

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 700298 BY  
ZAKRITOE AKTSIONERNOE OBCHTCHESTVO ZAKRITOGO TIPA  
“TORGOVY” DOM POTOMKOV POSTAVCHTCHIKA DVORA EGO  
IMPERATORSKAGO VELITSCHESTVA P.A. SMIRNOVA TO REGISTER A  
MARK IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 70183  
BY UDV NORTH AMERICA INC**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. 700298 BY  
ZAKRITOE AKTSIONERNOE OBCHTCHESTVO ZAKRITOGO TIPA  
“TORGOVY” DOM POTOMKOV POSTAVCHTCHIKA DVORA EGO  
IMPERATORSKAGO VELITSHESTVA P.A. SMIRNOVA TO REGISTER A  
MARK IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 70183  
BY UDV NORTH AMERICA INC**

### **BACKGROUND**

1. On 21 September 1998, Zakritoe Aktsionerное Obchtchestvo Zakritogo Tipa “Torgovy” Dom Potomkov Postavchtchika Dvora Ego Imperatorskago Velitschestva p.a. Smirnova of Piatnitskaya, Moscow, Russia on the basis of a registration held in the Russian Federation, sought to extend protection to the United Kingdom of the trade mark shown, below under the provisions of the Madrid Protocol:

Торговый Домъ  
потомковъ  
Поставщика Двора  
Его Императорскаго Величества  
П.А.Смирнова  
у Чугуннаго моста въ Москве

2. The international registration is numbered 700298 and protection was sought in Class 33 in respect of “Alcoholic beverages”. The request was accepted under the provisions of The Trade Marks (International Registration) Order 1996. I note that the subsequent publication records that the transliteration of the mark is:

“Torgovy Dom Potomkov Postavchtchika Dvora Ego Imperatorskago Velitschestva P.a. Smirnova Ou Tchougounnago Mosta V Moskve” meaning “Trading Company and the supplier to the Court of His Imperial Majesty, P A Smirnov at the cast iron bridge in Moscow”.

3. On 19 October 1999, UDV North America Inc of Hartford, Connecticut, United States of America filed notice of opposition. The opponents say that they are the proprietors of a number of earlier trade marks (details of which can be found in Annex A to this decision) and that these have been extensively used by them or under licence on the goods covered by the registrations. All such use has, they say, accrued to the benefit of the opponents who have built up a substantial reputation and goodwill in the marks. The grounds of opposition

stemming from this background, are, as follows:

- S under section 56 of the Act, by virtue of the extensive use and reputation, the mark SMIRNOFF is entitled to protection under the Paris Convention as a well known trade mark;
- S under section 3(6) of the Act, in that the request to extend the protection of the international registration in suit was made in bad faith;
- S under Section 5(1) of the Act in that the international registration is identical to the opponents' registration Nos: 1295657 and 2045198 and covers identical goods;
- S under section 5(2) of the Act, as the international registration in suit is identical or similar to the opponents' earlier trade marks and covers identical and/or similar goods;
- S under section 5(4) of the Act, because use of the international registration in suit is liable to be prevented by the law of passing off.

4. The registered proprietors filed a counterstatement which answers these allegations on the same basis as the other various actions between the parties (see my decision in Nos 11286-11299) ie. that UDV' inherited a defective chain of title to the SMIRNOFF name and knew that to be the case at all material times.

5. Both sides seek an award of costs in their favour. Both sides filed evidence. The matter came to be heard on 24 and 25 April 2001, when the applicants were represented by Mr Michael Edenborough and Mr Simon Malynicz both of Counsel instructed by A1 Trade Marks & Service Marks. Mr James Mellor of Counsel instructed by Bristows appeared for the opponents.

## **THE EVIDENCE**

6. This consists of a number of witness statements and statutory declarations from both parties. I have already summarised the vast majority of this evidence in my decision in Nos 11286-11299 and do not intend to repeat it again here but it is attached as Annex B to this decision. That said, in these proceedings, the opponents also filed two additional witness statements.

7. The first dated 14 April 2000 is by Edwin Atkinson. Mr Atkinson explains that he is Director General of the Gin and Vodka Association of Great Britain. He adds that this body is an independent association of producers and traders of gin and vodka in the United Kingdom. He states that he is aware of the various products available in the vodka and gin markets in the United Kingdom and Europe. He adds that he is aware that SMIRNOFF is one of the world's leading brands of vodka. Exhibit EA1 of Mr Atkinson's declaration consists of a photograph of a bottle of SMIRNOFF RED LABEL. He observes that the label contains the Russian Cyrillic words CMHPOBCKAP BODKA which he is informed by the opponents' legal representatives means SMIRNOFF VODKA in English. Exhibit EA2 to his declaration consists of a copy of the application in suit. Mr Atkinson comments that as he does not

understand Russian or the Cyrillic alphabet and in the absence of a translation, he would have no idea what the words in the application mean. That said, he observes that the application includes the word CMNPHOBA which in his view is very similar to the word CMHPOBCKAR which appears on the SMIRNOFF vodka bottle. Exhibit EA3 consists of a copy of an English translation of the application in suit (obtained by the opponents legal representatives) which he notes includes a reference to P.A. Smirnov.

8. Mr Atkinson concludes his witness statement by commenting that in his view if vodka bearing the Russian Cyrillic wording contained in the application in suit was sold in the United Kingdom, it is likely, in practice, to be referred to as SMIRNOV or SMIRNOFF vodka (since this is the most readily understandable name by which such a product could be known), and that this would inevitably cause public confusion with the well known SMIRNOFF vodka sold by the opponents. The potential for confusion is, he says, reinforced by the fact that the application in suit, the Russian Cyrillic word CMNPHOBA, which is, in his view, virtually identical to the word CMHPOBCKAR which appears on the opponents' SMIRNOFF bottles.

9. The second witness statement dated 25 April 2000 is by Beverly Brozsely. Ms Brozsely explains that she is a Marketing Manager with United Distillers & Vintners Limited (hereafter UDV). She has held this position for twelve months having been with the company for approximately eight years. The information in her statement comes from her own knowledge and from the records kept by UDV and the advertising agencies which UDV employ.

10. Having referred to an earlier statutory declaration, (see Annex B) Ms Brozsely goes on to provide information which is not directly relevant to this set of proceedings.

11. That concludes my review of the evidence in so far as I think it necessary.

## **DECISION**

12. In my decision in No M656943, I dealt with all of the grounds pleaded in these proceedings (a copy of my decision in that case is attached as Annex C) with the grounds under Section 3(6), 5(1), 5(4)(a) and Section 56 dismissed. With the exception of the two witness statements mentioned above, the evidence was substantially similar to the evidence filed here.

13. Clearly the mark the subject of this application is significantly different to the mark in the proceedings mentioned above. I will return to this point (when considering the position under Section 5(2) of the Act) in more detail later in this decision. However, given the significant differences between the trade marks and bearing in mind my comments in relation to the grounds of objection under Section 3(6), 5(1), 5(4)(a) and Section 56 in the decision mentioned above, I do not think the opponents are in any better position under these headings in these proceedings and consequently they must fail.

14. That said, in No M656943 the opponents ultimately succeeded under Section 5(2)(b) of the Act (primarily) on the basis of their registration No: 2045198. For the sake of convenience the respective trade marks at issue in these proceedings are reproduced below:

**Applicants' mark**

Торговый Домъ  
потомковъ  
Поставщика Двора  
Его Императорскаго Величества  
П.А.Смирнова  
у Чугуннаго моста въ Москве

**Opponents' mark**

**СМИРНОВА**

15. The opponents' trade mark 2045198 dates from 17 November 1995 and is registered in respect of "Wines, spirits and liqueurs; all included in class 33". I do not propose to repeat either the statutory provisions of Section 5(2)(b) or Section 6(1) of the Act here, but it is clear that the opponents' mark constitutes an "earlier trade mark" within the meaning of Section 6 and that it stands registered for identical goods to the application in suit.

16. Similarly I do not propose to repeat here the standard judicial tests for determining if marks are similar within the meaning of Section 5(2) of the Trade Marks Act - but simply refer to points (a) to (i) of the decision indicated.

17. In reaching a conclusion under Section 5(2)(b), I pay due regard to the established principles referred to above. Whilst I note that when the trade mark was published the application included a transliteration clause which made reference to P A Smirnov, this transliteration clause is for information purposes only and will not form part of the mark if it is registered.

18. The trade mark the subject of the application in suit does include within it the opponents'

**СМИРНОВА**

trade mark. However appearing as it does on the fifth line (as the eleventh element) of the application (and unlike my decision in No M656943), I do not think it is (nor would in my view the average consumer) consider it to be the distinctive or dominant feature of the applicants' trade mark. Given that the average consumer in the United Kingdom is unlikely to be able to understand Cyrillic script, it is unlikely to be given any more significance than any of the other elements comprising the trade mark. The various elements would in effect simply be seen as devices. That being the case, in my view, the opponents' trade mark is "lost" within the totality of the applicants' trade mark and as such the two marks are in my view most unlikely to be confused. That being the case, the only ground of opposition which remains (based on Section 5(2)(b) of the Act) fails.

19. The applicants having been successful in these proceedings are entitled to a contribution towards their costs. I order the opponents to pay to the applicants the sum of £500. 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 23 Day of November 2001**

**M KNIGHT**  
**For the Registrar**  
**The Comptroller General**

**Annex A:** Order a copy  
**Annex B:** Order a copy  
**Annex C:** Decision 0/526/01