O-310-06

TRADE MARKS ACT 1994

IN THE MATTER OF AN APPLICATION UNDER NO. 2292232
BY WILLIAM GRANT & SONS LTD

AND

AN OPPOSITION THERETO UNDER NO. 91802
BY MAST-JÄGERMEISTER AG

IN THE MATTER OF an application under No.2292232 by William Grant & Sons Ltd and an opposition thereto under No. 91802 by Mast-Jägermeister AG

Background

1. Application No. 2292232 was applied for on 8 February 2002 and stands in the name of William Grant & Sons Ltd. The application seeks registration of the following mark:

in respect of: *scotch whisky* in class 33.

2. On 3 July 2003, notice of opposition was filed on behalf of Mast-Jägermeister AG. The grounds of opposition are, in summary:

- Under section 5(2)(b) based on the opponent's Community trade mark No. 337337 and UK trade mark No. 2020114.

- Under section 5(4)(a) by virtue of the law of passing off based on the opponent's trade marks.

3. The applicant filed a counter-statement essentially denying each of the grounds of opposition.

4. Both parties request an award of costs. Neither party requested to be heard but both filed evidence and written submissions.

Opponent's evidence

5. This takes the form of a statutory declaration dated 4 May 2004 by Dietmar Franke. Mr Franke states that he is the Regional Director for International Business for the opponent company, a position he has held since 1993. Mr Franke is a German citizen, says he is familiar with the English language and he is authorised to make the statutory declaration on behalf of his company. The information he provides is said to come either from his own knowledge or from his company's records.

6. Mr Franke states that his company first started using a stag's head device in relation to alcoholic spirits in about 1935 and has used such a device continuously since then on spirits in the nature of herb liqueurs. He goes on to say that his company first sold spirits in the UK under the stag's head device in 1978.

7. At exhibit J1, Mr Franke gives details of what he says are his company's sales and budget figures for the UK. He explains that "sales" refer to the number of 70cl bottles sold and "budget" refers to advertising and promotional costs. The figures are as follows.

Year	Sales	Budget (Euros)		Year	Sales	Budget (Euros)
1978	2094	0		1990	4500	14,464,83
1979	0	0		1991	3240	3,984,67
1980	0	0		1992	9193	113,448,12
1981	0	27,184,13		1993	16839	114,310,83
1982	0	0		1994	22864	139,411,04
1983	1189	0		1995	27724	174,486,87
1984	1135	0		1996	30404	178,594,51
1985	1302	0		1997	32061	189,761,05
1986	547	0		1998	33501	189,140,55
1987	0	0		1999	29517	203,789,66
1988	4915	44,386,64		2000	17091	161,340,30
1989	3824	56,965,06		2001	30994	141,041,70

8. He also provides figures for 2002 but I cannot be sure how much of this relates to a period before the relevant date in these proceedings.

9. Mr Franke gives brief details of the consecutive agreements entered into by his company with a number of distributors in the UK. Mr Franke also provides a number of other exhibits:

J2, J3 and J4: Material produced by distributors
J5: An extract from "Drinks International" magazine Feb 2000
J6: An undated catalogue produced by current distributor
J7: A 2003 catalogue produced by current distributor
J8: Promotional materials
J9: A list of customers and stockists throughout UK dating from 1995/96
J10: An extract from "Impact" magazine February 2000
J11: An extract from "Impact" magazine February 2001
J12: An extract from "Impact" magazine February 2002

Exhibits J13 and J14 are similar extracts from "Impact" magazine both dated after the relevant date.

Applicant's evidence

10. This consists of two witness statements, the first by George Daniel Tait and dated 15 June 2005. Mr Tait is the Company Secretary of the applicant company, a position he has held since 1996. He confirms he is authorised to make the statement on behalf of the applicant and that the facts come from his own knowledge or his company's records.

11. Mr Tait says that his company first adopted the stag's head device as a trade mark in the UK in respect of whisky in approximately 1974. Mr Tait says that his company or its predecessors have continuously used a stag device since 1974 on their Glenfiddich label. At exhibit 1 he attaches details of a UK trade mark owned by his company's predecessors dating to 27 June 1974 which shows the device of a stag's head on a Glenfiddich label. He goes on to say that in about 1984 the Glenfiddich label was changed to give the stag device greater prominence. He attaches a copy of the amended trade mark at exhibit 2. At exhibit 3 he attaches a copy of the current label.

12. Mr Tait states that the applicant's Glenfiddich single malt whisky is extremely well known and that during the last 40 years it has either been the first or second best selling single malt in the UK, enjoying on average a 24.5% share of the total UK Malt whisky market for the years between 1985 and 2002 inclusive.

13. The UK volume and sales value of Glenfiddich malt whisky is given as follows:

Year	Volume (litres)	Value (£)
1998	614,592	17,243,000
1999	561,330	17,172,000
2000	610,000	17,083,000
2001	588,800	17,478,000

14. Figures are also given for 2002 but again I cannot be sure how much relates to a period before the relevant date. Whilst he does not provide details of advertising and promotional spend, Mr Tait does say that substantial amounts are expended each year.

15. Mr Tait says that Glenfiddich whisky is available in every major supermarket chain in the UK as well as all major off licenses and the majority of pubs, clubs and other licensed premises.

16. There is also a witness statement of Brian Herbert March dated 20 June 2005. Mr March says he is senior partner in the firm of Wildbore & Gibbons, the applicant's trade mark attorneys.

17. At exhibit 1 Mr March introduces a copy of the results of a search of the UK trade marks register commissioned by his firm in May 2005. The firm also commissioned a report which is a limited survey of marks consisting of or containing devices of

animals with antlers, in use in the UK in respect of alcoholic drinks and this is exhibited at exhibit 2.

18. No further evidence was filed by either party.

Decision

19. Section 5(2)(b) of the Act states:

> "5.- (1) ……
>
> (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."

20. The term "earlier trade mark" is defined in section 6 of the Act as follows:

> "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,"

21. Each of the opponent's registrations relied on are earlier trade marks within the definition of Section 6 of the Act.

22. In determining the question under Section 5(2), I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel v Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *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,* paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG,* paragraph 23, 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 he has

kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B. V.* 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*, paragraph 23;

(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*, paragraph 23;

(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 v Metro-Goldwyn-Mayer Inc*, 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*, paragraph 24;

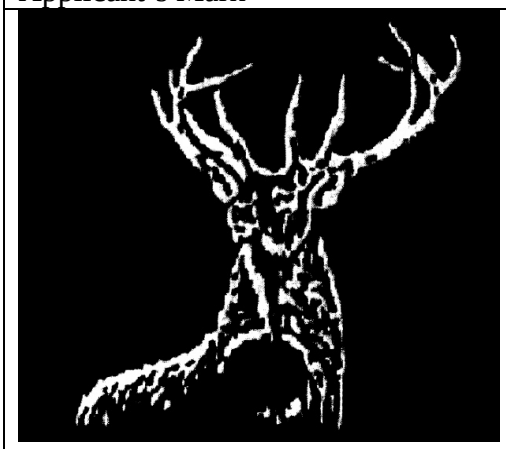
(g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*, paragraph 26;

(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*, 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-Mayer Inc*, paragraph 29.

23. The goods for which the applicant seeks registration are “Scotch whisky”. The opponent’s earlier Community trade mark No. 337337 is registered for a variety of goods including spirits. The opponent’s other earlier trade mark covers herb liqueurs. These are also spirits. Whisky being a spirit, identical goods are involved. I therefore turn to a comparison of the marks.

24. For ease of reference I set out the respective marks below:

Applicant's Mark	Opponent's Marks
	 CTM 337337
	 2020114

25. The mark applied for consists of the body and head of an antlered deer in a naturalistic form and viewed from the side, with the animal's head twisted to its right. The animal appears against a dark background. Both of the opponent's earlier marks also contain what I take to be a device of a deer.

26. In the opponent's earlier Community trade mark the animal is presented in a less naturalistic form and only the animal's head and neck appears, viewed face on. The animal device is contained within a circular border. Between the antlers of the deer and extending the full height of them, is a relatively large cross device surrounded by what appears to me to be a sunburst pattern.

27. The opponent's earlier UK trade mark is an oblong shape which is said to be a label. In its upper portion is also contained an antlered deer's head and neck presented face on. Unlike the opponent's earlier Community trade mark, the device of a deer is in naturalistic form. Again, between the antlers, there is a cross device and sunburst pattern, the whole contained within a circular border. What appear to me to be leaves extend out from the lower part of the circle under the deer's head. The lower portion

of the oblong shaped label contains details of the source and alcoholic content of the product itself. Between the two portions is a wide dark stripe underneath which is a somewhat castellated line border.

28. The opponent has filed evidence of use. The evidence shows the opponent to have been selling its goods in the UK for some time and allows me to say the opponent has a reputation in the UK. What the evidence does not allow me to do is to say there is a reputation in any trade mark(s) the opponent may use nor to apportion the reputation the opponent has to either of the trade marks it relies on in these proceedings.

29. The report forming exhibit 2 to Mr March's evidence, is a report commissioned from a firm of investigators. The report indicates that a number of whiskies are for sale which include representations of deer on their labels. Whilst the report is dated 10 June 2005, and therefore after the relevant date in these proceedings, it supports my own long standing knowledge that devices of stags are not uncommonly used in relation to scotch whiskies and spirits. In my opinion, a device of a stag's head has a relatively low level of distinctiveness in relation to scotch whiskies and spirits.

30. Visually and aurally, there are some similarities between the respective marks in that each consists of or contains a device of a deer. The representations of each of the respective deer differ as set out above. And whereas the applicant's trade mark consists solely of the representation of a deer, the opponent's earlier marks contain other distinctive elements. Whilst each of the respective marks may be described as "deer" marks, the presence of other elements within each of the earlier marks, including but not limited to the name of the producer and bottler in the case of the opponent's earlier UK registration and the cross device and sunburst pattern in both earlier marks, would not, in my opinion, be overlooked. I consider that the differences between each of the respective marks outweigh the visual and aural similarities even taking into account that the average consumer rarely has the opportunity to compare marks side by side but has to rely on the imperfect picture he has of them.

31. Conceptually, the applicant's mark is a naturalistic representation of a stag. Whilst each of the trade marks relied on by the opponent contain the device of a deer, the style and presentation of the deer differ and the inclusion in each of the earlier marks of other distinctive and, in the context of alcoholic drinks, somewhat unusual elements would not, I believe, be overlooked by the average consumer and take the representations away from the naturalistic.

32. I bear in mind that the goods are alcoholic drinks and therefore the average consumer is an adult who purchases alcohol either for their own or for others' consumption. Purchasers are likely to bring varying degrees of knowledge and attention to their purchase of the goods but given the nature of the goods they are likely to be bought with some care, with attention being paid variously to e.g. the specific variety, age, proof, blend, source, price etc. of the product.

33. Taking all matters into account, I consider there to be no likelihood of confusion. The opposition under the grounds of section 5(2)(b) fails.

34. In view of my decision under section 5(2) and my comments on the evidence filed, I do not intend to consider the ground of opposition under section 5(4)(a).

Costs

35. The applicant having succeeded is entitled to an award of costs. I take into account the fact that no hearing took place. I order the opponent to pay the applicant the sum of £1400 as a contribution towards its costs. This sum is 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 31st day of October 2006

Ann Corbett
For the Registrar
The Comptroller-General