

O-466-16

SUPPLEMENTARY DECISION

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3109363

BY RUSSELL SHARP

TO REGISTER THE TRADE MARK

CALEDONIAN

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION

THERE TO UNDER No. 405131 BY

SCOTTISH & NEWCASTLE LIMITED

BACKGROUND

1) It has been drawn to my attention that the decision issued in this matter on 6 September 2016 contained a typographical error. Specifically, paragraph 45 of the decision which read:

“45) Clearly, the opponent’s mark 2025620A is identical to the applicant’s mark. With regard to the applicant’s marks 2194365 and EU 10336972 these have as their dominant element the word CALEDONIAN albeit presented in a curved label as might be found on the neck of a bottle. Both marks contain slightly different images of buildings in the background but both are equally non-descript and likely to be mostly ignored as of no consequence by the average consumer. These two marks are therefore highly similar to that of the opponent. Lastly I turn to the opponent’s mark EU 10337004. This has as its first element the identical word to that of the applicant’s mark. It also has as its second element the numbers and symbols which most consumers would recognise as meaning “eighty shillings”. In my experience such an element was fairly common at one time on beers, being used as an indication that the beer was of greater strength and flavour, although today’s younger drinkers may be unaware of this meaning. Even so, the first element would indicate the origin of the product to the majority of consumers and so the mark must be regarded as highly similar to the applicant’s mark. **In conclusion, 2025620A is identical to the applicant’s mark, whilst 2144365, EU 10336972 and EU 10337004 are all highly similar to the applicant’s mark.**”

should have read:

“45) Clearly, the opponent’s mark 2025620A is identical to the applicant’s mark. With regard to the opponent’s marks 2194365 and EU 10336972 these have as their dominant element the word CALEDONIAN albeit presented in a curved label as might be found on the neck of a bottle. Both marks contain slightly different images of buildings in the background but both are equally non-descript and likely to be mostly ignored as of no consequence by the average consumer. These two marks are therefore highly similar to that of the applicant. Lastly I turn to the opponent’s mark EU 10337004. This has as its first element the identical word to that of the applicant’s mark. It also has as its second element the numbers and symbols which most consumers would recognise as meaning “eighty shillings”. In my experience such an element was fairly common at one time on beers, being used as an indication that the beer was of

greater strength and flavour, although today's younger drinkers may be unaware of this meaning. Even so, the first element would indicate the origin of the product to the majority of consumers and so the mark must be regarded as highly similar to the applicant's mark. **In conclusion, 2025620A is identical to the applicant's mark, whilst 2144365, EU 10336972 and EU 10337004 are all highly similar to the applicant's mark."**

2) The error is plainly an irregularity in procedure and capable of being corrected under Rule 74. Consequently, I give the parties notice that paragraph 45 of the decision will be amended to the version shown above and apply as though that paragraph had appeared in the original version of the decision.

3) My comments in paragraph 49 have also been questioned as I referred to use of the opponent's mark on a bottle of spirits. It has been pointed out that they do not use their mark on spirits, however a number of the opponent's marks are registered for "alcoholic beverages" in class 33. Lastly, the issue of such goods being sold in supermarkets has been raised. Whilst the applicant has stated that his goods will be not be sold in such retail outlets there is no restriction upon its application and so the applicant could have sold its goods through such outlets.

Dated this 4th day of October 2016

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