

O-328-13

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 2619760**

**BY**

**JW FOODS LTD**

**TO REGISTER THE TRADE MARK**

**STALLION ENERGY DRINK**

**IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**


**UNDER NO 103775**

**BY**

**TONY BASRA**

## BACKGROUND

- 1) On 02 May 2012, JW Foods Ltd ('JW') applied to register the trade mark 'STALLION ENERGY DRINK' in respect of 'Energy drinks' in class 32.
- 2) The application was published on 06 July 2012 in the Trade Marks Journal and notice of opposition was subsequently filed by Mr Tony Basra. Mr Basra claims that the application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act').
- 3) One earlier UK trade mark registration is relied upon, details of which are as follows:

Mark details	Goods relied upon
<p data-bbox="204 712 571 745"><b>UK trade mark: 2604248</b></p> <p data-bbox="245 824 730 907"><b><i>DOUBLE STALLION</i></b></p>  <p data-bbox="204 1249 667 1283"><b>Filing date: 13 December 2011</b></p> <p data-bbox="204 1328 783 1393"><b>Date of entry in the register: 30 March 2012</b></p>	<p data-bbox="815 712 1382 891"><b><i>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.</i></b></p>

- 4) The earlier mark has a filing date of 13 December 2011 and completed its registration procedure on 30 March 2012. The consequences of these dates are, in relation to JW's mark, that i) Mr Basra's registration is an earlier mark in accordance with section 6 of the Act and ii) it is not subject to the proof of use conditions contained in section 6A of the Act.

- 5) JW filed a counterstatement in which it stated the following:

*We disagree with the objector's argument that their brand and ours are over similar, and therefore would confuse the public.*

*Our brand is for a single product i.e. "Stallion energy drink", whereas the objector's brand mark relates to a range of products, i.e. "Double Stallion" this, that or the other. As you can see from the example copied on the following page, our logo is of a completely different design. [see directly below]*

16.9 Ounces



Carbonated Soft Drink 500ml (16.9 Oz. Fl.)

*There are a number of different companies producing drinks with the word stallion in their registered brand names and we do not believe our brand name would cause any more confusion than those.*

6) Neither party filed evidence or submissions during the evidential rounds; nor did either party request to be heard or file submissions in lieu. I therefore make this decision after conducting a thorough review of the papers and giving full consideration to the respective submissions made in the notice of opposition and counterstatement. I will refer to specific submissions as, and when, I consider it appropriate.

## **DECISION**

### **Section 5(2)(b)**

7) This section of the Act states:

*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.*

8) The leading authorities which guide me are from the Court of Justice of the European Union (CJEU): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. It is clear from these cases that:

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

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

(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*,

(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*,

(e) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*,

(f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*,

(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.*,

(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; *Sabel BV v Puma AG*,

(i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*,

(j) 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*,

(k) 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 and Adidas Benelux BV*,

(l) 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.*

### **Comparison of goods**

9) The General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05 held:

*29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark*

10) In the instant case, the goods to be compared are:

<b>Mr Basra's goods</b>	<b>JW's goods</b>
<b>Class 32:</b> 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.	<b>Class 32:</b> Energy drink

11) Mr Basra's 'non-alcoholic drinks' is a broad term; it covers a wide variety of non-alcoholic beverages, including 'Energy drinks'. It follows that, in accordance with the *Meric* principle, the respective goods are identical.

### **Average consumer and the purchasing process**


12) It is necessary to consider these matters from the perspective of the average consumer of the goods at issue (*Sabel BV v.Puma AG*). The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect, but his/her level of attention is likely to vary according to the category of goods.

13) The goods at issue in the instant case will be purchased by the general public. They are those which are low cost and are likely to be bought on a fairly regular basis and, in my view, may be described as an impulse purchase. For these reasons, it is likely that a low degree of attention will be afforded during the selection process. The selection is likely to take place 'off the shelf' from retail establishments and therefore the purchase is likely to be mainly visual. However, I bear in mind that, on occasion, the goods may be requested orally in public houses, for example, and therefore aural considerations will also be given due regard in my considerations.

### **Comparison of marks**

14) In its counterstatement JW has referred to, and provided an image of, "our logo which is of a completely different design [to Mr Basra's]". However, the "logo", visible at paragraph 5 of this decision, is not the mark which is the subject of the trade mark application in the instant case and therefore cannot play a part in my considerations. In approaching the assessment of similarity of the marks and likelihood of confusion,

I must do so on the basis of the mark, as applied for, as shown in the table below. Accordingly, the respective marks to be compared are:

Mr Basra's mark	JW's mark
<p data-bbox="359 369 678 425" style="text-align: center;"><b>DOUBLE STALLION</b></p> 	<p data-bbox="853 459 1348 492" style="text-align: center;"><b>STALLION ENERGY DRINK</b></p>

15) The average consumer normally perceives a mark as a whole and does not proceed to analyse its details. The visual, aural and conceptual similarities 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*). Accordingly, there cannot be an artificial dissection of the marks, although, it is necessary to take into account any distinctive and dominant components.

16) In JW's mark, the words 'ENERGY DRINK' are neither a distinctive nor dominant element due to their wholly descriptive nature and positioning within the mark. It is the word 'STALLION', by virtue of its distinctiveness and prominent position at the beginning of the mark, which is both dominant and distinctive.

17) In Mr Basra's mark the image of two horses and the phrase 'DOUBLE STALLION' are both distinctive elements. 'DOUBLE STALLION' is prominently positioned at the top of the mark and presented in bold. The image of two horses is positioned below the words; it takes up a substantial proportion of the mark and is also boldly presented. To my mind, both the words and the image strike the eye together and neither dominates the mark more than the other.

18) There is a clear point of visual coincidence between the marks owing to the presence of the word 'STALLION' in both in a very similar font. The other words in the respective marks (DOUBLE/ENERGY DRINK) are clearly different and Mr Basra's mark contains an image of two horses which is absent from JW's mark. Taking into account all of the aforementioned similarities and differences, and viewing the marks as wholes, I find there to be a reasonable degree of visual similarity.

19) As the average consumer is unlikely to attempt to vocalise the image in Mr Basra's mark and, owing to the presence of the word 'STALLION' in both marks, there is, in my view (notwithstanding that each mark contains other additional word(s) which are absent from the other) a good degree of aural similarity.

20) Turning to the conceptual aspect of the comparison, Collins English Dictionary defines 'STALLION' as 'an uncastrated male horse, especially one used for breeding'.<sup>1</sup> I think it likely that the average consumer will know that a Stallion is a

<sup>1</sup> 'stallion' 2000, in *Collins English Dictionary*, Collins, London, United Kingdom, viewed 24 July 2013, <from <http://www.credoreference.com/entry/hcengdict/stallion>>

male horse. However, even if I am wrong, it is still likely that they will nonetheless know that it is a certain *type* of horse. Bearing this in mind, Mr Basra's mark, in its totality, is likely to evoke the idea of two horses, of the same type. JW'S mark is likely to evoke the concept of a single horse, of the same type as in Mr Basra's mark (the words 'ENERGY DRINK' do not come into play as they are, as I have already stated, wholly descriptive of the goods). There is a high degree of conceptual similarity.

### **Distinctive character of the earlier mark**

21) I must consider the distinctive character of the earlier mark. The distinctive character of a trade mark must be assessed by reference to the goods or services for which it is registered and by reference to the way it is perceived by the relevant public (*Rewe Zentral AG v OHIM (LITE) Case T-79/00 [2002] ETMR 91*). As no evidence of use has been filed by Mr Basra, I have only the inherent level of distinctiveness to consider.

22) Both elements in Mr Basra's mark are distinctive, with neither describing nor alluding to the goods covered by his registration, and it follows that the mark as a whole is possessed of a good level of inherent distinctive character.

### **Likelihood of confusion**

23) In deciding whether there is a likelihood of confusion I must take account of all of the above factors. I must also keep in mind the following:

- i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*);
- ii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V*), and;
- iii) the principle that the more distinctive Mr Basra's mark is, the greater is the likelihood of confusion (*Sabel BV v Puma AG*).

24) As I indicated earlier, in its counterstatement JW states, inter alia, the following:

*There are a number of different companies producing drinks with the word stallion in their registered brand names and we do not believe our brand name would cause any more confusion than those.*

25) JW has provided no evidence showing the nature and scale of use in the marketplace of the 'brand names' to which it refers and there is also no evidence to show what the relevant consumer's perception of any such use may be. As a consequence of JW's assertion not being supported by any evidence, it fails to convince me that the position in the market has any impact on my considerations regarding whether or not there is a likelihood of confusion between the respective trade marks.

26) I have found there to be identity between the respective goods and that the average consumer will primarily be the general public who will pay a low degree of attention during the mainly visual purchasing act. However aural considerations must also be given due regard in my considerations for the reasons already given. As regards the marks themselves, I have found that they share a reasonable degree of visual similarity, a good degree of aural similarity and a high degree of conceptual similarity. I have also found that the earlier mark is possessed of a good degree of inherent distinctive character.

27) There are two possible types of confusion which may occur. These are direct and indirect confusion. Direct confusion occurs where one mark is mistaken for the other because the average consumer thinks they are the same. Indirect confusion occurs when the average consumer will realise that the marks are not the same but will nonetheless assume, in light of the similarities between them, that the respective goods emanate from the same, or economically linked, undertaking(s). I must consider the likelihood of both types of confusion.

28) I will deal firstly with the likelihood of direct confusion. Drawing all of the above findings together I find that, even allowing for the factor of imperfect recollection, and bearing in mind that the purchasing act is likely to be mainly visual, the similarities between the marks are not great enough to result in a likelihood that one mark will be mistaken for the other. There is not a likelihood of direct confusion.

29) I must now turn to consider whether there is nonetheless a likelihood of indirect confusion. In this regard, I bear in mind, in particular, that the respective goods are identical, that Mr Basra's mark is possessed of a good degree of distinctive character and that there is a high degree of conceptual similarity between the marks, with both evoking the idea of the same type of horse(s). In light of the aforesaid and having weighed all relevant factors, I conclude that the similarities between the marks are sufficient to give rise to a likelihood of indirect confusion. That is to say that there is a likelihood that the average consumer will assume that the respective goods emanate from the same or economically linked undertaking(s).

**Mr Basra's opposition succeeds.**

## **COSTS**

30) Mr Basra has been successful and is entitled to an award of costs. I award costs on the following basis:

Preparing notice of opposition and considering a counterstatement:	£200
Opposition fee:	£200
<b>Total:</b>	<b>£400</b>



31) I order JW Foods Ltd to pay Mr Tony Basra 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 13<sup>th</sup> day of August 2013**

**Beverley Hedley  
For the Registrar,  
the Comptroller-General**