

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2020540
BY HI-SPIRITS INTERNATIONAL LIMITED
TO REGISTER THE TRADE MARK:
BOSS
IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No 52025
BY BRANDBREW SA
BASED UPON THE EARLIER TRADE MARK:
BASS
(and others)**

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by HI-SPIRITS INTERNATIONAL LIMITED
to register the trade mark:
BOSS
in class 32
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IN THE MATTER OF Opposition thereto under No 52025
by Brandbrew SA

Background

1) On 13 May 1995 Hi-Spirits International Limited applied to register the trade mark **BOSS** in respect of the following goods in class 32 of the International Classification of Goods and Services:

beers, lagers, ales, mineral waters and non-alcoholic beverages

The application was published on 8 November 2000.

2) On 18 January 2001 Brandbrew SA filed notice of opposition to this application.

3) The opponent states that he is the proprietor of the following United Kingdom trade mark registrations:

- no 292276 for the trade mark **BASS** for *beer*
- no 996159 for the trade mark **BASS** for *beer, ale, stout and porter; shandy; beverages containing beer and included in class 32; and preparations included in class 32 for making all the aforesaid goods*
- no 21701 for the trade mark :



for *beer*

- no 996152 for the trade mark:



for *beer and preparations included in Class 32 for making beer*

- no 2001325 for the trade marks:



for *ale*

All the above registrations are in class 32 of the International Classification of Goods and Services and currently stand in the name of the opponent.

4) The opponent states that the trade mark in suit is phonetically and visually similar to the word BASS, which he states is a distinctive element of all his trade marks. He states that the goods encompassed by the respective trade marks are identical or similar. Consequently, registration of the trade mark in suit would be contrary to section 5(2)(b) of the Act.

5) The opponent states that he or his predecessors in title have been using the trade mark BASS for well over 100 years in relation to beers and other alcoholic drinks and as a result a considerable reputation and goodwill has been acquired. Consequently, use of the trade mark in suit would offend against the law of passing-off and so its registration would be contrary to section 5(4)(a) of the Act.

6) The applicant filed a counterstatement denying the grounds of opposition.

7) Both parties filed evidence and seek an award of costs. After the completion of the evidence rounds I advised the parties that I believed a decision could be made without a hearing. However, the parties were advised that they retained their right to a hearing. Neither party requested a hearing so I will make a decision after a careful study of the papers.

Opponent's evidence

8) This consists of a statutory declaration made by Stuart Newland. Mr Newland is the director of business services of Bass Brewers Limited (BBL). Mr Newland states that BBL and Interbrew SA are both subsidiaries of Interbrew SA.

9) Mr Newland states that in 1777 William Bass bought his own brewery in Burton-on-Trent. William Bass used his signature as a trade mark to denote the beer brewed in that company. Mr Newland states that his descendants and successors have used that signature on products to denote both their origin and high quality.

10) Mr Newland exhibits at SN1 various labels displaying the word BASS. All the labels show the signature the subject of trade mark registration no 21701 and the words BASS & Co's. The labels emanate from between 1844 and 1937. All of the labels indicate that they are for some type of beer.

11) Mr Newland exhibits at SN3 a copy of Bass PLC's annual report and financial statement of 1996. He states that Bass PLC is the former owner of the BASS brewing business. Mr Newland states that it will be seen that BBL, the company within Bass PLC group primarily

responsible for the sale of alcoholic beverages, made an operating profit in 1996 of £157 million, the predominant portion of which would be attributable to the United Kingdom. It would appear that this figure does not relate solely to goods bearing the BASS trade mark or goods which are beverages. There is reference to the sale of a gas business and to the Hooper's Hooch, Caffrey's Irish Ale and Carling brands. The document indicates that in the year 1995 the profit for BBL was £144 million.

12) Mr Newland exhibits at SN4 a copy of a newsletter of September 1996 called "Horizons". He draws attention to pages 6 and 7 of this newsletter, which he states sets out Bass Brewers' excellent record in producing goods for export. This newsletter shows a variety of trade marks that the opponent uses including Tennents, Barbican, Hooch, Caffrey's and Staropramen.

13) Mr Newland exhibits at SN5 a copy of a pamphlet entitled "The True Story of the Classic English Ale" which gives the history of BASS pale ale. Mr Newland also refers in his declaration to a leaflet entitled "The Story of Bass" but this has not been adduced into the proceedings.

14) Exhibited at SN6 is a copy of an article about the painting Manet's "The Bar at the Folies Bergere". This article refers to the presence in the painting of a bottle bearing a red triangle, which it identifies as the first trade mark to be registered in the United Kingdom and to be in the ownership of BASS. Mr Newland states that many artists have celebrated the opponent's product and that Picasso created over thirty works depicting the BASS pale ale bottle and its distinctive trade mark.

15) Exhibited at SN7 are printouts from the opponent's website. The pages give the history of BASS.

16) Exhibited at SN8 is an empty tin of ale which bears inter alia the word BASS in the same script as the signature of registration no 21701. Exhibited at SN9 are samples of promotional material. All of these relate to beer. Certain of the materials do not bear any indication of date. However, others bear closing dates for competitions; from these it would appear that they emanate from well after the relevant date for these proceedings.

17) Mr Newland gives details of export sales. I do not see that these have a bearing upon my deliberations. He also gives figures for sales, which I presume emanate from the United Kingdom, from 1996 to 2000. They are between £51 and £56 million. Again the figures all emanate from after the relevant date. Advertising figures are given. It is not indicated if these relate to the United Kingdom alone. Again the figures are for the period from 1996 – 2000, so after the relevant date.

18) Mr Newland states that goods sold under the trade mark have been promoted widely throughout the United Kingdom and that the company is a sponsor of the "The Publican Golfing Pub of the Year". He exhibits at SN10 an entry form for this competition for the year 2001.

19) Mr Newland ends his declaration with what can best be described as submissions rather than evidence of fact. Therefore, I will say no more about them but take them on board in considering my decision.

Applicant's evidence

20) This consists of a witness statement by Christopher Wharton. Mr Wharton is a director of the applicant. Mr Wharton states that the applicant is the owner of United Kingdom trade mark registration no 1494241 for the trade mark BOSS in class 32, which covers cider. Mr Wharton goes on to deal with use of the trade mark for cider. As the specification of the trade mark in suit does not encompass cider I do not consider that I need to say any more about the cider side of the business. Mr Wharton states that the applicant decided to extend his product range by selling lager. Mr Wharton goes on to give figures for the sale of lager from 1995 to 2001. The turnover starts at £76, 864 and ends at £216,858. Mr Wharton refers to where goods under the trade mark BOSS have been sold but does not advise if all these locations relate to both the cider and the lager. So, it is not possible to be certain as to the locations in which the lager has been sold. Mr Wharton states that no promotional literature has been produced for lager sold under the trade mark BOSS. He exhibits at annex 2 an empty tin displaying the BOSS trade mark. The tin indicates that the contents are lager. The tin has a sell by date of October 2002, there is no indication of when it was produced.

Opponent's evidence in reply

21) This consists of a witness statement by Nicholas David Baker. Mr Baker is a trade mark attorney. I would characterise his witness statement as representing submissions rather than evidence of fact. I will, therefore, say no more about it. However, I will take on board the submissions in reaching my decision.

Decision

Likelihood of confusion

22) Section 5(2)(b) of the Trade Marks Act 1994 states that a trade mark shall not be registered if because:

“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.”

23) Section 6(1)(a) of the Act defines an earlier trade mark as:

“a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks”

24) All the trade marks upon which the opponent relies fall within the parameters of section 6(1)(a) and are, therefore, earlier trade marks.

25) In determining the question under section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *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] FSR 77 and *Marca Mode CV v. Adidas AG* [2000] ETMR 723. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v. Puma AG* page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG* page 224, 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.* page 84, paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG* page 224;
- (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* page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 132, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG* page 224;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG* page 224;
- (h) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG* page 732, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* page 133 paragraph 29.

26) Taking into account the trade marks and the specifications, if the opponent cannot succeed in relation to registration nos 996159 and 996152 I cannot see that he can succeed in respect of any of the other registrations.

Comparison of signs

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

Earlier registrations:

BASS

A stylized cursive logo for 'Bass Vfo'. The word 'Bass' is written in a flowing, handwritten style with a double underline under the 'a'. The letters 'V' and 'fo' are also in cursive, with the 'V' being particularly large and decorative.

Trade mark in suit:

BOSS

28) I consider the upper trade mark of the opponent first. It is a common English word used in relation to a voice of a low register, a stringed musical instrument and a type of fish. BOSS is another common English word which has a variety of meanings; such as the head of a group or organisation, to act in an overbearing manner and a stud. The respective trade marks, therefore, have different conceptual associations.

29) BASS has two potential pronunciations. In one it is pronounced in the same fashion as the word 'base'; in the other the vowel is pronounced as a short 'a' and the double 's' as a strong sibilant. BOSS is pronounced with a normal 'o' sound ending with a strong sibilant. The ear is well used to differentiating between small words with different vowel sounds e.g. cat, cot and cut. Taking into account the shortness of the words and the very different vowel sounds I do not consider that the respective trade marks are phonetically similar.

30) This leaves the issue of visual similarity. In relation to common words the public, in my view, do not divorce the meaning and the look of the word. The two are inextricably linked, when the word is seen it is identified with its meaning. The visual interpretation is based upon the identification of the word. Consequent upon this I consider that the respective trade marks are not visually similar.

31) I consider, taking the above into account, that the trade marks BOSS and BASS are not similar.

32) The same arguments apply for the lower trade mark of the opponent, perhaps even more owing to the additional element at the end and the stylisation. However, I consider it necessary to consider whether the stylisation of the word BASS might lead the public to read the 'a' as an 'o'. If that were the case this would be damning for the applicant. In considering this matter I have had some difficulty. I am very well aware of the trade mark of the opponent. I automatically read it is BASS. I have had to try and place myself in a trade mark bubble and consider the matter uncontaminated from my knowledge of the trade mark. Having considered the matter carefully I consider that the normal, circumspect consumer, even if in a hurry, will read the vowel as an 'a'. Consequently I cannot see that the opponent can be in any better position in relation to this trade mark.

Conclusion

33) In order for there to be a likelihood of confusion the respective trade marks have to be similar. All the matters that have to be considered in the global appreciation of the trade marks, reputation, proximity/identity of goods, nature of goods, the earlier trade mark being particularly distinctive, cannot assist an opponent where the signs are not similar. Without similarity of signs there can be finding of a likelihood of confusion. This is what The European Court of Justice in *Sabel* held:

“In that connection, it is to be remembered that Article 4(1)(b) of the Directive is designed to apply only if, by reason of the identity or similarity both of the marks and of the goods or services which they designate, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

Mr Hobbs QC, sitting as the Appointed Person, also dealt with this matter in *Raleigh International* [2001] RPC 11:

"Similarities between marks cannot eliminate differences between goods or services; and similarities between goods or services cannot eliminate differences between marks. So the purpose of the assessment under section 5(2) must be to determine the net effect of the given similarities and differences."

34) I note the comments of the applicant about the absence of confusion in the market place. Lack of confusion in the market place can be indicative that there is not likely to be a likelihood of confusion as per section 5(2)(b) of the Act. The goods which are of interest to me are those encompassed by class 32; the situation in relation to cider does not affect the situation. The sales of lager are quite clearly small; publicity, it would appear, has been non-existent. The applicant's specification covers goods other than lager e.g. ales. That no one states that they have been confused proves little other than that there is an absence of evidence; especially in the context of such small sales. I do not consider that, in this case, the presence of goods under both trade marks on the market tells me anything about the likelihood of confusion. This matter has not been given any weight by me in my deliberations.

35) I find that there is not a likelihood of confusion.

Passing-off

36) Section 5(4)(a) of the Act states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented——

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

37) To succeed in a case of passing-off the opponent has to show:

- that his goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature
- that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered him, are the goods of the opponent
- that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation

38) I have no doubt from the evidence supplied, which shows a long and continuous use of BASS in relation to ales, that the opponent does have the requisite goodwill for ales. However, I have already found that the respective signs are not similar. For misrepresentation to take place the public will have to identify the sign of the applicant with the goods of the opponent. As the signs are not similar I do not believe that they would. Consequently, I do not consider that there is any misrepresentation and the claim in relation to passing-off must fall.

39) I find that the grounds of opposition under section 5(4)(a) must be dismissed.

40) The applicant having succeeded he is entitled to a contribution towards his costs and I therefore order the opponent to pay him 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 04 day of September 2002

**D.W.Landau
For the Registrar
the Comptroller-General**