

O-184-11

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 2510349
BY SHAWS DRINKS COMPANY LIMITED
TO REGISTER A TRADE MARK IN CLASSES 32 & 33**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 99894 BY
NICHOLAS DYNES GRACEY**

BACKGROUND

1. On 5 March 2009, Shaws Drinks Company Limited (“Shaws”) applied to register **ADRENALIN RUSH** as a trade mark. Following examination, the application was accepted and published for opposition purposes on 18 September 2009 for the following goods:

Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines; soft drinks; carbonated drinks [non-alcoholic, and beers]; aerated drinks [non-alcoholic]; mineral drinks (Non-medicated-); vegetable drinks; fruit drinks; fruit flavoured carbonated drinks [not more than 1.2% alcohol by volume]; fruit flavoured drinks [not more than 1.2% alcohol by volume]; bottled fruit drinks; drinks flavoured with fruit pastes; multi-vitamin fruit juice beverages [not for medical use]; multi-vitamin enriched fruit juice beverages [other than for medical use]; sarsaparilla beverages [non-medicinal]; seltzers [beverages]; sherbets [beverages]; sorbets [beverages]; energy drinks [not for medical purposes]; isotonic drinks [not for medical purposes]; beverages containing vitamins [not for medical purposes]; beverages enriched with added minerals [not for medical purposes]; low alcohol drinks containing not more than 1.2% (by volume) of alcohol); alcoholic drinks [except beer] containing not more than 1.2% of alcohol by volume; alcoholic beers; alcohol reduced beer [not more than 1.2% of alcohol by volume]; alcohol free beer; fruit beers; ginger beer; malt beer; pilsner beer; root beer; preparation for making beverages; preparations for making fruit drinks; preparations for making vegetable drinks; preparations for making low alcoholic drinks; preparations for making non alcoholic drinks; preparations for use in the production of beer; preparations in the form of powder for making drinks; beverage ingredients for use in vending machines; effervescing beverages (Pastilles for-); effervescing beverages (Powders for-); and parts and fittings for all the aforesaid goods.

Class 33: Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails; alcoholic beverages [except beer]; alcoholic beverages [except beer] containing more than 1.2% of alcohol by volume; beverages (Distilled-); alcoholic essences; alcoholic extracts; still beverages [alcohol content 1.2% or more (by volume)]; carbonated beverages [alcoholic, except beers]; fruit based alcoholic beverages; punches [beverage] having an alcohol content of 1.2% or more (by volume); Digesters [liqueurs and spirits]; beverages containing wine [alcohol content 1.2% or more by volume]; champagne wines; dry sparkling wines; fortified wines; preparations for making alcoholic beverages.; and parts and fittings for all the aforesaid goods.

2. On 15 December 2009, Nicholas Dynes Gracey filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (as amended) (the Act). Mr Gracey indicates that the opposition is directed against all of

the goods contained in the application for registration. Mr Gracey relies upon one trade mark registration:

Trade Mark	No.	Application date	Registration date	Goods relied upon
ADRENALIN ADRENALINE (series of 2)	2399047	09.08.2005	07.08.2009	5 - Baby food; food supplements; preparations for personal hygiene. 21 - Utensils, containers. 25 - Clothing; footwear; headgear. 31 - Agricultural products; agricultural produce; fruit and vegetables. 33 – Alcoholic beverages. 34 - Tobacco; smokers articles.

3. In his Notice of Opposition Mr Gracey says:

“Goods are likely to be sold via similar sales outlet/store e.g. Food, Off Licence, Pharmacy, Sports.”

4. On 11 February 2010, Shaws filed a counterstatement. Other than accepting that the competing goods in class 33 were identical, it consists, in essence, of a denial of the ground of opposition.

5. Neither party filed evidence or written submissions nor did they ask to be heard.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(a)....

(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, or

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) 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,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

8. In these proceedings Mr. Gracey is relying upon the registration shown in paragraph 2 above. This constitutes an earlier trade mark under the above provisions, and is not subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004.

Section 5(2)(b) – case law

9. In reaching a decision I must take into account the guidance provided by the European Court of Justice (ECJ) in a number of judgments. The principal cases are: *Sabel BV v. Puma AG* [1998] R.P.C. 199, *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117, *Lloyd Schuhfabrik Mayer & Co. GmbH v. Klijsen Handel B.V* [2000] F.S.R. 77 and *Marca Mode CV v. Adidas AG + Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG V Thomson multimedia Sales Germany & Austria GmbH* (case C-120/04) and *Shaker di L. Laudato & Co. Sas v Office for Harmonization in the Internal Market (Trade Marks & Designs)* (case-334/05).

It is clear from all these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all the relevant factors: *Sabel BV v. Puma AG*, paragraph 22;

(b) the matter must be judged through the eyes of the average consumer of the good/services in question; *Sabel BV v. Puma AG*, paragraph 23, who is deemed to be reasonably well informed and circumspect and observant – but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v. Puma AG*, paragraph 23;
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v. Puma AG*, paragraph 23;
- (e) when considering composite marks, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element; *Shaker di L. Laudato & Co. Sas* (C-334/05), paragraph 42;
- (f) an element of a mark may play an independent distinctive role within it without necessarily constituting the dominant element; *Medion AG V Thomson multimedia Sales Germany & Austria GmbH*, paragraph 30;
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17;
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v. Puma AG*, paragraph 24;
- (i) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v. Puma AG*, paragraph 26;
- (j) further, the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; *Marca Mode CV v. Adidas AG + Adidas Benelux BV*, paragraph 41;
- (k) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 29.

The average consumer and the nature of the purchasing process

10. 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. With the exception of "beverage ingredients for use in vending machines" which appears in Shaws' application in class 32 and which I assume are likely to be aimed at businesses engaged in supplying vending machines and

businesses who have vending machines in their premises, the goods at issue in these proceedings are beverages of one sort or another or preparations for making such beverages. With the exception of the beverage ingredients for use in vending machines, the average consumer for such goods will be the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18. With the exception of the beverage ingredients for use in vending machines, all of the goods at issue are sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self selection), and in bars and restaurants (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar and on menus etc.). When the goods are sold in, for example, bars and restaurants, the selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. *In Simonds Farsons Cisk plc v Spa Monopole*, case T-3/04, the Court of First Instance (now the General Court) 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.”

11. Consequently, while the goods may be ordered orally in bars and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will display when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are, in my view, likely to pay at least a reasonable level of attention when selecting the goods. Insofar as beverage ingredients for use in vending machines are concerned, I have no evidence as to how these goods are selected nor do I have any experience of my own on which to draw. In the absence of evidence or written submissions to the contrary, I intend to proceed on the basis that visual considerations are likely to dominate the selection process with the goods being the subject of self selection from, for example, the shelves of a wholesaler or appearing in, for example, printed listings (either in hard copy or on line). However, as it is also possible that businesses may order the goods by telephone, aural considerations should also be kept in mind.

Comparison of goods

12. For the sake of convenience the goods to be compared are as follows:

Mr Gracey's goods	Shaws' goods
<p>5 - Baby food; food supplements; preparations for personal hygiene.</p> <p>21 - Utensils, containers.</p> <p>25 - Clothing; footwear; headgear.</p> <p>31 - Agricultural products; agricultural produce; fruit and vegetables.</p> <p>33 – Alcoholic beverages.</p> <p>34 - Tobacco; smokers articles.</p>	<p>Class 32: Beers; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines; soft drinks; carbonated drinks [non-alcoholic, and beers]; aerated drinks [non-alcoholic]; mineral drinks (Non-medicated-); vegetable drinks; fruit drinks; fruit flavoured carbonated drinks [not more than 1.2% alcohol by volume]; fruit flavoured drinks [not more than 1.2% alcohol by volume]; bottled fruit drinks; drinks flavoured with fruit pastes; multi-vitamin fruit juice beverages [not for medical use]; multi-vitamin enriched fruit juice beverages [other than for medical use]; sarsaparilla beverages [non-medicinal]; seltzers [beverages]; sherbets [beverages]; sorbets [beverages]; energy drinks [not for medical purposes]; isotonic drinks [not for medical purposes]; beverages containing vitamins [not for medical purposes]; beverages enriched with added minerals [not for medical purposes]; low alcohol drinks containing not more than 1.2% (by volume) of alcohol); alcoholic drinks [except beer] containing not more than 1.2% of alcohol by volume; alcoholic beers; alcohol reduced beer [not more than 1.2% of alcohol by volume]; alcohol free beer; fruit beers; ginger beer; malt beer; pilsner beer; root beer; preparation for making beverages; preparations for making fruit drinks; preparations for making vegetable drinks; preparations for making low alcoholic drinks; preparations for making non alcoholic drinks; preparations for use in the production of beer; preparations in the form of powder for making drinks; beverage ingredients for use in vending machines; effervescing beverages (Pastilles for-); effervescing beverages (Powders for-); and parts and fittings for all the aforesaid goods.</p>

	<p>Class 33: Alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails; alcoholic beverages [except beer]; alcoholic beverages [except beer] containing more than 1.2% of alcohol by volume; beverages (Distilled-); alcoholic essences; alcoholic extracts; still beverages [alcohol content 1.2% or more (by volume)]; carbonated beverages [alcoholic, except beers]; fruit based alcoholic beverages; punches [beverage] having an alcohol content of 1.2% or more (by volume); Digesters [liqueurs and spirits]; beverages containing wine [alcohol content 1.2% or more by volume]; champagne wines; dry sparkling wines; fortified wines; preparations for making alcoholic beverages.; and parts and fittings for all the aforesaid goods.</p>
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13. In its counterstatement Shaws admit that the competing goods in class 33 are identical; I agree. Insofar as its goods in class 32 are concerned, in its counterstatement Shaws said:

“4.5 We submit that the goods covered in class 32 of the application (i.e. soft drinks) are dissimilar to those in class 33 (i.e. alcoholic drinks) because (TREAT analysis):

Uses/users are significantly different because of the age and health/safety restrictions relating to alcohol; the times and circumstances at/in which the respective beverages are drunk; and the general price differential (often resulting from tax). In fact, the relevant public is circumspect when buying drinks, and would not confuse soft drinks for alcoholic drinks, for instance when buying for a child. In any case, alcoholic drinks are suitably labelled so that consumers do not confuse them for soft drinks. Thus, with the aid of circumspection, the relevant public will readily distinguish between the respective marks.

Trade channels are different for the respective beverages, in part because of the above mentioned restrictions in relation to alcoholic drinks.

Different shelves are used to display alcoholic drinks and soft drinks in the case of self-serve beverages, for instance in supermarkets.

Competition does not occur between alcoholic drinks and soft drinks.

4.7 [The opponent also relies upon goods in classes 5, 21, 25, 31 and 34]. However, these goods are totally different to drinks...the applicant denies the relevance of these goods to the proceedings.”

14. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and, as Shaws point out in their counterstatement, *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the ECJ accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market.
- (e) 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;
- (f) 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.

15. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T- 325/06 the General Court (GC) explained when goods were complementary:

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P *Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

16. First of all I agree with Shaws that the goods contained in classes 5, 21, 25, 31 and 34 of Mr Gracey’s registration do not assist him in these proceedings; his best case lies with his goods in class 33. If he fails in relation to these goods he will be in no better

position in relation to the goods in the classes mentioned above. Shaws views on why the competing goods in classes 32 and 33 are dissimilar are reproduced above. Having considered the position by reference to, inter alia, the *Treat* case mentioned by them, I have come to the following conclusions.

17. Broadly speaking all of the goods are beverages for consumption or preparations for making such beverages. I note that a number of the phrases included in Shaws' specification in class 32, for example, "low alcohol drinks containing not more than 1.2% (by volume) of alcohol" and "non alcoholic wines" are the low or non alcoholic equivalent of the "alcoholic beverages" contained in class 33 of Mr Gracey's registration. The uses, users, physical nature and trade channels of these competing goods are likely to be the same, and as the user may choose to select, for example, a low or non-alcoholic wine as opposed to its alcoholic equivalent, the goods are also in competition with one another. In my view there is a very high degree of similarity between these goods.

18. The goods which remain in Shaws' specification can, in my view, be split into three categories i.e. beer and the preparations for making beer, what Shaws refer to as soft drinks and the preparations for making these goods and beverage ingredients for use in vending machines. The users of beer and alcoholic beverages are the same as are (broadly speaking) the uses; as they could all be drunk, for example, before, during or after a meal there is an element of competition between them. As to trade channels, although the goods would be found on different shelves in, for example, a supermarket, they would be sold in close proximity; they may also appear side-by-side on menus in bars and restaurants. Overall, I consider there to be a fairly high degree of similarity between beer (and preparations for making beer) and alcoholic beverages in class 33.

19. Insofar as the clash between soft drinks and alcoholic beverages are concerned, once again the users may be the same i.e. members of the general public over the age of 18. While as a general rule, alcoholic beverages in class 33 are not drunk simply to slake the thirst, as both could be drunk, for example, before, during or after a meal there is, once again, an element of competition between the goods. Although found on different shelves, the goods will be located in the same general area of a supermarket (although I accept not in such close proximity as beer); once again they may also appear side-by-side on menus in bars and restaurants. In addition, as some of the goods in Mr Gracey's specification in class 33 are often served in combination with goods contained in Shaws' application (gin with tonic water for example) there is also an element of complementarity between the competing goods. Overall, I consider there to be a moderate degree of similarity between soft drinks (and preparations for making soft drinks) and alcoholic beverages in class 33.

20. Finally, I think I should treat "beverage ingredients for vending machines" in the same way I have treated the preparations for making the various drinks i.e. as highly similar on the basis that the ingredients could be used to make either low or non-alcoholic versions of the drinks contained in Mr Gracey's registration, or in respect of beer similar to a fairly high degree, and finally insofar as soft drinks are concerned, similar to a moderate degree.

Comparison of trade marks

21. The trade marks to be compared are: **ADRENALIN/ADRENALINE** and **ADRENALIN RUSH**.

22. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he/she rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he/she has kept in his/her mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

Distinctive and dominant components

23. In its counterstatement Shaws said:

“4.3 Moreover, ADRENALIN does not serve an independently distinctive role within the mark ADRENALIN RUSH, since ADRENALIN RUSH hangs together as a whole to create a different overall impression (*Medion*). The average consumer would not perceive the words ADRENALIN and RUSH separately and therefore would not see ADRENALIN RUSH and ADRENALIN as emanating from economically linked undertakings.”

24. In the case mentioned by Shaws above i.e. *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04, the ECJ said:

“29. In the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see *Matratzen Concord*, paragraph 32).

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.

34. This would be the case where, for example, the owner of a widely-known mark makes use of a composite sign juxtaposing this mark and an earlier mark which is not itself widely known. It would also be the case if the composite sign was made up of the earlier mark and a widely-known commercial name. In fact, the overall impression would be, most often, dominated by the widely-known mark or commercial name included in the composite sign.

35. Thus, contrary to the intention of the Community legislator expressed in the 10th recital in the preamble to the directive, the guarantee of the earlier mark as an indication of origin would not be assured, even though it still had an independent distinctive role in the composite sign.

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark. “

25. Mr Gracey's registration consists of a series of two trade marks. As the first trade mark in the series i.e. ADRENALIN is identical to the first word in Shaws' application, it is this trade mark which offers him the best prospect of success in these proceedings, and I shall conduct the comparison with that conclusion in mind. Mr Gracey's ADRENALIN trade mark is presented in upper case. As no part of the trade mark is highlighted or emphasised in any way there is no dominant element; the distinctiveness lies in the totality.

26. Shaws' application consists of the words ADRENALIN RUSH presented as separate words also in upper case. In their counterstatement Shaws argue that the word ADRENALIN does not play an independent distinctive role within their trade mark, as ADRENALIN RUSH hangs together as a totality. I have no evidence as to whether at the material date in these proceedings (March 2009) the phrase ADRENALIN RUSH would have been known to the average consumer of the goods at issue. However, on the basis that it was not, the totality the two words create leads to such an obvious and

unambiguous interpretation i.e. a rush of adrenalin, I agree with Shaws that the word ADRENALIN does not play an independent distinctive role within their trade mark. The distinctiveness of Shaws' trade mark lies in the totality.

Visual similarity

27. I have described the competing trade marks above. In its counterstatement Shaws said:

“4.1 The composite mark ADRENALIN RUSH, which would always be perceived as a whole, is visually dissimilar to ADRENALIN because it has two words, is a longer string, and contains the additional distinguishing element RUSH...”

28. While I agree that the word ADRENALIN does not play an independent distinctive role within Shaws' trade mark, consisting as it does of the first word of Shaws' trade mark and the only element in Mr Gracey's trade mark, results, in my view, in a reasonable degree of visual similarity between them.

Aural similarity

29. In its counterstatement Shaws said:

“4.1 For similar reasons ADRENALIN RUSH is phonetically dissimilar to ADRENALIN and, moreover, the distinctive sound of the word RUSH predominantly resonates in the mind of the consumer. Thus there are clear visual and phonetic dissimilarities between the respective marks, creating a different overall impression.”

30. Mr Gracey's trade mark consists of one word with four syllables; Shaws' trade mark consists of two words containing four and one syllable respectively. While there are clearly differences, once again the presence of the word ADRENALIN as the first word in both trade marks leads, in my view, to a reasonable degree of aural similarity between them.

Conceptual similarity

31. In its counterstatement Shaws said:

“4.2 Clear conceptual differences between the respective marks also create a different overall impression, as the fanciful term ADRENALIN RUSH evokes a sense of danger and/or exhilaration whereas ADRENALIN is a comparatively bland term which does little to capture the imagination of the average consumer.”

32. In my view the word ADRENALIN is (as the Oxford Dictionary of English explains) likely to be well known to the average consumer as a reference to the hormone secreted by the adrenal glands that increases rates of blood circulation, breathing, and

(less likely I think) carbohydrate metabolism which prepares muscles for exertion; it is this image which Mr Gracey's trade mark is likely to conjure up in the mind of the average consumer. The combination ADRENALIN RUSH (whether known as a phrase in its own right or not), is likely to evoke in the mind of the average consumer an image of a release (rush) of adrenalin. The fact that both trade marks contain the word ADRENALIN, combined with the meaning Shaws' trade mark is likely to convey to the average consumer, results, in my view, in quite a high degree of conceptual similarity between them.

Distinctive character of Mr Gracey's earlier trade mark

33. I must now assess the distinctive character of Mr Gracey's earlier trade mark. The distinctive character of a trade mark must be appraised first by reference to the goods in respect of which it has been registered and, second, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. As mentioned above, the word ADRENALIN is well known as is its meaning. However, as far as I am aware it has no descriptive meaning for the goods for which it stands registered, nor is it non-distinctive. Whilst not in the category of an invented word, and in the absence of any evidence attesting to the use that may have been made of it, it is, in my view, a trade mark possessed of a reasonable level of inherent distinctive character.

Likelihood of confusion

34. In determining whether there is a likelihood of confusion, I need to bear a number of factors 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. It is also necessary for me to consider the distinctive character of Mr Gracey'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/she has retained in his/her mind.

35. Earlier in these proceedings I concluded that the competing goods were either identical (in respect of the class 33 element of Shaws' application), or were highly or moderately similar in respect of the goods contained in class 32 of the application. In addition, having identified the distinctive and dominant elements of the competing trade marks, I concluded that there was a reasonable degree of both visual and aural similarity and quite a high degree of conceptual similarity; I also found that Mr Gracey's

trade mark was possessed of a reasonable level of inherent distinctive character. Applying these conclusions to the matter at hand, I have come to the conclusion that there is a likelihood that Shaws' trade mark will be confused with the trade mark of Mr Gracey. While the differences in the respective trade marks may (and I put it no higher than that) be sufficient to avoid direct confusion (i.e. where one trade mark is mistaken for the other), I have little doubt that the average consumer will assume, given the presence of the word ADRENALIN in each trade mark and the similar conceptual messages the competing trade marks will convey to them, that Shaws' trade mark is being used by an undertaking economically linked to Mr Gracey i.e. there will be indirect confusion, and the opposition based upon section 5(2)(b) of the Act succeeds accordingly.

Costs

36. As Mr Gracey has been successful, he is entitled to a contribution towards his costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide, I award costs to Mr Gracey on the following basis:

Preparing a statement and considering Shaws' statement:	£200
Official fee:	£200
Total:	£400

37. I order Shaws Drinks Company Limited to pay to Nicholas Dynes Gracey the sum of **£400**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 02 day of June 2011

C J BOWEN
For the Registrar
The Comptroller-General