

O-026-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2437529
BY WESTBURY TOBACCO COMPANY LIMITED TO REGISTER
A SERIES OF FOUR TRADE MARKS IN CLASS 34**

AND

**IN THE MATTER OF OPPOSITION NO 95467 BY
REEMTSMA CIGARETTENFABRIKEN GMBH**

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**IN THE MATTER OF Application No 2437529
By Westbury Tobacco Company Limited to register
a series of four trade marks in Class 34**

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By Reemtsma Cigarettenfabriken GmbH**

BACKGROUND

1. On 3 November 2006, Westbury Tobacco Company Limited (“W”) applied to register the following series of four trade marks:

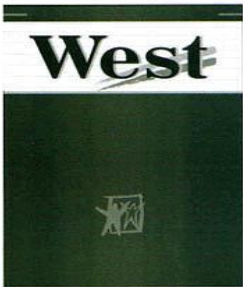



for the following goods:

Class 34:

Tobacco and tobacco products; cigarettes; smokers' articles; matches; parts and fittings for all the aforesaid goods.

2. On 6 September 2007, Reemtsma Cigarettenfabriken GmbH (“RC”) filed notice of opposition to this application based on a single ground under Section 5(2)(b) of the Trade Marks Act 1994 (“The Act”). In relation to this ground, RC relies upon the following earlier trade marks:

No:	MARK:	GOODS RELIED ON:
CTM ¹ 3487071	WEST	Class 34: Tobacco, whether manufactured or unmanufactured; cigarettes; cigars; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; matches and smokers' articles.
CTM 4236006		Class 34: Tobacco whether manufactured or unmanufactured; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; cigarettes; matches and smokers' articles.
CTM 4597654		Class 34: Tobacco whether manufactured or unmanufactured; tobacco products; tobacco substitutes, none being for medicinal or curative purposes; cigarettes; matches and smokers' articles.

¹ Community Trade Mark

3. RC claims that the applied for trade marks contain the whole of its distinctive trade mark(s) WEST and that the goods applied for are identical to those registered under its trade mark. As such, it claims that there is a likelihood of confusion on the part of the public. W filed a counterstatement denying the ground of opposition. It considers that visually, aurally and conceptually, the respective marks are different and readily distinguishable.

4. Only RC filed evidence, a summary of which follows. Neither side requested a hearing. W did, however, file written submissions in lieu of a hearing. Although RC did not file formal written submissions, it did make a number of submissions in its evidence which I will take into account.

RC's evidence

5. This consists of a statutory declaration, dated 21 April 2008, from Trevor Martin Williams. Mr Williams is the Deputy Company Secretary of Imperial Tobacco Limited (ITL), RC's parent company. Mr Williams' main statements are that:

- The WEST trade mark was adopted for use on cigarettes in 1981 in Germany and has been in continuous use ever since and that this use has spread rapidly throughout the rest of the world (since 1982).
- The trade mark forms the basis of a WEST "family" of marks which are registered and in use in over 150 countries. Exhibit 2 shows a non-exhaustive list of WEST trade mark registrations in various territories and Exhibit 3 a selection of various registration certificates from a number of these territories.
- That RC enjoys a strong market position in relation to cigarettes and associated products, as a result of the continuous and substantial use of the WEST trade mark. The total annual sales worldwide for cigarettes bearing the WEST trade mark from 2001 to 2006 are:

YEAR	No. of cigarettes sold (millions)
2001	24,773
2002	26,726
2003	25,795
2004	23,872
2005	23,823
2006	24,855

- RC has sold the WEST brand of cigarettes in the UK since the 1990s and has sold over 3 million cigarettes to date. Mr Williams concedes that this figure is not substantial with regard to the overall cigarette market in the UK, but adds that the WEST brand will still be known to a significant number of consumers in the UK.

- RC has invested millions of pounds in advertising, merchandising and promotion of goods bearing the WEST trade mark with the result being widespread recognition as a market leader. I note that this, again, is worldwide and not specific to the UK.
- RC has sponsored the Formula One “WEST McLaren Mercedes Race Team” from 1997 to 2006. The tournament includes a British leg. Information on this tournament, including references to WEST as part of the sponsorship, is shown in Exhibit 4.
- ITL’s website, under the heading “Brands”, states that the trade mark “WEST” has a significant presence in Germany and Central and Eastern Europe. Mr Williams accepts that this does not mention the UK, although he states that it is easy to conceive that a significant number of people from these areas reside in and/or visit the UK and it is likely that the WEST brand will be known to them. As a result, Mr Williams believes there to be a likelihood of confusion.

DECISION

The law and the leading authorities

6. Section 5(2)(b) of the Act states:

“(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.”

7. When making my determination, I take into account the guidance from the case-law of the European Court of Justice (“ECJ”) on this issue, notably: *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, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Case C-120/04 Medion (2005) ECR I-8551* and *Case C-334/05P Shaker di Laudato & C.Sas v OHIM (“LIMONCHELLO”)*. 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*,

- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods and services, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,
- (f) the assessment of similarity can only be carried out solely on the basis of the dominant element in a mark if all of its other components are negligible (*Limonchello, para 42*)
- (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; *Sabel BV v Puma AG*,
- (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*,
- (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 and Adidas Benelux BV*,
- (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.*,
- (k) 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 (*Medion, para 30*).

Relevant public and the purchasing act

8. As the ECJ states in *Sabel BV v. Puma AG*, matters must be judged through the eyes of the average consumer. I must, therefore, assess who this is. Both specifications cover tobacco and tobacco products, such as cigarettes and cigars, together with other smokers' articles. These are not specialist goods and will be bought by the general public, but particularly by those who smoke. In my experience, such consumers will normally possess a reasonably high degree of brand awareness often displaying loyalty to a particular brand. In my view, this equates to a reasonably high degree of care and attention being applied during the purchasing process.


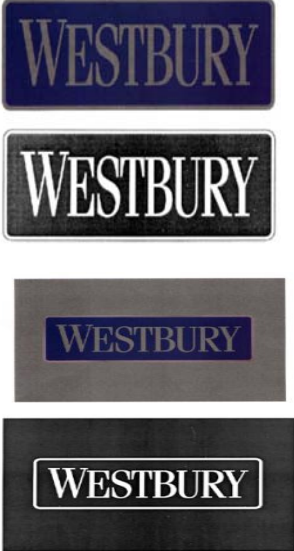
9. The manner in which the goods will be purchased must also be considered. It is likely that the goods will be purchased most often over the counter, for example in a supermarket or in a newsagents shops, but sometimes also in more specialist shops such as tobacconists. Cigarettes can also be purchased from vending machines. It is likely, therefore, that in the main, the goods will be requested orally. This means that the degree of aural similarity is of particular significance. However, the average consumer may also be looking at the goods when he requests them over the counter or when purchasing from a vending machine. Therefore, the degree of visual similarity is also important and cannot be ignored.

Comparison of the goods

10. This requires little analysis. The terms in the respective specifications use virtually identical terminology. W accepts in its written submissions that the goods are identical. I need not say any more, the goods are identical.

Comparison of the marks

11. In assessing this factor, I must consider the visual, aural and conceptual similarities between the respective trade marks, bearing in mind their distinctive and dominant components (*Sabel BV v. Puma AG, para 23*). The respective trade marks are reproduced below for ease of reference.

RC's earlier trade marks	W's trade mark
	

12. I am of the view that RC's earlier "word only" mark WEST represents its strongest case. Its other marks contain additional elements which are more distant, visually, from W's marks. The aural consideration is the same. Although W's marks have some minor differences between them in relation to stylisation and colours, they will all be seen and referred to as WESTBURY. This element is, therefore, the dominant element in all of them. I also take the view that the other elements in W's marks (such as the borders) are negligible in the terms set out in *Limonchello* because they play so small a part in the overall impression and distinctiveness. Even if I am wrong on this and the other elements are not negligible, they have so little an impact that this is unlikely to affect my findings of similarity and likelihood of confusion. Therefore, the comparison to be made is, effectively, between WEST and WESTBURY.

13. RC's argument relates to the word WEST being entirely contained within WESTBURY. W argues that this is an artificial dissection and that there are significant visual and aural differences. W also highlights a conceptual difference which I will say more on below.

14. In terms of the visual comparison, the word WEST comprises the entirety of RC's mark and makes up the first half of W's trade mark. This, inevitably, creates a

degree of visual similarity. In case *T-22/04 Reemark Gesellschaft für Markenkooperation mbH v. OHIM (“Westlife”)*, para 34, the CFI² stated:

“Visually, there is no question that there is a degree of similarity between the marks at issue because the earlier trade mark, West, is the first component of the mark applied for, Westlife”.

15. It is of course necessary to assess the degree of visual similarity. Irrespective of the above, WESTBURY, is not, in my view, simply two words joined together. There is no natural break in the word and it strikes the eye as a single, distinct and complete word. This is an important factor and one which provides a contrast with the WESTLIFE case as the mark there was seen as two words joined together. Taking all this into account, I find that whilst there is a degree of visual similarity, it is only a low degree.

16. With regard to the aural comparison, the respective marks have a point of similarity in that the first part of WESTBURY will be pronounced in identical terms as WEST. However, as has been argued by W, WEST is comprised of one syllable, WESTBURY of three, and furthermore the addition of ‘BURY’ has a significant effect on the overall pronunciation. As with visual similarity, whilst there may be a degree of aural similarity, it is only a low degree.

17. Conceptually, WEST is a word which signifies a geographical direction. It may also be recognised as a surname. WESTBURY, W argues, may be recognised as a place name in England. It is indeed a town in Wiltshire, although there is no evidence to persuade me that this will be known by the average consumer. However, even if it is not known, I am prepared to accept that WESTBURY, at the very least, evokes the idea and concept of a place name. W also argues that the borders around its marks will be seen as a road sign. I do not agree with this submission as the borders are so plain. Nevertheless, this does not detract from the concept behind the words themselves. In terms of conceptual comparison, I note that in *Case T-292/01 Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS) (2003) ECR* the CFI stated:

“Next, it must be held that the conceptual differences which distinguish the marks at issue are such as to counteract to a large extent the visual and aural similarities pointed out in paragraphs 49 and 51 above. For there to be such a counteraction, at least one of the marks at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately....

The fact that one of the marks at issue has such a meaning is sufficient – where the other mark does not have such a meaning or only a totally different meaning - to counteract to a large extent the visual and aural similarities between the two marks.”

² The Court of First Instance of the European Communities

18. The ECJ reached the same conclusion, expressed in similar terms, in the *Picasso and others v DaimlerChrysler AG Picarro/Picasso case (C- 361/04P)*.

19. Applied to this case, WEST has a clear and specific meaning be it directional or surnominal. WESTBURY does not have such a meaning which, therefore, creates a conceptual difference. Indeed, I have found WESTBURY to have its own meaning, therefore creating conceptual dissonance. This also creates a further contrast with the Westlife decision as in that case, the marks (WEST and WESTLIFE) could not be significantly distinguished on conceptual terms as they both evoked a perception of western goods or of a western lifestyle. This means that the counteraction described in the above case law has the capacity to operate. However whether this is sufficient to avoid confusion will be discussed later.

Distinctiveness of the earlier mark(s)

20. The guidance in *Sabel BV v Puma AG* states that 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.

21. The word WEST is an ordinary dictionary word meaning a geographical direction or it could possibly be seen as a surname. Although it is not an invented word it is not meaningful or even allusive in relation to its goods. Overall, I consider it to have a reasonable degree of distinctive character, per se.

22. What impact does the use made of the mark have? Figures are provided for annual turnover worldwide since 2001, but there is nothing specific to the UK. RC asserts in its evidence that the WEST brand has sold 3 million cigarettes in the UK since 1990, but concedes that this figure is not significant in the relevant market. RC argues that despite this, the brand will still be well known. There is little in the evidence to support this proposition. I must also consider the significance of the sponsorship deal for a Formula One Team. In my view, this has only minor relevance. It is difficult to see what the average consumer will take from this sponsorship by simply seeing the WEST name associated with Formula 1 and not placed in context as a cigarette brand. In totality, the evidence fails to persuade me that the WEST mark has anything over and above its inherent, reasonable degree of distinctive character.

Family of marks

23. Before detailing my conclusions on whether there exists a likelihood of confusion, I must deal with a further “submission” outlined in the evidence of RC. The argument is, in essence, that the WEST mark is part of a “family” of trade marks. Exhibit 2 of the evidence shows a number of CTMs incorporating the word WEST, but with additional words such as Ice, Gold, Silver and Menthol. Mr Williams argues that confusion between the respective marks is likely and that it would be easy to conceive that the public would consider the trade mark applied for to be an extension of the WEST brand, particularly as the WEST brand is often marketed in combination with other words and/or visual elements. The Appointed Person, Professor Ruth

Annand dealt with reliance on a family of marks in *Infamous Nut Co Ltd's Trade Marks* [2003] RPC 7. She held as follows:

“35. It is impermissible for section 5(2)(b) collectively to group together several earlier trade marks in the proprietorship of the opponent.

36. Section 5(2)(b) speaks of registration being refused on the basis of an earlier trade mark (as defined by section 6). Thus where the opponent relies on proprietorship of more than one earlier trade mark, the registrability of the applicant's mark must be considered against each of the opponent's earlier trade marks separately (*ENER-CAP Trade Mark* [1999] RPC 362).

37. In some circumstances, it may be possible for the opponent to argue that an element in the earlier trade mark has achieved enhanced distinctiveness in the eyes of the public because it is common to a “family of marks” in the proprietorship and use of the opponent (*AMOR*, Decision no 189/1999 of the Opposition Division, OHIM OJ 2/2000, p. 235). However, that has not been shown by the evidence to exist in the present opposition and cannot, as contended by Mr Walters on behalf of the opponent, be presumed from the state of the register in Classes 29 and 31.”

24. None of the marks which are said to form part of this “family” have been pleaded in the case before me. Neither has any evidence been provided to show them in use. I cannot see how a “family” of marks argument can, therefore, be pursued. This does not however rule out WESTBURY being seen as a brand variant of WEST. I will assess this next.

Likelihood of confusion

25. In reaching a decision on whether there is a likelihood of confusion, I must consider the possibility of both direct and indirect confusion. I begin by considering direct confusion which occurs when the average consumer mistakes one mark for the other and is confused as to the economic origin of the goods sold under the respective marks. The case-law makes it clear that there is an interdependency between the relevant factors (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*) and that a global assessment of the factors must be made when determining whether there is a likelihood of confusion (*Sabel BV v. Puma AG*). I must, therefore, consider the relevant factors from the viewpoint of the average consumer to determine whether they are likely to be confused.

26. The goods in this case are identical. This is important because a lesser degree of similarity in the marks can be offset against this factor (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*). I also bear in mind that the average consumer rarely has the opportunity to view marks side by side and must instead rely on an imperfect picture of them he has kept in mind (*Lloyd Schuhfabrick Meyer*). However, the marks are low in similarity and W's mark contains an additional and noticeable element which is unlikely to go unnoticed. This, in my view, mitigates strongly against

imperfect recollection. Further mitigation is provided by the conceptual differences that I have already highlighted.

27. I also bear in mind the nature of the goods themselves and, in particular, the higher degree of attention that I believe consumers of such goods would pay during the purchasing process. Considering all these factors, I do not believe that the average consumer would mistake one mark for the other. **I, therefore, conclude that there is no likelihood of direct confusion.**

28. Turning now to indirect confusion, namely where the average consumer makes an association between the marks, due to some similarity between them, which leads them to believe that the goods come from the same or an economically linked undertaking. The question is whether the presence of WEST, the common element between the two marks, is enough to make the average consumer believe that the goods are the responsibility of the same or an economically linked undertaking. WESTBURY, as I have found already, is not a composite mark. The word WEST is not the dominant feature of it nor does it play an independent distinctive role in the terms set out in *Medion*. I have also found already that WESTBURY would evoke the concept of a place name. On this, I note the decision of Geoffrey Hobbs QC (sitting as the Appointed Person) in *Cardinal Place BL 0/339/04* where he stated at paragraph 15:

“The perceptions and recollections triggered by the earlier mark are likely to have been ecclesiastical whereas the perceptions and recollections triggered by the Applicant’s mark are likely to have been locational as a result of the qualifying effect of the word **PLACE** upon the word **CARDINAL**. A qualifying effect of that kind can be quite powerful as indicated by the examples cited in argument on behalf of the Applicant: **SOMERSET** as compared with **SOMERSET HOUSE**; **COUNTY** as compared with **COUNTY HALL**; **CANARY** as compared with **CANARY WHARF**.”

29. Taking all of the above into account, and despite the goods being identical and the earlier mark being reasonable distinctive, I am not persuaded that the average consumer for these goods would view WESTBURY as an extension or variation of the WEST trade mark or otherwise believe that they came from the same or economically linked undertaking. **There is no likelihood of indirect confusion.**

COSTS

30. As the opposition has failed, W is entitled to a contribution towards its costs. Accordingly, I order Reemtsma Cigarettenfabriken GmbH to pay Westbury Tobacco Company Limited the sum of £1100. This amount is calculated as follows:

Considering notice of opposition - £200
Filing counterstatement - £300
Considering evidence - £200
Preparing and filing written submissions - £400

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 28th day of January 2009

**L White
For the Registrar
The Comptroller-General**