

O-414-12

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2582952
BY
DUNHILL TOBACCO OF LONDON LIMITED
TO REGISTER THE TRADE MARK**

DUNHILL RELEASE

IN CLASS 34

AND

**THE OPPOSITION THERETO
UNDER NO 102480
BY
PHILIP MORRIS BRANDS SÀRL**

Background and pleadings

1. Dunhill Tobacco of London Limited (“the applicant”) applied for the trade mark DUNHILL RELEASE (number 2582952) on 27 May 2011, claiming an international priority date of 10 December 2010 (from Japan). The application was published in the *Trade Marks Journal* on 8 July 2011, following which it was opposed by Philip Morris Brands Sàrl (“the opponent”).

2. The following goods and services are applied for in class 34:

Cigarettes; tobacco; cigars; cigarillos; roll your own tobacco; pipe tobacco; tobacco products, namely smoking tobacco; cut tobacco; leaf tobacco; chewing tobacco and snuff.

3. The opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Section 5(2)(b) states:

“(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.”

4. The ground is based upon all the goods of the opponent’s earlier international registration designating the Community, for goods also in Class 34:

0981008



FLAVORELEASE

Raw or manufactured tobacco; tobacco products, including cigars, cigarettes, cigarillos, hand-rolling tobacco, pipe tobacco, chewing tobacco, snuff, kretek; tobacco substitutes (for non-medical use); smokers' articles, including cigarette paper and tubes, cigarette filters, tobacco boxes, cigarette cases and smokers' ashtrays, tobacco pipes, pocket machines for rolling cigarettes, smokers' lighters; matches.

5. The international registration has a Swiss priority date of 27 May 2008 and a designation date of 3 October 2008. The database of the Office for Harmonisation in the Internal Market (“OHIM”) indicates that it was published as having been protected on 5 October 2009. There is no indication as to when it was published for opposition purposes, from which it would be possible to ascertain the date on which it became protected. As the registration cannot have been protected for five years or more at the date of publication of the application, there is no requirement for proof of use of the earlier registration.

6. The opponent claims that the marks are visually, aurally and conceptually similar, the word element of the earlier mark being the dominant element. Consumers would see the earlier mark as being made up of two words and would pronounce it FLAVOR RELEASE. The opponent claims that the word RELEASE is more distinctive and dominant than FLAVOR because FLAVOR is “fairly descriptive”, whereas (claims the opponent) the word RELEASE is distinctive. The opponent claims that the applicant has taken a distinctive and dominant element of the earlier mark and simply added its house mark. In the opponent’s view, consumers will focus on the word RELEASE in both parties’ marks. This, in conjunction with the identity of the parties’ goods, will lead to a likelihood of confusion.

7. The applicant filed a counterstatement in which it states that it does not dispute that the respective goods are identical. It sets out reasons for denying that the marks are similar which I will not detail here, but will bear in mind when I come to compare the marks. The applicant denies that there is a likelihood of confusion.

8. Both sides filed evidence and submissions. Neither side wished to be heard, choosing instead for this decision to be made on the basis of the papers filed.

Evidence

9. Jens Behrendt, a director of the opponent, has filed a short witness statement in support of the opposition in which he states:

“I am not aware of any tobacco products having been sold in the UK that bear the word RELEASE as a brand or sub-brand, or that bear that word as part of a brand or sub-brand. I see no reason why adult smokers in the UK would think that RELEASE, if featured as (or as part of) a brand or sub-brand on tobacco products, was descriptive or allusive of any characteristic of a tobacco product.”

10. The applicant has also filed a short witness statement, from Stuart Aitchison who is the IP Formalities Manager of BATMark Limited (the agent of record for the applicant), which is a member of the British American Tobacco Plc group of

companies. Mr Aitchison was previously BATMark Limited's Trade Mark Manager. He states:

"Flavour is a vitally important characteristic of tobacco products and one which often dictates a consumer's choice of product. This flavour is released either by igniting, chewing or moistening (e.g. snus) the tobacco, resulting in a sensory experience for the user. In view of this, while the word RELEASE alone may be merely allusive, I believe consumers of tobacco products in the UK would immediately understand the words FLAVOUR RELEASE as being wholly descriptive of one of the fundamental characteristics of such products, namely to release flavour".

Decision

11. The leading authorities which guide me in relation to section 5(2)(b) of the Act are from the Court of Justice of the European Union ('CJEU'): *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, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. 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 for 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) 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*

f) 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*.

(g) 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*,

(h) 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*,

(i) 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*,

(j) 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*,

(k) 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*,

(l) 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*.

Comparison of goods and services

12. In its counterstatement, the applicant states:

“3. The Applicant does not dispute that the goods applied for under the Applicant’s Mark are identical to those for which the Opponent’s Mark has registered protection.”

I will treat this as an admission that the parties’ goods are identical and will therefore proceed on this basis (the goods are clearly identical).

Average consumer and the purchasing process

13. The average consumer is reasonably well informed and reasonably circumspect and observant, but his level of attention is likely to vary according to the category of goods or services. The average consumer of the goods will be (legally) those over the age of 16. There will be a range of levels of attention depending on whether, for example, a packet of cigarettes is bought as a routine purchase, or an expensive cigar is bought for a special occasion. Overall, the level of attention of the average consumer will be average. Unless a vending machine is being used, the goods have to be requested orally because they are sold behind the counter. The goods are displayed on shelves and will be seen, so there is still a visual element to the purchasing process, as is the case with a vending machine.

Comparison of trade marks

14. The marks to be compared are:

Opponent's mark	Applicant's mark
	DUNHILL RELEASE

15. The authorities direct that, in making a comparison between the marks, I must have regard to each mark's visual, aural and conceptual characteristics. I have to decide which, if any, of their components I consider to be distinctive and dominant, without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details. There are two clear components in the opponent's mark. Although the device is at the front of the mark, it is the word element which is more dominant because it takes up a larger proportion of the mark. However, the word element is not more distinctive than the device because the word element, although presented as a single component, is liable to be perceived as an elision of the words FLAVOR and RELEASE (the American English spelling of FLAVOUR being commonly known in the UK). RELEASE is one of the two components of the applicant's mark. It is not the dominant distinctive element of the application because the other element, DUNHILL, is not a dictionary word and therefore will be seen as a distinctive, invented word. Although it is of equal length to RELEASE, DUNHILL also appears at the front of the mark. DUNHILL is the dominant and distinctive component of the application.

16. The only point of similarity between the mark, RELEASE, is the second part of the elided FLAVORELEASE element in the opponent's mark and is the second/final component of the applicant's mark, and is not dominant in either mark. The position of RELEASE points away from visual similarity when

considered in relation to the presence of the other elements because all of the other elements are alien to each party's mark (the device, FLAVOR and DUNHILL). The marks have a low degree of visual similarity. Aurally, the comparison is FLAVOUR RELEASE against DUNHILL RELEASE. The first word heard in each mark is completely different so only the latter half of each mark is the same aurally. The level of aural similarity is no more than average.

17. The meaning of the word element in the opponent's mark, FLAVORELEASE, is the release of flavour¹. FLAVOR qualifies RELEASE; the words work together to create the concept. The two words in the applicant's mark do not have a conceptual relationship with one another; RELEASE stands alone and DUNHILL is an invented word. RELEASE is a dictionary word with a well known meaning, the same meaning as in the opponent's mark. However, the difference between them is that RELEASE in the applicant's mark has no other word to give it context. The meaning is clear in the opponent's mark: it is the release of flavour. In the applicant's mark, there is an allusion to the release of something, but it is non-specific. There is a low to average degree of conceptual similarity between the marks because although the concept of release is overt in the opponent's mark, it is elliptical and not tied to flavour in the applicant's mark; there is also the presence of DUNHILL in the applicant's mark, which has no meaning.

18. Overall, the level of similarity between the parties' marks is low.

Distinctiveness of the earlier mark

19. It is necessary to consider the distinctive character of the opponent's mark because the more distinctive it is, either by inherent nature or by use (nurture) the greater the likelihood of confusion². The distinctive character of a trade mark must be assessed by reference to the goods or services in respect of which registration is sought and by reference to the way it is perceived by the relevant public³. The opponent has not filed any evidence of use, so there is no claim to an enhanced level of distinctive character through use. The applicant submits, in Mr Aitchison's witness statement, that flavour is an important characteristic of tobacco products and it is flavour which dictates choice of product. The opponent submits, in Mr Behrendt's witness statement, that RELEASE has no commonly recognised meaning or usage in the UK in relation to tobacco. However, I have to consider the distinctive character of the earlier mark as comprised of all its elements, which includes the device and the FLAVORELEASE component. The meaning of FLAVORELEASE is clear in

¹ The applicant submitted that the opponent's mark might also be interpreted as FLAVORELEASE, "alluding to offering consumers the opportunity to experience the flavour of a product for a set period of time", but I think this is extremely unlikely.

² *Sabel BV v Puma AG* [1998] RPC 199.

³ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

relation to the goods: the products release flavour. The American spelling and the elision of the two words give some disguise to the mark and I do not forget that there is a device element in the mark, albeit a simple one. Taking into account the descriptiveness of the word element, the variant spelling and elision, together with the device, I conclude that the opponent is entitled to claim an average level of inherent distinctive character in its mark.

Likelihood of confusion

20. In deciding whether there is a likelihood of confusion between the marks, I must weigh the various factors I have identified. This includes keeping in mind the whole mark comparison and the principle of interdependency, whereby a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*).

21. The opponent submits that the word RELEASE is the most distinctive element of its mark. It submits that the applicant has taken this element and has added its house mark, Dunhill. The opponent quotes the following from *Medion*:

“32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

....

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

22. The opponent relies upon the above paragraphs for its proposition:

“Following the Judgment in *Medion*, a sign composed of an earlier mark plus the name of a company should be regarded as similar with the earlier mark if the earlier mark has an independent distinctive role in the composite sign without necessarily constituting the dominant element.”

However, the present case can be distinguished from *Medion*, where a house mark (Thomson) had been added to the word ‘Life’, which was the earlier mark. Here the applicant has not added DUNHILL to FLAVORELEASE. “Release” is not the earlier mark which still has an independent role in the application, as per the CJEU’s paragraph 36. *Medion* does not support the opponent’s case.

23. The high point of similarity between the marks is on an aural level. Aural similarity (and it is no more than an average level of similarity) does not outweigh the visual and conceptual similarities, but must be factored in as part of the global assessment⁴. I keep in mind that the goods are identical, are subject to an average level of attention and that aural selection plays a part in the purchasing process. However, there is still a significant visual aspect to the purchase because the goods will be seen on display shelves behind the counter when they are asked for. I consider that the marks have very different overall impressions, particularly visually and conceptually. Viewing them as wholes, the points of difference outweigh the single point of similarity (RELEASE), which is not the dominant and/or distinctive component of either mark. The distinctiveness of the opponent’s mark, which is no more than average, lies in its totality. These factors will mitigate any risk of imperfect recollection. Even in relation to identical goods, the average consumer will not be confused; nor will there be any association in the sense of an assumption that the goods are offered by undertakings which are commercially associated. There is no likelihood of confusion.

Outcome

24. The opposition fails. The application is to be registered.

⁴ CJEU, Case C-206/04 P *Mülhens GmbH & Co KG v OHIM*: “21 It is conceivable that the marks’ phonetic similarity alone could create a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see, in respect of Directive 89/104, *Lloyd Schuhfabrik Meyer*, paragraph 28). However, it must be noted that the existence of such a likelihood must be established as part of a global assessment as regards the conceptual, visual and aural similarities between the signs at issue. In that regard, the assessment of any aural similarity is but one of the relevant factors for the purpose of that global assessment.”

²² Therefore, one cannot deduce from paragraph 28 of the judgment in *Lloyd Schuhfabrik Meyer* that there is necessarily a likelihood of confusion each time that mere phonetic similarity between two signs is established.”

Costs

25. The applicant has been successful and is entitled to an award of costs on the following basis⁵:

Considering the opposition and filing the counterstatement	£300
Considering the opponent's evidence and filing evidence/submissions	£500
Total:	£800

26. I order Philip Morris Brands Sàrl to pay Dunhill Tobacco of London Limited the sum of £800. 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 23rd day of October 2012

**Judi Pike
For the Registrar,
the Comptroller-General**

⁵ As per the scale in Tribunal Practice Notice 4/2007.