outcome of various opposition proceedings before EU National Offices (the oppositions being upheld in the United Kingdom and Austria, but ultimately rejected in Denmark, Finland and Sweden). She attaches at Exhibit “NZ18” a copy of the decision of the Danish Board of Appeal and at Exhibit “NZ19” copies of the decisions of the Finnish and Swedish National Offices.
35. Ms Zenato concludes her evidence by stating that during the past 17 years throughout which her company has used the trade mark in Ireland there have been no reported cases of confusion with the Opponent’s collective trade mark, not least because her company uses, with the permission of SIQURIA S.p.A., D.O.C. VALPOLICELLA RIPASSO SUPERIORE on its labels.
36. The Opponent decided not to file evidence in reply and both parties declined to elect to neither attend at a Hearing or to file written submissions in lieu of attending. Both expressed a preference for the Controller to decide the issue on the material already filed.

Collective Trade Marks

37. Before addressing the specific grounds of opposition, I think it prudent to consider the legislation regarding European Union collective trade marks and the peculiarities of the relevant provisions which are set out in Regulation (EU) 2017/1001 of the European Parliament and of the Council (the “EU Trade Mark Regulations”).

38. Collective marks must be owned by an association and all members of the association can use the mark. In order to secure the registration of an EU collective trade mark the association who owns the mark must provide the EUIPO with a set of regulations specifying the terms and conditions of its use, including rules regarding the persons authorised to use the mark, the conditions of membership of the association and, where they exist, any sanctions for members in respect of improper use. Importantly, these regulations must also authorise any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark. It is clear to me from the evidence submitted by both parties that the Applicant is entitled to become a member of the association that owns the collective mark VALPOLICELLA RIPASSO, but chose for reasons unspecified, not to join the association.

39. It is also clear from the legislation that collective marks can comprise material that would not be registrable as an ordinary trade mark. Looking at the Opponent's mark, it consists of a geographical reference to a place in Italy (VALPOLICELLA) and an element that describes a fermentation process (RIPASSO). In my opinion neither element is registrable in its own right (in the case of RIPASSO the EUIPO confirmed as much when rejecting the Masi Agricola S.p.A. application for its registration), nor would the elements when combined be registrable as an ordinary trade mark, because no single individual or company could rightly be given a monopoly in, or exclusive rights to, the geographical and descriptive term VALPOLICELLA RIPASSO. However, the EU Trade Mark Regulations provide for the registration in the form of collective marks signs that contain geographical references by virtue of the derogation in Article 74(2) which states:

“By way of derogation from Article 7(1)(c)¹, signs or indications which may serve, in trade, to designate the geographical origin of the goods or services may constitute EU collective marks within the meaning of paragraph 1.”

40. Additionally, Article 73(2) of the EU Trade Mark Regulations goes on to say that the proprietor of a collective trade mark cannot prohibit a third party from using in the course of trade the collective trade mark where such use is in accordance with honest practices. Furthermore, and most importantly, the proprietor of a collective trade mark cannot invoke its mark against a third party who is entitled to use a geographical name. The relevant provision in Article 74(2) is written in the following terms:

¹ The prohibition on the registration of trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the... geographical origin... of the goods.

“An EU collective mark shall not entitle the proprietor to prohibit a third party from using in the course of trade such signs or indications, provided that he uses them in accordance with honest practices in industrial or commercial matters; in particular, such a mark shall not be invoked against a third party who is entitled to use a geographical name.”

41. It appears to me the legislators recognised that a term which is registered as a collective mark can be used both in a trade mark sense and in a descriptive sense, and accordingly, made provisions to prohibit the proprietor of a registered collective mark from stopping a third party from using the term in a descriptive manner, if that third party has an entitlement to use it in such a manner.
42. The evidence submitted by the Applicant clearly shows that its produce meets the exacting specifications set out by SIQURIA S.p.A. (the Italian body responsible for the quality and traceability of foodstuffs) to allow the Applicant to use the D.O.C. VALPOLICELLA RIPASSO SUPERIORE to describe its wine. The Applicant provided certificates from SIQURIA S.p.A. to demonstrate this. Therefore, under Article 74(2) of the EU Trade Mark Regulations the Applicant has every right to use the term in connection with its qualifying wines, which means the Opponent cannot prohibit such use.
43. Having said that, the question as to whether the right to use the term VALPOLICELLA RIPASSO extends to a right to seek registration for a trade mark that contains the term is not answered by the EU Trade Mark Regulations. So, I turn now to the grounds of opposition.

Section 10(2)(b)

44. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads as follows:
- (2) A trade mark shall not be registered if because –*
- (a) ...*
- (b) it is similar to an earlier trade mark and would 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 of the later trade mark with the earlier trade mark.*
45. As is evident from the wording of Section 10(2), the four basic requirements that must be met in order for an objection under it to succeed are that, (i) there must be “an earlier trade mark”, (ii)

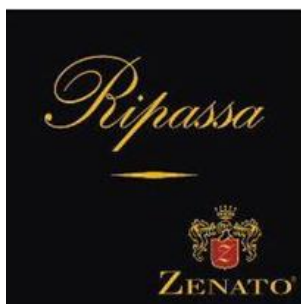
the goods of the application must be identical with or similar to those in respect of which the earlier trade mark is protected, (iii) the mark applied for must be similar to that earlier trade mark, and, (iv) there must be a resultant likelihood of confusion on the part of the public.

46. The first two of these conditions are clearly fulfilled. The Opponent's mark was filed at the EUIPO on 3 May, 2006 and by virtue of Section 11(1)(b) of the Act, it is an earlier trade mark as against the present application for the purposes of Section 10. The goods in the application for registration are identical with the goods for which the Opponent's earlier trade mark is registered, as both include "*alcoholic beverages (except beers)*" in Class 33.

Comparison of the marks

47. I have compared the respective marks of the parties on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below, I am mindful that the Court of Justice of the European Union has noted (in *Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*)² that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

48. There is limited visual and aural similarity between the marks as can readily be seen when the marks are placed side-by-side as below.



VALPOLICELLA RIPASSO

² Paragraph 23 of decision dated 11 November, 1997

49. The Applicant's mark contains one figurative and two verbal elements, the words are in different sizes and are depicted in different typefaces, and there are three colours in play. The Opponent's mark is purely verbal, depicted solely in uppercase letters in a standard black font. The Applicant's mark contains the word ZENATO and a family crest, which are not present in the Opponent's mark. While the word VALPOLICELLA appears in the Opponent's mark it is absent from the disputed mark. The commonality that exists relates to the first six letters R-I-P-A-S-S of the remaining word element in each of the marks.
50. In light of the shared R-I-P-A-S-S element I find there is some visual and aural similarity between the marks. However, when the non-shared elements are considered, I find there is a low level of overall visual and verbal similarity.
51. The Opponent's mark is purely descriptive and does not contain any elements that are inherently distinctive. The mark may have gained secondary meaning through the use made of it to such an extent that it may have acquired distinctiveness. But I find it difficult to definitively establish from the evidence that use of the mark resulted in consumers instinctively recognising it as a trade mark in its own right and not as a term that describes a type of wine that consumers may associate with many different Valpolicella Ripasso wine producers, not just the members of the association that is the proprietor of the VALPOLICELLA RIPASSO collective trade mark. Accordingly, I can be satisfied only that the Opponent's mark conveys the message that it is a Ripasso wine from Valpolicella.
52. The Applicant admits it uses the term Valpolicella Ripasso on its labels, but that is not the same as Valpolicella having a presence in the disputed mark. In any event, I am completely satisfied the Applicant's use of the term is for the purpose of identifying the wine being sold under the Applicant's mark as a Valpolicella Ripasso, which the Applicant is permitted to do by virtue of its wine fulfilling the requirements to use the PGI Valpolicella Ripasso. Such use is not use in a trade mark sense but use in a descriptive sense, or as a PGI, which is explicitly provided for under the EU Trade Mark Regulations governing the registration of collective trade marks.
53. The Applicant claims the word RIPASSA in its mark is invented and fanciful, whereas, the Opponent maintains it is a conscious and direct play on the word Ripasso. On this I agree with the Opponent. However, this does not have a significant bearing on the assessment of the conceptual similarities between the marks. The message conveyed by the Applicant's mark is that it is Ripasso wine from the Zenato family. The term Valpolicella is not part of the mark

applied for, so conceptually the mark in and of itself cannot be read as an indication that the Applicant's wine is a Valpolicella Ripasso.

54. I find both marks identify the source of a ripasso wine, but in each case the source is different. Conceptually I am satisfied the Applicant's mark relates specifically to the particular source of a ripasso wine which is the ZENATO brand owner, as distinct from the general membership of the association that is the source of the wine bearing the Opponent's mark. Therefore, conceptually they are somewhat dissimilar. Having completed a global assessment, I find that the two marks share a very low level of overall similarity.

Likelihood of confusion

55. The question is whether the very low level of similarity is nonetheless sufficient to come within the meaning of Section 10(2)(b) of the Act? The criteria against which that assessment must be made has been enunciated in a number of decisions of the European Court of Justice³ and they include the following:

- a. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa;
- b. the more distinctive the earlier mark, the greater will be the likelihood of confusion;
- c. in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings;
- d. in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations;
- e. a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed;

³ Sabel BV –v- Puma AG and Rudolph Dassler Sport (Case C-251/95) [1998] 1 CMLR 445; Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc. (Case C-39/97) [1999] 1 CMLR 77; Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV (Case C-342/97) [1999] 2 CMLR 1343

- f. the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind;
- g. the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

56. In applying those criteria to the facts of the present case, I regard the marks in question as having a very low level of similarity. However, the goods covered by the Application (Alcoholic beverages except beers) are identical to those of the earlier registration, which means a lower level of similarity between the marks could be deemed sufficient to declare a likelihood of confusion exists. Bearing this important consideration in mind I am satisfied nonetheless that the actual level of similarity between the marks falls way short of what is required in order for me to conclude that such a likelihood exists.

57. The Opponent's mark lacks any inherent distinctiveness and therefore it does not have an obvious capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from the goods of other undertakings. However, the Opponent's mark has been used in the European Union since May 2006 and through such use it may have acquired a certain level of distinctiveness. I say "may have" because it appears to me that recognition of the term Valpolicella Ripasso does not necessarily equate to the Opponent's collective trade mark having acquired distinctiveness, as there is every likelihood that knowledge of the term Valpolicella Ripasso has resulted from the use of the Valpolicella Ripasso PGI's, which dates from 2009, as through use of the Opponent's collective trade mark.

58. The overall impression created by the marks in question is that they are very different. The wording is different, the concept is somewhat different, and in my opinion, the additional elements of the Applicant's mark reinforce significantly that difference.

59. The class of goods is not broad, but relates to alcoholic drinks which are controlled substances in Ireland and restricted to persons over the age of eighteen. This confines consumers of the goods to the general Irish adult public.

60. The Applicant has provided ample evidence to justify its claims that its RIPASSA ZENATO mark has been long-used in Ireland. Invoices, volume of sales figures and turnover all point to a

long-standing and successful market presence in Ireland. Even the Opponent has provided material relating to the Applicant's wine being sold by a number of Irish wine retailers and has referred to coverage of the Applicant's mark in advertising and reviews.

Overall assessment of likelihood of confusion:

61. In light of the foregoing factors, I am required to make an overall assessment of the likelihood of confusion that may exist between the Opponent's earlier trade mark and the Applicant's mark. The confusion in question may be direct confusion, whereby the Applicant's product is mistaken for that of the Opponent, or indirect confusion, whereby the Applicant's product is associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer of the goods in question. In essence I must judge the matter of the assessment of likelihood of confusion in accordance with ECJ guidance to decision-makers, which can be summarised as follows: *Imagine a typical purchasing scenario involving the average person who already knows the product sold under the earlier trade mark and ask yourself whether it is likely that he will select and purchase a product bearing the mark put forward for registration in the mistaken belief that it is the product he knows by the earlier mark (direct confusion) or that it is related to that product (indirect confusion by association).* It is not necessary to find that every consumer would be confused and nor is it sufficient to find that some consumers might be confused in order to refuse registration of a trade mark under the section. The question is whether it is likely or unlikely that the average person would be confused in the course of the typical purchasing scenario. In the present case, I have decided that there is no likelihood of confusion or association for the reasons stated below.

62. There is a lot more going on with the Applicant's mark than just the word RIPASSA and, in my opinion, the word ZENATO and the family crest element contribute significantly to its distinctiveness and serve to distance the Applicant's mark from that of the Opponent. The visual, aural and conceptual differences between the disputed mark and the Opponent's mark are so obvious that a person exercising reasonable care would be unlikely to select goods bearing the Applicant's mark in place of one bearing the Opponent's mark. The trade marks do not look or sound sufficiently similar to make direct confusion between them a real likelihood. Even allowing for imperfect recollection, confusion seems unlikely because the distinctive

features of the Applicant's mark, which create its lasting impression (ZENATO and the family crest) are not reproduced in the Opponent's mark.

63. Having fully considered all the evidence and exhibits I am satisfied the Applicant's mark does not offend against Section 10(2)(b) of the Act and, therefore I reject the opposition on this ground.

Unfair Advantage - Section 10(3)

64. Turning now to grounds of opposition in respect of Section 10(3) of the Act which provide as follows:

“(3) A trade mark which is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of an EU trade mark, in the European Union) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.

65. The purpose and effect of that provision is to afford an extra level of protection to marks that have a reputation over and above that which is given to other trade marks. As is evident from the wording of the Section, there are a number of conditions that must be fulfilled in order for it to apply. Firstly, there must be identity or similarity of the marks at issue; secondly, the earlier mark must have a reputation in the State or in the EU; thirdly, the use of the later trade mark must be without due cause; and fourthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.

66. I have already found that the first two conditions are met – there is a level of similarity (albeit very low) with the Opponent's mark and that the term VALPOLICELLO RIPASSO enjoys some reputation in the EU (though as already mentioned that could be as a result of the Valpolicella Ripasso PGI). However, is the Opponent's reputation entitled to protection under the Paris Convention as a well-known trade mark and does it enjoy the type of reputation that Section 10(3) seeks to protect? Such a reputation would be expected to extend beyond the limited class of consumers of the Opponent's goods and to penetrate the consciousness of the wider public such that a substantial number of people would know and recognise the mark even if they had never used the Opponent's goods. In my opinion the Opponent's reputation does not reach that level.

67. The waters get murkier in terms of the taking of unfair advantage by the added complication of the Valpolicella Ripasso PGI, which the Applicant is entitled to use in respect of its qualifying wine. In lodging this opposition, it appears to me the Opponent is either ignoring that fact or is claiming its collective trade mark rights trump those of the PGI. Neither proposition is correct or sustainable. In my opinion, if either right should have any precedence over the other it should be the PGI. A right to use a PGI is based strictly on the product being produced in accordance with the specifications governing the PGI. No-one can be prohibited from using it on any other grounds. In contrast, the right to use a collective trade mark is restricted to those who are members of the association that owns the mark which brings all kinds of other factors into play, including personalities.
68. This can result in a clear mismatch between the collective trade mark provisions of the EU Trade Mark Regulations and the Protected Geographical Indications registration system. As a result of two separate property rights, with different provisions attaching to each, the potential for conflicts is rife. In these proceedings, a wine producer whose wine is certified as qualifying to use the PGI may not be, or want to be, a member of the association that owns the collective trade mark for the same term. Both the collective trade mark and the PGI exist to protect VALPOLICELLA RIPASSO wines, yet as is happening here, a legitimate user of the PGI can find itself under attack by the association that owns the collective trade mark.
69. So, as regards the third condition, it is clear to me that the Applicant, by virtue of its right to use the Valpolicella Ripasso PGI, has due cause to use that term in trade. That is sufficient to reject the opposition based on Section 10(3), but for completeness sake I shall look at the fourth condition that use of the Applicant's trade mark must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the Opponent's mark. As stated earlier the Applicant admits to using the term Valpolicella Ripasso on its wine labels. I have already found that this is not use in a trade mark sense and, anyhow, the term does not feature in the disputed mark. All things considered, the Opponent's claim does not stack up. Its own evidence shows the Applicant's DOC VALPOLICELLA RIPASSO SUPERIORE wine was among the winners at the prestigious Concours Mondial de Bruxelles international wine awards. Therefore, it is clear the use by the Applicant of the term Valpolicella Ripasso in trade is actually enhancing the prestige and renown of the term, not detracting from it. Therefore, for these reasons I reject the opposition based on Section 10(3) of the Act.

Use Prevented by Law - Section 10(4)(a)

70. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the State 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...”

71. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the disputed mark in relation to the goods covered by the application would, as of the relevant date, have constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation would have caused damage to the Opponent. While I have previously found that the Opponent’s evidence does not prove that its mark was entitled to protection under the Paris Convention as a well-known trade under Section 10(3), I do accept the Opponent had, prior to the relevant date, a protectable goodwill under the mark in relation to the goods for which it is registered.

72. That being said, I do not accept that the use by the Applicant of a mark, which is quite different from the Opponent’s mark, could on any reasonable interpretation, constitute a misrepresentation leading to damage. For the use by the Applicant of its trade mark to be liable to be prevented by virtue of the law of passing off, it would be necessary for the Opponent to show that such use would constitute a misrepresentation, leading to damage, that the goods so marked were those of the Opponent. In the absence, as I have found, of any likelihood of confusion or association between the respective marks, I cannot see how there could be any misrepresentation as to the provenance of the Applicant’s goods by virtue of the use of its trade mark and nor is it conceivable that the Opponent could suffer loss or damage if the Applicant’s mark were used in a normal and fair manner as a trade mark for the relevant goods. The basic ingredients of an action for passing off have not been established and I do not believe, therefore, that the use by the Applicant of the mark propounded for registration is liable to be prevented by the law of passing off and, accordingly, I dismiss the opposition under Section 10(4).

73. For all the reasons outlined above, I have decided that the prior registration and use of the Opponent’s collective European Union Trade Mark does not constitute grounds for refusal of

the application to register the Applicant's mark. Therefore, I have decided to dismiss the opposition and to allow the mark to proceed to registration.

Dermot Doyle

Acting for the Controller

13 August 2019