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TRADE MARKS ACT 1994  
IN THE MATTER OF APPLICATION 2107264  
BY ROYAL JUBILEE WHISKIES LIMITED  
TO REGISTER THE TRADE MARK  
**McBAIN**  
IN CLASS 33

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AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 47389  
BY McCAIN FOODS (GB) LIMITED

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5 IN THE MATTER OF APPLICATION No 2107264  
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BACKGROUND

15 On 9 August 1996, Royal Jubilee Whiskies Limited of Jubilee House, 19-21 High Street, Whitton, Middlesex, TW2 7LU applied under the Trade Marks Act 1994 for registration of the trade mark McBAIN in respect of the following goods:

20 Class 33: "Spirits, but insofar as whisky and whisky-based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland".

25 On 21 August 1997 McCain Foods (GB) Limited, filed notice of opposition. The opponent did not file any evidence within the authorised period despite the granting of three extensions of time, adding five months to the statutory three month period. Under Rule 13(5) the opposition can be continued without the opponent having to file evidence. However, the grounds of opposition in the original statement of opposition other than those relating to Section 5 (2) were dismissed. The amended grounds of opposition are:

30 "The opponent is the registered proprietor of the following UK trade mark registrations;

MARK	NUMBER	CLASS	JOURNAL	PAGE
McCain	1558501	32	6053	7662
McCain and device	1558511	32	6053	7663

35 Registration of the mark would be contrary to the provisions of Section 5(2)(b) of the Trade Marks Act 1994".

40 The applicant did not file a counterstatement or any evidence. At the request of the opponent a hearing was held on 8 June 2000 at which they were represented by Mr Barrett of Withers & Rogers, the applicant was not represented.

## DECISION

The ground of opposition under Section 5(2) is as follows:

5                   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 mark is protected,**  
  
                      *there exists a likelihood of confusion on the part of the public, which includes the*  
10                   *likelihood of association with the earlier trade mark.”*

An earlier right is defined in Section 6(1)(a) which states:

15                   “6.-(1).....

**(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.”**

20                   The first issue is whether the opponent’s trade marks are “earlier” marks. Both applications  
(1558501 & 1558511) were received on 8 January 1994 and registered on 17 March 1995. The  
application in suit was received on 9 August 1996. The opponent’s marks are therefore “earlier”  
trade marks.

25                   I have to determine whether there exists a likelihood of confusion on the part of the relevant  
public. In deciding this issue I rely on the decision of the Court of Justice of the European  
Communities (ECJ) in the *Sabel v Puma* case C251/ 95 - ETMR [1998] 1-84. In that case the  
court stated that:

30                   “Article 4(1)(b) of the directive does not apply where there is no likelihood of confusion  
on the part of the public. In that respect, it is clear from the tenth recital in the preamble  
to the Directive that the appreciation of the likelihood of confusion ‘depends on  
35                   numerous elements and, in particular, on the recognition of the trade mark on the  
market, of the association which can be made with the used or registered sign, of the  
degree of similarity between the trade mark and the sign and between the goods or  
services identified’. The likelihood of confusion must therefore be appreciated globally,  
taking into account all factors relevant to the circumstances of the case.

40                   Global appreciation of the visual, aural or conceptual similarity of the marks in  
question, must be based on the overall impression given by the marks, bearing in mind,  
in particular, their distinctive and dominant components. The wording of Article 4(1)(b)  
of the Directive - “there exists a likelihood of confusion on the part of the public” -  
45                   shows that the perception of the marks in the mind of the average consumer of the type  
of goods or services in question plays a decisive role in the global appreciation of the  
likelihood of confusion. The average consumer normally perceives a mark as a whole

and does not proceed to analyse its various details.

5 *In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”*

10 I also have regard to the approach adopted by the European Court of Justice in Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc. (case C-39/97) (ETMR 1999 P.1) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

15 *“A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the directive, which states that it is indispensable to give an*  
20 *interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified.”*

25 Further, I take account of the following guidance of the European Court of Justice in Lloyd Schuhfabrik Meyer & Co (1999 ETMR 690) in which the court held that:

30 *“For the purposes of ... global appreciation, the average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96 Gut Springenheide and Tusky [1998]ECR I-4657, paragraph 31). However, account should be taken of the fact that the average consumer only rarely has the chance to make a direct comparison between the different marks but must place his trust in the imperfect picture of them that he has kept in his mind. It should be also be borne in mind that the average consumer’s level*  
35 *of attention is likely to vary according to the category of goods or services in question.”*

40 In order to make the global assessment on the similarity of the marks, it is necessary to consider individual aspects of the question. I propose to firstly consider the similarity of the goods of the two parties.

45 For the purposes of the comparison I shall be considering the opponent’s trade mark registration number 1558501 McCAIN, as the opponent’s other trade mark 1558511 consists of the word McCain and a device. I therefore regard the opponent’s trade mark 1558501 as providing its best case.

The applicant’s mark has a specification of “Spirits, but insofar as whisky and whisky-based

liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland". Whilst the opponent's specification is "All goods included in Class 32". Class 32 includes alcoholic beer. The opponent asserted that alcoholic beer is an alcoholic beverage, and as such is similar to the applicant's specification.

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In considering the degree of similarity between the goods I rely on the decision by Jacob.J. in the *British Sugar Plc v James Robertson & Sons* [“TREAT” 1996 RPC 281]. In that case the court stated that:

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“The following factors must be relevant in considering whether there is or is not similarity:

- a) The respective uses of the respective goods or services;
- b) The respective users of the respective goods or services;
- c) The physical nature of the goods or acts of service;

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d) The respective 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 in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

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f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in the trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors”.

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Whilst I acknowledge that in view of the *CANON - MGM* judgement by the European Court of Justice ( C-39/97) the *TREAT* case may no longer be wholly relied upon, the ECJ said that the factors identified by the UK government in its submissions, which are the factors listed in *TREAT*, are still relevant.

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In utilising this approach and applying it to this case it is clear that the uses, users, physical nature and trade channels are all similar. Whilst it could be argued that the goods are likely to be found on different shelves, equally they could be said to compete as they would be in close proximity when sold in supermarkets or off-licences. Overall, it is my view that the goods are similar. I also note that a similar view was taken in the case of *Turney and Sons’ Trade Mark* RPC XI at page 44 line 25.

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Considering the two marks, *McCAIN* and *McBAIN*, they would, in my opinion, both be seen as surnames. I therefore note the comments of Buckley, J. in the *Buler* trade mark case [1966 RPC 141]:

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“It seems to me that surnames stand in a different position from the point of view of spelling from ordinary words in the English language, for spelling is a matter of considerable importance in distinguishing one surname from another. One may easily understand the meaning of an ordinary word in the English language, although it is misspelt; but if one finds a surname spelt in a way which one does not expect it to be spelt one is immediately put upon inquiry as to whether or not it is the name of some other

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person than the person to whom one supposes the name to belong.”

5 “I think that this aspect of the matter also involves some consideration of the phonetic aspect of the matter, for if the word as written would not appear prima facie to have the same sound as the name which it is said to be a misspelling of, then it seems to me more difficult to regard it as merely a misspelling of the name in question.”

10 Although these comments were made regarding a case under the 1938 Act I do believe that the views expressed are still valid under the 1994 Act.

15 Visually the words differ only by the third letter of each mark, the applicant’s being a B whereas the opponent’s mark has a C. Phonetically, the marks are similar, both beginning with the prefix “Mc” and end with “AIN”. But they differ in the beginning of the second syllable, B as opposed to the alliterative C.

20 Having weighed all of the factors set out above, it is my opinion that the degree of similarity between the respective marks and the respective is not sufficient to have created a likelihood of confusion at the material date of 9 August 1996.

25 The opposition having failed, the applicant is entitled to a contribution towards costs. I order the opponent to pay to the applicant the sum of £335. 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.

30 Dated this 23 Day of August 2000

35 George W Salthouse  
For the Registrar  
The Comptroller General