

O-183-03

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION No. 2126739
IN THE NAME OF THE SILVER SPRING MINERAL WATER COMPANY LTD**

AND

**IN THE MATTER OF OPPOSITION THERETO
BY LOBLAW COMPANIES LIMITED
UNDER OPPOSITION No. 48501**

TRADE MARKS ACT 1994

**IN THE MATTER OF Application No. 2126739
in the name of The Silver Spring Mineral Water Company Ltd**

AND

**IN THE MATTER OF Opposition thereto
by Loblaw companies Ltd
under Opposition No. 48501**

BACKGROUND

1. On 12 March 2002, the Registrar issued a decision on the substantive issues involved in this case. There was an appeal to the Appointed Person, one of the grounds being that, in part, the decision was based upon jurisprudence handed down by the High Court after the parties had been heard by the Registrar with no subsequent opportunity having been provided for them to comment. In his decision of 24 September 2002 Mr Simon Thorley QC, acting as the Appointed Person, allowed the appeal on that ground, set aside the decision of the Registrar's Hearing Officer and remitted the case back for a hearing before another Hearing Officer.

2. The hearing took place before me on 29 October 2002. Before dealing with the substantive issues involved I record the outcome of a preliminary point which arose. Miss Fiona Clark of Counsel, who, as before, appeared for the opponent, submitted that this was a full re-hearing, Mr Thorley having set aside the whole of the Hearing Officer's decision. Mr Michael Edenborough of Counsel, who, also as before, appeared for the applicant for registration, submitted that I had to have regard to the appeal itself which, in terms of the substantive issues considered, was based only upon a finding under Section 5(2)(b) of the Act. The decision of the Hearing Officer dismissed all other grounds of opposition fairly summarily leaving the 5(2)(b) issue as the focal point of his decision. That was the only ground the subject of the appeal to the Appointed Person in terms of the substance of the decision. On top of that there was the procedural flaw in which the Hearing Officer considered and took into account a judgment handed down by the High Court after the date of the hearing without giving either party an opportunity to make submissions.

3. Mr Edenborough submitted that in considering whether or not the hearing was a rehearing of the case as a whole, I must consider the context in which the appeal was made, i.e. the appeal was based on section 5(2)(b) only. Miss Clark on the other hand argued that we were back to first principles and that I could take into account the pleadings and the evidence filed originally and proceed on that basis.

4. Whatever the merits of their particular submissions, I had to bear in mind the decision of Mr Simon Thorley, acting as the Appointed Person, when he concluded right at the end of his

decision: “I therefore allow the appeal, set aside Mr Salthouse’s decision and remit the opposition back to the Registry for a hearing before a different hearing officer.”

5. It seems to me that taking that sentence at its face-value the case itself is back to be considered de novo. I think Miss Clark was right when she said that the Appointed Person had the opportunity to make directions as to the scope of the case to be considered. He chose not to. That, Mr Edenborough may have argued, was because he was considering the appeal in the context in which it was made, i.e. section 5(2)(b) being the only ground on which the substantive appeal was based. However, I was not prepared to put myself into the place of the Appointed Person and try and determine what he was thinking and considering. I simply took the words that he had used in his decision at their face-value and therefore in the circumstances of this case I was prepared to consider the opposition as a whole on the basis of the agreed pleadings and the evidence filed, so that all of the grounds of opposition could again be considered.

6. In the event, Miss Clark indicated that the only ground being pursued by her client was that based upon Section 5(2)(b) and it was to that ground that submissions were directed. For the sake of completeness, I therefore dismiss the grounds of opposition based upon Section 3(1)(b), 3(4) (which was a mistaken attempt to bring in a Section 5(4)(a) relative ground objection – but Miss Clark accepted that she was no better off under Section 5(4)(a) than under 5(2)(b)); 5(2)(a) and 5(1) are also dismissed.

7. The application for registration in suit was made on 14 March 1997 by The Silver Spring Mineral Water Company Ltd in respect of the trade mark PC CLEAR for the following specification of goods in Class 32:

“Non-alcoholic beverages; soft drinks; carbonated soft drinks; fruit drinks; fruit-flavoured fizzy drinks; mineral water; flavoured mineral water; preparations for making non-alcoholic beverages”.

8. Following acceptance and publication, on the 6 May 1998, Loblaw Companies Limited filed their notice of opposition to the application.

9. The opponent submits that the trade mark the subject of the application is similar to their trade marks registered under Nos. 1533201, 1533202, 1534576 and 1533203, in respect of identical or similar goods, such that the application should be refused under Section 5(2)(b) of the Act. Miss Clark accepted that her best case lay in respect of registration number 1533203 the details of which are as follows:

Mark:



Specification:

“Fruit juices; fruit drinks; mineral and aerated water; non-alcoholic drinks; all included in Class 32.”

10. Section 5(2)(b) states:

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

- (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.”

11. An earlier right is defined 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,”

12. I am satisfied that the opponent’s trade mark is an earlier right on the basis of the above and go on to consider matters against the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] R.P.C. 199, *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.

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 224;
- (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.

13. In the course of their submissions Counsel also drew to my attention the judgement of the Court of Appeal in *R. v BUD and Budweiser Budbrau* [2003]RPC 25 trade marks, the judgment of the High Court having caused the re-hearing. However, I did not regard the judgment of the High Court or the Court of Appeal directly relevant in this case because the questions posed and answered in those cases were directed to other Sections of the Act. The jurisprudence of the ECJ and which relates directly to what is Section 5(2)(b) of the Act and as set out earlier is sufficient for me to reach a view. Mr Edenborough also drew to my attention *IQ Trade Mark Application* [1993] RPC 379 which dealt with the matter of two letter trade marks and the Registrar's practice, under the previous legislation, of requiring disclaimers to the letters involved. This was to argue that in the absence of any disclaimers attached to the opponent's earlier trade mark the Registrar must have seen that trade mark as a device and not simply letters. This distinguished the applicant's and the opponent's trade marks in this case. I reject that submission. I have no knowledge of the circumstances in which the registration of the earlier trade mark took place. My job is to consider the two trade marks before me in this case and determine whether registration of the applicant's is likely to lead to confusion or deception of the public, under the provisions of Section 5(2)(b).

14. Also, both Counsel drew, without much enthusiasm, upon the evidence filed by both parties in this case. For my part I find it of no help. In the context of Section 5(2)(b) statements by representatives of the applicant and the opponent as to how the respective trade

marks might be viewed carry no weight. Nor do sales and promotional figures outwith this jurisdiction. I fall back therefore on my own view of matters with full regard to all of the jurisprudence outlined earlier.

The Goods

15. First of all, neither side disputed that the goods the subject of the application and registration were not identical or similar and I so hold. I only need therefore consider the respective trade marks.

16. The goods at issue are among those items commonly bought by the public at large. They are not expensive items but given that they are for consumption by the purchasers, their family or friends they are likely to be purchased with some, if not very extensive care.

The trade marks

17. The two trade marks are set out below:

Opponent's Trade Mark



Applicant's Trade Mark

PC CLEAR

18. The opponent's trade mark is in my view the letters PC in script form. Despite Mr Edenborough's submissions that the public would see it as a device I believe that the public would, without having to spend time analysing it, see the trade mark as I have already described as the letters PC in script form. The applicants trade mark consists of the two letters PC together with the word CLEAR.

Distinctive Character of the trade marks

19. The letters PC are in my view distinctive for the goods in question here. Their normal meaning would be Personal Computer and as the goods are far removed from the computer and related fields the letters PC are distinctive. However, the applicant's trade mark has the added element of the word CLEAR. For some of the goods covered by the specification, ie. lemonade and mineral water, the term CLEAR could be descriptive. Though I have no evidence that the public would so regard the term it seems to me obvious that the word CLEAR is a descriptor for things like lemonade and mineral water. Thus that element of the trade mark would have less impact on the public. For that reason I believe that both trade marks are likely to be seen as PC trade marks with the same conceptual similarities.

Global assessment

20. As indicated earlier, there is no evidence of any enhanced reputation as a result of use of the earlier trade mark.

21. I have already held that the general public who will be the consumers of these goods, will see these two trade marks as PC trade marks. I have already given my view that the two trade marks would be seen, conceptually, as PC trade marks. This is so despite the differences in script between them. It follows that aurally, both will be pronounced as PC. The fact that the PC element is the predominant one in the applicant's trade mark with the term CLEAR being a descriptor for some of the goods covered by the specification reinforces that. Therefore, given that the respective goods are the same it seems to me that it must follow that the grounds of opposition under Section 5(2)(b) are made out. Registration of the applicant's trade mark is likely to lead to confusion on the part of the public. The application for registration is therefore refused.

Costs

22. Both sides made submissions on the matter of the costs incurred as a result of the earlier hearing and decision which was set aside on appeal, as well as on the costs of the appeal itself.

23. I have not dealt with these submissions in the decision, the matter is one which is to be dealt with bilaterally between the Patent Office and the parties. However, insofar as the costs incurred in the case before me and taking account of the cost of filing the notice of opposition, perusing the counterstatement, attendance at the hearing, but not for the preparation of and filing of evidence, which played no part in the proceedings, I order the applicants to pay to the opponents the sum of £950.

Dated this 27th day of June 2003

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