

O-295-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3145210
BY CENTRAL LINE HOLDINGS LIMITED

TO REGISTER A SERIES OF TWO TRADE MARKS

THREE RIVERS

AND

3 RIVERS

IN CLASS 33

AND

THE OPPOSITION THERETO
UNDER NO 406576 BY RIVES PITMAN S.A.

BACKGROUND

1. On 19 January 2016, Central Line Holdings Limited (the applicant) applied to register the above trade marks in the following class:¹

Class 33

Alcoholic beverages (except beers); spirits and liquors; distilled beverages; gin; beverages made from or containing gin.

2. The application was published on 5 February 2016, following which RIVES PITMAN S.A. (the opponent) filed notice of opposition against all of the goods in the application.

3. The opponent bases its case on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (the Act). Under sections 5(2)(b) and 5(3) the opponent relies upon the following European Union trade mark (EUTM):

Mark details and relevant dates	Goods and services relied upon
Mark: EUTM1712140 RIVES Filed: 19 June 2000 Registered: 20 December 2001	Class 29 Milk and fruit-based nutritional beverages. Class 32 Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages. Class 33 Alcoholic beverages (except beers).

4. With regard to the opposition under section 5(2)(b) the opponent states:

“15. The mark in the Opponent’s Registration is phonetically and visually closely similar to the mark in the Application. The mark in the said Registration consists solely of the word RIVES. The Applicant’s mark

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

contains the word RIVERS which is an almost identical term to RIVES and is wholly incorporated into the mark. The word RIVERS is the dominant and distinctive element of the Applicant's mark.

16. The goods claimed in the Application are identical to the goods covered by the Opponent's Registration. The identity and similarity between the marks and between the goods combines to create a likelihood of confusion."

5. With regard to the section 5(3) ground, the opponent states that it has substantial goodwill and reputation, particularly in Spain as well as in the rest of the EU, in relation to gins, vodka, rum, whisky, liqueurs with and without alcohol, fruit drinks and fruit juices, energy drinks and syrups. It submits that the similarity between the parties' marks mean that a link would be established resulting in the applicant gaining unfair advantage, tarnishing the opponent's mark and reducing the distinctiveness of it.

6. Under the section 5(4)(a) ground, the opponent relies on the sign RIVES, first used in the UK in December 2014.² It states that it has considerable reputation in the EU and Spain and that the similarity of the parties' marks mean that there would be a misrepresentation resulting in damage to the opponent.

7. The applicant filed a counterstatement in which it requested the opponent prove use. It states:

"2... There has been no, or not sufficient, use of the indicium RIVES by the Opponent in relation to alcoholic beverages to generate a protectable goodwill within the United Kingdom.

10. It is admitted that the goods that form the specification of the Application are included within those for which the Opponent's Mark is registered and

² In its statement of grounds and notice of opposition the opponent claimed first use of the sign RIVES in the UK in December 2015. The first witness states that the sign was first used in December 2014. At the hearing I asked the opponent to clarify the date of first use which was being claimed. It was confirmed as December 2014.

so are identical...There does not exist a likelihood of confusion as the marks in question are not sufficiently similar.”

8. The applicant denies the opponent’s claim under section 5(3) of the Act and states that the opponent does not have the necessary reputation.

9. Both sides filed evidence and skeleton arguments. The opponent was represented by Mr Kashif Syed of Beck Greener. The applicant was represented by Jonathan Moss of Counsel, instructed by Brandsmiths. Both attended by video conference held on 11 April 2017.

EVIDENCE

Opponent’s evidence

Witness statement of Felipe Toro Benjumea and exhibits FB1 - FB16

Applicant’s evidence

Witness statement of David James Rigby and exhibits DJ1 - DJR4

10. For reasons which will become apparent later in this decision I will not detail the evidence here.

DECISION

11. Section 5(2)(b) of the Act 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, or there exists a likelihood of confusion on the part of the

public, which includes the likelihood of association with the earlier trade mark.”

12. 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.”

13. The opponent's earlier mark is subject to proof of use because, at the date of publication of the application, it had been registered for five years.³ At this point, and for reasons which will become clear, I am going to presume that the opponent has shown the necessary use in respect of all of the goods in its specification.

Section 5(2)(b) case law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C -342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

³ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

15. In accordance with the above cited case law, I must determine who the average consumer is for the goods at issue and also identify the manner in which those goods will be selected in the course of trade.

16 In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*⁴, Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

⁴ [2014] EWHC 439 (Ch)

17. The average consumer is a member of the general public.⁵ The respective goods are made available through a variety of trade channels. They may be bought in a supermarket or off-licence, where the selection is likely to be made by the consumer from a shelf. They may also be bought from a website or mail-order catalogue, where the consumer will also select the goods visually. They may also be sold through bars, restaurants, clubs and public houses, where the goods may be requested orally, from a member of staff. However, in considering this point, I bear in mind the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM)⁶ when it 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.”

18. Consequently, even though the purchase of the goods in a bar or restaurant (and so on) may involve an aural element, the selection will be made, primarily, from the display of goods e.g. on shelves, in fridges and on optics at the back of the bar. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element.

19. The level of attention paid to the purchase will vary depending on the nature of the goods. As a general rule most of the respective goods are fairly low-value, reasonably frequent purchases. However, the parties’ specifications would also include such

⁵ For goods where the alcohol content exceeds 0.5% ABV the average consumer will be over 18 years of age.

⁶ T-3/04

goods as single malt whisky, vintage wines and champagne which are likely to be sold at a higher price and which may give rise to a higher level of attention being paid. In any event the level of attention paid will be that necessary to achieve, inter alia, the correct flavour, age, strength and variety. Accordingly, the average consumer will pay at least a reasonable level of attention to the purchase of the goods.

Comparison of goods

20. In paragraph 10 of its statement of grounds the applicant states:

“It is admitted that the goods that form the specification of the Application are included within those for which the Opponent’s Mark is registered and so are identical.”

21. It was confirmed at the hearing that the parties agree that the goods at issue are identical. This decision is based on the opponent’s class 33 goods only. If the opponent cannot succeed in respect of identical goods then it will be in no better position relying on goods in other classes.

Comparison of marks

22. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
<p>RIVES</p>	<p>THREE RIVERS & 3 RIVERS</p>

23. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁷, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

24. With regard to the comparison to be made between the respective marks, the opponent states:

“16. It should first be noted that the ‘Three/3’ element of the Applicant’s mark is non-distinctive for all of the goods claimed in class 33 of the Application as it is a numeral without any fanciful or unusual element and adds little to the mark other than specifying quantity. Further, the word ‘rivers’ has no meaning in relation to the goods at issue. The relevant public would make no connection between ‘rivers’ and alcoholic beverages or gin. Consequently, the dominant and distinctive element of the Applicant’s mark is ‘rivers’ and this should be the tribunal’s focus of attention.”

25. Throughout the hearing and in its written submissions the opponent omitted the first word/number of the applicant's mark from any comparison between the parties' respective marks. It did so on the basis of the decision in *Caterham Car Sales & Coachworks Ltd's Application*,⁸ which concerned an application for the number 7 for

⁷ *Sabel v Puma AG, para.23*

⁸ [2000] ETMR 14

goods and services in classes 12, 28 and 37. The third Board of Appeal at the EUIPO held that:

“The numeral 7 fell within the definition of a ‘sign’, but could not in principle be the subject of exclusive rights of use, in the absence of any unusual or fanciful feature.”

26. The opponent submits, relying on this authority, that in the absence of any unusual or fanciful feature the number 3 or its word equivalent is not capable of being a trade mark. That case is not on all fours with the situation before me in this case. The applicant had not applied for the number 3. The applicant’s mark is THREE RIVERS (and 3 RIVERS) and must be assessed on that basis.

27. There is no additional stylisation applied to this series of marks. In both cases the first part - 3/THREE - reads into the second word ‘RIVERS’, clearly defining the number of rivers. The overall impression of each of the marks in the applicant’s series of marks rests in their totalities.

28. The applicant’s mark is the word RIVES presented in upper case. There is no additional stylisation. The overall impression rests in the totality of the mark.

Visual and aural similarity of the marks

29. Having reached its conclusions outlined above, at paragraph 24, regarding the applicant’s mark, the opponent submits that the marks RIVERS and RIVES are visually virtually identical and aurally similar, differing only in the sound ‘er’.

30. The applicant states:

“11. There is virtually no aural similarity. The Rives Mark is pronounced like ‘hives’ or ‘jives’. The ‘ive’ sound in those words is different from the same letters in ‘rivers’. There is also the clear extra addition of the word ‘three’ at the start...”

13. Likewise, there is virtually no visual similarity apart from sharing 4 letters, namely 'rive'. The extra 'three' at the start is significant and the Three Rivers Mark would be considered as a whole. The 'three' at the start does not drop away like the Opponent seems to suggest."

31. Visually the five letters RIVES in the opponent's mark appear within the applicant's mark, being the 6th, 7th, 8th, 9th and 11th characters of THREE RIVERS and the 2nd, 3rd, 4th, 5th and 7th of the mark 3 RIVERS. The marks differ in the fact that the applicant's marks are made up of two parts and the second part 'RIVERS' contains the additional 'R' resulting in that word being 'RIVERS' not 'RIVES'. I find the parties' marks to be visually similar to a fairly low degree.

32. Aurally, the applicant suggests that the opponent's mark will be pronounced to rhyme with 'jives'. This is certainly one way in which it may be articulated but it is equally likely to be pronounced 'reeves'. The applicant's mark will be clearly understood by the average consumer and will be pronounced accordingly. Whichever way the opponent's mark is pronounced it is a single syllable whereas the applicant's mark is three syllables. The aural similarity between the marks is very low.

Conceptual similarity

33. The applicant states:

14. The Opponent failed to plead any conceptual meaning and therefore cannot do so now. In any event, it is hard to see what conceptual meaning it could have apart from being a made up word. The Three Rivers Mark on the other hand has a very clear conceptual meaning to the average consumer, i.e. that of three rivers. This conceptual meaning has nothing to do with the alcoholic goods for which registration is sought, and it [is] therefore highly distinctive for goods such as gin.

34. The opponent states:

“In the witness statement of Mr Rigby he says at paragraph 2 that ‘The purpose of this statement is to explain why we chose the brand name THREE RIVERS for our gin products’. He goes on to say at paragraph 7 that ‘three rivers run through Manchester City Centre; the River Irk, the River Medlock and the River Irwell’. He then provides a link to his company’s website at paragraph 8 which shows a webpage describing his company’s selection of the name. The tribunal should bear in mind that the assessment of section 5(2) is based on the notional average consumer of the products as applied for. In the absence of evidence of CLH’s significant use and reputation in the mark THREE RIVERS and the educating of consumers regarding the origin of its product, it cannot reasonably be argued that the notional average consumer would a) be aware of the waterways running through Manchester and b) even if he/she was aware, no connection would be made between THREE RIVERS and alcoholic beverages. It is thus of no consequence how CLH selected its name as the connection between the name and the product is so weak that it would not have any impact on the perception of the average consumer.”

35. I agree that it is unlikely that the average consumer of the applicant’s goods, any further afield than Manchester (and perhaps even in Manchester), would be familiar with the three rivers to which the name refers as a reference to an origin location for the goods. The suggested meaning is not one which would be apparent to the average consumer until he or she had been educated to see it that way and, with no evidence to that effect, I cannot make such a finding.

36. Rive is an English word, though in my experience, not one that is commonly used. It is likely to be unknown to many and, as a consequence, the average UK consumer of these goods will instead see the opponent’s mark as an invented word, or, I would add, possibly a word of unknown meaning from another language. In either case it does not convey a meaning which would be readily understood. In contrast, the applicant’s mark has a clear and immediate meaning, namely, three rivers.

37. Taking all of these factors into account, I find the marks to be conceptually dissimilar.

Distinctive character of the earlier mark

38. 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 used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger*.⁹

39. The opponent's earlier mark is RIVES. In terms of its inherent distinctiveness it makes no descriptive nor allusive reference to the goods and, despite it being a dictionary word in English, is most likely to be seen by the average consumer as an invented word or a word from another language with an unknown meaning. Consequently, it possesses a high degree of inherent distinctive character.

40. The opponent claims an enhanced level of distinctiveness as a result of the extensive use which has been made of its mark in relation to the goods listed in the registration. It concludes that this results in increased likelihood of confusion.

41. For reasons which will become clear below, I will presume the opponent's mark to possess the highest degree of distinctive character.

Likelihood of confusion

42. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.¹⁰ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to the interdependency principle i.e. a

⁹ *Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.*

¹⁰ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V paragraph 27*

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.

43. I have made the following findings:

- The average consumer is a member of the general public
- The level of attention paid to the purchase will vary. That said, the goods will require at least a reasonable degree of attention to be paid as the average consumer will need to consider, inter alia, the flavour, variety and strength.
- The purchase will be primarily a visual one, though I do not discount an aural element.
- The respective marks possess fairly low visual similarity, very low aural similarity and are conceptually dissimilar.
- The earlier mark has a high level of inherent distinctive character and I have presumed the highest degree of enhanced distinctive character.

44. In making a finding, I bear in mind the comments of Mr Iain Purvis Q.C. as the Appointed Person in *Kurt Geiger v A-List Corporate Limited*,¹¹ in which he pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark

¹¹ *BL O-075-13*

alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

45. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

46. It is clear here that the distinctive character of the earlier mark rests in ‘RIVES’. The application is for the series of marks ‘THREE RIVERS’ and ‘3 RIVERS’. ‘RIVES’ has no counterpart in the applicant’s mark and the high point of similarity is a fairly low visual similarity. Consequently, even if it were possessed of the highest degree of distinctive character it would not increase the likelihood of confusion.

47. Taking all of these factors into account, no matter how high the opponent’s level of use and distinctive character of the mark, or how low the level of attention to be paid to the purchase by the average consumer, I find the parties’ respective marks are not sufficiently similar to give rise to a likelihood of confusion.

CONCLUSION

48. The opposition fails under section 5(2)(b).

The grounds under sections 5(3) and 5(4)

49. If the opponent were able to show the necessary reputation for getting a case off the ground under section 5(3), which is defined in *General Motors*,¹² the lack of

¹² [1999] ETMR 950

similarity between the marks means that the necessary link would not be established.¹³

50. The opposition fails under section 5(3) of the Act.

51. Similarly, even if the opponent could show the goodwill required to begin a case under section 5(4) of the Act, the nature of the marks is such that there would not be the necessary misrepresentation.¹⁴

52. The opposition fails under section 5(4)(b) of the Act.

COSTS

53. The opposition having failed, the applicant is entitled to a contribution towards its costs. I award costs on the following basis:

Preparing a statement and considering the other side's statement:	£300
Commenting on the other side's evidence and filing evidence:	£500
Preparation for and attending a hearing	£300
Total:	£1100

54. I order Rives Pitman S.A. to Central Line Holdings Limited the sum of £1100. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 26th day of June 2017

¹³ Defined in *Adidas Saloman* [2004] ETMR 10 and *Intel* [2009] ETMR 13.

¹⁴ *Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue)* at paragraph 165 provides the analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731.

**Ms Al Skilton
For the Registrar,
The Comptroller-General**