

O-040-04

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2309421
IN THE NAME OF INDOMITA WINES S.A.**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 91406 IN THE NAME OF
CHATAM INTERNATIONAL INC.**

TRADE MARKS ACT 1994

**IN THE MATTER OF application No 2309421
in the name of Indomita Wines S.A.**

And

**IN THE MATTER OF opposition thereto under No 91406
in the name of Chatam International Inc.**

Background

1. On 31 August 2002, Indomita Wines S.A. applied to register the trade mark QUINTUS in Class 33 in respect of the following specifications of goods:

Wines and spirits.

2. On 13 January 2003, Chatam International Inc. filed notice of opposition against the application, the ground being in summary:

Under Section 5(2)(b) because the mark applied for is similar to the opponents= earlier Community Trade Mark registration, and is sought to be registered for goods that are identical or similar.

3. Details of the earlier mark relied upon by the opponents is as follows:

Number	Mark	Class	Specification
CTM 1056126	QUANTUM	33	Wines

4. The applicants filed a Counterstatement in which they deny the ground on which the opposition is based.

5. Both sides request that costs be awarded in their favour.

6. Only the opponents filed evidence in these proceedings. Neither party took up the offer of an oral hearing, and accordingly, after a careful study of the evidence on file, I issue my decision on the facts before me.

Opponents= evidence

7. This consists of a Witness Statement dated 16 July 2003, and comes from Raymond Roy Prentice, a trade mark attorney and the opponents=representative in these proceedings.

8. Mr Prentice refers to exhibit RRP1, which consists of details relating to the opponents= QUANTUM Community Trade Mark registration as detailed above. Exhibit RRP2 consists of details of Community Trade Mark registration No. 1746346, also, inter alia, for the mark QUANTUM and registered in respect of AWines and alcoholic drinks (except beers)@, the proprietor being Chambourd & Cie (Societe a responsabilite limitee). This second registration contains the following description of the mark:

ABlue bottle with labelling and a white background and black lettering@.

9. It also contains an indication of colour ABlue, white and black@.

10. Exhibit RRP3 consists of a fax communication from Charles Jacquin et Cie.,Inc to Mr Prentice, confirming that Chambourd is a subsidiary of Chatam. The fax also confirms that the CTM registration in the name of Chambourd has been assigned to Chatam, a copy of the assignment, dated 9 July 2003 being shown as exhibit RRP4.

11. Mr Prentice recounts having conducted a search of the UK and Community trade marks registers, for all marks in Classes 32 and 33 that consist of the string QU*NTU*, the results of which are shown as exhibit RRP5. Mr Prentice notes that only the applicants= mark was retrieved from the UK register, and only the opponents=registrations from the Community Trade Marks register.

12. That concludes my review of the evidence insofar as it is relevant to these proceedings.

Decision

13. The opposition is based on Section 5(2)(b). That section reads as follows:

A5.-(2) A trade mark shall not be registered if because B

(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.@

14. An earlier trade mark is defined in Section 6 of the Act as follows:

A6.- (1) In this Act an earlier trade mark means B

- (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.®

15. In my consideration of a likelihood of confusion or deception I take into account the guidance provided by the European Court of Justice (ECJ) in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] 45 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*,
- (b) the matter must be judged through the eyes of the average consumer of the goods/services in question; *Sabel BV v Puma AG*, 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.*,
- (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*,
- (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*,
- (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*,
- (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*,
- (g) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,

- (h) 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*,
- (i) 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*,
- (j) 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.*

16. In the Statement of Grounds, the opponents mention one earlier mark, a CTM for the trade mark QUANTUM, registered in Class 33 in respect of wines. In his evidence Mr Prentice refers to a second CTM that has been assigned by a subsidiary to the opponents, but he does not ask that this second mark be taken into account as being an earlier mark in these proceedings. Accordingly, I shall determine this opposition on the basis of the one mark relied upon in the Statement of Grounds, but in any event, if the opponents do not succeed in respect of the mark they cite in the statement of grounds, they will be in no better position in respect of the one that they have acquired.

17. In their counterstatement the applicants say that QUANTUM is an ordinary English word with meanings relating to size or quantity, but as far as I am aware, it has no relevance for, and is a distinctive mark in respect of the goods for which it is registered. I have no evidence that the opponents have used the mark, and cannot, therefore say that the mark has a reputation or is any more distinctive because of the use that has been made of it.

18. Both specifications contain the specific goods *Wine* so in that respect identical goods must be involved. Insofar as both the application and the opponents' earlier registration have no form of limitation that would otherwise delineate them, I must assume that at least notionally they share the same channels of trade, from manufacture to retailer, and also the same consumer.

19. The applicants' specification goes somewhat wider in that it also contains *Spirits* and the question is whether such a description of goods would be regarded as being similar to the wine covered by the opponents' earlier mark. In answering this I would ordinarily look to the guidance of Jacob J. in *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281. However, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Balmoral Trade Mark* [1998] R.P.C. 297, determined that wine and whisky should be regarded as similar goods, saying

I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to

signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the Applicant over-emphasise the part played by producers and under-emphasise the part played by other traders in the business of buying and selling whisky and wines.

It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of "own brand" or "merchant-specific" labelling. Those who supply retail customers may be licensed to do so under an "off-licence" or a licence for "on and off sales" in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well. When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the British Sugar case (uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines.

20. Given the reasoning in his decision, I do not see why other spirits should not also be taken to be similar goods to wine.

21. Wines and spirits are not inordinately expensive goods, although I do accept that there are some exceptions to this. In my experience, consumers of spirits tend to know the various names and will usually be loyal to a particular brand because of price or taste. The same can be said of wine but I would say possibly to a lesser extent. When purchased from a retail outlet such as a supermarket, wines and spirits will usually be obtained by self-selection, and as such, identification will be by visual recognition. When purchased in licensed premises, the consumer may ask for a wine or spirit by name, either from memory or after scanning the bottles on display, or simply request a particular type, e.g, whisky, red wine, with no regard to the brand. In such cases the aural, and to a lesser extent, visual similarity will have a part to play.

22. In most word marks conceptual similarity may have little part to play. In this case the applicants say that the respective marks have very different meanings, QUINTUS being a Greek or Roman name, and QUANTUM being a word denoting size, quantity etc, inferring that the consumer will be aware of each and will use this knowledge to tell them apart. The words may be familiar to some consumers, but I am not sure that their exact meanings would be.

23. The case law states that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, although qualifies this by saying that the distinctiveness and dominance of individual components should have some bearing. In my view, neither word has an element that should be considered to be any more distinctive or particularly dominant, but as both parties have made reference to the construction of the two words, I will go on and consider their submissions.

24. The opponents refer to the fact that both incorporate the initial letters QU followed by the letters NTU, the applicants to the differences in their likely pronunciation, breaking the marks into two elements and comparing them as KWINT-TUS against KWAN-TUM. Given the similarity in the use of consonants, I would say that if there is a distinctive or dominant component of either mark, it must be the same element in both marks, and if only by virtue of being at the beginning of the word this element is likely to be the syllable QU*NT. It is plain to see that there is a resemblance in this element but when the vowels are placed in position the appearance and sound of both is markedly different. Add in the differences in the termination of the words and I have little hesitation in determining that the words are quite different in sound and appearance, and even allowing for the possibility of imperfect recollection, that the consumer is unlikely to confuse the two.

25. On a global appreciation of all of the circumstances, I consider that a consumer familiar with the mark QUANTUM, on seeing QUINTUS used on the same or similar goods, will not be led into wrongly believing that the respective goods come from the same or economically linked undertakings, and that there is no likelihood of confusion. Accordingly, the objection under Section 5(2)(b) fails.

26. The opposition having failed, the applicants are entitled to an award of costs. I order the opponents to pay the applicants the sum of , 1,000 as a contribution towards their costs. 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 6th day of February 2004

**Mike Foley
for the Registrar
the Comptroller General**