

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION No 2156553
BY LANCHESTER WINE CELLARS LIMITED
TO REGISTER A TRADE MARK IN CLASS 33
AND IN THE MATTER OF OPPOSITION THERETO
UNDER NUMBER 50389
BY HALEWOOD INTERNATIONAL LIMITED

BACKGROUND

1) On 27 January 1998, Lanchester Wine Cellars Limited of The Old Court House, Newbiggin Lane, Lanchester, County Durham, DH7 0NT applied under the Trade Marks Act 1994 for registration of the mark LAMBRUSSI in respect of “Wines, sparkling wines and perries” in Class 33.

2) On the 10 November 1999 Halewood International Limited of The Sovereign Winery, Roberttown Lane, Roberttown, Liversedge, WF15 7LL filed notice of opposition to the application. The grounds of opposition, are in summary:

- a) The opponent is the proprietor of four Trade Marks (detailed at annex A).
- b) The mark applied for offends against Sections 3(1)(b), (c) & (d) of the Trade Marks Act 1994.
- c) The mark applied for is similar to those registered by the opponent and therefore offends against Sections 3(b), 3(6), 5(2)(b), 5(4)(a),5(4)(b) and 56(2) of the Trade Marks Act 1994.

3) The applicant subsequently filed a counterstatement denying the opponent’s claims. Both sides ask for an award of costs.

4) Only the opponent filed evidence in these proceedings. Neither party wished to be heard in this matter. My decision will therefore be based on the pleadings and the evidence filed.

OPPONENT’S EVIDENCE

5) The opponent filed a declaration, dated 22 March 2000, by Harry Melling the Managing Director of the opponent company, a position he has held since 1983.

6) Mr Melling states that his company has been selling sparkling perries under the mark “Lambrini” throughout the UK continuously since 1994. He provides a list of towns and cities where the goods have been sold which shows nationwide coverage apart from North-West England and North Wales. He also provides figures for sales and promotion of the mark “Lambrini” in the UK as follows:

Year	Sales £	Promotion £
1994	760,000	-
1995	3,420,000	-

1996	10,240,000	-
1997	17,200,000	350,000
1998	21,200,000	1,100,000

7) Mr Melling states that the mark has been promoted by both press and television advertising. Examples of leaflets, brochures, and copies of advertisements are provided at exhibit 1. Only some of the items are dated. All of those which are dated are after the relevant date of 27 January 1998.

8) Mr Melling claims that the success of his company's product has led others to use marks beginning with "LAMB" in order to "ride on the success of the Lambrini trade mark".

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

DECISION

10) The opponent has pleaded a number of grounds which are not particularised and/ or not dealt with in the evidence filed. The applicant in forgoing an oral hearing could have supplied written submissions, but did not. In these circumstances I dismiss the grounds of opposition under Sections 3(1)(b), 3(1)(c), 3(1)(d), 3(b) and 3(6).

11) The opponent also claims that the trade mark LAMBRINI is entitled to protection under the Paris Convention as a well-known trade mark under Section 56 of the Trade Marks Act 1994. However, to come within this provision the opponent needs to establish that the mark is well known in the United Kingdom as being the mark of a person who is (a) 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. A Convention country is defined in section 55(1)(b) of the Trade Marks Act 1994 as a country that is party to the Paris Convention *other than the United Kingdom* (my emphasis). Therefore only trade marks which are owned by proprietors who are domiciled or have a base in a country signatory to the Paris Convention other than the United Kingdom can claim protection under this head. The opponent does not appear to fit into that category. Consequently the opponent cannot claim protection under this provision of the Act and this ground of opposition is also dismissed.

12) The next ground of opposition is under Section 5(2)(b) of the Act which states:-

*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 likelihood of association with the earlier trade mark."

13) An earlier right 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,
- (b)...
- (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

14) 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-Meyer Inc.* [1999] E.T.M.R. 1, *Lloyd Schfabrik 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 Schfabrik 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*

15) As is clear from the Annex to this decision the opponent is relying on a number of registrations either of the word LAMBRINI alone, or LAMBRINI others with devices. There is also a registration listed for LAMBRUCINI although no evidence is provided regarding use of this mark. In my view the opponent's strongest case is under registration 2104703 (Lambrini).

16) Registration is sought for "Wines, sparkling wines and perries" in Class 33. Clearly, in my view, the specification of the mark in suit is subsumed within the specification of the opponent's mark 2104703. The goods of the two parties are therefore, in my opinion, to be regarded as identical for the purposes of Section 5(2). It is clear from the above cases that in the overall assessment of a likelihood of confusion, the similarity of goods is but one aspect. Due regard should be given to the closeness of the respective marks, the reputation the earlier mark enjoys in respect of the goods or services for which it is registered, and any other relevant factors.

17) Both LAMBRINI and LAMBRUSSI are, it would seem, invented words. Visually they are of similar length and, self evidently, have the first four letters in common. They also consist of three syllables. The endings of the words are different but the presence of the concluding letter "I" will strike many people as suggestive of a foreign word as few English words end in the letter "I". Aurally the marks can be distinguished but the common first element and the terminal "I" are likely to leave an impression. Neither has any conceptual meaning, being invented words. But equally they would not be distinguished in the way that dictionary words with similar appearances but different meanings would be. The visual characteristics of the marks are, therefore, particularly important. I bear in mind also that, although wines are generally purchased with a modicum of care, due allowance must also be made for imperfect recollection.

18) With all of this in mind I come to the conclusion that when all factors are considered, that there was a realistic likelihood of confusion at 27 January 1998. Consequently, the opposition under Section 5(2)(b) succeeds.


19) As the above finding determines the matter I do not intend to consider the ground of opposition under Section 5(4)..

20) The opposition having been successful the opponent is entitled to a contribution towards costs. I order the applicant to pay the opponent the sum of £535. 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 09 day of October 2001

George W Salthouse
For the Registrar
The Comptroller General

ANNEX A

Mark	Number	Effective Date	Class	Specification
LAMBRINI	2104703	10.7.96	33	Wines, spirits, liqueurs and cocktails; fortified wines; cider, perry; low alcohol drinks containing more than 1.2% alcohol by volume; mixtures of all the aforesaid goods; preparations for making all the aforesaid goods.
LAMBRUCINI	2132652	12.5.97	33	Wines, spirits, liqueurs and cocktails; fortified wines; cider, perry; low and on-alcoholic drinks; mixtures of all the aforesaid goods; preparations for making all the aforesaid goods.
 <p>The logo for Lambrini Bianco is a rectangular label with a decorative, arched top. At the top center is a circular emblem containing a silhouette of a vineyard or estate. Below this, the word 'Lambrini' is written in a large, elegant, cursive script. Underneath 'Lambrini', the word 'BIANCO' is printed in a smaller, bold, sans-serif font. Below 'BIANCO', the text 'SLIGHTLY SPARKLING PERRY' is written in a very small font. At the bottom left of the label, '7.5%vol' is printed, and at the bottom right, '150cl e' is printed. At the very bottom of the label, in the smallest font, it reads 'HOLLYWOOD VINTNERS, L.A. REBBLITIONARY WINE & SPIRITS'.</p>	2147275	7.10.97	33	Perry

2147650

Refused

33

Perry

