

O-013-06

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 2298297  
IN THE NAME OF COORS WORLDWIDE INC**

**AND**

**OPPOSITION NO. 91722 THERETO BY  
BERENTZEN DISTILLERS INTERNATIONAL GMBH**

## **TRADE MARKS ACT 1994**

### **IN THE MATTER OF application No. 2298297 in the name of Coors Worldwide Inc and opposition No. 91722 thereto by Berentzen Distillers International GmbH**

#### **Background**

1. On 18 April 2002, W P Thompson & Co on behalf of Coors Worldwide Inc filed an application under No. 2298297 for registration of the trade mark SCREAMERS in respect of "*alcoholic beverages*" in class 33.
2. On 27 May 2003, Berentzen Distillers International GmbH filed notice of opposition. The single ground of opposition is based on Section 5(2)(b) of the Act because of the existence of the opponent's earlier Community trade mark No. 2155091 for the word "Creamers". This registration covers goods in several classes but the opposition is based only on the following goods: "*alcoholic beverages (except beers)*" also in class 33.
3. The applicant filed a counter-statement essentially denying the ground of opposition.
4. Both sides filed evidence and both ask for an award of costs. Neither party requested to be heard, but the applicant did file written submissions. After a careful study of all the papers, I give my decision.

#### **Opponent's evidence**

5. This takes the form of a witness statement from Peter Hillier and dated 29 October 2004. Mr Hillier states he is a Trade Mark Attorney in the firm of Marks & Clerk who act for the opponent in these proceedings.
6. Mr Hillier gives details of internet searches he carried out using the Google search engine on 5 July 2004 and 5 October 2004 and attaches a number of exhibits consisting of printouts of the results of his searches. I note that the searches post-date the relevant date in these proceedings. Mr Hillier goes on to provides a comparison of the respective trade marks.

#### **Applicant's evidence**

7. The applicant's evidence is a witness statement from Patti L. Zenk and dated 3 February 2005. Ms Zenk is legal counsel for the applicant and is authorised to make the statement on its behalf.
8. Ms Zenk comments on Mr Hillier's evidence and also provides a comparison of the respective trade marks, attaching a number of exhibits comprising of internet print outs which again post-date the relevant date. Also exhibited is an extract from the

Oxford English Reference Dictionary 1996 ed. showing an entry for the word Screamer.

9. Ms Zenk states the Screamers product has been in the marketplace in the UK since 2003 and has been sold through both on-trade and off-trade channels with total sales in excess of 750,000 litres. No instances of confusion with any other brand has been reported to the applicant.

### **Opponent's evidence in reply**

10. This is a further witness statement from Mr Hillier and dated 21 April 2005. Mr Hillier comments on Ms Zenk's evidence and again provides a comparison of the respective trade marks. Mr Hillier exhibits extracts from Kerly's Law of Trade Marks and Trade Names 13<sup>th</sup> Ed. and comments on the likelihood of confusion.

11. It is clear that much of the evidence is in form of commentary and opinion. I have not set out that commentary and opinion in any detail but will refer to it as necessary in my decision. That concludes my summary of the evidence.

### **Decision**

12. The opposition is based on an objection under Section 5(2)(b) of the Act which states:

“ 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. The term “earlier trade mark” is defined in section 6 of the Act as follows:

“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 opponent's registration is an earlier trade mark within the definition of Section 6 of the Act.

15. In determining the question under Section 5(2), 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*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question: *Sabel BV v Puma AG*, paragraph 23, 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 he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen B.V.* 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*, paragraph 23;
- (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*, paragraph 23;
- (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 v Metro-Goldwyn-Mayer Inc*, 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*, paragraph 24;
- (g) 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*, paragraph 26;
- (h) 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;
- (i) 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*, paragraph 29.

16. 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. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, evaluating the importance to be attached to those different elements and taking into account the degree of similarity in the goods, the category of goods in question and how they are marketed.

17. There is no dispute that identical goods are involved. I therefore go on to compare the respective trade marks. For ease of reference, I set out the respective marks below:

Applicant's Mark  
SCREAMERS

Opponent's Mark  
Creamers

18. The opponent's earlier mark, which is in lower case except for an initial capital letter, is a dictionary word consisting of eight letters. The mark applied for is also a dictionary word but presented in plain block capitals. It contains the eight letters of the earlier mark in the same order but with an additional letter "s" at the beginning of the mark. It is a well established principle that the beginnings of marks are of particular importance (see *Tripcastroid* (1925) 42 RPC 264). I also take into account that the initial letter is not usually overlooked (see *Anadin v Inadine* [1992] RPC 421). Whilst the respective marks have a degree of visual similarity the addition of the initial letter "s" is a clear visual difference.

19. Aurally, similar considerations apply. Despite the mark applied for having an additional letter at the beginning, both marks consist of two syllables and are of similar length. Mr Hillier commented in his evidence on how the letter "s" appearing at the beginning of words are often lost in speech. This argument, of course, depends on what any preceding words might be but I take the view that the sibilant consonant is one which is aurally distinctive.

20. Alcoholic beverages are sold through any number of channels including retail premises such as shops, supermarkets and off-licences and in bars and restaurants. In retail premises, goods are generally displayed on shelving. It could be argued that sales in bars and restaurants would be made by oral request however, even if this is the case, there is no evidence that the goods are sold in a way which precludes visual inspection. In support of this I take note of the following comments of the ECJ judgement in *Simonds Farsons Cisk plc v Spa Monopole* T-3/04:

"58...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."

21. Both marks consist of ordinary dictionary words, each with its own distinct and well known meaning. It seems to me that the mark applied for denotes someone, or something that utters or emits a loud and piercing noise and certainly there is no evidence before me that at the relevant date in these proceedings, the mark had any alternative meaning. In contrast, the earlier mark denotes something used as a substitute for or resembling cream. I do not believe there to be any conceptual similarity between the respective marks.

22. There is no evidence that the opponent's earlier mark has any enhanced reputation because of the use made of it, but it seems to me that it has a relatively high inherent distinctiveness.

23. I must also consider the relevant public for the goods in issue. Given that the goods are alcoholic beverages, I take the relevant public to be the general adult population, notwithstanding the fact some adults eschew alcohol. Whilst the goods are an everyday purchase and of relatively low cost, I bear in mind that the average consumer is deemed to be reasonably circumspect and observant and will exercise a certain degree of care. This is particularly so given that the goods in question will be imbibed and therefore subject to personal preferences such as taste.

24. Whilst there are some similarities between the respective marks, there are also significant differences between them. The average consumer normally perceives a mark as a whole and does not analyse its various details (*Sabel v Puma*). Both marks are ordinary dictionary words with distinct and different meanings which would be readily understood. On a global appreciation, taking into account all relevant factors, I find that the differences outweigh the similarities such that there is no likelihood of confusion to the average customer for the goods even where identical goods are concerned. The opposition under section 5(2)(b) fails.

#### **Costs**

25. The applicant having succeeded is entitled to an award of costs. I take into account the limited nature of the evidence filed by both parties and that the decision was reached without recourse to a hearing. I order the opponent to pay the applicant the sum of £1100. This sum is to be paid with seven days of the expiry of the appeal period or within seven days of the final determination of this case should any appeal against this decision be unsuccessful.

**Dated this 17 day of January 2006**

**Ann Corbett  
For the Registrar  
The Comptroller-General**