

O-190-04

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2286183
BY JORDAN BRAND LIMITED
TO REGISTER THE TRADE MARK
V-10
IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 90589
BY CAMPBELL SOUP COMPANY

BACKGROUND

1) On 21 November 2001, Jordan Brand Limited of Silverstone, Northamptonshire, NN12 8TJ applied under the Trade Marks Act 1994 for registration of the trade mark “V-10” in respect of the following goods in Class 33: “Alcoholic beverages; wines, spirits and liqueurs”.

2) On 21 May 2002 Campbell Soup Company of Campbell Place, Camden, 08103-1799, New Jersey, United States of America filed notice of opposition to the application. The grounds of opposition are in summary:

a) The opponent is the proprietor of the Community Trade Marks and UK Trade Marks detailed below. The opponent and its predecessors have used these marks in the UK since 1958 in relation to a vegetable juice drink. A primary focus has been on the healthy nature of this drink and its ability to contribute to a healthy lifestyle. It has however also been targeted at an adult customer base and is frequently to be found in cocktail recipes. Sales of the product have averaged £1.2 million in the two years prior to the relevant date. The product is available from large supermarkets, convenience stores and health stores throughout the UK. The cost per can is 85 pence.

b) The opponent contends that the goods included in the applicant’s specification are similar to those for which its marks are registered. In the alternative, the goods are not similar but use of the mark would take unfair advantage of or be detrimental to the distinctive character or the repute of the opponent’s marks. The opponent contends that its marks have acquired goodwill and reputation in the UK. Therefore, the application offends against Sections 5(2)(b), 5(3), 5(4)(a) and 56 of the Trade Marks Act 1994.

Trade Mark	Number	Effective Date	Class	Specification
V8	CTM 212217	01.04.96	29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats, vegetable juices.
			32	Vegetable juices, beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
	CTM 212241	01.04.96	29	Meat, fish, poultry and game; meat extracts; preserved, dried and cooked fruits and vegetables; jellies, jams, fruit sauces; eggs, milk and milk products; edible oils and fats, vegetable juices.

			32	Vegetable juices, beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
	UK 900337	12.10.66	32	Vegetable juices for use as beverages.
	UK 1295067	08.12.86	32	Fruit juices and vegetable juices, all included in Class 32.

3) The applicant subsequently filed a counterstatement denying the opponent's claims.

4) Both sides filed evidence and ask for an award of costs. The matter came to be heard on 20 April 2004 when the applicant was represented by Mr Abrahams of Counsel instructed by Messrs Dechert. The opponent was represented by Mr Speck of Counsel instructed by Messrs Sceptre.

OPPONENT'S EVIDENCE

5) The opponent filed a witness statement, dated 17 January 2003, by Jonathan Elms the Marketing Controller of Campbell Grocery Products Ltd an English subsidiary of the opponent company. He states that the opponent began use of the trade mark V8 in the UK in May 1958 and that it has been used since that date in relation to a vegetable juice drink.

6) Mr Elms states that the UK registration for V8 was achieved in 1966 as a result of significant use of the mark. He provides, at exhibit JE3, some of the evidence filed at the time. However, given the number of years that has passed I do not find this evidence of assistance in my decision. Mr Elms states that although the primary focus has always been on the healthy nature of the drink it has also been targeted at adults as a cocktail mixer. At exhibit JE4 he provides pages from various internet sites which provide recipes for cocktails and include V8 as an ingredient. Each cocktail shows a date when it was entered on the site. However, all of these dates are after the relevant date.

7) Mr Elms states that the product is sold by supermarkets, convenience stores and health food stores throughout the UK and on-line. At exhibit JE5 he provides a print

out from a web site which sells the product. However, this is dated October 2002. He provides the following sales figures for the UK:

Financial Year	Sales £	Sales volume
1996	992,870	3.5 million
1997	1,200,000	4.1 million
1998	N/A	N/A
1999	1,100,000	N/A
2000	1,310,000	N/A

8) At exhibits JE1 and JE7 Mr Elms provides copies of labels showing how the mark is used in the UK. In JE1 the publication refers to use in the UK of “‘upbeat’ contemporary graphics”. However, the publication appears to have been published in 1994. Exhibit JE7 consists of copies of labels none of which are dated. In all cases the mark has a hyphen between the “V” and the “8” with underneath the words “vegetable juice” or “tomato and vegetable juice”. Exhibit JE8 consists of a letter and a copy of a label dated 1971 which I do not find of assistance. At exhibits JE9 and JE10 he provides copies of a recent advertisement for the product and promotional material. These are either dated May 2002, after the relevant date, or are undated.

9) Mr Elms states that in 2000, Germany hosted a world exposition. The EU hosted one pavilion and presented a videotape part of which featured the Office for Harmonization in the Internal Market (OHIM). OHIM selected a number of trade marks which he states it regarded as “significant” for use in the video one of which was the opponent’s trade mark number 212241. At exhibit JE11 he provides copies of correspondence relating to the use of the trade mark in the video. However, the correspondence only makes it clear that the twenty seconds devoted to OHIM was to include what the writer from OHIM describes as “significant trade marks”. How long each image lingered on the screen is unclear.

APPLICANT’S EVIDENCE

10) The applicant filed a witness statement, dated 22 August 2003, by Mike Hall-Taylor the Head of Jordan Brand limited which is a sister company of Jordan Grand Prix Limited. He states that he has been associated with the company since September 1999. He states that the applicant has submitted applications for the mark in suit in a number of countries world wide.

11) Mr Hall-Taylor states that in October 2001 the company wanted to launch its EJ-10 energy drink. Five alcoholic cocktails were devised to see what customers thought of the energy drink mixed with a variety of spirits. The most popular combination was that with vodka. To avoid problems in educating bar staff and also the risk of improperly mixed cocktails the obvious solution was to pre-package the cocktail. The V-10 is a blend of vodka, EJ-10 energy drink and a dash of lime. The name, V-10, comes from the engine used by the Grand Prix team. He states that “the V-10 drink depicts the ethos of the Jordan Formula One team, namely “fast living; high

performance; loads of fun” and is targeted at young male adult drinkers, in particular.”

OPPONENT’S EVIDENCE IN REPLY

12) The opponent filed a witness statement, dated 26 November 2003, by Tim Perman the Marketing Director of Campbells Grocery Products Limited an English subsidiary of the opponent. He draws attention to the fact that his company’s V8 drink is used as a cocktail ingredient, a number of which include Vodka. He claims that the applicant’s use of the mark with the word “Vodka” appearing above the mark in suit will lead customers to assume that the drink is a mix of vodka and V-10. They will therefore link this to his company’s V8 drink also used as a mixer.

13) Mr Perman states that both parties product will be sold via similar outlets and both are usually sold chilled.

14) That concludes my review of the evidence. I now turn to the decision.

DECISION

15) I shall deal firstly with the ground of opposition under Section 5(2)(b) which reads:

“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.”

16) An “earlier trade mark” is defined in Section 6, 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 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,”

17) The opponent is relying on two Community Trade Mark Registrations 212217 and 212241 registered with effect from 1 April 1996 and two UK Trade Mark Registrations 900337 and 1295067 registered with effect from 12 October 1966 and 8 December 1986 respectively. All these marks are plainly “earlier trade marks”.

18) In determining the question under section 5(2)(b), 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-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R 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-Meyer Inc.* page 7 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 8, paragraph 24;

(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-Meyer Inc.* page 9, paragraph 29.

19) In essence the test under Section 5(2) is whether there are similarities in marks and goods and/or services which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of

confusion I am guided by the judgements of the European Court of Justice mentioned above. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements taking into account the degree of similarity in the goods and/or services, the category of goods and/or services in question and how they are marketed. Furthermore, I must compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

20) I shall first consider the goods of the two parties. It was accepted at the hearing that the opponent's strongest case resided in its Class 32 specifications, I do not need therefore not consider the goods registered in Class 29.

21) Mr Abrahams referred me to the factors set out by Mr Justice Jacob in *British Sugar Plc v James Robertson & Sons Ltd* [1996] R.P.C. 281 at page 296. Adapted to the instant case, it can be stated as:

- a) the uses of the respective goods or services;
- b) the users of the respective goods or services;
- c) the physical nature of the goods or services;
- d) the trade channels through which the goods or services reach the market;
- e) in the case of self-serve consumer items, where in practice they are respectively found or likely to be found on the same or different shelves; and
- f) the extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods or services, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

22) These factors were referred to in the opinion of the Advocate General in *Canon*; page 127, paragraphs 45-48. In its judgement, the ECJ stated at paragraph 23:

“23. In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary.”

23) The specifications to be considered are:

Applicant's Specification	Opponent's specification.
Class 33: Alcoholic beverages; wines	212217 & 212241: Class 32: Vegetable juices, beers; mineral and aerated waters and other non-alcoholic

spirits and liqueurs.	drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.
	900337: Class 32: Vegetable juices for use as beverages.
	1295067: Class 32: Fruit juices and vegetable juices, all included in Class 32.

24) Mr Abrahams contended that the goods of both parties were beverages and thus their uses, physical nature and end users were the same. He also contended that they would be sold alongside each other, indeed that they would be on the same shelf or in the same chiller cabinet.

25) Clearly, the physical nature of the products are similar in that they are all liquids, even though the viscosity may differ. In the broadest sense their uses are similar in that they are all beverages which can be used to slake a thirst. There is an overlap in users in that the adult general public, with the exception of teetotalers would, potentially, be consumers of both parties goods. Clearly juveniles could not be considered as users of the applicant's products whereas they would consume the opponent's goods. Although I have no evidence regarding trade channels I do not believe that they would be the same, as alcoholic drinks are subject to various duties and are usually kept in bonded warehouses, though this comment does not apply to the opponent's registrations for "beers". Similarly, in my experience I do not consider that the goods of both parties, with the exception of "beers" would be found on the same shelf or even in the same section of a shop. Alcoholic drinks are kept separate from other types of drinks as they are restricted purchases which can only be sold at certain times of the day and only to adults. Some supermarkets even erect barriers to prevent shoppers from getting into the alcohol section outside of licensing hours.

26) Taking the above into account it is my opinion that only "beers" included in the opponent's CTM specifications are similar goods to those of the applicant, all the other goods in the opponent's specifications are not similar.

27) Mr Abrahams contended that the opponent's marks, whilst differing slightly, were all primarily "V8" marks. He stated that the depiction of vegetables in CTM 212241, the hyphen in UK 1295067 and the slight stylisation of both of the trade marks UK 900337 and UK1295067 would not detract from the distinctive character of the opponent's mark. I agree with him that the marks would all be seen as "V8" marks. In any event the opponent's strongest case is under CTM 212217 which is "V8" in plain type with no stylisation or hyphen.

28) Clearly, when comparing the two marks "V10" and "V8" there are similarities in that they both begin with the letter "V" and both then have a number. Both marks also have car engines connotations as most car engines are expressed as "V" and a number. The most common examples in road cars being "V4", "V6" & "V8". In motor racing the most common configurations are "V6", "V8" & "V10". Whilst differences in short marks may assume greater importance to my mind, the visual, aural and conceptual similarities outweigh the differences, such that the marks are similar.

29) I also have to consider whether the opponent's marks have a particularly distinctive character either arising from the inherent characteristics of the marks or

because of the use made of them. To my mind the opponent's marks have an inherent distinctive character.

30) The opponent claims that it has a considerable reputation in the UK for its vegetable juice. However, most of the evidence filed was of little assistance in establishing such a reputation as it is either undated, dated after the relevant date or dated many years prior to the relevant date. The opponent filed turnover and volume figures but did not provide any evidence to put these figures into context such as the size of the market or its market share. The opponent did not file evidence from the trade or any independent witnesses as to its reputation. Taking all this into account I cannot accept the opponent's contention that they have a substantial reputation in the marks in the UK.

31) Carrying out a global assessment and taking into account imperfect recollection I consider that when used on "beers" there is a likelihood of confusion between the opponent's mark and the mark in suit. The opposition based on "beers" in CTM 212217 succeeds. The opposition based upon all other goods in the specifications of the other marks listed fails.

32) I next turn to the grounds of opposition under Sections 5(3), 5(4)(a) and 56 which state:

"5.(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

5. (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, or

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an "earlier right" in relation to the trade mark.

56.-(1) References in this Act to a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark are to a mark which is well-known in the United Kingdom as being the mark of a person who -

- (a) is a national of a Convention country, or

- (b) is domiciled in, or has a real and effective industrial or commercial establishment in, a Convention country,

whether or not that person carries on business, or has any goodwill, in the United Kingdom.

References to the proprietor of such a mark shall be construed accordingly.

(2) The proprietor of a trade mark which is entitled to protection under the Paris Convention or the WTO agreement as a well known trade mark is entitled to restrain by injunction the use in the United Kingdom of a trade mark which, or the essential part of which, is identical or similar to his mark, in relation to identical or similar goods or services, where the use is likely to cause confusion.

This right is subject to section 48 (effect of acquiescence by proprietor of earlier trade mark).

(3) Nothing in subsection (2) affects the continuation of any *bona fide* use of a trade mark begun before the commencement of this section.”

Section 5(3)

33) To succeed under this ground the opponent must show that it enjoys a reputation in the earlier right. I have found earlier in this decision that the opponent has not established a reputation in the trade marks. This ground of opposition therefore fails.

Section 5(4)(a) - Passing off

34) To succeed under this ground the opponent must show that it enjoyed goodwill at the relevant date. The relevant date for passing off purposes relates to the commencement of the behaviour complained of. This will normally be the date of the filing of the application.

35) I have found earlier in this decision that the opponent has no reputation in its trade marks. It has shown that it has made sales of its “vegetable juice” and therefore may be said to have goodwill. However, earlier in this decision I found that use of the opponent’s mark on such goods, actual or on a fair and notional basis would not result in confusion with the application in suit. Accordingly, it seems to me that the necessary misrepresentation required by the tort of passing off will not occur. The opposition under Section 5(4)(a) of the Act must fail.

Section 56

36) The need to be “well known” in the United Kingdom is a pre-requisite under this ground and in view of my earlier finding that the opponent has no reputation in its trade marks in the UK, this claim does not get off the ground. The ground of opposition under Section 56 of the Act must fail.

37) The opponent has been successful under Section 5(2)(b) with regard to part of its specification in two of the four marks stated in its ground of opposition. It failed under the other three grounds. As the opponent was successful in only one of its grounds the costs have been reduced. I order the applicant to pay the opponent the sum of £500. This sum 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 2nd day of July 2004

George W Salthouse
For the Registrar,
The Comptroller-General