

O-031-09

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2422537
BY VRIJHEID UK LTD
TO REGISTER THE TRADE MARK:**

LE TRAPPISTE

IN CLASS 43

AND

**THE OPPOSITION THERETO
UNDER NO 94745
BY INTERNATIONAL TRAPPIST ASSOCIATION**

Trade Marks Act 1994

**In the matter of application no 2422537
by Vrijheid UK Ltd
to register the trade mark:
LE TRAPPISTE
in class 43
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INTRODUCTION

1) On 23 May 2006 Vrijheid Ltd made an application for the registration of the trade mark LE TRAPPISTE. The application was published for opposition purposes on 28 July 2006 with the following specification:

bar, restaurant, cafe, cafeteria, snack bar, public house, nightclub and catering services; preparation of food and drink.

The above services are in class 43 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

2) After publication the trade mark was assigned to Vrijheid UK Ltd, which I will refer to as Vrijheid.

3) On 30 October 2006 International Trappist Association, which I will refer to as ITA, opposed the registration of the trade mark.

4) In relation to the grounds of opposition under section 5(2)(b) of the Trade Marks Act 1994 (the Act), ITA relies on two Community collective mark¹ registrations in the name of Internationale Vereniging TRAPPIST (which is International Trappist Association in Dutch). The two registrations are:

- No 88745 for the collective mark:



¹ Section 1(2) of the Act states:

“(2) References in this Act to a trade mark include, unless the context otherwise requires, references to a collective mark (see section 49) or certification mark (see section 50).”

The application for registration was made on 24 July 1998 and the registration process was completed on 20 June 2000. Consequently, it is subject to the proof of use requirements². ITA claims that the mark has been used during the five years prior to the publication of the application in respect of *beers*. Vrijheid has required ITA to furnish proof of use of the trade mark in respect of these goods. *Beers* are in class 32 of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

- No 2922649 for the same collective mark. The application for registration was made on 6 November 2002 and the registration process was completed on 12 May 2004. Consequently, it is not subject to the proof of use requirements. The collective mark is registered for the following goods:

bleaching preparations and other substances for laundry use; cleaning, polishing, scouring and abrasive preparations; soaps; perfumery, essential oils, cosmetics, hair lotions; dentifrices;

coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice;

alcoholic beverages (except beers).

The above goods are in classes 3, 30 and 33 respectively of the Nice Agreement concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, as revised and amended.

5) ITA claims that *beers* of registration no 887455 and all of the goods of registration no 2922649 are similar to the services of the application. It claims

² The proof of use requirement was governed by rule 13(C) of the Trade Marks Rules 2000 which states:

“13C. - (1) The person opposing the registration, within three months of the initiation date -
(a) shall file any evidence he considers necessary to adduce in support of his grounds of opposition; and
(b) where -
(i) the opposition is based on an earlier trade mark;
(ii) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication; and
(iii) the truth of a matter set out in the statement of use is either denied or not admitted by the applicant,
shall file evidence supporting the statement of use.”

that the respective marks are similar, consequently, there is a likelihood of confusion and registration of Vrijheid's trade mark would be contrary to section 5(2)(b) of the Act, which states:

“(2) A trade mark shall not be registered if because -

.....

(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.”

6) In respect of registration no 887455, ITA claims that registration of Vrijheid's trade mark would also be contrary to section 5(3) of the Act, which states:

“(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC) in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

ITA claims that its collective mark has a reputation in respect of beers. ITA claims that its collective mark is well-known. It claims that there will be a blurring of its trade (sic) mark as its distinctiveness will be eroded, as will its singularity and exclusivity.

7) ITA claims that registration of Vrijheid's trade mark would be contrary to section 5(4)(a) of the Act, which states:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade,”

ITA claims that the sign TRAPPIST has been used in the United Kingdom in relation to beers since 1 January 1970. It claims that the sign, the subject of its collective mark registrations, has been used in the United Kingdom in relation to beers since 20 June 2000.

8) Vrijheid filed a counterstatement. It required proof of use of registration no 887455 in respect of beers. It denies that the registration of its trade mark would be contrary to sections 5(2)(b), 5(3) or 5(4)(a) of the Act.

9) In relation to section 5(2)(b) it states that there is not a likelihood of confusion as the respective marks are not sufficiently similar and the respective goods and services are not similar.

10) In relation to section 5(3) Vrijheid denies that that the respective marks are sufficiently similar and puts its claims to reputation and blurring to strict proof.

11) In relation to section 5(4)(a) Vrijheid is put to strict proof in relation to its claims.

12) Both sides filed evidence.

13) A hearing was held on 7 January 2009. Vrijheid filed written submissions in lieu of attending the hearing. ITA was represented by Mr Guy Tritton, of counsel, instructed by Taylor Wessing.

Evidence

Evidence of ITA

14) This consists of two witness statements made by Mr Jan M Van Gool. Mr Van Gool is president of ITA, a position that he has held since 2006. He has been associated with ITA since 2004.

15) ITA is a Belgian based international not for profit association which was granted legal personality by royal decree on 9 December 1997. ITA represents fourteen Trappist abbeys in Europe in respect of their traditional Trappist products, mainly beers and cheeses. The goods are produced by a production unit situated inside the monastery or in its immediate vicinity. Mr Van Gool states that “[t]hrough its physical configuration, organisation, use and management, the entire business demonstrates both an indisputable link of subordination to the accredited monastery and a business culture that fits in with monastic life”. The work is carried out by monks, nuns or lay persons from the accredited monastery, or by a business entrusted with the production, packaging and marketing, provided that the business is “dependent on the accredited monastery and operates under” its supervision in terms of production, administrative management methods, quality, publicity and financing. The proceeds are intended for material, intellectual and spiritual needs, the maintenance of the buildings, their fittings and the environment of the accredited monastery. Any surplus is used for charitable or social work or is given to other Trappist monasteries.

16) Mr Van Gool states that only seven beers which comply with the requirements mentioned above have been authorised to use the Trappist logo, the subject of the Community trade mark registrations. These are the beers of Chimay, Westvleteren, Westmalle, Koningshoeven (the La Trappe beers), Achel, Rochefort and Orval. Mr Van Gool states that only these seven beers are allowed to use the logo and to refer to the Trappist monasteries.

17) Mr Van Gool states that there have been substantial sales in the United Kingdom of products bearing the logo since the 1980s. Exhibited at JG3 is a table showing sales, in hectolitres, in the United Kingdom of Trappist ales under the logo since 2001.

	2001	2002	2003	2004	2005	2006	Total
Chimay							8,246.25
Orval	76.50	116.34	150.71	145.41	99.63	272.44	861.03
Rochefort	30.09	35.08	53.61	115.79	64.7	88.30	387.60
Westmalle		1308.00	2776.00	4260.00	2580.00		10,924

Total 20,418.88

1 Crate = 24 x 0.33 centilitres = 7.92 litres.
 20,418.88 hectolitres = 257,814 crates

Exhibited at JG4 – JG15 are various letters, translations of letters and e-mails re the sale of Chimay, Orval, Rochefort and Westmalle beers; these letters confirm the sales and/or the use of the Trappist logo in the United Kingdom. (A copy of an e-mail exhibited at JG15 re Westmalle beers shows total sales of 10,994 hl from 2002 to 2005, however, there is an arithmetical error and the total is as per exhibit JG3.) Exhibited at JG16 are figures for the export of Belgian beers. This shows sales of beers in the United Kingdom (in hls) of: 360,162 380,000, 443,175, 431,035, 591,760, 452,300 and 516,908 in the years 2000, 2001, 2002, 2003, 2004, 2005 and 2006 respectively (a total of 3,175,340 hls).

18) Mr Van Gool states that “numerous” publications on Belgian beers have been published in the United Kingdom. Exhibited at JG17 are copies of two pages from *Belgium’s Great Beers* by Michael Jackson headed “Trappist Beers”. Mr Van Gool indicates that the volume is 343 pages long and that it was published in 1998. In the section on Chimay Mr Jackson writes that it was this abbey that “coined the appellation “Trappist Beer”. Exhibit JG17 also includes pages about Trappist beer from *Wikipedia*, downloaded on 24 September 2007.

19) A letter is exhibited at JG18 to the second witness statement of Mr Van Gool in relation to the sales of La Trappe beers in the United Kingdom. The following sales figures (in hls) are given: 46.76, 70.72, 46.40, 83.72, 9.4, 267.24, 630.48 and 698.96 for 1999, 2000, 2001, 2002, 2003, 2004, 2005 and 2006 respectively. A letter is exhibited at JG19 giving the sales (in hls) in the United Kingdom of

Orval beers from 1997 to 2000, Rochefort beers from 1995 to 2000 and Chimay beers from 1985 to 1990 and from 1998 to 2000.

	1995	1996	1997	1998	1999	2000	Total
Rochefort	15.29	13.07	27.01	21.38	34.53	31.84	143.12
Orval			69.14	62.41	106.44	93.14	331.13

Chimay:

Year	HL
1985	44
1986	182
1988	108
1989	103
1990	487
1998	1173
1999	1111
2000	1337

20) Exhibited at JG21 are copies of pages from *Belgo Cookbook* by Denis Blais and André Plisneir. The book has a copyright date of 1997. The extract from the book exhibited is about Trappist beers. It refers to Chimay, Orval, Rochefort, Sixtus and Westmalle beers. The extract states that the Sixtus beer is on rare occasions available in London. Exhibited at JG21 are copies of pages from *Good Beer Guide to Belgium & Holland* by Tim Webb, the book was published by the Campaign for Real Ale (CAMRA) and bears a copyright date of 2002, the book was first published in 1992. Included in the exhibit is a section of the book that deals with Trappist beers. The extract refers to Achel, Chimay, Rochfort, Orval, Westmalle and Westvleteren beers. The section states, inter alia,

“The other one was at Schaapskooi abbey near Tilburg in the Netherlands, which still sells its beers under the names Koningshoeven or La Trappe. After being taken over by the Bavaria brewery of Lieshout in 1999 it had its right to use the “Authentic Trappist Product” logo withdrawn.”

“There is no beer style called Trappist. The term “Trappist Beer” is a designation of the brewery of origin. Indeed the logo “Authentic Trappist Product” is really a brand in the old sense, gifted by the Vatican. This appellation should be a guarantee of purity and excellence but unfortunately recent developments are threatening to drive a coach and horses through its reputation.”

21) Exhibited at JG22 are copies of two certificates from CAMRA’s annual Peterborough beer festival. The certificate from 1996 is for best beer in the

European bottled beer category; the certificate from 1997 is for best bottled beer. Both relate to Orval beer.

22) Exhibited at JG23 are copies of press articles that refer to Trappist beers:

- *What's Brewing* of October 1993 .
- *The Independent Imbiber* of August/September 1996.
- *Wine & Spirit International* of June 1998.
- *Independent on Sunday* of 15 March 1998
- *Business Week* of 29 December 1997.
- *The Bulletin* of 19 February 1998.
- *The Independent* of 10 August 2005.
- *Beers of the World* of March 2006.
- *Western Daily Press* of 3 February 2005.

Also included in the exhibit are copies of two articles which emanate from 22 June 2007 and May 2007, as so after the date of the application for registration.

Evidence of Vrijheid

Witness statement of Martin Bernard Matthews

23) Mr Matthews is the director and sole owner of Vrijheid. Vrijheid and its predecessor in title have been trading as a Belgian café bar under the name Le Trappiste in Altrincham, Cheshire since 2002. Mr Matthews states that his café bar sells beers from five of the six Trappist brewing monasteries in Belgium, and from the one Trappist brewing monastery in the Netherlands. Mr Matthews exhibits at MBM1 a copy of the café's beer menu from 2008. This includes both draft and bottled Trappist beers; the Trappist beers shown in the menu are Chimay, La Trappe, Westmalle, Rochefort, Orval, Achel and Westvieteren. Exhibited at MBM2 are pages downloaded from Le Trappiste's website. The website states that the café bar stocks all of the Trappist beers. At MBM3 a colour copy of the menu is exhibited. Mr Matthews notes that the Belgian theme of the café bar is reinforced by the use of the colours of the Belgian flag. A section of the menu is devoted to Trappist beer, this section is headed with the following wording:

“Only seven breweries can classify their beers as ‘Trappist’ and all are from Belgium with the exception of La Trappe. They are strong top fermented ales and are all brewed on the monastery premises. The beers can be dark or golden in colour.”

The café bar holds beer tasting evenings and exhibited at MBM4 are copies of two leaflets for such evenings.

24) Mr Matthews states that since 1 August 2005 Vrijheid has had an annual turnover of over £100,000 per annum. He states that the café bar has been reviewed by a number of organisations and exhibits at MBM5 copies of pages from websites with reviews of the café bar:

- belgianbeerguide.co.uk.
- outincheshire.co.uk.
- beerintheevening.com.
- ratebeer.com.
- foodanddrinkfestival.com.
- sugarvine.com.

The pages downloaded from foodanddrinkfestival.com relate to a Belgian Trappist beer tasting evening to be held on 9 October 2006.

25) Mr Matthews states that there are at least two other bars trading under the name Le Trappiste, one in Brussels and one in Paris; pages downloaded from the Internet in relation to these two establishments are exhibited at MBM6.

26) Mr Matthews states that he has not been aware of any customers who have believed that the café bar is in some way connected or associated with any of the brewers of Trappist beers or with the ITA.

Witness statement of Terry Roy Rundle

27) Mr Rundle is one of the trade mark attorneys acting for Vrijheid in this case.

28) Mr Rundle states that, with the exception of bottled beers from Westvleteren, all bottled beers from the Trappist monasteries carry the Trappist logo on their labels. Exhibited at TRR1 are copies of photographs of bottles of Trappist beers showing the Trappist logo:

- La Trappe – the logo appears on the rear label in a small format.
- Chimay - the logo appears on the rear label in a small format, the words Trappist beer appear on the front label, as do the words Pères Trappistes.
- Achel – the word Trappist appears on the front label as does the Trappist logo, the Trappist logo also appears on the rear label
- Trappistes Rochefort – the Trappist logo appears on the bottom left hand corner of the front label.
- Orval – this only has a neck label, upon the reverse of which the Trappist logo appears.
- Westmalle – Trappist appears under Westmalle on the front label, the Trappist logo appears in a small format on the rear label.

Proof of use of registration no 887455

29) Community collective mark 887455 is subject to the proof of use requirements. It has to be shown that there was genuine use of the collective mark during the five year period prior to the date of the publication of the application, ie 28 July 2006. ITA claims that there has been genuine use of the collective mark in respect of beers in this period. In its written submissions Vrijheid states:

“It is not disputed that the Opponent’s Mark has been used, but we do dispute that it has been used as a **trade mark** for the purposes of distinguishing the goods or services of the Opponent from the same or similar goods or services of other undertakings such as the Applicant. We submit that the Opponent’s mark is not being used as a trade mark, but as a collective or certification mark.”

It would appear that Vrijheid has not taken cognisance of the fact that the marks upon which ITA relies are collective marks, not trade marks. As the mark for which proof of use is required is a collective mark, one would expect to see that this is how it has been used.

30) The case law in relation to genuine use has dealt with genuine use in relation to trade marks. I will consider the claim to genuine use of the collective mark by reference to this case law, *mutatis mutandis*. The European Court of Justice (ECJ) in *Ajax Brandbeveiliging BV v Ansul BV* Case C-40/01 stated :

“36. “Genuine use” must therefore be understood to denote use that is not merely token, serving solely to preserve the rights conferred by the mark. Such use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of goods or services to the consumer or end user by enabling him, without any possibility of confusion, to distinguish the product or service from others which have another origin.

37. It follows that genuine use of the mark entails use of the mark on the market for the goods or services protected by that mark and not just internal use by the undertaking concerned. The protection the mark confers and the consequences of registering it in terms of enforceability vis-à-vis third parties cannot continue to operate if the mark loses its commercial *raison d’être*, which is to create or preserve an outlet for the goods or services that bear the sign of which it is composed, as distinct from the goods or services of other undertakings. Use of the mark must therefore relate to goods or services already marketed or about to be marketed and for which preparations by the undertaking to secure customers are under way, particularly in the form of advertising campaigns. Such use may be either by the trade mark proprietor or, as

envisaged in Article 10(3) of the Directive, by a third party with authority to use the mark.

38. Finally, when assessing whether there has been genuine use of the trade mark, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, in particular whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark.

39. Assessing the circumstances of the case may thus include giving consideration, *inter alia*, to the nature of the goods or service at issue, the characteristics of the market concerned and the scale and frequency of use of the mark. Use of the mark need not, therefore, always be quantitatively significant for it to be deemed genuine, as that depends on the characteristics of the goods or service concerned on the corresponding market.”

The essential function of a Community collective mark is to distinguish “the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings”³ so the collective mark guarantees to the consumer or end user that the undertaking using the collective mark is a member of the appropriate association.

31) In *MFE Marienfelde GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-334/01 the Court of First Instance (CFI) considered the practical application of the *Ansul* criteria:

“34 When assessing whether use of the trade mark is genuine, regard must be had to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark is real, particularly whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark, the nature of those goods or services, the characteristics of the market and the scale and frequency of use of the mark (*Ansul*, paragraph 43).

35 Concerning the extent of the use made of the earlier mark, account must be taken, in particular, of the commercial volume of all the acts of use on the one hand and the duration of the period in which those acts of use occurred, and the frequency of those acts, on the other.

36 In order to examine, in a given case, whether use of the earlier mark is genuine, an overall assessment must be made taking account of all the relevant factors in the particular case. That assessment implies a certain

³ Article 64(1) of Council Regulation 40/94 of December 20, 1993.

interdependence between the factors taken into account. Thus, a low volume of goods marketed under that trade mark may be compensated for by a high intensity or a certain constancy in time of the use of that trade mark or vice versa. Moreover, the turnover achieved and quantity of product sales under the earlier mark cannot be assessed in absolute terms but must be assessed in relation to other relevant factors, such as the volume of commercial activity, the production or marketing capacities or the degree of diversification of the undertaking exploiting the mark, and the characteristics of the products or services on the market in question. For that reason, the Court has held that use of the earlier mark need not always be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39).

37 However, the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the party opposing new registration to produce additional evidence to dispel possible doubts as to its genuineness.

In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the CFI stated:

“33 The Court of Justice also added, in paragraph 72 of the judgment in *Sunrider v OHIM*, paragraph 27 above, that it is not possible to determine *a priori*, and in the abstract, what quantitative threshold should be chosen in order to determine whether use is genuine or not, which means that a *de minimis* rule, which would not allow OHIM or, on appeal, the Court of First Instance, to appraise all the circumstances of the dispute before it, cannot therefore be laid down. Thus, the Court of Justice has held that, when it serves a real commercial purpose, even minimal use of the trade mark can be sufficient to establish genuine use (*LA MER*, paragraph 26 above, paragraph 58).”

32) The use of the collective mark, that ITA claims to have taken place is, by third parties, with the permission of ITA. Mr Tritton in his submissions effectively characterised this type of use as use by licensee. For the use to be considered to be with the permission of ITA it must be use that is allowed by the terms of the regulations governing the Community mark; just as use by a licensee must be within the terms of the licence⁴. ITA must have submitted the regulations

⁴ See by analogy the opinion of Advocate General Kokott in *Copad SA g Christian Dior couture SA ea* Rechtssache C-59/08 in relation to exhaustion of right and the terms of a licence:

“37. Art. 8 Abs. 2 der Richtlinie 89/104 ist somit dahin gehend auszulegen, dass der Markeninhaber die Rechte aus der Marke gegen einen Lizenznehmer geltend machen kann, weil dieser gegen eine Bestimmung des Lizenzvertrags verstößt, nach der der Verkauf an Discounter untersagt ist, wenn dieser Verkauf das Ansehen der Ware so stark beeinträchtigt, dass ihre Qualität in Frage gestellt wird.

governing the use of the collective mark to OHIM as per Article 65 of Council Regulation 40/94 of December 20, 1993, however, ITA has not furnished a copy of these regulations in these proceedings. Article 65 states:

“1. An applicant for a Community collective mark must submit regulations governing its use within the period prescribed.

2. The regulations governing use shall specify the persons authorized to use the mark, the conditions of membership of the association and, where they exist, the conditions of use of the mark including sanctions. The regulations governing use of a mark referred to in Article 64(2) must authorize any person whose goods or services originate in the geographical area concerned to become a member of the association which is the proprietor of the mark.”

In his first witness statement Mr Van Gool sets out that standards of ITA (see paragraph 15). He goes on to list the beers that comply with these standards. He states that “[o]nly these seven beers are allowed to use the logo and to refer to the Trappist monasteries”. In the absence of any challenge to this statement or any claim by Vrijheid that the use claimed by ITA is not within the terms of the collective mark regulations, I find that any use of the mark that is proven is use that complies with the regulations.

33) I am not aware of any authority that has decided the number of member states in which a Community mark has to be used to establish genuine use. In *ILG Ltd v Crunch Fitness International Inc* [2008] ETMR 17 the Fourth Board of Appeal of the Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) stated:

“11 The relevant period is October 1998 to October 2003. Use in one country of the Community, such as Italy, is sufficient (Joint Statements by the Council and the Commission entered in the Minutes of the Council meeting at which the CTMR was adopted, No.B.10, OH OHIM 1996, 607, 613), provided that is it [*sic.*] genuine.”

Decisions of the boards of appeal of OHIM do not have the status of being binding authorities. (The boards of appeal are not tribunals but parts of the administration system of the office⁵.) The view of the Fourth Board of Appeal

52. Art. 7 Abs. 1 der Richtlinie 89/104 ist somit dahin gehend auszulegen, dass ein Lizenznehmer, der Waren unter einer Marke unter Missachtung einer Bestimmung des Lizenzvertrags in den Verkehr bringt, nur dann ohne die Zustimmung des Markeninhabers handelt, wenn der Lizenznehmer durch den Vertrieb zugleich die Rechte aus der Marke im Sinne von Art. 8 Abs. 2 verletzt.

⁵ See *The Procter & Gamble Company v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-63/01:

does not sit very comfortably with Article 108 of Council Regulation 40/94 of December 20, 1993:

“2. Conversion shall not take place:

(a) where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the Member State for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;”

In the absence of any challenge by Vrijheid on this point, and the absence of any binding case law, I will follow the position advanced by the Fourth Board of Appeal.

34) In the statement of grounds, in relation to section 5(4)(a) of the Act, ITA states that the Trappist logo has been used in the United Kingdom since 20 June 2000. As part of the statement of grounds a statement of truth is made, I assume, therefore, that there must be a reason for such a specific date to be given. In various letters that have been exhibited a number of undertakings make claims that the Trappist logo has been used prior to that date eg in exhibit JG12 where Mr Ian Clay of James Clay & Sons writes that the logo had been used continuously for the ten years prior to 13 April 2007. In exhibit JG9 Ms Louise Smale writes that the logo has been used since at least 1986, however, ITA did not have a legal personality until 9 December 1997; so it is difficult to see how the collective mark could even have existence prior to this date. The letters that are exhibited do not, of course, contain statements of truth; they must be taken as hearsay evidence, hearsay evidence that, to some extent, is contradicted by the statement on the statement of grounds and the statement of Mr Van Gool. Despite the inconsistencies in the evidence, I consider that it is established that the collective trade mark has been used on beers branded under the names of Chimay, Orval, Rochefort and Westmalle during the relevant period, as per the letters that have been exhibited to the first statement of Mr Van Gool. Sales figures of these beers have been given in evidence. Sales figures have been given for La Trappe beers, however, there is no evidence that the collective mark has been used on the beers in the relevant period; although the evidence of Vrijheid shows use of the collective mark on La Trappe beers, this is not identified as being use in the relevant period. Mr Van Gool does not state that in the relevant period the collective mark has been used on La Trappe beers. “Genuine use of a trade mark cannot be proved by means of probabilities or

“23. In the light of the foregoing, the Boards of Appeal cannot be classified as ‘tribunals’. Consequently, the applicant cannot properly rely on a right to a fair ‘hearing’ before the Boards of Appeal of the Office. “

suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned.⁶

35) There is nothing to suggest that the use of the collective mark is solely to maintain a registration. In the period 2000 – 2006 the sales of all of the beers, excluding La Trappe (which emanates from the Netherlands), amounted to 0.69% of Belgian beers sold in the United Kingdom and so would amount to a fraction of the sales of all beers. The beers are expensive, they are a premium product. The sales have taken place consistently over a number of years. From the evidence of both parties it appears that there are a large number of brands in the beer, so many of them are bound not to have enormous sales. Taking into account the nature of the products and the market I consider that ITA has established genuine use of its collective mark.

36) It is necessary to decide upon a fair description for the goods for which genuine use has been shown. I must not be over picky⁷. It is necessary to consider how the relevant public, which for these goods would be the public at large, describe the goods⁸. The CFI in *Reckitt Benckiser (España), SL v Office*

⁶ *Kabushiki Kaisha Fernandes v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) Case T-39/01.*

⁷ *Animal Trade Mark* [2004] FSR 19:

“20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a picky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for three-holed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

⁸ *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1).

for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) Case T-126/03 stated:

“42 The Court observes that the purpose of the requirement that the earlier mark must have been put to genuine use is to limit the likelihood of conflict between two marks by protecting only trade marks which have actually been used, in so far as there is no sound economic reason for them not having been used. That interpretation is borne out by the ninth recital in the preamble to Regulation No 40/94, which expressly refers to that objective (see, to that effect, *Silk Cocoon*, cited at paragraph 27 above, paragraph 38). However, the purpose of Article 43(2) and (3) of Regulation No 40/94 is not to assess commercial success or to review the economic strategy of an undertaking, nor is it to restrict trade-mark protection to the case where large-scale commercial use has been made of the marks (Case T-334/01 *MFE Marienfelde v OHIM – Vétoquinol (HIPOVITON)* [2004] ECR II-0000, paragraph 32, and Case T-203/02 *Sunrider v OHIM – Espadafor Caba (VITAFRUIT)* [2004] ECR II-0000, paragraph 38).

43 Therefore, the objective pursued by the requirement is not so much to determine precisely the extent of the protection afforded to the earlier trade mark by reference to the actual goods or services using the mark at a given time as to ensure more generally that the earlier mark was actually used for the goods or services in respect of which it was registered.

That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

44 With that in mind, it is necessary to interpret the last sentence of Article 43(2) of Regulation No 40/94 and Article 43(3), which applies Article 43(2) to earlier national marks, as seeking to prevent a trade mark which has been used in relation to part of the goods or services for which it is registered being afforded extensive protection merely because it has been registered for a wide range of goods or services. Thus, when those provisions are applied, it is necessary to take account of the breadth of the categories of goods or services for which the earlier mark was registered, in particular the extent to which the categories concerned are described in general terms for registration purposes, and to do this in the light of the goods or services in respect of which genuine use has, of necessity, actually been established.

45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used actually belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of 'part of the goods or services' cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories."

37) Chimay, Orval, Rochefort and Westmalle beers all emanate from Belgium. In *West (Trading As Eastenders) v Fuller Smith and Turner Plc* [2003] ETMR 30 and [2003] FSR 44 it was decided that use of a trade mark only on bitter beer could not maintain a registration for beers at large. In this case the evidence

shows that the beers are not of one type, there is no Trappist style. All of the beers upon which use has been proved emanate from Belgium, should the specification be limited to Belgian beers?. As there is no Trappist style of Belgian beer there can be, a fortiori, no style of Belgian beer. It seems to me, therefore, that to categorise a beer as Belgian is artificial, if accurate, and that a fair specification for the registration will be *beers*, as claimed by ITA.

Likelihood of confusion – section 5(2)(b) of the Act

Average, relevant consumer and nature of purchasing decision

38) *Beers and alcoholic beverages* of the collective mark specifications are bought by the public at large who are over eighteen years of age. The other goods of registration no 2922649 are all bought by the public at large. Certain of the class 33 and class 3 goods, and *beers*, could be of high value and involve a careful and educated purchasing decision, however, they could equally be of low value and the result of an impulse or casual purchase. The services of the application will be used by all, although certain of them might be governed by age limits eg *public house services*. The nature of the services are such that they could be purchased very much on the spur of the moment, eg popping into a public house. In considering the likelihood of confusion I must take into account the lowest common denominator that could lead to confusion in relation to the goods and services, eg the impulse purchaser. Viewing the matter from the perspective of the lowest common denominator, the nature of the purchasing process is such that it increases the potential effects of imperfect recollection. (This is not to gainsay that the average consumer is reasonably circumspect and observant.)

Comparison of marks

39) The marks to be compared are:

ITA's collective mark:



Vrijheid's trade mark:

LE TRAPPISTE

40) The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details⁹. 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 components¹⁰. Consequently, I must not indulge in an artificial dissection of the trade marks, although I need to take into account any distinctive and dominant components. The average consumer 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 he/she is deemed to be reasonably well informed and reasonably circumspect and observant¹¹. The assessment of the similarity of the marks must be made by reference to the perception of the relevant public¹².

41) In the collective mark the words 'authentic' and 'product' clearly have a highly descriptive nature. The two toned hexagon device will not dominate the perception of a consumer. The word TRAPPIST is the largest word element in the trade mark. TRAPPIST is the dominant component of the collective mark. The French, singular male definite article of Vrijheid's mark is in terms of size the smallest part of the mark; it will also be seen as a French form of the definite article. TRAPPISTE is the dominant component of Vrijheid's mark. (However, LE does have a noticeable perceptual effect as it makes the mark appear to be French, despite the vast majority of the average, relevant customers having no idea that trappiste is the French for a Trappist monk. At the same time the average, relevant consumer will inevitably conflate Trappiste with Trappist.) The presence of the e at the end of TRAPPISTE will at the most have a marginal effect on the phonetic and visual similarities of the dominant components of the respective marks. One at all times has to consider the marks in their entirety, this requirement has particular significance in this case. The mark of Vrijheid evokes France as well as a religious order; the conceptual significance of the average, relevant consumer will be born of this combined perception. The collective mark clearly identifies a particular and authentic product, it will lead the average, relevant consumer to expect a product. The TRAPPIST element will have the conceptual association of a religious order. There is no French connotation attached to the collective mark. As a whole the word elements of the collective mark will have the conceptual association of a genuine product that relates to a particular religious order. (My considerations re the conceptual associations of TRAPPIST and TRAPPISTE are predicated upon the basis that the average, relevant consumer will be aware that this describes a religious

⁹ *Sabel BV v Puma AG* [1998] RPC 199.

¹⁰ *Sabel BV v Puma AG* [1998] RPC 199.

¹¹ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV* [2000] FSR 77.

¹² *Succession Picasso v OHIM - DaimlerChrysler (PICARO)* Case T-185/02.

order. I take this as a notorious fact¹³; the Trappists are, I believe, well-known owing to the generally held perception that they have taken vows of silence, whether that is in fact the case I have no idea.) In considering the overall visual similarity between the marks I have to take into account all elements of the marks; an element cannot be discarded from the consideration because of its limited distinctiveness¹⁴. In this case the hexagon device is completely alien to

¹³ I also bear in mind the decision of Mr Richard Arnold QC, sitting as the appointed person in *Air Parts Europe Limited v Inbev SA* BL O/160/08:

“Counsel for the opponent accepted, however, that the dictionary meaning of the word “beck” was “a brook, a rivulet; spec. a mountain, hill or moorland stream” (*Shorter Oxford English Dictionary*, 5th ed); and that, if the hearing officer had relied upon his own knowledge of the English language in reaching his conclusion as to how the word would be understood by the average consumer, that conclusion would not have been open to challenge. In these circumstances I consider that there was no material error in the hearing officer’s assessment.”

¹⁴ See the judgment of the European Court of Justice in *Société des Produits Nestlé SA c Office de l’harmonisation dans le marché intérieur (marques, dessins et modèles) (OHMI)* Case C-193/06:

“35 En particulier, la Cour a jugé à cet égard que, dans le cadre de l’examen de l’existence d’un risque de confusion, l’appréciation de la similitude entre deux marques ne peut se limiter à prendre en considération uniquement un composant d’une marque complexe et à le comparer avec une autre marque. Il y a lieu, au contraire, d’opérer la comparaison en examinant les marques en cause considérées chacune dans son ensemble (voir, en ce sens, ordonnance *Matratzen Concord/OHMI*, précitée, point 32, ainsi que arrêts précités *Medion*, point 29, et *OHMI/Shaker*, point 41).

41 Certes, au point 50 de l’arrêt attaqué, le Tribunal a examiné l’importance de l’élément figuratif propre à la marque demandée par rapport à son élément verbal. Toutefois, ayant constaté que cet élément figuratif n’est pas dominant par rapport à l’élément verbal, en ce sens que son intensité est égale ou inférieure à l’élément verbal et que ce dernier ne saurait donc être considéré comme subsidiaire ou négligeable, il a estimé pouvoir conclure à l’existence d’une similitude visuelle entre les signes en cause sur le seul fondement de la similitude des éléments verbaux, sans examiner, à ce stade ultime de son appréciation sur ce point, l’impression d’ensemble résultant, pour la marque demandée, de la combinaison d’un élément verbal et d’un élément figuratif.

42 Il est vrai que, selon la jurisprudence, l’impression d’ensemble produite dans la mémoire du public pertinent par une marque complexe peut, dans certaines circonstances, être dominée par un ou plusieurs de ses composants (voir, en ce sens, ordonnance *Matratzen Concord/OHMI*, précitée, point 32, et arrêts précités *Medion*, point 29, ainsi que *OHMI/Shaker*, point 41).

43 Toutefois, ainsi que la Cour l’a déjà jugé, ce n’est que si tous les autres composants de la marque sont négligeables que l’appréciation de la similitude pourra se faire sur la seule base de l’élément dominant (arrêt *OHMI/Shaker*, précité, point 42). Tel pourrait notamment être le cas, ainsi que le Tribunal l’a relevé au point 47 de l’arrêt attaqué, lorsqu’un composant d’une marque complexe est susceptible de dominer à lui seul l’image de cette marque que le public pertinent garde en mémoire, de telle sorte que le ou les autres composants de cette marque est ou sont négligeables dans l’impression d’ensemble produite par celle-ci.

46 Il en résulte que l’appréciation opérée par le Tribunal repose, aux points 48 à 50 de l’arrêt attaqué, sur la présomption selon laquelle, lorsqu’une marque complexe est composée à la fois

the mark of Vrijheid as are the words AUTHENTIC and PRODUCT; LE is totally alien to the collective mark. Overall the marks give rise to quite different visual impressions; despite the similarities of the TRAPPIST/TRAPPISTE elements, which elements are also phonetically similar.

Comparison of goods and services

42) In assessing the similarity of goods and services it is necessary to take into account, inter alia, their nature, their intended purpose¹⁵, their method of use and whether they are in competition with each other or are complementary¹⁶. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed¹⁷. In relation to construing words in a trade mark specification “one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”¹⁸. One should not give words in a specification an unnaturally narrow meaning¹⁹. Although it dealt with a non-use issue, I consider that the words of Aldous LJ in

d'un élément verbal et d'un élément figuratif, et que ce dernier est d'une intensité égale ou inférieure au premier, l'appréciation de la similitude visuelle des signes en cause peut être établie sur la seule base de la similitude des éléments verbaux, de sorte que, à intensité égale, ce sont uniquement ces derniers qui déterminent la similitude visuelle desdits signes.

47 Il s'ensuit que le Tribunal, en n'ayant pas apprécié la similitude visuelle des signes en cause sur la base de l'impression d'ensemble produite par ceux-ci, a méconnu l'article 8, paragraphe 1, sous b), du règlement n° 40/94 et que, partant, les points 48 à 50 de l'arrêt attaqué sont, à cet égard, entachés d'une erreur de droit.”

¹⁵ The earlier incorrect translation of 'Verwendungszweck' in the English version of the judgment has now been corrected.

¹⁶ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

¹⁷ He considered that the following should be taken into account when assessing the similarity of goods and/or services:

- “(a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective 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 competitive. This inquiry 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 services in the same or different sectors.”

¹⁸ *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281.

¹⁹ *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267.

Thomson Holidays Ltd v Norwegian Cruise Lines Ltd [2003] RPC 32 are also useful to bear in mind:

“In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under section 10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

Specifications for services should not be given an over wide construction²⁰.

43) Mr Tritton concentrated his submission in relation to the similarity of the goods and services on the *beers* of the collective mark. It is necessary to take into account the full panoply of the goods covered by registration no 2922649. I cannot see that the class 3 goods of this registration have any meaningful coincidences with the services of the application in terms of similarity. So the goods and services that I will be comparing are:

Vrijheid’s application: *bar, restaurant, cafe, cafeteria, snack bar, public house, nightclub and catering services; preparation of food and drink.*

ITA’s registrations: *beers; coffee, tea, cocoa, sugar, rice, tapioca, sago, artificial coffee; flour and preparations made from cereals, bread, pastry and confectionery, ices; honey, treacle; yeast, baking-powder; salt, mustard; vinegar, sauces (condiments); spices; ice; alcoholic beverages (except beers).*

As Mr Tritton concentrated on *beers* in relation to similarity, I assume that this represents the best case for ITA. Mr Tritton referred to the *Opposition Guidelines* of OHIM in relation to the similarity of *beers* to certain of the services of the application. These guidelines represent a view of an individual or group of individuals. They have the fundamental drawback that they cannot distinguish between the traditions and markets of each of the twenty seven member states. I doubt that the Deutsches Patent – und Markenamt will consign *Die Ähnlichkeit von Waren und Dienstleistungen* to the dustbin in favour of these guidelines. Mr

²⁰ *Avnet Incorporated v Isoact Ltd* [1998] FSR 16:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

Tritton also looked to the decision of Mr Geoffrey Hobbs QC, sitting as the appointed person, in *Balmoral Trade Mark* [1999] RPC 297. This decision was made in August 1998, prior to the judgment of the ECJ in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (although post *British Sugar Plc v James Robertson & Sons Limited*). The decision of Mr Hobbs in relation to the similarity of the goods and services is a question of fact and not a question of law. I consider that it is necessary to stick to first principles, ie comparing the respective goods and services within the parameters of the case law.

44) *Bar, café (if licensed) and public house services* all supply alcoholic beverages which will include *beers* and class 33 *alcoholic beverages*, such as ciders, wines and spirits. In effect the registrations of ITA encompass all alcoholic beverages. Often the serving of alcoholic beverages is the primary purpose of the establishments under consideration and the primary reason that their clients visit them. The purchasers of alcoholic beverages from retailers will be the same persons that visit these establishments. The purpose of both alcoholic beverages and the aforesaid establishments is the slaking of the thirst and/or arriving at a state of intoxication. I have often read and heard the licensed trade complaining that the sale of alcohol in supermarkets at low prices is taking trade from it. One can purchase an alcoholic beverage to drink at home from a shop or go to one of the aforesaid establishments to drink. Consequently, I consider that there is a degree of competition between alcoholic beverages and *bar, café (if licensed) and public house services*. The aforesaid establishments require alcoholic beverages to ply their trade and so the respective goods and services are complementary; this is not a case of mutual dependence but single dependence ie the service providers are dependent on alcoholic beverages but the suppliers of the goods are not dependent upon the service providers. However, whilst saying that, it is to be borne in mind that the supplying of alcoholic beverages to the licensed trade can form an important part of the business and trade of the producer of alcoholic beverages. Alcoholic beverages would be supplied in the fulfilment of the services and so the services would act as a channel of trade for these goods. Consequent on the above, *beers* and *alcoholic beverages* are similar to *bar, café and public house services*.

45) *Preparation of drink* must be included in *bar, café and public house services* and so also be similar to *beers* and *alcoholic beverages*.

46) In his submissions re the similarity of the goods and services Mr Tritton referred to the tradition of tied public houses in the United Kingdom, where the brewery owns the public house. I am unable to see how this relates to the issue of similarity of the goods and services. It is, however, something that can be considered in the global appreciation as to likelihood of confusion. I have, however, taken into account above that alcoholic beverages would be supplied in the fulfilment of the services under consideration.

47) This leaves *restaurant, cafeteria, snack bar, nightclub and catering services, preparation of food and drink* to be considered in relation to similarity of goods and services. In making this comparison I keep to the forefront of my mind the *Avnet* principle of not giving an over wide construction to the specification of the application. *Restaurant, cafeteria, snack bar, catering services, preparation of food* are all primarily food related services; the supply of alcoholic beverages may be ancillary to certain of the services but does not represent the primary purpose. The user of these services is primarily attempting to satisfy hunger rather than slake the thirst. I consider it unlikely that *snack bar* services would supply alcoholic beverages. Consequently, I consider that the use of the respective goods and services is for primarily different purposes. Owing to this fundamental, primary difference the uses of the respective goods and services are not the same. I cannot see that one would purchase an alcoholic beverage as a substitute for these services. Although an alcoholic beverage might be taken with food, I cannot see that there is any dependent or symbiotic relationship involved. Consequently, I do not consider that the respective goods and services are either complementary or in competition. Alcoholic beverages could be supplied in the fulfilment of *restaurant, cafeteria and catering services* and so these services would act as a channel of trade. At the best there is a very low degree of similarity between *beers and alcoholic beverages* and *restaurant, cafeteria and catering services*. I do not consider that the aforesaid goods are similar to *snack bar services and preparation of food*.

48) I am aware that in *Group Lottus Corp, SL v c Oficina de Armonización del Mercado Interior (marcas, dibujos y modelos) (OAMI)*, Case T – 161/07 the CFI held that there was a low degree of similarity between beers and nightclub services²¹. I am not convinced that the understanding of *nightclubs (salas de*

²¹ “33 A este respecto, la afirmación de la demandante de que las cervezas y los servicios citados no se destinan al mismo público (véase el apartado 20 de la presente sentencia), no basta para poner en entredicho la relación de complementariedad declarada probada por la Sala de Recurso. En efecto, como señala acertadamente la resolución impugnada en el apartado 46, aunque es cierto que un «bar de copas» evoca un bar con más estilo y más clase, donde la gente puede charlar mientras escucha música discreta y toma una copa, hoy en día este término se usa cada vez más en el negocio de los restaurantes, los bares y los hoteles como un eufemismo de lo que se llamaba un bar o un pub en un lenguaje más coloquial. En cualquier caso, los establecimientos que proporcionan servicios de bar de copas, generalmente también ofrecen cervezas. Lo mismo sucede respecto a los «servicios de esparcimiento, discoteca y sala de fiestas» (véase el apartado 49 de la resolución impugnada).

34 Asimismo, el hecho de que la interviniente haya solicitado el registro de la marca denominativa COYOTE UGLY para servicios de las clases 41 y 42 (véase el apartado 21 de esta sentencia) no tiene incidencia en el presente asunto. En él, el riesgo de confusión mencionado por la resolución impugnada se refiere a las cervezas de la marca anterior, por una parte, y a los servicios de bar de copas y a los servicios de esparcimiento, discoteca y sala de fiestas para los que se solicita el registro de la marca, por otra parte. No se discute que estos productos y servicios son distintos, y únicamente se ha declarado probado que presentan cierto grado de complementariedad. El hecho de que la interviniente haya solicitado el registro de otra marca denominativa expresamente para servicios de las clases 41 y 42 no pone en entredicho esta conclusión.

fiestas) by the CFI equates with the current position in the United Kingdom. At one time a nightclub described the sort of establishment that Paul Temple would visit; a place supplying food, drink and a cabaret. Perhaps such establishments still flourish in London, they are not abundant elsewhere, in my experience. Nowadays the nightclub is normally described as a club; it is an establishment that encourages vertical drinking, is open until the small hours of the morning and has loud music playing. The entertainment side is of importance, but equally the same can be said for many public houses which will use the showing of sporting events or karaoke sessions to entice customers. I consider that the similarities established in relation to *bar, café and public house services* and *beers and alcoholic beverages* applies, if perhaps to a lesser extent and so *nightclub services* are similar to *beers and alcoholic beverages*.

49) Consequent upon my findings above I need to consider *restaurant, cafeteria, snack bar, catering services and preparation of food* in relation to the class 30 specification of registration no 2922649, in order to decide if there is a greater degree of similarity in relation to these goods that in relation to *beers and alcoholic beverages* or any similarity at all. (The class 3 goods of the earlier registration will certainly not add anything to ITA's case.)

50) The class 30 specification does not encompass prepared meals which would be the closest goods to the services under consideration; as restaurants often supply both meals to be eaten on the premises and to be carried- out, and there are many catering establishments that only provide carry-out meals. Taking into account the *Avnet* principle I do not consider that the parts of the specification under consideration would encompass coffee houses (such as Starbucks®) and so there is no close link with coffee or tea; that sort of establishment would be encompassed by *café services and preparation of drink*, for which I have already found similarity in relation to *beers and alcoholic beverages*. All of the class 30 goods would be used in the relation to the services under consideration but so would plates, cups and glasses, this does not establish similarity²². As the components of goods are not necessarily similar to the goods²³, it seems to be

35 Por consiguiente, la Sala de Recurso obró acertadamente al considerar que, aunque las «cervezas» y los «servicios de discotecas y salas de fiestas» difieran por su naturaleza y su origen comercial, no puede negarse que existe un menor grado de similitud entre estos productos y servicios si se tiene en cuenta el grado de complementariedad identificado en la resolución impugnada. Lo mismo cabe decir respecto a los «servicios de esparcimiento», que comprenden las discotecas y las salas de fiesta, como se indica en el apartado 48 de la resolución impugnada. En efecto, aunque es muy probable que exista otro tipo de esparcimiento distinto de las discotecas y las salas de fiesta, no corresponde a la Sala de Recurso o al Tribunal de Primera Instancia, sino a la demandante, definir los servicios incluidos en la rúbrica «servicios de esparcimiento» que no presenten similitudes con sus propios productos.”

²² cf *Assembled Investments (Proprietary) Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-105/05

²³ cf *Les Editions Albert René v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-336/03:

that it is even less likely that similarity is likely to be established where components are used to produce a final product which is the subject of a service. Taking into account the criteria of both *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* and *British Sugar Plc v James Robertson & Sons Limited* I cannot see that there is any meaningful coincidence between the services *restaurant, cafeteria, snack bar, catering services* and *preparation of food* and the class 30 goods of the earlier registration. (Bearing in mind that I do not consider it necessary to consider *coffee* in relation to the services owing to my findings in relation to *alcoholic beverages* and *beers*.) (Mr Tritton put forward no arguments in relation to the class 30 goods, concentrating his fire power on ITA's beer.)

Summing up of similarity of goods and services

51) *Beers and alcoholic beverages* are similar to *bar, café and public house services, nightclub services* and *preparation of drink*. There is a very low degree of similarity between *beers and alcoholic beverages* and *restaurant, cafeteria and catering services*. *Snack bar services and preparation of food* are not similar to the goods of the earlier registration.

Conclusion re likelihood of confusion

52) In considering whether there is a likelihood of confusion various factors have to be taken into account. There is the interdependency principle – a lesser degree of similarity between trade marks may be offset by a greater degree of similarity between goods, and vice versa²⁴. Certain of the services are not similar to the goods of the earlier registrations, consequently, there can be no likelihood of confusion. Certain of the services are similar to the goods of the earlier registration to a very low degree. Certain of the services enjoy a reasonable degree of similarity with the goods of the earlier registration.

53) It is necessary to consider the distinctive character of the earlier trade mark; the more distinctive the earlier trade mark the greater the likelihood of confusion²⁵. The distinctive character of a trade mark can be appraised only, first, by reference to the goods or services in respect of which registration is

61 The applicant's arguments can only be rejected. It is true that computers in different forms are necessary for the proper operation of 'instruments and installations for telecommunication' and 'telephone-answering service (for temporarily absent subscribers)' may occasionally be supplied by the body which manufactures the necessary equipment, but that is not enough to conclude that those goods and services are similar, still less 'very similar'. The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.

²⁴ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117.

²⁵ *Sabel BV v Puma AG* [1998] RPC 199.

sought and, secondly, by reference to the way it is perceived by the relevant public²⁶. In determining the distinctive character of a 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 mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings²⁷. In relation to section 5(3) of the Act (see below) I find that ITA has not established an enhanced reputation in relation to its collective mark. Mr Tritton argued that the Trappist element of ITA's trade mark was distinctive in the same way that Coca-Cola is distinctive. Coca-Cola is a brand, a trade mark, that is its essence, outwith the carbonated beverage it does not have a meaning; it is also, perhaps, the most famous brand in the world. Trappist is not primarily a brand, in the context of this case it is not a trade mark but a collective mark. The essence of the word Trappist is that it describes a religious order, not a brand for a product. I cannot see that Mr Tritton's analogy holds good. In considering Trappist and its distinctiveness in relation to the goods for which it is registered it is necessary to consider the collective mark as a whole. In considering likelihood of confusion one is considering the perception of the average, relevant consumer so one is looking at the sense of the collective mark rather than its meaning²⁸. In this case I

²⁶ *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

²⁷ *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

²⁸ "The first and basic one is the preponderance of the sense [smysl] of a word over its meaning [znachenie] – a distinction we owe to Frederick Paulhan. The sense of a word, according to him, is the sum of all the psychological events aroused in our consciousness by the word. It is a dynamic, fluid, complex whole, which has several zones of unequal stability. Meaning is only one of the zones of sense, the most stable and precise zone. A word acquires its sense from the context in which it appears; in different contexts it changes its sense. Meaning remains stable throughout the changes of sense. The dictionary meaning of a word is no more than a stone in the edifice of sense, no more than a potentiality that finds diversified realization in speech." *Thought and Language* by Lev Vygotsky translated by Alex Kozulin, The MIT Press. See also the judgment of the CFI in *Ratiopharm GmbH v Harmonisierungsamt für den Binnenmarkt (Marken, Muster und Modelle)* (HABM), Case T-48/07:

"29 Was erstens das Argument angeht, der Ausdruck „biogenerics“ könne hinsichtlich der fraglichen Waren nicht beschreibend sein, weil es aus wissenschaftlicher Sicht keine generischen Biopharmaka gebe, so ist daran zu erinnern, dass das maßgebliche Kriterium für die Beurteilung des beschreibenden Charakters die Wahrnehmung durch die maßgeblichen Verkehrskreise ist (vgl. Urteil WEISSE SEITEN, Randnr. 90 und die dort angeführte Rechtsprechung). Selbst wenn nämlich insoweit das Bestehen biotechnologisch hergestellter generischer pharmazeutischer Erzeugnisse in technischer Hinsicht streitig sein sollte, steht doch fest, dass der Ausdruck „biogenerics“ von den maßgeblichen Verkehrskreisen so verstanden werden wird, dass er einem Erzeugnis aus dem pharmazeutischen, medizinischen oder wissenschaftlichen Bereich entspricht. Zum einen werden nämlich Durchschnittsverbraucher den Ausdruck als eine Beschreibung patentfreier biotechnologisch hergestellter pharmazeutischer Erzeugnisse wahrnehmen, da sie sich nicht der Schwierigkeiten bewusst sind, mit denen eine Reproduktion der Wirkstoffe dieser Erzeugnisse verbunden ist. Zum anderen belegen die Beweismittel, auf die sich die Prüferin und die Beschwerdekammer gestützt haben, dass eine Verwendung des

consider that the sense and the meaning are one and the same. The collective mark of ITA tells the average, relevant consumer that the product has the characteristic or quality of being genuinely made by Trappists or coming from a Trappist monastery²⁹. If Trappist had transcended into a brand rather than a religious order this could add to distinctiveness³⁰. However, as it is, I consider

Ausdrucks „biogenerics“ zur Bezeichnung dieser Erzeugnisse durch gewerbliche Verbraucher und in Fachkreisen trotz seiner in technischer Hinsicht bestehenden Ungenauigkeit üblich ist.”

²⁹ cf *Score Draw Limited v Alan James Patrick Finch* [2007] EWHC 462 (Ch) Mann J:

39. The words "other characteristics of goods or services" are obviously more general than the more specific words which precede it. They demonstrate that the preceding words are not the only way in which the provisions of the subsection can be fulfilled. It is therefore open to Score Draw to seek to demonstrate that the badge operates so as to be descriptive of some characteristic of goods other than those enumerated in the section. It seeks to do so by saying that the badge identifies the Brazilian football team nature of the goods to which it is applied. Mr Reed found it hard to articulate the precise characteristic involved, but it was of that general nature. By way of a parallel, Mr Reed relied on *Linkin Park LLC's Application, Case O-035-05* [2006] ETMR 74.

40 In that case the appointed person (Mr Richard Arnold QC) had to consider whether the name of a pop group (Linkin Park) was descriptive under head (c) when applied to posters and books. He held that the term "other characteristics" did not have to be construed *ejusdem generis* with the other characteristics referred to, and in paragraph 44 said:

"I see no reason why subject matter should not qualify [as a characteristic]."

He said that in order to deal with a submission that subject matter should indeed not qualify. He was implicitly accepting the suggestion that the expression "Linkin Park" in its context did indeed amount to a description of subject matter. He observed in paragraph 42:

"By the application date the Mark was no longer meaningless, but on the contrary had acquired a well-established meaning of denoting the Group."

41. I find this analysis, and the parallel with the present case, helpful. The mark in this case is not a mark which, in its actual terms, describes subject matter in the same way as the words "Linkin Park" would have described subject matter in the *Linkin Park* case by making those very words descriptive of the characteristics of the goods. However, the effect of the badge, in the eyes of the relevant public is very similar. The CBD badge would, on the evidence, be recognised by them as denoting the clothing as Brazilian team clothing because the badge had been part of that clothing for many years, had in particular been part of the clothing of more modern successful teams, and since the mid-90's had been sold as a necessary and integral part of replica kit. It does not say "Brazilian National Club" in terms, but it would mean that to the relevant public even if (as seems likely) they do not know the Portuguese words for which the initials stand. I consider that in the circumstances the badge is descriptive of a characteristic of the clothing which bears it in the sense that it connotes that the clothing is, or has an association with, the historic Brazilian national team.

³⁰ In the copy of an article from *The Independent on Sunday*, exhibited at JG23, the following appears:

"Orval has appointed a marketing manager, François de Harenne, who says the trademark is "not a logo of quality", admitting, I'm happy if the consumer considers it as such, but the real aim is a sign saying the beer comes from a Trappist monastery."

that for the average, relevant consumer the collective mark will describe a characteristic or quality and so have a very low degree of inherent distinctiveness, a low degree that is not improved by the use that has been shown.

54) Mr Tritton referred to the tradition of tied public houses in the United Kingdom. I consider that this is a notorious fact; despite this being less the case nowadays; various brewers having been made to dispose of their estates or part of their estates by competition authorities. This is a factor that must be given some weight in relation to *bar* and *public house services*; I do not consider that it is a relevant factor in relation to the other services.

55) As decided above, the nature of the purchasing decision means that the possibilities of the effects of imperfect recollection are increased.

56) In *Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM) v Shaker di L Laudato & C Sas* Case C-334/05 P the European Court of Justice

“41 It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, 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. On the contrary, 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 (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42 As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

57) “[C]onceptual and visual differences between two signs may counteract aural similarities between them, provided that at least one of those signs has, from the point of view of the relevant public, a clear and specific meaning, so that the public is capable of grasping it immediately”³¹.

58) In *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-3/04 the CFI held:

³¹ *Mülhens GmbH & Co KG v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case C-206/04 P.

“45. It must be stated that, contrary to what the applicant maintains, where a sign consists of both figurative and verbal elements, it does not automatically follow that it is the verbal element which must always be considered to be dominant.

47. It is also apparent from the case-law of the Court of First Instance that, in a compound sign, the figurative element may occupy a position equivalent to the verbal element (see Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraph 53).

48. In addition, even in circumstances where two conflicting marks are composed of similar verbal elements – which is not the case here – that fact does not, by itself, support the conclusion that there is a visual similarity between the signs. The presence, in one of the signs, of figurative elements set out in a specific and original way can have the effect that the overall impression conveyed by each sign is different (see, to that effect, Case T-156/01 *Laboratorios RTB v OHIM – Giorgio Beverly Hills (GIORGIO AIRE)* [2003] ECR II-2789, paragraph 74).

56. As OHIM has wisely observed, the degree of phonetic similarity between two marks is of less importance in the case of goods which are marketed in such a way that, when making a purchase, the relevant public usually perceives visually the mark designating those goods (see, to that effect, Case T-292/01 *Phillips-Van Heusen v OHIM – Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 55).

58. 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.

59) Although one might be recommended a bar, public house etc, one is going to look at the signage and take cognisance of it before entering. The signage of licensed premises is one of the oldest traditional uses of a trade mark in the United Kingdom. The goods and services are both primarily chosen and distinguished by the eye and so visual similarity, of lack thereof, is a key issue.

60) The collective mark shouts that it relates to a product, a very particular product with the characteristic/quality of having been produced by Trappists. It tells the average, relevant consumer that it is a product, not a service. It leaves

the average, relevant consumer in no doubt as to this message it sends. Vrijheid's trade mark tells the average, relevant consumer that this is something French and something relating to Trappists. It does not speak of a product, it does not speak of a characteristic or quality. Despite the Trappist link it has a sense that is different to the collective mark.

61) Having weighed up all the factors, and taking into account ITA's best position of *beer* against *public house services*, I have come to the conclusion that the average relevant consumer would not believe that the services of Vrijheid and the goods of ITA come from the same source or from an economically linked source or that Vrijheid was part of ITA. (Of course, the average, relevant consumer is most unlikely to know that ITA's mark is a collective mark or what a collective mark is.) **There is not a likelihood of confusion and the grounds of opposition under section 5(2)(b) of the Act are dismissed.**

Section 5(3) of the Act

62) For its claim to be considered under section 5(3) of the Act ITA must establish that its collective mark is known to "a significant part of the public concerned by the products or services covered"³². Following the judgment of Mr Geoffrey Hobbs QC, sitting as a deputy high court judge, in *Whirlpool Corporations and others v Kenwood Limited* [2008] EWHC 1930 (Ch) use in the United Kingdom can be enough to establish the requisite reputation for a Community mark:

"76.....I think that the aim should generally be to prevent conflict occurring in any substantial part of the Community and that the United Kingdom can for that purpose be regarded as a substantial part of the Community, with or without the addition of France and Germany."

63) In the period 2000 – 2006 the sales of all of the beers amounted to 0.69% of Belgian beers sold in the United Kingdom. There is no indication as to the percentage of the whole United Kingdom beer market that the beers have but it must be considerably smaller than that. The collective mark has not been promoted in any way. It is used as a subsidiary mark. Mr Tritton tried to lay claim to use of the word TRAPPIST to support his case. I have to consider the mark that is registered, not another mark. Mr Tritton was not able to support this submission re taking into account the use of the word TRAPPIST with any case law.

64) It is possible for marks with limited sales to have exceptional reputations, to become almost part of the common lexicon; that is a question of fact and there is nothing to suggest that ITA has achieved this in relation to its collective mark. **I do not have the slightest hesitation in finding that ITA has not established**

³² *General Motors Corporation v Yplon SA* Case C-375/97 [2000] RPC 572.

that at the material date it had the requisite reputation. The grounds of opposition under section 5(3) of the Act, therefore, are dismissed.

Passing-off – section 5(4)(a) of the Act

65) The principles of the law of passing-off were summarised by Lord Oliver in *Reckitt & Colman Products Ltd v. Borden Inc* [1990] RPC 341 at page 406:

“The law of passing off can be summarised in one short, general proposition: no man may pass off his goods as those of another. More specifically, it may be expressed in terms of the elements which the plaintiff in such an action has to prove in order to succeed. These are three in number. First he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by him are the goods or services of the plaintiff. ... Thirdly he must demonstrate that he suffers, or in a *quia timet* action that he is likely to suffer, damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff.”

66) The generally accepted definition of goodwill is that of Lord Macnaghten in *IRC v Muller & Co's Margarine Ltd* [1901] AC 217:

"What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start. The goodwill of a business must emanate from a particular centre or source. However widely extended or diffused its influence may be, goodwill is worth nothing unless it has power of attraction sufficient to bring customers home to the source from which it emanates. Goodwill is composed of a variety of elements. It differs in its composition in different trades and in different businesses in the same trade. One element may preponderate here and another element there. To analyse goodwill and split it up into its component parts, to pare it down as the Commissioners desire to do until nothing is left but a dry residuum ingrained in the actual place where the business is carried on while everything else is in the air, seem to me to be as useful for practical

purposes as it would be to resolve the human body into the various substances of which it is said to be composed. The goodwill of a business is one whole, and in a case like this it must be dealt with as such. For my part, I think that if there is one attribute common to all cases of goodwill it is the attribute of locality. For goodwill has no independent existence. It cannot subsist by itself. It must be attached to a business. Destroy the business, and the goodwill perishes with it, though elements remain which may perhaps be gathered up and be revived again."

67) How goodwill is to be established has been dealt with in several judgments³³. *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* establishes that one cannot just follow a formula or demand certain predetermined requirements to be met.

68) ITA neither produces nor sells beers, it does not have a trade in them. Any goodwill in the sales of the beers resides with the various brewers which produce them, not with ITA. On the principle established in *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1999] RPC 826 ITA could not bring an action for passing-off in the courts as it does not have a title to sue. In that case Chadwick LJ held:

"I respectfully agree with the Vice-Chancellor's view that it would be convenient if a trade association were permitted to sue in a representative capacity on behalf of its members. But I find it impossible to reach the conclusion that that is permitted under the language of Order 15, rule 12(1) in circumstances where, as will usually be the case, the trade association either has no interest of its own capable of founding a cause of action; or, if it has any interest of its own, that is not the same interest as that interest of its members. The remedy lies in an alteration to the Rules of Court. It does not lie in bending those Rules to allow a representative action in circumstances which, as drawn, they were not intended to cover.

For those reasons I take the view that Chocosuisse does not have locus to sue in these proceedings, whether in its own right or as a representative of the Swiss chocolate manufacturers."

The key issue was that Chocosuisse did not have a locus standi. These proceedings were commenced prior to 1 October 2007, so prior to the coming into effect of The Trade Marks (Relative Grounds) Order 2007, which requires an opponent to be the proprietor of an earlier right upon which it relies in opposition proceedings. Prior to 1 October 2007 there was no requirement for an opponent

³³ *South Cone Inc v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19, *Loaded* BL O/191/02, *Phones 4u Ltd v Phone4u.co.uk. Internet Ltd* [2007] RPC 5 and *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat).

to have a locus standi³⁴. Consequently, ITA can rely upon the goodwill of other undertakings in relation to the use of the Trappist logo and the sign TRAPPIST.

69) It is necessary to establish the material date for passing-off purposes. It is well established that the material date is the date of the behaviour complained of³⁵. Section 5(4)(a) implements article 4(4)(b) of Directive 2008/95/EC of 22 October 2008 which states:

“rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark.”

So the material date cannot be after the date of application. ITA has not denied that statement of Mr Matthews that Le Trappiste café/bar has been trading since 2002. This trade has not been anywhere near across the spectrum of the specification of the application. It has also been localised in one area, Altrincham; the application for a trade mark is by its nature an application for rights across the United Kingdom. Taking these two factors into account, I consider that the behaviour complained of rests squarely with the filing of the application and that, therefore, the material date is the date of application, 23 May 2006.

70) The articles relating to the beers refer to TRAPPIST more than to the Trappist logo. Some reference to TRAPPIST appears on the front of various of the labels: La Trappe – Trappistenbier; Chimay – Pères Trappistes; Achel – stylised Trappist; Rochefort – Trappistes; Westmalle – Trappist. The sales figures show that up to 2006 Chimay and Westmalle were the biggest selling brands. (As Vrijheid has furnished pictures of the labels it is reasonable to assume that it does so on the basis that the labelling reflects the position at the material date and before.) There is nothing to suggest that any undertaking that is not a member of ITA has used the term Trappist in the United Kingdom in relation to beers.

71) There is nothing to suggest that any goodwill and reputation in the United Kingdom would be for anything other than the beer. The evidence leaves some ambiguity as to the position in Belgium and the Netherlands. *Michael Jackson's Beer Hunter* states that “Most offer their beers in a nearby café or auberge/inn.”

³⁴ See the decision of Mr Geoffrey Hobbs QC, sitting as the appointed person in *Wild Child Trade Mark* [1998] RPC 455:

“Moreover there appears to be no requirement under the Act for the person claiming protection for an “earlier right” to be the proprietor of the right for which protection is being claimed: see sections 38(2), 46(4) and 47(3).”

³⁵ *Cadbury Schweppes Pty Ltd v Pub Squash Co Pty Ltd* [1981] RPC 429 and *Inter Lotto (UK) Ltd v Camelot Group PLC* [2004] RPC 8 and 9.

He goes on to refer to the beers being available at nearby establishments as follows:

Orval: L'Ange Gardien – (*The Independent Imbiber* also refers to this establishment.)

Chimay: Ferme des Quatre Saisons

Rocheftort: Limbourg, Malle Post

Westvleteren: Café In De Vrede

Westmalle: Trappisten

He writes that in 1998 Achel opened a small pub.

In *Good Beer Guide to Belgium & Holland* Tim Webb comments, in relation to Westmalle: “but do they really think that their own brewery café should be suggesting you drink it with grenadine?” It may be that certain of the monasteries do have their own cafés; even if they do, there is nothing to suggest that the average consumer in the United Kingdom who knows of the beers will know of this. Any goodwill is solely rooted in beers.

72) Mr Tritton included in his authorities *Taittinger SA and Others v Allbev Ltd and Another* [1993] FSR 641 and *Erven Warnink Besloten Vennootschap and Another v J Townend & Sons (Hull) Ltd and Another* [1979] FSR 397. The former case is one of several cases brought in relation to the use of the sign champagne in relation to beverages that were not champagnes. In the former case Gibson LJ stated:

“The word “champagne” is distinctive of a sparkling alcoholic wine produced in, and only in, Champagne.”

In *Erven Warnink Besloten Vennootschap and Another v J Townend & Sons (Hull) Ltd and Another*, at first instance ([1978] FSR 1), Goulding J made a finding of fact that was not disturbed above:

“A substantial reputation and goodwill have, over half a century or more, been acquired by the name “Advocaat” as that of a drink with recognisable qualities of appearance, taste, strength, and satisfaction. Indeed, the defendants' own sales director said unhesitatingly that the word “Advocaat” had a goodwill attached to it, and helped to obtain sales.”

It is clearly established that a term that is descriptive of a type of product can enjoy a protectable goodwill. It was established that a large swathe of the public would know the terms champagne and advocaat.

73) The evidence is consistent in that TRAPPIST does not describe a particular type of beer. Certain people will be aware of the actual significance of the use of TRAPPIST in relation to beers but the evidence does not demonstrate that the

average consumer of the beverages upon which this sign is used will know this. There is no evidence to suggest what the average consumer of the Trappist beers will consider the sign TRAPPIST indicates in relation to them. In relation to the Trappist logo, which is also relied upon under this head of damage, there is a clearer message. As I have indicated above, in relation to section 5(2)(b) of the Act and the average relevant consumer, the Trappist logo will tell the average consumer that the product has the characteristic or quality of being genuinely made by Trappists or coming from a Trappist monastery. This is not something nearly as easy to nail down as the characteristics established by champagne and advocaat.

74) In considering passing-off one is not simply considering a sign against sign comparison, as with section 5(2)(b) of the Act. In relation to the application one is considering normal and fair use of the trade mark in relation to all of the services of the specification. In relation to the signs upon which ITA relies one has to consider everything surrounding them, everything that will effect the reaction of the average consumer who knows of the sign and its use.

75) The first sign upon which the average consumer will identify and rely upon is the brand of the beer, this is what he or she is purchasing, as there is no Trappist characteristic per se. The beers being sold are premium products and in small numbers, the consumer of these products will generally be knowledgeable and is likely to be an aficionado of beers. (This reflects the actual purchasers rather than the wide public that has to be considered for the purchase of beers in relation to the establishment of a reputation for section 5(3) of the Act.) This customer will not know of any tradition of Trappists setting up licensed premises in the United Kingdom. Indeed, the idea of Trappists setting up such premises, even if under licence, would appear quite bizarre. There has been nothing in the nature of the trade in the United Kingdom that would lead the person who knows of Trappist beers to the conclusion that Trappists would have tied premises, in the way that some brewers have. There is no indication that there are Trappist monasteries in the United Kingdom which have licences for the sale of alcoholic beverages.

76) I accept that the two signs upon which ITA relies are identified with the goodwill of the businesses of the brewers who make use of them.

77) ITA must demonstrate that there is likely to be a misrepresentation by Vrijheid (this being to all intents and purposes a *quia timet* action, see above re material date) leading or likely to lead the relevant public to believe that it is responsible for the services offered by Vrijheid in some way. This responsibility could be in the nature of ownership or licensing. There is no evidence that the various breweries who trade with reference to the two signs upon which ITA relies have entered into any licence arrangements. All the evidence is against this type of activity existing. The misrepresentation might, in relation to the erosion of the distinctiveness of the two signs, be something more fugitive but it

still must bring back the consumer to an identification with the goodwill of one or more of the brewers. I do not consider that the average consumer will believe that there is any relation between the services of the application and the Trappist brewers. **Taking into account all the factors surrounding the goodwill of the various brewers, the nature of the signs upon which ITA relies, the nature of Vrijheid's trade mark and the nature of the services of the application I do not consider that there will be a misrepresentation.**

78) The grounds of opposition under section 5(4)(a) of the Act are dismissed.

COSTS

78) Vrijheid UK Ltd has been successful and is entitled to a contribution towards its costs. I award costs upon the following basis:

Considering notice of opposition	£200
Statement of case in reply	£300
Preparing and filing of evidence	£300
Considering evidence of the other side	£150
Written submissions	£50
TOTAL	£1,000

I order International Trappist Association to pay Vrijheid UK Ltd the sum of £1,000. 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 2 day of February 2009

**David Landau
For the Registrar
the Comptroller-General**