

O-257-10

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION 2452023
BY TESCO STORES LIMITED
TO REGISTER IN CLASS 32 THE TRADE MARK:

BOHEME 1795

AND

IN THE MATTER OF OPPOSITION 95998 BY
BUDEJOVICKY MESTANSKY PIVOVAR A.S.

TRADE MARKS ACT 1994

**In the matter of application 2452023 by Tesco Stores Limited
to register in class 32 the trade mark: BOHEME 1795**

and

in the matter of opposition 95998 by Budejovicky Mestansky Pivovar a.s.

The background and the pleadings

1) On 10 April 2007 Tesco Stores Limited (“Tesco”) applied to register the trade mark BOHEME 1795 in class 32 of the Nice classification system¹. Registration is sought in respect of:

Beer, ale, stout and lager.

2) On 29 January 2008 Budejovicky Mestansky Pivovar a.s. (“Bud”) opposed the registration of Tesco’s trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Bud relies on a single trade mark of which it is the proprietor, namely Community Trade Mark (“CTM”) 4075107 which is also registered in class 32, but in respect of “beers including non-alcoholic beers”. The CTM was filed on 14 October 2004 (so making it an earlier mark under the provisions of section 6 of the Act) and it completed its registration procedure on 16 January 2006. The earlier mark is depicted below:



¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

3) Bud claims that the distinctive element of both trade marks is the numeral 1795 (I will return to why this is claimed later). It also claims that all of the goods sought by Tesco are identical to the goods covered by its earlier mark. Bud believes that all this will lead to a likelihood of confusion. I also note that as the earlier mark had not completed its registration procedure before the period of five years ending with the date of publication of Tesco's mark², the proof of use provisions contained in section 6A³ of the Act do not apply. Therefore, the earlier trade mark can be taken into account in these proceedings for its specification as registered.

4) Tesco filed a counterstatement denying the grounds of opposition. It denies that there is a likelihood of confusion. Tesco contends that the earlier mark is a complex mark which does not give rights in its individual components that are, it claims, separately non-distinctive. Tesco says that numerals are not distinctive *per se* as they are used in trade to indicate when the brewery etc. that produces the goods was established.

5) Both sides filed evidence. The matter then came to be heard before me on 25 June 2010. At the hearing Mr John Groom of Groom Wilkes & Wright LLP represented Tesco whereas Mr Michael Lynd of Marks & Clerk represented Bud.

The evidence

6) Two people gave written evidence on behalf of Bud: i) Mr Lynd (Bud's representative in these proceedings) and ii) Mr Daniel Drevikovsky (Bud's General Manager). Both Mr Lynd and Mr Drevikovsky gave evidence relating to the history of Bud, its brewery and its predecessors in title. It is sufficient to record, and it is an undisputed fact, that its history dates back to the year 1795 when the town council of Ceske Budejovice (Budweis) returned to its citizens the municipal brewery formally belonging to Matej Konvicka.

7) Both Mr Lynd and Mr Drevikovsky also gave evidence relating to an agreement between Bud and Tesco whereby Bud produce the beer that Tesco sell under the mark the subject of these proceedings. A framework agreement, dated 18 June 2007, is exhibited to Mr Drevikovsky's witness statement. It is a short agreement, the operative part of which reads:

"It is Tesco Stores Limited's (further Tesco) intention to progress to launch the Tesco Lager Brand with BUDEJOVICKY MESTANSKY PIVOVAR a.s (further BMP) whereby BMP would supply beer to Tesco for resale under the branding selected by Tesco (except for branding with the words

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Budweiser or Budweis) and in the quantities and for the prices set forth below.”

8) Both witnesses also refer to the modifying of Bud’s “1795” label for Tesco to sell the beer in the UK. Mr Lynd suggests that this means that Tesco are, in effect, using its 1795 label under licence from Bud. He also states that this means that Bud cannot be taken to have consented to Tesco’s use/registration. Details of the modified label are exhibited to Mr Drevikovsky’s witness statement – the labels consist predominantly of the word/numeral BOHEME 1795. Details of Bud’s sales to Tesco under the agreement are also provided. I do not need to set them out in detail, but it is fair to say that the numbers involved appear reasonably significant.

9) In addition to the above, Mr Lynd also gave evidence as to the meaning/distinctiveness of the word BOHEME (as contained in Tesco’s mark) and also the distinctiveness of the numeral 1795. I will come back to this evidence later. Mr Drevikovsky also gave evidence as to Bud’s sales in the UK of beer under its 1795 label, again, I will come back to this.

10) In terms of Tesco’s evidence, this comes from Mr Groom, its representative in these proceedings. His evidence relates predominantly to the word BOHEME and, as with Mr Lynd’s evidence in relation to this, I will come back to this.

Section 5(2)(b) of the Act

11) This section reads:

“5.-(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.”

12) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

13) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as

assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

14) Given the nature of the respective marks under comparison and the nature of the arguments that have been made in the claims and counterclaims, it is useful to set out some of the guidance that has come from the ECJ in relation to the likelihood of confusion where complex or composite marks are involved. I particularly note the judgment in *Medion v Thomson Multimedia* [2006] ETMR 13 where it was stated:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

15) Also, the judgment in *OHIM v Shaker di L Laudato & Co Sas* (C-334/05 P, 12 June 2007) where it was stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element”

16) There is no dispute that the goods in the respective specifications are identical. Bud’s earlier mark covers beer in general which, Mr Groom helpfully conceded, is a general term that would cover the different types of drinks (beer, ale, stout and lager) covered by Tesco’s application.

17) Given that the goods are identical, the average consumer must also be identical. The goods are purchased by the general public, albeit those of drinking age. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change (or at least the degree of attention that the average consumer displays during the purchasing act) depending on the particular goods in issue (see, for example, the decision of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The goods here are not the most expensive of products, nor are they infrequent purchases. However, they are still likely to be purchased with at least a reasonable degree of care and attention given that taste, and to some extent brand loyalty, is likely to play a part in the selection process. There is, therefore, no significant increase or decrease from the norm in respect of the degree of care and attention likely to be deployed by the average consumer when purchasing the goods.

18) That leads to the comparison of the marks. The comparison must be made in relation to the totalities of the respective marks, but bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). In view of this, and before making any form of comparison, I should make an assessment of what constitutes the dominant and distinctive elements of the respective marks.

19) Bud's mark is shown below:



20) I believe it clear and obvious to anyone viewing the above mark that the most dominant element is the numeral 1795. It dwarfs the other elements quite considerably. Tesco claims that numerals are either non-distinctive or very low in distinctiveness and, therefore, in the context of Bud's mark, the distinctiveness will lie in its composite nature. There is, though, no evidence that numerals are non-distinctive. The only evidence is from Bud who observes that the Intellectual Property Office's work manual suggests that such numerals are registrable *prima facie*⁴ and that a number of numeral consisting trade marks have been duly registered by different undertakings⁵.

21) Whilst the numeral in Bud's mark may be perceived by the average consumer as a date, and whilst the average consumer may understand it as having some form of significance to the history of the business providing the goods, I see no reason why the average consumer will not also see it as

⁴ The relevant extract reads: "Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers, e.g. 1560, 8787 and not round numbers e.g. 1000, 2400 – which are commonly used in trade as mere model or product numbers for goods. Even round numbers may be distinctive for services and goods not usually sold under a model or product number such as foods and drink. Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character"

⁵ For example: 1828, 1936, 1664, 1832, 1770, 1698, 1727, 1761, 1608 & 1727.

performing a distinctive trade mark role. The significance of dates on/in labels or trade marks, and whether they perform a distinctive trade mark role, will very much depend on the context of use. For example, a recent(ish) date on a wine label may be perceived merely as a vintage indication. Similarly, if in a complex/composite mark there was an indication along the lines of “brewed since xxxx” or “Established in xxxx” then the date represented by the xxxx would likely have little trade mark significance. In the case before me, whilst the average consumer may still believe that the date has significance regarding the manufacturer of the goods, the dominance given to the element and its self-standing (within the mark) form of presentation combine so that it will be taken as a trade origin indicating element. Whilst there are, of course, other elements in the mark to bear in mind, the overall impression of the mark means that **the numeral 1795 is not only a dominant and distinctive element of the mark, it is the dominant and distinctive element.**

22) I also note that in Mr Drevikovsky’s evidence he exhibited an extract from the website of the Beer Club of Great Britain where Bud’s product, including a picture of it showing the label, is offered for sale. It is clear from this that the beer is sold by reference to the brand 1795. Whilst this is not what has led me to the above finding because the method of selling/marketing is chosen by the manufacturer/marketer and it may not represent the perception of the average consumer, it at least supports my view that the 1795 element is more than capable of performing an independent and distinctive role within the mark as a whole.

23) Tesco’s mark consists of the word/numeral BOHEME 1795. The first element, the word BOHEME, is subject to evidence from both sides. For Bud, Mr Lynd’s evidence is that the word Boheme is a French word meaning Bohemia⁶. His evidence is also that the province of Bohemia (as well as its principal towns of Pilsen and Budweis) is well known for its brewing industry. Extracts from the Encyclopedia Britannica (11th edition published in 1911) are provided in an attempt to illustrate this. One such extract, in relation to Bohemia, reads:

“Sugar refining is another industry, which, although of recent date, had had a very great development, and the breweries produce a beer which is appreciated all over the world”

24) To further support his assertions, Mr Lynd also provides in evidence (at Exhibit MAL8) details of trade mark registrations which include the prefix “BOHEM-“, most of which cover beer. They include marks containing the words “BOHEMIA”, “bohemia regent”, “BOHEMIA OBSCURA” (and device), a label mark containing the word “BOHEMIA” at the bottom, a stylised mark containing

⁶ The extracts are from Le Grande Dictionnaire Hachette-Oxford. Mr Lynd notes that the second definition for “Bohême” is “Bohemia” and the only definition for “Bohême” is “Bohemia”. I note that the first definition for Bohême is “Bohemian”.

the words “A bohemia lazne karlovy vary”, and a mark containing the words “OLD BOHEMIA”. He also highlights that Tesco, on the rear of its BOHEME 1795 label, uses the words “a true Bohemian Classic”.

25) Mr Groom’s evidence, on the other hand, is that the word BOHEME will have other connotations to an English speaking person than that asserted by Bud. He provides the first 20 pages of a Google report for “Boheme” (this is a world-wide search not limited to UK based websites) none of which, he says, relate to the region in the Czech Republic. Having examined the report I note that some relate to the opera “La Boheme”, with most of the others relating to the names of cafes, restaurants, hotels or other goods and services. Mr Groom also conducted searches in various reference works (Exhibits JAG2-8). In relation to “Boheme” the word either had no entry or the reference work pointed to related references for entries such as La Boheme, the opera. In relation to “Bohemia” the reference works relate, in the main, to a historical region in Central Europe.

26) Whether or not a word in a trade mark has a meaning can only be relevant to the extent that such a meaning is known by the average consumer. I should approach this assessment with caution as it would be wrong to accept to readily the degree of knowledge that the average consumer may possess⁷. Mr Lynd’s evidence is that Boheme is French for Bohemia and that Bohemia will indicate, effectively, the geographical origin of the goods. In my view, it would be wrong to assume that the average consumer in the UK would know that Boheme is French for Bohemia. Whilst some French words will be known by the average consumer, I would not count Boheme amongst them.

27) The average consumer could, though, still make a link to geographical origin if the word Boheme points that way. However, I am far from convinced that this is so. Whilst the Google report provided by Mr Groom is for world-wide hits rather than the UK, it nevertheless suggests that if the word is to be perceived by the average consumer as one with a meaning, such meaning will not relate to geographical origin in Bohemia. On the evidence before me, I believe that the average consumer will either see the word simply as an invented word or, alternatively, that it will remind them of the opera by Puccini. Whichever meaning is taken, this works against Bud’s claim that Boheme has geographical significance. I have not ignored the evidence relating to the use of BOHEM-marks on the register or the use by Tesco of the words “a true Bohemian Classic” on the back of its label. In relation to the former argument, none of the marks actually contain the word BOHEME as such and, furthermore, the mere presence of such marks on the register tells me little as to what is going on in the marketplace and what, if any, consequent impact this will have had on the average consumer. In relation to the latter argument, such use by Tesco cannot be taken to have informed the notional average consumer that the word Boheme has meaning.

⁷ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08.

28) The second element in Tesco's mark is the numeral 1795. I have already discussed the distinctiveness of such an element when considering Bud's earlier mark. A lot depends on the context of use and the consequent impact on the average consumer. It is certainly not an element that can be said, *per se*, to lack distinctiveness. In the context of the mark BOHEME 1795, the two elements do not blend to create a meaningful whole. The elements will strike the average consumer as two separate elements presented in one overall trade mark. I do not consider that 1795 will be taken merely as a non-distinctive date. Whilst it may be perceived as a date and whilst it may be assumed that the date has some meaning to the undertaking responsible for the goods, it will, effectively, play a dual role as it will also be seen as a trade origin indicating element given the way it is presented as a key part of the whole trade mark. Whilst the word BOHEME may be regarded as being the slightly more dominant and distinctive element because it has (as an invented word or as a reference to Puccini's opera) no suggestive qualities to the goods and also because of its presence at the beginning of the mark, the numeral 1795 still plays a dominant and distinctive role within the mark as a whole. **Both the element BOHEME and the element 1795 constitute dominant and distinctive elements – BOHEME being slightly more dominant and distinctive than 1795.**

29) In terms of the comparison between the respective marks, the same issues relate to the visual, aural and conceptual comparisons, namely, that the numeral 1795 is present in both marks. This, at the least, and bearing in mind the respective dominance and distinctiveness of this element in the respective marks, creates a degree of visual, aural and conceptual similarity. The difference though, the presence of the word BOHEME in Tesco's mark and the other elements in Bud's mark, means that any similarity overall cannot be placed at the higher end of the spectrum. I consider there to be a moderate degree of similarity overall.

30) An additional factor that needs to be assessed when determining whether there is a likelihood of confusion is the distinctiveness of the earlier mark. This is because the more distinctive it is (based either on inherent qualities or because of the use made of it) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Whilst I agree with Mr Groom's submission that the 1795 element (which I have found to be the dominant and distinctive element of the earlier mark) does not imbue a high degree of distinctiveness, I see no need to place it at the lower end of the spectrum. I consider that the average consumer would regard the element, and, consequently, the trade mark as a whole, as a mark of a reasonable degree of distinctiveness.

31) I must also consider the use made by Bud of its mark. Mr Drevikovsky's evidence gives some details of its use such as invoices (from June 2007) to the Beer Club of Great Britain (an extract from this company's website selling Bud's goods is also provided) and, also, an international way-bill to a consignee in Preston called The Warehouse Wine Company. However, the overall scale and

quantum of its sales in the UK are not apparent from the evidence. Neither is there any evidence highlighting any promotional or advertising activities. Whilst the goods have clearly been sold under the trade mark, its use as set out in the evidence cannot be found to have enhanced its distinctive character.

32) The various factors that I have assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17). A global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33) The goods are identical and the earlier mark has a reasonable degree of distinctive character. I must also take into account the concept of imperfect recollection. I bear in mind, of course, the whole mark comparison. I also bear in mind the dominant and distinctive elements as assessed earlier. The question, though, really boils down to whether the average consumer will, due to the common presence of 1795 in both marks, be led to believe that the goods sold under the respective marks are the responsibility of the same or an economically linked undertaking.

34) Tesco's mark has as a dominant and distinctive element the numeral 1795. Whilst it may not be the most dominant and distinctive element in the mark, this does not rule out a likelihood of confusion (see the *Medion* case). The Boheme element is, in any event, only slightly more dominant than 1795. I also consider the 1795 element to have a normal degree of distinctiveness such that the average consumer, when appreciating the overall impression of the mark, will regard it as playing an independent and distinctive role. Whilst Bud's mark includes other words and insignia on its label, it is dominated to a significant extent by the numeral 1795 and this is the only real element the average consumer will latch on to when recalling that mark. That is not to say that I have ignored those other elements as they are far from negligible, but 1795 is far and away the most important aspect of the mark. This is so despite Mr Groom's submission that numerals are not particularly memorable. Taking all of this into account, I believe that the average consumer will believe that the goods are the responsibility of the same or an economically linked undertaking. The similarity in terms of the common inclusion of the 1795 element will be put down to economic connection rather than co-incidence. **There is a likelihood of confusion.**

35) In reaching my conclusions I have said little about the manufacturing agreement between Bud and Tesco. This is because the test, as the case-law indicates, must be assessed from the viewpoint of the average consumer. The average consumer will be unaware of the agreement so it is difficult to see what this brings to the table. In any event, Bud was the only party to refer to this in its evidence and I have, anyway, found in its favour.

36) The opposition under section 5(2)(b) of the Act succeeds.

Costs

37) Bud has been successful and is entitled to a contribution towards its costs. I hereby order Tesco Stores Limited to pay Budejovicky Mestansky Pivovar a.s. the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering Tesco's evidence
£500

Attending the hearing
£400

38) The above sum should 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 22 day of July 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

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(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.”

12) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

13) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as

assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

14) Given the nature of the respective marks under comparison and the nature of the arguments that have been made in the claims and counterclaims, it is useful to set out some of the guidance that has come from the ECJ in relation to the likelihood of confusion where complex or composite marks are involved. I particularly note the judgment in *Medion v Thomson Multimedia* [2006] ETMR 13 where it was stated:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

15) Also, the judgment in *OHIM v Shaker di L Laudato & Co Sas* (C-334/05 P, 12 June 2007) where it was stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element”

16) There is no dispute that the goods in the respective specifications are identical. Bud's earlier mark covers beer in general which, Mr Groom helpfully conceded, is a general term that would cover the different types of drinks (beer, ale, stout and lager) covered by Tesco's application.

17) Given that the goods are identical, the average consumer must also be identical. The goods are purchased by the general public, albeit those of drinking age. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change (or at least the degree of attention that the average consumer displays during the purchasing act) depending on the particular goods in issue (see, for example, the decision of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The goods here are not the most expensive of products, nor are they infrequent purchases. However, they are still likely to be purchased with at least a reasonable degree of care and attention given that taste, and to some extent brand loyalty, is likely to play a part in the selection process. There is, therefore, no significant increase or decrease from the norm in respect of the degree of care and attention likely to be deployed by the average consumer when purchasing the goods.

18) That leads to the comparison of the marks. The comparison must be made in relation to the totalities of the respective marks, but bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). In view of this, and before making any form of comparison, I should make an assessment of what constitutes the dominant and distinctive elements of the respective marks.

19) Bud's mark is shown below:



20) I believe it clear and obvious to anyone viewing the above mark that the most dominant element is the numeral 1795. It dwarfs the other elements quite considerably. Tesco claims that numerals are either non-distinctive or very low in distinctiveness and, therefore, in the context of Bud's mark, the distinctiveness will lie in its composite nature. There is, though, no evidence that numerals are non-distinctive. The only evidence is from Bud who observes that the Intellectual Property Office's work manual suggests that such numerals are registrable *prima facie*⁴ and that a number of numeral consisting trade marks have been duly registered by different undertakings⁵.

21) Whilst the numeral in Bud's mark may be perceived by the average consumer as a date, and whilst the average consumer may understand it as having some form of significance to the history of the business providing the goods, I see no reason why the average consumer will not also see it as

⁴ The relevant extract reads: "Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers, e.g. 1560, 8787 and not round numbers e.g. 1000, 2400 – which are commonly used in trade as mere model or product numbers for goods. Even round numbers may be distinctive for services and goods not usually sold under a model or product number such as foods and drink. Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character"

⁵ For example: 1828, 1936, 1664, 1832, 1770, 1698, 1727, 1761, 1608 & 1727.

performing a distinctive trade mark role. The significance of dates on/in labels or trade marks, and whether they perform a distinctive trade mark role, will very much depend on the context of use. For example, a recent(ish) date on a wine label may be perceived merely as a vintage indication. Similarly, if in a complex/composite mark there was an indication along the lines of “brewed since xxxx” or “Established in xxxx” then the date represented by the xxxx would likely have little trade mark significance. In the case before me, whilst the average consumer may still believe that the date has significance regarding the manufacturer of the goods, the dominance given to the element and its self-standing (within the mark) form of presentation combine so that it will be taken as a trade origin indicating element. Whilst there are, of course, other elements in the mark to bear in mind, the overall impression of the mark means that **the numeral 1795 is not only a dominant and distinctive element of the mark, it is the dominant and distinctive element.**

22) I also note that in Mr Drevikovsky’s evidence he exhibited an extract from the website of the Beer Club of Great Britain where Bud’s product, including a picture of it showing the label, is offered for sale. It is clear from this that the beer is sold by reference to the brand 1795. Whilst this is not what has led me to the above finding because the method of selling/marketing is chosen by the manufacturer/marketer and it may not represent the perception of the average consumer, it at least supports my view that the 1795 element is more than capable of performing an independent and distinctive role within the mark as a whole.

23) Tesco’s mark consists of the word/numeral BOHEME 1795. The first element, the word BOHEME, is subject to evidence from both sides. For Bud, Mr Lynd’s evidence is that the word Boheme is a French word meaning Bohemia⁶. His evidence is also that the province of Bohemia (as well as its principal towns of Pilsen and Budweis) is well known for its brewing industry. Extracts from the Encyclopedia Britannica (11th edition published in 1911) are provided in an attempt to illustrate this. One such extract, in relation to Bohemia, reads:

“Sugar refining is another industry, which, although of recent date, had had a very great development, and the breweries produce a beer which is appreciated all over the world”

24) To further support his assertions, Mr Lynd also provides in evidence (at Exhibit MAL8) details of trade mark registrations which include the prefix “BOHEM-“, most of which cover beer. They include marks containing the words “BOHEMIA”, “bohemia regent”, “BOHEMIA OBSCURA” (and device), a label mark containing the word “BOHEMIA” at the bottom, a stylised mark containing

⁶ The extracts are from Le Grande Dictionnaire Hachette-Oxford. Mr Lynd notes that the second definition for “Bohême” is “Bohemia” and the only definition for “Bohême” is “Bohemia”. I note that the first definition for Bohême is “Bohemian”.

the words “A bohemia lazne karlovy vary”, and a mark containing the words “OLD BOHEMIA”. He also highlights that Tesco, on the rear of its BOHEME 1795 label, uses the words “a true Bohemian Classic”.

25) Mr Groom’s evidence, on the other hand, is that the word BOHEME will have other connotations to an English speaking person than that asserted by Bud. He provides the first 20 pages of a Google report for “Boheme” (this is a world-wide search not limited to UK based websites) none of which, he says, relate to the region in the Czech Republic. Having examined the report I note that some relate to the opera “La Boheme”, with most of the others relating to the names of cafes, restaurants, hotels or other goods and services. Mr Groom also conducted searches in various reference works (Exhibits JAG2-8). In relation to “Boheme” the word either had no entry or the reference work pointed to related references for entries such as La Boheme, the opera. In relation to “Bohemia” the reference works relate, in the main, to a historical region in Central Europe.

26) Whether or not a word in a trade mark has a meaning can only be relevant to the extent that such a meaning is known by the average consumer. I should approach this assessment with caution as it would be wrong to accept to readily the degree of knowledge that the average consumer may possess⁷. Mr Lynd’s evidence is that Boheme is French for Bohemia and that Bohemia will indicate, effectively, the geographical origin of the goods. In my view, it would be wrong to assume that the average consumer in the UK would know that Boheme is French for Bohemia. Whilst some French words will be known by the average consumer, I would not count Boheme amongst them.

27) The average consumer could, though, still make a link to geographical origin if the word Boheme points that way. However, I am far from convinced that this is so. Whilst the Google report provided by Mr Groom is for world-wide hits rather than the UK, it nevertheless suggests that if the word is to be perceived by the average consumer as one with a meaning, such meaning will not relate to geographical origin in Bohemia. On the evidence before me, I believe that the average consumer will either see the word simply as an invented word or, alternatively, that it will remind them of the opera by Puccini. Whichever meaning is taken, this works against Bud’s claim that Boheme has geographical significance. I have not ignored the evidence relating to the use of BOHEM-marks on the register or the use by Tesco of the words “a true Bohemian Classic” on the back of its label. In relation to the former argument, none of the marks actually contain the word BOHEME as such and, furthermore, the mere presence of such marks on the register tells me little as to what is going on in the marketplace and what, if any, consequent impact this will have had on the average consumer. In relation to the latter argument, such use by Tesco cannot be taken to have informed the notional average consumer that the word Boheme has meaning.

⁷ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08.

28) The second element in Tesco's mark is the numeral 1795. I have already discussed the distinctiveness of such an element when considering Bud's earlier mark. A lot depends on the context of use and the consequent impact on the average consumer. It is certainly not an element that can be said, *per se*, to lack distinctiveness. In the context of the mark BOHEME 1795, the two elements do not blend to create a meaningful whole. The elements will strike the average consumer as two separate elements presented in one overall trade mark. I do not consider that 1795 will be taken merely as a non-distinctive date. Whilst it may be perceived as a date and whilst it may be assumed that the date has some meaning to the undertaking responsible for the goods, it will, effectively, play a dual role as it will also be seen as a trade origin indicating element given the way it is presented as a key part of the whole trade mark. Whilst the word BOHEME may be regarded as being the slightly more dominant and distinctive element because it has (as an invented word or as a reference to Puccini's opera) no suggestive qualities to the goods and also because of its presence at the beginning of the mark, the numeral 1795 still plays a dominant and distinctive role within the mark as a whole. **Both the element BOHEME and the element 1795 constitute dominant and distinctive elements – BOHEME being slightly more dominant and distinctive than 1795.**

29) In terms of the comparison between the respective marks, the same issues relate to the visual, aural and conceptual comparisons, namely, that the numeral 1795 is present in both marks. This, at the least, and bearing in mind the respective dominance and distinctiveness of this element in the respective marks, creates a degree of visual, aural and conceptual similarity. The difference though, the presence of the word BOHEME in Tesco's mark and the other elements in Bud's mark, means that any similarity overall cannot be placed at the higher end of the spectrum. I consider there to be a moderate degree of similarity overall.

30) An additional factor that needs to be assessed when determining whether there is a likelihood of confusion is the distinctiveness of the earlier mark. This is because the more distinctive it is (based either on inherent qualities or because of the use made of it) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Whilst I agree with Mr Groom's submission that the 1795 element (which I have found to be the dominant and distinctive element of the earlier mark) does not imbue a high degree of distinctiveness, I see no need to place it at the lower end of the spectrum. I consider that the average consumer would regard the element, and, consequently, the trade mark as a whole, as a mark of a reasonable degree of distinctiveness.

31) I must also consider the use made by Bud of its mark. Mr Drevikovsky's evidence gives some details of its use such as invoices (from June 2007) to the Beer Club of Great Britain (an extract from this company's website selling Bud's goods is also provided) and, also, an international way-bill to a consignee in Preston called The Warehouse Wine Company. However, the overall scale and

quantum of its sales in the UK are not apparent from the evidence. Neither is there any evidence highlighting any promotional or advertising activities. Whilst the goods have clearly been sold under the trade mark, its use as set out in the evidence cannot be found to have enhanced its distinctive character.

32) The various factors that I have assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17). A global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33) The goods are identical and the earlier mark has a reasonable degree of distinctive character. I must also take into account the concept of imperfect recollection. I bear in mind, of course, the whole mark comparison. I also bear in mind the dominant and distinctive elements as assessed earlier. The question, though, really boils down to whether the average consumer will, due to the common presence of 1795 in both marks, be led to believe that the goods sold under the respective marks are the responsibility of the same or an economically linked undertaking.

34) Tesco's mark has as a dominant and distinctive element the numeral 1795. Whilst it may not be the most dominant and distinctive element in the mark, this does not rule out a likelihood of confusion (see the *Medion* case). The Boheme element is, in any event, only slightly more dominant than 1795. I also consider the 1795 element to have a normal degree of distinctiveness such that the average consumer, when appreciating the overall impression of the mark, will regard it as playing an independent and distinctive role. Whilst Bud's mark includes other words and insignia on its label, it is dominated to a significant extent by the numeral 1795 and this is the only real element the average consumer will latch on to when recalling that mark. That is not to say that I have ignored those other elements as they are far from negligible, but 1795 is far and away the most important aspect of the mark. This is so despite Mr Groom's submission that numerals are not particularly memorable. Taking all of this into account, I believe that the average consumer will believe that the goods are the responsibility of the same or an economically linked undertaking. The similarity in terms of the common inclusion of the 1795 element will be put down to economic connection rather than co-incidence. **There is a likelihood of confusion.**

35) In reaching my conclusions I have said little about the manufacturing agreement between Bud and Tesco. This is because the test, as the case-law indicates, must be assessed from the viewpoint of the average consumer. The average consumer will be unaware of the agreement so it is difficult to see what this brings to the table. In any event, Bud was the only party to refer to this in its evidence and I have, anyway, found in its favour.

36) The opposition under section 5(2)(b) of the Act succeeds.

Costs

37) Bud has been successful and is entitled to a contribution towards its costs. I hereby order Tesco Stores Limited to pay Budejovicky Mestansky Pivovar a.s. the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering Tesco's evidence
£500

Attending the hearing
£400

38) The above sum should 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 22 day of July 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

O-257-10

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION 2452023
BY TESCO STORES LIMITED
TO REGISTER IN CLASS 32 THE TRADE MARK:
BOHEME 1795
AND
IN THE MATTER OF OPPOSITION 95998 BY
BUDEJOVICKY MESTANSKY PIVOVAR A.S.

TRADE MARKS ACT 1994

**In the matter of application 2452023 by Tesco Stores Limited
to register in class 32 the trade mark: BOHEME 1795**

and

in the matter of opposition 95998 by Budejovicky Mestansky Pivovar a.s.

The background and the pleadings

1) On 10 April 2007 Tesco Stores Limited (“Tesco”) applied to register the trade mark BOHEME 1795 in class 32 of the Nice classification system¹. Registration is sought in respect of:

Beer, ale, stout and lager.

2) On 29 January 2008 Budejovicky Mestansky Pivovar a.s. (“Bud”) opposed the registration of Tesco’s trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Bud relies on a single trade mark of which it is the proprietor, namely Community Trade Mark (“CTM”) 4075107 which is also registered in class 32, but in respect of “beers including non-alcoholic beers”. The CTM was filed on 14 October 2004 (so making it an earlier mark under the provisions of section 6 of the Act) and it completed its registration procedure on 16 January 2006. The earlier mark is depicted below:



¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

3) Bud claims that the distinctive element of both trade marks is the numeral 1795 (I will return to why this is claimed later). It also claims that all of the goods sought by Tesco are identical to the goods covered by its earlier mark. Bud believes that all this will lead to a likelihood of confusion. I also note that as the earlier mark had not completed its registration procedure before the period of five years ending with the date of publication of Tesco's mark², the proof of use provisions contained in section 6A³ of the Act do not apply. Therefore, the earlier trade mark can be taken into account in these proceedings for its specification as registered.

4) Tesco filed a counterstatement denying the grounds of opposition. It denies that there is a likelihood of confusion. Tesco contends that the earlier mark is a complex mark which does not give rights in its individual components that are, it claims, separately non-distinctive. Tesco says that numerals are not distinctive *per se* as they are used in trade to indicate when the brewery etc. that produces the goods was established.

5) Both sides filed evidence. The matter then came to be heard before me on 25 June 2010. At the hearing Mr John Groom of Groom Wilkes & Wright LLP represented Tesco whereas Mr Michael Lynd of Marks & Clerk represented Bud.

The evidence

6) Two people gave written evidence on behalf of Bud: i) Mr Lynd (Bud's representative in these proceedings) and ii) Mr Daniel Drevikovsky (Bud's General Manager). Both Mr Lynd and Mr Drevikovsky gave evidence relating to the history of Bud, its brewery and its predecessors in title. It is sufficient to record, and it is an undisputed fact, that its history dates back to the year 1795 when the town council of Ceske Budejovice (Budweis) returned to its citizens the municipal brewery formally belonging to Matej Konvicka.

7) Both Mr Lynd and Mr Drevikovsky also gave evidence relating to an agreement between Bud and Tesco whereby Bud produce the beer that Tesco sell under the mark the subject of these proceedings. A framework agreement, dated 18 June 2007, is exhibited to Mr Drevikovsky's witness statement. It is a short agreement, the operative part of which reads:

"It is Tesco Stores Limited's (further Tesco) intention to progress to launch the Tesco Lager Brand with BUDEJOVICKY MESTANSKY PIVOVAR a.s (further BMP) whereby BMP would supply beer to Tesco for resale under the branding selected by Tesco (except for branding with the words

² Tesco's mark was published on 9 November 2007 and Bud's mark completed its registration procedure on 16 June 2006.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Budweiser or Budweis) and in the quantities and for the prices set forth below.”

8) Both witnesses also refer to the modifying of Bud’s “1795” label for Tesco to sell the beer in the UK. Mr Lynd suggests that this means that Tesco are, in effect, using its 1795 label under licence from Bud. He also states that this means that Bud cannot be taken to have consented to Tesco’s use/registration. Details of the modified label are exhibited to Mr Drevikovsky’s witness statement – the labels consist predominantly of the word/numeral BOHEME 1795. Details of Bud’s sales to Tesco under the agreement are also provided. I do not need to set them out in detail, but it is fair to say that the numbers involved appear reasonably significant.

9) In addition to the above, Mr Lynd also gave evidence as to the meaning/distinctiveness of the word BOHEME (as contained in Tesco’s mark) and also the distinctiveness of the numeral 1795. I will come back to this evidence later. Mr Drevikovsky also gave evidence as to Bud’s sales in the UK of beer under its 1795 label, again, I will come back to this.

10) In terms of Tesco’s evidence, this comes from Mr Groom, its representative in these proceedings. His evidence relates predominantly to the word BOHEME and, as with Mr Lynd’s evidence in relation to this, I will come back to this.

Section 5(2)(b) of the Act

11) This section reads:

“5.-(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.”

12) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

13) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as

assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

14) Given the nature of the respective marks under comparison and the nature of the arguments that have been made in the claims and counterclaims, it is useful to set out some of the guidance that has come from the ECJ in relation to the likelihood of confusion where complex or composite marks are involved. I particularly note the judgment in *Medion v Thomson Multimedia* [2006] ETMR 13 where it was stated:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

15) Also, the judgment in *OHIM v Shaker di L Laudato & Co Sas* (C-334/05 P, 12 June 2007) where it was stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element”

16) There is no dispute that the goods in the respective specifications are identical. Bud's earlier mark covers beer in general which, Mr Groom helpfully conceded, is a general term that would cover the different types of drinks (beer, ale, stout and lager) covered by Tesco's application.

17) Given that the goods are identical, the average consumer must also be identical. The goods are purchased by the general public, albeit those of drinking age. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). This general presumption can, however, change (or at least the degree of attention that the average consumer displays during the purchasing act) depending on the particular goods in issue (see, for example, the decision of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). The goods here are not the most expensive of products, nor are they infrequent purchases. However, they are still likely to be purchased with at least a reasonable degree of care and attention given that taste, and to some extent brand loyalty, is likely to play a part in the selection process. There is, therefore, no significant increase or decrease from the norm in respect of the degree of care and attention likely to be deployed by the average consumer when purchasing the goods.

18) That leads to the comparison of the marks. The comparison must be made in relation to the totalities of the respective marks, but bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). In view of this, and before making any form of comparison, I should make an assessment of what constitutes the dominant and distinctive elements of the respective marks.

19) Bud's mark is shown below:



20) I believe it clear and obvious to anyone viewing the above mark that the most dominant element is the numeral 1795. It dwarfs the other elements quite considerably. Tesco claims that numerals are either non-distinctive or very low in distinctiveness and, therefore, in the context of Bud's mark, the distinctiveness will lie in its composite nature. There is, though, no evidence that numerals are non-distinctive. The only evidence is from Bud who observes that the Intellectual Property Office's work manual suggests that such numerals are registrable *prima facie*⁴ and that a number of numeral consisting trade marks have been duly registered by different undertakings⁵.

21) Whilst the numeral in Bud's mark may be perceived by the average consumer as a date, and whilst the average consumer may understand it as having some form of significance to the history of the business providing the goods, I see no reason why the average consumer will not also see it as

⁴ The relevant extract reads: "Four digit numbers will also normally be regarded as having some distinctive character, provided that they are random numbers, e.g. 1560, 8787 and not round numbers e.g. 1000, 2400 – which are commonly used in trade as mere model or product numbers for goods. Even round numbers may be distinctive for services and goods not usually sold under a model or product number such as foods and drink. Numbers which are current or shortly forthcoming dates should be regarded as devoid of any distinctive character"

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performing a distinctive trade mark role. The significance of dates on/in labels or trade marks, and whether they perform a distinctive trade mark role, will very much depend on the context of use. For example, a recent(ish) date on a wine label may be perceived merely as a vintage indication. Similarly, if in a complex/composite mark there was an indication along the lines of “brewed since xxxx” or “Established in xxxx” then the date represented by the xxxx would likely have little trade mark significance. In the case before me, whilst the average consumer may still believe that the date has significance regarding the manufacturer of the goods, the dominance given to the element and its self-standing (within the mark) form of presentation combine so that it will be taken as a trade origin indicating element. Whilst there are, of course, other elements in the mark to bear in mind, the overall impression of the mark means that **the numeral 1795 is not only a dominant and distinctive element of the mark, it is the dominant and distinctive element.**

22) I also note that in Mr Drevikovsky’s evidence he exhibited an extract from the website of the Beer Club of Great Britain where Bud’s product, including a picture of it showing the label, is offered for sale. It is clear from this that the beer is sold by reference to the brand 1795. Whilst this is not what has led me to the above finding because the method of selling/marketing is chosen by the manufacturer/marketer and it may not represent the perception of the average consumer, it at least supports my view that the 1795 element is more than capable of performing an independent and distinctive role within the mark as a whole.

23) Tesco’s mark consists of the word/numeral BOHEME 1795. The first element, the word BOHEME, is subject to evidence from both sides. For Bud, Mr Lynd’s evidence is that the word Boheme is a French word meaning Bohemia⁶. His evidence is also that the province of Bohemia (as well as its principal towns of Pilsen and Budweis) is well known for its brewing industry. Extracts from the Encyclopedia Britannica (11th edition published in 1911) are provided in an attempt to illustrate this. One such extract, in relation to Bohemia, reads:

“Sugar refining is another industry, which, although of recent date, had had a very great development, and the breweries produce a beer which is appreciated all over the world”

24) To further support his assertions, Mr Lynd also provides in evidence (at Exhibit MAL8) details of trade mark registrations which include the prefix “BOHEM-“, most of which cover beer. They include marks containing the words “BOHEMIA”, “bohemia regent”, “BOHEMIA OBSCURA” (and device), a label mark containing the word “BOHEMIA” at the bottom, a stylised mark containing

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the words “A bohemia lazne karlovy vary”, and a mark containing the words “OLD BOHEMIA”. He also highlights that Tesco, on the rear of its BOHEME 1795 label, uses the words “a true Bohemian Classic”.

25) Mr Groom’s evidence, on the other hand, is that the word BOHEME will have other connotations to an English speaking person than that asserted by Bud. He provides the first 20 pages of a Google report for “Boheme” (this is a world-wide search not limited to UK based websites) none of which, he says, relate to the region in the Czech Republic. Having examined the report I note that some relate to the opera “La Boheme”, with most of the others relating to the names of cafes, restaurants, hotels or other goods and services. Mr Groom also conducted searches in various reference works (Exhibits JAG2-8). In relation to “Boheme” the word either had no entry or the reference work pointed to related references for entries such as La Boheme, the opera. In relation to “Bohemia” the reference works relate, in the main, to a historical region in Central Europe.

26) Whether or not a word in a trade mark has a meaning can only be relevant to the extent that such a meaning is known by the average consumer. I should approach this assessment with caution as it would be wrong to accept to readily the degree of knowledge that the average consumer may possess⁷. Mr Lynd’s evidence is that Boheme is French for Bohemia and that Bohemia will indicate, effectively, the geographical origin of the goods. In my view, it would be wrong to assume that the average consumer in the UK would know that Boheme is French for Bohemia. Whilst some French words will be known by the average consumer, I would not count Boheme amongst them.

27) The average consumer could, though, still make a link to geographical origin if the word Boheme points that way. However, I am far from convinced that this is so. Whilst the Google report provided by Mr Groom is for world-wide hits rather than the UK, it nevertheless suggests that if the word is to be perceived by the average consumer as one with a meaning, such meaning will not relate to geographical origin in Bohemia. On the evidence before me, I believe that the average consumer will either see the word simply as an invented word or, alternatively, that it will remind them of the opera by Puccini. Whichever meaning is taken, this works against Bud’s claim that Boheme has geographical significance. I have not ignored the evidence relating to the use of BOHEM-marks on the register or the use by Tesco of the words “a true Bohemian Classic” on the back of its label. In relation to the former argument, none of the marks actually contain the word BOHEME as such and, furthermore, the mere presence of such marks on the register tells me little as to what is going on in the marketplace and what, if any, consequent impact this will have had on the average consumer. In relation to the latter argument, such use by Tesco cannot be taken to have informed the notional average consumer that the word Boheme has meaning.

⁷ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08.

28) The second element in Tesco's mark is the numeral 1795. I have already discussed the distinctiveness of such an element when considering Bud's earlier mark. A lot depends on the context of use and the consequent impact on the average consumer. It is certainly not an element that can be said, *per se*, to lack distinctiveness. In the context of the mark BOHEME 1795, the two elements do not blend to create a meaningful whole. The elements will strike the average consumer as two separate elements presented in one overall trade mark. I do not consider that 1795 will be taken merely as a non-distinctive date. Whilst it may be perceived as a date and whilst it may be assumed that the date has some meaning to the undertaking responsible for the goods, it will, effectively, play a dual role as it will also be seen as a trade origin indicating element given the way it is presented as a key part of the whole trade mark. Whilst the word BOHEME may be regarded as being the slightly more dominant and distinctive element because it has (as an invented word or as a reference to Puccini's opera) no suggestive qualities to the goods and also because of its presence at the beginning of the mark, the numeral 1795 still plays a dominant and distinctive role within the mark as a whole. **Both the element BOHEME and the element 1795 constitute dominant and distinctive elements – BOHEME being slightly more dominant and distinctive than 1795.**

29) In terms of the comparison between the respective marks, the same issues relate to the visual, aural and conceptual comparisons, namely, that the numeral 1795 is present in both marks. This, at the least, and bearing in mind the respective dominance and distinctiveness of this element in the respective marks, creates a degree of visual, aural and conceptual similarity. The difference though, the presence of the word BOHEME in Tesco's mark and the other elements in Bud's mark, means that any similarity overall cannot be placed at the higher end of the spectrum. I consider there to be a moderate degree of similarity overall.

30) An additional factor that needs to be assessed when determining whether there is a likelihood of confusion is the distinctiveness of the earlier mark. This is because the more distinctive it is (based either on inherent qualities or because of the use made of it) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Whilst I agree with Mr Groom's submission that the 1795 element (which I have found to be the dominant and distinctive element of the earlier mark) does not imbue a high degree of distinctiveness, I see no need to place it at the lower end of the spectrum. I consider that the average consumer would regard the element, and, consequently, the trade mark as a whole, as a mark of a reasonable degree of distinctiveness.

31) I must also consider the use made by Bud of its mark. Mr Drevikovsky's evidence gives some details of its use such as invoices (from June 2007) to the Beer Club of Great Britain (an extract from this company's website selling Bud's goods is also provided) and, also, an international way-bill to a consignee in Preston called The Warehouse Wine Company. However, the overall scale and

quantum of its sales in the UK are not apparent from the evidence. Neither is there any evidence highlighting any promotional or advertising activities. Whilst the goods have clearly been sold under the trade mark, its use as set out in the evidence cannot be found to have enhanced its distinctive character.

32) The various factors that I have assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17). A global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33) The goods are identical and the earlier mark has a reasonable degree of distinctive character. I must also take into account the concept of imperfect recollection. I bear in mind, of course, the whole mark comparison. I also bear in mind the dominant and distinctive elements as assessed earlier. The question, though, really boils down to whether the average consumer will, due to the common presence of 1795 in both marks, be led to believe that the goods sold under the respective marks are the responsibility of the same or an economically linked undertaking.

34) Tesco's mark has as a dominant and distinctive element the numeral 1795. Whilst it may not be the most dominant and distinctive element in the mark, this does not rule out a likelihood of confusion (see the *Medion* case). The Boheme element is, in any event, only slightly more dominant than 1795. I also consider the 1795 element to have a normal degree of distinctiveness such that the average consumer, when appreciating the overall impression of the mark, will regard it as playing an independent and distinctive role. Whilst Bud's mark includes other words and insignia on its label, it is dominated to a significant extent by the numeral 1795 and this is the only real element the average consumer will latch on to when recalling that mark. That is not to say that I have ignored those other elements as they are far from negligible, but 1795 is far and away the most important aspect of the mark. This is so despite Mr Groom's submission that numerals are not particularly memorable. Taking all of this into account, I believe that the average consumer will believe that the goods are the responsibility of the same or an economically linked undertaking. The similarity in terms of the common inclusion of the 1795 element will be put down to economic connection rather than co-incidence. **There is a likelihood of confusion.**

35) In reaching my conclusions I have said little about the manufacturing agreement between Bud and Tesco. This is because the test, as the case-law indicates, must be assessed from the viewpoint of the average consumer. The average consumer will be unaware of the agreement so it is difficult to see what this brings to the table. In any event, Bud was the only party to refer to this in its evidence and I have, anyway, found in its favour.

36) The opposition under section 5(2)(b) of the Act succeeds.

Costs

37) Bud has been successful and is entitled to a contribution towards its costs. I hereby order Tesco Stores Limited to pay Budejovicky Mestansky Pivovar a.s. the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering Tesco's evidence
£500

Attending the hearing
£400

38) The above sum should 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 22 day of July 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**

O-257-10

TRADE MARKS ACT 1994
IN THE MATTER OF APPLICATION 2452023
BY TESCO STORES LIMITED
TO REGISTER IN CLASS 32 THE TRADE MARK:
BOHEME 1795
AND
IN THE MATTER OF OPPOSITION 95998 BY
BUDEJOVICKY MESTANSKY PIVOVAR A.S.

TRADE MARKS ACT 1994

**In the matter of application 2452023 by Tesco Stores Limited
to register in class 32 the trade mark: BOHEME 1795**

and

in the matter of opposition 95998 by Budejovicky Mestansky Pivovar a.s.

The background and the pleadings

1) On 10 April 2007 Tesco Stores Limited (“Tesco”) applied to register the trade mark BOHEME 1795 in class 32 of the Nice classification system¹. Registration is sought in respect of:

Beer, ale, stout and lager.

2) On 29 January 2008 Budejovicky Mestansky Pivovar a.s. (“Bud”) opposed the registration of Tesco’s trade mark under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Bud relies on a single trade mark of which it is the proprietor, namely Community Trade Mark (“CTM”) 4075107 which is also registered in class 32, but in respect of “beers including non-alcoholic beers”. The CTM was filed on 14 October 2004 (so making it an earlier mark under the provisions of section 6 of the Act) and it completed its registration procedure on 16 January 2006. The earlier mark is depicted below:



¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

3) Bud claims that the distinctive element of both trade marks is the numeral 1795 (I will return to why this is claimed later). It also claims that all of the goods sought by Tesco are identical to the goods covered by its earlier mark. Bud believes that all this will lead to a likelihood of confusion. I also note that as the earlier mark had not completed its registration procedure before the period of five years ending with the date of publication of Tesco's mark², the proof of use provisions contained in section 6A³ of the Act do not apply. Therefore, the earlier trade mark can be taken into account in these proceedings for its specification as registered.

4) Tesco filed a counterstatement denying the grounds of opposition. It denies that there is a likelihood of confusion. Tesco contends that the earlier mark is a complex mark which does not give rights in its individual components that are, it claims, separately non-distinctive. Tesco says that numerals are not distinctive *per se* as they are used in trade to indicate when the brewery etc. that produces the goods was established.

5) Both sides filed evidence. The matter then came to be heard before me on 25 June 2010. At the hearing Mr John Groom of Groom Wilkes & Wright LLP represented Tesco whereas Mr Michael Lynd of Marks & Clerk represented Bud.

The evidence

6) Two people gave written evidence on behalf of Bud: i) Mr Lynd (Bud's representative in these proceedings) and ii) Mr Daniel Drevikovsky (Bud's General Manager). Both Mr Lynd and Mr Drevikovsky gave evidence relating to the history of Bud, its brewery and its predecessors in title. It is sufficient to record, and it is an undisputed fact, that its history dates back to the year 1795 when the town council of Ceske Budejovice (Budweis) returned to its citizens the municipal brewery formally belonging to Matej Konvicka.

7) Both Mr Lynd and Mr Drevikovsky also gave evidence relating to an agreement between Bud and Tesco whereby Bud produce the beer that Tesco sell under the mark the subject of these proceedings. A framework agreement, dated 18 June 2007, is exhibited to Mr Drevikovsky's witness statement. It is a short agreement, the operative part of which reads:

"It is Tesco Stores Limited's (further Tesco) intention to progress to launch the Tesco Lager Brand with BUDEJOVICKY MESTANSKY PIVOVAR a.s (further BMP) whereby BMP would supply beer to Tesco for resale under the branding selected by Tesco (except for branding with the words

² Tesco's mark was published on 9 November 2007 and Bud's mark completed its registration procedure on 16 June 2006.

³ Section 6A of the Act was added to the Act by virtue of the Trade Marks (Proof of Use, etc.) Regulations) 2004 (SI 2004/946) which came into force on 5th May 2004.

Budweiser or Budweis) and in the quantities and for the prices set forth below.”

8) Both witnesses also refer to the modifying of Bud’s “1795” label for Tesco to sell the beer in the UK. Mr Lynd suggests that this means that Tesco are, in effect, using its 1795 label under licence from Bud. He also states that this means that Bud cannot be taken to have consented to Tesco’s use/registration. Details of the modified label are exhibited to Mr Drevikovsky’s witness statement – the labels consist predominantly of the word/numeral BOHEME 1795. Details of Bud’s sales to Tesco under the agreement are also provided. I do not need to set them out in detail, but it is fair to say that the numbers involved appear reasonably significant.

9) In addition to the above, Mr Lynd also gave evidence as to the meaning/distinctiveness of the word BOHEME (as contained in Tesco’s mark) and also the distinctiveness of the numeral 1795. I will come back to this evidence later. Mr Drevikovsky also gave evidence as to Bud’s sales in the UK of beer under its 1795 label, again, I will come back to this.

10) In terms of Tesco’s evidence, this comes from Mr Groom, its representative in these proceedings. His evidence relates predominantly to the word BOHEME and, as with Mr Lynd’s evidence in relation to this, I will come back to this.

Section 5(2)(b) of the Act

11) This section reads:

“5.-(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.”

12) In reaching my decision I have taken into account the guidance provided by the European Court of Justice (“ECJ”) in a number of judgments: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77, *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (Case C-120/04) and *Shaker di L. Laudato & Co. Sas* (C-334/05).

13) The existence of a likelihood of confusion must be appreciated globally, taking into account all relevant factors (*Sabel BV v Puma AG*). As well as

assessing whether the respective marks and the respective goods/services are similar, other factors are relevant including:

The nature of the average consumer of the goods in question and the nature of his or her purchasing act. This is relevant because it is through such a person's eyes that matters must be judged (*Sabel BV v Puma AG*);

That the average consumer rarely has the chance to make direct comparisons between trade marks and must, instead, rely upon the imperfect picture of them he or she has kept in mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*) This is often referred to as the concept of "imperfect recollection";

That the degree of distinctiveness of the earlier trade mark (due either to its inherent qualities or through the use made of it) is an important factor because confusion is more likely the more distinctive the earlier trade mark is (*Sabel BV v Puma AG*);

That there is interdependency between the various factors, for example, a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the respective goods, and vice versa (*Canon Kabushiki Kaisha v Metro- Goldwyn-Mayer Inc.*).

14) Given the nature of the respective marks under comparison and the nature of the arguments that have been made in the claims and counterclaims, it is useful to set out some of the guidance that has come from the ECJ in relation to the likelihood of confusion where complex or composite marks are involved. I particularly note the judgment in *Medion v Thomson Multimedia* [2006] ETMR 13 where it was stated:

"29 In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30 However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31 In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32 The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33 If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34 This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35 Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36 It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

15) Also, the judgment in *OHIM v Shaker di L Laudato & Co Sas* (C-334/05 P, 12 June 2007) where it was stated:

“41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its

components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element”

16) There is no dispute that the goods in the respective specifications are identical. Bud's earlier mark covers beer in general which, Mr Groom helpfully conceded, is a general term that would cover the different types of drinks (beer, ale, stout and lager) covered by Tesco's application.

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18) That leads to the comparison of the marks. The comparison must be made in relation to the totalities of the respective marks, but bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG*, paragraph 23). In view of this, and before making any form of comparison, I should make an assessment of what constitutes the dominant and distinctive elements of the respective marks.

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20) I believe it clear and obvious to anyone viewing the above mark that the most dominant element is the numeral 1795. It dwarfs the other elements quite considerably. Tesco claims that numerals are either non-distinctive or very low in distinctiveness and, therefore, in the context of Bud's mark, the distinctiveness will lie in its composite nature. There is, though, no evidence that numerals are non-distinctive. The only evidence is from Bud who observes that the Intellectual Property Office's work manual suggests that such numerals are registrable *prima facie*⁴ and that a number of numeral consisting trade marks have been duly registered by different undertakings⁵.

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performing a distinctive trade mark role. The significance of dates on/in labels or trade marks, and whether they perform a distinctive trade mark role, will very much depend on the context of use. For example, a recent(ish) date on a wine label may be perceived merely as a vintage indication. Similarly, if in a complex/composite mark there was an indication along the lines of “brewed since xxxx” or “Established in xxxx” then the date represented by the xxxx would likely have little trade mark significance. In the case before me, whilst the average consumer may still believe that the date has significance regarding the manufacturer of the goods, the dominance given to the element and its self-standing (within the mark) form of presentation combine so that it will be taken as a trade origin indicating element. Whilst there are, of course, other elements in the mark to bear in mind, the overall impression of the mark means that **the numeral 1795 is not only a dominant and distinctive element of the mark, it is the dominant and distinctive element.**

22) I also note that in Mr Drevikovsky’s evidence he exhibited an extract from the website of the Beer Club of Great Britain where Bud’s product, including a picture of it showing the label, is offered for sale. It is clear from this that the beer is sold by reference to the brand 1795. Whilst this is not what has led me to the above finding because the method of selling/marketing is chosen by the manufacturer/marketer and it may not represent the perception of the average consumer, it at least supports my view that the 1795 element is more than capable of performing an independent and distinctive role within the mark as a whole.

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⁶ The extracts are from Le Grande Dictionnaire Hachette-Oxford. Mr Lynd notes that the second definition for “Bohême” is “Bohemia” and the only definition for “Bohême” is “Bohemia”. I note that the first definition for Bohême is “Bohemian”.

the words “A bohemia lazne karlovy vary”, and a mark containing the words “OLD BOHEMIA”. He also highlights that Tesco, on the rear of its BOHEME 1795 label, uses the words “a true Bohemian Classic”.

25) Mr Groom’s evidence, on the other hand, is that the word BOHEME will have other connotations to an English speaking person than that asserted by Bud. He provides the first 20 pages of a Google report for “Boheme” (this is a world-wide search not limited to UK based websites) none of which, he says, relate to the region in the Czech Republic. Having examined the report I note that some relate to the opera “La Boheme”, with most of the others relating to the names of cafes, restaurants, hotels or other goods and services. Mr Groom also conducted searches in various reference works (Exhibits JAG2-8). In relation to “Boheme” the word either had no entry or the reference work pointed to related references for entries such as La Boheme, the opera. In relation to “Bohemia” the reference works relate, in the main, to a historical region in Central Europe.

26) Whether or not a word in a trade mark has a meaning can only be relevant to the extent that such a meaning is known by the average consumer. I should approach this assessment with caution as it would be wrong to accept to readily the degree of knowledge that the average consumer may possess⁷. Mr Lynd’s evidence is that Boheme is French for Bohemia and that Bohemia will indicate, effectively, the geographical origin of the goods. In my view, it would be wrong to assume that the average consumer in the UK would know that Boheme is French for Bohemia. Whilst some French words will be known by the average consumer, I would not count Boheme amongst them.

27) The average consumer could, though, still make a link to geographical origin if the word Boheme points that way. However, I am far from convinced that this is so. Whilst the Google report provided by Mr Groom is for world-wide hits rather than the UK, it nevertheless suggests that if the word is to be perceived by the average consumer as one with a meaning, such meaning will not relate to geographical origin in Bohemia. On the evidence before me, I believe that the average consumer will either see the word simply as an invented word or, alternatively, that it will remind them of the opera by Puccini. Whichever meaning is taken, this works against Bud’s claim that Boheme has geographical significance. I have not ignored the evidence relating to the use of BOHEM-marks on the register or the use by Tesco of the words “a true Bohemian Classic” on the back of its label. In relation to the former argument, none of the marks actually contain the word BOHEME as such and, furthermore, the mere presence of such marks on the register tells me little as to what is going on in the marketplace and what, if any, consequent impact this will have had on the average consumer. In relation to the latter argument, such use by Tesco cannot be taken to have informed the notional average consumer that the word Boheme has meaning.

⁷ See, for example, the decision of Anna Carboni (sitting as the Appointed Person) in *Cherokee* BL-O-198-08.

28) The second element in Tesco's mark is the numeral 1795. I have already discussed the distinctiveness of such an element when considering Bud's earlier mark. A lot depends on the context of use and the consequent impact on the average consumer. It is certainly not an element that can be said, *per se*, to lack distinctiveness. In the context of the mark BOHEME 1795, the two elements do not blend to create a meaningful whole. The elements will strike the average consumer as two separate elements presented in one overall trade mark. I do not consider that 1795 will be taken merely as a non-distinctive date. Whilst it may be perceived as a date and whilst it may be assumed that the date has some meaning to the undertaking responsible for the goods, it will, effectively, play a dual role as it will also be seen as a trade origin indicating element given the way it is presented as a key part of the whole trade mark. Whilst the word BOHEME may be regarded as being the slightly more dominant and distinctive element because it has (as an invented word or as a reference to Puccini's opera) no suggestive qualities to the goods and also because of its presence at the beginning of the mark, the numeral 1795 still plays a dominant and distinctive role within the mark as a whole. **Both the element BOHEME and the element 1795 constitute dominant and distinctive elements – BOHEME being slightly more dominant and distinctive than 1795.**

29) In terms of the comparison between the respective marks, the same issues relate to the visual, aural and conceptual comparisons, namely, that the numeral 1795 is present in both marks. This, at the least, and bearing in mind the respective dominance and distinctiveness of this element in the respective marks, creates a degree of visual, aural and conceptual similarity. The difference though, the presence of the word BOHEME in Tesco's mark and the other elements in Bud's mark, means that any similarity overall cannot be placed at the higher end of the spectrum. I consider there to be a moderate degree of similarity overall.

30) An additional factor that needs to be assessed when determining whether there is a likelihood of confusion is the distinctiveness of the earlier mark. This is because the more distinctive it is (based either on inherent qualities or because of the use made of it) the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). Whilst I agree with Mr Groom's submission that the 1795 element (which I have found to be the dominant and distinctive element of the earlier mark) does not imbue a high degree of distinctiveness, I see no need to place it at the lower end of the spectrum. I consider that the average consumer would regard the element, and, consequently, the trade mark as a whole, as a mark of a reasonable degree of distinctiveness.

31) I must also consider the use made by Bud of its mark. Mr Drevikovsky's evidence gives some details of its use such as invoices (from June 2007) to the Beer Club of Great Britain (an extract from this company's website selling Bud's goods is also provided) and, also, an international way-bill to a consignee in Preston called The Warehouse Wine Company. However, the overall scale and

quantum of its sales in the UK are not apparent from the evidence. Neither is there any evidence highlighting any promotional or advertising activities. Whilst the goods have clearly been sold under the trade mark, its use as set out in the evidence cannot be found to have enhanced its distinctive character.

32) The various factors that I have assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17). A global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

33) The goods are identical and the earlier mark has a reasonable degree of distinctive character. I must also take into account the concept of imperfect recollection. I bear in mind, of course, the whole mark comparison. I also bear in mind the dominant and distinctive elements as assessed earlier. The question, though, really boils down to whether the average consumer will, due to the common presence of 1795 in both marks, be led to believe that the goods sold under the respective marks are the responsibility of the same or an economically linked undertaking.

34) Tesco's mark has as a dominant and distinctive element the numeral 1795. Whilst it may not be the most dominant and distinctive element in the mark, this does not rule out a likelihood of confusion (see the *Medion* case). The Boheme element is, in any event, only slightly more dominant than 1795. I also consider the 1795 element to have a normal degree of distinctiveness such that the average consumer, when appreciating the overall impression of the mark, will regard it as playing an independent and distinctive role. Whilst Bud's mark includes other words and insignia on its label, it is dominated to a significant extent by the numeral 1795 and this is the only real element the average consumer will latch on to when recalling that mark. That is not to say that I have ignored those other elements as they are far from negligible, but 1795 is far and away the most important aspect of the mark. This is so despite Mr Groom's submission that numerals are not particularly memorable. Taking all of this into account, I believe that the average consumer will believe that the goods are the responsibility of the same or an economically linked undertaking. The similarity in terms of the common inclusion of the 1795 element will be put down to economic connection rather than co-incidence. **There is a likelihood of confusion.**

35) In reaching my conclusions I have said little about the manufacturing agreement between Bud and Tesco. This is because the test, as the case-law indicates, must be assessed from the viewpoint of the average consumer. The average consumer will be unaware of the agreement so it is difficult to see what this brings to the table. In any event, Bud was the only party to refer to this in its evidence and I have, anyway, found in its favour.

36) The opposition under section 5(2)(b) of the Act succeeds.

Costs

37) Bud has been successful and is entitled to a contribution towards its costs. I hereby order Tesco Stores Limited to pay Budejovicky Mestansky Pivovar a.s. the sum of £1300. This sum is calculated as follows:

Preparing a statement and considering the other side's statement
£400

Filing evidence and considering Tesco's evidence
£500

Attending the hearing
£400

38) The above sum should 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 22 day of July 2010

**Oliver Morris
For the Registrar,
The Comptroller-General**