

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2268151
IN THE NAME OF HALEWOOD INTERNATIONAL LIMITED
TO REGISTER A TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER
No. 90381 BY GUINNESS UDV NORTH AMERICA INC**

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in the name of Halewood International Limited
to register a trade mark in Class 33**

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**IN THE MATTER OF Opposition thereto under No. 90381
by Guinness UDV North America Inc**

BACKGROUND

1. On 21 April 2001 Halewood International Limited applied to register the trade mark VODKA ELEMENTS in Class 33 of the register for a specification of “Alcoholic beverages in class 33”, subsequently amended and limited to “Alcoholic beverages, consisting of or containing vodka as an ingredient, all included in Class 33”.
2. The application was accepted by the Registrar and published in the Trade Marks Journal.
3. On 3 September 2001 Bristows on behalf of Guinness UDV North America Inc filed Notice of Opposition. In summary the grounds of opposition were as follows:
 - (i) Under Section 3(1)(b) of the Act as the mark is devoid of distinctive character for alcoholic beverages containing elements of vodka or vodka as an element.
 - (ii) Under Section 3(1)(c) of the Act because the mark consists exclusively of signs or indications which may serve, in the trade, to designate the kind, quality, quantity or other characteristics of goods and services as the mark consists exclusively of an indication of an alcoholic beverage which contains elements of vodka or vodka as an element.
 - (iii) Under Section 3(1)(d) of the Act as the mark consists exclusively of a sign or indication which has become customary in the current language or in the bona fide and established practices of the trade as the goods comprise an alcoholic beverage which contains as an essential ingredient vodka so that it contains “vodka elements”.
 - (iv) Under Section 3(3)(b) of the Act in that the mark is of such a nature so as to deceive the public as to the nature or quality of the goods insofar as the mark may be used on all alcoholic beverages in Class 33, including beverages which do not contain an element of vodka.
 - (v) Under Section 3(4) of the Act because use of the applicant’s mark is prohibited in the United Kingdom by Council Regulation (EEC) No 1576/89 of 29 May 1989, in particular Article 1(4)(q), which defines “vodka” as rectified ethyl alcohol of agricultural origin or filtered through activated charcoal, possibly followed by straightforward distillation or an equivalent treatment, so that the organoleptic characteristics such as a mellow taste by the addition of flavouring, and Article 5

which precludes any use of the word “vodka” for a spirit drink which does not meet the specifications set out in Article 1(4).

4. The applicant filed a Counterstatement denying the grounds of opposition raised under Section 3(1). In relation to the Section 3(3)(b) and Section 3(4) grounds the applicant amended the specification of goods in the mark in suit to read “Alcoholic beverages, consisting of or containing vodka as an ingredient, all included in Class 33”. In light of this amendment the applicant denies the Section 3(3)(b) and Section 3(4) grounds.

5. Both sides filed evidence and asked for an award of costs in their favour. Neither party requested a hearing but the opponent forwarded written submissions to assist the Hearing Officer in the making of the decision.

Opponent’s Evidence

6. This consists of a witness statement by Philip Edward Culbert dated 14 March 2002. Mr Culbert is a solicitor employed by Bristows, the opponent’s professional advisors in this case.

7. Mr Culbert states that the word “vodka” is descriptive and devoid of any distinctive character in relation to beverages consisting of or containing vodka. He adds that the words “elements” in its ordinary usage has a natural descriptive meaning in relation to the applicant’s goods and says that it would be perfectly normal in the English language if the amended specification for this application had read “Alcoholic beverages, consisting of or containing vodka as an element, all included in Class 33”. In Mr Culbert’s view the words “element” and “ingredient” are interchangeable.

8. Mr Culbert goes on to draw attention to Exhibit PEC1 to his statement which comprises a copy of a definition of the word “element” taken from the Concise Oxford Dictionary. According to this definition an element is a “component part”. He states that, applied to the mark VODKA ELEMENT this leads to the descriptive interpretation that vodka is a component part of the product so labelled or that the goods are vodka combined with another element.

9. Next, Mr Culbert states that he arranged Internet searches to establish how the word “elements” is used in relation to alcoholic beverages and at Exhibit PEC2 to his statement are printouts from websites identified during those searches. In particular, Mr Culbert draws attention to the following:

“1. An article entitled “Vodka’s image” by Brian Balthazar which uses the following phrase in relation to vodka – “the most popular spirit in the world today businessman John G Martin got America to take notice of the liquor, tasting its mixability with other elements for cocktails.”

2. An article entitled “Confused Get Infused” by Mike Robothom which included the following – “on display behind the bar at Infusion eight large glass jars are filled with vodka and their infusing elements”.

3. An article entitled “Skyy Blends S Great Fruit Into Once Great Vodka” on www.nightclub.com– beverage news, which includes the following – “blending so

many citrus flavours into vodka ie nothing new but Skyy Spirits has crossed into new territory by blending so many citrus elements into one spirit”.

10. Mr Culbert concludes that the mark in suit is descriptive and devoid of distinctive character; designates the kind, quality or quantity of the applicant’s goods; and is customary in the current language in the bona fide and established practices of trade.

Applicant’s Evidence

11. This consists of a witness statement by Simon James Belcher dated 8 July 2002. Mr Belcher is a registered trade mark attorney and a partner in Urquhart-Dykes & Lord, the applicant’s professional advisor in this case.

12. Mr Belcher states that the word ELEMENTS has a number of meanings and he attaches as Exhibit SJB1 to his declaration an extract taken from The Shorter Oxford English Dictionary, Third Edition, which sets out definitions of the singular form of the word. He says the definition which is indicated in widespread use is : Component part – one of the relatively simple parts of any complex substance. He adds that the other definitions of the word given in the dictionary are concerned with its use in technical fields and states that the fact that the widely used dictionary definition of ELEMENT is concerned with complex substances, supports the position that the word would not be used by the average consumer when looking to identify an alcoholic beverage using descriptive language.

13. Mr Belcher concludes that the mark, as a whole, is a lexical invention and that there are perceptible differences between the combination of words submitted for registration and the terms used in common parlance in relation to alcoholic beverages.

14. This completes by summary of the evidence filed in this case.

15. The opponent has forwarded written submissions to assist the making of the decision. In essence these submissions concern the dictionary definitions of the word “element” and in particular make the point that the words “element” and “ingredient” are interchangeable.

DECISION

16. The relevant parts of Section 3(1) of the Act read as follows:

“3.-(1) The following shall not be registered -

- (a),
- (b) trade marks which are devoid of any distinctive character,
- (c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

- (d) trade marks which consist exclusively of signs or indications which have become customary in the current language or in the *bona fide* and established practices of the trade:

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.

17. In the present case I must consider whether, on a prima facie basis, the mark in suit meets the requirements of Section 3(1)(b), (c) and (d) of the Act. The proprietor has not submitted nor provided evidence that its mark has acquired a distinctive character as a result of the use made of it.

18. I now turn to a consideration of the evidence filed by the opponent. Much of this evidence relates to material accessed from sources outside the UK ie American internet sites, and contains information relating to the position after the relevant date for these proceedings (21 April 2001). While this evidence is of no real weight it may go to infer that the dictionary definition of the word “Elements” as meaning “a component part” of a product, may reasonably be applied in the context of ingredients for vodka cocktails or alcoholic beverages in general.

19. In order to determine whether or not the mark in suit in its totality meets the requirements of Section 3(1) it seems to me that a full and proper approach involves a consideration of the individual elements comprised in the mark and then, taking into account the goods and the particular customer for the relevant goods, undertaking a global appreciation as to whether in totality the marks meet the requirements set down in the Act.

20. I firstly consider the Section 3(1)(b) ground taking into account the guidance set out in the decision of Geoffrey Hobbs QC sitting as the Appointed Person in *Cycling Is ...* [2002] RPC 37. In particular, I find paragraphs 66 to 71 of that decision, set out below, to be of particular assistance:

“66. This brings me to the question whether the signs possess a distinctive character enabling them to fulfil the essential function of a trade mark in relation to goods and services of the kind specified in the application for registration. (The goods and services comprise “clothing footwear and headgear” in Class 25 and “advertising all relating to the cycling industry” in Class 35).

67. The case for allowing registration rests upon the proposition that the signs are cryptic to a degree which makes it more likely than not that they would carry connotations of trade origin (whatever other connotations they might also carry) in the mind of the relevant class of persons or at least a significant proportion thereof..

68. The case for refusing registration rests upon the proposition that the signs are visually and linguistically meaningful in a way which is more likely than not to relate the goods and services to the activity of cycling without also serving to identify trade origin in the mind of the relevant class of persons.

69. The difference between these two positions resides in the question whether the perceptions and recollection the signs would trigger in the mind of the average

consumer of the specified goods and services would be origin specific or origin neutral.

70. The relevant perspective is that of the average consumer who does not know there is a question, but who is otherwise reasonably well-informed and reasonably observant and circumspect.

71. I do not suppose that such a person would pause to construe the signs when encountering them in any of the different settings (including advertising and promotion settings) in which they might be used. Even so, the degree of attention required to take note of the signs in the first place would be sufficient, in my view, to leave a well-informed and reasonably observant and circumspect person with the clear impression that the signs were being used with reference to goods and services related to cycling”.

21. The mark in suit comprises the two words VODKA ELEMENTS. The word VODKA merely describes the goods or a constituent ingredient of the goods. Furthermore, the dictionary word ELEMENTS could refer to the component parts of the goods. However, it seems to me that the word ELEMENTS solus is elliptical in character in relation to vodka or alcoholic drinks which contains vodka. The word is imprecise in relation to the identity of the products contents, as the relevant goods do not in themselves comprise the component parts or ingredients (although all alcoholic drinks can be mixed with others), but are alcoholic beverages in their own right ie finished products.

22. In considering the mark in its totality it seems to me that VODKA ELEMENTS does no more than infer to the customer for vodka or alcoholic drinks containing vodka ie the general public over eighteen years of age, that the goods comprise or contain vodka. The fact that the mark includes the word ELEMENTS means that the mark VODKA ELEMENTS, in totality, conveys no precise or inferred message. The mark, in totality, is ambiguous in relation to the goods.

23. To conclude, in relation to Section 3(1)(b) I find that, in totality the mark VODKA ELEMENTS is origin specific and this ground of opposition fails.

24. I now go on to Section 3(1)(c) and in relation to this ground I am guided by the September 2001 judgement of the European Court of Justice in *Proctor & Gamble Company v Officer for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case – 282/99P for the mark BABY DRY.

25. I give below paragraphs 37, 39 and 40 of the judgement in full:

“37. It is clear from those two provisions taken together that the purpose of the prohibition of registration of purely descriptive signs or indication as trade marks is, as both Proctor & Gamble and the OHIM acknowledge, to prevent registration as trade marks signs or indication which, because they are not different from the usual way of designating the relevant goods or services or their characteristics, could not fulfil the function of identifying the undertaking that markets them and are thus devoid of the distinctive character needed for that function.”

“39. The signs and indication referred to in Article 7(1)(c) of Regulation 40/94 are thus only those which may service in normal usage from a consumer’s point of view to designate, either directly or by reference to one of their essential characteristics, goods or services such as those in respect of which registration is sought. Furthermore, a mark composed of signs or indication satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way or designating the goods or services concerned or their essential characteristics.”

“40. As regards trade marks composed of words, such as the mark at issue here, descriptiveness must be determined not only in relation to each word taken separately but also in relation to the whole which they form. Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services of their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

26. These paragraphs indicate that only words which are no different from the usual way of designating the relevant goods or their characteristics are now debarred from registration by virtue of Section 3(1)(c).

27. In light of the above guidance I do not feel that the opponent has any stronger case under Section 3(1)(c) than under Section 3(1)(b). For the reasons stated previously (paragraphs 22 and 23 of this decision refer), I believe the combination of the words VODKA and ELEMENTS, as a whole, does not serve in normal usage from a customers point of view to directly designate the goods or the essential characteristics of the goods for which registration is sought.

28. I find that the mark meets the requirements of Section 3(1)(c) of the Act and this ground of opposition fails.

29. Turning to the Section 3(1)(d) ground I have no hesitation in concluding that, on the basis of the opponent’s evidence in this case (upon which I have commented at paragraph 18 of this decision), this ground cannot be maintained in relation to the goods for which registration is sought.

30. The remaining grounds of opposition under Section 3(3)(b) and Section 3(4) of the Act were addressed by the applicant through the limitation of their specification of goods. Following this limitation the opponent has provided no evidence or submissions in relation to these grounds and in my view the Section 3(3)(b) and Section 3(4) grounds can no longer be sustained.

COSTS

31. As the applicant has been successful they are entitled to a contribution towards their costs. I order the opponent to pay the applicant the sum of £1000. 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 this case if any appeal against this decision is unsuccessful.

Dated this 19 day of February 2003

**John MacGillivray
For the Registrar
the Comptroller-General**