

O-016-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 794303
BY DIWISA DISTILLERIE WILLISAU SA
TO REGISTER A TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 71020
BY BRASSERIE FISCHER**

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by Brasserie Fischer**

BACKGROUND

1. On 2 December 2002 DIWISA Distillerie Willisau SA applied to protect the trade mark CROSSKA in Classes 32 and 33 of the Register under the provisions of the Madrid Protocol on the basis of registration in Switzerland and an International Priority Claim Date of 19 September 2002.
2. Class 32 was deleted from the application and protection is now sought only in relation to “Alcoholic beverages (except beer)” which fall within Class 33.
3. The application was subsequently published in the Trade Marks Journal and on 20 June 2003 Brasserie Fischer filed Notice of Opposition. In summary the grounds are under Section 5(2)(b) of the Act, because the mark applied for is similar to the following earlier trade mark owned by the opponent which covers identical and similar goods and there exists a likelihood of confusion on the part of the public –

Registration No.	Mark	Search Significant date	Specification of goods
International Registration No. 765575		21 February 2001	Class 32: Beers.

4. The applicant filed a Counterstatement denying the grounds of opposition, adding that the suffix SKA is common in Class 33 which means greater emphasis would be placed on the prefixes CROS and KRI.
5. The opponent filed evidence and forwarded written submissions for the hearing officer's consideration. Both parties requested an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing.

OPPONENT'S EVIDENCE

6. The opponent's evidence consists of a witness statement dated 18 June 2004 by Mr Hombeline du Parc-Tredaniel. Mr Parc-Tredaniel is Legal Manager of Brasserie Fischer (the opponent).

7. Mr Parc-Tredaniel confirms that Class 32 has been deleted from the specification of the mark in suit and provides details going to the ownership and validity of the earlier trade mark.

OPPONENT'S SUBMISSIONS

8. The opponent's written submissions are contained in a letter dated 10 December 2004 from Frank B Dehn & Co, the opponent's professional advisors in these proceedings.

9. The opponent draws attention to the *Sabel BV v Puma AG* decision of the European Court of Justice and goes on to compare the respective marks before me. It submits that phonetically the two marks are virtually identical as they both consist of two syllables, have phonetically identical starting letters ("KR" and "CR") and phonetically identical endings ("SKA" and "SSKA"). The opponent goes on to state that the sole phonetic difference between the marks is the single letter "I" in the opponent's mark and the letter "O" in the mark applied for – a short syllable given little prominence. In the opponent's view it is highly likely that confusion would occur through imperfect recollection and the trade channels through which the goods are sold.

10. Turning to a comparison of the goods, the opponent submits that the respective goods are highly similar. It states that in nature they are all alcoholic drinks which would be purchased by the same consumers, they are sold through the same trade channels e.g. off licences and supermarkets, where they would be sold in close proximity. The opponent also points out that both "Beers" and "Alcoholic beverages (except beer)" are commonly sold in pubs, bars, cafes and clubs and that it is in these sort of establishments where phonetic similarity is particularly pertinent.

11. This concludes my summary of the evidence and submissions. I now turn to the decision.

DECISION

Section 5(2)(b)

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

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

13. An earlier right is defined in Section 6, the relevant parts of which state:

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

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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,”

14. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

15. It is clear from these cases that:

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*;
- (g) account should be taken 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 was registered; *Lloyd*;

- (h) mere aural similarity between trade marks may create a likelihood of confusion; *Lloyd*;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.*

16. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my considerations on whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. As I have no evidence to demonstrate use of the respective marks in the UK in relation to the relevant goods, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on the goods covered within the respective specifications.

17. I turn first to a comparison of the respective goods and have to decide whether the goods covered by the application are the same or similar to the goods covered by the opponent's registration. In relation to the determination of similarity of goods I have considered the guidelines formulated by Jacob J in *British Sugar v James Robertson & Sons Ltd* [1996] RPC 281 (pages 296, 297) as set out below -

“The following factors must be relevant in considering whether there is or is not similarity:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of services;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in particular they are respectively found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for the industry, put the goods or services in the same or different sectors.”

18. Whilst I acknowledge that in view of the CANON-MGM judgement by the European Court of Justice (3-39/97) the Treat case may no longer be wholly relied upon, the ECJ said the factors identified by the UK Government in its submissions (which are listed in Treat) are still relevant in respect of comparison of goods.

19. The application is in respect of “Alcoholic beverages (except beer)” in Class 33, which would encompass wines, spirits such as whisky, vodka etc, cider and “alcopops”. The earlier mark is registered in respect of “Beers” in Class 32.

20. In my considerations I am mindful of the following comments from the *Balmoral Trade Mark* Case [1998] RPC 297 where similarity between whisky and wines was an issue:

“At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different products which emanate (and are known to emanate) from producers specialising in different and distinct fields of commercial activity. This was said to render it unlikely that a producer of whisky would become (or be expected to become) a wine producer and unlikely that a producer of whisky who did become a wine producer would market (or be expected to market) his whisky and wines under the same trade mark. I was urged to accept that this made it possible for one producer to use a mark for whisky and another producer to use the same mark concurrently for wines without any real likelihood of confusion ensuing.

I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the applicant over-emphasise the part played by producers and under-emphasise the part played by other traders in the business of buying and selling whisky and wines.

It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of “own brand” or “merchant-specific” labelling. Those who supply retail customers may be licensed to do so under an “off-licence” or a licence for “on and off sales” in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well.

When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar* case (uses, users and physical nature of the relevant goods and service; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines.”

21. The goods at issue there were whisky and wines. However, I see no basis for coming to a different view where beers and other alcoholic beverages such as wine, spirits, cider and ‘alcopops’ are concerned, bearing in mind the observations of the Appointed Person in relation to the importance of the merchandising of the goods and the channels of trade. The respective goods are similar.

22. I now go to a comparison of the mark in suit with the opponent’s earlier registration. In the Counterstatement, the applicant submits that the suffix SKA is common in Class 33. However, there is no evidence on this point and in any event the applicant’s comments amount to no more than ‘state of the register information’. I am not assisted by such submissions and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting or of incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

23. My decision involves a comparison of the applicant’s and opponent’s particular marks and must be made on its own merits, taking into account notional and fair use of the respective marks.

24. The applicant’s mark consists of the invented word CROSSKA presented in upper case. The opponent’s earlier registration comprises the invented word KRISKA presented in a slightly stylised manner, but essentially the word presented in upper case. I would add that the opponent’s earlier registration is a highly distinctive mark deserving a wide penumbra of protection.

25. It is clear from the guiding authorities that the respective marks must be compared as a whole and by reference to overall impression. Furthermore, I must be careful not to overanalyse the marks as the real test is how customers would perceive the marks in the normal course and circumstances of trade.

26. Visually, the respective marks CROSSKA and KRISKA comprise seven and six letters respectively. They share the same second letter, the letter “R” and their final three letters – “SKA”. However, it seems to me that the different first letter and the difference in the beginnings to the marks ie. CROSS and KRIS, are very obvious to the eye and have a significant impact in visually distinguishing the marks in their totalities. In my view the marks are not visually similar.

27. From an aural point of view I find the marks far less easy to separate. There is no difference in the CR and KR sound or in the termination of the respective marks. The difference between the “O” and “I” sound in the middle of the marks could well be subsumed, allowing for the normal imperfections of speech and could prove very difficult to distinguish in the context of the marks in their totalities. Precise and careful articulation might mitigate the possible effects but in normal trading circumstances that is unlikely to occur – see paragraph 30 of this decision. I find the respective marks to be aurally similar to a high degree.

28. Conceptually it seems to me that both marks consist of invented words which do not lend themselves to an obvious allusion or meaning. It seems to me that no real conceptual similarity is identifiable. However, invented words of this nature are far less readily distinguishable than dictionary words with similar appearances but different meanings. Imperfect recollection of the marks may well be a factor.

29. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider in relation to the goods at issue, who the average customer is, how the goods are sold and make allowance for imperfect recollection.

30. The customer for both “Beers” and “Alcoholic beverages (except beer)” are members of the public over eighteen years of age. The goods are sold through the same outlets on adjacent shelves and through pubs, clubs and bars. They are often purchased on behalf of others or as part of “a round” of drinks. In *David West v Fuller Smith & Turner Plc* (BL O/136/00) the Hearing Officer paid particular regard to the importance of aural similarity between the marks ESB and ESP Eastenders Strong Pils. In doing so he recognised that the trade in beers and other alcoholic beverages (at least in public houses, bars and clubs) still relies to a large extent on word of mouth orders and that it was correct to consider all the main avenues of trade in the goods concerned.

31. The guiding authorities make it clear that a likelihood of confusion may be found on the basis of aural similarity alone – see *Lloyd* (mentioned earlier in this decision). However, it is not an automatic consequence. The result in any particular case will depend on a global appreciation taking all factors into account.

32. In the present case the respective marks are aurally very similar and the respective goods are similar. Taking into account the customer for the goods and the significance of word of mouth orders in relation to the respective goods, I find that there is a likelihood of confusion.

33. The opposition under Section 5(2)(b) of the Act succeeds.

COSTS

34. The opponent is entitled to a contribution towards costs and I order the applicant to pay the opponent the sum of £900 which takes into account that no hearing took place on this case and that the applicant did not file evidence. This sum is to 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 January 2005

**JOHN MacGILLIVRAY
For the Registrar
the Comptroller-General**