

O-420-20

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK REGISTRATION NO. 1451377

BY BADET CLEMENT ET COMPAGNIE

TO REGISTER

EDOUARD DELAUNAY

AS A TRADE MARK IN CLASS 33

AND

OPPOSITION THERETO

UNDER NO. 417430

BY LES ROCHES BLANCHES SA

Background and pleadings

1. On 11 January 2019, Badet Clement Et Compagnie (“the holder”) designated the UK under the international registration (“IR”) number 1451377 for the following trade mark:

EDOUARD DELAUNAY

2. The application was published for opposition purposes on 24 May 2019 for the following goods in Class 33:

Wines, spirits and liqueurs.

3. Les Roches Blanches Sa (“the opponent”) filed a notice of opposition on 22 August 2019. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all the goods in the IR. The opponent relies upon all the goods covered under the following UK trade mark registration:

Mark: Louis DELAUNAY

UK registration no. 3189027

Filing date: 03 October 2016

Registration date: 30 December 2016

Goods:

Class 33: Alcoholic beverages (except beers); wine; sparkling wine; champagne.

4. The opponent argues that there is a likelihood of confusion, including the likelihood of association because the competing marks are similar, and the goods are identical.

5. The holder filed a counterstatement denying the grounds of opposition

6. The opponent is represented by Boulton Wade Tennant LLP. The holder is represented by Withers & Rogers LLP. Only the opponent filed evidence. I will summarise the evidence to the extent I consider appropriate. No hearing was requested. Only the opponent filed written submissions in lieu. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

Opponent's evidence

7. The evidence consists of the witness statement of Angharad Rolfe Johnson, with two exhibits. Ms Johnson states that she is a Trade Mark Attorney at Boulton Wade Tennant LLP.

8. Print out of search results from the website *www.forebears.io* is presented as Exhibit ARJ1. Ms Johnson claims that the website is a genealogy database. The search results obtained on 3 January 2020 for surnames Delaunay, Smith, Rolfe and Johnson are provided in evidence.

9. Ms Johnson further states that according to the website *www.forebears.io*, ranking for each surname is as follows:

Surname	UK rank			
	England	Scotland	Wales	N. Ireland
Delaunay	37,073 rd	-	-	20,681 st
Rolfe	1,117 th	4,110 th	1,631 st	9,963 rd
Johnson	7 th	165 th	35 th	427 th
Smith	1 st	1 st	12 th	24 th

10. The incidence of each surname is as follows:

Surname	UK Incidence			
	England	Scotland	Wales	N. Ireland
Delaunay	89	0	0	1
Rolfe	7,289	116	207	9
Johnson	191,454	5,118	6,354	884
Smith	632,854	64,005	25,660	5,916

11. Exhibit ARJ2 is titled "World Forename & Surname Distribution Maps" and contains information such as the history of, and the process of creation of geospatial data for,

the website *www.forebears.io/*. According to the Exhibit, Forebears Names is a free service providing access to the largest geospatial database of forename and surname distribution and demographics. The Exhibit is dated 1 June 2020.

DECISION

Section 5(2)(b)

12. The opposition is based upon section 5(2)(b) of the Act, which read as follows:

“5. (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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

13. An earlier trade mark is defined in s. 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) or 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

14. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than five years before the international registration date of the opposed mark, it is not subject to the proof of use provisions under section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

15. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;
- (c) The average consumer normally perceives the mark as a whole and does not proceed to analyse its various details;
- (d) The visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in

mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) Nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

16. The holder accepts that the respective goods are identical.¹ Given that the holder's goods are either identically contained in or fall within the opponent's broad term "alcoholic beverages", I accept that the competing goods are identical.

¹ See the holder's counterstatement, para 4.

The average consumer and the nature of the purchasing act

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

18. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

19. The goods at issue are alcoholic beverages. The average consumer for alcoholic beverages will be the public at large over the age of 18 who are not teetotal. The goods may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self-selection) and in public houses (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar etc.). When the goods are sold in, for example, public houses the selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, 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.”

20. While the goods may be ordered orally in public houses, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Although for the most part the cost of the goods is likely to be relatively low, the average consumer is likely to ensure that they are selecting the correct type, flavour, strength etc, of beverage. Accordingly, they are, in my view, likely to pay a medium level of attention to the selection of the goods at issue.

Distinctiveness of the earlier mark

21. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22. The opponent submits:

“The dominant and distinctive element of the of the Earlier Registration is the element DELAUNAY”.²

23. The opponent has filed evidence, however, neither the evidence shows, nor a claim has been made to, the enhanced distinctive character of the mark. The opponent’s mark will be perceived in its entirety as comprising a full name. Louis is likely to be recognised as being a name of French origin but one which is not unusual in the UK and, therefore, in my view, it possesses a low to normal degree of distinctive character.

24. The opponent’s evidence³ refers to the figures on the ranking for the surname DELAUNAY in the UK. According to the evidence, the surname is ranked only at 37,073rd position in England and 20,681st position in Northern Ireland. No ranking has been provided for Wales and Scotland. There were only 89 incidences of the surname in England and 1 in Northern Ireland. None has been recorded in Wales and Scotland. From the evidence, it appears to me that the surname DELAUNAY is not commonly used in the UK. Given its unusual nature, the surname, in my view, possesses a high degree of distinctive character. When considering the mark as a whole, although the forename possesses a relatively weaker distinctive character than the surname, the

² See the opponent’s statement of grounds, para 5.

³ See Exhibit ARJ1.

presence of the unusual surname will confer the mark as a whole a high degree of distinctive character.

Comparison of marks

25. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

26. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

27. The trade marks to be compared are as follows:

Opponent's trade mark	Holders' trade mark
Louis DELAUNAY	EDOUARD DELAUNAY

28. The holder argues that in a global comparison of the marks, both elements of the marks should be given equal weight since the respective marks comprises of forenames and surnames.⁴

29. The opponent's mark would be understood as the full name of a person. I have already concluded that the surname DELAUNAY is more distinctive than the forename Louis. Even though both words contribute to the overall impression of the mark, due to its unusual nature and that it takes up the greatest proportion of the mark, the relative weight of the surname in the overall impression of the mark is likely to be greater than the forename.

30. The holder's mark is comprised of the words "EDOUARD" and "DELAUNAY" both presented in bold capital letters without any stylisation. The average consumer is likely to recognise EDOUARD as a French forename and, probably, one which is a variant of the known English name Edward. Following my findings noted earlier, DELAUNAY is likely to be perceived as a rare surname. Although EDOUARD is reminiscent of the well-known English forename Edward, its French spelling (which is unlikely to be commonly used in the UK) gives it a similar degree of distinctiveness to the unusual name DELAUNAY. I therefore consider that both names contribute roughly equally to the overall impression of the mark.

31. Visually, the marks coincide in the surname DELAUNAY. The difference between the marks is that they begin with different forenames, namely, Louis and EDOUARD. The holder's mark is presented in bold capital letters while only the word DELAUNAY and the letter "L" in Louis in the opponent's mark are presented in capital letters. Bearing in mind that notional and fair use would allow the opponent to use the earlier mark in differing typefaces, the difference in the letter case is insignificant in my comparison. Considered overall, I find that the marks are visually similar to a medium degree.

32. In an aural comparison, the forenames will be pronounced conventionally. Each forename consists of two syllables which share no aural similarity. However, given that

⁴ See the holder's counterstatement, para 2.

the marks coincide in the pronunciation of the surnames, and therefore share the same three syllables at the end of the marks, I find that the marks are aurally similar to a medium degree.

33. As regards the conceptual comparison, in *Luciano Sandrone v European Union Intellectual Property Office (EUIPO)*, Case T-268/18, General Court (“GC”) held that:

“82. Both the applicant and EUIPO harbour doubts in that regard. The applicant submits that the signs at issue are conceptually different, while EUIPO contends that the comparison between them is neutral in that respect. Furthermore, according to EUIPO, the case-law is unsettled on this point since, in certain judgments, the EU Courts have held that it was possible to make a conceptual comparison between signs containing a surname or first name, while in other judgments it was held that a conceptual comparison of that type of sign was not possible.

83. The Court considers it therefore necessary to clarify the case-law on this point. In that regard, it must be borne in mind that the purpose of the conceptual comparison is to compare the ‘concepts’ that the signs at issue convey. The term ‘concept’ means, according to the definition given, for example, by the *Larousse* dictionary, a ‘general and abstract idea used to denote a specific or abstract thought which enables a person to associate with that thought the various perceptions which that person has of it and to organise knowledge about it’.

84. Similarly, according to the case-law, conceptual similarity means that the signs at issue convey analogous semantic content (judgment of 11 November 1997, *SABEL*, C-251/95, EU:C:1997:528, paragraph 24).

85. Therefore, a first name or a surname which does not convey a ‘general and abstract idea’ and which is devoid of semantic content, is lacking any ‘concept’, so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example,

to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM — McKenzie (McKENZIE)*, T-502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM — Cortefiel (PEDRO)*, T-38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI*, T-707/16, not published, EU:T:2018:424, paragraph 65).

88. In the present case, the Board of Appeal did not identify any concept with which the first name and surname in question could be associated. Nor have the parties put forward any such arguments.

89. Therefore, the mere fact that the relevant public will associate the sign the registration of which is sought with a first name and a surname and thus with a specific, imaginary or real person, and that the earlier mark will be perceived as designating a person called Luciano is irrelevant for the purposes of a conceptual comparison of the signs at issue.”

Other than the fact that the average consumer will perceive the respective parties' marks as referring to two individuals, neither the forename or the surname in the respective marks, or the full names as a whole, are likely to evoke any concept the average consumer could associate with. Certainly, there is no evidence or submissions to the contrary. On that basis, I find that the marks are conceptually neutral.

Likelihood of confusion

34. A likelihood of confusion is made on a global assessment of all factors relevant to the circumstances of the case (*Sabel* at [22]). It is necessary for me to factor in the

distinctive character of the earlier trade mark, as the more distinctive this trade mark is the greater the likelihood of confusion (*Sabel* at [24]). I must also have regard to the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and that the average consumer rarely has an opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

35. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

36. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark”.

37. I find that the different forenames are sufficient to avoid direct confusion between the marks. That leaves me with only the likelihood of indirect confusion to be considered.

38. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

39. Earlier in this decision, I concluded:

- That the contested goods are identical to the goods covered under the opponent's mark;
- That the goods will be selected primarily by visual means, with a medium degree of attention. There is also an aural element to the purchase process;
- That the marks are visually and aurally similar to a medium degree and conceptually neutral;
- That the opponent's mark, as a whole, is distinctive to a high degree and it is the unusual surname which gives the mark its high degree of distinctiveness overall.

40. The opponent submits:

“Further, it is submitted that the general public would perceive both the forename ‘Louis’ and ‘Edouard’ as having a similar connotation and a French resonance, and this is also the case for DELAUNEY. As such, they will be seen as related in some way, i.e. being from the same family.

Thus, it is submitted that the relevant public would naturally expect there to be a relationship between people of the names LOUIS DELAUNEY and EDOUARD DELAUNEY in the same sector of wine production. Because the names are so close and have the same resonance, one would naturally expect

a familial and a commercial relationship to exist and apply the qualities and styles of one to the other: but that would not be correct in this case.

Moreover, because the names are so close and have the same resonance and conceptual connotations, it is possible simply to confuse the two by the doctrine of imperfect recollection: both marks are, unmistakably, the names of gentlemen with forenames of a similar nature and with the same unusual surname, and that alone can enable confusion.”⁵

41. The holder submits:

“It is not uncommon for winery names to comprise people’s surnames and since the elements LOUIS and DELAUNAY in the respective marks are different, the overall impression given by the marks is that they are visually, phonetically and conceptually dissimilar. As such, the marks are not sufficiently similar for there to exist a likelihood of confusion on the part of the public, which includes likelihood of association with the opponent’s mark.”⁶

42. In *Luciano Sandrone v EUIPO*,⁷ the GC indicated that:

“99. In the present case, in the wine-growing world, names carry great weight, whether surnames or names of vineyards, since they are used to reference and designate wines. In general, it should be noted that consumers usually describe and recognise wines by reference to the word element which identifies them and that this element designates, in particular, the grower or the estate on which a wine is produced (judgments of 27 February 2014, *Pêra-Grave v OHIM — Fundação Eugénio de Almeida (QTA S. JOSÉ DE PERAMANCA)*, T 602/11, not published, EU:T:2014:97, paragraph 35, and of 11 July 2018, *ANTONIO RUBINI*, T 707/16, not published, EU:T:2018:424, paragraph 49; see also, to that effect, judgment of 13 July 2005, *Julián Murúa Entrena*, T 40/03, EU:T:2005:285, paragraph 56). Thus, it is the distinctive element ‘Sandrone’

⁵ See the opponent’s written submissions dated 26 August 2020.

⁶ See the holder’s counterstatement, para 3.

⁷ Case T-268/18

which will serve to identify the applicant's wines, or the name as a whole, that is to say, 'Luciano Sandrone', but not the element 'Luciano' alone.

43. Even while accepting that the average consumer, particularly in the wine-growing sector, is likely to be familiar with personal names being indicative of trade origin, in the present case, the common element is a surname that is considered as rare/unusual from the perspective of the average UK consumer. Bearing in mind the unusual and highly distinctive nature of the surname DELAUNAY (which is the element that gives the earlier mark its high degree of distinctiveness overall), the medium degree of aural and visual similarity and conceptual neutrality between the marks, I consider it likely that, when faced with identical goods, the average consumer is likely to expect an economic connection between the respective undertakings. For example, wines emanating from the same, or linked, family estate/vineyard(s). There is, therefore, a likelihood of indirect confusion.

Conclusion

44. The opposition has succeeded in full. The international registration will be refused.

Costs

45. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice ("TPN") 2/2016. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and Considering the counterstatement:	£200
Preparing and filing evidence:	£500
Preparing written submissions:	£300

Total:

£1100

46. I order Badet Clement Et Compagnie to pay Les Roches Blanches SA the sum of **£1100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 4 September 2020

Karol Thomas

For the Registrar

The Comptroller-General