

**TRADE MARKS ACT 1938 (AS AMENDED)  
AND TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 1580644  
BY JACKSON INTERNATIONAL TRADING COMPANY  
KURT D. BRÜHL GESELLSCHAFT mbH & CO KG  
TO REGISTER THE MARK BOSS! IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER  
NO. 45750 BY BASS PUBLIC LIMITED COMPANY**

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15 **DECISION**

On 2 August 1994 Jackson International Trading Company Kurt. D. Brühl Gesellschaft mbH & Co. KG applied under Section 17 of the Act to register the mark BOSS! in Class 32 for a specification of goods which reads

20 “Mineral water, isotonic beverages for athletes, iced tea and iced coffee”

The application claims a priority date of 28 June 1994.

25 It is numbered 1580644.

On 22 October 1996 Bass Public Limited Company filed notice of opposition to this application. In summary the grounds are as follows:-

- 30 (i) under Section 12 by reason of a number of registrations standing in the name of the opponents (see Annex for details)
- (ii) under Section 11 by reason of the use by the opponents of their marks
- 35 (iii) under Section 17(1) in that the applicants cannot claim to be the proprietors of the mark applied for

The opponents also ask that the application be refused in the exercise of the Registrar’s discretion.

40 The applicants filed a counterstatement either not admitting or denying the opponents’ grounds.

Both sides ask for an award of costs in their favour.

45 Both sides filed evidence but neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

By the time this matter came to be decided, the Trade Marks Act 1938 had been repealed in accordance with Section 106(2) and Schedule 5 of the Trade Marks Act 1994. In accordance with the transitional provisions set out in Schedule 3 to that Act however, I must continue to apply the relevant provisions of the old law to these proceedings. Accordingly all references in the later parts of this decision are references to the provisions of the old law.

### **Opponents' evidence**

The opponents filed a statutory declaration by Paul Christopher Waters, their Assistant Company Secretary. He says that the company is the successor in business to Bass & Co which was established in 1777 when William Bass bought his own brewery at Burton-on-Trent. William Bass used his signature as a trade mark to denote the beer brewed by the company. His descendants and successors have used that signature on products to denote both their origin and their quality. In support of the opponents' case he exhibits

- PCW 1 - labels showing the word BASS
- PCW 2 - a copy of the schedule to the grounds of opposition showing the company's registered trade marks
- PCW 3 - a copy of the 1996 annual report and financial statement
- PCW 4 - a copy of the September 1996 edition of the company's newsletter called Horizons
- PCW 5 - a copy of a leaflet entitled "The Story of Bass" featuring the company's triangle device
- PCW 6 - samples showing how the mark is used in the UK. Mr Waters says that such use is not confined to alcoholic beverages. He points to use in connection with the company's public houses which also sell other products and to the "Shandy BASS" product sold in off licences and supermarkets
- PCW 7 - an article regarding the painting "The Bar of the Folies Bergere by Monet showing the renown of the mark
- PCW 8 - copies of postcards produced by the Bass Group in 1909 and 1925-30 respectively
- PCW 9 - a photocopy of the cover of a booklet entitled "A Glass of Pale Ale" first printed in 1880
- PCW 10 - a printout of entries in the company's Internet website.

Mr Waters also offers observations on the issue of possible confusion and points particularly to the fact that the company's mark is often used in script form where the differences between

the letters 'a' and 'o' are less obvious.

### **Applicants' evidence**

5 The applicants filed two declarations by Consul Kurt D Brühl and Dr Fritz Karmasin.

10 Mr Brühl is the Director of the opponents. He says that the mark BOSS! was adopted to represent the quality and prestige of the company's products and has been developed in line with a further mark "THE BOSS!" in relation to energy and sports drinks. Examples of the packaging that has been developed is at Exhibit KDB 1. Mr Brühl says that his company has built up a long standing reputation in the drinks industry and for many years has been active in the sale and distribution of coffee, tea, whisky and sparkling wine. He exhibits (KDB2) the cover of the Brühl Magazine illustrating a selection of these other products.

15 Mr Brühl says that a specialist report has been carried out into consumer understanding of the mark "(THE) BOSS!" The main results and a summary of the survey are presented as Exhibit KDB3. The results are said to show that 96% of those surveyed do not associate the mark with the drinks industry and none of the people surveyed mentioned Bass. He too comments on the issue of comparison of marks.

20 Dr Karmasin is the Managing Director of Dr Karmasin Gesellschaft, an Austrian company trading as "The Austrian Gallup Institute", and a member of the Gallup International Association.

25 He says that in or about August 1997 he commissioned on behalf of Jackson International Trading Company a market survey in Great Britain, the questionnaire and methodology of which were devised by his Company and the fieldwork of which was conducted by OMNIMAS, a division of Taylor Nelson AGB Plc, another member of the Gallup International Association.

30 Based upon the results provided by OMNIMAS, his Company produced a report and analysis of their survey, a copy of which is exhibited at FK1.

35 That completes my review of the evidence.

The principal grounds of objection are under Sections 11 and 12. These sections read:

40 "11. It shall not be lawful to register as a trade mark or part of a trade mark any matter the use of which would, by reason of its being likely to deceive or cause confusion or otherwise, be disentitled to protection in a court of justice, or would be contrary to law or morality, or any scandalous design.

45 12.-(1) Subject to the provisions of subsection (2) of this section, no trade mark shall be registered in respect of any goods or description of goods that is identical with or nearly resembles a mark belonging to a different proprietor and already on the register in respect of:-

- (a) the same goods
- (b) the same description of goods, or
- 5 (c) services or a description of services which are associated with those goods or goods of that description."

10 The reference in Section 12(1) to a near resemblance is clarified by Section 68(2B) of the Act which states that references in the Act to a near resemblance of marks are references to a resemblance so near as to be likely to deceive or cause confusion.

15 The established tests for objections under these provisions are set down in Smith Hayden and Company Ltd's application (Volume 1946 63 RPC 101) later adapted, in the case of Section 11, by Lord Upjohn in the BALI trade mark case 1969 RPC 496. Adapted to the matter in hand, these tests may be expressed as follows:-

20 **(Under Section 11)** Having regard to the user of the mark BASS (including in script form, on labels and in association with the triangle device) is the tribunal satisfied that the mark applied for, BOSS!, if used in a normal and fair manner in connection with any goods covered by the registration proposed will not be reasonably likely to cause deception and confusion amongst a substantial number of persons?

25 **(Under Section 12)** Assuming user by the opponents of their marks (see Annex) in a normal and fair manner for any of the goods or services covered by the registrations concerned, is the tribunal satisfied that there will be no reasonable likelihood of deception amongst a substantial number of persons if the applicants use their mark BOSS! normally and fairly in respect of any goods covered by their proposed registration?

30 I will deal firstly with the Section 12 objection.

35 The opponents refer to over ninety marks registered or applied for. Most of these are label or composite marks relating to the opponents' main trade in beer and other alcoholic beverages. I do not think it is necessary to record details of all of these marks. I regard the registrations referred to in the Annex as offering the opponents' their best chance of success for a variety of reasons. In particular No 21701 illustrates the BASS mark in script form; 292276 and 996159 are for the mark BASS solus in plain block capitals for specifications covering alcoholic beverages; 1323641, 1324585 and 1544174 are registered for goods which correspond more closely to the applicants' goods; and 1286786 shows the BASS mark in relation to public house services.

45 The established guidance in relation to comparison of goods is that set out in JELLINEK'S application, 63 RPC 59. It requires me to consider the nature and purpose of the respective sets of goods and their channels of trade. So far as the opponents' alcoholic beverages specifications are concerned I cannot see that there is any conflict with the applicants' goods. The latter's specification covers a range of (non alcoholic) soft drinks whose nature in terms of composition and production differ markedly from alcoholic beverages. Their purpose is also

quite different. Whilst most drinks share the common characteristic that they are intended to quench thirst that is insufficient (and too broad a level of categorisation) to say that they are goods of the same description. The channels of trade also differ. At the manufacturing/production level the process for making soft drinks is quite different to that of brewing. Wholesales and retailers may of course trade in both. But even where the goods meet in a single retail outlet (a supermarket say) they are unlikely to be sold or stocked together. Public houses will usually sell mineral waters in addition to alcoholic beverages but even then the goods would be displayed separately. Insofar as the opponents rely on their registrations for alcoholic beverages (21701, 292276 and 996159) I do not consider that goods of the same description are involved. By way of extension of this reasoning I also do not regard the applicants' goods as being of the same description as the public house services of registration 1286786. Whilst a connection exists between beer and public house services, no evidence or argument has been put before me to suggest that similar considerations apply in relation to the goods at issue here. No 1286786 is also, therefore, of no assistance to the opponents.

The opponents do, however, have a number of registrations covering non-alcoholic beverages including mineral water (these are Nos 1323641, 1324585 and 1544174). The applicants goods are, therefore, either the same as or closely similar to those of these registrations. The matter therefore rests on a comparison of the marks for which purpose I adopt the test laid down in Pianotist Co's application:-

"You must take the two words. You must judge of them both by their look and by their sound. You must consider the goods to which they are to be applied. You must consider the nature and kind of customer who would be likely to buy those goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of these trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be a confusion - that is to say - not necessarily that one will be injured and the other will gain illicit benefit, but that there will be a confusion in the mind of the public, which will lead to confusion in the goods - then you may refuse the registration, or rather you must refuse the registration in that case."

Bearing all of the above criteria in mind I feel able to say straightaway that the mark applied for is not confusingly similar to Nos 1324585 and 1544174. The latter are complex label marks where the words Bass or William Bass (in script form) are associated with other matter notably the words BARBICAN and DISTINCTION ALE. The final registration I propose to consider is a word only mark, BASS TRIANGLE. Visually and aurally I find this quite different to the mark applied for, BOSS!. Mr Waters points out in his declaration that the opponents' mark BASS is often used in script form (bearing in mind also normal and fair use) and that this could make the difference between the words BASS and BOSS less obvious. There may be some force to that argument. Both BASS and BOSS are dictionary words with reasonably well known meanings. They are also short words where small differences, of a single letter say, may serve to differentiate. However if the matter rested solely on a comparison of the words BASS and BOSS, given the narrow distinction between them and the potential problems arising from use in script form, the opponents might have had a rather

stronger case. However, as matters stand, the comparison is between BOSS! and BASS TRIANGLE. Considering the marks as totalities, as I must, I cannot see that there is any real tangible risk of confusion. The opposition, therefore, fails under Section 12.

5 Turning to Section 11 I must consider the applicants' position in the light of the opponents' user. The evidence mainly goes to establishing the opponents' long standing trade and reputation in beer and other alcoholic drinks under a variety of marks (in the main label marks based on the word BASS and the well known triangle device). A number of the exhibits post date the relevant date. The 1996 Annual Report and Financial Statement (at PCW3) gives  
10 some historical trading information but not in my view in a sufficiently disaggregated form to be of assistance to the opponents in these proceedings. Even so on the basis of the material I accept that the opponents have a very substantial reputation in beer and related alcoholic beverages under the mark BASS (also in script and label form).

15 There is very little information available relating to the opponents' trade in the goods that are the subject of this application. So far as I can see no trading information (turnover, promotional expenditure etc) has been supplied. I note from the Annual Report and Accounts (PCW3) that the company gives a broad breakdown of its trading activities into 'Hotels',  
20 'Leisure retailing' and 'Branded drinks'. The latter is itself sub-divided into 'Bass Brewing' and 'Britvic Soft Drinks'. In the commentary on the Operating and Financial Review under the 'Branded Drinks - Britvic Soft Drinks' heading a number of other brands are referred to (Tango, Mountain Dew, Robinsons etc) reflecting, I assume either the company's own brands or bottling/licensing activities. It is not apparent from this material that BASS is used in  
25 connection with the soft drinks business. I am unable, therefore, to conclude that the opponents have established use of BASS (or a colourably similar sign) in relation to soft drinks. That might not be fatal to their case if there were persuasive evidence that the nature of the trade was such that the public would expect a major brewer to market soft drinks under the same mark as is used for beer and other alcoholic drinks. There is no evidence bearing on this point. The opposition also fails under Section 11.

30 The final grounds are under Section 17(1) and (2). Under the former the opponents say that the applicants are not entitled to claim to be the proprietors of the mark. I can see no basis in evidence which would lead me to that conclusion. Under Section 17(2) there is the matter of the Registrar's discretion. Nothing has been brought to my attention to suggest I should  
35 exercise discretion adversely to the applicants. The opposition thus fails on these grounds as well.

40 As the applicants have been successful they are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435.

Dated this 20 day of July 1999

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50 M REYNOLDS  
For the Registrar  
the Comptroller General

The opponents have attached to their statement of grounds a schedule of registrations and applications standing in their name.

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I do not think it is necessary to record full details of all these marks. Accordingly what follows is information on what appear to be the most relevant registrations.

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No.	Mark	Class	Journal	Specification
21701		32	0186/00059	Beer.

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292276	BASS	32	1539/01660	Beer.
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996159	BASS	32	4999/01097	Beer, ale, stout and porter; shandy; beverages containing beer and included in Class 32; and preparations included in Class 32 for making all the aforesaid goods.
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1323641	BASS TRIANGLE	32	5787/04601	Beer, ale, stout, porter and lager; non-alcoholic beverages and preparations for making such beverages; fruit juices; beverages containing not more than 1.2% (by volume) of alcohol; all included in Class 32.
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1324585		32	5845/06210	Non-alcoholic drinks and preparations for making such drinks; beverages containing not more than 1.2% (by volume) of alcohol; shandy and preparations for making shandy' beer, ale, porter and lager; all included in Class 32; but not including fruit juices.
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1544174

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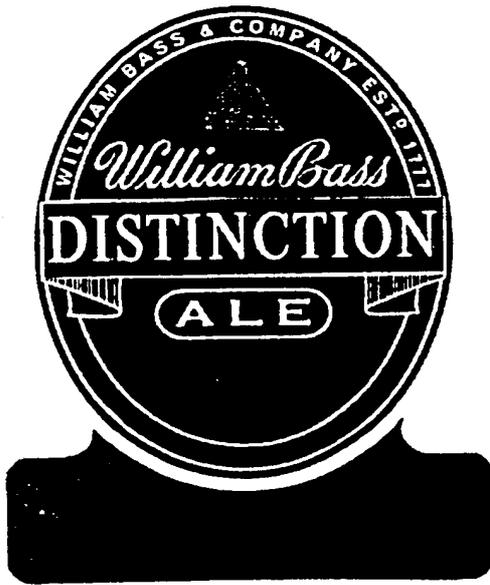
6035/04583

Beer, stout, lager, porter, ale; mineral and aerated waters; non-alcoholic drinks; drinks containing not more than 1.2% (by volume) of alcohol; all included in Class 32.

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1286786

42

5814/01512

Public house services included in Class 42.

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Some 90 other registrations or applications are referred to. The majority are label marks.