

O-078-16

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3074242
BY GREENLAND HOTEL MANAGEMENT INTERNATIONAL GROUP LIMITED
TO REGISTER THE TRADE MARK**

PRIMUS

**IN CLASS 43
AND**

**IN THE MATTER OF OPPOSITION
THERE TO UNDER Nos. 403833 BY
BROUWERIJ HAACHT N.V.**

BACKGROUND

1) On 26 September 2014, Greenland Hotel Management International Group Limited (hereinafter the applicant) applied to register the trade mark shown on the page above in respect of the following services:

Class 43: Accommodation bureaux [hotels, boarding houses]; cafés; canteens; boarding houses; hotels; restaurants; boarding house bookings; hotel reservations; bar services; holiday camp services [lodging]; reservation of temporary accommodation; motels; tourist homes; rental of meeting rooms; rental of chairs, tables, table linen, glassware; day-nurseries [crèches]; rental of cooking apparatus; rental of drinking water dispensers; retirement homes; providing campground facilities.

2) The application was examined and accepted, and subsequently published for opposition purposes on 26 December 2014 in Trade Marks Journal No.2014/053.

3) On 25 February 2015 Brouwerij Haacht N.V. (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates	Class	Specification
PRIMUS	CTM 8239378	23 April 2009 07 October 2009	32	Beers

a) The opponent contends that its mark and the mark applied for are similar. It also contends that the goods for which its mark is registered are similar to the services applied for as beer is sold in the types of premises applied for; also that the names of alcoholic beverages are often displayed upon the walls of such establishments in order to advertise the fact that the beverage is sold on the premises. The application therefore offends against Section 5(2)(b) of the Act. On 2 December 2015 the opponent limited its opposition to the following services: cafes; canteens; restaurants; bar services.

4) On May 2015 the applicant filed a counterstatement, denying that the marks or goods and services are similar. The applicant did not request proof of use.

5) Only the opponent filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 8 September 2015, by Jon William Welfoot the opponent's Trade Mark Attorney. He states that the opponent is one of the largest brewers in Belgium and sells its products throughout the EU including the UK and elsewhere in the world. The opponent's flagship beer is called PRIMUS PILSNER and it is claimed that it is well known in Belgium, France and the Netherlands. It is available as a bottled and draught beer and is sold in the UK. Annual sales, presumably worldwide, are said to be 15,000 hectolitres. He states that Primus beer has been sold extensively in the EU and provides invoices (see below). Mr Welfoot also offers his opinion on the similarity of the marks and the respective goods and services. He provides the following exhibits:

- JWW1: A history of the Haacht brewery.
- JWW2: Names of various beers brewed by Haacht including Primus.
- JWW3: A copy of a report from the UK beer guild which refers to the launch of Primus in the UK in April 2014. Also in this exhibit are pages from two internet sites showing Primus beer for sale in the UK. One is undated the other is after the relevant date.
- JWW5: Copies of invoices dated between 3 October 2012 and 20 February 2014. There is one invoice for each of the following countries: France, Eire, Denmark, Spain, UK, Germany, Netherlands, Italy, Lithuania and Belgium. For reasons best known to themselves the opponent have redacted virtually all information relating to the amount of beers and value of these orders.

7) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

8) The only ground of opposition is under section 5(2)(b) which reads:

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

(a)

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

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

9) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

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

10) The opponent is relying upon its trade mark listed in paragraph 3 above. Given the interplay between the date that the opponent’s mark was registered and the date that the applicant’s mark was published, the opponent’s mark is subject to proof of use. However, the applicant chose not to request the opponent to prove use of its mark.

11) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

- (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.

The average consumer and the nature of the purchasing decision

12) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are 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.”

13) In respect of the applicant’s opposed services in class 43 (cafes; canteens; restaurants; bar services) these would usually be selected by reference to the names on the buildings themselves, particularly cafes, or by reference to advertising whether print media or online. A café may be chosen on the spur of the moment with little thought other than the need for refreshments, whereas a restaurant may be selected and booked weeks or months in advance of a particular date. Therefore the amount of attention paid by the average consumer will vary enormously. The average consumer would be the adult population of the UK. The visual aspect is likely to be the most important although I cannot overlook the aural considerations which may arise from a word of mouth recommendation.

14) Considering the applicant’s class 32 goods, the average consumer would be over eighteen and include the whole of the adult population other than those who are tee-total. Beers come in a number of different forms which have very different tastes and the average consumer is usually likely to have a distinct preference. Such goods will not be purchased or selected without a degree of care. The applicant’s beer could be sold in supermarkets, public houses, off licences or online. The visual aspect is likely to be the most important, whether self-selecting in a supermarket or when ordering in a pub as most beers are sold either “on tap” in which case they have a marker on the tap facing the consumer or if sold in bottle form will be displayed behind the bar with the labels on display. In the case of ordering in a pub or restaurant I also accept that aural issues have a part to play and so must be considered but these would be of secondary importance given that the consumer will still see the marks on e.g. (drinks) menus. The amount of attention paid to the selection will be of a medium degree as aspects such as the type of beer, taste, alcohol content and price are all likely to be considered.

15) Overall the average consumer for these types of goods and services is likely to pay a low (cafes) to medium (restaurants) degree of attention to the selection of such items and services.

Comparison of goods and services

16) In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

17) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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) I also take into account the comments of Jacob J. in *Avnet Incorporated v. Isoact Ltd* [1998] FSR 16 where he said:

“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.”

19) I also take into account the comments in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, where the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

20) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

21) Further, I take into consideration the comments in *Oakley, Inc v OHIM*, Case T-116/06 where, at paragraphs 46-57, the General Court held that although retail services are different in nature, purpose

and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

22) I note that in *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

23) However, on the basis of the European courts’ judgments in *Sanco SA v OHIM* Case C-411/13P, and *Assembled Investments (Proprietary) Ltd v. OHIM* Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case T-105/05, at paragraphs [30] to [35] of the judgment, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

24) The goods and services of the two parties are:

Applicant’s services	Opponents’ goods
cafes; canteens; restaurants; bar services.	Beers

25) The opponent referred me to a recent decision by OHIM between the same parties in which OHIM stated:

“The contested *cafes, canteens, restaurants, bar services*; are services related to the provision of food and drinks to others. In this sense, notwithstanding their different nature (goods v

services) they are closely related to the earlier goods. In fact, it is easy to argue that there is evident complementarity between, say *beers* of the earlier mark and *bar services* for example. What is in any event certain is that the contested services invariably offer the earlier goods. Moreover, it is common practice nowadays for producers of the earlier *beers or wines* to offer the contested services under the same brand and to offer their drinks in such establishments. To that end, the relevant public, which is the same for the competing goods and services, would expect that in some cases the commercial origin of said goods and services also coincide. In view of these factors, the contested services are similar to a low degree to the earlier mark's goods."

26) In the instant case no evidence has been filed to show that brewers or distillers offer the services that are the subject of the opposition using the same mark that identifies their goods. I am willing to accept that bar services are clearly complementary to beers. However, I am unwilling to accept the OHIM ruling as it is not clear what evidence was relied upon in finding that "it is common practice nowadays for producers of the earlier *beers or wines* to offer the contested services under the same brand and to offer their drinks in such establishments". I am not aware that the same situation exists in the UK and there is no evidence to persuade me that I should reach the same conclusion as OHIM.

27) In my view, a canteen in the UK is typically attached to a place of work, and usually do not serve alcohol primarily due to health and safety issues relating to the operation of machinery. Such establishments would not, therefore, display the name of any alcoholic drink provider. Similarly with cafes even if they do offer small bottles of wine or beer they do not, typically, have the brewer's name on the wall in a similar way to public houses, and the public would not believe that a café was owned by a brewery in the same way that they are aware that public houses are franchised or tied. Lastly, restaurants will usually serve alcohol in addition to food and will display bottles and brewers' names on beer taps. In my experience, however, they do not usually have large signage with the name of a brewer/s on the building unless linked to a franchised public house. The majority of restaurants in the UK, in my experience, offer a small range of beers, wines and spirits from a range of manufacturers and so are not inextricably linked to a single producer.

28) Whilst "bar services" are complementary to "beers" to a low to medium degree, "Cafes, canteens and restaurants" are not similar nor complementary to "beers".

Comparison of trade marks

29) 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 them, bearing in mind their distinctive and dominant components. The 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."

30) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account their distinctive and dominant components and to give due weight to any other features

which are not negligible and therefore contribute to the overall impressions created by them. The trade marks to be compared are:

Opponents' trade mark	Applicant's trade mark
PRIMUS	PRIMUS

31) The applicant's mark is slightly stylised and has a device element of a triangle under the letter "M". Visually the marks are similar to a high degree despite this small device element. Aurally the marks are identical as they consist of the same letters, and the device element cannot be pronounced. Conceptually the word has no meaning that I am aware of, and no evidence has been filed in relation to this issue. **Overall the marks are similar to a high degree.**

Distinctive character of the earlier trade marks

32) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

33) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

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

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which

has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.'

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

34) As the opponent's mark has no meaning it must be regarded as a made up word and **as such it has a high degree of inherent distinctiveness but cannot benefit from enhanced distinctiveness as the opponent has not shown that it has a significant reputation in the UK or the EU. The evidence it provided was not sufficient as the invoices were heavily redacted and no figures provided for total EU sales, or its market share. I also note that its launch in the UK was stated as being April 2014 (JWW3) only five months prior to the relevant date.**

Likelihood of confusion

35) 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 services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponents' 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 and services, 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 average consumer is a member of the general public over eighteen years of age, who will select the goods and services by predominantly visual means, although not discounting aural considerations. Overall the average consumer for these types of goods and services is likely to pay a low to medium degree of attention to the selection of such items.
- the opponent's earlier trade mark has a high degree of inherent distinctiveness in relation to its goods but cannot benefit from an enhanced distinctiveness.
- overall the marks are similar to a high degree.
- whilst "bar services" are complementary to "beers" to a low to medium degree, "Cafes, canteens and restaurants" are not similar nor complementary to "beers".

36) In view of the points in paragraph 35 above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the "bar services" applied for by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in relation to "bar services". However, in relation to "cafes, canteens and restaurants" the opposition under section 5(2)(b) fails.**

CONCLUSION

37) The opponent did not oppose certain services and the opposition has failed in relation to three of the four services opposed. The mark can continue to registration in respect of:

Class 43: Accommodation bureaux [hotels, boarding houses]; boarding houses; hotels; boarding house bookings; hotel reservations; holiday camp services [lodging]; reservation of temporary accommodation; motels; tourist homes; rental of meeting rooms; rental of chairs, tables, table linen, glassware; day-nurseries [crèches]; rental of cooking apparatus; rental of drinking water dispensers; retirement homes; providing campground facilities; cafes, canteens and restaurants.

38) Both parties have enjoyed a measure of success and as such I decline to award costs.

Dated this 12th day of February 2016

**George W Salthouse
For the Registrar,
the Comptroller-General**