

Trade Marks Act, 1963

Decision in hearing in the Patents Office

IN THE MATTER OF an application for registration of Trade Mark No. 158535 and in the matter of an Opposition thereto.

**DAIRYGOLD CO-OPERATIVE
SOCIETY LIMITED**

Applicants

AUSTIN NICHOLS & CO. INC.

Opponents

1. Dairygold Co-operative Society Limited, a co-operative society registered under the Industrial and Provident Societies Acts, 1893 to 1978, of Plunkett House, 84 Merrion Square, Dublin made application on 27 August, 1993 to register the words “ORAN-GO” and “ORANGO” as a series of two trade marks in Part A of the Register in Class 32 in respect of a specification of goods that read:

“Non-alcoholic drinks; preparations and syrups for making such drinks; fruit drinks and fruit juices; drinks containing milk and fruit extract.”

The application was accepted for registration in part A of the Register and was advertised under No. 158535 in Journal No. 1755 of 8 March, 1995.

2. Notice of Opposition pursuant to Section 26 of the Trade Marks Act, 1963 was filed on 8 June, 1995 by Austin Nichols & Co. Inc., an American Corporation of 1290 Avenue of the Americas, New York, New York 10104, United States of America. The Applicants filed a Counter-Statement on 5 February, 1996 and

evidence was in due course filed under Rules 37, 38 and 39 of the Trade Mark Rules, 1963.

3. The Opposition became the subject of a hearing before me, acting for the Controller, on 12 September, 2000. The parties were notified on that the Opposition was dismissed. I now state the grounds of my decision and the materials used in arriving thereat.

4. In their Notice of Opposition, the Opponents stated as follows:
 - (i) The Opponents have for many years carried on business at the above address as manufactures an merchants of inter alia beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; carbonic fruit flavoured drinks; syrups and preparations for making beverages (hereinafter referred to as “said goods”).
 - (ii) The Opponents are the proprietors of the trade marks shown in the schedule hereunder (hereinafter referred to as “said Trade Marks”) and have for many years extensively used said Trade Marks in connection with said goods and said Trade Marks denote and have long denoted both to the trade and to the public goods manufactured and sold by the Opponents and distinguish and have long distinguished said Goods from the like goods of other manufacturers and merchants.

Schedule hereinbefore referred to:

| Mark | Reg. No. | Reg. Date | Class | Journal No. |
|-------------|-----------------|------------------|--------------|--------------------|
| ORANGINA | 63174 | 13/1/61 | 32 | 905 |

Goods: Carbonic orange flavoured drinks and juices.

| | | | | |
|----------|--------|--------|----|------|
| ORANGINA | 122956 | 2/2/87 | 32 | 1564 |
|----------|--------|--------|----|------|

Goods: Beers, minerals, aerated waters & non alcoholic drinks; fruit drinks & fruit juices; syrups and preparations included in class 32 for making beverages.

- (iii) The Applicants have made said application to have said opposed mark registered in respect of goods being non-alcoholic drinks; preparations and syrups for making such drinks, fruit drinks and fruit juices; milk and fruit extract. These goods are the same goods and/or goods of the same description as said goods.
- (iv) Said opposed mark so nearly resembles said Trade Marks both orally and visually as to be calculated to deceive and to lead to the Applicants' goods being sold, purchased and passed-off as and for said goods and to lead to the inference that goods made by the Applicants and said goods emanate from the same source. Therefore, registration of said opposed mark, having regard to the use and reputation of said opponents Trade Marks, would contravene Sections 19 and 20 of the Trade marks Act, 1963.
- (v) Said opposed mark is not adapted, in relation to the goods in respect of which said application is proposed to be registered, to distinguish the goods from the goods of other traders and registration of said opposed mark would, therefore, offend against the provisions of section 17 of the Trade Marks Act, 1963.
- (vi) Said opposed Mark is not capable of distinguishing the goods in respect of which it is proposed to be registered from those of other traders and registration of said opposed mark would therefore offend against the provision of section 18 of the Trade Marks Act, 1963.
- (vii) Said opposed mark is not a Trade Mark within the meaning of Section 2 of the Trade marks Act, 1963.
- (viii) The Applicant is not the proprietor of said opposed mark and registration of said opposed mark would, therefore, offend against the provisions of Section 25 of the Trade Marks Act, 1963.
- (ix) The Applicants do not use or propose to use said opposed mark for the purposes of indicating a connection in the course of trade between the Applicants and the goods and registration of the mark would, therefore, offend against the provisions of Section 2 and 25 of the Trade Marks Act, 1963.

- (x) The registration of the said opposed mark would be contrary to the provisions of the EC Harmonisation Directive, Council Directive 89/104/EEC.
- (xi) Having regard to the foregoing said application would be disentitled to protection in a Court of Justice and registration, therefore, would be contrary to Section 19 of the Trade marks Act, 1963.
- (xii) The Opponents respectfully submit that said Application ought in the discretion of the Controller be refused and requests that the Opponents may be granted an award of costs in this matter.

5. In their Counter-Statement, the Applicants stated as follows:

- (i) The Applicant has no knowledge of the statements made in paragraph 1 of the Notice of Opposition.
- (ii) The Applicant does not admit any of the statements made in paragraph 2 of the Notice of Opposition save that the Opponent is the registered proprietor of Trade Marks Nos. 63174 and 122956.
- (iii) The allegations made in paragraphs 3,4,5,6,7,8,9,10 and 11 of the Notice of Opposition are emphatically denied.
- (iv) The Trade Marks ORAN-GO/ORANGO (hereinafter referred to as the said Trade Marks), which the Applicant has applied to register as a series of two trade marks under Application No. 158535 (hereinafter referred to as the said application) are qualified for registration under Section 17 and 18 of the Trade Marks Act, 1963, and are Trade Marks within the definition contained in Section 2 of the Act. The Applicant has used or has a present and definite intention of using the said Trade Marks in respect of the goods set forth in the said application and had such an intention at the date of filing of the said application. The said application does not offend against the provisions of Section 25 of the Act.
- (v) The trade marks ORAN-GO/ORANGO are both visually and phonetically quite different from the Opponent's trade mark ORANGINA. Consequently, use by the Applicant of the said Trade Marks would not be

likely to deceive and/or cause confusion, or to lead to the Applicant's goods being passed off as or mistaken for goods of the Opponent, or to the assumption that the Applicant's and Opponent's goods emanate from the same trade source and registration of the said Trade Marks would not contravene Section 19 of the Trade Marks Act, 1963.

- (vi) The said Trade Marks do not so closely resemble the opponent's trade mark as to be calculated to deceive and/or cause confusion and registration of the said Trade Mark would not contravene Section 20 of the Trade Marks Act, 1963.
- (vii) Registration of the said Trade Marks would neither embarrass nor prejudice the Opponent in the conduct of the Opponent's business.
- (viii) Registration of the said Trade marks would not be contrary to the provisions of the EC Harmonisation Directive (Council Directive 89/104/EEC).
- (ix) There is no good reason why registration of the said Trade Marks should be refused at the discretion of the Controller.
- (x) Accordingly the Applicant requests that the opposition be rejected and that an award of costs be made in favour of the Applicant.

6. By way of evidence under Rule 37, the Opponents submitted a Statutory Declaration dated 13 September, 1996, and exhibits, by Michel Fontanes, Chairman of Compagnie Financiere Des Produits Orangina, a French company of 595 Rue Pierre Berthier-Domaine Saint-Hilaire, 13855 Aix-en-Provence, France. Mr Fontanes stated that his company assumed responsibility for the present proceedings by virtue of a Deed assigning all rights in and to Irish registration nos. 63174 and 122956. Mr Fontanes stated that sales of the goods throughout the Republic of Ireland since 1990 were of the order of £400,000 per annum and that the trade mark was extensively advertised and promoted through many media including cinema and tv advertising, advertisements in trade journals and by way of sponsorship of the Dublin mini marathon. The approximate average total amount spent annually on advertising and publicising the goods under the trade mark ORANGINA was in the region of £200,000 per annum. Mr Fontanes stated

the ORANGINA goods are sold in virtually every city, town and village in the jurisdiction and gave details of the trade channels through which the goods are bought and sold. He considered the Applicants marks to be confusingly similar, both visually and phonetically, to his company's trade mark and that the Applicants were seeking to cash in on the considerable reputation of the ORANGINA mark.

7. By way of evidence under Rule 38, the Applicants submitted a Statutory Declaration dated 28 April, 1997, and exhibits, by Michael McCormack, Secretary of Dairygold Co-operative Society Limited. Mr McCormack stated his company intends to use the trade mark applied for and had such an intention at the date of filing. Mr McCormack questioned the Opponent's claimed sales of £400,000 per annum. He suggested that if, as claimed by the Opponents, ORANGINA drinks have been sold in every city, town and village in the country, the turnover figure should be considerably higher than £400,000 per annum. Mr McCormack also stated that, with the exception of the extract from Checkout magazine dated April, 1993, the materials exhibited by Mr Fontanes were either undated or dated after the relevant date of 27 August, 1993 and submitted that the evidence failed to establish a reputation in the mark ORANGINA. Consequently, the Opponents had no case under Section 19. In Mr McCormack's opinion, there was no potential for confusion between ORAN-GO/ORANGO and the Opponents' ORANGINA marks, the word ORANGINA being neither visually nor phonetically similar to either version of his company's mark. He submitted the words ORAN-GO/ORANGO are pronounced OR-AN-GO, whereas the word ORANGINA is pronounced OR-AN-GEE-NA. He stated the common element between the marks was the prefix ORAN, which is derived from the ordinary dictionary word ORANGE and no manufacturer of citrus drinks could legitimately claim to have an exclusive right to use the prefix ORAN or ORANG in relation to such drinks. He referred to the exhibit showing particulars of all registrations in Class 32 which incorporate words beginning with both prefixes He also emphatically denied the Opponents' assertion that his company adopted the marks ORAN-GO/ORANGO in order to cash in on the Opponents' ORANGINA mark. Mr

McCormack stated the marks ORANGO and ORANGINA co-exist on the UK market and that no opposition was lodged against his company's UK application.

8. By way of evidence under Rule 39, the Opponents submitted a Statutory Declaration dated 14 May, 1998, and exhibits, by Jacques Pfister, Chairman of Compagnie Financiere Des Produits Orangina. Mr Pfister stated the invoices and other commercial documents exhibited which dated from 1990-1993 was evidence that the ORANGINA mark has been in substantial use in this country and that the Opponents have a substantial goodwill and reputation in the mark. He stated the expenditure on press advertising alone was £63,400 in 1990, £53,300 in 1991 and £3,800 in 1992. Referring to the similarity between the marks in question, he argued that, when comparing marks, they should be compared in their entirety and not in their component parts. He also stated that, as the prefix was the most important and memorable part of a mark, the visual, phonetic and connotative similarities between the Applicants' marks and his company's marks would cause considerable deception and confusion. Referring to the list of trade marks exhibited by Mr McCormack, Mr Pfister stated that his company's was the owner of the only "ORAN-" prefixed registration in Class 32. Referring to the co-existence of the marks in the UK, Mr Pfister stated the position in other countries is irrelevant to the present proceedings. He also questioned the Applicants' intention to use the mark, stating that the Applicants have not produced any evidence of use of the mark.
9. At the Hearing the Applicants were represented by Norman MacLachlan of MacLachlan & Donaldson and the Opponents by Mary Rose O'Connor of Cruickshank & Co.
10. At the Hearing the Opponents referred to several authorities including the OVAX application, Smith, Hayden & Co. [1946 63 RPC 97] and BALI [1969 RPC 472], PIANOTIST [1906 23 RPC 774]. They submitted that when the standard tests for comparing marks were applied to the present case, the Applicants' mark so nearly

resembled that of the Opponents and there was a likelihood of deception and confusion.

11. I will first deal with the objections under Section 20. I am satisfied that the goods in respect of which the Applicants seek registration are the same goods or description of goods as the goods on which the Opponents' mark is used. I am further satisfied that both marks are addressed to the same purchasing public. The issue to be decided, therefore, is whether or not the marks so closely resemble each other as to be likely to deceive or cause confusion.

The standard test for comparing marks is that set down in *Pianotist* (1906) 23 RPC 774 in which Parker J stated:

"You must take the two words. You must judge them, both by their look and by their sound. You must consider the nature and kind of customer who would be likely to buy the goods. In fact, you must consider all the surrounding circumstances; and you must further consider what is likely to happen if each of those trade marks is used in a normal way as a trade mark for the goods of the respective owners of the marks. If, considering all those circumstances, you come to the conclusion that there will be confusion – that is to say, not necessarily that one man will be injured and the other will gain illicit benefit, but there will be a confusion in the minds of the public which will lead to confusion in the goods – then you may refuse registration, or rather you must refuse registration in that case".

In applying this test, I find the marks do not so nearly resemble each other as to be likely to deceive or cause confusion. While the marks share the same prefix "ORAN", there are considerable visual and phonetic differences. The marks have different suffixes, "GO" versus "GINA". The Opponents' mark has an extra syllable. In terms of phonetics, I am satisfied the Applicants' mark is pronounced OR-AN-GO while that of the Opponents is pronounced OR-AN-GEE-NA. There is no doubt in my mind that, if used in a normal and fair manner, there is no

reasonable likelihood of confusion between the marks and I dismiss the opposition under Section 20.

12. The Opponents also raised an objection under Section 19. In order for Section 19 to apply, it is necessary for the Opponents to first show they have a reputation in the mark such that it is known to a substantial number of people. At the Hearing the Applicants argued the Opponents did not have the required reputation. While they accepted there was substantial use of the ORANGINA mark when it was first launched in this country, and the mark was successful in France and in continental Europe, there was no continuing use in this jurisdiction and at the relevant date the product was in decline. They submitted it was common knowledge the product was no longer available on the Irish market.

The Opponents were challenged by the Applicants to substantiate their claimed turnover of “£400,000 per annum since 1990” and advertising and promotional expenditure of “£200,000 per annum”. In response, the Opponents submitted invoices of sales, all of which relate to 1990, 1991 or 1992 and other commercial information relating to advertising and promotional expenditure. They gave figures for press advertising only - £63,400 in 1990, £59,300 in 1991 and £3,800 in 1992. The figure for 1992 is particularly low and I am not satisfied on evidence that the Opponents’ claimed advertising and publicity expenditure of £200,000 per annum could be relied upon.

Based on the evidence submitted by the Opponents, I am not satisfied they had, at the relevant date, the required reputation in the mark ORANGINA sufficient to allow them oppose under Section 19. However, if I am wrong in this, I am satisfied that the Applicants have discharged the onus on them to show there is no likelihood of confusion between their mark and that of the Opponents. I, therefore, dismiss the opposition under Section 19.

13. As for the remaining objections, I am satisfied the Applicants had at the date of application a bona fide intention to use the mark and I see no good reason to

exercise the Controller's discretion against the Applicants under Sections 2 or 25. I am further satisfied the mark is adapted to distinguish within the meaning of Section 17 and capable of distinguishing within the meaning of Section 18 and I dismiss these objections. As the application falls to be determined in accordance with the Trade Marks Act, 1963, I do not propose to deal with the Opponents' opposition on the grounds that registration of the mark would be contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member States relating to trade marks.

14. As the opposition has failed on all grounds I see no good reason to exercise the Controller's discretion adversely towards the Applicants.

Dermot Sheridan

For the Controller

January, 2002