

O-201-13

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL TRADE MARK REGISTRATION NO 1 095 799 IN
THE NAME OF OBSHESTVO S OGRANICHENNOY OTVETSTVENNOSTYU IN
RESPECT OF THE MARK

PETER THE GREAT

IN CLASS 33

AND OPPOSITION THERETO UNDER NO 72380

BY WORLD SPIRITS INTERNATIONAL LTD

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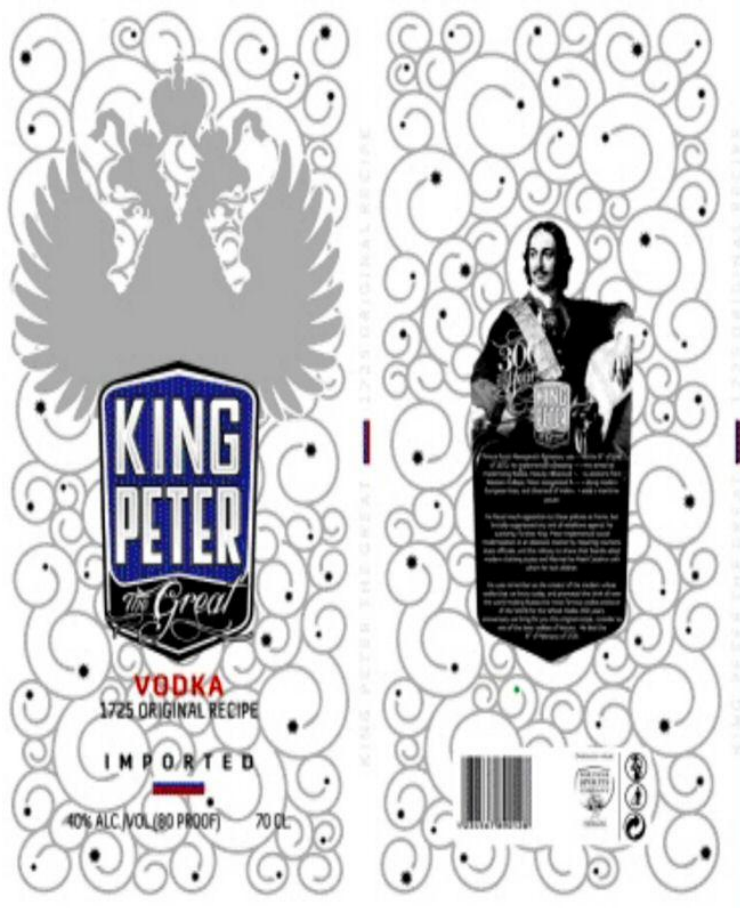
IN CLASS 33

AND OPPOSITION THERETO UNDER NO 72380

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The Background and Pleadings

1. Obshchestvo S Ogranichennoy Otvetstvennostyu (“the applicants”) applied to protect in the United Kingdom its international trade mark as shown above on 14/09/2011. The application was published in the Trade Marks Journal on 30/12/2011 in respect of vodka in Class 33.
2. World Spirits International (“the opponents”) opposes protection on the basis of its earlier international trade mark (designating the EU) as shown below. This is under No 1 105 791, with a date of protection of 19 December 2012 and a priority date of 30 June 2011. It is protected in respect of vodka in Class 33:



3. The ground upon which the opposition is based is Section 5(2) (b) of the Trade Marks Act 1994 (“the Act”). The opponent notes that the goods in question are identical and claims that the respective trade marks are visually, aurally and conceptually similar. As such, there is a likelihood of confusion.
4. The applicant filed a counterstatement denying the claim made.
5. Neither side requested a hearing and only the opponent filed evidence. This will be referred to where relevant during this decision. Written submissions were received from both parties which have been taken into account in reaching this decision.

The opponent’s evidence

6. This is a witness statement, from Jaime Abrisqueta Ynzenga, A Director of the opponent company. Mr Ynzenga explains that though vodka bearing the earlier trade mark is not currently sold in the UK, the opponent’s website has been promoting the product. Exhibit JAY1 shows printouts from the website. A number of other promotional activities are mentioned. I note that the opponent seems to emphasise that these promotional activities are aimed at the UK public. I infer from this that the opponent considers this relevant to the potential for confusion between the respective trade marks. To that end I will simply state that the absence of actual confusion has no bearing on the matter to be decided. The assessment to be made is notional in nature and is, with the exception of considerations of reputation and/or enhanced distinctiveness, based upon the trade marks as they appear on the

Register. Mr Ynzenga goes on to make a number of submissions regarding the distinctiveness of the earlier trade mark which I will not summarize here, but will refer to where appropriate and relevant during my decision.

DECISION

Likelihood of confusion – Section 5(2) (b) of the Act.

7. The relevant parts of section 5 of the Act read as follows:

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

(a)

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

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

8. The leading authorities which guide me in this ground are from the CJEU: *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn- Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C- 334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, who is deemed to be reasonably well informed and reasonably circumspect and observant - but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,

(d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,

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e) assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark; the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*

f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.

(g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,*

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

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,*

(j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG,*

(k) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v Adidas AG and Adidas Benelux BV,*

(l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*

Comparison of the goods

9. I note that the goods of the respective trade marks are both vodka and so are identical.

Comparison of the marks

10. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account any distinctive and dominant components.

11. The respective trade marks are shown below:

<p>Earlier trade mark</p>	<p>Contested trade mark</p>

12. Visually, I note that the marks each contain the verbal elements “Peter The Great”. However, their manner of depiction differs in that they are stylised quite differently. Further, the earlier trade mark includes a number of additional visual elements, including a pictorial representation of a male figure, swirled devices and a representation of the Romanov coat of

arms. Finally, the verbal elements of the earlier trade mark are encased within a badge/shield. There is also the use of the colours blue, red and grey, though this is not pertinent as there is no limitation in respect of colour. In this regard, I note the guidance in *Specsavers International Healthcare Limited & Others v Asda Stores Limited* [2010] EWHC 2035 (Ch). I note that the applicant's argue that the element "the" is completely illegible. Though I accept that it is smaller and more difficult to see than "King Peter" and "Great", it is not completely illegible and to conclude so would be incorrect. There is at least potential for it to be seen. In any case, bearing in mind the differences already described, I consider the overall degree of visual similarity to be low.

13. Aurally, the matter is somewhat different. The marks will coincide entirely in the elements "peter the great", bearing in mind that there is at least potential for the word "the" in the earlier trade mark to be articulated. They will differ in respect of the additional element "king" in the earlier trade mark, which does have an aural impact as it will be enunciated first. It is true that other words are also present in the earlier sign, such as "vodka", "imported", together with a large section of text which appears underneath the pictorial representation of a male figure. Aside from "vodka" which may be included orally, to my mind the remaining verbal elements are unlikely to be enunciated. Even if vodka were to be included, and bearing in mind the addition of the word "king", I remain of the view that the marks are aurally similar. In my view, the degree of aural similarity is high. I would add that even if the element "the" in the earlier trade mark is not articulated, the degree of similarity is at least moderate. Before leaving the aural comparison, I note that the applicant is of the view that the opponent's product is likely to be referred to as "King Peter" vodka. There is no convincing evidence to support this claim. Further, even if there were, I am of the view that there remains at least a degree of aural similarity between "King Peter" and "Peter the Great".
14. Conceptually, I am of the view that there are likely to be two scenarios. The first is that the contested trade mark will be understood, at least by part of the United Kingdom public, as referring to the Russian Tsar. The same is true of the earlier trade mark and I consider this to be so, irrespective of the debate as to the legibility of the element "the" in the earlier trade mark. This mark includes the elements "King Peter", a pictorial representation of the said figure and a double headed bird, a Russian emblem. To my mind, all features convey the concept of the Russian Tsar and this will be clearly understood in the earlier trade mark. For those who are aware of the Russian Tsar therefore, they are conceptually identical. The second scenario is that each of the trade marks here will not convey the message of a specific person. Rather they will each be understood in the abstract as referring to a historical figure. Each of the trade marks convey such a message in my view and are liable to convey the same message. In either scenario, they are conceptually identical.

Distinctive and dominant components

15. As regards dominant components, in respect of the contested trade mark, I am of the view that there is no clear stand out element. Rather it will be appreciated instantly as a whole. As regards the earlier trade mark, I note that the parties have made a number of submissions on the point. According to the opponent, the element "king peter the great" is the dominant and distinctive element of its mark, with the remaining dots and circles being abstract and meaningless. Conversely, the applicant's argue that the element "the great" in the earlier trade mark is much smaller and, in its view (as already outlined above), the word "the" is

completely illegible. Rather, it argues, the earlier trade mark includes the words “King Peter” as part of a complex and striking device mark. In my view, the earlier trade mark is comprised of a number of elements and is a complex mark. It is true that the elements “King Peter” catch the eye. However, so do a number of other elements, such as the male figure and the double headed bird. To my mind, even if “King Peter The Great” is the stand out dominant element (and I am not wholly convinced it is), the other elements are not negligible in the terms set out in Limoncello and so, in my view, the correct comparison to be made is in respect of the trade marks as wholes.

16. In respect of distinctive components, the earlier trade mark is a complex mark, with a number of distinctive features, including the element “King Peter the Great”. There is no one feature that can be considered to be clearly the most distinctive component.
17. The effect of all this is that there is no clear stand out dominant and distinctive element in the earlier trade mark. As such, it, as a whole must be compared to the contested trade mark in an assessment of the overall degree of similarity between the two signs. In this regard, I have found there to be only a low degree of similarity visually. However, there is potentially a high degree of aural similarity and they are conceptually identical. Overall therefore I consider the marks to be similar, to a moderate to high degree.

Distinctiveness of the earlier trade mark

18. The degree of distinctiveness of the earlier trade mark must also be assessed. This is important because the more distinctive the earlier mark(s) (based either on inherent qualities or because of use made), the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). The opponent argues that its mark is particularly distinctive as it is named after a famous person and so is unusual in the marketplace. However, this seems to be the extent of the argument advanced. I do not accept that the earlier mark’s distinctiveness is enhanced purely because it is named after a famous person, nor as the opponent seems to suggest, because it is unusual in the marketplace. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00*). 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 trade mark to identify the goods for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods from those of other undertakings (*Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97*).
19. The issue to be considered is whether or not the earlier trade mark is distinctive *prima facie*, or as a result of the use made of it. In this case, there is no evidence of use in the UK which suggests either a reputation or enhanced distinctiveness *through use*. I must therefore decide the matter on a *prima facie* basis. Working on a worst case scenario for the opponent, it is true that Peter the Great is a Russian Tsar and that this will be understood by at least a part of the relevant public. It is also true that Russia is associated with vodka and so it may be argued that the opponent is playing upon this Russian connection. However, to my mind even if this is the case, the earlier trade mark is comprised of a number of elements, all of which are presented in a manner which renders them distinctive in respect of

the goods in question. These include the verbal element “King Peter The Great”, *the male figure and the remaining device elements*. Combined, therefore they are clearly distinctive. I pitch the degree of distinctiveness as being at least average.

The average consumer

20. The case-law informs me that the average consumer is reasonably observant and circumspect (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). The degree of care and attention the average consumer uses *when selecting goods or service providers can, however, vary* depending on what is involved (see, for example, the judgment of the GC in *Inter- Ikea Systems BV v OHIM* (Case T-112/06)).
21. In relation to alcoholic drinks the average consumer will be the general public, albeit those of drinking age. given that vodka, being a spirit, is relatively expensive in terms of beverages and a product that is likely to be purchased intermittently. However, this does not equate to the purchasing act being undertaken with the highest degree of attention or consideration, a medium degree of care and attention is likely to be utilised. The goods can be purchased *via self selection from, for example, supermarket shelves* or may also be requested orally such as convenience stores where spirits can be displayed behind a counter. As such, both visual and aural considerations are important.

Global Assessment – Conclusions on Section 5(2)(b)

22. It is clear that the factors assessed have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17) and that a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.
23. The goods in this case are identical and so the interdependency principle is in full operation here. The marks are aurally similar, irrespective of the alternative ways in which the earlier trade mark could possibly be pronounced. Further, I have found them to be conceptually identical (whether Peter the Great is known as a specific person or in a more abstract sense). It is true that there is only a low degree of visual similarity. However, as I have already stated, aural considerations are also important as these goods can be requested orally. While it is true that a reasonable degree of attention is likely to be displayed during the purchasing process, I must also bear in mind that consumers rarely have the opportunity to view trade marks side by side and so rely on an imperfect picture of them. Taking all of these matters in the round, I am of the view that the overall degree of similarity between the

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signs as displayed on identical goods is sufficient for me to conclude that the relevant public will be unable to readily distinguish between them and will either mistake one for the other or will believe them to be provided by the same manufacturer. To my mind, there is therefore a likelihood of confusion. As such, the opposition succeeds in its entirety.

COSTS

24. The opponent has been successful and is entitled to a contribution towards its costs. I award the opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Statutory fee for filing opposition - £200

Filing notice of opposition and considering counterstatement- £300

Filing evidence and submissions - £500

Total £1000

25. The above sum should 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 15th day of May 2013

Louise White

For the Registrar,

The Comptroller-General