

O-325-14

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2651081  
BY WHYTE AND MACKAY LIMITED  
TO REGISTER THE TRADE MARK  
JURA ORIGIN  
IN CLASS 33  
AND**

**IN THE MATTER OF CONSOLIDATED OPPOSITIONS  
THERE TO UNDER Nos. 400339 and 400340  
BY ORIGIN WINE UK LIMITED & DOLCE CO. INVEST LIMITED**


## BACKGROUND

1) On 06 February 2013 Whyte and Mackay Ltd (hereinafter the applicant) applied to register the trade mark **JURA ORIGIN** in respect of the following goods in Class 33: Scotch whisky and Scotch whisky based liqueurs produced in Scotland.

2) The application was examined and accepted, and subsequently published for opposition purposes on 1 March 2013 in Trade Marks Journal No. 6981.

3) On 30 May 2013, Origin Wine UK Limited and Dolce Co. Invest Ltd (hereinafter the opponents) filed notices of opposition. The grounds of the oppositions are in summary:

a) The opponents are the proprietors of the following trade marks:

Mark	Number	Date of application / registration	Class	Specification relied upon
ORIGINS	2275969	22.07.01 / 28.12.01	33	Alcoholic beverages (except beers); wine.
ORIGIN	2307360	06.08.02 / 04.04.03	33	Wines; alcoholic beverages.
	CTM 9065384	29.04.10 / PENDING	33	Alcoholic beverages (except beers), including wines.

b) The opponents rely upon their three marks above and contend that the mark in suit is confusingly similar to their trade marks and that the goods are identical or similar. The mark in suit therefore offends against Section 5(2)(b) of the Act.

4) On 9 August 2013 the applicant filed counterstatements denying all the grounds. They put the opponents to strict proof of use. As Dolce Co. Invest Ltd is an associated of Origin Wine Ltd a request was made to consolidate the cases to which the Registry agreed. On 12 February 2014 the cases were consolidated.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. The matter came to be heard on 11 June 2014 when the opponents were represented by Mr Stobbs of Messrs Stobbs; the applicant was represented by Ms Shah of Messrs Murgitroyd & Company.

## OPPONENTS' EVIDENCE

6) The opponents filed a witness statement, dated 3 October 2013, by Yves Bernard Adrien Fontannaz, a Director of Origin Wine Ltd. He states that his company constitutes the UK sales arm of the larger Origin Group founded in South Africa in 2002. The group provides a holistic service and manages the entire supply chain for its clients, from wine making, treating, blending, analysis, bottling and label design and processes up to 80

million litres of wine every year. He states that the group also develops, produces and trades in wine products under its own trade marks and those of its clients. On 21 December 2009, his company took assignment of the Origin trade marks from First Quench Retailing Ltd (FQR), the assignment being recorded by the IPO on 19 January 2010. FQR trading as Threshers and Wine Rack in the UK launched ORIGIN wine in February 2003 and continued to trade under the mark until it went into administration in 2009. This is confirmed by various press articles at exhibits YF3-YF8 inclusive. Since taking over the trade marks the opponents have since October 2012 sold their ORIGIN wine throughout the UK via a contract with Tesco. This is confirmed by exhibit YF9 which is a press article, dated 30 April 2013 which refers to an award presented by Tesco to the opponents in relation to events in 2012. The article mentions that nine of its own brands are on Tesco's shelves. At exhibits YF10 & 11 are extracts from Tesco online dated 16 September 2013 which shows two bottles of ORIGIN wine for sale. The label includes an image of South Africa and the wine is also clearly identified as South African. Mr Fontannaz states that during the period 17 October 2012 to 1 March 2013, the opponents sold £37,122 worth of Origin branded wine to Tesco. At exhibit YF13 he provides twelve invoices. Only four are dated prior to the relevant date (06.02.13), these show sales of £18,642 worth of ORIGIN Pinotage 2012 and Chenin Blanc 2012 between 17 October 2012 and 4 December 2012.

7) Mr Fontannaz states that in March 2012 he attended a trade fair in Germany and began discussions with a Canadian company in respect of them supplying Origin with Canadian Whisky branded under the ORIGIN name. This was launched at the Wine Fair in London in May 2013, with the first sales also starting in the same month.

## **APPLICANT'S EVIDENCE**

8) The applicant filed two witness statements by Jacqueline Ann Leek an Assistant Company Secretary of the applicant company, a position she has held since 1996. These statements were prior to the consolidation and apart from the dates the statements (23 December 2013 & 30 December 2013) and exhibits appear to be identical. She states that her company has used the mark JURA in relation to whisky since 1988. The whisky is produced on the island of Jura. The mark in suit is used on ten year old Jura whisky, the youngest JURA whisky. The name celebrates the beginning (origin) of the revival of the Jura distillery. She states that JURA 10 year old whisky has won numerous prizes, and that the mark JURA is well known in the industry and also to the general public. She provides the following turnover figures for JURA 10 year old whisky in the UK:

Year	Turnover £million
2008/09	3.5
2009/10	4.4
2010/11	5.7
2011/12	7.0
2012/13	4.9

9) Ms Leck states:

“13. As a result of the company’s continuous use of the mark JURA, the public will immediately recognise products bearing the mark JURA as originating from Whyte and Mackay Limited. Such recognition extends to all of our JURA extensions, namely JURA SUPERSTITION, JURA PROPHECY and JURA DIURACHS’ OWN, and the mark that is subject of this application JURA ORIGIN.”

And:

“15. I have demonstrated that the company’s reputation in the mark JURA in the UK and throughout the world is so significant that the average consumer will immediately recognise that whisky products bearing the mark JURA emanate from the company.

16. I have demonstrated that the inclusion of ORIGIN in the JURA ORIGIN mark has significant meaning in distinguishing 10 year old JURA from other JURA offerings.”

10) She provides the following exhibit:

- JAL01: At page 7 is a photograph of the various JURA whiskies named in paragraph 9 above. In all cases the word JURA is prominent and is considerably larger than the additional word (Prophecy, Superstition etc) which is printed underneath the word JURA. On the neck label the word JURA is easily read but the word “Origin” is virtually invisible due to its comparative size. The wording under the picture refers to “Origin” being the whisky that began the story.

11) That concludes my summary of the evidence filed, insofar as I consider it necessary.

## **DECISION**

12) The only ground of opposition is under Section 5(2)(b) which 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.”

13) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

14) The opponents are relying upon their trade marks listed in paragraph 3 above which are clearly an earlier trade mark. The applicant requested that the opponents provide proof of use. Given the interplay between the dates that the opponents' marks were registered and the date that the applicant's mark was published, it is entitled to request such proof in respect of two of the marks (2275969 & 2307360) as per Section 6A of the Act which states:

“6A Raising of relative grounds in opposition proceedings in cases of non-use.

(1) This section applies where-

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

- (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

15) I must first consider whether the opponents have fulfilled the requirement to show that genuine use of their marks has been made. In the instant case the publication date of the application was 1 March 2013, therefore the relevant period for the proof of use is 2 March 2008 – 1 March 2013. I bear in mind the leading authorities on the principles to be applied, namely: the judgments of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 (“*Ansul*”) and *Laboratoire de la Mer Trade Marks C-259/02* (“*La Mer*”). In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch), Arnold J commented on the case-law of the CJEU in relation to genuine use of a trade mark:

“In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

“(1) Genuine use means actual use of the mark by the proprietor or a third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely 'token', which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider*, [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22]-[23]; *Sunrider*, [70]-[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no *de minimis* rule. Even minimal use may qualify as genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]”

16) I also take note of the comments of Mr Daniel Alexander Q.C sitting as the Appointed Person in *PLYMOUTH LIFE CENTRE* BL/O/236/13 [2013] RPC 34 where he commented at paragraphs 17-22:

“17. Just as wide specifications give rise to problems, so does generalized and non-specific evidence seeking to support wide specifications once challenged for non-use. That is particularly so given the approach that tribunals must take to the issue of proof of use in the case of such specifications. Tribunals considering the issue of what use has been proven and what specification is appropriate in the

light of such use apply the principles summarized in *NIRVANA O/262/06*. In that case, the Appointed Person (Mr Richard Arnold QC) set them out as follows at [58]-[59]:

“I derive the following propositions from the case law reviewed above:

(1) The tribunal’s first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].

(2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].

(3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].

(4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].

(5) In order to decide what is a fair specification, the tribunal should inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

(8) The exercise of framing a fair specification is a value judgment: *ANIMAL* at [20].

59. I would add a point which in my judgment is implicit in most of the decisions, although not explicit, which is that it is for the tribunal to frame a fair specification and not the parties.”

18. Arnold J returned to this topic recently in *Stichting BDO & Ors v BDO Unibank, Inc & Ors* [2013] EWHC 418 (Ch) and considered the extent to which the *NIRVANA* approach might be said to differ from that adopted by the CFI. Having set out the *NIRVANA* approach, he said at [56]-[58]:



56. In *EXTREME Trade Mark* [2008] RPC 2, again sitting as the Appointed Person, I considered the decision of the CFI in Case T-256/04 *Mundipharma AG v OHIM* [2007] ECR II-449 and continued as follows:

"54. Although at first blush this suggests an approach which is somewhat different to that laid down by the English authorities considered in *NIRVANA*, I consider that the difference is smaller than might appear. The essence of the domestic approach is to consider how the average consumer would fairly describe the goods in relation to which the trade mark has been used. Likewise, paragraph [29] of *Mundipharma* indicates that the matter is to be approached from the consumer's perspective.

55. To the extent that there is a difference between them, I remain of the view expressed in *NIRVANA* that I am bound by the English authorities interpreting section 46(5) of the 1994 Act and Article 13 of the Directive and not by the CFI's interpretation of Article 46(2) of the CTM Regulation since, as already noted above, there are differences between the two legislative contexts. Nevertheless I consider that English tribunals should endeavour to follow the latter so far as it is open to them to do so. *Mundipharma* suggests that, within the spectrum of domestic case law, the slightly more generous approach of Jacob J. in *ANIMAL Trade Mark* [2003] EWHC 1589 (Ch), [2004] FSR 19 is to be preferred to the slightly less generous approach of Pumfrey J. in *DaimlerChrysler AG v Alavi* [2001] RPC 42."

57. In *Daimler AG v Sany Group Co Ltd* [2009] EWHC 1003 (Ch), [2009] ETMR 58 Geoffrey Hobbs QC sitting as a Deputy High Court Judge summarised the correct approach at [10] as follows:

"... the aim should be to arrive at a fair specification by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify. ..."

58. As Mr Hobbs added when sitting as the Appointed Person in *Euro Gida Sanayi Ve Ticaret Ltd v Gima (UK) Ltd* (BL O/345/10) at 11:

"For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient

use of the trade mark on the market concerned (to use the words of *Anheuser-Busch* – see above)

20. Providing evidence of use is not unduly difficult. If an undertaking is sitting on a registered trade mark, it is good practice in any event from time to time review the material that it has to prove use of it. Courts and tribunals are not unduly harsh as to the evidence they are prepared to accept as establishing use. In *Almighty Marketing Ltd. v Milk Link Ltd.* [2005] EWHC 2584 (Ch) (18 November 2005) a case primarily concerning the requirements of rule 31 of the Trade Mark Rules which require a proprietor to show prima facie use at the first stage of proceedings, Kitchin J (as he then was) analysed the requirements of evidence of use by reference to the authorities and said:

17. In *Carte Bleue Trade Marks* [2002] RPC 31 Mr. Knight, the principal hearing officer acting for the registrar, observed at paragraph 35:

"Therefore it seems to me that the Act and the Rules indicate that at least initially the registered proprietor in seeking to defend himself against an allegation of non-use need only show use at the outset which indicates clearly to those concerned that a proper defence is, and can be, mounted in relation to the allegation that the trade mark has not been used."

If, in using the expression "proper defence", the hearing officer meant an arguable defence then I respectfully agree with him. After referring to another decision by one of the registrar's hearing officers in *Adrenalin* [O/BL336/99] he continued, at paragraph 37:

"From my point of view I would simply reinforce what has been said in these decisions and in the Manual, that the sort of evidence that one would normally hope to see is copies of brochures, catalogues, pamphlets, advertisements, etc all of which show use of the trade mark in question together with some indication of the sales of goods, or the provision of services during the relevant periods. Clearly this cannot be an exhaustive list and is merely an example of documents which might be sent in."

I agree with the hearing officer that evidence of this kind is highly desirable. If the proprietor files such evidence it will assist in clarifying the issues at an early stage and may even serve to shorten the proceedings. It is not, however, a requirement of rule 31(3). If the proprietor is able to establish that it has an arguable defence to the application without filing such evidence then, in my judgment, it is not obliged to do so.

21. Having considered the evidence and the observations of the Hearing Officer, Kitchin J continued:

22. In my judgment the hearing officer fell into error...in seeking to apply the decision *Carte Bleue* as if it were laying down a code as to the specific documentary evidence which must be filed in order to satisfy rule 31(3). In particular, and as is apparent from paragraph 25 of the decision, he appears to have been of the view that it was incumbent upon the appellant to provide information such as brochures, catalogues, pamphlets, advertisements or the like together with an indication of the sales of goods achieved under the mark during the relevant period. There is no requirement upon the proprietor to provide such information although it may be desirable for him to do so. The rule only requires that the evidence, considered as a whole, establishes that the proprietor has an arguable defence to the application for revocation.

22. The burden lies on the registered proprietor to prove use. However, that and other cases show that there is no particular way in which use must be established. At the initial stage of revocation proceedings, where all he has to show is an arguable case, the approach may be more relaxed but even when the matter comes to be finally determined there is also no hard and fast way in which use must be proved. Evidence which may be sufficient to establish an arguable case that there has been use for the purpose of rule 31 may be insufficient ultimately to prove that there has been such use on the balance of probabilities. However, it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more, so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

17) And continued at paragraphs 26 -

“26. A wide claim of use of the kind made by Ms Stanley is not straightforwardly false (since it might be said that the fact that some tuition, training are workshop services, however narrow, would form a basis for it). I am nonetheless of the view that broad conclusory statements of that kind in evidence of use should be avoided, unless they are properly justified.

27. This sort of thing is not unduly difficult to avoid, especially for represented litigants. The Rules of Conduct for Patent Attorneys, Trade Mark Attorneys and other Regulated Persons give guidance in paragraph 14 to the effect that a such persons must not submit orally or in any documents or pleading, inter alia, a) statements of fact or contentions that are not supported by the evidence or

instruction of the client; b) contentions that he cannot justify as prima facie arguable. So attorneys engaged in contested proceedings in which use is in issue will, in any event, be regularly turning their minds to the question of the supportability of claims of use as part of their professional obligations.

28. I do not know whether the evidence in this case was prepared with professional assistance and I make no criticism of those involved in this case. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted. Excising the unjustifiable is as much a part of the exercise of dotting the i’s and crossing the t’s of the evidence (referred to in *Laboratoires Goemar*) as is reinforcing the justified.

29. Second, in my view, the overall criticisms made by the Hearing Officer of this evidence were warranted.

30. Ordinarily, given that the use was relatively recent, one would expect general statements about use of the kind made by Ms Stanley to be backed up with detailed evidence of turnover in respect of each of the services in question identifying, with precision, the dates upon which such services were provided and the amount of trade conducted (or, in appropriate cases, the nature of the promotional activity). Or one would, at least, expect a cogent explanation for why such material was unavailable. In the case of potentially wide categories such as “Chinese medicine” and “nutritional treatments”, one would expect the evidence to descend into considerable detail as to the range of services offered to make it clear that a specification of that kind could be supported. One would expect itemized invoices or other financial records showing the volume of business in the specific areas so that it was possible properly to assess the nature of the use in its context. Although it is true that such material is not strictly necessary in that, in appropriate cases, a case will not automatically fail for the want of it, the failure to provide a cogent documented record where there is no real reason for not doing so is something the court can take into account.”

18) From the evidence it is clear that the opponents have only used its ORIGIN and ORIGINS marks upon wine within the specified period. The first use of the opponents’ marks on spirits was in May 2013 two months after the relevant period. **I therefore find that the opponents have only shown use of their registered marks in the UK on**

**wine during the relevant period. This finding was accepted by the applicant in their written submissions and at the hearing.**

19) When considering the issues under Section 5(2) and the likelihood of confusion, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd* [ALLIGATOR O/333/10] Mr Hobbs QC acting as the Appointed Person set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods/ services in question; who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;

(e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element in that mark;

(f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

(g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;

(h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;

(i) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

### **Distinctive character of the opponents' earlier trade marks**

20) The opponents have provided limited evidence of use of their registered marks in the UK. The turnover figures appear quite low and have not been put into context of the market. To my mind, the opponents' UK marks cannot benefit from an enhanced distinctiveness, although the marks have, I believe, a moderate level of inherent distinctiveness for the goods for which they are registered. No use of the CTM mark has been provided, and so it cannot benefit from an enhanced distinctiveness, although the mark has, I believe, a moderate level of inherent distinctiveness for the goods for which it is proposed to be registered.

### **The average consumer and the nature of the purchasing process**

21) I must now determine the average consumer for the goods of the parties and the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings in class 33 are alcoholic beverages, the average consumer for which will be the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18. All of the goods at issue may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self selection) and in public houses and restaurants (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar, menus etc.). When the goods are sold in, for example, public houses, the selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM), Case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant's

goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

22) Consequently, while the goods may be ordered orally in public houses and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. As to the level of attention the average consumer will display when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are likely, in my view, to pay a reasonable level of attention to the selection of the goods at issue.

**Comparison of goods and services**

23) For ease of reference I reproduce the specifications of both parties:

Applicant’s specification	Opponents’ specifications	
Class 33: Scotch whisky and Scotch whisky based liqueurs produced in Scotland.	2275969	Class 33: Wine.
	2307360	Class 33: Wines.
	CTM 9065384	Class 33: Alcoholic beverages (except beers), including wines.

24) The accepted test for comparing goods and services is that set out by Jacob J. in *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 28 TREAT, which was effectively endorsed by the Advocate General in *Canon*; ETMR 1. The factors to be taken into account are:

- a) The respective uses of the respective goods and services;
- b) The respective users of the respective goods and services;
- c) The physical nature of the goods and services;
- d) The respective trade channels through which the goods and 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 and 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 in the same or different sectors.

25) I also take into account the following guidance of the GC in *Gérard Meric v OHIM*, T-133/05:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

26) **Clearly, in respect of the opponents’ CTM 9065384 the specification encompasses the whole of the goods that the applicant seeks to register and so they must be regarded as identical.** Turning to the opponents’ other two marks the specification is restricted to wine whereas the applicant’s mark is for, broadly speaking, spirits.

27) The applicant referred me to OHIM's Opposition Decision No 958/1999 between *William Grant & Sons Limited and Glen Catrine Bonded Warehouse Limited* in which the Office stated the following:

"The applicant's goods "wines" and the opponent's "Whisky, gin and vodka" are similar to the extent that they are all alcoholic drinks and are sold in the same retail outlets. However, they are dissimilar in that they are produced by different kinds of undertakings. The opponent's goods are spirits, characterised by a high level of alcohol and are produced by distilleries. In contrast, wines are the result of the fermentation of grape juice and normally have a much lower alcoholic content. Wine and spirits have therefore different methods of production and different producers. These diversities in nature determine also diversity in use of the products in question. The use consumers make of wine is, in the grand majority of cases, not an alternative to gin or vodka. In Europe the two groups of products represent two different and, possibly, opposite traditions: one from northern Europe (Ireland and Scotland for whisky and gin, and Scandinavian countries for vodka); and one from southern Europe where the cultivation of grapes is predominant. This is still so deep-rooted in the respective traditions that nobody would normally think that the goods might have the same origin. For the same reason, their use is also traditionally so different that they are not seen as a substitute or as an alternative to each other. Therefore, they are not in competition with each other.


Consequently, in a balanced assessment, the elements of similarity between the goods are negligible when weighed up against those of dissimilarity."



28) Of course I am not bound by this decision, although I accept many of its points regarding the basic ingredients, different manufacturing processes, and the fact that the goods are not in direct competition. However, although there is no evidence regarding trade channels I am aware from my own experience that wines and spirits are sold through the same retail outlets, including public houses. Although they would not tend to be on same shelf they would be in close proximity as wines and spirits have to be grouped into an area that can be access restricted if required by the licensing laws. Clearly, whilst both are beverages they are not purchased in order to quench one's thirst; they differ considerably in their alcoholic strengths; they are not complementary or in competition with each other. Both do share a common characteristic in that they provide a relaxing and/or enjoyable drinking experience, at home or at a social gathering. The contention that wine makers do not normally produce spirits and spirit makers do not produce wine is one which I accept, although supermarkets may have their own brand out on a range of goods. **Considering the matter in the round it is my opinion that there is a low degree of similarity between the goods of the applicant and the goods of the opponents' marks 2275969 and 2307360.**

**Comparison of trade marks**

29) For the purpose of the comparison I regard 2275969 and 2307360 as being virtually identical. As 2307360 is for the singular version of the opponents' mark this is slightly stronger than the plural form and therefore will be the version I use in the comparison test along with the opponents' CTM mark. At the hearing Mr Stobbs accepted my view. For ease of reference the marks of the two parties are as follows:

Applicant's Mark	Opponents' Marks
<p><b>JURA ORIGIN</b></p>	<p>CTM 9065384</p> <div style="text-align: center;">  <p><b>ORIGIN</b><sup>®</sup></p> <p>W I N E</p> </div> <p>2307360: <b>ORIGIN</b></p>

30) In considering the marks I take into account the following paragraphs of the *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* [C-120/04] case which read:

“[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.”

31) And also Case T-6/01 *Matratzen Concord GmbH v OHIM* where the GC stated:

“A complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the complex mark. That is the case where that component is likely to dominate, by itself, the image of that mark which the relevant public keeps in mind, with the result that all the other components of the mark are negligible within the overall impression created by it.”

32) I shall first compare the opponents’ UK mark 2307360 to the mark in suit. The opponents contend:

“In relation to the comparison of the marks, the comparison is very straightforward. In the case of the Opponents’ earlier ORIGIN mark it is contained in its entirety in the JURA ORIGIN mark, and the majority of the analysis identified above in relation to the Opponents’ Community Trade Mark applies in relation to this comparison also, but more so. Bearing in mind the clear house mark sub-brand approach in the JURA ORIGIN mark, the analysis is clear, the marks are similar, and the analysis in the Medion case will clearly apply.”

33) The applicant contends that:

“The link between the two words of WML’s marks is however important. ‘JURA ORIGIN’ hangs together, because the purpose of the word ORIGIN is to provide information as to one particular characteristic of WML’s well known JURA mark. The word ORIGIN merely gives WML’s JURA element context. It explains to a consumer the particular nature of the JURA whisky provided. The word ORIGIN is thus descriptive in the context of WML’s mark.”

34) At the hearing Ms Shah for the applicant also stated:

“So when you look at how the mark is used you see that it is "Jura Origin" underneath "10 years". Now, 10 years is the age of the whisky so, therefore, the use of "Origin" is in a descriptive way to show that it is a 10 year whisky.”

And:

“No, it is when you look at the mark in its totality, Jura Origin will indicate that it is a brand of Jura and that because of the way it is underneath....”

And:

“MS. SHAH: No. The evidence is to show that the JURA mark is known, is recognised within the whisky industry.

THE HEARING OFFICER: Right, so you have used Jura, you have got Jura well-known and distinctive and then you have a number of sub-brands of Jura?

MS. SHAH: Yes, we have a number of products that are Jura products, yes.

However, we do... but those marks are different to what we have at the moment.

So, therefore, that is why we request that each case is looked at on its own merits.

THE HEARING OFFICER: Certainly.”

35) From the evidence and the written and oral comments by the applicant it is clear that the applicant uses the brand JURA as its “house” or “lead” brand and then has a number of sub brands which designate the age of the whisky to be found inside the bottle and/or different blends. Ms Shah describes the word “origin” in the applicant’s mark as descriptive. However, the average consumer would not immediately be aware that the term refers to a 10 year old scotch, they would have to be educated into this and there is no evidence that this is the case. Similarly, if the consumer were aware that JURA is an island in the Southern Inner Hebrides then the term “origin” would suggest that the contents of the bottle upon which the mark is used was produced on the island. However, there is no evidence that consumers are aware of the existence of the Isle of Jura. To my mind, the dominant element in the applicant’s mark must be the word JURA, however the word “origin” is an independent and distinctive element. The two words only “hang together” if one is educated into the existence of the Isle of Jura. The word “origin” is clearly used as a sub-brand by the applicant as the applicant itself has acknowledged. In my opinion, although there are obvious differences between the marks of the two parties, the whole of the opponent’s mark has been subsumed into the applicant’s mark with a “house” brand simply placed in front. The opponent’s mark 2307360 is at least moderately similar to the mark in suit.

36) Moving onto consider the opponent’s CTM 9065384 much the same contentions apply. The leaf device is eye catching but it will not form any part of aural or conceptual considerations, and leaf devices upon alcoholic beverage labels are commonplace, such that they largely go unnoticed. Even if the device element were seen as distinctive it cannot be verbalised. The only other difference is the presence of the word “wine” in the opponent’s mark. The applicant contended that use of this mark upon anything other than wine would be deceptive. However, this is not a line of defence open to them. I accept that it will cause the average consumer to pause if the mark is used on whisky however, it would probably be quickly rationalised by the consumer as being a reference to the producer “Origin Wine” and not a description of the contents. I come to the conclusion that there is a moderate degree of similarity between the opponent’s mark 9065384 and the mark in suit.

## Likelihood of confusion

37) I must now take all the above into account and consider the matter globally taking into account the interdependency principle- a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods and vice versa. The evidence does not allow me to find the opponents to have a reputation in any of their marks, although I do consider them to have a moderate level of inherent distinctiveness for the goods for which they are registered / applied for. I have found that the opponent's marks are moderately similar to the mark in suit. In the case of marks 2307360 and 2275969 I found that the goods had a low degree of similarity. In respect of the opponent's CTM 9065384 the specification, if approved by OHIM would be identical to the applicant's registered specification.

38) In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

39) To my mind, when considering the opponents’ marks 2307360 and 2275969 to the mark in suit despite the goods only having a low degree of similarity I believe that the marks are sufficiently similar that the average consumer would be directly confused. However, in case I am wrong on this it is also my view that, should the average consumer not mistake the marks for each other, the similarities in the marks and goods are such that the it would lead the average consumer into believing that the applicant and the opponent are commercially linked and they are likely to assume that the products produced under the application have a common origin to those produced under the earlier mark. The situation is stronger in respect of the opponents’ CTM 9065384 in that the goods are identical and the marks have a degree of similarity such that the average consumer would be directly confused. Again should the average consumer not mistake the marks for each other, the similarities in the marks and goods are such that the it would lead the average consumer into believing that the applicant and the opponent are commercially linked and they are likely to assume that the products produced under the application have a common origin to those produced under the earlier mark. **The opponents therefore succeeds in full in respect of its marks 2307360 and 2275969 in respect of the ground of opposition under Section 5(2)(b). If the opponent’s application 9065384 at OHIM achieves registration for the terms I have relied upon in my comparison, then the opposition under Section 5(2)(b) will also succeed in full.**

## CONCLUSION

**40) The opponent has been fully successful in its opposition under Section 5(2)(b).**

## COSTS

41) As the opponent has been successful it is entitled to a contribution towards its costs.

Preparing a statement and considering the other side’s statement x 2	£600
Expenses x 2	£400
Preparing evidence and considering the evidence of the other side	£700
Preparing for and attending a hearing	£1000
TOTAL	£2,700

42) I order Whyte and Mckay Ltd to pay Origin Wine UK Ltd and Dolce Co. Invest Ltd the sum of £2,700. This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 23rd day of July 2014**

**George W Salthouse  
For the Registrar,  
the Comptroller-General**