

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2059808
BY DANIEL MARTIN WOODS
TO REGISTER A TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
NO. 45008 BY HEUBLEIN INC**

**IN THE MATTER OF Application no. 2059808
by Daniel Martin Woods
to register a trade mark in Class 33**

5 **and**

**IN THE MATTER OF Opposition thereto under
no. 45008 by Heublein Inc**

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DECISION

15 On 6 March 1996 Daniel Martin Woods applied to register the trade mark MIRGOFF in Class 33 in respect of “Wines, spirits and liqueurs; vodka”.

On 31 July 1996 Heublein Inc filed notice of opposition to this application. The grounds of opposition in summary:-

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1. The opponents are the proprietors of a number of registrations in Class 33 which they refer to as the SMIRNOFF trade marks. A schedule of these marks is attached at Annex A of this decision;

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 2. The mark applied for is contrary to the provisions of Section 5(2)(b) because it is similar to the opponents’ earlier SMIRNOFF trade marks and is to be registered for identical or similar goods with the result that there exists a likelihood of confusion;

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 3. The mark applied for contravenes the provisions of Section 5(3) because it is similar to the opponents’ SMIRNOFF trade marks which have a substantial reputation in the United Kingdom and use of the mark applied for takes unfair advantage of or is detrimental to the distinctive character or repute of the opponents’ SMIRNOFF trade marks;

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 4. The opponents’ SMIRNOFF trade marks are entitled to protection under the Paris convention as a well-known mark and so objection arises under Section 56.

40 The opponents further requested that the Registrar refuse application no. 2059808 in the exercise of his discretion. However, under the Trade Marks Act 1994 the Registrar does not have a discretion to refuse an application as he did under the old law. An application can only be refused if it fails to comply with the requirements of the Act and Rules in one or more respects.

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

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The opponents filed a Statutory Declaration dated 10 February 1997 by David John Osborne, the International Marketing Manager for The Pierre Smirnoff Company Limited - an associated company of the opponents. Mr Osborne explains that the SMIRNOFF trade marks as set out and defined in the Statement of Grounds of Opposition are used extensively for the sale of SMIRNOFF vodka and vodka products in the UK and throughout the world. The SMIRNOFF word mark alone is registered in over 80 countries, SMIRNOFF Red is the world's number one vodka and SMIRNOFF vodka is the world's second largest international premium spirit brand.

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Mr Osborne states that in the last four financial years over £246m worldwide and over £50m in the UK has been spent on advertising, marketing and promoting the SMIRNOFF goods. At "DJO-1" is exhibited a selection of 12 posters used in a current advertising campaign for SMIRNOFF vodka in the UK, which also includes television and cinema advertising. Mr Osborne goes on to say that the posters also form part of a global campaign in over 50 countries. At "DJO-2" copies are provided of a selection of the SMIRNOFF advertisements which were published in the USA between 1934 and 1984. Copies of a small selection of SMIRNOFF advertisements published around the world are provided at "DJO-3". An in-house catalogue of promotional items developed by the opponents to help promote SMIRNOFF goods is provided at "DJO-4".

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Mr Osborne states that in the last four financial years there have been over £1,290,000,000 sales of SMIRNOFF goods worldwide and over £250,000,000 in the UK. He goes on to say that the large amounts spent on advertising and promotion, and the huge volume of sales reflect the fact this is a world-famous brand and that SMIRNOFF is a world-famous mark.

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A copy of an in-house document referred to as "Pacemaker" which outlines details of recent promotional and advertising activities undertaken in respect of the SMIRNOFF trade marks throughout the world is provided at "DJO-5". Mr Osborne claims that this shows the extent of the international reputation of the SMIRNOFF brand. He goes on to say that, in addition to sales in restaurants and public houses, SMIRNOFF goods are sold in stores throughout the UK, including Tesco, Sainsbury, ASDA, Waitrose, Oddbins and duty free stores.

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Mr Osborne is concerned that, given the comprehensive use and customer recognition of the SMIRNOFF trade marks, the sale of the applicants' MIRGOFF vodka will lead to confusion - the products and outlets are identical. He goes on to say the word MIRGOFF is the word SMIRNOFF with the S removed and the N replaced by a G. Mr Osborne claims that this thinly veiled attempt to reproduce the sound and appearance of the vodka brand leader results in a word which is phonetically similar in both of its two syllables to SMIRNOFF. He states that in a crowded or noisy atmosphere, such as a busy public house, the word SMIRNOFF could easily be confused with the word MIRGOFF. Mr Osborne has no knowledge of the reasons why the applicants have chosen to apply for the mark MIRGOFF for vodka and he calls on the applicants to explain why they have chosen a similar mark to SMIRNOFF.

Mr Osborne states that the extensive advertising and sales of SMIRNOFF goods throughout the United Kingdom and world-wide has led to SMIRNOFF branded products having an exceptionally high reputation in the public eye. He is concerned that the use of the applicants' MIRGOFF mark will take unfair advantage of the substantial reputation of the SMIRNOFF trade marks in the UK and world-wide.

That concludes my review of the evidence.

I will deal first with the objection based on Section 5(2)(b).

This Section reads:

“5.- (1)

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

(a)

(2) 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.”

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

“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,

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

(b) 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.”

In considering the issue of confusion I take account of the guidance given by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* (1998 RPC 199). The relevant sections of the ECJ's decision are set out below:-

5 “..... 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.

10 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.

20 In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.”

25 The opponents rely upon eight registrations of trade marks in their name which consist or include the word SMIRNOFF. All of these registrations are in Class 33 - six of the registrations cover "vodka", the remaining two cover "wine, spirits and liqueurs". Therefore, all these registrations cover identical or similar goods (see the BALMORAL case 1999 RPC 297) to the application in suit, and qualify as ‘earlier trade marks’ within the meaning of Section 6(1) of the Act. The likelihood of confusion therefore falls to be determined primarily by reference to the similarity of the marks, taking account of any evidence of reputation of the earlier trade marks and any other relevant factors.

35 From the sales and advertising figures provided it is clear that at the material date, 6 March 1996, the opponents had a substantial reputation for “vodka” under their SMIRNOFF trade marks. It is clear from the Sabel v Puma case that a strong mark with a reputation deserves more protection than a weaker mark with no reputation in the market.

40 So far as the respective marks are concerned, in overall terms they are similar in length and appearance. Visually, they have common elements in that they both contain the letters MIR and end with the letters ‘OFF’. However, the opponents’ marks begin with the letter S and in the opponents’ mark the letter N precedes the letters “OFF” whereas in the applicants’ mark it is the letter G. Therefore, a direct comparison of the trade marks may lead to the view that they are not confusingly similar. However, I must also take into account imperfect recollection - see the ARISTOC LTD v RYSTA LTD case [1945] 62 RPC (page 72 line 46 to page 73 line 4). I think that the visual differences between the applicants’ trade mark MIRGOFF and the opponents’ SMIRNOFF trade marks are not sufficient to make it unlikely

that confusion would not occur, on the basis of imperfect recollection. Where, as in this case, the words are made up or fanciful which do not have a meaning in the English language, such similarities are more likely to cause confusion. Additionally, it appears to me that the pronunciation of the applicants' trade mark MIRGOFF could be similar to be pronunciation of the opponents' trade mark SMIRNOFF.

As the ECJ stated in *Sabel v Puma*, the public normally perceive trade marks as wholes and do not proceed to analyse the various details. I believe that this approach is of particular importance in this context. Moreover, when the earlier marks have a particular reputation (as I have already found the opponents' marks SMIRNOFF have in relation to vodka) it is more likely that the similarity between the respective marks may cause the public to wonder whether there is some sort of connection in trade, even if the differences between the marks is noticed.

Conceptually, neither mark conveys a meaning; neither are dictionary words. As far as the English language is concerned they should be treated as made up or fanciful words. However, whilst there is no conceptual similarity, taking into account the visual and aural similarities of the respective marks and imperfect recollection, I am of the clear view that there exists a likelihood of confusion. The opposition, therefore, succeeds under Section 5(2)(b).

I go on to consider the grounds of opposition under Section 5(3) which states

“(3) A trade mark which -

- (a) is identical with or similar to an earlier trade mark, and
- (b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

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, 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.”

The goods covered by the opponents' registrations are identical or similar to the applicants' goods. This ground of opposition must therefore be dismissed.

Finally, I turn to consider the ground based on the opponents' claim that their SMIRNOFF trade marks are well known marks within the meaning of the Paris Convention.

The United Kingdom fulfils its obligations under the Paris Convention (Article 6 bis) by the terms of Section (6)(1)(c) and Section 56 of the Trade Marks Act 1994. Under Section 6(1)(c) such a “Paris” mark is included within the term “earlier trade marks”. Sections 5(1) and 5(2) afford protection to such marks. Since I have already considered under Section 5(2) the conflict between the respective marks, I do not think there is anything further to be considered arising from the opponents' claim that their marks are well known within the meaning of the Paris Convention.

As the opposition has been successful the opponents are entitled to a contribution toward their costs. I order the applicants to pay the opponents the sum of £635.

5 **Dated this 16 day of June 1999.**

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15 **D C MORGAN
For the Registrar
the Comptroller General**

Annex A

	<u>Mark</u>	<u>Class</u>	<u>Registration No.</u>	<u>Description of Goods</u>
5	SMIRNOFF	33	1,295,657	Vodka
10	SMIRNOFF & device	33	1,431,537	Vodka
	SMIRNOFF DE CZAR	33	1,328,847	Vodka
15	SMIRNOFF & device	33	2,023,546	Wine, Spirits and Liqueurs
20	SMIRNOFF Label	33	1,295,658	Vodka
	SMIRNOFF Label	33	2,052,422	Vodka
25	SMIRNOFF Label	33	1,295,659	Vodka
30	SMIRNOFF MOSCOW MULE Bottle	33	1,588,562	Wines, Spirits and Liqueurs