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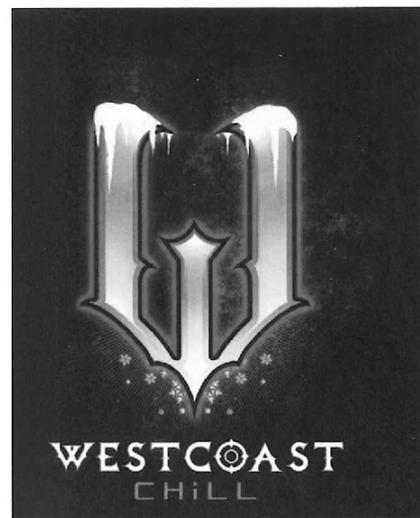
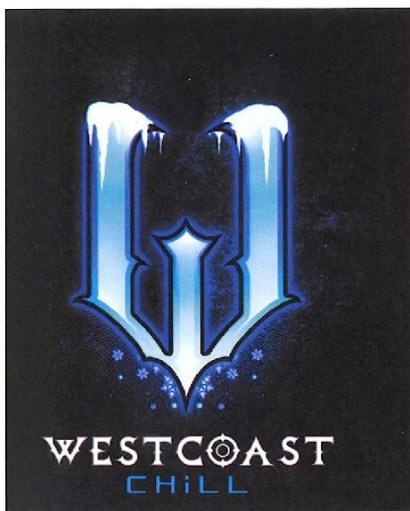
TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS IN THE MATTER OF

APPLICATION NOS 2632092 & 2632106

BY JOSEPH COMPANY INTERNATIONAL, INC

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 32:



(AS A SERIES OF TWO TRADE MARKS)

&

WEST COAST CHILL

AND

OPPOSITION THERETO (UNDER NOS 104253 & 104260)
BY IRISH DISTILLERS LIMITED

BACKGROUND

1) On 21 August 2012 Joseph Company International, INC ('JCI') applied to register the trade marks shown on the cover of this decision. Application number 2632092 (for a series of two marks) claims a priority date of 23 February 2012 from the United States of America. Both applications sought to be registered for the following goods in class 32:

“Energy and sport drinks containing dietary and nutritional supplements, vitamins and herbs.”

2) The applications were published on 21 September 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by Irish Distillers Limited ('IDL'). IDL claims that the applications offend under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). Both oppositions are directed against all of JCI's goods.

3) IDL rely on the same two earlier Community Trade Mark ('CTM') registrations for each opposition; details of which are as follows:

Mark details	Goods relied upon
<p>CTM NO: 2727691</p> <p>WEST COAST COOLER</p> <p>Filing date: 07 June 2002 Date of entry in the register: 20 October 2003</p>	<p>Class 33: <i>Low alcohol wine coolers.</i></p>
<p>CTM NO: 8849846</p>  <p>Filing date: 01 February 2010 Date of entry in register: 27 July 2010</p> <p>Indication of colour: blue, white, black, silver and grey.</p>	<p>Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks; fruit juices; non-alcoholic cocktails; syrups and other preparations for making beverages.</i></p> <p>Class 33: <i>Alcoholic beverages (except beers).</i></p>

4) CTM 2727691 has a filing date of 07 June 2002 and completed its registration procedure on 20 October 2003. CTM 8849846 has a filing of 01 February 2010 and completed its registration procedure on 27 July 2010. The consequences of these dates, in relation to JCI's mark, are i) both CTM's constitute an earlier mark in accordance with section 6 of the Act and ii) only CTM 2727691 is subject to the proof of use conditions contained in section 6A of the Act.

5) JCI filed counterstatements for both oppositions denying any similarity between the respective marks. Further, it also denied any similarity or identity between the respective goods. As a consequence, it denies any likelihood of confusion. JCI also requested IDL provide proof of use for its earlier CTM 2727691 for both oppositions.

6) Further to receipt of the counterstatements the two oppositions were consolidated¹ in light of the identity of the parties and the similar issues to be determined. Both parties filed evidence during the evidential rounds (JCI's evidence was also accompanied by brief submissions). Neither party opted to be heard with both preferring to file written submissions in lieu. I now make this decision after conducting a thorough review of the papers and giving full consideration to all evidence and submissions. I will refer to certain of the parties' submissions as, and when, I consider it appropriate.

EVIDENCE

IDL's evidence

7) For reasons which will emerge later in this decision, I do not consider it necessary to summarise the evidence of IDL in detail. Suffice it say that all of the evidence purports to demonstrate use of IDL's earlier CTM No: 2727691 in relation to 'low alcohol wine coolers'. None of the evidence relates to use in relation to 'non-alcoholic drinks'.

JCI's evidence

8) JCI's evidence consists of a very brief witness statement, dated 30 July 2013, in the name of Michael Elliot, registered trade mark attorney at the firm Greaves Brewster LLP, JCI's representative in these consolidated proceedings. Mr Elliot attaches a single Exhibit (ME1) which he states 'is a true copy of a photograph of a can of energy drink, showing how the applicant's trade mark is applied to the goods'. Mr Elliot asserts that 'the appearance of the trade mark applied for is in stark contrast to the manner in which the earlier marks are applied to the opponent's goods, as shown in the evidence filed by the opponent on 21 May 2013'. The photograph at Exhibit ME1 appears to show a can of drink with JCI's mark (which is the subject of application 2632092) on the front together with the words 'PURE ENERGY' and 'energy supplement'. At the top of the can is, what appears to be, an image of a block of jagged ice.

¹ Under the provision of rule 62(1)(g) of The Trade Marks Rules 2008.

DECISION

9) IDL rely on two earlier CTM's in these consolidated proceedings; only one of which is subject to proof of use (No: 2727691). IDL claim use in relation to 'low alcohol wine coolers' and all of its evidence relates to demonstrating use for these goods only. However, IDL's other CTM (No: 8849846) which is not subject to proof of use covers a broader range of goods. In the circumstances, I consider it appropriate to firstly assess the likelihood of confusion between CTM 8849846 and JCI's marks. I will therefore only consider the evidence of use for CTM 2727691 in the event that it becomes necessary i.e. if IDL is unsuccessful on the basis of its CTM 8849846.

Section 5(2)(b)

10) This section of the Act provides:

“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.”

11) The leading authorities which guide me 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 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

12) The General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution

(HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

13) In the instant case, the goods to be compared are:

IDL’s goods	JCI’ goods
<p>Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks; fruit juices; non-alcoholic cocktails; syrups and other preparations for making beverages.</i></p> <p>Class 33: <i>Alcoholic beverages (except beers).</i></p>	<p>Class 32: <i>Energy and sport drinks containing dietary and nutritional supplements, vitamins and herbs.</i></p>

14) IDL’s specification includes the broad term ‘*mineral and aerated waters and other non-alcoholic drinks*’ (my emphasis). JCI’s goods are types of non-alcoholic drink which are encapsulated by the term I have emphasised in IDL’s specification. As such, the respective goods are identical in accordance with the *Meric* principle.

Average consumer and the purchasing process

15) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v. Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

16) The goods at issue in the instant case will be purchased by the general public and particularly those who participate in sports or other ‘keep-fit’ activities. They are those which are low cost and are likely to be bought on a fairly regular basis. Accordingly, it is likely that a fairly low degree of attention will be afforded during the purchasing act. The selection is likely to take place ‘off the shelf’ from retail establishments and therefore the purchase is likely to be mainly visual. However, I bear in mind that, on occasion, the goods may be requested orally, over a counter perhaps, and therefore aural considerations will also play a part in my considerations.

Comparison of marks

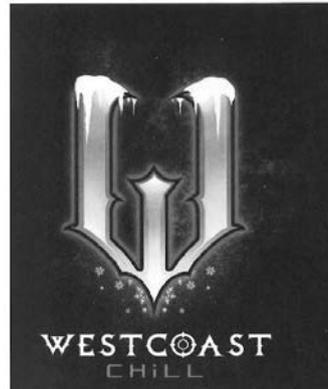
17) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities must therefore be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*). Accordingly, there cannot be an artificial dissection of the marks, although it is necessary to take into account any distinctive and dominant components.

Comparison of the earlier mark with application 2632092

18) IDL's mark:



Application 2632092:



19) IDL's mark consists of a number of elements. There are the two banners, presented in blue, running parallel to each other at some distance apart. Upon the top banner is the device of what appears to be an abstract representation of a wave together with a number of bubbles. Also on the top banner are the words 'West Coast' above the word 'COOLER'. The bottom banner contains the same words, but in a larger font. A similar abstract wave device and bubbles as that on the top banner also appears on the lower banner (although it is not contained wholly in the lower banner but rather spills out above it). To my mind, given their size, positioning, and bold font, the words 'West Coast' on the lower banner are dominant. The abstract device of the wave and bubbles spilling out above is less dominant than 'West Coast'. Both 'West Coast' and the abstract device are distinctive. The same words and device on the top banner are obviously also distinctive however they are less

dominant than they appear on the lower banner. As for the word 'COOLER', this is somewhat overshadowed on both banners by the words 'West Coast' due its fainter font and relative size and positioning. 'COOLER' is not a dominant element, nor is it, due its strong allusive qualities (i.e. being suggestive of a cooling drink), a particularly distinctive element, if it all.

20) Application 2632092 consists of a series of two marks. The only difference between these marks is that one is presented in grey-scale and the other in black, white and blue; in all other respects they are the same. Both marks consist of a number of elements. There is the rectangular background which, in my view, is little more than a backdrop for the other elements in the marks and is of little significance. There is also the large stylised letter 'W' which has the appearance of being snow-capped and made of ice. At the base of the 'W' are very small snowflakes. The stylised 'W' is prominent and takes up a substantial proportion of the mark as a whole- it is a dominant and distinctive element. Below the 'W' is the word WESTCOAST in a stylised font with the letter 'O' possessing further stylisation. The WESTCOAST element is distinctive and only slightly less dominant than the stylised 'W'. Underneath WESTCOAST is the word CHiLL. Of all the elements in the mark, CHiLL is the least dominant and distinctive.

21) From a visual perspective, JCI state, inter alia, the following:

"The Applicant's device marks have strikingly different appearances to those device marks of the Opponent. Those of the Applicant have a gothic feel and comprise a large highly stylised "W" as the main and dominant feature of the marks. The marks of the Opponent give the feeling of light and bubbly."

22) IDL states, inter alia, the following:

"Visually, the stylisation and graphic elements present in the marks do not disguise the prominence of the word elements in the overall impression created by the marks. These word elements ("WEST COAST COOLER" and "WESTCOAST CHILL") are of equivalent length and comprised of many of the same letters, used in the same position."

23) There are plainly points of difference between the marks- the stylised 'W,' in particular, being a clear point of contrast, as contended by JCI. Nevertheless, there is also force in IDL's submission. There is a clear point of commonality owing to the presence of the words West Coast/WESTCOAST (albeit that those words are presented in different styles and fonts). To my mind, having regard for my comments in paragraphs 19 and 20, there is a moderate degree of visual similarity.

24) From an aural perspective, the respective marks clearly contain words which are alien to the other, with quite different pronunciations (in the form of the words COOLER and CHiLL). As regards the 'W' element, I note that JCI states:

"In practice we believe that consumers may even ask to purchase a can of 'W'."

25) IDL states:

“Aurally, the marks would be pronounced “WEST COAST COOLER” on the one hand and “WEST COAST CHILL” on the other. The fact that the “WEST COAST COOLER” wording on the Opponent’s mark is repeated is inconsequential-it would be artificial to imagine that consumers would repeat this element when ordering a bottle of the Opponent’s product in a bar. Similarly, the “fork” graphic element (the Opponent does not believe that it would be regarded by consumers as a letter “W”, on account of its severe stylisation) would not be pronounced by consumers when order the Applicant’s goods.”

26) I have already indicated (in paragraph 20) that the snow-capped element will be seen as the letter ‘W’. Whilst it is true that the ‘W’ possesses stylisation, it is, in my view, still clearly a ‘W’ and not a fork. As for JCI’s contention that the consumer may simply refer to its marks by reference to the ‘W’ element, I accept that this is certainly possible however, much more probable, in my view, is that they will refer to the word elements and therefore I agree with IDL in that respect. Insofar as the duplication of words in IDL’s mark is concerned, I agree it would be ‘unrealistic’ to suppose that this would lead to those words being spoken twice. Taking all factors into account, there is a good degree of aural similarity.

27) Turning to the conceptual comparison, I note in its submissions, JCI states:

“The trade mark applied for is conceptually different from the earlier marks because the word CHILL, meaning “to cool”, has a different meaning from the word COOLER used in the earlier marks to mean “a long drink made from wine, fruit juice and soda water”. The use of the word CHILL in the mark applied for alludes to the fact the goods-energy and sports drinks-are for sale in a self-chilling can with an internal heat exchange unit which is activated to cool the drink when it is to be consumed.”

28) IDL states:

“Conceptually, the “WEST COAST” element conjures up an image of the most westerly edge of a land mass. Since both marks feature this element, the resultant conceptual impression is also shared between them. The word “COOLER” in the Opponent’s mark will either be viewed as a reference to the nature of the drinks or as an indication of temperature. Similarly, the word “CHILL” in the Applicant’s mark will also be considered as an indication of temperature.”

29) At this point, I remind myself that it is distinctive concepts which are important and, for present purposes, I must assess the conceptual identity of IDL’s mark in relation to its ‘non-alcoholic drinks’ rather than ‘low alcohol wine coolers’. Bearing these points in mind, I do not consider that JCI’s submission assists it. The respective words COOLER and CHILL, as they are presented in the relevant marks, are merely likely to allude to the consumer that the relevant goods are cooling/chilled (and this is so regardless of whether they are sold in a self-chilling can or not). The main conceptual hook, which as indicated by IDL is shared by the respective marks, lies in the distinctive phrase ‘West Coast’/ ‘WESTCOAST’ i.e. a westerly area of land

by the sea/ocean. As regards the stylised 'W' in the applicant's mark, if this projects any immediately graspable concept at all, it will be of the letter itself. The respective marks are conceptually similar to, at least, a very good degree.

Comparison of the earlier mark with application 2632106

30) IDL's mark:



Application 2632106:

WEST COAST CHILL

31) In approaching the comparison, I bear in mind my earlier comments at paragraph 19 in relation to IDL's mark.

32) Application 2632106 consists of three words in plain block capitals. I note IDL submits:

"The most dominant and distinctive component of [application 2632106] is the "WEST COAST" element, on account that it occurs at the beginning of the respective marks (which is given greater prominence and significance by consumers) and also because the third word ["CHILL"] is less distinctive."

33) There is force in this submission. It is a general rule of thumb that the beginnings of marks will usually have more effect on the perception. In my view, the rule of thumb applies here such that the two words WEST COAST (which combine instantly to form the name of a location) are likely to command the greatest degree of attention. These words are positioned prominently at the beginning of the mark, they constitute a large proportion of the mark as a whole and possess a greater degree of distinctiveness than the word CHILL in relation to the relevant goods. That said, the presentation of the mark is such that the eye is invited to read through all three words together- they appear to form a phrase.

34) Visually, the marks coincide in respect of the words 'West Coast' (albeit that those words are presented in different styles and fonts). While all other aspects of the marks differ, there is, nevertheless, owing to the aforementioned common words, a reasonable degree of visual similarity.

35) Aurally, my comments in relation to application 2632092 are equally applicable here (with the exception of those relating to the 'W' element). There is a good degree of aural similarity.

36) I have indicated above that, in light of its presentation, I consider the three words in JCI's mark work together to form a phrase. The resultant concept portrayed is, to my mind, that of a cold area of westerly land by the sea/ocean. Bearing in mind my comments at paragraph 29 regarding the concept portrayed by the IDL's mark, there is a very good degree of conceptual similarity.

Distinctive character of the earlier mark

37) I must consider the distinctive character of the earlier mark. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*).

38) As no evidence of use has been filed by IDL in relation to 'non-alcoholic drinks', I have only the inherent level of distinctiveness to consider. The mark is not in the highest category of distinctiveness of, for example, an invented word. Nevertheless, bearing in mind, in particular, that the words 'West Coast' (being the most dominant element of the mark) would not appear to be descriptive or allusive of the goods or their qualities, I consider the mark as a whole to possess, at least, an average degree of inherent distinctiveness.

Likelihood of confusion

39) Evidence has been filed on behalf of JCI purporting to show how its mark is used in the course of trade. It is claimed that the evidence shows that JCI's mark has a strikingly different appearance in use than that of the opponent's mark in use and that, accordingly, there is no likelihood of confusion. JCI's evidence does not assist me and IDL's evidence of use has no bearing on my current considerations. I must assess the likelihood of confusion between CTM 8849846 and JCI's marks notionally, based on IDL's mark as registered, JCI's mark as applied for, and the goods which are listed in the respective specifications.

40) In deciding whether there is a likelihood of confusion I must take account of all of the above factors. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the

- marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and;
 - iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

41) I have found identity between the respective goods. The average consumer of those goods will be the general public, and particularly those who participate in sports or other 'keep-fit' activities. I have also found that a fairly low degree of attention will be paid during the mainly visual purchasing act and that the earlier mark is possessed of, at least, an average degree of inherent distinctive character.

42) As regards the similarities between IDL's mark and application 2632092, I have found there to be a moderate degree of visual similarity, a good degree of aural similarity and, at least, very good degree of conceptual similarity. Drawing all of my findings together, I find that, even allowing for the fairly low degree of attention that is likely to be paid, the consumer is unlikely to directly confuse the marks, particularly since the purchase will be mainly visual and I have put the level of visual similarity at only a moderate level. Nevertheless, the similarities that do exist are sufficient, bearing in mind, in particular, the degree of conceptual similarity and the identity between the goods, to result in a likelihood of indirect confusion i.e. that the consumer will assume the respective goods emanate from the same or linked undertaking(s).

43) Turning to application 2632106, I have found the respective marks to share a reasonable degree of visual similarity, a good degree of aural similarity and a very good degree of conceptual similarity. Taking all factors into account and having regard for the interdependency principle, the similarities between the marks again result in a likelihood of indirect confusion.

The consolidated oppositions succeed in full.

COSTS

44) IDL has been successful and is entitled to an award of costs. In approaching the award I take into account that the Form TM7 and accompanying statement of grounds were identical for both oppositions and that the proceedings were consolidated before IDL filed its evidence. I award costs on the following basis:

Preparing notice of opposition	£300
Opposition fee (x2)	£400
Filing evidence	£500
Written submissions:	£300

Total:

£1500

45) I order Joseph Company International, INC to pay Irish Distillers Limited the sum of **£1500**. 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 12th day of December 2013

**Beverley Hedley
For the Registrar,
the Comptroller-General**