

O-412-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3024251
BY
MAXICORP LIMITED**

TO REGISTER THE TRADE MARK

Eisenberg

IN CLASSES 5 AND 32

AND

**THE OPPOSITION THERETO
UNDER NO 60000075
BY
HALEWOOD INTERNATIONAL BRANDS LIMITED**

BACKGROUND

1. On 1 October 2013, Maxicorp Limited (the applicant) applied to register the trade mark: **Eisenberg** in classes 5 and 32 of the Nice Classification system.¹ The specification stands as follows:

Class 5

Protein based drinks for sports nutrition.

Class 32

Protein based fruit drinks; calorie controlled and calorie reduced beverages; energy drinks; none being derived from grapes or wine.

2. The application was published on 15 November 2013. Halewood International Brands Limited (the opponent) filed notice of opposition against the application, on 17 February 2014, under the fast track opposition procedure.

3. The opposition was brought under section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon UK trade mark 1310544, shown below:

Mark details and relevant dates	Goods relied on
<p>Mark:</p> <p>EISBERG</p> <p>Filing date: 20 May 1987</p> <p>Date of entry in the Register: 19 April 1991</p>	<p>Class 32</p> <p>De-alcoholised wines included in Class 32.</p>

4. Rule 17A(7) of the Trade Marks Rules 2008 (as amended by the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013) (the Rules) states as follows:

(7) Where the earlier mark is subject to proof of use under section 6A of the Act, the proof of use that the opponent wishes to rely upon shall be provided with the notice of fast track opposition.

5. The opponent's earlier mark is subject to proof of use and evidence was provided with the notice of opposition.

6. On 7 May 2014, the applicant filed a counterstatement, denying the ground of opposition.

7. Rules 20(1)-(3) of the Rules (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:

¹ *International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).*

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

8. The net effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions.

9. No leave was sought in respect of these proceedings.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if 1) the Office requests it or 2) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise written arguments will be taken.

11. A hearing was neither requested nor considered necessary. The opponent filed written submissions, which I will refer to as necessary, below.

12. I give this decision following a review of all of the material before me.

The opponent’s evidence of use

13. The opponent’s evidence of use is provided by Simon John Oldroyd, its Commercial Director. Four exhibits are attached to his witness statement:

14. Exhibit 1 consists of invoices showing sales of Eisberg products between 2008 and 2013. Mr Oldroyd describes them as sample invoices and states that more are available on request. The products are listed on the invoices as ‘Eisberg’ followed by a description such as, inter alia, Rosé, Chardonnay, Reisling. They are dated between 30 December 2008 and 19 April 2013. The sales amounts on the invoices which relate to Eisberg goods vary from £366.30 to £5,400.

15. Exhibit 2 comprises copies of labels from a range of Eisberg products. Eight pages are provided which have copies of wine bottle labels shown. Each displays the mark as follows:

EISBERG®

16. The words ‘ALCOHOL FREE WINE’ are placed below the mark with a description of the wine, such as Chardonnay and an amount of calories. The labels for the back of the bottles include a list of ingredients, nutritional information and a calorie total per 100ml as well as a description of the wine’s flavour. The labels are not dated and it is not clear during which period they were used.

17. Exhibit 3 consists of prints from Eisberg’s website. The first is a photograph of four bottles of wine. The first bottle is larger than the other three. The mark EISBERG can be seen on each label as well as the words ‘ALCOHOL FREE WINE’. The print is of poor quality so it is not possible for me to read the remaining information. The labels look to be a similar style to those shown in the previous exhibit. The page was printed on 14 February 2014, outside the relevant period and is otherwise undated. The second page is titled, ‘Going Alcohol Free Might Be A Lifestyle Choice Or Medical Necessity. But It’s No

Reason To Give Up Your Favourite Wines'. The page includes a photograph of four bottles of wine and a photograph of the side view of a pregnant woman. The remaining pages show a list of a few EISBERG wines with a description and a link to find out where to buy them. A link is also provided to contact EISBERG with questions.

18. Exhibit 4 comprises prints of website pages from supermarkets which stock the opponent's goods. All of the pages were printed on 14 February 2014, after the relevant period and is otherwise undated. The first is from *Morrisons* and shows a bottle of white wine. The label is the same as those shown earlier for EISBERG alcohol free wines. The variety cannot be read from the bottle but the description states that it is Chardonnay. The second page is from *Waitrose*. The bottle cannot be seen due to the quality of the copy and there is no description. The page heading shows 'Eisberg White 0.05% Riesling Germany – *Waitrose*'. The third page is from *Tesco* and shows a promotion to save 50p on bottles of EISBERG alcohol free wine as part of a campaign by the British Liver Trust. The earlier mark is shown as follows:



19. The fourth page is taken from *Waitrose*. The bottle cannot be seen clearly but the description alongside it refers to 'Eisberg White 0.05% Riesling Germany'. As far as I can tell, the mark looks to be presented in the same way as shown in the Tesco promotion, shown at paragraph 18, above.

20. Mr Oldroyd also provides sales figures as follows:

Year	No. of cases	Sales value (£)
2009	48,610	524,531
2010	126,370	1,373,638
2011	124,579	1,356,338
2012	104,962	1,140,804
2013	96,439	1,076,033

21. This concludes my summary of the evidence.

Proof of use

22. As stated above, the earlier mark is subject to proof of use.

23. Section 6A of the Act reads as follows:

"6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

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

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

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

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

(7) Nothing in this section affects –

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

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

24. The relevant period is the five year period ending on the date of publication of the application, namely 16 November 2008 to 15 November 2013. The onus is on the opponent, under section 100 of the Act, to show genuine use of its mark during this period in respect of those goods relied on.

25. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use.

26. The requirements for “genuine use” have been set out by the Court of Justice of the European Union (CJEU) in its judgments in *Ansul BV v Ajax Brandbeveiliging BV*, Case C-40/01 [2003] RPC 40 and *Silberquelle GmbH v Maselli-Strickmode GmbH* Case C495/07, [2009] ETMR 28 and by the Court of Appeal in the UK in *LABORATOIRE DE LA MER Trade Mark* [2006] FSR 5. In *Stichting BDO and others v BDO Unibank, Inc and others* [2013] EWHC 418 (Ch) Arnold J commented on the case law of the CJEU in relation to genuine use of a trade mark:

‘In *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] Anna Carboni sitting as the Appointed Person set out the following helpful summary of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli Strickmode GmbH* [2009] ECR I-2759 (to which I have added references to Case C-416/04 P *Sunrider v OHIM* [2006] ECR I-4237):

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

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

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

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

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

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

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

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

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

27. I must decide if the mark has been genuinely used as per the above case-law. The opponent’s unchallenged sales figures show a level of sales which are by no means insignificant and demonstrate a consistent frequency of activity throughout the relevant period. The invoices (which used the word Eisberg) show sales to five areas of the UK. The evidence shows the mark in the forms I have reproduced above at paragraphs 15 and 18. The mark is also shown, throughout the evidence, in upper case. It is presented in black on a light background. Two different typefaces are used, both of which are not out of the ordinary. The evidence in totality demonstrates that the Eisberg mark has been genuinely used in the relevant period.

28. The earlier mark is registered for “de-alcoholised wines” in class 32. The goods upon which the mark is used are described in the evidence as “alcohol free wines”, which seems to me to be just an alternative form of terminology. The mark may be relied upon for the specification as registered.

DECISION

29. The opposition is brought under 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.”

Section 5(2)(b) case law

30. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

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; *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-6/01; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04; *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P.

The principles

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

The average consumer and the nature of the purchasing act

31. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average

consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

32. The average consumer is a member of the general public. The goods are made available through a variety of trade channels. They may be bought in a shop, supermarket or off-licence and in the case of some of the applicant's goods, a gym or health food shop. The selection is likely to be made by the consumer from a shelf or from a website or mail-order catalogue, where the consumer will also select the goods visually. They may also be sold through bars, clubs and public houses, where the goods may be requested orally, from a member of staff. In considering this point I bear in mind the comments of the Court of First Instance (now the General Court) in *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* (OHIM)² when it said:

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

33. Consequently, even though the purchase of these goods in a bar may involve an aural element, the selection will be made, primarily, from the display of goods on shelves, in fridges and on optics at the back of the bar. Accordingly, the purchase of such goods is primarily visual, though I do not discount an aural element. The level of attention paid to the opponent's de-alcoholised wines is likely to be reasonable. The applicant's goods (in particular those in class 5) may also be bought in gyms and health stores. In the case of protein based sports drinks in class 5, these are likely to be used as part of a wider fitness program and may require a reasonable level of attention to be paid to the purchase. In any event the level of attention paid will be that necessary to achieve inter alia, the correct flavour/variety and possibly nutritional content. Accordingly, the average consumer will pay a reasonable level of attention.

Comparison of goods

34. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>Class 32</p> <p>De-alcoholised wines.</p>	<p>Class 5 - Protein based drinks for sports nutrition.</p> <p>Class 32 - Protein based fruit drinks; calorie controlled and calorie reduced beverages; energy drinks; none being derived from grapes or wine.</p>

² T-3/04

35. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

“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.”

36. In *Proctor & Gamble Company v Simon Grogan*, O-176-08, Anna Carboni, sitting as the appointed person, referred to *Caremix*³ and said:

“32. The International Classification system also applies to Community trade marks. Rule 2(4) of Commission Regulation 2868/95/EC implementing the Regulation on the Community trade mark (40/94) states as follows:

(4) The classification of goods and services shall serve exclusively administrative purposes. Therefore, goods and services may not be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, and goods and services may not be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

33. It is thus made plain under the Community trade mark system that class numbers are irrelevant to the question of similarity of goods and services.

34. There is no similarly plain provision in the Act or the Directive. The Court of Appeal has held that, although the purpose of classifying goods and services is primarily administrative, that does not mean that the class numbers in an application have to be totally ignored in deciding, as a matter of construction, what is covered by the specification: *Altecnic Ltd's Trade Mark Application (CAREMIX)*⁴. But neither the Court of Appeal, nor the ECJ, nor any other court or tribunal in the United Kingdom, has gone so far as to state that class numbers are determinative of the question of similarity of goods in the case of national trade marks. On the contrary, they are frequently ignored.”

37. I also bear in mind the views of Neuberger J in *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267, where he stated:

“I should add that I see no reason to give the word "cosmetics" and "toilet preparations" or any other word found in Schedule 4 to the Trade Mark Regulations 1994 anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context. In particular, I see no reason to give the words an unnaturally narrow meaning simply because registration under the 1994 Act bestows a monopoly on the proprietor.”

38. With regard to interpreting terms in specifications, I will bear in mind the guidance provided in *Treat*:

³ *Altecnic Ltd's Trade Mark Application (CAREMIX)* [2002] R.P.C. 639

⁴ *Ibid*

In “construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”. Words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning.”

39. And in *YouView TV Ltd v Total Ltd* when⁵ Floyd J said:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

40. Factors which may be considered include the criteria identified in *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281 (hereafter *Treat*) for assessing similarity between goods and services:

- (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 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, taking into account how goods/services are classified in trade.

41. And the comments of the CJEU in *Canon* in which it stated, at paragraph 23 of its judgment:

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

⁵ [2012] EWHC 3158 (Ch) at [12]

42. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi [2005] ECR II-685)”

43. With regard to the applicant's goods in classes 5 and 32 the opponent states:

“The goods of the application are all non-alcoholic drinks. The applicant qualifies the goods with various descriptors: “protein based”, “calorie controlled”, “calorie reduced”, “energy”, and further qualifies the Class 32 goods by stating that none are derived from grapes or wine. Even with these qualifications, the goods are still non-alcoholic drinks. Taking into account the well-established principles of comparison of goods, we submit that the goods of the application are all similar with the opponent's goods, de-alcoholised wines. Their nature is the same, being non-alcoholic; their use is the same, as they are consumed for refreshment and hydration; their users are the same, being consumers of non-alcoholic drinks; their trade channels are the same, as producers of de-alcoholised wines also produce other non-alcoholic drinks...and supply their ranges to the same retailers. Furthermore, the goods are displayed in the same section of retail outlets, namely the drinks section. The goods are also in competition, as a consumer looking for a non-alcoholic or soft drink will consider a wide variety of types of drink, including waters, fruit juices, cordials, protein based drinks, energy drinks, low calorie drinks and de-alcoholised wines. All these types of product compete with each other.”

Class 5 goods

44. The applicant states:

“...The only similarity is that they are liquids which are drunk but it is clear that if one characterises the respective nature of the products they are completely different...The respective goods are drunk for different purposes – people will not drink protein drinks for sports nutrition instead of de-alcoholised wines and vice versa. Wine and de-alcoholised wine products are not drunk for sports nutrition purposes...The composition of the products is different; the products would neither compete nor be considered complimentary [sic]. We submit that de-alcoholised wines are essentially an alternative only to wines...It is submitted that no reliance should be placed on the fact that the respective goods would be sold in the same outlets because modern supermarkets and other outlets sell goods of all kinds. The relevant public is aware that the goods sold in these places come from a multitude of independent undertakings.

In its Statement of Case...the opponent merely submits that the respective products are sold in the “drink's section” in retail outlets. The position is clearly that de-alcoholised wines are sold alongside wines and the applicant's products set out in the heading above would be sold in a different section

In relation to the goods in class 5 it is submitted that the respective goods are drunk for different purposes and the average consumer would not expect sports nutrition protein drinks to be produced by the same manufacturer as the producer of non-alcoholic wines; they fall into different markets and would be sold in different places and typically at different price points. We submit that it is difficult to conceive of a situation in which the average consumer will intend to purchase a protein drink for sports nutrition and instead purchase de-alcoholised wine. The goods are not similar.”

45. The users of the applicant's goods in class 5 will, at the highest level, be the same as those purchasing the opponent's de-alcoholised wines in class 32 to the extent that both may be bought by members of the general public. However, the applicant's goods will be bought with sports nutrition in mind, rather than as 'a drink' in its own right.

46. The uses of the parties' goods are different as the applicant's protein based drinks will be purchased for a nutritional purpose, for example, to aid muscle growth and/or provide energy, whereas the purchase of the opponent's goods is an end in itself, to enjoy the drink, possibly in a social setting.

47. The applicant's goods will be made available in packaging which will make them convenient to drink, more than likely in bottles, cartons or cans or in powder form, to be mixed with water. The opponent's goods are more likely to be sold in larger bottles (as is the case with wine containing alcohol) to be poured into a glass or other drinking vessel.

48. The trade channels for the respective goods are different. While they may both be available from a large supermarket this is not sufficient to indicate similar channels of trade. The opponent's goods are likely to be sold in close proximity to their alcoholic counterparts while the applicant's goods of the type in class 5 are likely to be sold in a pharmaceutical or health and fitness area of a supermarket.

49. The goods are neither in competition or complimentary. These are dissimilar goods.

Class 32 goods - Protein based fruit drinks; energy drinks, none being derived from grapes or wine.

50. The applicant says of these goods:

“...all of the arguments set out in relation to the applicant's goods in class 5 above apply equally in relation to the above goods in class 32 because the principles are the same for these drinks. This would be the case even if the goods in class 32 were not further qualified by the exclusion, “none being products derived from grapes or wine”.

51. Protein based fruit drinks and energy drinks may be bought for their primary purpose of providing protein and/or energy, rather than to be enjoyed as drinks in their own right. However, they may also be selected as soft drinks, consumed for taste or may be used as mixers with alcohol. The trade channels are unlikely to coincide as de-alcoholised wines are specific products which offer an alternative to wine containing alcohol. They are unlikely to be displayed cheek by jowl with protein or energy drinks. The goods are not in competition and are not complementary. Consequently, I find these to be dissimilar goods.

The remaining class 32 goods

52. The applicant states:

“The applicant’s submissions in relation to these goods are principally the same as the applicant’s other goods. However, as part of the process of the de-alcoholisation of wine, the resulting product contains less calories than wine which has had some of the alcohol taken out. The applicant submits that this fact is irrelevant for the purposes of this opposition.”

53. The opponent says:

“We submit that the inclusion of the qualification “none being derived from grapes or wine” in class 32 of the application is not sufficient to render the goods different from the opponent’s goods. It is true that the opponent’s goods are derived from grapes and wine, however, the opponent’s goods are also low calorie drinks. The consumer will not, in general, consider the basis of a soft drink when making a purchasing decision, instead they base their decision on flavor type and cost. For consumers, de-alcoholised wine may replace ordinary fruit drinks, fruit juices and other soft drinks as an alternative, especially on occasions when the consumer cannot temporarily consume alcohol, and vice versa. De-alcoholised wines and the goods of the application are to a large degree interchangeable and in competition.”

54. Calorie controlled and calorie reduced beverages cover a large number of products which could include calorie reduced, de-alcoholised wines of the type included in the opponent’s specification. In accordance with *Meric* these are identical goods.

55. To the extent that there may be other goods included within the opponent’s specification which are not necessarily low calorie I will go on to consider these in more detail. There is a degree of overlap between the users and uses of these goods where the average consumer may be selecting a beverage as an alternative to an alcoholic drink. In these circumstances one may be presented with a range of soft drinks both in standard and low calorie versions as well as low and non-alcoholic versions of drinks which also have an alcoholic counterpart. The nature of the goods may differ, de-alcoholised wines being sold in wine bottles, whereas low calorie beverages are often made available in cans or bottles. Though in my experience drinks which can be drunk on their own or as mixers are often sold in larger bottles and are poured into glasses in the same way as a de-alcoholised wine would be.

56. The applicant’s goods will not necessarily be presented in similar areas of stores and websites to the opponent’s goods, as low calorie beverages include a wide range of products which may include goods such as ready mixed coffee drinks. However, since the application may also include low calorie alternatives to other class 32 goods such as beers, they may be available in close proximity to one another. In my experience, mixers such as slimline tonic are also available alongside other low alcohol goods.

57. Some of these goods are in competition with one another. A consumer seeking an alternative to an alcoholic drink may choose a low alcohol wine, slimline tonic, diet cola or any number of other beverages included within this class.

58. The goods are not complimentary.

59. Given the range of goods which could be included within the terms calorie controlled and calorie reduced beverages, there are some which are clearly similar, such as, inter alia, other de-alcoholised goods, low calorie beers. As well as goods which are not similar such as low calorie coffee drinks.

Comparison of marks

60. The marks to be compared are as follows:

The opponent's mark	The applicant's mark
Eisenberg	EISBERG

61. In making a comparison between the marks, I must consider the respective marks' visual, aural and conceptual similarities with reference to the overall impressions created by them, bearing in mind their distinctive and dominant components⁶, but without engaging in an artificial dissection of the marks, because the average consumer normally perceives a mark as a whole and does not analyse its details.

62. The opponent's mark consists of the plain word 'Eisenberg'. It is presented in plain type in title case and is not stylised in any way. The distinctiveness lies in the mark as a whole.

63. The applicant's mark consists of the plain word 'EISBERG'. It is presented in plain type in upper case and is not stylised in any way. The distinctiveness lies in the mark as a whole.

Similarity of the marks

64. The opponent states that the marks are highly similar:

"The only difference between the two marks is the inclusion of two additional letters, EN, in the centre of the applicant's mark. We submit that the inclusion of these two letters is not sufficient to render the marks sufficiently distinct for confusion not to be likely. The marks are similar visually and phonetically. In conceptual terms, neither mark has any particular meaning to the UK consumer".

65. The applicant states:

"It is denied that the marks are similar. The average consumer normally perceives marks as a whole and the two additional letters in the middle of the word "EisENberg" and the ensuing additional syllable render the marks

⁶ *Sabel v Puma AG, para.23*

sufficiently distinct on a visual and phonetic basis. Similarly on a conceptual basis “eisberg” brings to mind the word “iceberg”. It is admitted that the word “EISENBERG” has no particular meaning to the average UK consumer in relation to the applicant’s goods.”

66. The marks begin and end with the same combinations of three and four letters respectively. The applicant’s mark has an additional ‘EN’ in the middle. The marks are visually and aurally highly similar.

67. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁷ The assessment must be made from the point of view of the average consumer. I do not agree with the applicant that the opponent’s mark will bring the word ‘iceberg’ to mind. Both marks may be seen as place names or surnames, but more likely, in my view, is that neither mark will give a definite conceptual meaning to the average UK consumer. The marks are conceptually distinct.

Distinctive character of the earlier mark

68. In determining the distinctive character of a trade mark it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify its goods 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.

69. As I have concluded above, the opponent’s mark will not convey a clear conceptual message to the average consumer. Consequently, it is neither descriptive nor elusive of the goods at issue and enjoys a high level of inherent distinctive character.

70. This is a case where evidence of use was required for proof of use purposes; however, given my findings above with regard to this evidence, although it is a used mark, I am unable to conclude that the opponent’s earlier mark has enhanced its distinctive character, above its already high level of inherent distinctive character, due to the use made of it.

Likelihood of confusion

71. In assessing the likelihood of confusion, I must adopt the global approach advocated by case-law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁸ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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.

72. Earlier in this decision I concluded that the marks share a high degree of visual and aural similarity and are conceptually distinct. I have found the earlier mark to have a high level of inherent distinctive character. I have found the applicant’s goods in class 5 to be dissimilar to the opponent’s goods in class 32. I have also found ‘protein based fruit drinks’ and ‘energy drinks’ in class 32 of the application to be dissimilar to the opponent’s goods

⁷ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

⁸ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

in class 32. Consequently, for these goods there can be no likelihood of confusion as per the judgment in *Waterford*.⁹

CONCLUSION

73. The opposition fails under section 5(2)(b) of the Act in respect of:

Class 5 – Protein based drinks for sports nutrition

Class 32 – Protein based fruit drinks and energy drinks

Revised specification

74. ‘Calorie controlled and calorie reduced beverages’ in class 32, include some goods which will lead to a likelihood of confusion but some goods which will not. In the circumstances, in accordance with TPN 1/2012, paragraph 3.2.2, I invite the applicant to file a revised specification and accompanying submissions detailing any types of goods it wishes to register that:

- a) Fall within the ambit of “calorie controlled and calorie reduced beverages”;
- b) Fall within the scope of this decision in that the goods so specified have no similarity to ‘de-alcoholised wines’;
- c) Do not fall foul of the guidance issued by the CJEU in the *Postkantoor*¹⁰ decision;

75. The applicant’s written submissions should explain why it considers the terms to be within the scope of my decision. A period of 14 days from the date of this decision is permitted for such action. Upon receipt of the above, the opponent will be allowed 14 days to comment on any proposed terms and I will then issue a supplementary decision in which I will decide whether any proposed terms are free from objection. If the applicant puts forward no revised terms then I will issue a supplementary decision confirming that the broad term ‘calorie controlled and calorie reduced beverages’ may include services which are the same or similar as those contained in the opponent’s specification. Consequently, there will be a likelihood of confusion.

76. The appeal period for the substantive and supplementary decisions will run from the date of the supplementary decision which will also include a decision on costs.

Dated this 29th day of September 2014

**Ms Al Skilton
For the Registrar,
The Comptroller General**

⁹ *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

¹⁰ *CJEU case C-363/99*