



## TRADE MARKS ACT 1995

### DECISION OF A DELEGATE OF THE REGISTRAR OF TRADE MARKS WITH REASONS

Re: Opposition by Brauerei Beck GmbH & Co KG to registration of trade mark application number 705374 - ISENBECK - in the name of Warsteiner Brauerei Haus Cramer GmbH & Co KG.

#### **Background**

Warsteiner Brauerei Haus Cramer GmbH & Co KG (the applicant) filed the above numbered application, for the word **ISENBECK**, on 28 March 1996 in respect of 'beer' in class 32. The application was accepted on a first examination report and acceptance was advertised in the *Australian Official Journal of Trade Marks* (the Journal) of 30 January 1997.

Brauerei Beck GmbH & Co KG (the opponent) filed a notice of opposition on 30 April 1997, listing grounds under s. 57 involving s.41, s.42, s.43 and s.44, and also grounds under s.58, s.59 and s.60. The opponent filed and served its evidence in support, consisting of two declarations, (Gartner 1 and Perrin), by 31 December 1997. The applicant filed and served one declaration (Brandes) as its evidence in answer by 29 September 1998. The opponent then chose to file and serve one further declaration (Gartner 2) as its evidence in reply, which it did by 9 August 1999. Neither party requested to be heard and so the matter has been directed to me, as a delegate of the Registrar, for a decision based on the material held in this Office.

#### **The Evidence**

Detlef Gartner, the deponent of the Gartner 1 and Gartner 2 declarations, made on behalf of the opponent, is the Export Director for the opponent company. The opponent is a

manufacturer and exporter of beer. It has brewed beer since 1873 in Germany under the strict purity requirements of the legislation known as the 'Reinheitsgebot' of 1516.

The Gartner 1 declaration sets out four registered trade marks, all containing the word BECK'S, on which the opponent relies. Details of these four marks are set out below, in the **Discussion**. The opponent first used the trade mark BECK'S in Australia in 1888, when it was awarded a gold medal for BECK's lager at the international centennial exhibition held in Melbourne. Also in evidence, as an attachment to the Gartner 1 declaration, is a detailed early history of the opponent company. The bulk of this historical material is in the German language without a verified translation into English. I can only consider those parts of this history which are in the English language, in line with Regulation 21.18. This history shows use of a beer label, in New South Wales, prominently displaying 'BECK & Co.' from as early as August 1886, use of a shop sign for 'BECK's LAGER' in a busy Sydney street in 1906 and a representation of a beer label for 'BECK's LAGER' used from 1907 in Australia. The Gartner 1 declaration claims that 'in the years leading up to 1914, BECK's beer was distributed widely throughout Australia as was well known.' Although the record is silent for the years 1914 to 1984, that same declaration provides sales figures for beer sold under the BECK's trade mark, in Australia, for the years 1984 to 1996.

Doreen Perrin, Patent Attorney for the opponent, provides in her declaration, current prices for the opponent's goods. This shows that a 330 millilitre bottle of BECK's beer retails at \$3.00 and a 5 litre keg may be purchased for \$39.95.

Jurgen Brandes, a fully authorised officer of the applicant, in his declaration constituting the evidence in answer, provides a brief history of the use of the ISENBECK mark from 1769 and a listing of the countries to which the applicant now exports beer under that trade mark. Mr Brandes also testifies to the fact that the Regional Court of Hamburg, in a judgement of 7 July 1998, ruled that the marks BECK's and ISENBECK are not sufficiently similar to produce confusion in the minds of prospective purchasers (in the German market). Other court judgements from overseas jurisdictions in favour of the applicant were also cited in the Brandes declaration.

The Gartner 2 declaration is the entire evidence in reply from the opponent. A copy of the judgement, of the Trade Mark Trial and Appeal Board of the United States Patent and Trade

Marks Office, refusing registration for the ISENBECK mark in the face of the opponent's BECK's and HAAKE BECK's marks, is attached as an exhibit to this declaration. Within the declaration Mr Gartner also challenges the level of use of the ISENBECK mark, with two claims - one being that 'the use made of the ISENBECK trade mark within Germany has been on a very small scale' and the other being that 'I note that no sales of the ISENBECK product in Australia are recorded'.

### **Submissions**

Both parties chose not to file any written submissions following the evidence stages. As neither party requested to be heard in the matter it has now been directed to me, as a delegate of the Registrar, for decision.

### **Discussion**

Although the notice of opposition listed grounds under seven sections of the Act, no support for those grounds under s.41, s.42, s.43, s.58 or s.59 is to be found in the evidence. Thus, I find that in relation to those five grounds the opposition is not successful. The remaining two grounds, those under s.44 and s.60, form the rest of the subject matter in these reasons.

#### ***(a) Section 44 - Identical etc. trade marks***

The legislation so far as it is relevant here reads:

**44.(1)** Subject to subsections (3) and (4), an application for the registration of a trade mark (*applicant's trade mark*) in respect of goods (*applicant's goods*) must be rejected if:

(a) the applicant's trade mark is substantially identical with, or deceptively similar to:

(i) a trade mark registered by another person in respect of similar goods or closely related services;

(ii) ...

(b) the priority date for the registration of the applicant's trade mark in respect of the applicant's goods is not earlier than the priority date for the registration of the other trade mark in respect of the similar goods or closely related services.

Note 1: For *deceptively similar* see section 10.

Note 2: For *similar goods* see subsection 14(1).

Note 3: For *priority date* see section 12.

The opponent claimed that four of its registered trade marks could provide a barrier to the present application. These I now set out below.

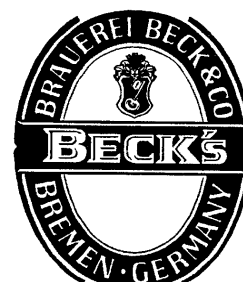
116481



116482



600469



The fourth mark relied upon is numbered 516204 and is a word trade mark registered for the series **BECK'S**, **BECK**, **Beck's** and **Beck**.

Registration details of these marks are as follows:

TRADE MARK	REGISTERED GOODS	PRIORITY DATE
116481	Beer	30 November 1953
116482	Beer	30 November 1953
516204	Beer, ale and porter	3 August 1989
600469	Beer, ale and porter	16 April 1993

The opponent's four trade marks all contain within their specifications 'beer' - the same goods as for the present application. All four registrations also pre-date the present application date, of 28 March 1996. Thus, these four registrations all satisfy the conditions necessary to successfully oppose the application in terms of s.44(1)(a)(i) and s.44(1)(b) set out above. The remaining test to be decided falls under s.44(1)(a) - whether or not the applicant's mark is either substantially identical with, or deceptively similar to, one or more of the four marks registered in the name of the opponent.

*(i) Substantially identical trade marks*

In evaluating substantially identical trade marks Windeyer J in *Shell Co. (Aust.) Ltd v Esso Standard Oil (Aust.) Ltd*<sup>1</sup> stated at 414:

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<sup>1</sup> (1961) 109 CLR 407

In considering whether marks are substantially identical they should, I think, be compared side by side, their similarities and differences noted and the importance of these assessed having regard to the essential features of the registered mark and the total impression of resemblance or dissimilarity that emerges from the comparison.

The present application is for the word ISENBECK in normal block lettering. Three of the opponent's marks contain both device elements and the word BECK's, whilst the fourth trade mark is a word trade mark for the series BECK'S, BECK, Beck's and Beck. All four marks exhibit obvious differences when the side by side comparison is made with ISENBECK. The opponent has not argued that the marks are substantially identical and I find that they are not. The opponent has, however, contended that the respective marks are deceptively similar.

*(ii) Deceptively similar trade marks*

Determination of deceptive similarity has until recently been governed by the finding in *Smith Hayden & Co Ltd's Application*<sup>2</sup> at 101, where Evershed J said:

Assuming user by [the opponents] of their marks 'Hovis' and 'Ovi' in a normal and fair manner for any of the goods covered by the registrations of those marks (and including particularly goods also covered by the proposed registration of the mark 'Ovax') is the Court satisfied that there will be no reasonable likelihood of deception or confusion among a substantial number of persons if [the applicants] also use their mark 'Ovax' normally and fairly in respect of any goods covered by their proposed registration?

Under the new Act, however, this test now stands modified by the judgement of French J in *Registrar v Woolworths Limited*<sup>3</sup> at 418:

The mandatory language of s33 gives effect to the intention, expressed in the Second Reading Speech, that there is to be a presumption of registrability when the application is examined by the Registrar of Trade Marks. This is a shift from the position under the previous law whereby the onus was on the applicant to establish registrability.

Under the present legislation, the Registrar must be satisfied that there will be a likelihood of deception or confusion before refusing the application; whereas the repealed Act required the Registrar to be satisfied that there would not be a likelihood of deception or confusion before

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<sup>2</sup> (1946) 63 RPC 97.

<sup>3</sup> 45 IPR 411

registering the application. Thus the directives from *Registrar v Woolworths*, supra, define the approach to be taken by the Registrar that clearly affords the applicant an advantage, in comparison with the earlier legislation, in having the trade mark accepted for registration.

Windeyer J also considered the question of deceptive similarity of trade marks in *Shell Co.*, supra, at 415:

On the question of deceptive similarity a different comparison must be made from that which is necessary when substantial identity is in question. The marks are not now to be looked at side by side. The issue is not abstract similarity, but deceptive similarity. Therefore the comparison is the familiar one of trade mark law. It is between, on the one hand, the impression based on recollection of the plaintiff's mark that persons of ordinary intelligence and memory would have; and, on the other hand, the impressions that such persons would get from the defendant's television exhibitions.

Another judgement to provide direction on the issue is *Rysta Limited's Application*<sup>4</sup>, where Luxmoore LJ held at 108 that:

It is the person who only knows the one word, and has perhaps an imperfect recollection of it, who is likely to be deceived or confused. Little assistance, therefore, is to be obtained from a meticulous comparison of the two words, letter by letter and syllable by syllable, pronounced with the clarity to be expected from a teacher of elocution.

The Court must be careful to make allowance for imperfect recollection and the effect of careless pronunciation and speech on the part not only of the person seeking to buy under the trade description, but also of the shop assistant ministering to that person's wants.

Of all of the opponent's registered marks, I believe that the mark BECK finds the greatest resemblance to ISENBECK, and so these are the two marks I intend to initially compare for similarity in terms of s.44.

Even where the marks are not seen side by side I do not believe that prospective purchasers of the goods would think the applicant's mark to **actually be** the opponent's mark. I can accept that this sort of confusion may be the case in some circumstances where the respective marks only vary by one letter - but I think that it would take an extremely careless observation by a person to think that, on seeing ISENBECK on beer, that such a person

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<sup>4</sup> (1943) 60 RPC 87

would think that it was the opponent's BECK beer previously purchased or sighted. To believe that an eight letter word and a four letter word will literally be mistaken, one for the other, stretches the boundary of reason a little too far, in my opinion. However, a further question that requires consideration is whether it is likely that deception or confusion could occur through 'conceptual confusion'.

The principle of conceptual confusion is summed up in *John Fitton & Co. Ltd's Application*<sup>5</sup>, at 113 where Mr S. E. Chisholm, the Assistant-Comptroller, commented:

With reference to the nature of the confusion alleged the evidence furnished on behalf of the Opponents by their trade declarants is directed not so much towards showing that the two marks 'Jests' and 'Easyjests' might themselves be confused either visually or orally, as towards establishing that confusion would result, owing to the presence of the common element 'Jest' in each mark, in traders and the public being induced to believe that the two sets of goods sold under the marks emanated from one and the same trade source.

Applying this principle to the present matter, I need to decide, whether or not the possible contextual confusion between the applicant's ISENBECK mark and the opponent's BECK mark is sufficiently strong to trigger s.44 in favour of the opponent.

I must, of course, decide this issue under the *Trade Marks Act 1995* as it operates in Australia with a consideration of the various circumstances and conditions peculiar to this particular opposition matter. Both parties however filed, as evidence, judgements and decisions from other jurisdictions, which found in their favour, on the issue of similarity of the respective marks. Some issues that may be relevant to the Australian market have been discussed in these earlier cases. Some of the issues discussed, however, are not relevant. Whilst I intend to consider the comments made in these various cases, I am not bound as precedent by any of the previously decided cases, from overseas jurisdictions, that have been submitted in the evidence.

As mentioned above, the applicant relies, in its evidence in answer, on a judgement from the Regional Court of Hamburg of 7 July 1998. The opponent relies, in its evidence in reply, on a judgement from the Trade Mark Trial and Appeal Board of the United States Patent and

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<sup>5</sup> 66 RPC 110

Trade Marks Office of 17 March 1999. These overseas decisions locked the outcomes at one to each party.

Several differences can be noted between the conditions and issues for decision in Germany and in the United States as against the similar considerations for the Australian market. The following list is not exhaustive but covers many of the differences.

- Isenbeck is a family name in Germany but does not appear as such in Australia.
- For one decision comparison of the respective marks is confined to a consideration of the applicant's mark with BECK's rather than the series shown for registration 516204 above.
- Issues of German pronunciation and rules of German grammar are considered.
- The actual use of a trade mark is a greater consideration as a pre-requisite to constitute a barrier under both the German and United States legislation considered, whereas s.44 requires no such use.
- A consideration of the entire beer labels is made rather than the trade marks as applied for or as registered in one of the decisions.
- Famous trade marks legislation is considered in the U.S. decision whereby any doubt is resolved in favour of the opponent's prior user of a famous mark.
- The state of the U.S. Register is also considered.

These judgements, in other jurisdictions, were made under laws that differ in many respects from current Trade Mark law in Australia. Additionally, the facts on which a comparison of deception or confusion depends are also quite different. On the basis of these clear differences the outcomes for these earlier judgements have little impact for the present decision.

Comparing BECK and ISENBECK in terms of the Australian market I note, firstly, that Beck is a proper name in Australia which occurs some 1959 times on the electoral rolls, whereas Isenbeck has no surnominal signification. Secondly, the word 'Beck' has a number of dictionary meanings. These include, as a noun, a brook or stream, the bottom of the valley through which a brook or stream flows, a mute signal or significant gesture, a gesture expressive of salutation or respect, an agricultural implement with two hooks, a large shallow vessel used in brewing, and as a verb, to make a mute signal or significant gesture. These

definitions can be found in the *Oxford English Dictionary (Second Edition)*. Thirdly, Isenbeck has no such dictionary meaning - but in the English language, gives the appearance of an invented word (or, to some, possibly as a foreign word). These differences in meaning and idea weigh in favour of the applicant.

The argument for the opponent, from the aspect of contextual confusion, relies on the marks BECK and ISENBECK being seen as a 'family' in some respect. The situation for possible contextual confusion as quoted in *John Fitton, supra*, concerned JESTS and EASYJESTS. These two words could be seen as having some association because the word 'easy' in the applicant's mark may readily be applied to some characteristic of the goods. The goods for that application included medicated sweets. Any possible descriptive or laudatory use for the word 'easy', in relation to medicated sweets, provides the purchasing public with a sufficient reason, in my opinion, to assume that 'Jests' and 'Easyjests' share a common trade source.

However, with BECK and ISENBECK it is difficult to derive any such similar connection. BECK is a surname in Australia, occurring 1959 times on the electoral roll. If, for instance, ISEN was a recognised given name, then some case could be mounted for the opponent concerning possible confusion of the trade source, despite the appearance of ISENBECK as a single word. BECK also has a dictionary meaning, although not a commonly used word. Again, if ISEN was a word or part word seen as functioning as a recognised adjective then the opponent may have a similar winning argument. ISENBECK does not have a direct dictionary meaning, despite the apparent derivations of ISEN and BECK from ancient forms of the German words EISEN and BACH. This factor adds to the differences between the marks available to the purchasing public. When confronted with the word ISENBECK the conceptual recollection by a prospective purchaser for the word BECK could be either as a surname, or as having some dictionary meaning, but whichever concept comes to the mind, I do not believe that either will readily relate ISENBECK to a family of BECK marks.

I do not believe that possible contextual confusion will be likely to occur 'among a substantial number of persons' as per *Smith Hayden, supra*, as modified by *Registrar v Woolworths, supra*, when a comparison is made between the applied for mark, ISENBECK, and the opponent's BECK trade mark. Similarly, I believe that the other three marks in the series of registered marks under registration number 516204, viz. the series BECK'S, Beck and Beck's, will not, separately, be likely to produce deception or confusion among a substantial number

of persons when comparison is made with the present mark. I find this to be the case because the marks BECK'S, Beck and Beck's display even less similarity, contextually, to ISENBECK than does BECK. The possessive form, involving BECK'S and Beck's, provides the purchaser with an added cue that those marks are based on a proper name, and therefore they are further distinguished from ISENBECK. My comments in relation to the differences between the mark ISENBECK and the mark BECK above apply to slightly greater effect in relation to the differences between ISENBECK and Beck.

The opponent also sought to rely on three composite trade marks in respect of its opposition under s.44. These three trade marks, numbered 116481, 116482 and 600469, are depicted above, close to the beginning of the **Discussion** section of these reasons. The three trade marks all contain the word BECK'S or BECK's together with other, generally descriptive words and with a similar device of a key in a shield. These three marks are even further removed from ISENBECK than the series of words BECK, BECK'S, Beck and Beck's due to the device element. Thus I find that possible deception or confusion, either visually or phonetically, is even less likely than for that series.

To find that the mark ISENBECK would be likely to cause deception or confusion among a substantial number of persons because of a contextual link with all the opponent's marks, I would need to find that the respective marks of the applicant and the opponent would be seen as a 'family' in some way. All of the opponent's marks contain, or consist of, the word BECK or its possessive form, BECK'S. The opponent does use some variations on the theme - with and without devices - but always with the constant word BECK (or BECK'S). I do accept that the opponent's marks form a family - but it is a family bound together by the full word BECK (or the possessive form BECK'S). The link actually producing the 'family' of trade marks is the full word BECK (or the possessive form). In my opinion, the expectation in the mind of the purchasing public that such a family of marks sets up, is that other marks associated within the family would also need to contain the full word BECK or its possessive form.

Nowhere, in the opponent's family of BECK marks, is a mark to be found in which BECK is used as simply a part-word, or even more particularly, as a suffix. In the present application BECK is used as a part-word suffix. I do not accept that the word ISENBECK would be seen as part of the opponent's 'family' of BECK marks given that none of the opponent's marks use

BECK in the suffix form. As such, I find that the respective mark of the applicant and the 'family' of marks of the opponent are not deceptively similar.

In the present circumstances, I believe that 'there will be no reasonable likelihood of deception or confusion among a substantial number of persons' and so there is no barrier to the application. However, even if I was less convinced to the point of being undecided on the issue, the words of Justice French direct me to presume that the application is registrable. Only if I was of the opinion that there is a real, tangible likelihood of deception or confusion would I be justified in refusing the application.

As I have found that the respective marks of the applicant and the opponent are not deceptively similar, or substantially identical, the opposition in terms of s.44 is not successful.

***(b) Section 60 - Trade mark similar to trade mark that has acquired a reputation in Australia***

As I mentioned above, opposition in terms of s.60 was the only other ground relied upon by the opponent.

The legislation reads:

**60.** The registration of a trade mark in respect of particular goods or services may be opposed on the ground that:

- (a) it is substantially identical with, or deceptively similar to, a trade mark that, before the priority date for the registration of the first-mentioned trade mark in respect of those goods or services, had acquired a reputation in Australia; and
- (b) because of the reputation of that other trade mark, the use of the first-mentioned trade mark would be likely to deceive or cause confusion.

Note 1: For *deceptively similar* see section 10.

Note 2: For *priority date* see section 12.

As I have already found, in my comments in relation to s.44 above, that the applicant's mark, ISENBECK, and the opponent's family of BECK (or BECK'S) marks are neither substantially identical nor deceptively similar, then the initial test under s.60 is not met by the opponent.

It is not necessary for me to assess the reputation acquired by the opponent's trade marks because this ground fails in terms of s.60(a). However, I note that the opponent's evidence indicates that the reputation lies with the word BECK'S rather than BECK. I also note that, in

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use the mark is almost universally BECK's where the letter 's' is in a smaller font than the other letters. As I mentioned in the comments concerning s.44 above, I believe that both BECK'S and BECK's are further removed from ISENBECK than is BECK.

Given the above material, I find that the opposition in terms of s.60 is not successful.

### **Conclusion**

From the foregoing I have found that the opposition is not successful in terms of the grounds under either s.44 or s.60 of the Act. The remaining five grounds listed in the notice of opposition were neither supported by material in the evidence nor argued by the opponent.

Hence, as a delegate of the Registrar, I direct that this opposition be dismissed, and that, on payment of the registration fee that the application may proceed to registration.

Don Nancarrow  
Acting Hearing Officer

31 March 2000