

O/442/11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2554007
BY ST ANDREWS WHISKY COMPANY LIMITED TO REGISTER THE
TRADE MARK**

st andrews whisky

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 101224
BY GILFIN INTERNATIONAL (TAPEMATE) LIMITED**

BACKGROUND

1. On 28 July 2010, St Andrews Whisky Company Limited ("SA") applied to register **st andrews whisky** as a trade mark for goods in class 33. Following examination, the application was accepted and published for opposition purposes on 3 September 2010 for a specification reading: "Scotch whisky".

2. On 23 November 2010, Gilfin International (Tapemate) Limited ("GI") filed a notice of opposition which consisted of a single ground based upon 5(2)(b) of the Trade Marks Act 1994 ("the Act"). Following amendment, GI's opposition is based upon the following trade mark:

Trade Mark	No.	Application Date	Registration Date	Goods relied upon in class 33
OLD ST. ANDREWS	CTM 5866851	30.04.2007	12.03.2008	Whisky

3. On 9 February 2011, SA filed a counterstatement in which the ground of opposition is denied. Having admitted that the goods in GI's registration are identical or similar to the goods in its application SA said:

"2. [GI's] trade mark contains the word OLD at the beginning of the mark, this word not being present in the trade mark applied for. In addition, the trade mark applied for contains the word whisky at the end of the mark, this word not being present in [GI's] mark. Furthermore, it is believed that [GI's] mark co-exists in the marketplace with at least one other mark containing the element ST ANDREWS, under which scotch whisky is sold by a third party, which suggests that the distinctiveness of the element common to the trade mark applied for and [GI's] mark is relatively low. Accordingly, the overall impression of both parties' marks is different."

4. Neither party filed evidence; GI filed written submissions in lieu of attendance at a hearing. I will refer to these written submissions as necessary below.

DECISION

5. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

An earlier trade mark is defined in section 6 of the Act, 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 or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

6. In these proceedings GI is relying upon the trade mark shown in paragraph 2 above which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which SA’s application was published i.e. 3 September 2010 and the date on which GI’s trade mark completed its registration procedure i.e. 12 March 2008, GI’s earlier trade mark is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

7. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *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, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). 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 for 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) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*
- (f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.
- (g) 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*,
- (h) 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*,
- (i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (j) 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*,
- (k) 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*,
- (l) 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*.

Comparison of goods

8. As both SA's application and GI's registration specify whisky, the goods at issue are identical.

The average consumer and the nature of the purchasing process

9. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The goods at issue are whisky; whisky will be bought by members of the general public over the age of 18.

10. In my experience, whisky is sold through a range of channels, including retail premises such as shops, supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self selection), and in bars and restaurants (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on the bottles themselves). Although when the goods are sold in, for example, bars and restaurants the selection process may be an oral one, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. *In Simonds Farsons Cisk plc v Spa Monopole*, case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, it must be noted that, 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.”

11. Consequently, while the goods may be ordered orally, it is likely to be in the context of a visual inspection of, for example, the bottles containing the goods prior to the order being placed. In view of the above, and while I consider the selection process to be primarily a visual one, I accept that aural considerations will also play their part, albeit, in my view, to a lesser degree. As to the level of attention the average consumer will display when selecting the goods, in my experience the cost of whisky can vary from relatively small sums to many hundreds or even thousands of pounds. While I accept that when these large sums are in play the average consumer will pay a high level of attention to their selection, this is not, in my experience, likely to be the norm. That said, the cost of whisky (whether bought in a bottle from a retailer or from a bar or restaurant) is still likely to be relatively expensive, and the need for the average consumer to ensure they are selecting, for example, the correct type e.g. single malt or blended and age of

whisky, suggests that even in those circumstances the average consumer is likely to pay at least a reasonable level of attention when selecting the goods.

Comparison of trade marks

12. The trade marks to be compared are: **st andrews whisky** and **OLD ST. ANDREWS**. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant elements

13. In its submissions GI said:

“It is self evident that the opposed mark...is very highly similar to [GI’s trade mark], given the common dominant and distinctive element “St Andrews” and given that the word “Old” does not affect the distinctive character of the earlier mark because age is a highly relevant factor when considering the goods (whisky).”

14. GI’s trade mark consists of three words which, in my view, will be viewed by the average consumer as making up two separate elements, i.e. the word OLD and the combination ST. ANDREWS. I agree with GI that the word OLD, though lacking precision, is unlikely to be seen as a distinctive element of its trade mark. This is because it is a well-established practice to sell whisky by reference to its age, i.e. 10 year old, or 30 year old whisky, a practice which is well-known to the average consumer and one of which I take judicial notice. The words ST. ANDREWS are likely to ‘hang together’ as a single element as it is likely to be well-known to the average consumer as a geographical location in Scotland (the full stop after ST merely indicating it to be an abbreviation for the word SAINT). As a consequence of these findings, the words ST. ANDREWS are the distinctive and dominant element of GI’s trade mark.

15. The position regarding SA’s trade mark can be shortly stated; once again, in my view, it consists of three words making up two elements. The word whisky appearing at the end of its trade mark is a mere description of the goods being sold and has no trade mark character. The only remaining element is the combination st andrews which is, in my view, the distinctive and dominant element of SA’s trade mark.

Visual, aural and conceptual similarity

16. I concluded above that the distinctive and dominant elements of the competing trade marks were the words ST. ANDREWS and st andrews. Other than the variation in type face and the presence of the full stop after the word ST in GI's trade mark, the distinctive and dominant elements of the competing trade marks are visually, aurally and conceptually identical.

Distinctive character of GI's earlier trade mark

17. I must now assess the distinctive character of GI's earlier trade mark. The distinctive character of a trade mark must be appraised first, by reference to the goods in respect of which it has been registered and, secondly by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In its counterstatement SA said that it believed that GI's trade mark co-existed in the marketplace with at least one other trade mark containing the words ST ANDREWS. This suggested to SA that "the distinctiveness of the element common [to both its and GI's trade mark] is relatively low". However, no evidence was filed by SA to support this assertion.

18. I have already accepted that the word OLD is not a distinctive element of GI's trade mark. However, not only is there nothing to suggest that OLD ST. ANDREWS is not a distinctive combination, in its submissions SA appear to accept that the combination ST ANDREWS (alone) has some distinctive character albeit, in its view, distinctive character which is "relatively low". Considered as a totality, the word OLD when combined with the name of a well known geographical location in Scotland i.e. ST ANDREWS, creates a totality which in the context of the goods at issue is, in my view, and absent use, possessed of a relatively low degree of inherent distinctive character.

Likelihood of confusion

19. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is also necessary for me to keep in mind the distinctive character of GI's earlier trade mark (as the more distinctive this trade mark is, the greater the likelihood of confusion), the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision I concluded that the average consumer of the goods at issue was a

member of the general public over the age of 18 who would buy the goods by primarily visual means and who would pay at least a reasonable level of attention to his purchase. I also concluded that the goods at issue were identical and that as the distinctive and dominant element of both parties' trade marks was the words ST. ANDREWS/st andrews the competing trade marks were visually, aurally and conceptually identical. Finally, I assessed the degree of inherent distinctive character present in GI's trade marks as relatively low. In reaching a conclusion on the likelihood of confusion, I note that in *L'Oréal v OHIM* – case C-235/05 P the CJEU said:

“42. It follows that the distinctive character of the earlier mark cannot have the significance which the applicant argues it should be given in the comparison of the signs in question, as it is not a factor which influences the perception which the consumer has of the similarity of the signs.

43. It must therefore be held that the applicant has misconstrued the concepts which govern the determination of whether a likelihood of confusion between two marks exists, by failing to distinguish between the notion of the distinctive character of the earlier mark, which determines the protection afforded to that mark, and the notion of the distinctive character which an element of a complex mark possesses, which is concerned with its ability to dominate the overall impression created by the mark.

44. In the second place, as was pointed out at paragraphs 35 and 36 of this judgment, the existence of a likelihood of confusion on the part of the public must be assessed globally, taking into account all factors relevant to the circumstances of the case.

45. The applicant's approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

20. In these proceedings SA accept that the words ST ANDREWS have some distinctive character. Given that the other elements present in the competing trade marks are not ones the average consumer would (for the reasons mentioned above)

rely upon to indicate origin when selecting the goods at issue, direct confusion i.e. where SA's trade mark is mistaken for GI's trade mark is, in my view, inevitable and GI's opposition based upon section 5(2)(b) of the Act succeeds accordingly.

Costs

21. GI has been successful and is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. In its submissions GI said:

“An award of costs on an increased scale in favour of [GI] is requested, bearing in mind that [SA] was notified of [GI's] intentions over a year ago and no sensible defence to this opposition exists.”

22. I have already mentioned the comments made by SA in its counterstatement regarding the potential co-existence in the marketplace of GI's trade mark with at least one other trade mark containing the words ST ANDREWS. I also note that on 30 August 2011 SA sought and was granted an extension of time to allow a report to be finalised which investigated: “use by other parties of marks containing the element St Andrews in relation to whisky.” While this evidence was never filed by SA, in my view it provides a clear and reasonable explanation of how SA was approaching GI's opposition and I see no reason why GI should be entitled to an award of costs beyond that which I would ordinarily have ordered. Bearing that in mind, and using the TPN mentioned as a guide, I award costs to GI on the following basis:

Preparing a statement and considering SA's statement:	£200
Opposition fee:	£200
Written submissions:	£100
Total	£500

23. I order st andrews whisky company limited to pay Gilfin International (Tapemate) Limited the sum of **£500**. 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 8th day of December 2011

C J BOWEN
For the Registrar
The Comptroller-General