

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 2041505 BY
JOSEPH E SEAGRAM & SONS, INC**

AND

OPPOSITION No 45103 BY DANIEL FINZI & CO (SUC.) LIMITED

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**IN THE MATTER OF Application for registration
no 2041505 by Joseph E Seagram & Sons, Inc
and opposition no 45103 by Daniel Finzi & Co (Suc.) Limited**

BACKGROUND

On 17 October 1995 Joseph E Seagram & Sons Inc of 375 Park Avenue, New York, United States of America applied to register the series of trade marks shown below.



The application proceeded to publication in respect of the following specification of goods in Class 33:-

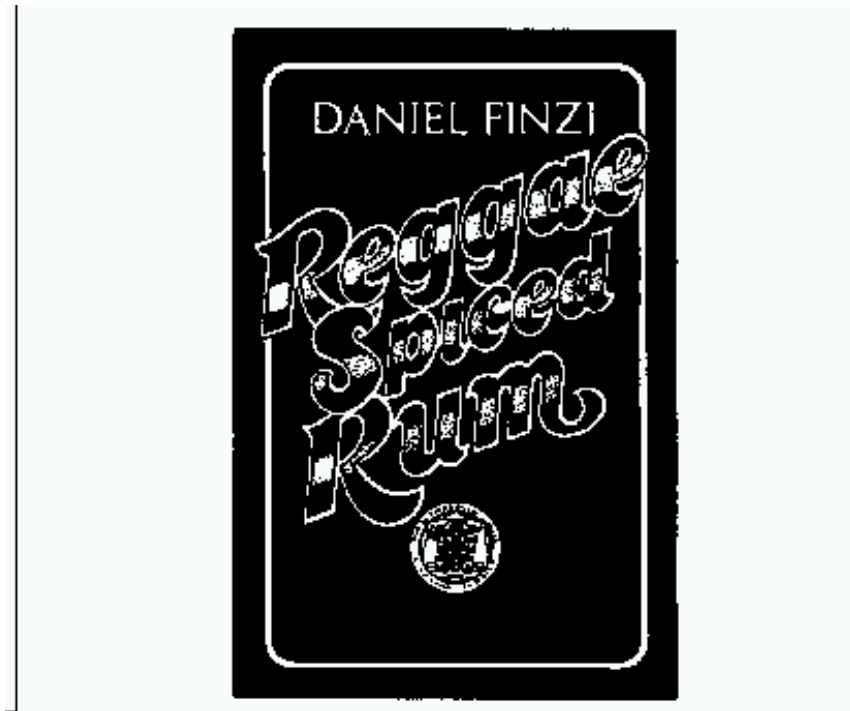
“Alcoholic beverages; rum and rum based beverages”.

The publication of the mark also included the following colour limitation:-

The mark is limited to the colours green, gold, black, white, red and yellow.

On 14 August 1996, Daniel Finzi & Co (Suc.) Limited of 234 Spanish Town Road, Kingston 11, Jamaica, West Indies filed notice of opposition. The grounds of opposition are in summary:

1. Under Section 5(2) of the Act, because of the existence of the opponents' earlier application for a similar trade mark applied for on 29 January 1994, numbered 1560688 and shown below:



2. Given the filing dates of the respective applications the opponents claim that they are the rightful proprietor of the trade mark, whether a label or not, containing the word REGGAE for goods in Class 33. I presume this ground goes to Section 3(6) of the Act, although specific details are not particularised.

The applicants filed a counter-statement in which they state they are the proprietors of trade mark registration no 1225801 for the mark REGGAE (word only) in Class 33 and registered for wines, spirits (beverages) and liqueurs. That trade mark was removed from the Register with effect from 14 June 1995 (see SRIS 0-271-98). The applicants admit that the opponents have filed application no 1560688 for registration of the mark DANIEL FINZI REGGAE SPICED RUM label, also in Class 33, but all grounds of opposition are denied.

Both sides seek an award of costs.

Evidence was filed by both parties and the matter came to be heard on 3 November 1999 when the applicants were represented by Mr Adrian Speck of Counsel instructed by RGC Jenkins & Co. The opponents were represented by Ms Denise McFarland of Counsel instructed by JE Evans-Jackson & Co.

DECISION

No evidence has been provided, nor any oral arguments submitted, to support the second ground of opposition mentioned above, and indicated by me as going to Section 3(6) of the Act. That being the case, this ground of opposition is dismissed.

I turn therefore to the ground of opposition based upon Section 5(2)(b) of the Act which states:

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

.....

(a) 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.

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,

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

(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.

(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.

I propose to consider the matter on the basis of the approach adopted by the European Court of Justice in *SABEL v PUMA* 1998 RPC 1999. 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:

"..... 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.

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."

I also have regard to the approach adopted by the European Court of Justice in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case - 39/97) which also dealt with the interpretation of Article 4(1)(b) of the Directive. The Court in considering the relationship between the nature of the trade mark and the similarity of the goods stated:

"A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. Accordingly, a lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified."

Finally, the court gave the following judgement on the interpretation of Article 4(1)(b):

"On a proper construction of Article 4(1)(b) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, the distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion."

In a Statutory Declaration dated 15 September 1997, Mr Ian Michael Harris who is the Marketing Director of Seagrams in the United Kingdom, he describes how, in December 1994 (SUK) identified a potential market in the UK for a new brand of white rum. To support this a copy of an inter-office memo on the subject dated 23 December 1994 is exhibited at IMH2. Mr Harris says that the project continued to develop to the stage where two main trade marks were proposed. These were CACIQUE and REGGAE. At exhibit IMH3 is a copy of SUK internal documentation dated 17 and 18 May 1995 supporting this contention. Mr Harris states that early in 1995 SUK entered into negotiations with two potential distributors Threshers Wine Merchants and Waverley Vintners. Mr Harris says that during the course of these discussions SUK proposed several possible brand names, one of which was the REGGAE mark, which SUK at that time knew to be available to them as JES were the proprietor of registration no 1225801 (now revoked). Mr Harris goes on to say that negotiations continued throughout the first half of 1995 and by May 1995 the product

specification had been finalised with both distributors. In June 1995 SUK showed Threshers and Waverley a label featuring the mark REGGAE. Copies of the label, shown to both parties, together with correspondence dated 15 June 1995 is exhibited at IMH4. In September 1995, explains Mr Harris, the REGGAE white rum product was launched bearing the mark that is the subject of the application in suit. A copy of the label used is exhibited at IMH5, and Mr Harris adds that the REGGAE brand of white rum has been continuously available to retailers throughout Scotland and England since that date.

The applicants therefore claim to have some use of their trade mark which pre-dates the date of filing of the opponents' application for registration. But that is not sufficient under the provisions of Sections 5(2) and Section 6 to get the opposition off the ground under that head. It is clear that he who is first to file must succeed, unless the later filed trade mark has acquired rights such that the provisions of 5(4)(a) would prevent the registration of the earlier filed trade mark. That is not the case here.

First of all I do not think that the evidence demonstrates any significant use of the opponents' trade mark such that it has gained a reputation which might assist them here. The goods covered by the respective specifications are the same and the respective trade marks are similar, such that confusion on the part of the public will occur. In reaching this view I take fully into account the authorities set out above. In my view the predominant feature of the applicants and the opponents' trade marks is the word REGGAE. The addition of the name DANIEL FINZI in the opponents trade mark (and the descriptive term Spiced Rum) are not elements which are going to remove the likelihood that when compared as wholes each trade mark will be seen and known as a REGGAE trade mark and goods sought and ordered under that term.

The opposition succeeds because the opponent has a similar trade mark to the applicant for the same goods which is an earlier trade mark under the provisions of Section 6, because the application for its registration carries an earlier filing date. It will therefore be a fatal barrier to the progress of this application upon its registration.

That being the case, and given my decision in opposition No: 42548, which results in the registration of the opponents' application for registration No 1560688, the opposition under Section 5(2)(b) of the Act succeeds. The opponent having been successful in these proceedings is entitled to a contribution towards their costs. I therefore order the applicant to pay to the opponent the sum of £835.

Dated this 14 Day of February 2000

**M Knight
For the Registrar
The Comptroller General**