

O-323-06

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2319225A
IN THE NAME OF
GLEN CATRINE BONDED WAREHOUSE LTD**

AND

**OPPOSITION THERETO UNDER NO. 93042 BY
LIDL STIFTUNG & CO KG**

TRADE MARKS ACT 1994

**IN THE MATTER OF application
No. 2319225A in the name of
Glen Catrine Bonded Warehouse Ltd
and opposition thereto under No. 93042
by Lidl Stiftung & Co KG**

Background

1. Application No. 2319225A has a filing date of 18 December 2002 and stands in the name of Glen Catrine Bonded Warehouse Ltd. The application seeks registration for the following series of five marks:

GLEN'S
GLEN'S VODKA
GLEN'S GIN
GLEN'S WHITE RUM
GLEN'S DARK RUM

in respect of: *Alcoholic beverages, whisky, liqueurs, vodka, gin, white and dark rum; but insofar as whisky and whisky based liqueurs are concerned, only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.*

2. On 17 December 2004, Urquhart-Dykes & Lord LLP, on behalf of Lidl Stiftung & Co KG, filed notice of opposition against the application. The grounds of opposition are, in summary:

- Under section 5(2)(b) based on the opponent's registration Nos. 2031043 and 1276168, and,
- Under section 5(3) based on the use of the opponent's trade marks.

3. On 7 April 2005, Murgitroyd & Co filed a counter-statement on behalf of the applicant essentially denying the claims made by the opponent. The applicant requested the opponent to provide proof of use of its earlier marks in relation to whisky. It also requested an award of costs in its favour.

4. Both parties filed evidence. Neither party requested to be heard but both filed written submissions in lieu of a hearing.

Evidence

5. The opponent filed two witness statements. The first is by Peter Fischer and is dated 21 September 2005.

6. Mr Fischer states he is the Managing Director of Lidl Stiftung & Co, a general partner of Lidl Stiftung & Co KG, a position he has held since 1 July 2000. He confirms he has full access to his company's relevant records and is authorised to make the witness statement on its behalf.

7. Mr Fischer explains that his company operates a chain of grocery stores and has been trading in the UK since 1994. He goes on to say that his company first used the GLEN ORCHY trade mark in the UK in December 1995 and the HUNTER'S GLEN trade mark in May 1999 in relation to whiskey. Both trade marks have been used throughout the whole of the UK and have, at various times, been available for purchase in each of his company's 330 stores.

8. Mr Fischer states that the average price of whiskey sold under the trade marks GLEN ORCHY and HUNTER'S GLEN ranges from between £7 and £12 approximately with some 200,000 bottles under each trade mark being sold each year. He provides the following details of sales:

GLEN ORCHY		HUNTER'S GLEN	
Year	Amount (euros)	Year	Amount (euros)
1995	192,857	1999	1,362,499
1996	947,828	2000	2,250,102
1997	993,942	2001	2,519,571
1998	1,473,427	2002	2,237,205
1999	2,129,998		
2000	2,939,226		
2001	3,594,854		
2002	2,915,997		

9. Mr Fischer also provides figures for later years but as these are all after the relevant date (as may be some of the information for 2002) I have not included them here.

10. Mr Fischer says that his company spends approximately £30,000 and £10,000 respectively, each year, promoting the GLEN ORCHY and HUNTER'S GLEN trade marks.

11. Mr Fischer explains that GLEN ORCHY and HUNTER'S GLEN feature on labels applied to the whiskey bottles. Advertisements generally consist of pictures of these bottles in a newsletter which is distributed in circulars, magazines and in his company's stores. He exhibits at PF1 a photocopy which he says is a newsletter. No date is given for when this was published but I note that it consists of a single page and appears to bear no reference to the opponent (or any other) company. No details of any external advertising have been provided.

12. The second witness statement is by Sally Erica Foreman and is dated 6 July 2005. Ms Foreman says she is an employee of Urquhart-Dykes and Lord LLP.

13. Ms Foreman explains that on 4 July 2005 she undertook a search of the UK Trade Mark Registry database for marks in class 33 containing the word GLEN. She exhibits a list of the results.

Applicant's evidence

14. This takes the form of a witness statement by Stuart William Wallace and is dated 18 November 2005. Mr Wallace says he is a registered trade mark agent, that he is Scottish and that he considers himself reasonably well informed in the matter of Scotch whisky. He gives no explanation as to why this is of any relevance.

15. At Exhibit SW1 he introduces details of UK and Community registrations which include the GLEN element. Exhibit SW2 consists of details from the Scotch Whisky Association's website. He explains that the Scotch Whisky Association is a trade association which claims to represent over 95% of Scotch Whisky producers. He sets out the Association's remit as taken from its website. Included are pages from the member's brand section of the Scotch Whisky Association's website showing brands which include the GLEN element. Exhibit SW3 is said to contain details from various internet retailers of Scotch Whisky.

16. No further evidence was filed by either party.

Decision

17. The opposition is based on objections under sections 5(2)(b) and 5(3) of the Act. Section 5(2) states:

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

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

(3) A trade mark which -

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

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, 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.”

18. It is not disputed that the trade marks relied on by the opponent are earlier trade marks within the meaning of Section 6 of the Act. The registration procedure for the earlier mark No. 1276168 was completed on 28 August 1990 and for earlier mark No. 2031043 registration was completed on 8 November 1996. Both of these dates are

before the start of the period of five years ending with the date of publication of the application in suit, which was 17 September 2004. In its counter-statement, the applicant puts the opponent to proof of use of its earlier marks in relation to Scotch whisky. These proceedings are therefore also subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. Section 4 of those Regulations amend section 6 of the Act by the addition of the following:

“6A Raising of relative grounds in opposition proceedings in case of non-use

- (1) This section applies where -
 - (a) an application for registration of a trade mark has been published,
 - (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
 - (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.
- (2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.
- (3) The use conditions are met if –
 - (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
 - (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.
- (4) For these purposes –
 - (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
 - (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.
- (5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.
- (6)
- (7)

19. Also of relevance is section 100 of the Act which states:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

20. The opponent has provided evidence intended to show what use it has made of its two earlier trade marks. Details of the value of sales made under each of them have been provided. Somewhat unhelpfully, however, these figures are given in euros rather than pound sterling and no information is provided as to what exchange rate(s) was(were) used to arrive at the relevant figures. Although no details are given in the evidence of the specific geographical location(s) where the sales may have taken place, sales are said to have been and continue to be made under both marks throughout the UK. No supporting invoices or similar documentation has been provided however sales are said to have taken place at various times in each of the opponent’s 330 grocery stores. In its evidence the opponent simply refers one to its website for details of where these stores are. That is not good enough. Any evidence on which a party wishes to rely must be included in its evidence.

21. Figures for advertising and promotional spend have been given for each of the earlier trade marks the opponent relies on. The figures are given in pounds sterling and is said to amount to £30,000 and £10,000 per annum respectively. A sample advertisement, which, as set out in paragraph 11 above, is subject to a number of criticisms, is provided however there is little or no evidence to show where, when and through which medium any advertising and promotion took place. There is no evidence from any third party nor any independent trade evidence.

22. The evidence clearly has flaws and does not strictly meet the requirements set out in *Ansul BV v Ajax Brandbeveiliging BV (Minimas)* [2003] RPC 40. I bear in mind, however, that the claims to have used the earlier trade marks made by Mr Fischer in his witness statement have not been challenged and I am prepared to accept, for the purposes of Section 6 and in the circumstances of this case, that the opponent has shown genuine use, just, of each of its earlier marks. I therefore go on to consider the objection under section 5(2)(b) of the Act.

23. Section 5(2)(b) of the Act states:

- “5.- (1)
- (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.”

24. The term “earlier trade mark” is defined in section 6 of the Act as follows:

- “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,”

25. Each of the registrations relied on by the opponent are earlier trade marks within the definition of Section 6 of the Act.

26. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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 v Metro-Goldwyn-Mayer Inc*, 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*, paragraph 24;

- (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*, paragraph 26;
- (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*, 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*, paragraph 29.

27. For ease of reference I set out the respective marks below:

Applicant's Marks	Opponent's Marks
GLEN'S GLEN'S VODKA GLEN'S GIN GLEN'S WHITE RUM GLEN'S DARK RUM For a recorded specification reading: <i>Alcoholic beverages, whisky, liqueurs, vodka, gin, white and dark rum, but insofar as whisky and whisky based liqueurs are concerned, only Scotch whisky and Scotch whisky based liqueurs produced in Scotland</i>	GLEN ORCHY For a recorded specification reading: <i>Wines; spirits and liqueurs other than Scotch whisky and Scotch whisky-based liqueurs; Scotch whisky and Scotch whisky based liqueurs</i>
	HUNTER'S GLEN For a recorded specification reading: <i>Wines, spirits (beverages; but not including liqueurs</i>

28. There is no dispute that identical goods are involved. As for the respective marks, clearly, there is some visual and aural similarity in that each contains the word GLEN. The applicant's marks also contain an apostrophe and letter S after the word GLEN. This is the only word in the first mark in the series whereas in the remaining four marks, the word precedes other word(s) which form a description of the goods.

29. Whilst each of the trade marks relied on by the opponent also contain the word GLEN, in the first mark relied on it is followed by the word ORCHY and in the second, preceded by the word HUNTER'S. Despite the commonality of the word GLEN, there are strong visual and aural differences between the respective marks.

30. Whilst the word GLEN is an ordinary dictionary word meaning a narrow and deep valley it is also a person's name. Conceptually, the applicant's marks having the apostrophe and the letter S is indicative of the possessive form of a person named Glen. The opponent's GLEN ORCHY trade mark brings to mind a place name. I am aware that Glenorchy is an area in the Highlands. HUNTER'S GLEN brings to mind a glen frequented by a hunter. There are strong conceptual dissimilarities between the respective marks.

31. The goods in issue are everyday goods. Being of an alcoholic nature the average consumer is likely to be an adult who drinks such goods or purchases them for others. Given the general price and very different types of whisky, they are likely to be bought with some care. Taking all factors in account, including the identity of the goods and allowing for the imperfect picture a purchaser may have in his mind, I consider the marks are not similar and there is no likelihood of confusion. The objection under section 5(2)(b) fails.

Section 5(3)

32. Given my findings I do not go on to consider the objection under section 5(3). For completeness however, I would simply reiterate my comments above that the evidence filed is somewhat lacking and, e.g. absent evidence of knowledge of the trade marks by the relevant public, it fails to meet the criteria set out in *General Motors Corporation v Yplon SA Case* [2000] RPC 572 (the *Chevy* case).

Costs

33. The applicant having succeeded is entitled to an award of costs. I bear in mind that the evidence filed in this case was not extensive and that a decision has been reached without a hearing having taken place. I order the opponent to pay the applicant the sum of £1300 as a contribution towards its costs. 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 16th day of November 2006

**Ann Corbett
For the Registrar
The Comptroller-General**