

O-022-05

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2230081
IN THE NAME OF GUINNESS UNITED DISTILLERS & VINTNERS LIMITED
TO REGISTER A TRADE MARK IN CLASSES 3, 4, 6, 8, 9, 14, 15, 16, 18, 20, 21,24,
25, 28, 29, 30, 32,33, 34, 35, 39, 41 AND 42**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 52643 IN THE NAME OF
ALSTOM SA**

Trade Marks Act 1994

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in the name of Guinness United Distillers & Vintners Limited
to register a trade mark in Classes 3, 4, 6, 8, 9, 14, 15, 16, 18, 20, 21,24, 25, 28, 29, 30,
32, 33, 34, 35, 39, 41 and 42**

And

**IN THE MATTER OF Opposition thereto
under No. 52643 in the name of Alstom SA**

Background

1. On 19 April 2000, Guinness United Distillers and Vintners Limited applied to register a trade mark in Classes 3, 4, 6, 8, 9, 14, 15, 16, 18, 20, 21,24, 25, 28, 29, 30, 32,33, 34, 35, 39, 41 and 42. On 6 June 2001, Alstom SA filed notice of opposition to the application but subsequently limited this to Classes 4, 6, 8, 9, 16, 24, 35, 39, 41 & 42. The specifications for these classes are as follows:

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|-----------------|----------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| Class 04 | Industrial oils and greases; lubricants, candles, wicks. |
| Class 06 | Common metals and their alloys; ironmongery; small items of metal hardware; pipes and tubes of metal; goods of common metal not included in other classes; bronze wall plates; candle holders. |
| Class 08 | Hand tools and implements (hand operated); cutlery; side arms; razors. |
| Class 09 | Scientific, optical apparatus and instruments; apparatus for recording, transmission or reproduction of sound or images; magnetic data carriers; recording discs; data processing equipment and computers; CD's; cassettes; mouse pads; mobile phones. |
| Class 16 | Paper, cardboard and goods made from these materials, not included in other classes; printed matter; book binding material; stationery; artists materials; pens, calendars, prints, postcards, notebooks, bookends, recipe books, bookmarks, instructional and teaching material; phonecards, mail order catalogues. |
| Class 24 | Textile and textile goods, not included in other classes; bed and table covers; coasters; tablecloths, tea-towels, bar towels. |

- Class 35** Organisation and conducting of exhibitions for commercial or advertising purposes; publication of publicity texts; consulting and information services relating to the aforesaid services.
- Class 39** Arrangement, transportation and warehousing of mail order goods and goods provided by way of the Internet.
- Class 41** Exhibitions; recreational, entertainment and educational services; consultancy, training and information services relating to all the aforesaid services.
- Class 42** Bars, pubs, cocktail lounges, restaurants, cafes and catering services.

2. The mark applied for is as follows:



3. The opposition is based on the following grounds:

- 1. Under Section 5(2)(b)** because the opponents are the owners of an earlier device mark that is similar to the device element of the mark of the application, and is sought to be registered in respect of identical and/or similar goods and services to those of the opponents= earlier mark.

4. Details of the earlier mark relied upon can be found as an annex to this decision.

5. The applicants filed a counterstatement in which they deny the grounds on which the opposition is based.

6. Both sides ask that an award of costs be made in their favour.

7. Both sides filed evidence in these proceedings. The matter came to be heard on 19 October 2004, when the applicants were represented by Mr Paul Walsh of Bristows, their trade mark attorneys. The opponents were represented by Mr Peter Charlton of Elkington & Fife, their trade mark attorneys.

Opponents= evidence

8. This consists of a Witness Statement dated 1 October 2003 from Peter John Charlton. Mr Charlton refers to exhibit PJC1 which consists of a printout from the OHIM website giving details of CTM 948968, the earlier mark owned and relied upon by the opponents in these proceedings.

Applicants= evidence

9. This consists of a Witness Statement dated 1 March 2004 from Paul Carey, General Manager of Guinness Storehouse visitor centre. Mr Carey says that he is also responsible for the GUINNESS STOREHOUSE brand in the UK.

10. Mr Carey gives his assessment of the relative importance of the elements of which the applicants=mark is composed, ranking the word GUINNESS and STOREHOUSE first and second respectively, and the logo element as being of least importance. He goes on to say that the GUINNESS brand is one of the most famous in the UK, having been introduced in the late 18th century, and that the current annual UK sales of Guinness is approximately 2.5 to 2.7 million hectolitres, with a value of around , 208 million.

11. Mr Carey says that Guinness beer has been widely advertised in the UK for some 75 years, the first national advertisement appearing in 1929. He says that some of the advertising campaigns, examples of which he mentions, have achieved iconic status amongst advertising professionals. Mr Carey says that from 2001 to 2004 his company has spent in the region of , 40 million on advertising and promotion. He mentions his company=s sponsorship of various sporting events, and the merchandising of items such as clothing, technology, and traditional drinks-related products such as beer mats and glasses.

12. Mr Carey restates his view that Guinness is the element of the mark that is best known and will have the greatest impact. He goes on to say that STOREHOUSE is a famous building in Dublin, being the original manufacturing site of GUINNESS. Mr Carey says that in 2001 the site was refurbished and is a visitors centre that has attracted over 700,000 visitors for each of the years it has been open.

13. Mr Carey gives details of the origins of the mark applied for, saying that he has been told that the conceptual message of the logo is the circular nature of the journey visitors take when passing through the various rooms in the visitors centre. He also says that it was designed by abstracting a pint glass when seen from above shot over a blue gel. Mr Carey concludes his Statement by giving his views on the impressions created by the mark applied for and the opponents=earlier mark, and the likelihood of them being confused.

14. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

15. The opposition is founded on Section 5(2)(b) of the Act, which reads as follows:

A5.-(2) A trade mark shall not be registered if because **B**

- (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 of the Act as follows:

A6.- (1) In this Act an earlier trade mark @ means **B**

- (b) 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. In a consideration of a likelihood of confusion or deception I must 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] 45 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*;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*;
- (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*;
- (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*;

- (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*;
- (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*;
- (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*;
- (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*;
- (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*.

18. The applicants seek to register their mark in respect of a diverse range of goods and services, some of which are clearly identical to those covered by the opponents' earlier mark, and will share the same channels of trade from manufacture to consumer. The spectrum encompasses low-priced items that would be selected with the minimum of care and attention, and others, in particular in respect of the services, that would be a considered and deliberate purchase.

19. Turning to the question of the similarity or otherwise of the respective marks, If the mark applied for consisted solely of the device the consumer could only refer to it by describing the design, and as both depict swirls this would most likely mean that they would be described in a similar fashion, and insofar as they convey an idea, would send a similar message. Given that both devices are representations of swirls there is inevitably a degree of visual similarity. The opponents' version is somewhat jagged in comparison to the smoothness of the applicants' design, but this is a detail that I consider likely to be lost in the mists of the consumers later recollection.

20. I have no evidence that goes to the uniqueness or otherwise of designs of this type in the relevant trade. I am aware that swirl type devices are used to indicate rotary motion, such as in water and air, which would lend support to the view that such designs are not uncommon. If this is the case the consumer will be used to seeing them being used by different traders and would be unlikely to assume a connection in trade.

21. However, the applicants' mark is not just the device. It incorporates the words GUINNESS, a brand name that the opponents do not dispute is famous in the UK, and STOREHOUSE which is also claimed to be well known. At the hearing Mr Charlton argued that the words were irrelevant because the consumer will assume that they are the name of the company that produced the goods that they were used to seeing under the device, or would

assume that there is some sort of financial tie-up, collaboration or whatever.

22. The case law states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, but qualifies this by saying that the distinctiveness and dominance of the individual components should be taken into account. It therefore seems to me that the opponents' argument is based upon the premise that the device in the applicants' mark is both distinctive, and overwhelms the significance of the words to the extent that it is by reference to the device that the consumer will recognise and refer to the mark. This relies upon the proposition that even though it is generally accepted that in composite marks it is the words that speak, the inclusion of the words will be insufficient to indicate a different trade origin to the public, but also that the device will be picked out and through poor recollection confused with the opponents' mark.

23. I have no argument with the opponents' contention that their device is distinctive for the goods and services for which it is registered. I do not, however, have any evidence of any use having been made so cannot consider the mark to have become any more distinctive by virtue of such use. The applicants' evidence includes details of the origins of their device, and the message that it is intended to convey, but I would have to say that without this explanation I would not have been able to determine this from looking at the mark, nor, I suspect would the consumer. But whatever its inspiration, the device is distinctive, and if only based on its size and positioning in relation to the words is an important element of the mark as a whole. The question is whether the device is sufficiently dominant to negate the significance of the words. In my view it is not.

24. Mr Charlton referred me to a number of cases, the first being the *Bulova Accutron* trade mark case [1969] RPC 102, in which it was held that the addition of the house mark Bulova to the word Accutron did not serve to prevent the likelihood of there being deception. The key to the decision is that Bulova and Accutron do not hold together and it was considered that the consumer would take the combination as an indication that the manufacturer was using two separate marks in connection with his products.

25. Given the fame of GUINNESS it is possible that the consumer would see this as the house mark, but would they then go on to determine that STOREHOUSE is one subsidiary mark and the device another? The word STOREHOUSE is a distinctive mark in relation to the goods and services. Although it could be argued that by virtue of its positioning the device is more prominent, this is counterbalanced by the fact that in the perception of marks words are generally more influential than devices and I would say that STOREHOUSE has a significance at least on par with that of the device. But I see no good reason why the consumer would consider these elements to be separate marks, or would focus their attention on the device alone. As the case law states, unless there is a distinctive element that dominates a mark, the average consumer will normally perceive a mark as a whole and will not analyse its various details.

26. Mr Charlton also referred me to two cases determined by the OHIM Boards of Appeal. In *Interface, Inc v Zadi S.P.A.* Case R652/1999-1, the First Board of Appeal determined that an earlier mark consisting of a device with the word ZADI placed beneath was similar to an application for a mark consisting solely of a visually very similar device, and on the facts of

the case there was a likelihood of confusion. The Board placed weight on the small size and positioning of the word ZADI in relation to the device, and that being the name of the company it would give the graphic element a prominence as the company's logo or mark. This is not at odds with the *Bulova* case, but for the reasons I have given I do not believe that it can be said to be representative of the position in relation to the case in hand.

27. The second case referred to was *Mastercard International, Inc. v Regent Associates Limited* Case R264/2002-4. As with the *Zadi* case the consideration was whether a mark consisting of a device with words placed beneath was similar to that of an earlier mark consisting of a device alone. Finding the marks to be significantly similar the Board gave its reasons as follows:

A12 Due to near identity it can be said that the earlier sign is almost fully incorporated in the challenged CTM. However, the challenged CTM is composed not only of the interlocking circles but includes the words REGENT ASSOCIATES. It is commonplace in trade mark law that word elements are more likely to be memorised by the public because they can be named easily. Whereas imagery is more difficult to remember. As a rule it can therefore be said that word elements will be used as distinguishing tools. Thus, at face value, the element clearly distinguishes the signs from each other. Nevertheless, the device element in the challenged CTM is not just some decoration, but an eye-catching element of the sign as a whole. The interlocking circles of the challenged CTM are placed prominently in the centre of the sign and are relatively big as compared to the word element. The signs thus remain significantly similar.

28. This decision confirms the significance of words in composite marks. As with the earlier decision the Board placed weight on the relative size and positioning of the words in relation to the device, although did not make any mention of their significance in the name of the company. The earlier mark in this instance had a number of visually striking elements that had been repeated in the mark under attack, and in the Board's opinion, was a highly distinctive mark that had an enhanced reputation through the use that had been made of it. Whilst I have accepted the earlier mark in this instance to be distinctive, I do not consider that I could go so far as to say that it is any more than that, and as I have said, there is no evidence that it has ever been used, let alone on a scale to say that it enhanced any reputation.

29. Whilst there are similarities between the earlier trade mark and the mark applied for, taking all of the facts of this case into account and adopting the global approach advocated, I come to the view that the differences are such that it is unlikely that a consumer would form an association between the mark applied for and the opponent's earlier mark, but should they do so, will not be led into believing that the respective goods or services come from the same or economically linked undertakings. In my view there is no likelihood of confusion and the ground under Section 5(2)(b) fails accordingly.

30. The opposition having failed, I order the opponents to pay the applicants the sum of , 2,000 contribution towards their costs. 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 21st day of January 2005

**Mike Foley
for the Registrar
the Comptroller-General**

The Annex is not attached.