

O-105-03

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2260311
BY BRL HARDY LIMITED
TO REGISTER A TRADE MARK
SOUTHERN CREEK
IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 52869
BY METRO DIENSTLEISTUNGS-HOLDING GMBH.

BACKGROUND

1) On 6 February 2001, BRL Hardy Limited of Reynell Road, Reynella, South Australia 5161, Australia, applied under the Trade Marks Act 1994 for registration of the mark SOUTHERN CREEK in respect of the following goods in Class 33: "Alcoholic beverages including wine".

2) On the 18 July 2001 Metro Dienstleistungs-Holding GmbH of 1 Leonhard-Tietz-Strasse, Koln D-50676, Germany filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of International Trade Mark number 704829 CENTRAL CREEK. This mark is registered for "Alcoholic beverages (except beers)" in Class 33, with a date of designation in the UK of 21 November 1998.

b) The mark in suit is similar to the opponent's trade mark and is to be registered for identical and similar goods in Class 33. The mark applied for therefore offends against Section 5(2)(b) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent's claims. The applicant submitted a list of seventy-six UK, International and Community trade marks which contain the word CREEK.

4) Both sides filed evidence in these proceedings. Both sides ask for an award of costs. Neither side wished to be heard.

OPPONENT'S EVIDENCE

5) The opponent filed two statements. The first, dated 28 May 2002 is by Penelope Ann Nicholls the opponent's Trade Mark Attorney. She provided a copy of the opponent's International Registration No 704829 at exhibit PAN1 to her statement.

6) The second statement, dated 24 April 2002, is by Graham Robinson an investigator employed by Farncombe International, a company which specialises in intellectual property investigations. Mr Robinson states that he was asked "to establish the frequency of usage in the UK of trade marks for wines/alcoholic beverages which combine the suffix 'CREEK' in

conjunction with another geographical adjective”. At exhibit GR2 he provides the results of his investigation. He states that:

“My findings pointed to the fact that while a large number of wines are available in the UK with trade marks which incorporate the suffix CREEK, there were no wines (or indeed other alcoholic beverages) with trade marks which incorporated the suffix CREEK in conjunction with another geographical adjective other than CENTRAL CREEK and SOUTHERN CREEK. The closest mark conceptually which I found was an Australian wine called Two Mile Creek which is an own label brand of Milton Sanford Wines Ltd. This wine is not supplied to the off trade, but is supplied to restaurants.”

APPLICANT’S EVIDENCE

7) The applicant filed three statements. The first, dated 13 September 2002, is by Christopher Carson, the Chief Executive Officer of BRL Hardy Europe Ltd. He states that he made enquiries of marketing staff of BRL Hardy and “the retailers of alcoholic beverages” in the UK. He states that there are numerous other alcoholic beverages whose names include the word CREEK. He also claims that those he spoke to had no knowledge of any confusion between Southern Creek products and any other product whose name included the word CREEK. He concludes from this that as there has been no actual confusion, the marks are not sufficiently similar to give rise to any likelihood of confusion.

8) The applicant also filed two statements, both dated 30 October 2002, by Stephen Allan Craske, the applicant’s Trade Mark Attorney. Mr Craske provides his own analysis of the marks and his opinion as to whether they are similar. He provides a list of other trade marks which contain the word CREEK and he claims that the average consumer would be aware of the common usage of this word and so would pay more attention to the prefix. He also provides details of the number of bottles of wine under the mark in suit have been sold in the UK. These are as follows:

Year	1996	1997	1998	1999	2000	2001	2002
Sales	31,993	21,179	3,471	0	0	0	0

OPPONENT’S EVIDENCE IN REPLY

9) The opponent filed a statement, dated 23 January 2003, by Angela Claire Thornton-Jackson, the opponent’s Trade Mark Attorney. She contends that the applicant’s evidence regarding the lack of confusion should be given little weight as no details of whom Mr Carson spoke to were provided, whether they had experience in the trade or whether they stocked the goods of both parties. She also points out that there have been no sales of Southern Creek in the UK since 1998 and sales prior to this date were minor.

10) Lastly Ms Thornton-Jackson points out that “state of the Register” evidence is irrelevant.

She then continues:

“Moreover, the opponent’s own investigations, and indeed the witness statement of Graham Robinson already filed in the proceedings, support the contention that CREEK trade marks are indeed common. However, that same investigation also points to the fact that SOUTHERN CREEK and CENTRAL CREEK are the only marks in use where CREEK is employed in conjunction with a geographical indication.”

11) That concludes my review of the evidence.

DECISION

12) The only ground of opposition is under Section 5(2)(b) of the Act which states:

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

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

13) An earlier trade mark 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) The opponent’s International Trade Mark registration No.704829 is plainly an “earlier trade mark”.

15) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [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 relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, paragraph 27;

- (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* page 224;
- (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* page 224;
- (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* page 132, paragraph 17;
- (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* page 224;
- (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* page 224;
- (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* page 732, paragraph 41;
- (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* page 133 paragraph 29.

16) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the 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 and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, 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 a full range of the goods and services covered within the respective specifications.

17) The application is for “alcoholic beverages including wine” in Class 33. The opponent’s mark is registered for “Alcoholic beverages (except beers)” in Class 33. Clearly the goods are identical.

18) It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the services for which it is registered, and any other relevant factors.

19) Visually the first words of each mark (SOUTHERN / CENTRAL) are visually dissimilar although the marks both end with the word CREEK,. However, it is accepted that differences at the start of a trade mark are more significant.

20) Phonetically the marks have the same ending CREEK. Clearly the initial parts of each mark differ, although both are two syllable words. To my mind the marks are not phonetically similar.

21) Conceptually, both marks refer to non-specific geographical locations. The word “creek” has a dictionary meaning as referring to an inlet from the sea, or a small river. In the context of alcoholic beverages I believe that most consumers would see the word as referring to a river or stream. When the initial word of each mark is added the whole would be seen as referring to the southern part of a river or the central area of a river. As no actual river is specified it would not be clear whether the reference was to the same river or creek or to totally different waterways perhaps on different continents. As the opponent has shown in its evidence there are a number of “Creek” marks in the marketplace. Both parties appear to agree that the word CREEK is not such as to exclusively designate the opponent’s goods. There is therefore some conceptual similarity, but there is no conceptual identity. “Central” and “Southern” are well known words with related but different meanings. I must also take into account the dictum of imperfect recollection.

22) Alcoholic beverages are, I would suggest, chosen with some care. Clearly when purchased in a self service environment such as a supermarket the visual aspect is the most important element as the label will be read. However, I must also take into account that such goods are also ordered verbally in pubs and clubs, where aural confusion may come into play.

23) Ordinarily I would also consider whether the opponent’s mark has a particularly distinctive character either arising from the inherent characteristics of the mark or because of the use made of it. However, the evidence of use in the UK which has been filed shows that the mark was not used in the two years prior to the relevant date and that even before then its sales were relatively minor. In such circumstances the opponent’s marks cannot be regarded as enjoying an above average reputation at the relevant date. Nor is it an inherently exceptionally strong mark.

24) With all of this in mind I come to the conclusion that when all factors are considered, that there was no likelihood of confusion at 6 February 2001. Whilst I accept that the mark in suit may bring to mind the opponent’s trade mark I do not believe that this association will cause the public to believe that the goods come from the same or economically linked undertakings.

25) Consequently, the opposition under Section 5(2)(b) fails.

26) The opposition having failed the applicant is entitled to a contribution towards costs. I order the opponent to pay the applicant the sum of £1100. 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 15TH day of April 2003

George W Salthouse
For the Registrar
The Comptroller General