

TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION No 2126290  
BY FRANK BOYD  
TO REGISTER THE MARK  
**BOLSKOFF**  
IN CLASS 33

AND IN THE MATTER OF OPPOSITION THERETO  
BY DISTILLEERDERIJEN ERVEN LUCAS BOLS B.V.

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by FRANK BOYD TO REGISTER A TRADE MARK IN CLASS 33

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AND IN THE MATTER OF OPPOSITION THERETO  
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**DECISION**

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**BACKGROUND**

On 11 March 1997, Frank Boyd of Suite 5, 149 Hamilton Terrace, St. Johns Wood, London, NW89 Q5 applied under the Trade Marks Act 1994 for registration of the trade mark **BOLSKOFF** in respect of the following goods "Vodka, Gin, all spirits." in Class 33:

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On the 10 October 1997 Distilleerderijen Erven Lucas Bols B.V. filed notice of opposition to the application. The grounds of opposition are in summary:

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I) that the opponents are the registered proprietors of the following trade marks which consist of or contain the word or letters BOLS.

Trade Mark	Number	Date	Goods
BOLS	491452	15/05/28	Hollands gin, dry gin, cherry brandy, kummel, curacao, maraschino and creme de menthe
BOLS label	645819	13/03/46	Gin and liqueurs, all being the produce of Holland
Anno 1575 Lucas Bols label	B684020	17/11/49	All goods included in Class 32
Anno 1575 Lucas Bols label	684021	17/11/49	All goods included in Class 33
SILVER TOP "BOLS"	B702593	12/11/51	All goods included in Class 33
BOLSKAYA	868064	13/08/64	All goods included in Class 33
Bols	B877947	07/04/65	All goods included in Class 33
BOLS	B878728	27/04/65	Beer, ale & porter, non-medicated mineral and aerated water; non-alcoholic drinks included in Class 32
BOLS	1430153	27/06/90	Gin; brandy and liqueurs; all included in Class 33
BOLS	B1435743	14/08/90	Catering services; consultancy services relating to distillery technology; restaurant, café, cafeteria, snack bar, bar, inn and public house services; all included in Class 42

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ii) In view of the opponents' use of and reputation in these marks the application is made in bad faith and so offends against Section 3(6) of the Trade Marks Act 1994.

iii) The applicant's mark is similar to the opponents' registered trade marks and is for similar and/or identical goods. It therefore contravenes Sections 5(2) and, by virtue of the opponents' reputation it also offends against Section 5(4) of the Trade Marks Act 1994.

The applicant did not file a counterstatement or any evidence. The opponents asked for costs, and indicated that they did not wish to be heard in the matter. My decision will therefore be based on the pleadings and the evidence filed.

#### OPPONENTS' EVIDENCE

This takes the form of a statutory declaration by Mrs Elizabeth Catherine Hondius, dated 30 June 1998, who is the Trade Marks Manager of Distilleerderijen Erven Lucas Bols B.V., the opponents in these proceedings.

Mrs Hondius states that the opponents have "since 1949" produced a range of liqueurs, spirits and a grenadine syrup under the trade mark BOLS in the UK. This range is described in a brochure produced by the UK distributor, J R Phillips, and filed as exhibit ECH-1. As well as providing prices for the twenty-one different liqueurs it has a picture of a group of seventeen bottles with the majority clearly showing the BOLS trade mark on their label.

Mrs Hondius claims that goods under the BOLS mark "are and have been since at least 1949" available throughout the UK. She claims that approx. £321,000 is spent annually on advertising and the goods are also promoted in the J R Phillips Christmas trade shows. Figures for the value of goods supplied under the BOLS mark in the UK are provided as follows:

Year	Annual Value
1994	£1,386,787
1995	£2,627,034
1996	£1,302,583

Finally, Mrs Hondius claims that as a result of the extensive use over many years the opponents have acquired considerable reputation in the trade mark BOLS. The applicant's use of the mark BOLSKOFF in relation to goods in class 33 is likely to cause confusion in the minds of consumers as to the source of the goods. She points out that the applicant's mark incorporates the whole of the opponents' trade mark BOLS, and is also similar in formation and appearance to another of the opponents' marks BOLSKAYA.

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



From the sales figures produced and the length of use it appears probable that at the material date, 11 March 1997, the opponents had a reputation for alcoholic beverages under the BOLS trade mark. The applicant has not denied their claim to such a reputation. However, it is not evident that they had a reputation under BOLSKAYA. It is clear from the Sabel v Puma case, that a strong mark with a reputation deserves more protection than a weaker mark with no reputation in the market.

I will therefore first compare the opponents' BOLS mark to the applicant's BOLSKOFF mark.

Visually the two marks differ in that one is a four-letter mark whilst the other is eight letters. However, the whole of the opponents' mark makes up the first half of the applicant's mark.

Phonetically the first syllable is exactly the same, with the applicants' mark having a second syllable. The consumer will hear the opponents' mark plus an additional syllable that does not add meaning to the word.

Conceptually, neither mark conveys a meaning; neither are dictionary words. As far as the English language is concerned, they should be treated as made up or fanciful words.

As the ECJ stated in Sabel v Puma, the public normally perceive trade marks as wholes and do not proceed to analyse the various details. Where the earlier mark has a particular reputation (as I have already found the opponents' mark BOLS has in relation to alcoholic beverages), it is more likely that factors such as a common distinctive start to a word mark, particularly where it incorporates the whole of an earlier mark, may cause the public to believe there is some sort of connection in trade, even if there are significant differences between the words as wholes. Where the words are made up or fanciful words which do not have a meaning in the English language these similarities are more likely to cause confusion.

Taking account of the longstanding presence of the BOLS mark in the UK market I conclude that the similarity of the marks (BOLS and BOLSKOFF) is sufficient to create a likelihood of confusion through association as to origin.

I must now consider the applicant's mark, BOLSKOFF, against the opponents' mark BOLSKAYA. Comparing the marks visually they are both eight letters long. They both start with the same five letters although the last three letters are different. Phonetically, they both have exactly the same first syllable, and each of the second syllables begins with the "K" sound.

The marks must be compared as wholes and the fact that they are for identical goods, the possibility of imperfect recollection and the fact that the endings of words tend to be slurred, needs to be taken into account. Having weighed all these factors it is my opinion that the marks are of sufficient similarity to have created a likelihood of confusion at the material date of 11 March 1997.

The opposition under Section 5(2) therefore succeeds based on the opponents' marks BOLS and BOLSKAYA.

Although the matter has already been decided, I will consider the remaining ground of opposition under Section 5(4) which states:

“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 -

5 (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

10 (b) by virtue of an earlier right other than those referred to in subsections (1) to (3) or paragraph (a) above, in particular by virtue of the law of copyright, design right or registered designs.

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.”

15 In deciding whether the mark in question “BOLSKOFF” offends against this section, I intend to adopt the guidance given by the Appointed Person, Mr Geoffrey Hobbs QC, in the WILD CHILD case (1998 14 RPC 455). In that decision Mr Hobbs stated that:

20 “The question raised by the Grounds of Opposition is whether normal and fair use of the designation WILD CHILD for the purposes of distinguishing the goods of interest to the Applicant from those of other undertakings (see Section 1(1) of the Act) was liable to be prevented at the date of the application for registration (see Art.4(4)(b) of the Directive and Section 40 of the Act) by enforcement of rights which the opponent could then have asserted against the Applicant in accordance with the law of passing off.

25 A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol. 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd - v - Borden Inc [1990] RPC 341 and Even Warnik BV - v - J. Townend & Sons (Hull) Ltd [1979] AC 731 is ( with footnotes omitted) as follows:

30 ‘The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

35 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

40 (2) that there is a misrepresentation by the defendant ( whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

45 With these considerations in mind I turn to assess the evidence filed on the behalf of the parties in the present proceedings as set out earlier in this decision.

The opponents’ claim that the public would be confused as to the source of the applicants’ goods believing them to come from them. The opponents state that their products are sold in retail outlets

throughout the UK and that approx. £321,000 is spent promoting their products each year. There is no evidence of the market share although annual sales figures for the years 1994 - 1996 have been provided and show an average sales figure of more than £1.7 million. I have already found that the opponents have a reputation in the market under the trade mark "BOLS", but no evidence of goodwill has been filed for their mark "BOLSKAYA". I have also found earlier in this decision that the opponents' marks (BOLS) is similar to the applicant's mark BOLSKOFF. In my view this similarity is likely to cause the public to believe that the products of the applicant originate from the opponents. Such confusion would inevitably cause damage to the opponents if only through the loss of sales.

I am therefore persuaded that at the relevant date, 11 March 1997, the opponents had a reputation in goods in class 33 (alcoholic beverages). I am also convinced that members of the public would confuse the products of the applicant for those of the opponents. The opponents would therefore be damaged. The opposition under Section 5(4) therefore succeeds.

The opposition having succeeded the opponents are entitled to a contribution towards their costs. I order the applicant to pay the opponents the sum of £600.

Dated this 3 day of March 1999

George W Salthouse  
For the Registrar  
The Comptroller General