

O-297-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2309589
BY INCORPORATED BEVERAGES (JERSEY) LIMITED
TO REGISTER THE TRADE MARK BLACK STAR
IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION NO 91537 BY
BERENTZEN BRENNEREIEN GmbH & CO KG**

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by Incorporated Beverages (Jersey) Limited to
Register the Trade Mark BLACK STAR in
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Berentzen Brennereien GmbH & Co. KG**

BACKGROUND

1. On 3 September 2002 Incorporated Beverages (Jersey) Limited applied to register the mark BLACK STAR for a specification of goods that reads:

“Alcoholic beverages; alcopops; wines, cider, spirits (beverages), vodka; cocktails; liqueurs; sparkling alcoholic drinks; alcoholic fruit extracts; alcoholic coolers; mixtures containing all of the aforesaid.” (Class 33)

2. On 4 March 2003 Berentzen Brennereien GmbH & Co. KG filed notice of opposition to this application. The opponent cites a single ground of opposition under Section 5(2)(b) of the Act based on its Community Trade Mark Registration No 364737, **Black Sun**, which covers “alcoholic beverages (except beers)”.

3. The opponent’s statement of case indicates that at the time of filing the application the specification included goods in Classes 30 and 32 as well. For whatever reason the specification now reads as above. Nothing turns on the deletion of these other Classes of goods. On the basis of identity or similarity in the respective sets of goods and similarity between the marks, the opponent claims that there is a likelihood of confusion.

4. The applicant filed a counterstatement denying the single ground of opposition.

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

6. Both sides filed evidence. The parties were offered the opportunity to be heard or to file written submission in lieu of a hearing. In the event neither side has requested a hearing. Written submissions have been received from Pinsent Masons, the applicant’s professional representatives in this matter. The parties’ pleaded cases and evidence also contain what amount to submissions. I take all these submission into account in reaching my decision.

The law and leading authorities.

7. Section 5(2) reads as follows:

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

- (a)
- (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.”

8. I take into account the 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 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. The guidance from these cases is now well known. Accordingly, I do not propose to set out the relevant passages. Suffice to say that the test is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. 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 various elements, taking into account also the degree of identity/similarity between the goods and how they are marketed. In comparing the marks I must have regard to the distinctive character of each and assume normal and fair use of the marks across the full range of the goods within their respective specifications. The matter must be considered from the perspective of the average consumer who is deemed to be reasonably well informed circumspect and observant.

The parties' submissions

9. The applicant has filed evidence in the form of a witness statement by Lee Curtis, a trade mark attorney at Pinsents, which includes dictionary extracts showing the meaning of the words that make up the competing marks. On the basis of this material it is submitted that BLACK is an adjective which qualifies the following noun and that consumers are likely to pay more attention to the noun. It is conceded that the sun is a star on the basis of the dictionary definitions. However, it is suggested that SUN and STAR are contrasting words in the minds of the public as stars appear at night and the sun during the day.

10. The applicant also submits that “the word BLACK is commonly used within the food and beverage sector as part of brand names. Black in common with other colours are widely used by various different traders to describe their goods and services to form part of brand names”. In support of this Mr Curtis exhibits an extract from the website www.owen.massey.net providing a listing of various ‘alcopops’ brands incorporating the word BLACK and an extract from the website of The Publican magazine which is said to show the word being used in the context of alcoholic beverages.

11. It is further submitted that the Community Trade Mark Office (CTMO) has accepted in opposition decisions that colours within trade marks, although not completely lacking in distinctive character, form a much less distinctive component of

a composite trade mark such as BLACK STAR. A number of CTMO opposition decisions are exhibited in support of the claim. Mr Curtis claims that the CTMO has come to the conclusion that colours are “effectively common to the trade”. State of the register material is also exhibited to demonstrate the concurrent registration of various SUN marks along with website extracts showing a number of SUN marks in use.

12. Peter Hillier of Edward Evans Barker, the opponent’s professional representatives, has filed a witness statement setting out the opponent’s submissions. His main points are that both marks share identical first elements (the word BLACK) and second elements commencing with the letter S. As the sun is a star, conceptual confusion is likely to arise. Mr Hillier contests the relevance of the applicant’s claim that there are other marks registered in the UK or with the CTMO incorporating the elements BLACK/SUN/STAR. He exhibits the results of a search for “BLACK S-” prefixed mark and notes that none of the second elements is similar to SUN or STAR. He observes that in any case if they are to be “relevant from the point of view of educating the public to distinguish between the marks then use is all”.

DECISION

13. It is common ground that the goods in this case are identical or closely similar. Both specifications cover alcoholic beverages, the Class heading for Class 33 in the International System for the Classification of goods and services. The applicant’s more extensive specification itemises a number of types of alcoholic beverages but all would fall within the broad term.

14. The parties’ have rightly, therefore, concentrated their evidence and submissions on the marks themselves.

15. It is well established that marks must be considered as wholes and must not be artificially divided up. It is also clear from *Sabel v Puma* (paragraph 23) that regard must be had to distinctive and dominant components. In this respect consumers are generally held to pay less attention to elements that may describe or allude to characteristics of the goods than to elements that are invented or, if not invented, do not convey any descriptive or allusive message about the goods. Issues can arise as to whether elements within corporate marks have an independent distinctive role (see *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04). That is likely to be an issue requiring particular consideration where the elements of a composite mark do not naturally “hang together” or create a new and distinctive idea that is independent of the meaning of the individual words.

16. This is not, however, the case here. The adjective and noun combinations of the competing marks do combine to create meanings of their own. For that reason I do not accept the applicant’s submissions in so far as they are intended to downgrade the contribution that the word BLACK makes to the marks as whole. Nor do I accept that the collective force of the OHIM decisions (Exhibit LMC6) is to accept that the names of colours within trade marks used in the food and beverage sector are effectively common to the trade. They might be in certain circumstances (red for wine for instance) but each case must be considered on its merits. I am not aware that BLACK is required descriptively in relation to alcoholic beverages at large. To the

extent that other traders have been shown to use it or wish to use it, it is in a trade mark rather than in a descriptive context.

17. Nor do I accept that, because BLACK is an adjective that qualifies the nouns SUN and STAR, it will necessarily attract less consumer attention. On the contrary it is in part the use of the name of a colour that is not usually associated with the sun or a star that gives the marks their impact and renders them distinctive. For that reason also the state of the register evidence that has been referred to by the applicant does not assist in determining this particular case.

18. Turning to a comparison of the marks the opponent's submissions point to the fact that both marks are "BLACK S-" marks. To that extent there is some visual and aural similarity. But in reality it is very limited. The other words are very common ones and consumers will have no difficulty in differentiating between the marks from a visual or phonetic standpoint.

19. The issue that underpins the opponent's case and, in my view, can be the only real basis for the opposition, is the nature and effect of whatever conceptual similarity exists between the marks. That conceptual similarity rests on the proposition that both marks refer to celestial bodies and in each case they are qualified by the adjective black which, as I have already suggested, is a somewhat unusual colour to associate with the sun or stars. Furthermore, as the applicant concedes, the sun is technically a star. This suggests to me that the low level of visual and aural similarity may in part at least be counter-balanced by a somewhat higher degree of conceptual similarity.

20. I go on to consider the effect of these findings on the likelihood of confusion bearing in mind that this is a matter of global appreciation taking account of all relevant factors. The goods in issue here are alcoholic drinks. The average consumer is the adult population at large some of whom may be regular purchasers others less so.

21. The drinks themselves may vary considerably in price as, arguably, will the degree of care exercised in the purchasing process. I anticipate that most alcoholic drinks will be purchased on the basis of visual inspection of labelling or by reference to some other written medium (a mail order catalogue or advertisement, say). There will also be oral ordering in restaurants, public houses, clubs etc though I note that in *Simonds Farsons Cisk plc v OHIM*, Case T-3/04 the Court of First Instance was not persuaded that this materially detracted from the predominantly visual nature of the purchasing process:

".....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."

22. Because drinks are not always purchased on a regular basis or on the basis of concurrent rather than sequential acquaintance with the marks, imperfect recollection may play a part.

23. This is not a case where I consider that there is any danger of direct confusion between the respective marks. The matter turns on the strength of the conceptual similarity that exists between the marks, and the effect it may have on consumers. In this respect it has been held that, 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 v MGM*, paragraph 29). How would consumers approach the marks? Even if they did not confuse one mark for the other, might they think that the marks represented a development in trade or another product based on the same theme as it were from the same trade source?

24. The answer to those questions turns in part on whether the conceptual similarity that exists on paper (the astronomical theme) would impact on consumer perception of the marks. I doubt, for instance, that consumers undertaking a routine commercial transaction such as purchasing alcoholic beverages would give any thought to whether the sun was technically a star and proceed along that thought path. A few may be struck by the shared astronomical theme and the slightly unusual use of the qualifying adjective BLACK but I am not persuaded that this reaction would be widespread or common. It is usually said that consumers do not analyse marks (*Sabel v Puma* paragraph 23). It is more likely in my view that consumers would take these marks at face value and would not pause to consider whether they converged on a similar conceptual theme to the point that they considered goods, even identical ones, sold under the marks emanated from the same or economically linked trade sources. On that basis the opposition fails under Section 5(2)(b).

25. The applicant has succeeded and is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of **£1100**. 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 19th day of October 2006

M REYNOLDS
For the Registrar
the Comptroller-General