

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2263386
BY DHAMECHA FOODS LIMITED
TO REGISTER A TRADE MARK IN CLASS 33**

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER No. 90326
BY POL ROGER & CIE**

**AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON
BY THE APPLICANT
AGAINST THE DECISION OF MR. J. MACGILLIVRAY
DATED 6 JUNE 2003**

DECISION

Application no. 2263386

1. Application No. 2263386 was filed on 7 March 2001 in the name of Dhamecha Foods Ltd. (“the Applicant”) requesting registration of the trade mark JEAN P. ROGER in Class 33 for “Alcoholic beverages; wines, spirits, liqueurs, cocktails”.
2. Following publication, on 24 July 2001, Pol Roger & Cie S.A. (“the Opponent”) opposed the application. The opposition was based on two grounds:
 - (a) Under section 5(2)(b) of the Trade Marks Act 1994 (“TMA”) because JEAN P. ROGER is similar to earlier trade marks in the proprietorship of the Opponent and is to be registered for goods identical or similar to the goods and services for which the earlier trade marks are protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade marks. The earlier trade marks relied upon by the Opponent are as follows:

International Registration No. 729697 (13 October 1999)



Class 32: Beer; mineral and sparkling water; soft drinks and preparations for making beverages (other than coffee, tea or cocoa-based, and milk beverages); fruit drinks and fruit juices; syrups

Class 33: Alcoholic beverages (except beer)

Class 42: Hotel services; providing food and drinks; café, cafeteria and cocktail lounge services; videotape recording (filming); exhibition-site management

United Kingdom Registration No. 90551 (4 June 1989)

EXTRA CUVÉE DE RÉSERVE.

A handwritten signature in cursive script that reads "Pol Roger & Co." on the top line and "Epervan" on the bottom line. The signature is enclosed in a faint rectangular border.

Class 33: Champagne

- (b) Under section 5(4)(a) of the TMA because the use of the trade mark JEAN P. ROGER in the United Kingdom is liable to be prevented by the law of passing off protecting the Opponent's unregistered trade marks and trade names consisting of or containing the words POL ROGER.

The Opponent's evidence

3. The Opponent's evidence consisted of a statutory declaration and witness statement of Alastair John Rawlence dated 30 April and 30 July 2002 respectively and a witness statement of Bill Gunn dated 25 July 2002. Mr. Rawlence, Messrs. Mewburn Ellis, is the Opponent's trade mark attorney. Mr. Gunn is the Managing Director of Pol Roger Ltd. The Applicant acknowledges that the evidence of Mr. Rawlence proves that the Opponent possessed significant reputation in the UK for POL ROGER champagnes at the relevant date (7 March 2001). Mr. Rawlence details substantial turnover figures and advertising expenditures for the past four years and exhibits, inter alia, sample invoices (SD-AJR3), historical events for POL ROGER champagnes starting with their introduction into the United Kingdom around 1876 (SD-AJR1, WS-AJR2, WS-AJR5), extracts from a "scrapbook" of press cuttings about the POL ROGER brand from the 1870's until the 1970's when the scrapbook was printed (WS-AJR3) and examples of more recent advertisements appearing in the United Kingdom press prior to the date of the application (WS-AJR4). Mr. Gunn's evidence explains that Pol Roger Ltd, the Opponent's exclusive United Kingdom distributor, recently expanded into the distribution of third party wines bearing the importer's name "POL ROGER LTD". Mr. Gunn states that during the period January to December 2000, Pol Roger Ltd imported and distributed in the United Kingdom

approximately £496,000 of such third party wines. Specimen labels are exhibited (BG1) and also a 2002 brochure and price list (BG2), which Mr. Gunn accepts is after the relevant date.

The Applicant's evidence

4. The Applicant's evidence comprised a witness statement of Amit Dhamecha dated 22 October 2002, who describes himself as the buyer for the Applicant. Mr. Dhamecha says that the Applicant acquired its business of wholesale of alcoholic and non-alcoholic beverages from Salamis & Co. Ltd in July 1999. He states that the mark JEAN P. ROGER has been in use in the United Kingdom for at least eight years in relation to wines. Mr. Dhamecha exhibits a summary of sales made by bottle of JEAN P. ROGER wines during the periods 1 January 1996 to 31 December 2000; 1 January 2001 to 30 September 2001; and 1 January 2002 to 30 September 2002 (AD1). Labels are exhibited at AD2. There are no sample invoices but brochures offering JEAN P. ROGER wines are exhibited for the years 1998, 2000 and 2001 (AD3). I note that the mark is presented on the labels "JEAN P'ROGER".

The Hearing Officer's decision

5. Neither party requested a hearing and the Hearing Officer arrived at his decision from the papers before him. The Hearing Officer proceeded on the basis that the Opponent's best case resided in International Registration No. 729697 covering identical goods to those in the mark applied for. There is no appeal against that aspect of the Hearing Officer's decision. Since he found in favour of the Opponent under section 5(2)(b) of the TMA, the Hearing Officer did not consider the opposition under section 5(4)(a) of the Act. Again, there is no complaint on that account.
6. Regarding section 5(2)(b) of the TMA, the Hearing Officer's conclusions were as follows (at paragraphs 37 - 40):

"37. Notwithstanding that there are obvious differences in the marks, particularly on a side by side comparison, I must take into account my earlier finding that the common element, the word ROGER, comprises a distinctive, strong and striking component of both marks. I must add to this my findings that the average consumer for the goods (alcoholic beverages), including wine will often be an occasional and non-specialised or sophisticated consumer who may rely upon the imperfect picture he/she has left in his/her mind. Taking into account the average consumer for the goods, that identical goods are involved and that the marks share a major and striking component, it seems likely that the word ROGER in the opponent's mark will be retained in the mind of customers. Notwithstanding the differing elements it is my view that the applicant's mark would capture the distinctiveness of the opponent's earlier marks in normal and fair use in the market place.

38. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see *SABEL*, paragraphs 16 – 18).”

39. The respective goods are identical and the respective marks are similar conceptually, visually and aurally in that the common element (ROGER) would suffice to lead the public to believe that the goods emanated from the same undertaking.

40. The opposition under section 5(2)(b) of the Act is successful.”

The appeal

7. On 4 July 2003, the Applicant filed notice of appeal to an Appointed Person under section 76 of the TMA. The Applicant accepts that the appeal is by way of review (*REEF Trade Mark* [2003] RPC 101, *El Du Pont de Nemours & Co v. ST Dupont* [2003] EWCA Civ 1368) but says that the Hearing Officer erred in the following respects:
- (a) The Hearing Officer gave inconsistent/wrong consideration to the manner in which the relevant buying public would perceive the Opponent’s POL ROGER mark.
 - (b) The Hearing Officer incorrectly applied the ruling of the Court of Justice of the European Communities (“ECJ”) in Case C-251/95 *Sabel BV v. Puma AG* [1997] ECR I-6191.
 - (c) The lack of evidence of actual confusion was ignored.

The Applicant also challenges the award of £1000 costs made against them as excessive given that there was no oral hearing below.

8. At the appeal hearing, Ms. Camilla Sexton, Messrs. Wildbore & Gibbons appeared on behalf of the Applicant and Mr. Alastair Rawlence, Messrs. Mewburn Ellis, represented the Opponent.

The grounds of appeal

9. The grounds of appeal cite internal inconsistency in the treatment of the manner in which the public would perceive the Opponent’s mark. Thus, at paragraph 31 of the decision, the Hearing Officer says that the word POL would be seen as a surname but in paragraphs 32 and 35 he concludes that POL ROGER would be viewed as a full name (i.e. forename and surname).

Paragraph 31 of the decision contains an obvious error in that the Hearing Officer is considering the Applicant's and not the Opponent's mark. The offending sentence should therefore read:

“The letter P followed by a full stop is likely to be perceived as an initial, and the word POL [sic – ROGER] as a foreign surname, the surname probably being regarded as French if the mark is used in relation to French wine or other French beverages.”

The Hearing Officer confirmed this error at the Opponent's request in a letter dated 3 March 2004. The Applicant did not object to a copy of this letter being admitted into the appeal.

10. Nevertheless, says Ms. Sexton, the Hearing Officer's conclusion that POL ROGER would be perceived as a full name is at variance with the evidence. Ms. Sexton directed me to various instances in the Opponent's evidence showing use of “Pol-Roger” as the family surname (for example, in the “Pol Roger” book (WS-AJR2) and in press cuttings (WS-AJR3)). Mr. Rawlence referred me to the historical account of the foundation of the Opponent on the Opponent's website (SD-AJR1). Pol Roger was the full name of the founder of the company (b. 24 December 1831), which fact is corroborated by the “Pol Roger” book. In the absence of any evidence specifically directed to the point, I believe that the Hearing Officer was perfectly entitled to form the opinion that the public would view the POL ROGER mark as comprising the full name of an individual. Indeed, the contrasting hyphenated family surname use can be regarded as confirmatory.
11. In *Sabel BV v. Puma AG* (supra.), the ECJ ruled that the likelihood of confusion in article 4(1)(b) of Directive 89/104/EEC (the equivalent of section 5(2) of the TMA) must be appreciated globally, taking into account all factors relevant to the circumstances of the case. The ECJ continued (at paragraph 23):

“23. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive – ‘... there exists a likelihood of confusion on the part of the public ...’ – shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”
12. The Applicant accepts that the Hearing Officer correctly directed himself as to the applicable law. But, alleges the Applicant, the Hearing Officer incorrectly applied the test for comparison of marks because he spoke of ROGER being a “distinctive and striking” component rather than a “distinctive and dominant” component as required by *Sabel*. Ms. Sexton referred me to paragraphs 34 and 37 of the Hearing Officer's decision in that regard. At paragraph 24(d) of the

decision, the Hearing Officer makes clear that he is aware of the ECJ's subject guidance in *Sabel*:

“(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 ...*”

Furthermore, at paragraph 37, he says “it seems likely that the word ROGER in the opponent's mark will be retained in the mind of customers”. Accordingly, I believe that the Opponent's criticism is a matter of semantics and I take note of the warning of Robert Walker L.J. in *REEF Trade Mark* (supra. at paragraph 29) that:

“The appellate court should not treat a judgment or written decision as containing an error of principle simply because of its belief that the judgment or decision could have been better expressed.”

13. Ms. Sexton says that in any event, ROGER is a common French surname. There is no likelihood of confusion because the public are well used to distinguishing between marks that contain a common surname even for identical goods. Ms. Sexton's submission ignores:
 - (a) The lack of evidence before the Hearing Officer on this point (decision, paragraph 31).
 - (b) The Hearing Officer's finding that the POL ROGER mark enjoyed a substantial reputation in the United Kingdom market for champagnes (decision paragraph 25).
 - (c) The presence in the Applicant's mark of the element “P.”.
14. Ms. Sexton argues that even if a finding of likelihood of confusion is justified in relation to champagne, the Hearing Officer erred in upholding the opposition across the width of the Applicant's specification. However, the evidence showed that the Opponent had already started to trade in third party wines under the POL ROGER mark and the Hearing Officer stated that he took note of the following comments of the ECJ in Case C-39/97 *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc.* [1998] ECR I-5507 at paragraph 29:

“Accordingly, the risk that the public might believe that the goods and or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive ...”
15. Lastly Ms. Sexton says that the Hearing Officer failed to take proper account of the fact that the Applicant had been trading under the JEAN P. ROGER mark for approximately eight years but there were no instances of actual

confusion. Mr. Rawlence points to the nature of the Applicant's trade namely, shippers and wholesalers of wine. As Laddie J. most recently observed in *Compass Publishing BV v. Compass Logistics Ltd* [2004] EWCA 520 (Ch), the absence of actual confusion is not necessarily telling in cases of conflict with an earlier trade mark. The tribunal must assess the likelihood of confusion on the basis of notional and fair use of the mark applied for and the earlier trade mark for the goods and services in the respective specifications.

16. At the appeal hearing, the Applicant took no point as to the costs awarded at the opposition hearing. I agree with Mr. Rawlence that they are in line with the standard scale.

Conclusion

17. In the result, the appeal fails. The Hearing Officer ordered that the Applicant should pay the Opponent the sum of £1000 in respect of the opposition and I direct that a further sum of £1000 be paid to the Opponent towards the costs of this appeal to be paid on the same basis as indicated by Mr. MacGillivray.

Professor Ruth Annand, 5 April 2004

Ms. Camilla Sexton of Messrs. Wildbore Gibbons appeared as Agent on behalf of the Applicant

Mr. Alastair Rawlence of Messrs. Mewburn Ellis appeared as Agent on behalf of the Opponent