

O-153-03

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2263386
BY DHAMECHA FOODS LIMITED
TO REGISTER A TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER No. 90326
BY POL ROGER & CIE S.A.**

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Background

1. On 7 March 2001 Dhamecha Foods Limited applied to register the trade mark JEAN P. ROGER in Class 33 of the register for “Alcoholic beverages; wines, spirits, liqueurs, cocktails.”
2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 24 July 2001 Pol Roger & Cie S.A. filed a Notice of Opposition. In summary the grounds were:
 - (i) Under Section 5(2)(b) of the Act because the mark applied for is similar to the following earlier trade marks owned by the opponent which cover identical and similar goods and services and there exists a likelihood of confusion on the part of the public –

International Registration No.	Mark	Search Significant Date	Goods and Services
729697		13 October 1999	Class 32: Beer; mineral and sparkling water; soft drinks and preparations for making beverages (other than coffee, tea or cocoa-based, and milk beverages); fruit drinks and fruit juices; syrups. Class 33: Alcoholic beverages (except beer). Class 42: Hotel services; providing food and drinks; café, cafeteria and cocktail lounge services; videotape

			recording (filming); exhibition-site management.
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UK Registration No.	Mark	Registration Effective	Goods
90551		4 June 1989	Class 33: Champagne

(ii) Under Section 5(4)(a) of the Act by virtue of the law of passing off.

4. On 24 October 2001 the applicant filed a Counterstatement denying the above grounds and stating that the word ROGER is a common French surname. Both sides filed evidence and asked for an award of costs in their favour. The parties were content for a decision to be taken without recourse to a hearing.

Opponent's Evidence

5. This consists of three witness statements, two by Alastair John Rawlence dated 30 April 2002 and 30 July 2002 and one by Bill Gunn dated 25 July 2002.

6. Mr Rawlence is a trade mark attorney employed by Mewburn Ellis, the opponent's professional advisors in these proceedings.

7. Mr Rawlence commences his first statement by commenting that the opponent's mark POL ROGER was first used in the UK in respect of alcoholic beverages including champagne circa 1876 and has been in continuous use in the UK ever since. He refers to Exhibit AJR 1 attached to his statement, which consists of pages taken from the opponent's UK website and which refer to the opponent's long history, foundation and use in the UK of the POL ROGER champagne brand. Mr Rawlence goes on to state that sales of alcoholic beverages including champagne in

the UK under the POL ROGER brand have been substantial since the brand was first launched on the market and he provides the following figures for the volume of sales of champagne under the mark for the years 1997 – 2000:

Year	Volume (number of bottles sold)	Turnover
1997	170838	£3,345,800
1998	166490	£3,231,600
1999	228602	£4,098,400
2000	120725	£2,177,900

8. At Exhibit AJR to his statement Mr Rawlence attaches samples of invoices to show sales of champagne bearing the mark POL ROGER to UK customers.

9. Mr Rawlence turns to promotional activity and he states that the first UK advertisement for champagne under the POL ROGER mark was in 1880. He provides the following figures relating to advertising expenditure in the UK under the POL ROGER brand for the years 1997 to 2000:

Year	Approximate annual advertising Expenditure in the UK
1997	£127,000
1998	£148,000
1999	£239,000
2000	£181,600

10. In his second witness statement Mr Rawlence goes on to submit that the applicant's mark and the opponent's marks are visually, phonetically and conceptually similar, in particular because the marks share the element "ROGER" and are prefixed by elements beginning with the letter P ie. "P" and "POL" respectively. Mr Rawlence also states that while ROGER is claimed by the applicant to be a common French surname, common surnames (including English surnames) have become distinctive in the UK for a wide range of goods and services.

11. Next, Mr Rawlence draws attention to search results for the UK, CTM and Madrid databases for marks containing the element ROGER for goods in Classes 32 and 33 and services in Class 42. He states that the only third party marks identified were CTM Registration No. 14028981, JOLLY ROGER in Class 42 and UK Registration No. 14028981, JOLLY ROGER in Class 42 and UK Registration No. 1325408, OWO RODGER in Class 33.

12. Mr Rawlence turns to the goods at issue and states that the opponents UK registration number 90551 covers "champagne" which is identical to the "alcoholic beverages" of the subject application and similar to other goods specified within it. He goes on to submit that the respective products are bought by the same kind of customers, are essentially the same type of products ie. alcoholic beverages, are likely to be sold in the same retail and service outlets e.g.

off licenses, supermarkets, bars, cafes, imported and distributed through the same trade channels e.g. wine and spirit merchants, and sold or dispensed in close proximity to one another.

13. Mr Rawlence draws attention to Exhibit AJR 2 to his statement which comprises copies of extracts taken from the book “Pol Roger” by Cynthia Parzych and John Turner, published in 1999, which is an account of POL ROGER champagnes and confirms long and continuous use of POL ROGER in the UK from the 1870s up until when the book was published. Mr Rawlence goes on to draw attention to further Exhibits to his statement relating to the use and promotion of the POL ROGER trade mark in the UK, in particular Exhibit AJR 3 a POL ROGER “scrapbook” being a bound collection of UK press cuttings, AJR 5 comprising copies of recent advertisements and AJR 6 comprising copy extracts from Christie’s World Encyclopaedia of Champagne and Sparkling Wine by Tom Stevenson, which was published in 1998.

14. Mr Gunn is the Managing Director of Pol Roger Limited, a company established in 1990 to act as the exclusive UK distributor of the champagnes of Pol Roger & Cie S.A. Mr Gunn adds that his company is also the exclusive distributor of various third party wines which are clearly labelled with the importers name, Pol Roger Ltd.

15. Mr Gunn states that during the period January – December 2000 his company imported and distributed in the UK approximately £496,000 of such third party wines in bottles the labels of which bore the importers name POL ROGER. Mr Gunn refers to Exhibit BG 1 to his statement which consists of example copies of the third party wine labels and Exhibit BG 2 which comprises copies of his company’s 2002 brochure and price list for third party wines.

Applicant’s evidence

16. This consists of a witness statement by Amit Dhamecha dated 22 October 2002. Mr Dhamecha is the buyer for Dhamecha Foods Limited (the applicant company).

17. Mr Dhamecha explains that his company acquired the business of wholesalers of alcoholic and non-alcoholic beverages from Salamis & Co Limited in July 1999, so the references in his statement to use by his company include use by Salamis & Co Limited as predecessors in title.

18. Mr Dhamecha states that the mark in suit has been in use in the UK for at least eight years in relation to wines and Exhibit AD1 to his statement contains a summary of sales made by bottle of JEAN P. ROGER wines during the periods 1 January 1996 to 31 December 2000, 1 January 2001 to 30 September 2001 and 1 January 2002 to 30 September 2002. Exhibit AD1 shows not insignificant sales of French wines under the mark in suit.

19. Mr Dhamecha goes on in Exhibit AD2 to his statement to draw attention to samples of labels under the mark and at Exhibit AD3 are examples of promotional material to illustrate use of the mark.

20. Mr Dhamecha concludes by stating that he is not aware of any instances of confusion between JEAN P. ROGER and POL ROGER.

21. This concludes my summary of the evidence filed in this case. I now turn to the decision.

Decision

22. Firstly I go to the ground of opposition under Section 5(2)(b) of the Act. Section 5(2) reads as follows:

“5.- (2) A trade mark shall not be registered if because -

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.”

23. An earlier right is defined in Section 6, the relevant parts of which state:

“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,”

24. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, page 224;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, page 224, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* page 84, paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, page 224;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, page 224;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 132, paragraph 17;
- (f) 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; *Sabel BV v. Puma AG*, page 224;
- (g) account should be taken of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it was registered; *Lloyd*, paragraph 29;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, page 224;
- (i) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (j) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, page 333, paragraph 29.

25. The reputation of a trade mark is an element to which importance may be attached in Section 5(2) considerations in that it may enhance the distinctive character of the mark at issue and widen the penumbra of protection of such a mark. The opponent has filed evidence relating to the reputation of the mark POL ROGER covered by its prior registrations and on the basis of this evidence, which in my opinion demonstrates long and extensive use and a respected history in its champagne product, the mark POL ROGER has a substantial reputation in the relation to champagne. While the opponent also has use of the mark, to a far more limited degree, in relation to wine in general, I do not believe the opponent to possess a reputation in the mark POL ROGER for wine as a whole. Nevertheless, the opponent possesses a reputation in the POL ROGER trade mark in relation to champagne and I will take this into account for the purposes of this decision.

26. In essence the test under Section 5(2) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion. In my consideration of whether there are similarities sufficient to show a likelihood of confusion I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural or conceptual similarity between the marks, evaluating the importance to be attached to those different elements, taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed. In this case it is accepted that the opponent's mark has a reputation. However, it was held in *Marca Mode v Adidas AG* (2000) ETMR 723:

“The reputation of a mark, where it is demonstrated, is thus an element which, amongst others, may have a certain importance. To this end, it may be observed that marks with a highly distinctive character, in particular because of their reputation, enjoy broader protection than marks with a less distinctive character (*Canon*, paragraph 18). Nevertheless, the reputation of a mark does not give grounds for presuming the existence of a likelihood of confusion simply because of the existence of a likelihood of association in the strict sense.”

27. Furthermore, in addition to making comparisons which take into account actual use of the respective marks, I must also compare the mark applied for and the opponent's registrations on the basis of their inherent characteristics assuming normal and fair use of the marks on a full range of the goods covered within the respective specifications.

28. Turning first to a consideration of the respective goods covered by the specification of the application in suit and the opponent's earlier registrations, it is obvious that the opponent's International Registration No. 729697 for “alcoholic beverages” in Class 33 covers identical goods to those specified in the mark in suit. Furthermore, the specification of the mark applied for would encompass “champagne”, the goods specified within the opponent's UK Registration No. 90551 and the goods for which the opponent possesses a reputation in the market place.

29. I now go on to a comparison of the mark in suit with the opponent's earlier registrations. In the evidence the opponent has drawn my attention to the state of the trade mark registers in relation to marks containing the words ROGER. I am not assisted by this evidence and I am guided on this point by the following comments of Mr Justice Jacob in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:

“Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word “Treat”. I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held 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. *MADAM Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

30. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits, taking into account any use of the marks and also fair and notional use of the respective marks across the full width of their specifications.

31. The mark in suit consists of the two words JEAN and ROGER separated by the letter P. Following the letter P is a full stop. While the applicant submits that the word ROGER is a common French surname, I have no evidence before me on this point. However, I have little doubt that the mark in suit as a whole is likely to be perceived as a full name of an individual by the average UK customer. The word JEAN is widely known as either a female forename or, especially in relation to the goods upon which the applicant's mark has been used ie. French wine, it may be perceived a French version of the forename John. The letter P followed by a full stop is likely to be perceived as an initial, and the word POL as a foreign surname, the surname probably being regarded as French if the mark is used in relation to French wine or other French beverages.

32. The opponent's prior registrations consist of the two words POL ROGER in a slightly stylized presentation and also the same words with the addition of "& Co.", a product descriptor and geographical location. For the purposes of this opposition, I do not believe that UK Registration No. 90551 adds to the opponent's case given that International Registration No. 729697 is for the words POL ROGER (without addition) and covers a wider specification of goods. In my comparison of the respective marks I intend to concentrate upon a comparison of Registration No. 729697 and the application in suit. While I have no evidence to show me how the average UK customer would perceive the POL ROGER mark, the historical evidence filed by the opponent does show that POL ROGER was the name of an individual and it is reasonable to presume that it could be perceived as a full name of foreign origin by UK customers, especially when used in relation to French produce when it could be seen as a French forename and surname.

33. It is, of course, possible to overanalyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

34. On a visual and aural comparison there are apparent differences in that the application in suit consists of two words and a letter/initial and the opponent's registration two words. Furthermore, the first words in the respective marks i.e. JEAN and POL, are obviously different. Notwithstanding that there are obvious differences in the marks, particularly on a side by side comparison, they share a common element i.e. the word ROGER, which on the basis of the information before me must be regarded as a distinctive and striking component within both marks. Accordingly, there is visual and oral similarity between the respective marks. While the opponent's registration is presented in a slightly stylized manner I have no doubt that it would be seen as a POL ROGER mark and in the presentation of the words would have no impact upon its oral use.

35. Turning to a conceptual comparison of the marks it seems to me that the mark in suit will be perceived as the full name of an individual and that it is likely that the opponent's mark will be perceived in the same way. Furthermore, especially when used in relation to French produce, it

is likely that the marks will be perceived as French names. I would add that these names share the same family name or surname.

36. In assessing the degree of similarity between the respective marks and whether it is sufficient to give rise to a likelihood of confusion I must also consider the goods at issue, the average customer for the goods and also make allowance for imperfect recollection. The customers for alcoholic beverages including the goods on which the marks have been used i.e. wine and champagne, are members of the general public over eighteen years of age. Such goods are available in retail outlets as well as pubs and clubs. Purchases of alcoholic beverages are often made on an occasional basis or for the benefit of others e.g. for parties or special occasions or in buying a round of drinks in a pub or a club. While some alcoholic beverages, including champagne and “top-end” wines may be relatively expensive and this is not “a bag of sweets” case, the customer is not necessarily a sophisticated or specialised consumer and imperfect recollection could well be a factor as such goods are often purchased on an occasional basis and/or for the benefit of others.

37. Notwithstanding that there are obvious differences in the marks, particularly on a side by side comparison, I must take into account my earlier finding that the common element, the word ROGER, comprises a distinctive, strong and striking component of both marks. I must add to this my findings that the average customer for the goods (alcoholic beverages), including wine will often be an occasional and non-specialised or sophisticated consumer who may rely upon the imperfect picture he/she has left in his/her mind. Taking into account the average customer for the goods, that identical goods are involved and that the marks share a major and striking component, it seems likely that the word ROGER in the opponent’s mark will be retained in the mind of customers. Notwithstanding the differing elements it is my view that the applicant’s mark would capture the distinctiveness of the opponent’s earlier marks in normal and fair use in the market place.

38. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon* :

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18).”

39. The respective goods are identical and the respective marks are similar conceptually, visually and aurally in that the common element (ROGER) would suffice to lead the public to believe that the goods emanated from the same undertaking.

40. The opposition under Section 5(2)(b) of the Act is successful.

41. As I have found for the opponent under Section 5(2) of the Act, I have no need to consider the ground of opposition raised under Section 5(4)(a) I would only add that I do not consider the opponent to have any stronger case under that ground.

Costs

42. The opponent is entitled to a contribution towards costs and I therefore order the applicant to pay the opponent the sum of £1,000. This sum is 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 6TH day of June 2003

**JOHN MACGILLIVRAY
For the Registrar
the Comptroller General**