

O-249-08

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2413291
BY MOHAMMAD RASHID AHMAD RAZA MIRZA TO REGISTER THE
TRADE MARK**



IN CLASSES 29, 30, 31 AND 32

**AND IN THE MATTER OF OPPOSITION
THERE TO UNDER NO 95005
BY BAVARIA S.A.**

TRADE MARKS ACT 1994

IN THE MATTER OF Application No. 2413291

by Mohammad Rashid Ahmad Raza Mirza to register the trade mark EAGLE and device in Classes 29, 30, 31 and 32

and

IN THE MATTER OF Opposition thereto under No. 95005

by Bavaria S.A.

BACKGROUND

1) On 8 February 2006, Mohammad Rashid Ahmad Raza Mirza applied under the Trade Marks Act 1994 (“the Act”) for the following trade mark:



2) The application was subsequently published in the Trade Marks Journal on 1 December 2006 in respect to the following goods:

Class 29: Prepared Asian meals.

Class 30: Prepared Asian meals.

Class 31: Lentils; rice (unprocessed).

Class 32: Mineral water, purified water, soft drinks, juices, drinking water.

3) On 23 February 2007, Bavaria S.A. filed notice of opposition to the application. It bases its opposition on Section 5(2) (b) and Section 5(3) of the Act and relies upon the following two earlier Community Trade Mark (CTM) registrations:

Trade Mark	Registration Date	Specification
CTM 4140505 	7 February 2006	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
CTM 2916294 AGUILA	10 November 2004	Class 32: Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

4) The opponent informs the reader that “aguila” is the Spanish word for “eagle” and claims a reputation in the sale of beer in Spain and the UK under the AGUILA trade mark. It also claims that the respective goods are similar.

5) The applicant subsequently filed a counterstatement denying the grounds for opposition.

6) The opponent filed evidence and this is summarised below. Neither party requested a hearing, but the opponent filed written submissions in lieu of a hearing. I also note that the applicant’s counterstatements includes a number of submissions that I will not list here, but I will draw upon and taken into account in this decision.

Opponent’s Evidence

7) This takes the form of two witness statements. The first, dated 12 December 2007, is by Gloria Storey, director of La Casa de Jack Ltd. Ms Storey explains that her company is in the business of importing, exporting and distributing Latin American food stuffs including drinks. AGUILA beer is one of seventy product lines that her company currently deals with. “Attachment 1” to the witness statement is a print of her company’s website dated 10 December 2007 illustrating a bottle of “Cerveza Aguila” being one of a

number of products illustrated under the heading “Colombian Drinks”. The company began importing AGUILA beer into the UK in September 2005 and she disclosed the scale of this importation as follows:

Period	Value of Imports	Volume of Imports
Between September 2005 and February 2006	£10,301.45	691 cases
February 2006	£759.90	51 cases

8) AGUILA beer was advertised in the “Express News” newspaper, which has a circulation in both London and Madrid, in September and October 2005 and “Attachment 3” contains copies of these advertisements.

9) The second witness statement, dated 21 December 2007, is by Fernando Jaramillo Giraldo. Mr Giraldo resides in Bogotá, Colombia and he is legal vice-president of Bavaria S.A.. He declares that he has a working knowledge of the English language. He states that AGUILA beer has been brewed in Colombia for many years and is now one of the top selling beers in that country.

10) The earliest record of export of AGUILA beer to the UK was on 29 June 2005 when 1440 bottles were shipped to “El Dorado FDQ Ltd of London SW6 1TX”. The sales value of this shipment was US\$ 7272 but was discounted to US\$ 6544.80. A further sale of the same amount was made to “El Dorado Ltd” on 1 January 2006. Sales invoices recording these transactions are attached to his witness statement.

DECISION

Section 5(2)(b)

11) Section 5(2)(b) of the Act reads:

“(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.”

12) An earlier trade mark 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), Community trade mark or international trade mark (EC) 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.”

13) The opponent relies upon two earlier trade marks. CTM 4140505 “CERVEZA-AGUILA Cerveceria de Barranquilla” and device, and CTM 2916294 AGUILA. Both of these earlier trade marks are earlier trade marks as defined in Section 6(1) of the Act.

14) In my consideration of a likelihood of confusion, I take into account the guidance from the settled case law provided by the ECJ in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [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*,

(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) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(h) 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*,

(i) 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 and Adidas Benelux BV*,

(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.*,

(k) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

(l) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*

Comparison of goods and services

15) In assessing the similarity of services, it is necessary to apply the approach advocated by case law and to take account of all the relevant factors relating to the services in the respective specifications. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the ECJ stated at paragraph 23 of its judgement:

‘In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.’

16) Other factors may also be taken into account such as, for example, the distribution channels of the goods concerned (see, for example, paragraph 53 of the judgment of the Court of First Instance (CFI) in Case T-164/03 *Ampafrance v OHIM – Johnson & Johnson (monBeBé)*).

17) First, I will consider the respective goods in Class 32 which are:

Class 32 goods of Bavaria S.A.	Class 32 goods of Mohammad Rashid Ahmad Raza
Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.	Mineral water, purified water, soft drinks, juices, drinking water

18) The term “mineral and aerated waters” covered by the earlier trade marks will clearly include the “(m)ineral water, purified water” and “drinking water” included in the Class 32 specification of the application. Further, the terms “fruit drinks and fruit juices” will cover “juices” and some “soft drinks” in the later trade mark’s specification. As such I conclude that, having considered the factors set out in *Canon*, these respective goods are identical or if not identical at least at the very top end of similarity.

19) The remaining goods of interest to the applicant are prepared Asian meals (Classes 29 and 30), lentils and rice (both Class 31). The opponent’s trade marks, on the other hand, cover various drinks and preparations for making beverages. The opponent, in its written submissions, cites the comments of Gloria Storey that her company offers a range of food products and beers under a single trading style and it contends that this supports its view that its Class 32 goods are similar goods to all the goods listed in the later application.

20) I am not persuaded by this argument. On a basic level, all the respective goods both deliver nutrition, but their uses and physical nature are very different. Similarly, at this basic level, the relevant user may be the same as eating and drinking are essential functions for life and both food and drink may be purchased together to satisfy this need to eat and drink but the consumer seeks food to satisfy hunger, and seeks drinks to satisfy thirst. The respective goods are not alternatives, nor are they in direct competition. I consider, therefore, that the respective goods have a different nature and a different end user. It is not normal to substitute one set of goods for the other and if a person wants a drink it is unlikely that, for example, they would decide upon one of the applicant’s food products as an alternative. Consequently I do not consider that the respective goods are in competition with one another. I do not consider that the respective goods enjoy a symbiotic relationship or are mutually dependant upon one another, as is the case for example with systems software and a computer. Therefore, I do not consider that the respective goods are complementary. Furthermore, in a retail environment the goods are sold separately and in a supermarket they are found in different sections/shelves. Taking into account all of the above, I consider that the goods listed in Classes 29, 30 and 31 of the application in suit are not similar to the goods of the earlier registrations.

The average consumer

21) As matters must be judged through the eyes of the average consumer (*Sabel BV v. Puma AG*, paragraph 23) it is important that I assess who the average consumer is for the goods at issue.

22) The applicant's trade mark essentially covers foodstuffs and drinks and the earlier trade marks cover drinks. As I have already established, there is a clear overlap between the respective drinks goods. It follows that the average consumer for both sets of goods will be the same. The average consumer in this case will be the general public who purchase such general consumer goods. Further, the price of such goods will be relatively low and will require a relatively low degree of consideration. The applicant's food products can also be described as general consumer goods and I find that the average consumer for these is the same as for drinks products and also that the purchasing act will involve a relatively low degree of consideration.

23) In summary, I consider that the average consumer for all of the respective goods will be the same and that the purchasing act will require a relatively low degree of consideration.

Use and distinctive character of the earlier trade mark

24) The distinctiveness of the earlier trade mark is an important factor to consider because the more distinctive the earlier trade mark, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Earlier trade mark CTM 4140505 consists of the words "CERVEZA AGUILA Cerveceria de Barranquilla" in a label device incorporating the device of an eagle that appears to be flapping its wings and with a suggestion of a globe device largely obscured behind the eagle. Other material is also present as can be seen in the reproduction in paragraph 3. Earlier trade mark CTM 2916294 consists of the word AGUILA. The opponent has explained that AGUILA is the Spanish word for "eagle". I do not believe that knowledge, or otherwise, of this fact has any bearing on the inherent distinctive character of both earlier trade marks as the concept of an eagle has a high level of inherent distinctive character for the goods in question. If, on the other hand, the consumer perceives AGUILA as a made up word, or a foreign word where the meaning is unknown, this too, will have a high level of distinctive character. In concluding that the earlier trade marks have a high degree of inherent distinctive character, I have taken account of the additional material present in the first of these earlier trade marks and I am of the view that this material does not alter my finding.

25) The level of distinctiveness can be based on its inherent qualities or because of use made of it and a reputation can enhance the level of distinctiveness. In its evidence, the opponent has submitted that 691 cases of AGUILA beer were imported by La Casa De Jack Ltd into the UK between September 2005 and February 2006 (a period covering the five months prior to the filing date of 8 February 2006 of the applicant's trade mark – "the relevant date") and that a further two consignments of 1440 bottles each were sold to El Dorado Ltd on 29 June 2005 and 1 January 2006 respectively. Taking account of the

short period of use prior to the relevant date, that this use is limited to only four shipments to two importers, and the absence of any evidence regarding retail sales leads me to find that use of both the earlier trade marks is insufficient to establish any reputation and as such the inherent level of distinctive character of the trade marks is not enhanced.

Comparison of marks

26) I will now go on to consider the differences between the trade marks themselves and the impact of any differences upon the global assessment of similarity. When assessing this factor, I must do so with reference to the visual, aural and conceptual similarities between the respective trade marks bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, para 23). The trade marks to be compared are:

Trade marks of Bavaria S.A.	Trade mark of Mohammad Rashid Ahmad Raza
CTM 4140505 	
CTM 2916294 AGUILA	

27) Firstly, I shall consider the comparison between the earlier trade mark CTM 4140505 and the applicant’s trade mark.

28) I find it convenient to begin with an analysis of conceptual similarity. Conceptually, the combination of the word EAGLE and the device of the same, both being of equal dominance in the applicant’s trade mark, convey an unequivocal conceptual identity being that of the raptor itself. Turning to the earlier trade mark, it is contended by the opponent that the word AGUILA is the Spanish word for eagle and I am prepared to accept this. The opponent, in its statement of grounds, contends that Spanish is spoken and understood by many consumers in the UK, that Spain is a popular holiday destination for UK consumers and that Spanish beer is a popular drink. However, no evidence is

provided to support these contentions. Further, it also quotes the following guidance in the Trade Mark Registry's Work Manual:

“In general, the most widely understood European languages in the UK are French, Spanish, Italian and German. The majority of UK consumers cannot be assumed to be fluent in any of these languages, but most of them will have an appreciation of some of the more common words from these languages...”

29) It may be so that the Spanish word “cerveza” and by extension the word “cervezaria” will be understood as meaning “beer” and “brewery” respectively as it can certainly be said that “cerveza” is a common Spanish word that UK consumers may come into contact with on a relatively regular basis, but it is less obvious as to whether the word “aguila” is also common and readily understood by the relevant UK consumer. In considering this point, I am mindful of the following comments of the CFI in *Matratzen Concord GmbH v. Office for the Harmonisation in the Internal Market (OHIM)* Case T-6/01, that were later endorsed by the ECJ in its Order C-3/03 P:

“38. First of all, it must be observed that, contrary to what is claimed by the applicant, the word Matratzen is not descriptive, from the point of view of the relevant public, of the goods covered by the trade mark applied for. As was pointed out in paragraph 27 above, that public is mainly Spanish-speaking. The word Matratzen has no meaning in Spanish. However, the file does not contain any evidence that a significant proportion of the relevant public has sufficient knowledge of German to understand that meaning...”

30) The comments of Ms Anna Carboni, sitting as the Appointed Person in *Chorkee v. Cherokee* [BL O-048-08] are also relevant to the current considerations:

37. I have no problem with the idea that judicial notice should be taken of the fact that the Cherokee Nation is a native American tribe. This is a matter that can easily be established from an encyclopaedia or internet reference sites to which it is proper to refer. But I do not think that it is right to take judicial notice of the fact that the average consumer of clothing in the United Kingdom would be aware of this. I am far from satisfied that this is the case. No doubt, some people are aware that CHEROKEE is the name of a native American tribe (the Hearing Officer and myself included), but that is not sufficient to impute such knowledge to the average consumer of clothing (or casual clothing in the case of UK TM no. 1270418). The Cherokee Nation is not a common subject of news items; it is not, as far as I am aware, a common topic of study in schools in the United Kingdom; and I would need evidence to convince me, contrary to my own experience, that films and television shows about native Americans (which would have to mention the Cherokee by name to be relevant) have been the staple diet of either children or adults during the last couple of decades.

38. I therefore agree with the Opponent that the Hearing Officer was wrong to find that the earlier trade marks would give rise to the concept of the native

American tribe by the same name in the mind of the average consumer and that he should not have relied on his own knowledge and experience to do so.

...

52. It will be clear from my review of the Hearing Officer's assessment of conceptual similarity that I do not agree that it is appropriate to assume that the relevant average consumer would think of the Cherokee Nation tribe when faced with the earlier trade marks. I stated at the hearing that I had expected to find some reference to Cherokee Jeeps, my own assumption being that many people would think of these vehicles in response to seeing the name CHEROKEE on clothing. Mr Groom rightly was not receptive to that suggestion. Like the Hearing Officer's assumption of the average consumer's awareness of the Cherokee Nation tribe, my assumption of their awareness of the Cherokee Jeep was not a fact of which I could take judicial notice in the absence of evidence."

31) Taking account of these comments I conclude that, in the absence of any evidence to the contrary, it would be wrong for me to accept that the word "aguila" will be understood by the relevant UK consumer as being the Spanish word for "eagle". I conclude that the relevant average consumer will identify the word elements as being foreign and probably Spanish words, but will not attribute any conceptual meaning beyond this basic assumption that the words relate to a beer called "Aguila" and a brewery called "Barranquilla".

32) In considering conceptual similarities, I also need to consider the impact of the non-verbal elements in the overall impression created by the trade mark. I have already identified that the relevant non-verbal elements are the eagle and globe device. In the earlier trade mark, this device element is not reinforced by the word elements as it is in the applicant's trade mark and neither does it share the same level of prominence as the device in the applicant's trade mark. The effect of this is that the dominance of the eagle and globe device within the trade mark is overshadowed by the word element CERVEZA AGUILA. The conceptual identity of the earlier trade mark is perceived by the relevant consumer as being that of a foreign and probably Spanish beer, or beer based product, that has a name of unknown meaning.

33) As I have already said, in the applicant's trade mark the device of an eagle shares equal prominence with the word EAGLE that appears directly below the device element. This results in a strong conceptual identity of an eagle.

34) In making this comparison, I am also mindful of the guidance given by the ECJ in *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* that assessment of similarity means more than taking just one component of a composite trade mark and comparing it with another mark and also in *Shaker di L. Laudato & C. Sas v OHIM* that only if other components are negligible is it permissible to make the comparison on the basis of the dominant element. In this case, I have identified the dominant elements in the

earlier trade mark as being CERVEZA AGUILA, but I recognise that the device element of the eagle and partial globe and the words Cerveceria de Barranquilla are not negligible.

35) In the earlier trade mark, the eagle and globe device is secondary to the words CERVEZA AGUILA, with its prominence being insufficient for the relevant consumer to attach a conceptual meaning of “Eagle beer”. As I noted earlier, the words CERVEZA AGUILA are, at best, understood as meaning “Aguila beer” and do not contribute to a concept that includes an eagle.

36) Taking all of the above into account, I find that there is no more than a low level of conceptual similarity between the earlier composite trade mark and the applicant’s trade mark.

37) The applicant, in its counterstatement, contends that visual differences are accentuated by the different colours claimed, but I note that when it was published, the applicant’s trade mark was not limited to colour in any way. I therefore intend to approach my analysis of visual similarity based on the fact that the applicant’s trade mark may be presented in any colour, including the same colours as are present in the opponent’s trade mark.

38) The opponent’s trade mark contains the device of an eagle positioned centrally in the trade mark with the suggestion of a globe partially visible behind the eagle. The words CERVEZA AGUILA appear in capital letters in a curved band above the eagle device and the words Cerveceria de Barranquilla appear in a curve below the eagle device. These features combine to give the appearance of a label where the dominant element is the words CERVEZA AGUILA. Having identified the dominant element of this trade mark, I should add that the eagle and globe device and the words Cerveceria de Barranquilla are not negligible when assessing similarity with the applicant’s trade mark. However, I consider that the remaining elements such as the leaf and hops device present in both top corners of the trade mark to be, at best, marginal and possibly negligible.

39) In *Medion* the ECJ also commented:

“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

40) Adapting this to the current proceedings, I recognise that the device of the eagle and globe in the opponent’s trade mark has an independent distinctive character in its own right. However, the prominence of this device element is lessened as a result of the proximity of the words CERVEZA AGUILA. Contributing to this reduced prominence is the fact that the consumers’ attention is not drawn to the presence of an eagle by the

proximity to a word recognised as describing it. The respective eagle and globe devices also have a number of visual differences. In the first trade mark, the eagle is depicted in a life-like style, flapping its wings whilst perched with a globe, overdrawn with a grid, partially visible behind its “perch”. In the applicant’s trade mark the eagle is represented in a more stylised, less life-like fashion with the size of its feet and talons exaggerated. The globe, whilst also partially obscured is more prominent and positioned behind the body of the bird and has lines drawn upon it reminiscent of continents.

41) Further, there is no visual similarity between any of the words present in the earlier trade mark and the word EAGLE present in the applicant’s trade mark.

42) All these factors combine to create two trade marks that, whilst sharing some common elements, nonetheless have a low level of visual similarity.

43) From an aural perspective there may be some uncertainty in the minds of the relevant consumer, who will not necessarily have a knowledge of the Spanish language, with regard to how the earlier trade mark is pronounced. The word CERVEZA may be pronounced ser-va-za, ser-va-sa, ser-va-tha or even ser-vee-za or ser-vee-sa. Similarly, the word AGUILA may be pronounced ah-gee-la, ah-gwee-la or possibly ah-gill-a. Similar considerations apply to the words Cerveceria de Barranquilla. It is clear to me however, that whichever pronunciation dominates, none have any aural similarity to the word EAGLE that appears in the applicant’s trade mark. I therefore find that there is no aural similarity between the earlier trade mark and the applicant’s trade mark.

44) In summary, with respect to the earlier composite trade mark, I find that there is no aural similarity and a low level of visual and conceptual similarity.

45) Turning to the earlier trade mark CTM 2916294 AGUILA and following my findings regarding how the relevant UK consumer will perceive the word AGUILA, I find that there is no aural, visual or conceptual similarity between this trade mark and the applicant’s trade mark.

Likelihood of confusion

46) It is clear from the case law that there is interdependency between the various factors that need to be taken into account when deciding whether there exists a likelihood of confusion. I must also take into account that trade marks are rarely recalled perfectly with the consumer relying, instead, on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27).

Likelihood of confusion in relation to the earlier word trade mark AGUILA

47) I have found that, in respect to the comparison of the earlier word trade mark AGUILA and the applicant’s trade mark, that there is no visual, aural or conceptual similarity and I have also found that at least some of the goods are identical or very similar but that other goods are not similar. Taking all these factors into consideration, I find that the relevant public will not confuse the trade marks or believe that the respective

goods originate from the same trade source. Accordingly, I find there is no likelihood of confusion.

Likelihood of confusion in relation to the earlier composite trade mark

48) In respect to the comparison of the earlier composite trade mark with the applicant's trade mark, I have found that there is no aural similarity and that there is a low level of visual and conceptual similarity and that in respect to the applicant's goods claimed in Classes 29, 30 and 31, the respective goods are not similar and I find that, in respect to these goods, there is no likelihood of confusion.

49) In respect to the comparison of the earlier trade mark with the applicant's trade mark with regard to the Class 32 goods, I have concluded that these goods are identical or very similar. I must now make an assessment as to whether all the factors combine to create a likelihood of confusion. In taking the balanced view and adopting the global approach advocated by case law, I find that the aural differences combined with the low level of visual and conceptual similarity is such as to not lead the relevant consumer to confuse the trade marks or to be led into believing that the respective goods originate from the same source. I therefore find that, in respect of these goods also, there is no likelihood of confusion.

50) The grounds for opposition in respect to Section 5(2) (b) of the Act therefore fail in their entirety.

Section 5(3)

51) I turn to consider the ground for opposition under Section 5(3) of the Act which reads as follows:

“5.-(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

52) The scope of Section 5(3) has been considered in a number of cases notably *General Motors Corp v Yplon SA* (CHEVY) [1999] ETMR 122 and [2000] RPC 572, *Adidas Salomon AG v Fitnessworld Trading Ltd.* [2004] ETMR 10, *Premier Brands UK Limited v Typhoon Europe Limited* (TYPHOON) [2000] FSR 767, *Daimler Chrysler A.G. v Alavi* (MERC) [2001] RPC 42, *C.A. Sheimer (M) Sdn Bhd's TM Application* (VISA)

[2000] RPC 484, *Valucci Designs Ltd v IPC Magazines* (LOADED) O/455/00, *Mastercard International Inc v Hitachi Credit (UK) Plc* [2004] EWHC 1623 (Ch), *Electrocoin Automatics Limited v Coinworld Limited and others* [2005] FSR 7 and *Davidoff & Cie SA v Gofkid Ltd* (DAVIDOFF) [2003] ETMR 42.

53) The applicable legal principles arising from these cases are as follows.

a) 'Reputation' for the purposes of Section 5(3) means that the earlier trade mark is known by a significant part of the public concerned with the products or services covered by that trade mark (paragraph 26 of the ECJ's judgment in *General Motors Corp. v Yplon SA (CHEVY)* [1999] ETMR 122).

b) Under this provision the similarity between the trade marks does not have to be such as to give rise to a likelihood of confusion between them; the provision may be invoked where there is sufficient similarity to cause the relevant public to establish a link between the earlier trade mark and the later trade mark or sign, *Adidas Salomon v Fitnessworld*, paragraphs 29-30.

c) The link must be such that it would cause real as opposed to theoretical effects: *Intel v Sihra* and *Intel Corporation Inc v CPM United Kingdom Ltd* [2006] EWHC 1878 (Ch).

d) The provision is not aimed at every sign whose use may stimulate the relevant public to recall a trade mark which enjoys a reputation with them (per Neuberger J. in *Premier Brands UK Limited v Typhoon Europe Limited* [2000] FSR 767).

e) The stronger the earlier trade mark's distinctive character and reputation the easier it will be to accept that detriment has been caused to it (per Neuberger J. in *Premier Brands*, and the ECJ in *CHEVY*, paragraph 30).

f) There is detriment to the distinctive character of the earlier trade mark where it is no longer capable of arousing immediate association with the goods or services for which it is registered. There is detriment to the repute of the earlier trade mark where the goods or services for which the later trade mark is used appeal to the public's senses in such a way that the earlier trade mark's power of attraction is diminished: *Spa Monopole v OHIM* [2005] ETMR 109 (CFI). These concepts have also been described as blurring or tarnishing the earlier trade mark (paragraph 88 of Pumfrey J.'s judgment in *Daimler Chrysler v Alavi* (MERC) [2001] RPC 42).

g) Unfair advantage is taken of the distinctive character or the repute of the earlier trade mark where there is clear exploitation and free-riding on the coat-tails of a famous trade mark or an attempt to trade upon its reputation: *Spa Monopole v OHIM*.

54) In its grounds for opposition, the opponent claimed use of the applicant's trade mark

is likely to dilute and so be detrimental to the distinctive character or the opponent's earlier trade marks. To make good this point, it is necessary for the opponent to establish that the earlier trade marks enjoyed a reputation at the relevant date. From the ECJ's comments in *CHEVY* it is known that for a reputation to exist, the relevant trade marks must be known by a significant part of the public concerned and that particularly important considerations are the market share held by the trade marks, the intensity, geographical extent and duration of use and the level of promotion undertaken.

55) No evidence has been provided regarding market share, but the scale of imports summarised in paragraphs 7 and 10 above when considered in the context of the overall bottled beer market in the UK leads me to conclude that the opponent's share of the market was extremely small and even insignificant. The evidence only reflects the scale of importation and provides no information on retail sales of the product. Importation was to two importers, both being London based and there is no evidence of the level or geographical extent of retail sales of the product. Regarding duration of use, the evidence illustrates that the first instance of importation took place in 29 June 2005, being a little over seven months prior to the relevant date. Evidence of promotional activity is limited to two different adverts, the first being published once in September 2005 and the second being published twice in October 2005. These publications were in a newspaper called "Express News" and Ms Storey, in her witness statement explains that it has circulation in both London and Madrid. However, no information is presented as to the circulation as it relates to London alone and as such I am not able to conclude that there has been any significant promotion in the UK.

56) What can be adduced from this information is that for a period of seven months before the relevant date, the opponent imported a small quantity of beer (with respect to the size of the potential market) to two London based importers and limited promotion took place in one publication with an unknown circulation. Taking all these factors into account, I find that with respect to both of the earlier trade marks the evidence fails to illustrate that, at the relevant date, the opponent had established a reputation. Therefore, the opposition under Section 5(3) fails.

COSTS

57) The opposition having failed, Mohammad Rashid Ahmad Raza Mirza is entitled to a contribution towards his costs. I award costs on the following basis:

Consideration of TM7	£133
Statement of case in reply	£200
Considering evidence	£100
TOTAL	£433

58) It should be noted that in this breakdown of costs, the sums awarded represent no more than two thirds of what I may otherwise have awarded. This reflects the fact that the

applicant has not had legal representation in these proceedings. The Civil Procedure Rules state at Part 48.6¹:

“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.”

59) I order Bavaria S.A. to pay Mohammad Rashid Ahmad Raza Mirza the sum of £433. 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 27th day of August 2008

**Mark Bryant
For the Registrar,
the Comptroller-General**

¹ Mr Simon Thorley QC, sitting The Appointed Person in *Adrenalin Trade Mark* (BL 0/040/02), confirmed the applicability of this Rule to costs before the Registrar of Trade Marks.