

**TRADE MARKS ACT 1994**

**IN THE MATTER OF AN APPLICATION TO PROTECT INTERNATIONAL  
TRADE MARK REGISTRATION NO 688185 IN THE UNITED KINGDOM  
IN THE NAME OF BRASSERIE FISCHER SA  
IN CLASSES 33 AND 42**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 70324  
BY THE SILVER SPRING MINERAL WATER COMPANY LIMITED**

## **TRADE MARKS ACT 1994**

**IN THE MATTER OF International Registration No 688185  
by Brasserie Fischer SA to protect a Trade Mark  
in Classes 33 and 42**

**and**

**IN THE MATTER OF Opposition thereto under No 70324  
by The Silver Spring Mineral Water Company Limited**

### **BACKGROUND**

1. On the 27<sup>th</sup> February 1998, Brasserie Fischer SA (the applicants) sought to extend protection of International Trade Mark Registration No 688185 in Classes 32, 33 and 42 to the United Kingdom. The trade mark is reproduced below:



2. The application for protection (the application) was accepted and published in UK Trade Mark Journal 6321 on 29<sup>th</sup> March 2000, in Classes 33 and 42, Class 32 having been refused during the examination process. The Class 33 and 42 specifications are shown below:

**Class 33**

Alcoholic beverages (except beers); wines, mulled wines, bitter aperitifs, liqueurs, brandy, spirits, flavoured sparkling alcoholic beverages.

**Class 42**

Restaurant (providing food and drink), café, cafeteria, pub, bar, self-service restaurant and non-stop fast food restaurant services, and more generally, restaurant and hotel services; rental of vending machines.

3. The application successfully claimed an International Priority date of 29<sup>th</sup> August 1997.
4. On the 29<sup>th</sup> June 2000, The Silver Spring Mineral Water Company Limited (the opponents) filed a notice of opposition, accompanied by a statement of grounds for the opposition. They say they are the registered proprietors of UK Trade Mark Registration No 2102694 for the trade mark **UFO** in Class 32 in respect of:

“Non-alcoholic beverages; carbonated soft drinks; preparations for making non-alcoholic beverages”.

5. The opponents add that protection for the trade mark which is the subject of the application in suit should be refused in the United Kingdom under the terms of Section 5(2)(b) of the Act, on the ground that, because it is similar to the trade mark UFO Registration No 2102694, and is for goods and services similar to those of which that earlier trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes a likelihood of association with that earlier trade mark.
6. The opponents state that although negotiations have taken place between the two sides, the applicants have not withdrawn the designation of the UK from the application for protection nor amended the scope of the application.
7. On the 9<sup>th</sup> October 2000, the applicants filed a counterstatement, essentially denying the grounds of opposition.
8. Both sides seek an award of costs in their favour.
9. Neither party has requested an oral hearing in these proceedings and therefore after a careful study of all the papers, including the written submissions from the representatives of both parties in lieu of a hearing, I give this decision.

**The Law**

10. There is only one ground of opposition and that is Section 5(2)(b) of the Act. This 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.”

An earlier right is defined in Section 6 of the Act, the relevant part of which states:

“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,
- (b) .....
- (c) .....”

### **Application of the Law**

11. In deciding this case, I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v. Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc* [1999] E.T.M.R. 1, *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.

12. 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 of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel 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 Kaisha 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.

## **The Evidence**

13. The **opponents** filed a statutory declaration dated 15<sup>th</sup> January 2001 by **Stephen Geoffrey Hale**, a registered trade mark agent and a partner in the firm of JY and GW Johnson. He states that he has handled trade mark matters on behalf of the opponents for over ten years and makes the declaration on the basis of his own personal knowledge.

14. The **applicants** filed a statutory declaration dated 2<sup>nd</sup> May 2001 by **Marc Wenger**, Legal Director of the applicants. He says he has held this position in the firm for ten years and has worked in the drinks industry for six years. He includes one exhibit with his statutory declaration, but this is an example of some literature produced in France and is of no assistance to me in these proceedings. He also says the product was launched in France in 1998 (post-dating the relevant date in these proceedings, which is the International Convention priority dated claimed - ie 29<sup>th</sup> August 1997) and is proposed to be used in the UK in the future.

15. Nothing else of evidential weight emerges from these two statutory declarations. They concern themselves almost exclusively with the submission and arguments of the respective parties. These are summarised below.

## Arguments of the Parties

16. The opponents argued:

- (a) Despite the stylisation of the mark in the application, the letters UFO are clearly discernible and the only reasonable means of identifying the mark in speech or in ordinary writing. As such, the two marks in question are clearly confusingly similar, the opponents mark being the letters UFO (solus).
- (b) Although the goods of the respective marks are not identical, these are similar. Alcoholic beverages and non-alcoholic beverages are both consumed as drinks, either separately or in appropriate circumstances mixed, in bars, public houses, hotels, restaurants and other licensed premises and are sold through them and off-licence premises, including specialist stores as well as general stores and supermarkets. Although alcoholic drinks are differentiated from non-alcoholic drinks by the presence of alcohol, there are nevertheless ranges of alcoholic drinks and non-alcoholic drinks which are particularly similar to one another in other respects. These include not only the alcohol-free beers and lagers, which resemble ordinary or low alcohol beers and lagers, but also the alcoholic lemonades and alcopops, which resemble non-alcoholic lemonades and similar drinks. Such products can be readily confused with one another, particularly in a drinking scene. Carbonated soft drinks as a class thus particularly closely resemble flavoured sparkling alcoholic drinks and are liable to be confused under the circumstances where their alcohol content or lack of it is not immediately apparent.
- (c) The application in suit also covers the services “restaurant (providing food and drink), café, cafeteria, pub, bar, self-service restaurant and non-stop fast food restaurant services and, more generally, restaurant and hotel services; also rental of vending machines”, all in Class 42. Non-alcoholic drinks are of course regularly served in all such premises and are regularly vended through vending machines. Use of a trade mark for such services which is similar to a trade mark used for non-alcoholic drinks would therefore be likely to lead to confusion on the part of customers.
- (d) Accordingly, because the trade mark which is the subject of the application in suit is similar to the earlier trade mark **UFO**, which is registered under No 2102694, and is to be registered for goods and services which are similar to the goods for which the earlier trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark.

17. For the applicants Mr Wenger argues:

- (a) The applicants’ mark has a high degree of stylisation, and while the letters UFO are discernible, the whole mark resembles the front of a 1950's juke box.

- (b) The product of greatest interest to them is intended to be a sparkling alcoholic drink with blue Curacao liqueur.
- (c) The comments of Mr Hale in his statutory declaration for the opponents show that he has no specific knowledge of the drinks industry.
- (d) In his experience of the industry, consumers these days tend to know whether they wish to purchase alcoholic or non-alcoholic drinks and are now extremely unlikely to confuse the two. The dangers involved are only too apparent and whilst all beverages are consumed in a wide range of outlets, the only absolute similarity between them is the fact they are all liquid.
- (e) He agrees with the opponents that manufacturers attempt to make non-alcoholic or low alcohol beers and lagers physically resemble the equivalent alcoholic products. This may be in order to preserve the image and to allow those drinking low alcohol products to appear from a distance to be ordering and drinking the real (alcoholic) thing.
- (f) Commenting I assume, on Mr Hale's view in paragraph 5 of his statutory declaration that "carbonated soft drinks ...closely resemble flavoured sparkling alcoholic drinks .....", Mr Wenger says that: "the phenomenon of the "alcopop" is relatively recent. Given the publicity which attaches to the sale of these products, and the fact that many of them have quite substantial alcoholic strengths, I do not believe that they are "similar" in any way to soft drinks. Neither are they particularly similar to beers other than for the fact they contain alcohol. Few beer drinkers are interested in them. Much publicity now attaches to under-age drinking and to the danger of driving cars after drinking excess alcohol, and the public are becoming increasingly careful about whether or not a drink that they buy contains alcohol, and if so, how much. In this context, despite them all being beverages, non-alcoholic and alcoholic drinks are very distinct."
- (g) In his view it is absurd to generalise that all non-alcoholic drinks are similar to all alcoholic drinks. He says that non-alcoholic beverages are sold primarily to quench thirst. The alcoholic beverages covered by the applications are primarily drunk as digestifs, or as accompaniments to or after meals as aperitifs, or for their flavour. This is one important distinction quite apart from the non-alcoholic/alcoholic distinction. In addition, soft drinks and in particular mineral waters need relatively little intervention by their products, whereas alcoholic drinks are produced by much more involved manufacturing processes.

- (h) As regards the services in Class 42, he says that it is rare for restaurants to be considered as the source of origin of mineral waters or soft drinks they sell. No restaurants he knows of have their own springs. Whilst a very small number of restaurants do serve mineral waters or even wines bearing their name, implying perhaps some element of selection, these products usually show the true source also. People go to restaurants to eat food prepared for them in a particular way and to accompany this with well-chosen wines or other (usually) flavoured drinks which complement the food. The nature of any soft drink by way of accompaniment is of marginal interest.

## **The Decision**

18. Not surprisingly, as can be seen, the parties are poles apart on whether the marks and the goods are similar. Whilst it is more usual in Section 5(2)(b) cases to compare the goods and services first, in this instance I think it is more convenient to begin with the comparison of the marks, before I consider the more difficult issue (in this case) of the goods and services. Indeed, if I find no similarity between the marks, the latter issue need not be dealt with at all.

## **Comparison of Marks**

19. It is well settled that when comparing the marks, the visual, aural and conceptual similarities must be assessed - see paragraph 12(d) above.

20. I do not intend to labour the analysis of the comparison of these marks, but will comment in short on each of these three key considerations. Visually (despite what is accepted by both sides as a significant stylisation of the mark under opposition) there is no doubt in my mind that the letters UFO are clearly discernible. They appear vertically in the application in suit, but given the potential presentational scope of the trade mark UFO (solus) in the earlier right of the opponents, I do not think anything much rides on that. Aurally they will be pronounced as the letters UFO (or perhaps occasionally as the word equivalent pronounced phonetically “YOOFO”). Conceptually, the letters clearly have a commonly understood meaning - ie the well recognised abbreviation for “Unidentified Flying Object”. This final point in particular also affords both the marks in this case a highly distinctive character, which can increase the likelihood of confusion.

21. There is no doubt in my mind that overall the two marks are similar.

## **Comparison of Goods and Services**

22. For ease of reference, I include a side by side comparison of the two sets of goods/services involved:



<b>OPPONENTS EARLIER TRADE MARK NO 2102694</b>	<b>APPLICATION UNDER OPPOSITION</b>
Class 32  Non-alcoholic beverages; carbonated soft drinks; preparations for making non-alcoholic beverages.	Class 33  Alcoholic beverages (except beers); wines mulled wines, bitter aperitifs, liqueurs, brandy, spirits, flavoured sparkling alcoholic beverages
	Class 42  Restaurant (providing food and drink), café, cafeteria, pub, bar, self-service restaurant and non-stop fast food restaurant services and, more generally, restaurant and hotel services; rental of vending machines

23. I will deal first with similarity between the goods in Class 32 and Class 33. The submissions from the parties sheds no absolute light on how the marks in question are used on their respective goods. Indeed in the case of the application, the marks are not yet in use in the UK at the relevant date. In any event, I must make the assessment bearing in mind the concept of “fair and notional use” (see *Origins Natural Resources Inc v Origin Clothing Limited* [1995] FSR 280 and the comments of Simon Thorley QC acting as the Appointed Person in *React Trade Mark* [2000] RPC 288) of the marks on the goods that they cover.

24. In considering the similarities or otherwise of the goods in question, I take into account the guidance of the Courts, eg the *CANON* case (see paragraph 11 above). This refers to factors which are relevant in assessing the similarity of goods as set out in the *TREAT* case [1996] RPC 291 by Jacob J. (paragraph 23 of the judgement). These are:

- (a) The uses of the respective goods or services;
- (b) the users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets, and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are in competition with

each other; that enquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or the services in the same or different sectors.

25. Given the broad nature of some of the terms within the specification in suit, I do not intend to comment on each of these factors individually, but bear them all in mind in my findings.

26. Taking the first items in the two specifications - "Non-alcoholic beverages" from the opponents earlier right in Class 32 and "Alcoholic beverages (except beers)" from Class 33 of the application - I think the matter is very clear. Both these broad terms contain goods which are in effect the equivalents of each other, one being the non-alcoholic version; the other containing alcohol. Examples would be non-alcoholic wine, cider or perry in Class 32 and their alcoholic counterparts in Class 33. These have long been held under Registry practice as being "goods of the same description" under the 1938 Trade Marks Act and "similar goods" under the 1994 Act.

27. In saying the above, I do not suggest that all non-alcoholic drinks are similar to alcoholic drinks (as Mr Wenger refers to in his declaration as being absurd, using the examples of liqueurs or bottled aperitifs against plain water or sparkling lemonade). That indeed would be absurd. But that is not the issue. The issue is, as I have identified it above, ie that some alcoholic drinks in Class 33, have (in trade) their non-alcoholic equivalents in Class 32 and the breadth of the terminology used in the two specifications allows for potential equivalency or at least similarity to exist.

28. Looking at the remainder of the specification of the application namely "wines, mulled wines, bitter aperitifs, liqueurs, brandy, spirits, flavoured sparkling alcoholic beverages", all in theory are contained within the broad term "Alcoholic beverages (except beers)" in the specification, but contain items which require individual assessment. As I have said, in my view and as a matter of practice "wines" and by logical extension "mulled wines" have their non-alcoholic equivalents in Class 32 and therefore are similar to goods within the ambit of the opponents' earlier right ie "Non-alcoholic beverages". However, the opponents have failed to provide me with any evidence or indeed even submissions on the "bitter aperitifs, liqueurs, brandy and spirits" within the application. Whereas I am aware through my own knowledge and through registry practice, that eg wines, cider and perry have their non-alcoholic equivalents, I cannot say as much for these other goods. As such, I find that they are not similar to the "non-alcoholic beverages" in the earlier trade mark nor indeed to the rest of the specification for the mark.

29. The next item in the application is "flavoured sparkling alcoholic beverages". I am told in Mr Wenger's declaration that the product of greatest interest to the applicants when they put the mark to use in the UK in the future, is a "sparkling alcoholic drink flavoured with blue curacao liqueur and having a strength of approximately 5% alcoholic by volume". The drink itself is blue.

30. Are “flavoured sparkling alcoholic beverages” then, similar to any of the goods in the opponents’ earlier trade mark? I would say clearly they are. The terms “Non-alcoholic beverages; carbonated soft drinks” in the earlier trade mark would include items such as lemonade, colas and other flavoured soft drinks. Their alcoholic equivalents - ie a cola with alcoholic content, a sparkling lemonade drink with alcoholic content, a fruit juice with alcoholic content etc, would be in Class 33 and covered by the specification of the application.

31. In this case for all but “bitter aperitifs, liqueurs, brandy and spirits” the global assessment of all factors ie similarity of marks and goods and because of the high distinctive character of the earlier right of the opponents, I find that there is a likelihood of confusion on the part of the public, including the likelihood of association with the earlier mark and as such the **opposition partially succeeds in Class 33**. To retain these specified goods within the application, the applicants should take the action specified at paragraph 36 below.

### **Comparison of Services**

32. Other than the submission of the parties, I have no evidence on the position in trade regarding the goods of the opponents’ earlier right and the services of the applicant.

33. As a matter of practice the Registrar holds some goods in Class 32 (namely beers) as being similar to “Inn and public house services”, for example. But the specification of the earlier right at best includes non-alcoholic beers and as such, must move the goods further away from the services of the application. As can be seen from the guidance at paragraph 12(e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa.

34. In my view, in the absence of evidence, from my own knowledge of the circumstances in trade, I think it highly unlikely that the average consumer, on encountering even a trade mark of the high distinctive character of the earlier mark in suit here, would be confused into thinking that the goods and services in question emanated from the same source. I do not consider the mere fact that non-alcoholic drinks can be served in restaurants, cafès, pubs etc, to mean that they would be thought to cause a likelihood of confusion on the part of the public, including the likelihood of association with the earlier mark.

35. This is true, in my view also of the “rental of vending machines” in the specification of the application. Whilst I recognise that vending machines often carry pictures of the goods they vend, I have no evidence before me to indicate that the same trade mark used in relation to the rental of vending machines, is the same trade mark used on the goods they dispense. **As such the opposition fails in its entirety in Class 42**.

## **Conclusions**

36. I have found that the opposition succeeds in part in Class 33, except against “bitter aperitifs, liqueurs, brandy and spirits”. **To retain these specified goods within the application, the applicants should file within one month of the expiry of the appeal period from the decision, a Form T M 21 to restrict the specifications of goods in Class 33 to those specified items.** If no Form T M 21 is filed within the period set, the application in Class 33 will be refused in its entirety.

37. The opposition fails in Class 42.

## **Costs**

38. I have considered the costs issues carefully and decided that as both sides have achieved a measure of success in these proceedings, I do not intend to favour either side with an award of costs.

**Dated this 03 Day of September 2002**

**G J Rose’Meyer  
For the Registrar  
the Comptroller-General**