

O-016-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2350110
BY HOUSE OF TOWNEND LIMITED TO REGISTER A
TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER NO. 92421 BY JMV JOSE MARIA VIEIRA**

TRADE MARKS ACT 1994

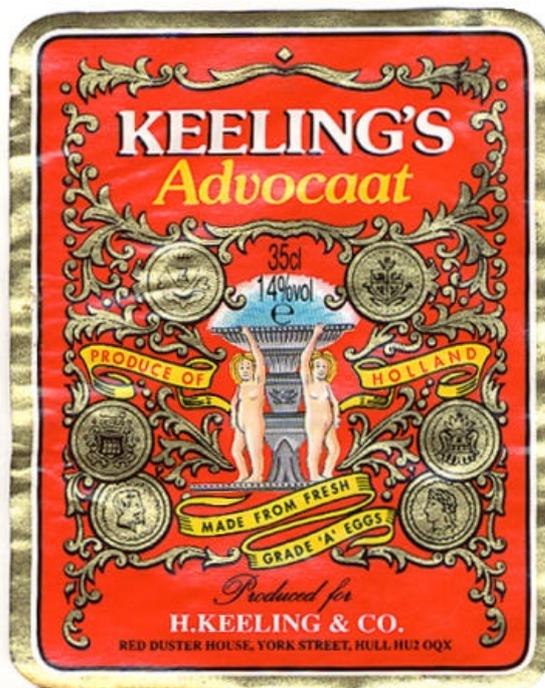
**IN THE MATTER OF Application No. 2350110
by House of Townend Limited to
register a trade mark in Class 33**

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**IN THE MATTER OF Opposition thereto
under No. 92421 by JMV Jose Maria Vieira**

BACKGROUND

1. On 27 November 2003, House of Townend Limited applied to register the trade mark shown below for a specification of goods reading: “Wines, spirits and liqueurs” in Class 33.



2. The application was accepted and published for opposition purposes.

3. On 13 April 2004, Mewburn Ellis acting as agents for JMV Jose Maria Vieira filed a notice of opposition. The opposition was originally based on Sections 5(2)(b), 5(3), 5(4)(a) and Section 56 of the Act. However, the grounds based on Sections 5(3), 5(4)(a) and Section 56 of the Act were subsequently withdrawn. The remaining Section 5(2)(b) ground, is based on the likelihood of confusion with registration No. 1491997 for the trade mark FEELINGS which is registered with effect from 25 February 1992 in respect of “Alcoholic beverages; all included in Class 33.”

4. On 20 July 2004, the Applicant filed a counterstatement in which the ground of opposition is denied. In their counterstatement, the Applicant explains that the Keeling's brand which is used for the marketing of an alcoholic liqueur produced from pasteurised eggs and brandy i.e. advocaat, was

launched in 1974 following the purchase by J. Townend & Son's (Hull) Ltd of the H. Keeling company which gave its name to Keeling's Old English Advocaat, which later became Keeling's Advocaat. They add that the Keeling's brand built up a considerable awareness during the 1970s and 1980s, establishing itself as one of the leading brands in the UK behind the market leader Warnink's Advocaat, and that over the years Keeling's has been sold through various national supermarket chains, such as Co-op, Asda, Morrisons, Budgens, Low Cost and Cellar 5. In addition, I note the following phrases which also appear in the Applicant's counterstatement:

- "the product has traded under the brand name Keeling's since 1974";
- "it is a different product and the consumer is aware that Keeling's is an Advocaat drink, given previous promotions and advertising";
- the chance of confusion is non-existent. A product that has been on the market for 30 years should surely be permitted to register its trade mark";
- "we don't believe the opponents have a strong reputation for their brand, Feelings, which was not registered until 19 years after the House of Townend first started trading under the name of Keeling's."

5. Only the Opponent filed evidence in these proceedings; both parties ask for an award of costs. The parties were invited to say whether they wished to be heard; neither indicated a wish to do so. However, written submissions have been received on behalf of the Opponent from Mewburn Ellis (their letter of 5 December 2005). Acting on behalf of the Registrar I give this decision.

EVIDENCE

Opponent's Evidence

6. This consists of a witness statement, dated 4 April 2005, by Roger Grimshaw. Mr Grimshaw is a Trade Mark Attorney in the employ of Mewburn Ellis, the Opponent's professional representatives in these proceedings. He states that his statement is made on the basis of records and other information supplied to him or from his own knowledge; he confirms that he is competent to make his statement on the Opponent's behalf.

7. Mr Grimshaw explains that on 1 April 2005, he instructed his firm's in-house trade mark searcher to conduct a search of the UK, Community Trade Mark and Madrid registers (the latter for marks designating the UK). The search was made in Class 33 of the register and was designed to reveal all marks that contained the string "-eeling-". The search which was made on the Marquesa and Questel commercial databases, revealed only the instant application and the Opponent's earlier trade mark – exhibit RSG1 refers.

8. On 4 April 2005, another search was conducted of the same registers and using the same databases indicated above. This search was designed to reveal marks containing the string "-eelings-" in any class, but to exclude marks that included the word "feelings". The results of the search are provided as exhibit RSG2.

9. On 4 April 2005, Mr Grimshaw inspected The New Oxford Dictionary of English and Collins English Dictionary; copies of the titles pages and the associated publication details of each are provided as exhibit RSG3. Mr Grimshaw comments that his investigations revealed that the only

words within these dictionaries that contain the string “eelings” are the words “feelings” and “peelings”.

10. Exhibits RSG4 and RSG5 consist respectively of a copy of a report entitled Noise Overload which relates to employee noise exposure in pubs, bars and clubs and which was produced in November 2004 by the Trades Union Congress and the Royal National Institute for the Deaf (RNID), a press release obtained from the website of the RNID and an extract obtained from www.dontlosethemusic.com Both documents in exhibit RSG5 were obtained on 4 April 2005.

11. That concludes my summary of the evidence filed in so far as I consider it necessary.

The Opponent’s written submissions

12. The Opponent’s written submissions are contained in the letter mentioned above. I will, for the most part, refer to them as necessary in my decision. That said, I note that they say:

“Thus, the basis for the denial of the Section 5(2)(b) claim is that the applicant’s product has been on the market for thirty years. No evidence has been presented to this effect. The applicants have not refuted the claim that the marks themselves are similar or that the goods are identical.”

AND:

“Again, the basis for the applicant’s argument against the objection under Section 5 is that they have used the mark KEELING’S in relation to an advocaat drink for a number of years. Thus, the applicant has only refuted the Section 5 ground of opposition on the basis of a claim to lengthy use of their mark in relation to advocaat. The applicants have not produced any evidence of honest concurrent use into the proceedings. Consequently the opposition should succeed.

13. I note that the Applicant is not professionally represented in these proceedings. With that in mind, I think it is reasonable to assume that they approached the grounds of opposition from a position that one in business might approach such matters, based on what in their view was the commercial reality of the situation. The fact that an Applicant unfamiliar with the complexities of trade mark opposition proceedings does not specifically deny that the respective trade marks at issue are similar, is not, in my view, a factor which should be given undue weight in proceedings such as these, and I intend to approach the matter on this basis.

DECISION

14. The sole ground of opposition is based on section 5(2)(b) of the Act. This reads:

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

(a)

(b) it is similar to an earlier 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.”

An earlier right is defined in section 6 of the Act, 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,”

The trade mark on which the Opponent relies is an earlier trade mark as defined by Section 6(1) of the Act.

15. In reaching a decision I take into account the well established 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* [1999] R.P.C. 117, *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.

It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors; *Sabel BV v. Puma AG*;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG* who is deemed to be reasonably well informed and 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 it’s 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) 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*;

(h) further, 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; *Marca Mode CV v. Adidas AG*;

(i) 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.*

Comparison of goods

16. The Applicant seeks registration for “Wines, spirits and liqueurs” in Class 33; the Opponent’s earlier trade mark is registered in respect of “Alcoholic beverages; all included in Class 33.” It is, I think, self evident that the goods of the Applicant are wholly contained within the Opponent’s specification and must therefore be regarded as identical.

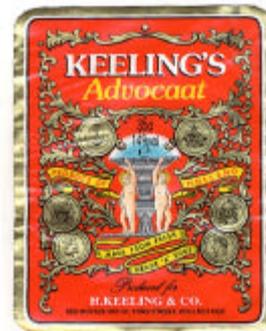
Comparison of marks

17. For the sake of convenience, the respective trade marks at issue in these proceedings are reproduced below:

Opponent’s trade mark:

FEELINGS

Applicant’s trade mark:



18. The reputation of a trade mark is an important consideration when making a determination under Section 5(2) of the Act, as it may enhance the distinctive character of the earlier trade mark and in so doing widen the penumbra of protection. The Opponent has not filed any evidence in these proceedings to demonstrate what, if any, use they have made of their trade mark; I have therefore only the inherent characteristics of the trade mark to consider. The Opponent’s trade mark consists of the pluralised version of the common English dictionary word FEELING which is described in Collins English Dictionary (5th Edition first published 2000) as meaning, inter alia, the sense of touch, the ability to experience physical sensations, a physical or mental impression, an impression or mood. In relation to the goods for which it is registered, the trade mark may allude to the fact that consumption of the goods may produce in the consumer a particular feeling or group of feelings but nothing more specific can be discerned. Whilst not in the category of an invented word, it is a trade mark which, in my view, and based on its inherent characteristics alone, is deserving of a reasonable degree of protection.

19. With these observations on the distinctive character of the Opponent's trade mark in mind, I now go on to compare the respective trade marks from the visual, oral/aural and conceptual standpoints.

20. Turning first to the visual comparison. As mentioned above, the Opponent's trade mark consists of the pluralised version of the common English word FEELING presented in plain block capitals, whereas the Applicant's trade mark is a complex label mark. In this regard, I note the comments in the Opponent's written submissions, namely:

“Turning to assess the marks themselves. The opponents contend that the dominant element in application no. 2350110 is the word “KEELING’S”. Although the mark contains additional matter, it is clear that the additional wording is non-distinctive e.g. ADVOCAT”, “35CL”, “14% VOL”, “PRODUCE OF HOLLAND”, “MADE FROM FRESH GRADE A EGGS”. Furthermore, the “device” elements of the mark are not particularly distinctive consisting primarily of “medallions” which are frequently used in relation to alcoholic beverages.

The word KEELING’S is by far and away the most prominent and dominant element within the mark and most importantly if a consumer were to order this product they could only order it by use of the word “KEELING’S”.”

21. I agree with these submissions. The word KEELING’S is, in my view, the distinctive and dominant component of the Applicant's trade mark; it appears at the top of the label and is likely to be the element of the Applicant's trade mark which fixes itself in the consumer's mind. Whilst I note that the base of the label also contains the words; “Produced for H.KEELING & CO, RED DUSTER HOUSE, YORK STREET, HULL, HU2 0QX, this, in my view, simply reinforces the use of the word KEELING’S as the brand identifier used at the top of the label.

22. Both words i.e. FEELINGS and KEELING’S are eight letters long and have the final seven letters in common; the word KEELING’S contains an apostrophe S whereas the word FEELINGS does not. However, the first letter of each word is different. It is well established (as per *Tripcastroid* [1925] 42 RPC 264) and *Anadin v Inadine* [1992] RPC 421), that it is the beginnings of trade marks that are particularly important, and that the initial letter of a trade mark is not usually overlooked. Whilst I accept that the respective trade marks share a degree of visual similarity, the difference in the initial letter is, in my view, a clear visual difference that would not go unnoticed.

23. Turning now to the oral/aural comparison. As mentioned above the respective trade marks are of identical length, sharing the same last seven letters; both also consist of two syllables. As such, there must be a degree of oral/aural similarity, although in my view this is mitigated by the difference in the first letter of each trade mark and that each trade mark has, in my view, its only conceptual identity (see para 26 below). In his written submissions Mr Grimshaw says:

“We must also consider the environment in which the relevant products are sold. In the opponent's witness statement, evidence was filed to show that the likely points of sale for the relevant products (pubs, bars and clubs) are noisy environments. (This will no doubt be obvious to anyone who has frequented such establishments). In such premises, it may be difficult for bar staff to hear the instructions of a customer which can only increase the likelihood of confusion between a request for a “FEELINGS” beverage and a “KEELING’S” beverage.”

24. Alcoholic beverages are sold through a range of channels including the pubs, bars and clubs mentioned by Mr Grimshaw. They are also sold through various retail premises such as shops,

supermarkets and off-licences; in retail premises goods are normally displayed on shelves. Whilst one may argue that when the goods are sold in, for example, pubs, bars and clubs the request would be an oral one, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk plc v Spa Monopole*, case T-3/04, the Court of First Instance said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

25. Consequently, while the goods may be ordered orally, it is clear that this is likely to be in the context of a visual inspection of the bottles containing the goods prior to the order being placed. In the light of these observations, and notwithstanding a degree of oral/aural similarity between the respective trade marks, the potential for oral/aural confusion is, in my view, reduced.

26. Turning finally to the conceptual comparison. In a potential purchaser’s mind, the Opponent’s trade mark is, in my view, likely to trigger one or more of the meanings ascribed to the word FEELING mentioned above. In contrast, in my view, the Applicant’s trade mark is likely to immediately suggest itself as a surname; a perception which on a visual inspection of the label would be reinforced by the inclusion of the words “H Keeling & Co”. In my view, the respective trade marks are conceptually quite different.

Likelihood of confusion

27. In reaching a conclusion, I must apply the global approach advocated having accessed the degree of visual, oral/aural and conceptual similarity between the respective trade marks. I must keep in mind the degree of similarity between the specification of goods for which registration is sought by the Applicant and the goods for which the Opponent’s trade mark is registered (which are identical), and the traits of the average consumer of the goods in question. The average consumer of the goods in question would be any member of the public over the age of 18, and who are, given the scope for personal preference in relation to the goods concerned, likely in my view to pay a relatively high level of attention to their purchase.

28. Having considered all of these interdependent factors, I have come to the conclusion that while there may be a degree of visual and oral/aural similarity between the respective trade marks, in my view, the degree of similarity is low; in addition, there is, in my view, a clear conceptual dissimilarity. Therefore, notwithstanding the identity of the goods in issue, there is, in my view, no likelihood of confusion between the respective parties’ trade marks and the opposition based on Section 5(2)(b) of the Act fails accordingly.

COSTS

29. The opposition has failed and the Applicant is entitled to a contribution towards their costs. In *Adrenalin Trade Mark*, (BL O/040/02), Simon Thorley QC, acting as the Appointed Person, said:

“8. It is correct to point out that the Registrar’s practice on costs does not specifically relate to litigants in person but in my judgment it could not be that a litigant in person before the Trade Mark Registry could be placed in any more favourable position than a litigant in person before the High Court as governed by the CPR. The correct approach to making an award of costs in the case of a litigant in person is considered in CPR Part 48.6.”

Part 48.6 of the Civil Procedure Rules referred to in the above passage provides as follows:

“48.6—(1) This Rule applies where the court orders (whether by summary assessment or detailed assessment) that costs of a litigant in person are to be paid by any other person.

(2) The costs allowed under this Rule must not exceed, except in the case of a disbursement, two-thirds of the amount which would have been allowed if the litigant in person had been represented by a legal representative.”

30. As the Applicant has not been represented in these proceedings, I will reduce the costs awarded to it by one third. I order the Opponent to pay to the Applicant the sum of £500. This sum 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 17 day of January 2006

**C J BOWEN
For the Registrar
The Comptroller-General**