TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3019656
BY RIDGEVIEW ESTATE WINERY LIMITED
TO REGISTER THE TRADE MARK
RIDGEVIEW GROSVENOR
IN CLASS 33
AND**

**IN THE MATTER OF OPPOSITION
THERETO UNDER No. 401282 BY
BOOKER LIMITED**

BACKGROUND

1) On 27 August 2013, Ridgeview Estate Winery Limited (hereinafter the applicant) applied to register the trade mark RIDGEVIEW GROSVENOR in respect of the following goods in Class 33: Sparkling Wine.

2) The application was examined and accepted, and subsequently published for opposition purposes on 4 October 2013 in Trade Marks Journal No.2013/040.

3) On 2 December 2013 Booker Limited (hereinafter the opponent) filed a notice of opposition. The grounds of opposition are in summary:

a) The opponent is the proprietor of the following trade mark:

Mark	Number	Date of application / registration	Class	Specification
GROSVENOR	1426987	29.05.90 15.11.91	33	Wines, spirits; gin; all included in Class 33.

b) The opponent contends that the mark in suit is confusingly similar to its registered trade mark. It states that the goods applied for in the mark in suit are similar or identical to those for which its mark is registered. The opponent contends that it has used its mark on gin since 1990 and has achieved significant reputation and goodwill in its mark. The mark in suit therefore offends against sections 5(2)(b), 5(3) and 5(4)(a) of the Act.

4) On 4 February 2014, the applicant filed a counterstatement denying all the grounds. The applicant put the opponent to strict proof of use of its registered mark.

5) Both sides filed evidence. Both parties seek an award of costs in their favour. Neither side wished to be heard although both sides provided written submissions which I shall take into account as and when they are relevant.

OPPONENT’S EVIDENCE

6) The opponent filed a witness statement, dated 9 April 2014, by Mark Chilton the Company Secretary and General Counsel of Booker Group Limited which is the parent company of the opponent. He states that the opponent was incorporated in 1924 and is a wholesaler of foods and drinks which supplies approximately 305,000 catering businesses (pubs, clubs, hotels and restaurants) and 73,000 independent retailers in the UK. The opponent has 172 branches throughout the UK and it also has a national delivery service. In the year ending March 2013 UK sales amounted to approximately £4billion. He states that the opponent sells a number of gin products under the GROSVENOR mark. He provides the following sales figures for Grosvenor London Dry Gin in the UK (this takes in all sizes of bottles).

2008	2009	2010	2011	2012	2013	2014
£2,768,804	£2,627,907	£2,705,415	£2,582,399	£2,585,687	£2,435,283	£2,317,229

7) Mr Chilton points out that these figures are wholesale prices and that the retail prices will be considerably higher. He states that sales under the mark began in 1990 and as a result the opponent has achieved a considerable reputation in the mark and also goodwill. He also points out that the opponent also sells various wines under a number of house marks but not under Grosvenor. In the years 2012 -2014 inclusive the opponent sold wine to the value of approximately £34million per annum. In addition they also sold various other spirits and fortified wines. He states that the opponent's customers look to the opponent to supply all their food and drink requirements. Mr Chilton contends that the applicant uses the word Ridgeview as a "House" label and the word "Grosvenor" as a secondary label applied to a single type of wine product. He believes that this could lead the public to consider the term "Ridgeview" as one of the opponent's in house marks and "Grosvenor" one of its products. He also provides the following exhibits:

- MC1: This is a photograph of a bottle of gin. The label is relatively plain and has the word GROSVENOR in large print in green on a white background. Just below this and printed in a much smaller font are the words "London Dry" with underneath this again in white letters on black but in a larger font the word "GIN". The rest of the label has what could be a large letter "G" but with the top half of the letter missing and a few inconsequential spirals.

- MC2: This shows a list of the various sizes of bottles of gin available. These range from the largest 1.5 litre which has the label upside down so that it can be read when placed in an optic behind a bar, to the smallest which is just 20cl. All of the bottles have the same label as described in MC1. All are described in the listing as Grosvenor London Dry Gin. It is dated March 2014.

- MC3: This consists of the sales figures per size of bottle. I have placed the grand total of these sales in the witness summary above.

- MC4: A copy of a guide to wines and spirits published by the opponent in 1998 as a guide to its wares for its customers. There is an entry for Grosvenor London Dry Gin which shows a slightly different label but still featuring the word GROSVENOR predominantly, with the only other wording, in a much smaller font being "Traditional London Dry Gin".

- MC5: A copy of an award certificate, dated 2013, from the International Spirits Challenge which states that "Grosvenor" has been awarded a bronze medal by the judging panel.

- MC6: Copies of price guides issued between 2004 and 2011 by the opponent in relation to its wines and spirits amongst other wares. These all show Grosvenor gin bottles with the same label as described in MC1 being offered for sale. There is also a photograph of an in-store promotion which has pictures of wine and spirit bottles including Grosvenor Gin; it is undated.

- MC7: This consists of pages from the applicant's website which shows bottles of wine with the word RIDGEVIEW in large print with underneath and in a slightly smaller font the word GROSVENOR. The website lists its wines under their secondary titles, presumably as one is already on the Ridgeview website. These names include others which are areas of London such as Knightsbridge, Cavendish, Fitzrovia and Bloomsbury as well as South Ridge, Marksman and Magnum.

APPLICANT'S EVIDENCE

8) The applicant filed a witness statement, dated 1 July 2014, by Tamara Roberts the General Manager and Director of the applicant company, a position she has held for ten years. She states that the applicant company was formed in 1994 and makes sparkling wines. The applicant began using the Ridgeview brand in 1998 and produced a sparkling wine under the Ridgeview Grosvenor mark in 2005. She states that the applicant chose a number of London locations for its names such as Cavendish, Fitzrovia, Knightsbridge, Bloomsbury and Victoria. She continues:

> "Each name is used as a sub-brand to my company's house brand RIDGEVIEW and each combined trade mark is used in relation to a particular style of English sparkling wine. The name RIDGEVIEW GROSVENOR is used for our "Blanc de blancs" sparkling wine whereas, for example, our RIDGEVIEW KNIGHTSBRIDGE sparkling wine is our "Blanc de Noirs" sparkling wine."

9) Ms Roberts states that the RIDGEVIEW GROSVENOR wine has won many awards from 2005 – 2013 and she lists eleven such awards. Because of this and the other publicity the wine has received she states that the wine has a high profile in the UK. She provides a list of outlets for the wine in the UK which includes, inter alia, Waitrose, Virgin Wines, Selfridges and Fortnum and Mason. She provides the following turnover figures for Ridgeview Grosvenor in the UK.

2007	2008	2009	2010	2011	2012	2013
£46,800	£46,800	£47,466	£68,040	£87,870	£107,100	£110,208

10) Ms Roberts states that approximately £30,000 has been spent each year since 2005 promoting the Ridgeview range of wines. She states that she is unaware of any confusion in the market place and points out that the opponent stocks Ridgeview Knightsbridge, although I am not sure how that is relevant. She states that the marks have co-existed for many years without confusion or detriment. She also provides the following exhibits:

- TR1: A screenshot from the applicant's website showing the wine bottle label. The word RIDGEVIEW is above the word GROSVENOR and is in a much larger font.

- TR2: Details of the forty four various awards the wine under the mark in suit has won from 2005-2013.

- TR3: A selection of newspaper and magazine articles which mention wine under the mark in suit. These include two articles showing that the wine was served at a lunch attended by the Queen in honour of her birthday in 2006, and at a state banquet in April 2014. This includes, inter alia, articles from the *Telegraph, York Press, The Times, Harpers, Daily Mail, Financial Times* and *Observer*; and are dated from 2005 – 2013. These include mentions of Ridgeview Merret Grosvenor, others only mention the vineyard Ridgeview. In the *Waitrose Wine Direct* list for 2008 the image on the bottle appears to have the word "Ridgeview" on the neck label but the main label seems to only have the word "Grosvenor". The article in *Harpers* refers to the wine as Merret Grosvenor. The *Daily Mail* article dated 8 December 2009 shows the bottle with only the word "GROSVENOR" visible on the main label.

- TR4: Consists of print outs from websites of retailers of the wine such as Waitrose, Virgin Wines, Selfridges and Fortnum and Mason. These list the wine in varying ways; "Ridgeview Merret Grosvenor"; "Ridgeview Estate Grosvenor"; "Grosvenor Curvee Merret Ridgeview"; "Grosvenor Ridgeview Estate" and "Ridgeway Grosvenor".

- TR5: This consists of price lists and order forms from 2005-2014 and a selection of invoices for the years 2005-2014. The invoices from 2005-2007 all refer to the product as MERRET GROSVENOR; those during 2009 -2013 seem to have a number of ways of referring to the product from "MERRET GROSVENOR"; "RIDGEVIEW GROSVENOR"; "GROSVENOR Blanc de Blanc RIDGEVIEW ESTATE" to "GROSVENOR CURVEE MERRET (Blanc de Blanc) RIDGEVIEW".

- TR6: A selection of newsletters sent out to customers from 2004 to 2009. These all have images of bottles of wine. These show use of the term "Merret Grosvenor" only on the main label upon the bottles.

OPPONENT'S EVIDENCE IN REPLY

11) The opponent filed a second witness statement by Mr Chilton dated 20 August 2014. He questions how Ms Roberts would be aware if any confusion had taken place. He also states that the opposition was not launched without warning. He files as an exhibit a letter dated 31 October 2013 from the opponent's Trade Mark Attorney to the applicant's legal representatives setting out in detail the registration and trade in the opponent's marks and the opponent's concerns. It also sets out in detail the grounds of opposition. Mr Chilton states that no reply was received.

12) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

13) I first turn to the ground of opposition based on section 5(2)(b) which reads:

> 5.-(2) A trade mark shall not be registered if because -
>
> (a) .....
>
> (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, the relevant part of which states:

> "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."

15) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier trade mark. The mark relied upon has been put to strict proof of use by the applicant. Section six of the Act states:

> "6A Raising of relative grounds in opposition proceedings in cases of non-use.
>
> (1) This section applies where-
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> (a) an application for registration of a trade mark has been published,
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> (b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
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> (c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

16) I must first consider whether the opponent has fulfilled the requirement to show that genuine use of the mark has been made. In the instant case the publication date of the application was 4 October 2013, therefore the relevant period for the proof of use is 5 October 2008 – 4 October 2013. In *Stichting BDO v BDO Unibank, Inc.,* [2013] F.S.R. 35 (HC), Arnold J. stated as follows:

"51. Genuine use. In *Pasticceria e Confetteria Sant Ambreoeus Srl v G & D Restaurant Associates Ltd* (SANT AMBROEUS Trade Mark) [2010] R.P.C. 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in *Ansul BV v Ajax Brandbeveiliging BV* (C-40/01) [2003] E.C.R. I-2439; [2003] R.P.C. 40 ; *La Mer Technology Inc v Laboratoires Goemar SA* (C-259/02) [2004] E.C.R. I-1159; [2004] F.S.R. 38 and *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759; [2009] E.T.M.R. 28 (to which I have added references to *Sunrider v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM) (C-416/04 P) [2006] E.C.R. I-4237):

(1) Genuine use means actual use of the mark by the proprietor or third party with authority to use the mark: *Ansul*, [35] and [37].

(2) The use must be more than merely token, which means in this context that it must not serve solely to preserve the rights conferred by the registration: *Ansul*, [36].

(3)The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end-user by enabling him, without any possibility of confusion, to distinguish the goods or services from others which have another origin: *Ansul*, [36]; *Sunrider* [70]; *Silberquelle*, [17].

(4) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, i.e. exploitation that is aimed at maintaining or creating an outlet for the goods or services or a share in that market: *Ansul*, [37]-[38]; *Silberquelle*, [18].

(a) Example that meets this criterion: preparations to put goods or services on the market, such as advertising campaigns: *Ansul*, [37].

(b) Examples that do not meet this criterion: (i) internal use by the proprietor: *Ansul*, [37]; (ii) the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*, [20]-[21].

(5) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including in particular, the nature of the goods or services at issue, the characteristics of the market concerned, the scale and frequency of use of the mark, whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them, and the evidence that the proprietor is able to provide: *Ansul*, [38] and [39]; *La Mer*, [22] -[23]; *Sunrider*, [70]–[71].

(6) Use of the mark need not always be quantitatively significant for it to be deemed genuine. There is no de minimis rule. Even minimal use may qualify as

> genuine use if it is the sort of use that is appropriate in the economic sector concerned for preserving or creating market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor: *Ansul*, [39]; *La Mer*, [21], [24] and [25]; *Sunrider*, [72]".

17) Although minimal use may qualify as genuine use, the CJEU stated in Case C-141/13 P, *Reber Holding GmbH & Co. KG v OHIM* (in paragraph 32 of its judgment), that "*not every proven commercial use may automatically be deemed to constitute genuine use of the trade mark in question".* The factors identified in point (5) above must therefore be applied in order to assess whether minimal use of the mark qualifies as genuine use.

18) The opponent's mark is registered for: Wines, spirits; gin; all included in Class 33. In the evidence summarised at paragraphs 6 & 7 above it is clear that the opponent has used its mark extensively during the relevant period of 5 October 2008 – 4 October 2013. During this time they have averaged sales of approximately £2.4 million per annum in the UK all relating to gin.

19) In considering the issue of a fair specification I take into account the comments of Mr Justice Arnold (as he now is) in his judgments as The Appointed Person in *Nirvana Trade Mark BL* O-262-06 and *Extreme Trade Mark BL* O-161-07 where he comprehensively examined the case law in this area. His conclusion in *Nirvana* was that:

> "(1) The tribunal's first task is to find as a fact what goods or services there has been genuine use of the trade mark in relation to during the relevant period: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [30].
>
> (2) Next the tribunal must arrive at a fair specification having regard to the use made: *Decon v Fred Baker* at [23]; *Thomson v Norwegian* at [31].
>
> (3) In arriving at a fair specification, the tribunal is not constrained by the existing wording of the specification of goods or services, and in particular is not constrained to adopt a blue-pencil approach to that wording: *MINERVA* at 738; *Decon v Fred Baker* at [21]; *Thomson v Norwegian* at [29].
>
> (4) In arriving at a fair specification, the tribunal should strike a balance between the respective interests of the proprietor, other traders and the public having regard to the protection afforded by a registered trade mark: *Decon v Fred Baker* at [24]; *Thomson v Norwegian* at [29]; *ANIMAL* at [20].
>
> (5) In order to decide what is a fair specification, the tribunal should

inform itself about the relevant trade and then decide how the average consumer would fairly describe the goods or services in relation to which the trade mark has been used: *Thomson v Norwegian* at [31]; *West v Fuller* at [53].

(6) In deciding what is a fair description, the average consumer must be taken to know the purpose of the description: *ANIMAL* at [20].

(7) What is a fair description will depend on the nature of the goods, the circumstances of the trade and the breadth of use proved: *West v Fuller* at [58]; *ANIMAL* at [20].

20) I also take into account the comments in *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited,* BL O/345/10, where Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

> "In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

21) I consider that a fair specification for the purposes of a comparison of the goods of the two parties is "Gin".

22) When considering the issue under section 5(2)(b) I take into account the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*. Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, 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, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) 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;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing decision

23) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

24) I take into account the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* where it said:

> “In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

25) The applicant’s specification is for “Sparkling Wine”, whilst the opponent’s specification is “gin”. Clearly both specifications are for alcohol which can only be purchased by those over eighteen. Both specifications can vary somewhat in their prices but neither would be considered to be complex or expensive. Bottles of alcohol tend, for the most part, to be purchased in shops and pubs. In shops they will be self selected and the visual aspect will be the most important element. In pubs drinks are mostly displayed via labels on pumps /optics at the bar or in cabinets where the labels can be viewed. When ordering in a pub aural considerations must be considered, but the initial choice will still be made visually. Retailers, hoteliers and others in business will also be customers but I believe that they will make their choices in a similar way, be it from the internet, a brochure or the shelves in a cash and carry. They may also order via the telephone or in person. Effectively they have the same issues as the general public and I regard them to be the same. Whilst I accept that the average consumer is reasonably circumspect and observant I believe that the goods of both parties will be purchased or selected with only a modicum of care.

Comparison of goods

26) The competing goods are “Sparkling Wine” and “Gin”. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

> “In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

27) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

a) The respective users of the respective goods or services;

b) The physical nature of the goods or acts of services

c) The respective trade channels through which the goods or services reach the market

d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

28) I accept that there are differences in the basic ingredients and manufacturing processes of the respective goods, and the fact that they are not in direct competition. However, although there is no evidence regarding trade channels I am aware from my own experience that wines and spirits are sold through the same retail outlets, including public houses. Although they would not tend to be on same shelf they would be in close proximity as wines and spirits have to be grouped into an area that can be access restricted if required by the licensing laws. Clearly, whilst both are beverages they are not purchased in order to quench one's thirst; they differ considerably in their alcoholic strengths; they are not complementary or in competition with each other. Both do share a common characteristic in that they provide a relaxing and/or enjoyable drinking experience, at home or at a social gathering. The contention that wine makers do not normally produce spirits and spirit makers do not produce wine is one which I accept, although supermarkets may have their own brand out on a range of goods. **Considering the matter in the round it is my opinion that there is a low degree of similarity between the goods of both parties.**

Comparison of trade marks

28) The trade marks to be compared are:

Opponent's trade mark	**Applicant's trade mark**
GROSVENOR	RIDGEVIEW GROSVENOR

29) In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

> “38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
>
> 39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.’
>
> 40. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out”.

30) However the independent and distinctive element does not need to be identical. In *Bimbo SA v OHIM,* Case T-569/10, the General Court held that:

> “96.According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé* v *OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).”

31) In *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), Arnold J. stated that:

> “47. In my view the principle which I have attempted to articulate in [45] above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *Bulova Accutron* the earlier trade mark was ACCURIST and the composite sign was BULOVA ACCUTRON. Stamp J. held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive ACCUTRON to have significance independently of the whole and would confuse it with ACCURIST.
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> 48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer

would perceive UVEDA to have significance independently of DABUR UVEDA as a whole and whether that would lead to a likelihood of confusion."

32) Further in *Annco, Inc. V OHIM,* Case T-385/09, the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

"48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue."

33) The opponent's mark consists of a single word. The applicant's mark consists of two words neither of which is more distinctive or dominant than the other. The two words do not "hang together" to form a conceptual image such as "Cardinal Place". I accept that "Grosvenor" is an area of London but as far as I am aware it has no meaning as far as wines are concerned. Both parts of the applicant's mark, to my mind, are independent elements and will be seen as such by the average consumer. Clearly, the whole of the opponent's mark is within the applicant's mark, although it is prefixed by a separate distinctive word "Ridgeview". Whilst there are obvious differences, there is a medium to high degree of similarity both visually and aurally. Conceptually the average consumer may be aware of Grosvenor as an area of London, in which case there is a degree of similarity here as well.

Distinctive character of the earlier trade mark

34) In *Lloyd Schuhfabrik Meyer & Co. GmbH* v *Klijsen Handel BV,* Case C-342/97 the CJEU stated that:

> "22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).
>
> 23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

35) Consisting as it does of the name of an area of London which has no connection to gin or alcohol in general, the opponent's earlier trade mark is possessed of at least a moderate degree of inherent distinctive character. The opponent has filed evidence of the use it has made of its earlier trade mark in the UK. The mark in suit has been used since 1990 and sales have been significant. Whilst the opponent did not provide evidence of market share or the size of the total market for gin I regard the use made of its mark by the opponent to be sufficient to enable it to benefit from enhanced distinctiveness through use in respect of its mark.

Likelihood of confusion

36) The applicant contended that it has used the mark in suit for a number of years without any confusion. I note that the use demonstrated by the applicant has been of a variety of marks albeit with the words "RIDGEVIEW" and "GROSVENOR" within them. Thus the absence of confusion contention is severely weakened. In addition I take into account the comments in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 where Laddie J held:

> "22. It is frequently said by trade mark lawyers that when the proprietor's mark and the defendant's sign have been used in the market place but no confusion has been caused, then there cannot exist a likelihood of confusion under Article 9.1(b) or the equivalent provision in the Trade Marks Act 1994 ("the 1994 Act"), that is to

say s. 10(2). So, no confusion in the market place means no infringement of the registered trade mark. This is, however, no more than a rule of thumb. It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

37) Also in *Rousselon Freres et Cie v Horwood Homewares Limited* [2008] EWHC 881 (Ch) Warren J commented:

> "99. There is a dispute between Mr Arnold and Mr Vanhegan whether the question of a likelihood of confusion is an abstract question rather than whether anyone has been confused in practice. Mr Vanhegan relies on what was said by Laddie J in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at paragraphs 22 to 26, especially paragraph 23. Mr Arnold says that that cannot any longer be regarded as a correct statement of the law in the light of *O2 Holdings Ltd v Hutchison 3G Ltd* [2007] RPC 16. For my part, I do not see any reason to doubt what Laddie J says...")

38) Further in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283 Millett L.J. stated that:

> "Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to differences extraneous to the plaintiff's registered trade mark."

39) In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the opponent has made genuine use of its Grosvenor trade mark in relation to "gin";

- the average consumer is a member of the general public, over eighteen years of age, who will select the goods by predominantly visual means and who will pay a moderate level of attention when doing so;

- the competing goods are similar to a low degree;

- the competing trade marks are visually and aurally similar to a medium to high degree. They are conceptually similar in so far as the GROSVENOR element is concerned;

- the opponent's earlier trade mark is possessed of a moderate degree of inherent distinctive character, and benefits from an enhanced distinctiveness by the use made of it in the United Kingdom.

40) In view of the above and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the goods provided by the applicant are those of the opponent or provided by some undertaking linked to them. **The opposition under Section 5(2) (b) therefore succeeds in total.**

41) I now turn to the ground of opposition under Section 5(3) which reads:

> "(3) A trade mark which-
> (a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark."

42) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* [1999] ETMR 950, Case 252/07, *Intel,* [2009] ETMR 13, Case C-408/01, *Addidas-Salomon,* [2004] ETMR 10 and Case C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora.* The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious likelihood that this will happen in future; *Intel, paragraphs 76 and 77.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

43) The onus is upon the opponent to prove that its earlier trade mark enjoys a reputation or public recognition and it needs to furnish the evidence to support this

claim. To my mind the opponent has provided the evidence, see paragraphs 6 & 7 above, that its mark does enjoy such a reputation and so it clears the first hurdle.

44) Once the matter of reputation is settled an opponent must then show that the relevant customers would make a link between the two trade marks and how its trade mark would be affected by the registration of the later trade mark. In Case C-408/01, *Addidas-Salomon,* the CJEU held that:

> "28. The condition of similarity between the mark and the sign, referred to in Article 5(2) of the Directive, requires the existence, in particular, of elements of visual, aural or conceptual similarity (see, in respect of Article 5(1)(b) of the Directive, Case C-251/95 *SABEL* [1997] ECR I-6191, paragraph 23 in fine, and Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraphs 25 and 27 in fine).
>
> 29. The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23)."

45) There is some debate as to whether the judgment of the CJEU in *L'Oreal v Bellure* means that an advantage gained by the user of a junior mark is only unfair if there is an intention to take advantage of the senior mark, or some other factor is present which makes the advantage unfair. The English Court of Appeal has considered this matter three times. Firstly, in *L'Oreal v Bellure* [2010] RPC 23 when that case returned to the national court for determination. Secondly, in *Whirlpool v Kenwood* [2010] RPC 2: see paragraph 136. Thirdly, in *Specsavers v Asda Stores Limited* [1] [2012] EWCA Civ 24: see paragraph 127. On each occasion the court appears to have interpreted *L'Oreal v Bellure* as meaning that unfair advantage requires something more than an advantage gained without due cause. However, the absence of due cause appears to be closely linked to the existence of unfair advantage. See paragraph 36 of the opinion of Advocate General Kokott in Case C-65/12 *Leidseplein Beheer and Vries v Red Bull.*

46) In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation

> and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

47) In *Aktieselskabet af 21. November 2001 v OHIM,* Case C-197/07P, the CJEU stated that:

> "22. With regard to the appellant's argument concerning the standard of proof required of the existence of unfair advantage taken of the repute of the earlier mark, it must be noted that it is not necessary to demonstrate actual and present injury to an earlier mark; it is sufficient that evidence be produced enabling it to be concluded prima facie that there is a risk, which is not hypothetical, of unfair advantage or detriment in the future (see, by analogy, concerning the provisions of Article 4(4)(a) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), Case C-252/07 Intel Corporation [2008] ECR I-0000, paragraph 38).
>
> 23. In the present case, it is clear that the Court of First Instance, in paragraph 67 of the judgment under appeal, properly established the existence of an unfair advantage within the meaning of Article 8(5) of Regulation No 40/94 in correctly considering that it had available to it evidence enabling it to conclude prima facie that there was a risk, which was not hypothetical, of unfair advantage in the future."

48) Earlier in this case I found that there was a low degree of similarity between the goods of the two parties. I also found that the opponent's mark has a moderate degree of inherent distinctiveness for "Gin" and has an enhanced reputation through its use. I also found that the competing trade marks are visually and aurally similar to a medium to high degree. They are conceptually similar in so far as the GROSVENOR element is concerned. Thus the link will be established. Adopting the composite approach advocated, the conclusions that I have set out above naturally lead me to the view that there is an advantage for the applicant to derive. As far as detriment is concerned, the opponent suggested that this would subsist in a reduction in the distinctiveness of their mark. I consider that registration of the mark in suit could have such an impact, either to the distinctiveness of the earlier mark or the reputation it enjoys. **The opposition under Section 5(3) therefore succeeds.**

49) I must take into account the contention that the applicant had due cause to adopt its mark and indeed has been using the mark since 2005. In *Leidseplein Beheer BV v Red Bull,* Case C-65/12, the CJEU held that:

> "43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation

must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of ‘due cause’ is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a reputation cannot lead to the recognition, for the benefit of that third party, of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

47. The Court thus held in paragraph 91 of the judgment in *Interflora and Interflora British Unit* (a case concerning the use of keywords for internet referencing) that where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without being detrimental to the repute or the distinctive character of that mark and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such a use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without ‘due cause’.

48. Consequently, the concept of ‘due cause’ cannot be interpreted as being restricted to objectively overriding reasons.

“60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of ‘due cause’ within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:

- how that sign has been accepted by, and what its reputation is with, the relevant public;

- the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and

- the economic and commercial significance of the use for that product of the sign which is similar to that mark.

50) The applicant contends that it adopted its mark as part of a series of marks all of which are areas of London. I accept that it has used marks which are the names of areas of London such as Knightsbridge, Bloomsbury etc. However, before adopting a trade mark and using it, it is incumbent upon the adopter to carry out due diligence to ensure that the mark is not already in use. Given that the opponent’s mark has been registered since 1991 for “wines, spirits; gin” it would have been easy to locate. The applicant could then have explored what if any use had been made. The applicant also contends that it has made us eof its mark since 2005. The evidence provided shows that the applicant has used a number of marks which contain the mark in suit, but in combination with a variety of other words (see exhibit TR4-6). I do not accept that the applicant can rely upon due cause or its actual use as a defence against the section 5(3) ground of opposition.

51) Given the findings above I do not need to consider the ground under Section 5(4)(a).

CONCLUSION

52) The opponent has been successful in its opposition under Section 5(2)(b) and 5(3).

COSTS

53) As the opponent has been successful it is entitled to a contribution towards its costs.

Expenses	£200
Preparing a statement and considering the other side’s statement	£200
Preparing evidence and considering the evidence of the other side	£500
TOTAL	£900

54) I order Ridgeview Estate Winery Ltd to pay Booker Ltd the sum of £900. This sum 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 21st day of November 2014

George W Salthouse
For the Registrar,
the Comptroller-General