

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO 2050048
BY KOPPARBERGS BRYGGERI AB TO REGISTER A
TRADE MARK IN CLASS 32**

AND

**IN THE OPPOSITION THERETO UNDER NO 46473
BY BASS PLC**

TRADE MARKS ACT 1994

5 **IN THE MATTER OF TRADE MARK APPLICATION NO 2050048**
BY KOPPARBERGS BRYGGERI AB TO REGISTER A
TRADE MARK IN CLASS 32

AND

10

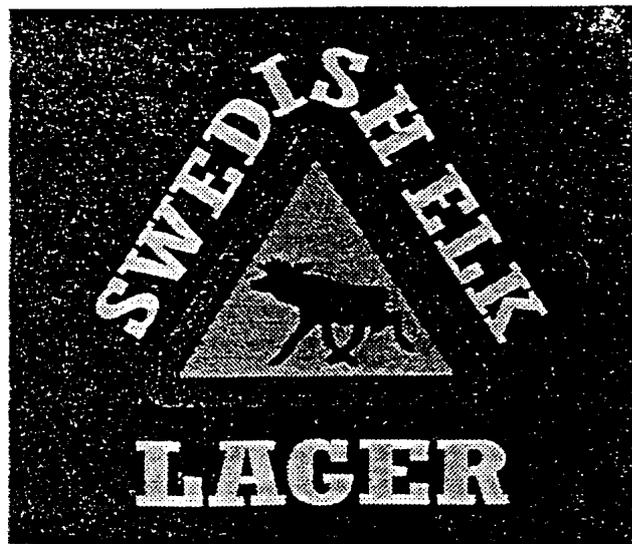
IN THE OPPOSITION THERETO UNDER NO 46473
BY BASS PLC

15

BACKGROUND

On 13 December 1995 Kopparbergs Bryggeri AB of Kopparberg, Sweden applied to register the trade mark shown below in Class 32 for "lager".

20



25

30

35

40 On 20 February 1997 Bass Public Limited Company filed notice of opposition to this application. The grounds of opposition are in summary:-

- i under Section 3(3) because the nature of the trade mark applied for is such to be likely to deceive the public
- 45 ii under Section 3(6) because the application for registration was made in bad faith

iii under Section 5(2) because the applicants' trade mark is similar to the opponents' earlier trade marks such that there exists a likelihood of confusion on the part of the public, which includes a likelihood of association, if registered.

5

iv under Section 5(4) because of the use made of their trade marks by the opponents, use of the applicants' trade mark would be liable to be prevented by the common law tort of passing off.

10 The earlier trade marks upon which the opponent relies are set out in a schedule to the Notice of Opposition but they draw attention in particular to those shown at Annex A. The opponents also asked for an award of costs to be made in their favour.

15 The applicants for registration filed a counterstatement denying all of the grounds of opposition. They too seek an award of costs in their favour.

20 Only the opponents filed evidence in these proceedings and the matter came to be heard on 22 October 1998. At the hearing the opponents were represented by Mr Henry Carr, Queen's Counsel, instructed by their trade mark agents, Trade Mark Owners Association. The applicants were not present and were not represented.

OPPONENTS' EVIDENCE

25 This consists of a statutory declaration by Paul Christopher Waters who is Assistant Company Secretary, Bass Public Limited Company (which is the head of a group of companies known collectively as The Bass Group) and the contents of the declaration is taken from his own knowledge, and the records of his company or other companies in The Bass Group.

30 Mr Waters provides background information on the Group's equilateral triangle trade mark which has been used since 1855 in various colours and combinations. Exhibited at PCW10 and 11 are a booklet and extracts from the company's Internet website which provide further historical background to the company's triangle device trade mark and its importance to the company.

35

40 Mr Waters states that the company has always vigorously defended the trade mark in the United Kingdom and refers to the decision in *Bass v Nicholson* (49 RPC 88). He also provides at Exhibit PCW2 a copy of an affidavit by a Mr James Richard Lloyd filed in the case of *Bass Limited v Ankara Pazari Gida Maddeleri Ticaret AS*, together with an affidavit by Mr Kenneth William Osbourne in the same case.

45 Mr Waters goes on to refer to the grounds of opposition and the registered trade marks of his company consisting of or containing an equilateral triangle device. He states that these trade marks have been used continuously and to a substantial extent in the United Kingdom. In that connection he refers to Exhibit PCW4 a copy of the company's annual report and financial statement of 1996 which shows that The Bass Group made an operating profit in

1996 of £157 million, primarily from the sale of alcoholic beverages in the United Kingdom. He also exhibits at PCW5 a copy of an advertisement from The Economist newspaper dated 1991 and various other newspapers between then and February 1997 all of which emphasise the importance of the triangle trade mark with such a slogan as “They copied our triangle because they couldn’t match our beer”.

In view of all the evidence it is Mr Waters belief that any company adopting a triangle device as their trade mark in respect of alcoholic and non-alcoholic drinks do so in the full knowledge of his company’s trade mark rights in a blatant attempt to trade off his company’s reputation in their trade mark.

That concludes my review of the evidence.

The first two grounds of opposition based upon Section 3(3) and Section 3(6) I dismiss as without foundation. First of all in relation to Section 3(3) there is no indication prima facie that there is anything inherent in the trade mark which would deceive the general public and no evidence has been submitted to that effect. Insofar as Section 3(6) is concerned, no evidence has been submitted that the trade mark in suit does not belong to the applicants or that they are not intending to use the trade mark on the goods covered by the application.

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

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

- (a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or
- (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.

An earlier right is defined in Section 6 the relevant parts at which state:

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

There was no dispute at the Hearing that the goods under the opponents' and applicants' respective trade marks were the same. I therefore need only consider whether the two trade marks are the same or similar. In doing so I consider the matter on the basis of the approach adopted European Court of Justice in *SABEL v PUMA* 1998 RPC 199. 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.”

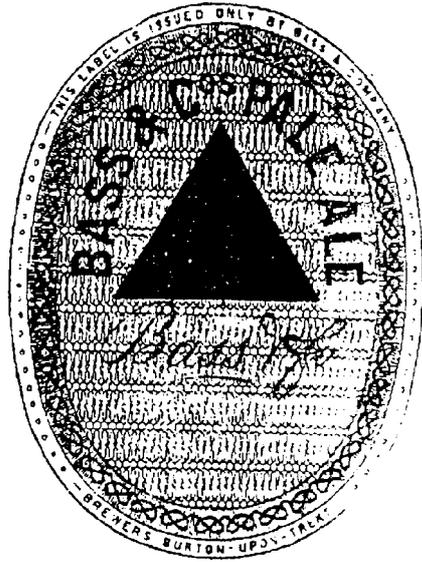
The opponents are the registered proprietor of a vast number of trade marks (including the first trade mark ever registered) which consist of, incorporate or describe an equilateral triangle. It is their belief that the applicants' trade mark incorporates within it an equilateral triangle device such that it is similar to their trade marks (for the same goods) such that confusion on the part of the public is likely if the application was allowed to proceed to registration.

The trade mark in suit does contain an equilateral triangle at its centre and therefore it contains the whole of the opponents' basic registration which is of an equilateral triangle solus. However, the applicants' trade mark consists also of a border, with rounded edges, surrounding the triangle, together with the device of an elk and the words SWEDISH ELK and LAGER, which are printed in such a way as to emphasise the triangular nature of the trade mark.

In order to apply the subjective test referred to earlier and set out in the European Court of Justice finding I have considered the trade mark the subject of the application against a number of the opponents' registrations set out in the schedule, in particular, the following:

5

1



10

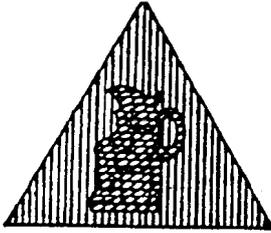


946968

20

969901

1202431



25



30

35

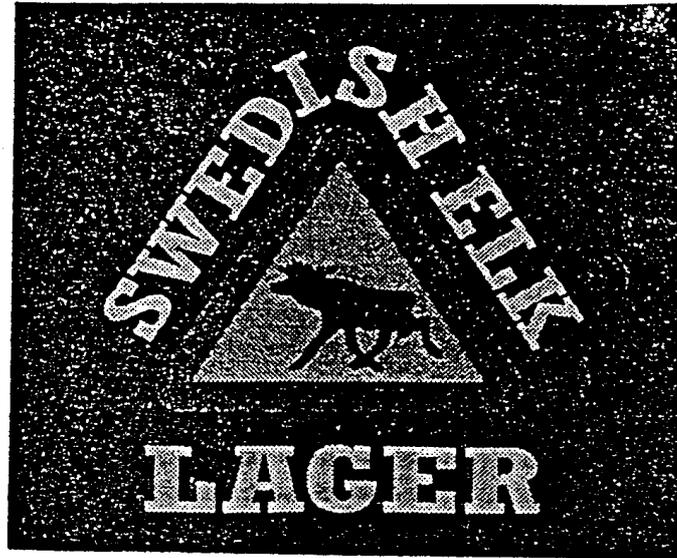
1202433



40

45

For convenience the applicants' trade mark is set out below:



In each of the opponents' trade marks the equilateral triangle device is a prominent or the dominant feature, not least because it is the Group's original registered trade mark which it is at pains to protect. But in most of the examples provided there are within the opponents' trade marks other features like the word BASS or the device of a Toby jug.

Bearing in mind the components of the opponents' trade marks and those of the applicants' trade mark, taking into account the reputation and notoriety of the opponents' trade marks, I consider that the opponents' trade marks convey a different overall impression from that of the applicants. The former would be known as 'triangle' trade marks, because of the dominant nature of that device, or BASS or Toby jug trade marks where they appear, whereas the applicants' trade mark would, in my view, be known as an elk trade mark given the prominence of the device of, together with the word, ELK appearing in the trade mark. I also consider that the triangle device in the applicants' trade mark is 'lost' in the trade mark because it would be seen as a border to the elk device, or it would be seen as a traffic sign warning motorists of elks, if it was seen at all.

Therefore I do not regard the respective trade marks of the opponents as similar to that of the applicants and the ground of opposition based upon Section 5(2) fails.

I turn to the ground of opposition based upon Section 5(4) which reads as follows:

“ (4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

5 (b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

10 A helpful summary of the elements of an action for passing off can be found in Halsbury’s Laws of England 4th Edition Vol 48 (1995 reissue) at paragraph 165. The guidance given with reference to the speeches in the House of Lords in Reckitt & Colman Products Ltd -v- Borden Inc [1990] RPC 341 and Erven Warnink BV -v- J Townend & Sons (Hull) Ltd [1979] ACT 731 is (with footnotes omitted) as follows:

15 “The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

20 (1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the defendant are goods or services of the plaintiff; and

25 (3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

30 The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of ‘passing off’, and in particular should not be used to

35 exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

40 Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

45 “To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

The evidence shows that the opponents have an established and considerable reputation and goodwill in the area of alcoholic beverages and the provision of services relating to such goods. The annual report and financial statement exhibited by Mr Waters is an indication of that. Considerable goodwill also subsists in the company's equilateral triangle device which is registered and used on its own or in combination with other elements across a wide range of alcoholic beverages and related services. I also take into account the nature of that use as indicated in the Statutory Declaration of James Richard Lloyd exhibited to Mr Waters' Declaration, in advertisements and on items such as beer mats and ashtrays in public houses and the like. The respective nature of the opponents' and the applicants' business is likely to be the same - the sale of alcoholic beverages. I therefore have to decide whether the use by the applicants of their trade mark is likely to lead the public to believe that goods offered under the applicants' trade mark are the goods of the opponents and whether as a result damage will occur. I use the future tense because I have no evidence from the applicants as to whether and how their trade mark is used.

For the reasons outlined above I do not consider that the applicants' trade mark is sufficiently similar to the opponents' trade marks to cause a likelihood of confusion on the part of the

public if used alongside one another. In reaching this view I have taken into account the judgement in Bass v Nicholson and in which the view was expressed that the symbol of a triangle in connection with beer meant Bass. That maybe so, but in this case the applicants' trade mark consists of more than just a triangle and its predominant element is of an ELK rather than a triangle.

5

For what it is worth had the trade marks been sufficiently similar to render confusion likely I have no doubt that damage would have been caused to the opponents' reputation and goodwill. However, as the respective trade marks are not such as to cause confusion amongst the public the law of passing off does not apply and the opposition based upon Section 5(4) fails.

10

The opposition having failed on all grounds the applicants are entitled to an award of costs in their favour. I therefore direct the opponents pay to the applicants the sum of £100 as a contribution towards their costs.

15

Dated this 11 day of December 1998

20

25 M KNIGHT
Principal Hearing Officer
For the Registrar
the Comptroller General