

O-250-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION 2457803
BY MILLRACE MARKETING LTD FOR THE MARK:**

liquid crystal

AND

**OPPOSITION THERETO (NO 96873) BY
DRENNAN INTERNATIONAL LIMITED**

TRADE MARKS ACT 1994

In the matter of application 2457803 by Millrace Marketing Ltd

and

Opposition thereto (no 96873) by Drennan International Limited

THE BACKGROUND AND THE PLEADINGS

1) The details of Millrace Marketing Ltd's ("Millrace") trade mark application the subject of this dispute are as follows:

Trade mark 2457803 for the mark:

liquid crystal

Filing date: 6 June 2007

Published in the trade marks journal: 7 March 2008

Goods sought to be registered: Class 28 - Angling apparatus, angling accessories.

2) Drennan International Limited ("Drennan") opposes the registration of the above mark. It filed its opposition on 17 April 2008. It opposes registration in respect of all the goods sought to be registered. Drennan bases its opposition under sections 5(2)(b), 5(3) & 5(4)(a) of the Trade Marks Act 1994 ("the Act"). Under the first two of these grounds Drennan relies on a single earlier trade mark of which it is the proprietor, namely:

UK trade mark registration 1209230 for the mark:

CRYSTAL

Filing date: 16 December 1983

Goods for which the mark is registered: Class 28 - Fishing floats.

3) Under Section 5(4)(a) Drennan relies on the use that it has made of the sign CRYSTAL since 1983.

4) Millrace filed a counterstatement denying the grounds of opposition. Despite Drennan's earlier mark being subject to the proof of use regulations, Millrace did not put Drennan to proof on its statement that it had used its mark in relation to fishing floats. Millrace states that the marks are sufficiently different and refers to 500 others marks containing the word CRYSTAL including 39 in Class 28. In relation to the claim under section 5(4(a), Millrace states:

"I have been in the Fishing tackle Trade since 1973 and ever since I have been aware of the generic word "crystal" to describe the clarity and transparency of items of fishing tackle to indicate properties of invisibility in water.

This is particularly relevant not just to floats but much more importantly to fishing line.

The German company D.A.M. were marketing "Crystal Bubble Floats" certainly as far back as 1973 and for all I know even longer. "Crystal fishing Line" has been described as such for very many years before even my knowledge."

A list of names containing the word CRYSTAL used on floats, fishing line and lures are provided in Millrace's counterstatement. It is then added:

"There is zero evidence that Drennan are using the word Crystal for any other fishing tackle item other than fishing floats.

Because of this we would dispute strongly their claim that "*the same would apply for other items of fishing tackle*"

When applying for our mark "Liquid Crystal" we were very much aware of the generic nature of the word "crystal" and as such devised our mark "Liquid Crystal" to provide qualification of the word crystal in order that it could stand apart from, and offer no confusion with, generic terminology".

5) Both sides filed evidence. Neither party requested a hearing, both filing written submissions instead.

THE EVIDENCE

Drennan's initial evidence – witness statement of Isobel Wilson

6) Ms Wilson is Drennan's company solicitor. She says that she has been involved in the fishing equipment industry for 14 years.

7) It is explained that Drennan manufactures, wholesale distributes and sells fishing equipment. It is stated that CRYSTAL branded floats have been continuously sold since 1983. Sample copies of these floats, and their packaging, are shown in Exhibit IW1. The photographs provided show:

- Three packaged products that have the word DRENNAN, a separate (but in close proximity) use of the words CRYSTAL PIKE FLOATS and the word(s) PIKER/WAGGLER/ZEPPLER;
- Various photographs of floats which have markings on them including the word DRENNAN and then words such as “No. 5 LOADED CARP CRYSTAL”, “3.5G CRYSTAL AVON”, “25 g CRYSTAL WAGGLER”, “1.0 grm LOADED GIANT CRYSTAL”, “2.0g LOADED INSERT CRYSTAL” & “No. 3 LOADED CARP CRYSTAL”;
- What appears to be labels for various floats which all have the word DRENNAN (stylized), various uses of the word CRYSTAL (CRYSTAL WAGGLERS, LOADED CRYSTAL, CRYSTAL AVONS) and then other designations such as “No.3 wagglers 2.0g”, “No. 9”, “No.3”. Information about the price is also included;
- A scan of some packaging for fishing hooks that has the word DRENNAN together with the words SPECIMEN CRYSTAL. Information on the back of the packaging is headed SPECIMEN CRYSTAL and in its technical specification the words “Straight Crystal Bend” are used;
- A page headed with Drennan’s name with various alpha numeric codes. It is not clear what this relates to. At the bottom of the page are the words ONIONS, BOBBERS, BIG STICKS, STICKS, CRYSTAL WAGGLERS, PEACOCK WAGGLE.

Ms Wilson explains that terms such as “Avons”, “Piker”, “Waggler” and “Zeppler” are common name for types of floats and have no trade mark significance.

8) Unit sales figures and turnover figures are provided for the years 1997 to 2007. On a yearly basis around 390,000 to 420,000 floats were sold per year amounting to turnover of between £250,000 and £270,000 per year. Advertising and promotion of CRYSTAL floats has not been significant in recent years as the brand is said to be already well established and that Drennan has concentrated instead on higher value and newer products. Some advertising/promotional material is, however, supplied, namely:

- A full page advertisement in *Anglers Mail* from 1985. It is headed DRENNAN LINE, HOOKS & CRYSTALS. At the bottom of the page are the words INSERT CRYSTALS which have “...an interchangeable tip which like the body, is as light and buoyant as peacock”. Pictures of the floats are depicted alongside these words and which have the words INSERT CRYSTALS written on them;
- An editorial in *Anglers Mail* from 1986 about Drennan, which refers to it as being a pioneer in terminal tackle. There is also information about its

CRYSTAL FLOATS. Included text states: "...the versatility of Drennan's Insert and Step Crystals has been increased...", "...70 different floats can be made up on the bank from combinations of seven insert Crystals, three Step Crystals and a single pack of combo tips". A quote from an angler includes: "...fish become float shy and Crystals offer anglers the chance to overcome this...". The article adds that: "Using Crystals he can adapt his float in seconds..", the angler concludes: "Crystals are definitely the best innovation in recent years for clear pits";

- An advertisement feature in *Angling Times* from 1989 about Drennan and its innovative approach. CRYSTAL is not mentioned;
- An advertisement in *Match Fishing Magazine* from 1998. In a "What's New" feature the words "DRENNANS > LOADED CARP CRYSTALS" are used. In the accompanying description the word CRYSTAL is not used.

9) Exhibit IW3 contains a price list from 1987/8 showing the various CRYSTAL names as referred to earlier.

10) Ms Wilson states that CRYSTAL has not become a generic word describing the clarity and transparency of floats or any other fishing tackle. To demonstrate this Ms Wilson provides in Exhibit IW5 Internet prints showing a Shakespeare "Clear oval bubble float" and a Middy "C-through LD-Insert Float". The implication is that these clear/see-through floats do not use the word CRYSTAL. Provided in IW5 is an Internet search conducted on Google for the term crystal fishing floats. The first page of hits are provided. It is not clear if this is a UK or a worldwide search. The majority of hits clearly relate to Drennan. Some, however, do not. One refers to a "Baggin Machine Fat Boy Crystal Float set", one refers to "50x CRYSTAL WAGGLER FLOATS", one to "10x Crystal Waggler Floats" and one to "Delos float box filled with 20 loaded crystal wagglers". At IW6 there is a photograph of Drennan's floats which all use the word Crystal (as set out earlier) but the floats have different tints. This is said to be further evidence that the mark is not descriptive of colourless, transparent floats; I note, though, that the floats are at least transparent and one of the floats is colourless.

11) Exhibit IW7 consists of a warning letter sent in 2008 to a fishing tackle supplier about the use of the word Crystal as part of the name of floats. The response says that such products have now been renamed but its website will still make reference to that word in a descriptive sense e.g. "the finish on this product is crystal clear".

Drennan's initial evidence – witness statement of Steve Partner

12) Mr Partner is a journalist who writes for *Angling Times*. He is aware of the name Crystal and he would "associate" it with Drennan floats. He considers the

mark to be well-known amongst anglers and it has become synonymous with the Drennan brand. He adds that:

“The name is strongly associated with Drennan as Peter Drennan was the first to bring out that type of float and they ended up in everyone’s tackle box. Other manufactures have avoided using the terminology of CRYSTAL as it is too strongly associated with Drennan.”

13) He refers to Drennan having advertised in *Angling Times*. He says that Drennan floats are used when he fishes and he writes about what tackle he uses. Crystal floats are probably the most popular.

14) Mr Partner is not aware of any other company who advertises fishing tackle in the *Angling Times* using the name CRYSTAL either on its own or in conjunction with another word. He is not aware of the LIQUID CRYSTAL brand. He says that if he encountered the name LIQUID CRYSTAL he would think it was a Drennan product, particularly if used on a float.

15) Mr Partner states that if he were to describe a clear plastic float he would use the terms see-through or transparent. He would avoid calling it CRYSTAL if it was not made by Drennan because of the association with Drennan.

Drennan’s initial evidence – witness statement of Martin Bowler

16) Mr Bowler is a professional angler, author and weekly columnist for *Angling Times*. Mr Bowler has been aware of Drennan’s CRYSTAL floats since the mid 1980s and that if he saw the word CRYSTAL in association with fishing tackle then this is what he would think of. He says the floats are clear floats (which avoid spooking fish) rather the previously available balsa, solid or opaque plastic floats. He believes that most anglers would be aware of the mark and that it is well-known.

17) Mr Bowler says that if he saw the mark CRYSTAL on any fishing tackle he would think it was made by Drennan. He says that Drennan also do a range of Specimen Crystal Hooks which has re-enforced the brand. He says that the mark CRYSTAL is synonymous with Drennan.

18) Mr Bowler cannot think of any item of fishing tackle made by other manufacturers with the word CRYSTAL on them. Nor can he think of any use in combination with another word. He does recall one company, Osprey, who made clear leads and described them as crystal clear leads but it is not part of the name.

19) Mr Bowler states that other clear plastic floats are just called “clear plastic floats” or “transparent plastic floats”. He says that other products are of lower quality and that Drennan CRYSTAL is a mark of quality.

Drennan's initial evidence – witness statement of Clive Doughty

20) Mr Doughty works (and is a shareholder) in Gerry's Tackle Shop, which he says is the biggest angling retailer in south west London. He has worked in the shop for 35 years, being the manager for 25 years.

21) Mr Doughty is aware of the CRYSTAL name and he associates it with Drennan. He explains that Drennan were the first to bring out clear floats with interchangeable tips. He mainly associates the name with floats but Drennan also do a fishing line called CRYSTAL so he would associate the name with other items of Drennan fishing tackle as well as floats.

22) Mr Doughty says that the name is well-known and anglers buying goods would ask for the product by name such as CRYSTAL Wagglers or Giant Crystals. He is not aware of any other company selling fishing tackle under the brand name CRYSTAL. He says that if he heard the name LIQUID CRYSTAL he would think it a Drennan product. He says that if he were to see the product he might be able to tell the difference because Drennan's products are high quality. Mr Doughty says that if someone asked for CRYSTAL Wagglers he would assume they meant Drennan's clear plastic wagglers. If someone asked for nightlights to fit a CRYSTAL Waggler he would provide one to fit Drennan's product. He says that other clear floats are just described as clear floats.

Millrace's evidence – witness statement of Andrew Dixon Reade

23) Mr Reade is Millrace's managing director. His evidence is about the use of the word CRYSTAL in relation to fishing tackle. The following is a summary:

- That the "trade mark" Crystal was first used in the UK by O Mustard & Son Ltd (a Norwegian company) in 1921 in relation to fishing hooks.
- Exhibit A is said to be indicative use of the mark from the Internet by a number of UK distributors in relation to various types of fishing tackle. **I will come back to this indicative use later.**
- It is said that the "mark" has been used in the whole of the UK and in over 130 countries worldwide.
- A letter sent to the tribunal in response to Drennan's evidence. This is more submission that evidence so will be borne in mind but not summarised here.

Drennan's reply evidence – 2nd witness statement of Isobel Wilson

24) This evidence responds, primarily, to Mr Reade's evidence of indicative use. I will refer back to the responses later in this decision.

DECISION

Section 5(2)(b)

The law

25) Section 5(2)(b) of the Act 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.”

26) In reaching my decision I have taken into account the guidance provided by the Court of Justice of the European Union (“CJEU”) 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).

27) 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 are similar, other factors are relevant including:

The nature of the average consumer of the goods/services 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*).

The average consumer

28) 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). The degree of care and attention the average consumer uses when selecting goods can, however, vary depending on what is involved (see, for example, the judgment of the General Court (“GC”) in *Inter-Ikea Systems BV v OHIM* (Case T-112/06)). All the goods involved are types of fishing tackle and other angling equipment and accessories. The average consumer is an angler. Owing to its technical requirements and that particular equipment is purchased for particular fish and particular types of fishing, angling equipment will generally be bought with a good deal of care, even if particular items are of low cost.

Comparison of the goods

29) Millrace seeks to register its mark in relation to: “angling apparatus, angling accessories”. Drennan’s earlier mark is registered in relation to fishing floats. As Millrace’s specification covers all types of fishing apparatus and accessories this means that it covers fishing floats. Goods can be considered identical if the term applied for falls within the ambit of the earlier mark, or vice versa¹. As things stands a finding of identical goods must be made.

30) Clearly, any other type of fishing apparatus or accessory beyond floats will not be identical. Millrace has not, though, put forward a revised specification setting out what these other items are. I note from its counterstatement that Millrace suggested to Drennan that it would exclude floats from its specification. I also note from its evidence that the goods on which it claims CRYSTAL to be a generic term include lines, hooks and lures. Some items of fishing apparatus may be more similar to floats than others. I will, therefore, consider the position in relation to Millrace’s term at large (which must be considered identical because it includes floats), however, I will also consider that matter in relation to fishing lines, hooks and lures.

31) In terms of the similarity between fishing lines, hooks and lures with floats, the following guidance about assessing goods similarity must be borne in mind:

¹ See *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)(OHIM)* Case T-133/05 (“*Gérard Meric*”).

In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, *inter alia*, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

32) Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(a) The respective uses of the respective goods or services;
- (a) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

33) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T- 325/06 it was stated:

“It is true that goods are complementary if there is a close connection between them, in the *sense that one is indispensable or important for the use of the other in such a way that* customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v*

OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

34) All the goods are types of fishing tackle. They are used by the same people and likely to be sold through the same channels of trade. The goods being assessed are used beyond the rod and reel (the line, lure, hook and float). The purpose is the same in terms of being apparatus to catch fish. The goods perform slightly different roles but they combine to perform the same function. Whilst the goods are not competitive or substitutable, there is very strong complementary relationship. **I conclude that hooks, line and lures for fishing are highly similar to fishing floats.**

The use of the word CRYSTAL in the fishing tackle industry and what, if anything, it designates

35) Millrace claims that the word CRYSTAL is a generic term used in the relevant trade, designating the clarity and transparency of certain types of fishing tackle. Millrace also refers in its submissions (but with no evidence in support) to certain types of fishing tackle being made from crystal. Reference is made to numerous marks on the register that contain the word CRYSTAL including 39 in class 28. In *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281 Jacob J stated:

“In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led to the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see *e.g. MADAME Trade Mark* (1966 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence.”

36) Also, in *GfK AG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-135/04 the GC stated:

“68. As regards the search of the Cedex database, the mere fact that a number of trade marks relating to Class 35 contain the word ‘bus’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned. Firstly, the search in question does not provide any information on the trade marks actually used in relation to the services concerned. Secondly, it includes a number of trade marks in which the word ‘bus’ is used descriptively by public transport businesses.”

Also of relevance to this issue are the words of Floyd J when he stated in *Nude Brands Limited v Stella McCartney Limited and others* [2009] EWHC 2154 (Ch):

“29. Whilst the use by other traders of the brand name NUDE in relation to perfume may give those traders relative rights to invalidate the mark, it does not give those rights to any defendant. I am not at this stage persuaded that this evidence has a bearing on any absolute ground of invalidity. It certainly does not go as far as establishing ground 7(1)(d) - customary indication in trade. Ground 7(1)(b) is concerned with the inherent character of the mark, not with what other traders have done with it. The traders in question are plainly using the mark as a brand name: so I do not see how this use can help to establish that the mark consists exclusively of signs or indications which may serve to indicate the kind or quality or other characteristics of the goods, and thus support an attack under 7(1)(c).”

37) I am, of course, aware of the judgment of Mr Daniel Alexander QC, sitting as a deputy judge of the High Court, in *Digipos Store Solutions Group Ltd v Digi International Inc* [2008] RPC 24 (“*Digipos*”) where he stated:

“Mr Tibber's evidence shows that it is not possible to draw firm conclusions as to whether the marks revealed by the search are in use, are in use in the United Kingdom or were in use at any relevant date, but there is, nonetheless, a significant number of undertakings which are either using or at least appear to wish to use the prefix DIGI- to denote digital in a number of contexts.”

38) It is to be noted that in that case Mr Alexander was not referred to the judgment of the GC in *GfK AG* and his judgment preceded the judgment of Mr Floyd in *Nude Brands Limited*. *Digipos* also turns very much upon its own facts. In his judgment Mr Alexander referred to the *Madame* case being an absolute grounds case and appeared to consider this of significance. The GC case referred to above is a relative grounds cases so clearly the GC considered that the principle of not giving weight to state of the register evidence applies in relative grounds cases. Mr Alexander went on to state in *Digipos*:

“It is, in my judgment, to be inferred that the reason that the prefix DIGI- is intended to be used (as these registrations or applications demonstrate) in at least a significant proportion of those marks is so as to indicate that the product or service is or involves digital apparatus, computers or software and that, to a large number of traders, that is what it means. That seems the most logical explanation for (a) the number and (b) the diversity of such marks. This provides further support for the proposition that DIGI used as a prefix has a limited capacity as such to distinguish goods or services of one undertaking from those of another when used in relation to goods or services involving digital apparatus, computers or software and is

common to this general trade.”

39) In view of the above, the references to the other CRYSTAL marks on the register is indicative of little. This is particularly so because Millrace has not even provided the details of such marks. In relation to the word CRYSTAL and its alleged designating qualities, I must be satisfied that the word will be known and perceived by the average consumer as a description of a particular type of fishing tackle or a characteristic of them – it must designate something. I am conscious that this is a field where, to the layman, unusual terminology is used. The evidence refers to words such as wagglers, avons, pikers and peacocks. The claim to being a generic term must be borne out by the evidence. I highlight below (broken down by product type) Mr Reade’s evidence as to indicative use of the word CRYSTAL. I also highlight Drennan’s evidence about this:

Use in relation to floats:

- *Mr Reade:* A print from the website of PBS Angling Supplies for a box of floats described as “100 x Crystal Wagglers Fishing Floats”. The box in which the floats are contained carries the word FLADEN FLOATS
- *Ms Wilson:* A statement that the above are Drennan’s products.
- As highlighted in my evidence summary, Ms Wilson provided a Google search report for CRYSTAL FISHING FLOATS which, in addition to a number of references to Drennan, there were references to: “Baggin Machine Fat Boy Crystal Float set”, “50x CRYSTAL WAGGLER FLOATS”, “10x Crystal Wagglers Fishing Floats” and one “Delos float box filled with 20 loaded crystal wagglers”.
- Mr Partner, Mr Bowler and Mr Doughty all attest to their knowledge of the word CRYSTAL being used by Drennan and that they “associate” the word with them.

40) From an inherent point of view the word CRYSTAL has no obvious link of meaning with fishing floats. It may be suggestive of floats that are crystal clear, but it would not be a usual use of language to abbreviate such a description to CRYSTAL. Neither is it likely (and there is no evidence to suggest otherwise) that the floats are made from crystal. In terms of the evidence, there is little use by others. The box with the word FLADEN FLOATS is said by Ms Wilson to contain Drennan’s products. This is not implausible and without a better understanding coming from Mr Reade’s evidence as to the actual content then this evidence is not particularly convincing. In terms of Ms Wilson’s Goggle search results, without seeing the web pages that underpin the search results, and also knowing its geographical significance, there is little I can take from this. The manner of use set out in Drennan’s evidence is somewhat unusual. The word CRYSTAL is certainly not the primary brand, and the word is used in different ways (e.g.

INSERT CRYSTAL(S), CRYSTAL WAGGLERS). There is, though, no evidence that this type of use will be perceived by the average consumer as some form of description. Mr Partner, Mr Bowler and Mr Doughty would “associate” the word CRYSTAL with Drennan, particularly its floats. This is not quite the same, however, as saying that the word is Drennan’s trade mark. That being said, there is nothing in their evidence which leads to me to conclude that the average consumer would perceive the word CRYSTAL as anything other than designating Drennan’s product. **In relation to fishing floats, the word CRYSTAL has no generic or descriptive qualities.**

Use in relation to hooks

- *Mr Reade*: Packaging showing use of the words:

Mustad Crystal;

Mustad Crystal Chub;

Crystal Match (produced, according to the packaging, by VMC);

Cristal Bleu (produced, according to the packaging, by VMC);

Cristal Rouge (produced, according to the packaging, by VMC);

A print of a web page of the retailer Decathlon showing:

CAPERLAN RED CRYSTAL HOOK;

VMC Crystal Blue Hooks;

Prints from the website *Mullakeys Direct* (which appears to be an angling retailer) for various Preston hooks which refer to “crystal Bend”;

There is also an extract from Mustad’s catalogue (which is said to date from 1980) with a page dedicated to “Crystal Hooks”.

- *Ms Wilson*: A statement that CRYSTAL BEND is a term of art to describe a type of bend in a hook (the other common bend being a round bend). She says that on occasion anglers may abbreviate crystal bend to just crystal. Drennan accepts that:

““crystal” in the context of the term “crystal bend” has a descriptive meaning in relation to hooks alone”

A statement that when the word CRYSTAL is used on Mustad’s (which she highlights as a Norwegian manufacturer) products anglers would know

that this related to the type or pattern of hook, but the word has no meaning in relation to any other type of tackle.

41) Again, there is no obvious inherent meaning in relation to the word CRYSTAL. Nevertheless, it is Drennan's own evidence that the word has meaning stemming from the known designation CRYSTAL BEND. Drennan's evidence refers to the use it has made of the word CRYSTAL as part of the name SPECIMEN CRYSTAL, however, it is not clear when this took place or the extent to which this has been used. **In relation to hooks, the word CRYSTAL will be perceived by the average consumer as an abbreviation for CRYSTAL BEND, a designator of the shape/pattern of the hook.**

Use in relation to flies/lures

- *Mr Reade*: A print of a web page of the retailer Decathlon showing what appears to be a lure (the picture is unclear) called the Flashmer Crystal Laser 9cm;

Two prints from *Mullakeys Direct* the first for a product called "Shakespeare Fly Selection No.12 Buzzers" which contains "one of each of the following patterns – hook sizes also list" which includes an "Olive Crystal – Hook size 12" and a "Red Crystal – Hook size 12"; the other flies in the pack are "Black Glow Buzzer", "Orange Glow Buzzer", "Black", "Olive" and "Bung Booby Orange". The second print relates to "Scierra Muddlers – pack of 5" one of which is referred to as "Black Crystal Mini" and another "White Crystal Mini" (the others in the pack are "Whisky Mini", "Minnow Standard" & "Yellow Marabou");

- *Ms Wilson*: A statement that the reference to "black/white crystal mini" is a reference to the hook (crystal hook) that the flies are on. There is no reference to the olive crystal and red crystal in relation to the Shakespeare flies but I assume the same inference would be drawn.

42) Mr Reade's evidence is from web pages so it at least shows actual commercial use. However, the degree to which the use was made before the date on which Drennan applied for its mark is not possible to ascertain. Furthermore, if the use is said to designate something it is difficult to see what it is designating. Millrace claims that the word CRYSTAL designates clarity and transparency. The flies/lures in question are difficult to see, but they do not appear to be clear or transparent. Ms Wilson suggests that the use of the word CRYSTAL indicates the shape of the hook on which the fly sits. Whilst this is not implausible, I do not consider that this is clearly the case, particularly when one bears in mind the other names of flies in the pack which do not refer to any hook shape. That being said, I am not persuaded that the word CRYSTAL designates anything in particular in relation to flies/lures. The word may simply have been

chosen as part of a quirky name and such use is not overwhelming. **In relation to flies/lures, the word CRYSTAL has no generic or descriptive qualities.**

Use in relation to fishing Line

- *Mr Reade*: Packaging (which is said to be used on the Internet by a number of UK distributors) showing the words:

“SAKUMA Nite Crystal”;

“Crystal Line” produced by “Tuff Stuff Unlimited”;

“PE Crystal” produced by “Cortlane”;

2 examples of “Crystal Line” which is “made in Germany for Mikadu”;

“PLINE X-TRA STRONG Crystal Clear”;

“Berkley Crystal FireLine MICRO ICE” & “Berkley Whiplash Crystal”.

- Ms Wilson responds by stating:

That the Crystal Line made by Tuff Stuff Unlimited is manufactured in the USA;

That the Crystal Clear fishing line is made by PLINE of California and the designation is, she states, arguably a descriptor for transparent fishing line (i.e. it is crystal clear);

That the uses by Berkley constitute unauthorized use of its mark in the UK and that it has launched opposition proceedings against the corresponding trade marks. From the submissions, it is clear that these opposition proceedings are no longer ongoing, an agreement being reached with Drennan permitting Berkley “restricted use of the mark CRYSTAL (with other matter) in limited circumstances in the UK”.

43) The matter must be judged from the perspective of the UK average consumer. Although Mr Reade states that the evidence he provides is of indicative use on the Internet by a number of UK distributors, it is not possible to ascertain the degree to which the packaging has been encountered by the average consumer. Ms Wilson highlights that TUFF STUFF UNLIMITED and PLINE are based overseas. Whilst this far from precludes the possibility that the products bearing the packaging have been used extensively enough in the UK to have had an impact on the average consumer, the fact remains that the tribunal has simply not been fully informed of the position. Is it not as though the prints have been taken from the websites of fishing tackle retailers or suppliers. This

reduces the reliability and significance of the evidence. In relation to the PLINE STRONG Crystal Clear product, I agree with Ms Wilson that this has little relevance as the use of CRYSTAL CLEAR is different from CRYSTAL on its own, the former sending a clearer descriptive message. I am left with five other uses, two of which Drennan say they now authorize, but all have an unspecified significance. It is not clear from any of the documentation provided that the word CRYSTAL is used as an actual designator. It may be being used in a trade mark sense. Mr Reade could, of course, have obtained support for his line of argument from other people in the trade but has not done so. Drennan, on the other hand have provided evidence from the trade and although it is not wholly convincing, none have highlighted that CRYSTAL has a designatory (in a descriptive sense) capacity. **In relation to fishing line, the word CRYSTAL has no generic or descriptive qualities.**

Comparison of the marks

44) The marks to be compared are:

liquid crystal

and

CRYSTAL

45) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

46) Drennan's mark consists of the word CRYSTAL alone and, so, it is its only component. In relation to Millrace's mark, the words LIQUID CRYSTAL hang together (liquid crystal being a known term) with neither element performing an independent distinctive role. Because of the known meaning I do not consider that either element dominates the other.

47) From a visual perspective, both words contain the word CRYSTAL so there is, as Millrace appears to concede in its submissions, a degree of similarity. The point of similarity is at the end of the LIQUID CRYSTAL mark, but as both elements of the mark have an equal prominence this factor is not significant.

Millrace's earlier mark is in a stylised lower-case script, but it is fairly unremarkable and does little in terms of creating a difference. I consider there to be a reasonable, neither high nor low, degree of visual similarity. This degree of similarity follows through to the aural assessment for similar reasons.

48) In terms of concept, for a conceptual meaning to be relevant it must be one capable of immediate grasp². The word CRYSTAL has an obvious meaning. A crystal is an ordinarily solid, naturally occurring substance. It is often made into something, often of a decorative nature. LIQUID CRYSTAL, on the other hand, is a liquid substance that has crystalline characteristics. The average consumer is likely to be aware of its use in liquid crystal displays (e.g. a type of television/monitor). The concepts are not identical or shared.

The distinctiveness of the earlier mark

49) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The position must be judged in relation to the goods of the earlier mark, namely fishing floats. From an inherent perspective the word CRYSTAL has, as stated earlier, a degree of suggestiveness relating to being crystal clear. Nevertheless, I still regard the word to be at least averagely distinctive. In relation to the use made, whilst I have commented that the use of the word is somewhat unusual in nature, it is also clear that the mark has been used for some time and to a significant extent. The evidence of so-called indicative use has done little to undermine this. I also have evidence from Mr Partner, Mr Bowler and Mr Doughty attesting to the reputation of the mark. For all these reasons, I conclude that the mark, in relation to floats, is a mark of a high degree of distinctive character.

Conclusions under section 5(2)(b)

50) It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that 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.

51) I will consider the position firstly in relation to Millrace's specification as it now stands which, given that it covers floats, must be considered to be identical to the specification of the earlier mark. The marks have a reasonable degree of visual and aural similarity. The concept is not shared, but I must bear in mind that

² This is highlighted in numerous judgments of the GC and the ECJ including *Ruiz Picasso v OHIMi* [2006] e.c.r. –I-643; [2006] E.T.M.R. 29.

although conceptual differences may counteract aural and visual similarity, such similarity is not always trumped as per the judgment of the GC in *Nokia Oyj v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-460/07*:

“66 Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

52) The earlier mark is highly distinctive. I must bear in mind the concept of imperfect recollection. Even though the differences between the marks and their concepts may assist in avoiding the marks being imperfectly recalled as each other, the purchasing process being reasonably considered further assisting, this does not rule out the possibility that the average consumer may nevertheless believe that the goods sold under the respective marks are the responsibility of the same or a related economic undertaking. Therefore, whilst I do not rule out altogether the possibility of the marks being directly confused, I consider the stronger case to lie with what is often known as indirect confusion. The question is whether the average consumer will put the common presence of the word CRYSTAL down to co-incidence or to economic connection. I come to the view that the latter, economic connection, is the likely reaction. In my view the average consumer will understand LIQUID CRYSTAL to be a new line or range of the CRYSTAL products produced by Drennan. This is particularly so when one bears in mind the distinctiveness of the earlier mark through its use. The finding of indirect confusion is certainly how Messrs Partner, Bowler and Doughty saw it. Whilst I do not base my findings solely on their evidence, it at least supports my view of the matter. **The opposition succeeds in relation to floats and, consequently, in relation to the specification as it now stands.**

53) I have, though, made assessments in relation to other types of fishing tackle as set out in Millrace’s evidence. I should say something about these. In relation to hooks, I take the view that the average consumer will perceive the use of the word CRYSTAL in LIQUID CRYSTAL to be a reference to the shape or pattern of the hook. For this reason the average consumer will not believe that the LIQUID CRYSTAL hook is from the same economic undertaking as the CRYSTAL floats. **There would be no likelihood of confusion in relation to fishing hooks.** In relation to the other types of fishing tackle, particularly lines, lures and flies, I have found that the word CRYSTAL has no meaning to the average consumer in relation to such goods. I consider the high degree of similarity between the goods, coupled with the reasonable degree of visual and aural similarity between the marks, will be put down to economic connection (at least in the indirect sense described earlier), particularly, again, when the reputation of Drennan’s mark is borne in mind, even if such reputation is only in relation to floats. **There is a**

likelihood of confusion in relation to other types of fishing tackle, apparatus etc.

54) Other than fishing hooks, the opposition under this ground succeeds.

Other grounds of opposition

55) It is not considered that the claim under section 5(4)(a) is materially different to that under section 5(2)(b). The outcome would be the same if I were satisfied that Drennan had the required goodwill. Furthermore, under section 5(3) I do not consider that Drennan is in any better position. It has succeeded except in relation to fishing hooks. In that respect, given my earlier comment that the average consumer would, in relation to fishing hooks, see the word CRYSTAL in LIQUID CRYSTAL as designating a type of hook, then a link would not be made between that and the floats sold by Drennan under the Crystal name. For these reasons I do not consider it necessary to deal with the other grounds of opposition.

Effect of my decision

56) As stated earlier, Millrace has not put forward a revised specification. However, as I found that there would be no likelihood of confusion between Millrace's mark used upon fishing hooks and Drennan's mark used on fishing floats, then it would be wrong to refuse the application for such goods. Millrace's application will be limited to "fishing hooks" and will stand as refused for everything else.

Costs

57) Drennan has been largely successful and, so, is entitled to a contribution towards its costs. I have though made a small reduction from what I would otherwise have awarded had Drennan been completely successful. I hereby order Millrace Marketing Ltd to pay Drennan International Limited the sum of £1400 which is calculated as follows:

Preparing a statement and considering the other side's statement
£350

Opposition fee
£200

Filing evidence and considering Millrace's evidence
£450

Written submissions
£400

58) 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 20th day of July 2011

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