

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 2060218
IN THE NAME OF GLOBALBRANDS TRADING & CONSULT AG
TO REGISTER THE MARK PASSION ATTACK IN CLASS 32**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO 45564
BY GROUPE JOKER**

TRADE MARKS ACT 1994

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**IN THE MATTER OF Application No 2060218
in the name of Globalbrands Trading & Consult AG
to register the mark PASSION ATTACK in Class 32**

10 **and**

**IN THE MATTER OF Opposition thereto under No 45564
by Groupe Joker**

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DECISION

20 On 6 March 1996 Globalbrands Trading & Consult AG applied to register the mark
PASSION ATTACK in Class 32 for a specification of goods which reads “Mineral and
aerated waters and other non alcoholic drinks, fruit drinks and fruit juices; syrups and other
preparations for making beverages.”

25 The application is numbered 2060218.

On 3 October 1996 Groupe Joker filed notice of opposition to this application. The grounds
of opposition are in summary:

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- i under Section 3(1)(a) in that the mark is not capable of distinguishing the
goods or services of one undertaking from those of other undertakings
 - ii under Section 3(3)(b) in that the mark is of such a nature as to deceive the
public as to the origin of the goods
 - 35 iii under Section 5(2)(b) in that the mark applied for is similar to Registration
No 1423041 standing in the name of the opponents and covers the same and
similar goods
 - 40 iv under Section 32(3) in that there is no intention to use the mark applied for in
relation to all of the goods covered by the application as filed.

Details of the registration referred to above are as follows:

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NUMBER	MARK	CLASS	JOURNAL	SPECIFICATION
1423041	PASSIONATA	32	5965/1460	Beers; aerated waters; non-alcoholic beverages; fruit beverages and fruit juices; syrups and preparations for making beverages; all included in Class 32.

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The applicants filed a counterstatement denying the above grounds. Both sides have asked for an award of costs in their favour. Only the opponents filed evidence in these proceedings. Neither side has requested a hearing. Acting on behalf of the Registrar and after a careful study of the papers I give this decision.

Opponents' evidence

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The opponents filed a declaration dated 7 November 1997 by Chantal Boisen, the General Manager of Groupe Joker. She is fully conversant with the English language.

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Ms Boisen says that her company manufactures, inter alia, soft drinks including fruit juices and fruit nectars. One of their trade marks is the word PASSIONATA and her company has been selling fruit beverages under the mark in the UK since 1993. Most of the remainder of the declaration is concerned with the issue of comparison of marks. I regard this material as being more in the nature of submissions in lieu of a hearing rather than evidence as such. It covers matters that are essentially for the tribunal to decide. I will, therefore, deal with the points made in reaching my own decision on the matter.

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The only other matter of substance raised by the evidence relates to the breadth of the specification applied for. In relation to this Ms Boisen says that it is her company's understanding that the applicants only manufacture carbonated soft drinks by reference to the trade mark PASSION ATTACK and therefore it is contended that the applicants have no intention to use the mark on all of the goods claimed and are therefore offending against Section 32(3) of the Trade Marks Act.

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That completes my review of the evidence.

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I should say at the outset that in my view the opponents have done nothing to explain or substantiate their grounds based on Sections 3(1)(a) and 3(3)(b) of the Act. In the absence also of any written submissions relating thereto I do not think it is for the tribunal to speculate on what the opponents had in mind. I, therefore, dismiss these grounds.

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The substance of the opponents' case must, I think, be based on the Section 5(2)(b) ground but before moving on to deal with that it will be convenient to comment on the only other objection which is based on Section 32(3) of the Act. This reads as follows:

“(3) The application shall state that the trade mark is being used, by the applicant or with his consent, in relation to those goods or services, or that he has a *bona fide* intention that it should be so used.”

5 In the ATTABOY trade mark case, an unreported Registry decision dated 28 August 1997 in relation to opposition (No 44276) to Application No 2020288, the hearing officer said

10 “In my view, Section 32(3) does no more than set out a requirement for an application to register a trade mark. The application form used in this case contains a statement in accordance with Section 32(3), which has been signed by Mr Sharpe [the applicant in that case]. Any challenge that this statement was made in bad faith falls to be considered under Section 3(6) of the Act.”

15 In the case before me the application form (Form TM3) contains the necessary statement signed on behalf of the applicants by their professional representative. The opponents for their part refer to their “understanding” of the goods of interest to the applicant company and extrapolate from this to a conclusion that the specification applied for goes beyond the goods on which use is intended. This is denied by the applicants. I accept that establishing another party’s true intentions at any point in time is a matter of considerable difficulty and it could be said in relation to this case that the applicants could have been more forthcoming about their plans. On the other hand the opponents have provided no real substantiation of their claim. Nor, on the face of it, does the applicants’ specification seem unreasonably wide. On the basis of the material before me, therefore, I find that the opposition fails in this respect.

25 As indicated the central ground of attack is Section 5(2)(b). This reads as follows:

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

30 (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,

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

The term “earlier trade mark” is itself defined in Section 6 of the Act as follows:

40 “6.- (1) In this Act an “earlier trade mark” means -

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

(b) a Community trade mark which has a valid claim to seniority from an earlier registered trade mark or international trade mark (UK), or

5 (c) a trade mark which, at the date of application for registration of the trade mark in question or (where appropriate) of the priority claimed in respect of the application, was entitled to protection under the Paris Convention as a well known trade mark.”

10 The opponents’ registered mark PASSIONATA has a filing date of 1 May 1990 and clearly covers identical goods. The matter, therefore, resolves itself into one of a comparison of the marks themselves. Ms Boisen in her declaration made a number of points which I will summarise as follows:

15 - the beginning of words is important. The marks at issue here both contain the element PASSION. The word ATTACK in the mark applied for contains the letters or element ATA. On this basis it is said that there is a strong visual similarity taking account also of imperfect recollection.

20 - confusion of the public is, therefore, likely. This risk is increased if beverage containers are placed together on shelves in such a way that a label is partly obscured.

25 - the products (soft drinks) are relatively inexpensive and as a consequence likely to be purchased without careful examination.

- because of what the opponents consider to be a strong visual similarity between the marks confusion may arise in the trade when ordering products if hand-written orders are made.

30 - there is oral similarity if the opponents’ trade mark were to be pronounced with short vowel sounds at the end of the mark.

35 I also bear in mind the approach adopted by the European Court of Justice in *Sabel v Puma* 1998 RPC 199. The Court considered the meaning of Article 4(1)(b) of the Directive (EC Directive 104/89) which corresponds to Section 5(2) of the Act and stated that

40 “... it is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion ‘depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified’. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case.

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That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The wording of Article 4(1)(b) of the Directive - ‘... there exists a likelihood of confusion on the part of the public...’ - shows that the perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details.”

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Turning to the marks themselves I have recorded above the opponents’ principal reasons for considering that there is a likelihood of confusion between the respective marks. It is, of course, undeniably the case that PASSION appears as an element in both marks. The opponents refer to circumstances of trade and the nature of the goods which might compound any underlying risk of confusion. They also refer to the possible effects of imperfect recollection. There is of course judicial authority for this latter point notably in ARISTOC v RYSTA 62 RPC 65 and DE CORDOVA v VICK 1951 RPC 103. It was also said in those cases that marks are remembered by general impressions and particularly first impressions. In this respect I find that the impression created on me by these marks is quite different and I think it highly unlikely that the circumstances of trade referred to by the opponents would displace this view. Not only does the applicants’ mark consist of two words compared to the single word of the opponents’ registration but they are also English language words. The opponents’ mark, PASSIONATA, is so far as I am aware not an English language word. I, therefore, take it to be either an invented word or, conceivably, a word drawn from perhaps Italian or Spanish. Either way it creates a quite different visual impression to the applicants’ mark.

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No information has been supplied to indicate how the opponents’ mark is pronounced. Ms Boisen speculates as to the position if her company’s trade mark were to be pronounced with short vowel sounds at the end of the mark (presumably she means to replicate as closely as possible the first two vowel sounds of the word ATTACK). On the face of it this seems unlikely and I note that, despite the fact the mark is said to have been used in this country since 1993, no indication is given as to how it is actually pronounced. I must, therefore, reach my own conclusion on the matter. PASSIONATA seems to me to have a rhythmic quality of its own. I consider that it is likely to be pronounced probably as a five syllable word with the stress on the penultimate syllable similar to the word sonata. The word ATTACK on the other hand in the applicants’ mark clearly has the stress on the second syllable and an ending that is unlikely to be slurred or lost. I do not therefore think the opponents’ concerns in relation to oral confusion (arising in relation to the ATA ending of their mark) are well founded. Thus I do not find the respective marks to be confusingly similar either visually or aurally. Nor do I find the marks conceptually similar. I have suggested above that the word PASSIONATA might either be invented or have its roots in, for instance, Italian or Spanish words. The most that can be said is that it suggests some association with the word ‘passion’ or ‘passionate’ but it is quite different in character to PASSION ATTACK. The latter is a somewhat unusual and striking combination and I cannot see that, taking the marks as totalities, there is a any risk of confusion with PASSIONATA.

There is however a possible further aspect to the matter which in my view reinforces the decision I have reached above. Neither the applicants or the opponents have commented on the reasons behind their choice of marks. The opponents do, however, say they have used their mark on fruit beverages. The specification of the application at issue also covers fruit
5 drinks and similar goods. I do not think it is fanciful to suggest that the word/element
PASSION in each of the marks could in fact be construed as an allusion, albeit a skilful one,
to passion fruit, a relatively common ingredient in or base for soft drinks. Once this
possibility is considered it seems to me that the common element PASSION would have
descriptive overtones and should be given less emphasis in the overall comparison. To put it
10 another way it is even more important to ensure that the comparison takes account of the
marks as wholes. I draw support for this view from F W Waide & Co Ltd's application 1916
RPC 320 where the High Court upheld the decision of the Registrar to allow the mark
ANCHOLA on to the register in the face of ANCHOVETTE (registered for, inter alia, fish
pastes). The common stem ANCHO picked up the first two syllables of the word 'anchovy'.

15 Bearing all the above points in mind I have come to the clear view that there is no real
likelihood of confusion on the part of the public if the applicants' mark is allowed to proceed
to registration. The opposition under Section 5(2)(b) fails accordingly.

20 As the applicants have been successful in these proceedings they are entitled to a contribution
towards their costs. I order the opponents to pay the applicants the sum of £235.

Dated this 25th day of August 1998

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30 M REYNOLDS
For the Registrar
the Comptroller General