

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NUMBER 2225149
BY CHURCHWARDS (ORCHARD PRODUCTS) LIMITED TO
REGISTER A TRADE MARK IN CLASS 33**

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NUMBER 51239
BY H.P. BULMER LIMITED**

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register a Trade Mark in Class 33**

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**IN THE MATTER OF Opposition thereto under Number 51239
by H.P. Bulmer Limited**

BACKGROUND

1. On 9 March 2000 Churchwards (Orchards Products) Limited applied to register the trade mark "Churchwards Lightning Jack" in Class 33 for a specification of "Cider".

2. The application was subsequently accepted by the Registrar and published in the Trade Marks Journal. On 1 August 2000 R.G.C. Jenkins & Co on behalf of H.P. Bulmer Limited filed a Notice of Opposition against the application. In summary the grounds of opposition were:-

- (i) Under Section 5(2)(b) of the Act because the trade mark applied for is confusingly similar to the following European Community trade marks (owned by companies who are wholly owned subsidiaries of the opponent) and registered for the same and similar goods:-

NUMBER	MARK	REGISTRATION EFFECTIVE	PROPRIETOR	CLASS	SPECIFICATION
253492	LIGHTNING	8 May 1996	INCH'S CIDER LIMITED	33	Alcoholic beverages
433789	JACK	20 December 1996	SYMOND'S CIDER AND ENGLISH WINE COMPANY LIMITED	33	Alcoholic beverages; cider; perry

(ii) Under Section 5(4)(a) of the Act in that the trade mark applied for is liable to be prevented by the law of passing off because Symond's has sold SCRUMPY JACK cider in the UK since 1973 and has a considerable goodwill and reputation in the trade mark SCRUMPY JACK and because Inch's has sold WHITE LIGHTNING cider in the UK since 1996 and has a considerable reputation and goodwill in the trade mark WHITE LIGHTNING.

3. The applicants, through their solicitors Bevan Ashford, filed a counterstatement denying the grounds of opposition. Both sides have asked for an award of costs in their favour and have filed evidence. The matter came to be heard on 7 January 2002 when the applicant for registration was represented by Mr Birchmore of the applicants and the opponent by Dr James of RGC Jenkins & Co

Opponent's Evidence

4. This consists of a statutory declaration by William George Stebbings dated 8 March 2001. Mr Stebbings is a solicitor and is the Group Solicitor and Company Secretary of H.P. Bulmer Limited (HPB, the opponent). He is also the Company Secretary of Symonds Cider and English Wine Company Limited (Symonds) and Inch's Cider Limited (Inch's).

5. Mr Stebbings states that HPB is the world's largest cider maker and sells its cider both directly and via wholly owned subsidiary companies, including Symonds and Inch's. He explains that the Symonds family started making their cider in Herefordshire, England in 1727 and that the Symonds family's cider making business and goodwill was acquired in July 1988. Mr Stebbings continues by stating that, in the European Community, Symonds sells its SCRUMPY JACK cider in the UK, Republic of Ireland, Spain and Sweden. SCRUMPY JACK has been on sale in the United Kingdom since 1973, the Republic of Ireland since 1990, Spain since 1991 and Sweden since 1992.

6. Next, Mr Stebbings turns to sales and promotion under the mark. He states that since 1994, the annual sales of SCRUMPY JACK cider in the United Kingdom in terms of turnover and volume have been as follows:

Year	UK Sales in Pounds Sterling	UK Sales in Hectolitres
1994	£13,791,000	1,474,954.50
1995	£16,573,000	1,828,454.50
1996	£19,180,784	2,000,000.00
1997	£17,447,985	1,810,000.00
1998	£17,386,622	1,847,000.00
1999	£20,540,509	1,797,000.00
2000	£20,941,505	2,008,000.00

and adds that since 1994, annual expenditure on the advertising and promotion of SCRUMPY JACK cider in the United Kingdom has been as follows:

Year	UK Advertising Expenditure in Pounds Sterling
1994	£1,494,136
1995	£1,020,000
1996	£ 830,000
1997	£2,658,646
1998	£2,647,200
1999	£1,074,000
2000	£1,500,000

7. Mr Stebbings states that since 1990, SCRUMPY JACK cider has been extensively advertised in the United Kingdom in the press, by way of posters and by means of television and other media advertising. He draws attention to "Exhibit WGS1" which comprises a bundle of sample SCRUMPY JACK labels, advertising and promotional literature for SCRUMPY JACK cider and a video of television advertisements for SCRUMPY JACK cider. These labels, advertising and promotional literature and television adverts have been or are being used in the UK. He adds that during the same period, the SCRUMPY JACK cider brand has been advertised in newspapers and magazines.

8. In addition to the advertising and promotional activities referred to above Mr Stebbings states that Symonds also gained considerable publicity as a sponsor of the England Rugby Union Football Team using the SCRUMPY JACK trade mark during the period 1993 to 1998. He refers to "Exhibit WGS2" to his declaration which comprises a bundle of copies of extracts from newspapers and trade journals relating to Symonds' sponsorship of the England Rugby Union Team.

9. Mr Stebbings goes on to state that, from 1999 to present, Symonds has been an official sponsor of the England cricket team and has used this as a vehicle to promote SCRUMPY JACK cider. He draws attention to "Exhibit WGS4", sample promotional literature for SCRUMPY JACK cider which emphasises the sponsorship of the England cricket team. This material includes information taken from the Internet website www.scrumptjack.com. He adds that in addition to the sponsorship of the England cricket team, Symonds was also an official supplier to the 1999 Cricket World Cup and gained considerable publicity for SCRUMPY JACK cider through this sponsorship. "Exhibit WGS5" to Mr Stebbings declaration comprises sample copies of pages taken from newspapers and magazines where this sponsorship of the 1999 World Cup has featured, in particular, the association of the trade mark SCRUMPY JACK and the 1999 World Cup is mentioned.

10. Mr Stebbings points out that Symonds is the proprietor of the following trade mark registration and application in the UK:

<u>Class</u>	<u>Mark</u>	<u>Regn/Appln. No.</u>	<u>Filing Date</u>
33	SCRUMPY JACK	2170785	29/06/98
33	SCRUMPY JACK	1501448	27/05/92

and he adds that Symonds is also the proprietor of the following trade mark registrations granted by the Office for Harmonisation in the Internal Market:

<u>Class</u>	<u>Mark</u>	<u>Regn. No.</u>	<u>Filing Date</u>
33	SCRUMPY JACK	180216	01/04/96
33	JACK	433789	20/12/96

11. Mr Stebbings draws attention to a previous opposition case. He states that in February 1995, the American Hard Cider Company filed a UK trade mark application (No. 2010729) for CIDER JACK covering "cider, hard cider". This application was opposed (under opposition No. 44676) in June 1996 by HPB, the parent company of Symonds. The basis for this opposition in the UK as:

- (i) Symonds' prior trade mark rights in the trade mark SCRUMPY JACK in the UK, and
- (ii) the known meaning of the word "scrumpy" in England.

The opposition to UK2010729 was successful and a copy of the decision is at Exhibit WGS8 to Mr Stebbing's declaration. The UK Hearing Officer stated that:-

"It is in my view very clear that the word JACK is the distinctive identifying feature of both the applicant's and opponent's marks. Consequently, there must be very good grounds for reaching the view that both visually and phonetically the public would

assume a connection between the two marks on encountering cider and be confused if, as in this case, no such connection exists. The opposition thus succeeds under Section 5(2)(b)".

12. Mr Stebbings claims that the Opponent is aware of only one cider sold in the UK that contains the word JACK in its name, the cider being SCRUMPY JACK sold by Symonds. He adds that the Opponent is sware of the existence of FROSTY JACKS cider, but this does not contain the word JACK. In Mr Stebbings view, the word JACK has no generic meaning on its own in relation to alcoholic beverages as a whole and cider in particular. The word "applejack" is a North American, rather than a UK term. Furthermore, it (apple jack) refers to a spirit based drink rather than to a cider drink and "Exhibit WGS9" to Mr Stebbing's declaration comprises a printout from the Concise Oxford Dictionary (10th Edition, 1999) for the pages defining "applejack" and "jack". He states that the absence of a reference to alcoholic beverages or cider in the "jack" definition will be noted as will any reference to drinking vessels, brewing terms or units of measurement.

13. Mr Stebbings next concentrates upon the WHITE LIGHTNING and LIGHTNING trade marks owned by Inch's. He explains that Inch's started making cider in Devon, England in 1971 and that Inch's cider making business and goodwill was acquired by HPB in 1996. WHITE LIGHTNING has been on sale in the UK since 1996.

14. Mr Stebbings states that since 1994, the annual sales of WHITE LIGHTNING cider in the United Kingdom, in terms of turnover and volume, have been as follows:

<u>Year</u>	<u>UK Sales in Pounds Sterling</u>	<u>UK Sales in Hectolitres</u>
1996		1,816,000.00
1997		2,476,000.00
1998	6,212,426	1,957,000.00
1999	18,449,350	2,380,000.00
2000	20,996,543	2,380,000.00

and that since 1997, Inch's annual expenditure on the advertising and promotion of WHITE LIGHTNING cider in the United Kingdom has been £246,000.

15. Mr Stebbings explains that from 1990, WHITE LIGHTNING cider has been advertised in the United Kingdom in the press, by way of posters and by means of television and other media advertising. "Exhibit WGS12" to his declaration comprises a bundle of sample WHITE LIGHTNING labels and advertising and promotional literatures for WHITE LIGHTNING cider. These labels and advertising and promotional literature have been or are being used in the UK. Mr Stebbings adds that the WHITE LIGHTNING brand of cider was also used to sponsor a racehorse called GO WHITE LIGHTNING. "Exhibit WGS13" to Mr Stebbings' declaration contains copies of literature relating to the racehorse. In the literature the horse is also referred to by his nickname of "Des".

16. Mr Stebbings points out that Inch's is the proprietor of the following trade mark registration in the UK.

<u>Class</u>	<u>Mark</u>	<u>Regn. No.</u>	<u>Filing Date</u>
33	WHITE LIGHTNING	UK 2024617	21/06/95

and that Inch's is the proprietor of the following trade mark registration granted by the Office for Harmonisation in the Internal Market:

<u>Class</u>	<u>Mark</u>	<u>Regn. No.</u>	<u>Filing Date</u>
33	LIGHTNING	253492	08/05/96

Applicant's Evidence

17. This consists of a statutory declaration by Frederick Albert James Egbeare dated 11 June 2001. Mr Egbeare is the Managing Director of Churchwards (Orchard Products) Limited (the applicants).

18. Mr Egbeare draws attention to Exhibit FE1 to his declaration which comprises extracts from the Collins, and Oxford English dictionaries and Brewer's Dictionary of Phrase and Fable which, he says, demonstrate references to "Jack" being a drinking vessel as well as a quarter of a pint or the equivalent of the imperial gill and to "Applejack" being distilled cider.

19. Mr Egbeare states that none of the opponent's evidence demonstrates any use of the words: WHITE; JACK; or LIGHTNING in isolation. In the applicant's view, the opponent is seeking to secure an anti-competitive monopoly on words or combinations of words in common usage, such as WHITE, JACK and LIGHTNING.

Opponent's Evidence in Reply

20. This consists of a second statutory declaration by William George Stebbings which is dated 16 July 2001.

21. Mr Stebbing's states that the Collins English Dictionary reference and Brewers Dictionary reference referred to in the applicant's evidence, make it clear that the word JACK is archaic in relation to drinking vessels. He adds that the Oxford English Dictionary reference also makes it clear that the word JACK is archaic in relation to measurements. In relation to the word "applejack", Mr Stebbings draws attention to Exhibit WGS7A to his declaration, comprising three dictionary definitions taken from the Oxford Concise Dictionary, the shorter Oxford English Dictionary and Chambers 20th Century Dictionary which, he states, show that it is a spirit distilled from cider and is a North American term.

22. This completes my summary of the evidence filed in this case. I now turn to the decision.

DECISION

23. Firstly, I consider the ground of opposition based upon Section 5(2)(b) of the Act which reads as follows:-

"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."

24. An earlier right is defined in Section 6, the relevant parts of which state:-

6.-(1)

- (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,"

25. 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.

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.

26. At the hearing Dr James confirmed that in relation to the Section 5(2)(b) ground the opponent was relying upon Community Trade Mark Registration Nos 253492 and 433789 and that as these marks had not yet been in use, the comparison of the applicant's and opponent's marks should be made on the basis of fair and notional use.

27. Turning first to a consideration of the respective goods covered by the specification of the application in suit and the opponent's registration, it is common ground that the respective specifications of goods include the same goods ie cider.

28. In essence the test under Section 5(2)(b) is whether there are similarities in marks and goods which would combine to create a likelihood of confusion and in my considerations I am guided by the recent judgements of the European Court of Justice mentioned earlier in this decision. The likelihood of confusion must be appreciated globally and I need to address the degree of visual, aural and conceptual similarity between the marks, taking into account the category of goods in question and how they are marketed.

29. In their pleadings, the applicants have drawn attention to the state of the register in relation to marks containing the words LIGHTNING or JACK and have also drawn attention to a number of alcoholic beverages being sold under marks containing one or other of these words. However, these assertions are not supported by evidence. Even if there was evidence, I find such evidence to be of little assistance as mere evidence of entries on the register or evidence which does not demonstrate the nature, length or extent of the actual use of the marks

concerned is of little value and is far from conclusive. My decision involves a comparison of the applicant's and opponent's particular marks and must be made on its own merits, taking into account fair and notional use of the respective marks.

30. The opponents prior registration Nos 253492 and 433789, consist of the words LIGHTNING and JACK respectively. The word LIGHTNING is an obvious dictionary word which in my view has no reference whatsoever to the goods at issue. In their pleadings and submissions the applicant's have drawn attention to the use of a mark "Summer Lightning" on beer by a third party. However, as explained earlier in this decision, I do not consider this to be of assistance in the current case and I also note that the parties to this opposition are both cider producers. In my opinion the word LIGHTNING is highly distinctive in relation to cider. The second registration relied upon by the opponents is for the word JACK which again, is an obvious dictionary word. One of the less obvious dictionary meanings of this word is that of a "drinking vessel" which the applicant's contend means that the word cannot be the subject of a trade mark monopoly. However, in my view this meaning is archaic and would not be taken by the average customer for cider as having a reference to the goods at issue. I would also mention that the applicant cannot show that JACK is a term used in the UK to denote an alcoholic beverage. Furthermore, as mentioned earlier, I do not consider the applicant's pleadings and submissions in relation to trade marks containing the word JACK and owned by third parties to be of any great assistance and I must consider the current case on its own merits.

31. The mark in suit, CHURCHWARDS LIGHTNING JACK, consists of three words. The first word is the name of the manufacturer or house mark and the second and third words are both dictionary words which I have earlier found to have no reference to the goods at issue. While the applicant submits that the words "Lightning Jack" refer to a fictional cowboy character taken from a film of the same name and produced/shown in the early/mid 1990's, it seems to me that the average customer for the goods in question is unlikely to be aware of this connection or signification and the words LIGHTNING JACK will convey no conceptual meaning to the average customer.

32. It is, of course, possible to over analyse marks and in doing so shift away from the real test which is how marks would be perceived by customers in the normal course and circumstances of trade and I must bear this in mind in my considerations.

33. The judgements of the European Court of Justice mentioned earlier in this decision make it clear that in my comparisons I must take into account the average customer for the goods, and the category of goods in question and how they are marketed. While I have no evidence before me on the point, my own knowledge tells me that the customers for cider are members of the general public being over eighteen years of age and that cider is sold "side by side" in retail outlets (including supermarkets) where it can be self-selected, and in pubs and clubs. Purchases are often made on an occasional basis and for the benefit of others eg for parties or barbecue's, and cider is not a particularly expensive or exclusive product. On a relative basis, it seems to me that cider will often be purchased without a great deal of care and consideration.

34. In my comparison of the respective marks I intend to concentrate upon a comparison of registration No 253492 (LIGHTNING) with the application in suit. While the opponent also relies upon registration No 433789 (JACK), I do not believe that a comparison of this latter mark with the application in suit will put the opponent in any stronger position as the registerability of the applicants mark must be considered against the cited marks separately.

35. On a visual, aural and conceptual comparison there are obvious differences in that the application in suit consists of three words and the opponents registration one word. This word, the word common to both marks (LIGHTNING) being the middle word within the mark applied for and coming before the word JACK. The first word in the applicants mark, CHURCHWARDS, would in my view be regarded by the average customer as a housemark and the average customer would consider the words LIGHTNING JACK as the trade mark for the product. However, even after this is taken into account there remains an obvious difference in that the mark applied for contains an additional word (JACK).

36. Notwithstanding that there are obvious differences in the marks, particularly on a side-by-side comparison, I must take into account my earlier finding that the common element, the word LIGHTNING, comprises a highly distinctive trade mark of the opponents. I must add to this my findings that the average customer for the goods ie cider, will very often be an occasional and relatively non-discriminating purchaser who may rely upon the imperfect picture of the marks he (she has kept in his/her mind). Taking into account the average customer for the goods and given the nature of the trade of the goods in issue (the goods being identical) and the highly distinctive nature of the trade mark LIGHTNING in relation to cider, it seems to me that the word comprising the opponent's mark (LIGHTNING) is likely to be retained in the mind by customers, notwithstanding the additional elements within the applicants mark. Accordingly, it is my view that the applicant's mark would capture the distinctiveness of the opponent's LIGHTNING mark in normal and fair use in the market place.

37. In reaching a decision in relation to the likelihood of confusion I have particularly borne in mind the following comments of the European Court of Justice in *Canon*:

“Accordingly, the risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 4(1)(b) of the Directive (see SABEL, paragraphs 16 to 18).”

38. The respective goods are identical and the respective marks are similar conceptually, visually and aurally in that the common element (LIGHTNING) would suffice to lead the public to believe that the goods emanated from the same undertaking. In my view, LIGHTNING and LIGHTNING JACK ciders would be assumed to come "from the same stable" and CHURCHWARDS would be taken as the name of that "stable".

39. The opposition under Section 5(2)(b) of the Act is successful.

40. As I have found for the opponent under Section 5(2) of the Act, I have no need to consider the grounds of opposition raised under Section 5(4)(a).

41. The opponents are entitled to a contribution towards their costs and I therefore order the applicants to pay them the sum of **£1500**. 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 my appeal against this decision is unsuccessful.

Dated this 5TH day of February 2002

**J MacGILLIVRAY
For the Registrar
the Comptroller-General**