O-545-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3058288
BY
PAUL CAMPLISSON

TO REGISTER THE TRADE MARK

VOLKOFF

IN CLASS 33

AND

THE OPPOSITION THERETO
UNDER NO 600000135
BY
HALEWOOD INTERNATIONAL BRANDS LIMITED

BACKGROUND

1. On 4 June 2014, Paul Camplisson (the applicant) applied to register the trade mark: VOLKOFF in class 33 of the Nice Classification system.[1] The specification stands as follows:

> **Class 33**
> Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcoholic cocktails; alcopops.

2. The application was published on 4 July 2014. Halewood International Brands Limited (the opponent) filed notice of opposition against the application, on 20 August 2014, under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade mark 2568170, shown below:

Mark details and relevant dates	**Goods relied on**
Mark: VOLKOVA **Filing date:** 29 December 2010 **Date of entry in the Register:** 1 April 2011	**Class 33** Alcoholic beverages; vodka; mixed spirit beverages; schnapps.

4. On 17 October 2014, the applicant filed a counterstatement, denying the ground of opposition.

5. Rules 20(1)-(3) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

> "(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit."

6. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

7. No leave was sought in respect of these proceedings.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

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[1] *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

9. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

10. I give this decision following a review of all of the material before me.

DECISION

11. Section 5(2)(b) of the Act reads 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 on the part of the public, which includes the likelihood of association with the earlier trade mark."

12. An earlier trade mark is defined in section 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."

13. The opponent's mark is an earlier mark, which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.

Section 5(2)(b) case law

14. The following principles are gleaned from the decisions 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 C-3/03, *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 a 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 great 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 the earlier mark to mind, 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.

The average consumer and the nature of the purchasing act

15. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

16. The average consumer is a member of the general public. The goods are made available through a variety of trade channels. They may be bought in a shop, supermarket, off-licence, online or from a catalogue. The selection is likely to be made by the consumer from a shelf or from a website or mail-order catalogue, where the consumer will also select the goods visually. They may also be sold through bars, clubs and public houses, where the goods may be requested orally, from a member of staff. In considering this point I bear in mind the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*[2] when it 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."

17. Consequently, even though the purchase of these goods in a bar may involve an aural element, the selection will be made, primarily, from the display of goods on shelves, in fridges and on optics at the back of the bar. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element. The level of attention paid will be that necessary to achieve inter alia, the correct flavour/variety and strength. Accordingly, the average consumer will pay a reasonable level of attention.

Comparison of goods

18. The goods to be compared are as follows:

The opponent's goods	**The applicant's goods**
Class 33 Alcoholic beverages; vodka; mixed spirit beverages; schnapps.	**Class 33** Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcoholic cocktails; alcopops.

19. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM,* Case T-133/05:

> *"29. …goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."*

20. Both parties' specifications contain the term 'alcoholic beverages' which are clearly identical. The remaining goods in the application are included within the term 'alcoholic

[2] *T-3/04*

beverages' in the opponent's specification. In accordance with *Meric,* these are also identical goods.

Comparison of marks

21. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 Court of Justice of the European Union 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."

22. It would be wrong, therefore, to artificially 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.

23. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
VOLKOVA	VOLKOFF

24. Both parties' marks consist of a single element, the opponent's being the word VOLKOVA, in block capitals with no form of stylisation and the applicant's being the word VOLKOFF, in block capitals, with no form of stylisation. Consequently, the overall impressions of both marks are based solely on those words.

Similarity of the marks

25. The opponent states:

> *"The marks to be compared are VOLKOVA and VOLKOFF. The marks are both invented words, with no meaning to an English-speaking consumer. The marks both consist of seven letters, of which the first five letters are identical, in the same order. The only difference between the marks is their endings. There is also a degree of similarity between the consonants V and F, as these are frequently pronounced in an identical, or at least similar, manner. Visually the*

marks are very similar. Phonetically, they are also similar, as the main emphasis is placed on the first syllable, VOLK. Conceptually, neither has a particular meaning, however, each gives an impression of a Russian word, and they share this characteristic."

26. The applicant denies any similarity between the marks.

27. Visually, the marks are the same length and share the same first five letters, VOLKO. They differ in the last two letters; the applicant's ending with FF, the opponent's with VA. The marks are visually highly similar.

28. Aurally, the applicant's mark consists of two syllables, VOLK-OFF. The second syllable may be pronounced as it is spelt, as the common English word OFF, or may be pronounced 'OF', with a softer 'F' sound. The opponent's mark consists of three syllables, VOLK-O (as in OPEN)-VA (as in the beginning of VANILLA). Taking these factors into account, the marks are aurally similar to a medium degree.

29. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer[3] and the assessment must be made from their point of view.

30. The overall impression of both marks is that of a single invented word, possibly of foreign origin. Accordingly, the average consumer will take no meaning from the marks at all.

31. I find the marks to be conceptually neutral.

Distinctive character of the earlier mark

32. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

33. As I have concluded above, the opponent's mark will not convey a clear conceptual message to the average consumer. Consequently, it is neither descriptive nor elusive of the goods at issue and enjoys a high level of inherent distinctive character.

Likelihood of confusion

34. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.[4] I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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.

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[3] *This is highlighted in numerous judgments of the GC and the CJEU including Ruiz Picasso v OHIM [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.*

[4] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

35. Earlier in this decision I concluded that the marks share a high degree of visual and a medium degree of aural similarity and are conceptually neutral. I have found the earlier mark to have a high level of inherent distinctive character and the parties' goods to be identical. The average consumer is a member of the general public who will pay a reasonable degree of attention to the purchase, which is primarily a visual one.

36. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027[5], that the first parts of words catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case both marks begin with the five letters 'VOLKO'. This letter combination is striking and would not go unnoticed by the average consumer. Bearing in mind the concept of imperfect recollection, in the context of widely available and fairly low cost goods, the similarity of the marks is such that there will, in my view, be direct confusion (where one mark is mistaken for the other).

Conclusion

37. The opposition succeeds.

COSTS

38. The opposition having succeeded, the opponent is entitled to a contribution towards its costs. I make the award on the following basis:

Preparing a statement and considering the other side's statement:	£300
Preparing submissions in lieu of attendance at the hearing:	£200
Official fee	£100
Total	£700

39. I order Paul Camplisson to pay Halewood International Brands Limited the sum of £600. 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 17th day of December 2014

Ms Al Skilton
For the Registrar,
The Comptroller General

[5] *El Cortes Inglés v OHIM - González Cabello and Iberia Lineas Aéreas de España (MUNDICOR) [2004] ER II - 965, paragraph 81*