

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No 2207512  
BY AGRICOLA Y FORESTAL ARCO IRIS S.A.  
TO REGISTER THE MARK  
CLAVA IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER No 51207  
BY BADISCHER WINZEREKELLER EG**

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**IN THE MATTER OF Application No 2207512  
by Agricola y Forestal Arco Iris S.A. to register the mark  
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**and**

**IN THE MATTER OF Opposition thereto under No 51207  
by Badischer Winzerkeller EG**

**DECISION**

1. On 2 September 1999 Agricola y Forestal Arco Iris S.A. applied to register the mark CLAVA for wines in Class 33. The application is numbered 2207512.
2. On 26 July 2000 Badischer Winzerkeller EG filed notice of opposition to this application basing their case on Section 5(2)(b) and their earlier trade mark No. 929349 for the mark LAVA covering wine in Class 33.
3. The applicants filed a counterstatement denying the above ground.
4. Both sides ask for an award of costs in their favour.
5. Only the applicants filed evidence. Neither side asked to be heard but the attorneys acting for the parties filed written submissions. In the case of the applicants these submissions were under cover of a letter dated 5 July 2001 from Carpmiels & Ransford. For the opponents the submissions were under cover of a letter of 21 June 2001 from Castles.
6. Acting on behalf of the Registrar and with all the above material in mind I give this decision.
7. Section 5(2)(b) 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."

8. I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*

[1999] E.T.M.R. 1, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG* [2000] E.T.M.R. 723.

9. It is clear from these cases that:-

- (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*, paragraph 22;
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v. Puma AG*, paragraph 23, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.* paragraph 27;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (f) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (g) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (h) further, 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; *Marca Mode CV v. Adidas AG*, paragraph 41;
- (i) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

10. The respective sets of goods are identical so the matter turns on the marks themselves.

No evidence of use of the opponents' mark has been placed before me so I have only its inherent characteristics to consider. So far as the applicants' mark is concerned Anne Wong, their professional representative, gives evidence to the effect that in Spanish 'clava' means a cudgel or club and may also mean a lance or spear. Specifically it is suggested that the mark CLAVA is intended to refer to a kind of cane made of stone and used by the chief of the Mapuche tribe of Indians and the mark would not therefore be confused with LAVA. If there was evidence that the goods at issue were only directed at Spanish nationals or other Spanish speakers in the UK or that consumers were likely to be aware of the intended reference there might be some force to that submission. However the goods are wine and it must be assumed that they will be directed at the populace at large and not a sub-set of Spanish speakers. In my view the general public in this country would regard CLAVA as being an invented word and I intend to approach the matter on that basis.

10. I have also been referred to a number of decisions involving comparison of marks. I have taken note of these but do not find them of significant assistance in determining the issue before me which necessarily turns on the particular marks involved.

11. I am required to take into account visual, aural and conceptual similarities and to make due allowance for imperfect recollection. Visually the applied for mark self evidently incorporates the whole of the opponents' mark. In relatively short words that certainly produces a point of similarity. The single letter difference is, however, at the start of the applicants' mark and is unlikely to be overlooked or to attract less attention as it might if it were positioned in the middle or at the end of the word. Moreover a single letter difference at the start of a relatively short word is likely to have a significant impact on overall perception of the mark. Visual inspection is itself likely to play an important part in the purchase of wine. Customers normally pay at least a modicum of attention to purchasing wines simply because a positive choice has to be made from a wide selection of such goods on offer in most retail outlets. Equally it must be recognised that the comparison is unlikely to be a side by side one and may be made on the basis of imperfect recollection of the name of another brand. The opponents also make the point in their written submissions that "on a wine label there is often other material to distract from the name of the wine itself and the name is often used in a certain typeface". That is true but the customer must also be taken to be reasonably well informed, circumspect and observant. The brands must, as it were, be given a fair chance. Taken overall I find that the visual difference between the marks outweighs the point of similarity.

12. The initial letter of the applicants' mark is also likely to play a significant part in spoken references to the mark. I cannot immediately think of any word beginning with CL where the C is not a hard (k) sound. That suggests a clear point of differentiation between the respective marks. Trade mark case law over the years (see for instance TRIPCASTROID 42 RPC 264 at page 279) has emphasised the importance attached to the beginnings of words and the tendency towards slurred endings.

13. Conceptually the applied for mark is (or rather I am treating it as) an invented word. The opponents' mark is a well known dictionary word. The opponents submit that "..... we believe that LAVA although having a meaning in the English language has no meaning in respect of wine and therefore would not be recognised in the way described by the applicants

in respect of such products". I do not accept that the normal meaning of a word would be lost or ignored simply because it is used as a trade mark (and is without descriptive significance in relation to the goods). On the contrary words will be recognised and remembered for what they are. As a result I see no reason to suppose that consumers would find any conceptual similarity between the respective marks.

14. Taking all the above considerations into account the high point of the opponents' case is that it is possible that some people may note that the whole of one mark appears in the other. But the guidance in *Sabel v Puma* (paragraph 26) is that mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2). That seems to me to be the position here. I am not persuaded that there is a likelihood of confusion. The opposition, therefore, fails.

15. The applicants have been successful and are entitled to a contribution towards their costs. I order the opponents to pay the applicants the sum of £435. 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 the case if any appeal against this decision is unsuccessful.

**Dated this 30<sup>TH</sup> day of July 2001**

**M REYNOLDS**  
**For the Registrar**  
**the Comptroller-General**