

O-050-15

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3031288
BY UNITED SPIRITS LIMITED
TO REGISTER
THE TRADE MARK:

RITU

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 401780 BY
ANTON RIEMERSCHMID WEINBRENNEREI UND LIKÖRFABRIK GMBH & CO KG

BACKGROUND

1. On 19 November 2013, United Spirits Limited (“the applicant”) applied to register the trade mark **RITU**. The application was published for opposition purposes on 3 January 2014, for the following goods in class 33:

Alcoholic beverages (except beers).

2. The application is opposed in full by Anton Riemerschmid Weinbrennerei Und Likörfabrik GmbH & Co KG (“the opponent”) on the basis of section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the goods shown below in Community Trade Mark (“CTM”) registration no. 10196798 for the trade mark: **Pitú** which was applied for on 15 August 2011 and the registration process for which was completed on 2 February 2012.

Class 33 - Alcoholic beverages (other than beer), wines, spirits and liqueurs.

In its Notice of opposition, the opponent states:

“9. The opponent submits that the goods of the opposed application are identical and/or similar to the goods of the opponent’s registration.

10. The opponent submits that the mark the subject of the opposed application is highly similar to the mark the subject of the opponent’s registration. Visually, the marks are extremely close since a capital P and a capital R can often be confused for each other, and the remainder of the constituent letters of the respective marks is identical save for an acute accent on the U of the opponent’s registered mark. The visual impression created by the mark is of particular relevance in the assessment of the similarity of marks when the goods in question are alcoholic beverages since these will often be bought by sight. Therefore, labels bearing similar marks could be confused. Furthermore, the respective marks are highly similar phonetically and could be confused.”

3. The applicant filed a counterstatement in which it admits the competing goods are identical or similar. However, it denies that the competing trade marks are similar. It states:

“5...Specifically the applicant denies that the respective marks are visually or phonetically similar.”

4. On 24 September 2014, the applicant restricted its application to “wines”. In a letter dated 21 October 2014, the opponent’s professional representatives, Kilburn & Strode LLP (“K&S”), confirmed that this restriction did not overcome its objection.

5. Both parties filed evidence; the opponent also filed written submissions at both the evidence-in-chief and reply stages of the proceedings. Although neither party asked to

be heard, the applicant filed written submissions in lieu of attendance at a hearing; I will keep all of these submissions in mind and refer to them, if necessary, below.

The opponent's evidence

6. This consists of a witness statement from Ryan Pixton, a trade mark attorney at K&S. The purpose of Mr Pixton's evidence is to introduce into the proceedings extracts from two decisions of the Court of First Instance/General Court; decisions which are then referred to in the opponent's written submissions. There is no need for parties to proceedings before the tribunal to file as evidence copies of decisions to which the tribunal itself has easy access; I will return to this point when I consider the matter of costs.

The applicant's evidence

7. This consist of a witness statement from Mahesh Nedungadi, the applicant's Senior General Manager (Legal) accompanied by seven exhibits consisting in excess of 100 pages. For reasons which will become obvious later in this decision, I do not intend to summarise this evidence here. Suffice to say that the principle purpose of this evidence is to provide background to the applicant's adoption of its RITU trade mark and details of its use and promotion in the United Kingdom since 2011.

DECISION

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

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

(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.”

9. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.- (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

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

10. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2 above, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not been registered for more than five years when the application was published, it is not subject to the proof of use provisions as per section 6A of the Act. As a consequence, the opponent is entitled to rely upon all of the goods it has nominated.

Section 5(2)(b) – case law

11. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

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

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

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

Comparison of goods

12. As the application has been limited to “wines” and as this word appears in the opponent’s specification in class 33, the competing goods are identical.

The average consumer and the nature of the purchasing decision

13. As the case law above indicates, it is necessary for me to determine who the average consumer is for wine. I must then determine the manner in which wine is likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

14. The average consumer of wine in class 33 is a member of the adult general public. Wine is sold through a range of channels, including retail premises such as supermarkets and off-licences (where it is normally displayed on shelves and is

obtained by self selection) and in public houses and restaurants (where it is displayed on, for example, shelves behind the bar and where the trade marks will appear on wine lists, menus etc.). Although the parties disagree about the relative importance of the phonetic aspect of the selection process, it is not necessary for me to resolve this difference of opinion here. Suffice to say, that I accept that when wine is sold in public houses and restaurants, there will be an oral component to the selection process. However, there is nothing to suggest that wine is sold in such a manner as to preclude a visual inspection. Consequently, while wine may be ordered orally in public houses and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottle or wine list prior to the order being placed. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part. As to the level of attention that will be paid, I am aware that the cost of wine can vary considerably. However, even in relation to relatively low cost wine, the average consumer will wish to ensure they are selecting, for example, the correct style, country of origin etc; as a consequence, they are likely, in my view, to pay an average degree of attention to their selection.

Comparison of trade marks

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

16. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

17. The competing trade marks are: **RITU** (the application) and **Pitú** (the opponent’s trade mark). As the opponent’s trade mark consists of a single word presented in title case in which no part is highlighted or emphasised in any way, there are, in my view, no distinctive and dominant elements. The overall impression it creates will be of an invented word or, if the average consumer registers the presence of the acute accent above the letter u, a word from a language other than English. As to the applicant’s trade mark, this also consists of a single word, albeit presented in upper case. Much like

the opponent's trade mark, the overall impression it creates will be of an invented word or, regardless of the absence of a diacritic, a foreign language word.

18. Both trade marks consist of four letters the last three of which are identical. Their presentation differs (one being in title case and the other in upper case), their first letters differ and the letter "u" in the opponent's trade mark contains an acute accent which is absent in the applicant's trade mark. In its submissions, the applicant argues that as both trade marks consist of short words, as the letters "P" and "R" are visually different and appear at the beginning of the competing trade marks and as the acute accent in the opponent's trade mark will make a "striking visual impact", the competing trade marks are visually similar to only a low degree. Whilst many of the applicant's submissions have merit, in my view, the visual similarity between the letters "P" and "R" when combined with three identical letters (albeit presented in upper and lower case) results in a reasonably high degree of visual similarity between the competing trade marks. I reach the same conclusion even if the average consumer registers the presence of the acute accent in the opponent's trade mark which, in my view, is debatable.

19. Aurally both trade marks consist of two syllables. Whilst I accept that the differing first letters will impact on their pronunciation, the presence of the acute accent in the opponent's trade mark is, in my view, unlikely, even if it is noticed, to affect the pronunciation of the opponent's trade mark by the average United Kingdom consumer to any significant extent (if at all). In its submissions, the applicant admits that the degree of aural similarity is moderate, whereas the opponent argues that the competing trade marks are aurally "very close". Considered overall, I think the opponent's position is more realistic; the competing trade marks are, in my view, aurally similar to a reasonably high degree.

20. Finally, insofar as conceptual similarity is concerned, I agree with the parties that as neither trade mark is likely to convey any meaning to the average consumer, the conceptual position is neutral.

Distinctive character of the opponent's earlier trade mark

21. 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)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As the opponent has not filed any evidence of the use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Although in its submissions the applicant argues that its distinctiveness "must be seen as normal", as a word which may be

considered to be either invented or as a word from a language other than English with which the average consumer is unfamiliar, it is, in my view, possessed of a high degree of inherent distinctiveness.

Likelihood of confusion

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

- the competing goods are identical;
- the average consumer is a member of the adult general public who will select the goods by predominantly visual means and who will pay an average degree of attention when doing so;
- the competing trade marks are visually and aurally similar to a reasonably high degree and conceptually neutral;
- the opponent's earlier trade mark is possessed of a high degree of inherent distinctive character.

23. Bearing in mind that identical goods are involved, combined with the lack of any conceptual hook to assist the average consumer's recollection of the competing trade marks, which in turn will lead to them being more susceptible to the effects of imperfect recollection, I have no hesitation concluding that there will be a likelihood of direct confusion i.e. where the average consumer mistakes the applicant's trade mark for that of the opponent (whether visually, orally or both). I should also mention that for the reasons stated in the opponent's submissions i.e. (i) its earlier trade mark is not subject to proof of use, (ii) it has filed no evidence of its reputation and (iii) its earlier trade mark has not been attacked by the applicant, it is the notional position that I must consider. As a consequence, neither the applicant's evidence nor its comment to the effect that there have been no instances of confusion have played any part in my considerations.

Conclusion

24. The opposition succeeds in full, and subject to any successful appeal, the application will be refused.

Costs

25. In its submissions, the opponent states:

“...It is also stresses that in its view, the evidence submitted by the applicant is voluminous and totally irrelevant to the present proceedings. That has required the opponent to expend unnecessary time and cost on reviewing and responding...”

26. In its submissions, the applicant states:

“9. Where a mark has been in use for a significant period in the UK, without challenge, prior to the filing of the application, it is not unreasonable for an applicant to defend its position by trying to illustrate this with evidence of the manner and extent of its use. The evidence filed by the applicant was not copious, it comprised one witness statement with seven exhibits...”

27. Tribunal Practice Notice (“TPN”) 4 of 2009 states:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person, in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, **or having used the trade mark before the attacker used or registered its mark are wrong in law**. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.” (my emphasis).

28. The above guidance makes it clear that, in the circumstances of this case, the filing of evidence by the applicant was pointless. Regardless, as it was still necessary for the opponent to review this evidence, I will make a corresponding award in the opponent’s favour. However, for the reasons outlined in paragraph 6 above, I will not make any award to the opponent in relation to its evidence. Awards of costs are governed by Annex A of TPN 4 of 2007. Using that TPN as a guide, but bearing the above comments in mind, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant's statement:	£200
Considering the applicant's evidence	£500
Written submissions:	£200
Opposition fee:	£100
Total:	£1000

29. I order United Spirits Limited to pay to Anton Riemerschmid Weinbrennerei Und Likörfabrik GmbH & Co KG the sum of **£1000**. 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 2nd day of February 2015

C J BOWEN
For the Registrar
The Comptroller-General