

**O-534-15**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO 3097827  
BY  
WICKED HATHERN BREWERY LIMITED  
TO REGISTER THE TRADE MARK**


**Route 46**

**IN CLASS 32**

**AND  
OPPOSITION 60000264 THERETO  
BY  
LODESTAR ANSTALT**

## BACKGROUND

1. On 6 March 2015, Wicked Hathern Brewery Limited (the Applicant) applied to register the mark 'Route 46' for Beer in Class 32.
2. The application was published on 27 March 2015, following which Lodestar Anstalt (the Opponent) filed notice of opposition 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 all the goods in Community Trade Marks 11404605 (the Opponent's word mark) and 11598778 (the Opponent's figurative mark), shown below:

Mark details and relevant dates	Goods relied upon
<p><b>Mark:</b></p> <p>Route 66</p> <p><b>Filing date:</b> 6 December 2012</p> <p><b>Registration date:</b> 7 May 2013</p>	<p><b>Class 32</b> Non-alcoholic beverages; soft drinks; mineral water; preparations for making beverages; beers; lagers; non-alcoholic beers; non-alcoholic lagers; preparations for making beers, lagers, non-alcoholic beers and non-alcoholic lagers.</p>
<p><b>Mark:</b></p>  <p><b>Filing date:</b> 22 February 2013</p> <p><b>Registration date:</b> 3 July 2013</p>	<p><b>Class 32</b> Non-alcoholic beverages; soft drinks; energy drinks; fruit drinks and fruit juices; mineral water; preparations for making beverages; beers; lagers; non-alcoholic beers; non-alcoholic lagers; preparations for making beers, lagers, non-alcoholic beers and non-alcoholic lagers.</p>

4. On 10 September 2015, the applicant filed a counterstatement, later amended, denying the ground of opposition.
5. Rules 20(1) – (3) of the Trade Marks Rules (TMR) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions, but Rule 20(4) does. It reads:
 

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”
6. The net effect of the above is to require parties to seek leave in order to file evidence in fast track oppositions. This does not extend to proof of use evidence which is filed with the notice of opposition.

7. No such leave was sought in respect of these proceedings.
8. 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.
9. A hearing was neither requested nor considered necessary, but the Opponent filed written submissions expanding upon its statement of case.

## **DECISION**

10. 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 -

(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.

11. 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.

12. The opponent's marks are earlier marks but are not subject to proof of use because, at the date of publication of the application, they had not been registered for five years. The opponent is therefore entitled to rely on them for all the goods for which they are registered.

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

13. 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:

*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.

### **Comparison of goods and services**

14. The Applicant's mark is applied for in respect of beers, which is identical to beers present in the Opponent's specification.

### **The average consumer**

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: Lloyd Schuhfabrik Meyer, Case C-342/97.

16. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median.

17. The average consumer of beer is a member of the general public, albeit over the age of 18. The goods will be sold either in supermarkets and off-licences where the mode of selection will be primarily visual, or in licensed premises such as pubs and restaurants where they will be ordered verbally, but may be visible on the taps or behind the bar.

18. In *Simonds Farsons Cisk plc v OHIM* Case T-3/04 it was stated:

58 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.

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when

purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves [...]

19. In terms of the degree of care and attention paid in the selection process, this will vary slightly between the more careful purchaser who is interested in the variety, geographic origin, ABV etc., and the less careful purchaser who makes a snap decision at the bar, generally speaking, given the cost and frequency of purchase I consider the degree of care and attention to be slightly below the norm.

### **Comparison of marks**

20. With regard to the comparison of marks, the Opponent submits the following in its Notice of Opposition:

*The marks Route 66 and Route 46 are visually, phonetically and conceptually similar. The only difference between the two marks is the numeral "4" in the middle of the mark subject of the opposed application. The remainder of the marks are identical.*

*It is well known that consumers tend to focus on the beginning of a mark. The elements ROUTE appearing at the beginning of both marks are identical. The last character in both marks is the numeral "6". In cases of imperfect recollection, consumers will not be able to distinguish between the mark ROUTE 66 and the mark ROUTE 46. When spoken aloud (sic) the marks are phonetically similar. Further the element ROUTE, appearing in both marks, brings to mind a main road and/or the choice of roads taken to get to a place. The numerals identify that particular route or road. Therefore the marks are conceptually similar.*

and in its written submissions:

*10. Visually the marks are similar. The element ROUTE appears as the first element in both marks.*

*11. In both marks the element ROUTE is then followed by a two digit number. This results in the marks being the same length. The only difference between the numbers 46 and 66 is the first digit i.e. "4" and "6". This slight change appears within the middle of both marks and can easily be overlooked by the consumer, particularly in cases of imperfect recollection.*

*12. ROUTE 66 will be regarded as one phrase, as will ROUTE 46.*

*13. Aurally the marks are similar. They will be spoken as ROUTE-SIXY-SIX and ROUTE-FORTY-SIX. Both starting and ending with the same sound. There is therefore a high degree of aural similarity.*

*14. Conceptually the marks are similar.*

*15. The Oxford English Dictionary defines ROUTE as meaning "A way or course taken in getting from a starting point to a destination. The line of a road, path or railway".*

16. This meaning of ROUTE as defined above has nothing to do with “beer” in Class 32. The element ROUTE in the mark is therefore distinctive.

17. Both marks make reference to ROUTE followed by an identifying number. The Applicant in their Counterstatement confirm that the inspiration behind their mark ROUTE 46 stems from the location of their brewery. They state at paragraph 4 of their Counterstatement “...in the area around the A46 trunk road”. This shows the relationship with the mark ROUTE 46 and a road, therefore the marks are conceptually similar.

21. In its amended counterstatement, the applicant submits:

1. The Applicants deny that the trade mark which is the subject of the above application is similar to the trade marks upon which the opposition has been based, such that there exists a likelihood of confusion between these marks in relation to any of the goods claimed by the application.

*It is to be noted that the UKIPO did not regard the Opponents’ earlier trade marks upon which the opposition is based as being confusingly similar, as they were not referred to within the Examination Report for the application.*

and

3. The Applicants are very surprised at the Opponents assertion that there is the potential for confusion between their mark and the Applicants. They feel that the consumer should be given more credit and will not have any problem distinguishing between the numbers 46 and 66.

22. Although they cite the figurative mark in their notice of opposition and statement of grounds, the Opponent makes submissions only in relation to the word mark. Therefore I shall focus on the comparison between the Applicant’s mark and the Opponent’s word mark. The Opponent’s position in respect of the figurative mark will be no better than that of its word mark. Therefore the marks to be compared are as follows:

The Applicant’s mark	The Opponent’s mark
Route 46	Route 66

23. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

...it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.

24. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.
25. 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 components, 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.
26. Both marks consist of the word 'Route' followed by a two digit number, '66' and '46' respectively. In each mark, the word and the number elements qualify one another, such that the phrases hang together to evoke the concept of a particular route within a numbered list and this is the overall impression each trade mark will convey.

### **Visual similarities**

27. The common elements of the mark are 'ROUTE \_6'. In terms of the differences in the number elements, the numeral in the 'tens' position is '4' in the Applicant's mark and '6' in the Opponent's mark. I also bear in mind that the repetition of the digit in 66 is a distinctive visual characteristic not shared by 46.
28. However I must consider the marks as a whole, weighing the similarities and differences I have identified, and bearing in mind the overall impression of the marks. In light of all of these factors the marks are visually similar to a high degree.

### **Aural similarities**

29. In terms of the aural assessment, the only difference between the marks is the second syllable, respectively 'four' and 'six'. As with the visual comparison I bear in mind that the alliteration present in 'sixty six' differs from 'forty six' where there is no such element.
30. Taking these factors into account, the marks are aurally similar to a high degree.

### **Conceptual similarities**

31. In terms of conceptual similarity, as was noted in Opposition 102879 to which the Opponent draws my attention, Route 66 is capable of recognition as the name of iconic United States highway by those who are familiar with it. However the assessment must be made from the point of view of the average consumer (see for example the decision of Ms Anna Carboni sitting as the Appointed Person in CHORKEE O-048-08), and I am unable to make the inference that the average UK consumer would be familiar with the



conceptual identity of the road known as Route 66. Nor am I bound to draw inferences from other Registry proceedings, but must consider the case before me on its merits.

32. Accordingly I must conclude that the conceptual identity of both marks is simply that of a particular road within a numbered system, and as such I find there to be a high degree of conceptual similarity.

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

33. 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.

34. I have no evidence of use to consider so only need to make a finding in respect of the inherent distinctiveness of the earlier mark. A road name has no allusive or descriptive bearing on beer, and therefore the earlier mark enjoys a normal degree of inherent distinctive character.

### **Likelihood of confusion**

35. In assessing the likelihood of confusion, I must adopt the global approach set out in 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. 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.

36. At this juncture I note the Applicant's submission that "there are several other co-existing registrations incorporating the element "ROUTE" covering various "beverages"", and that "there is a beverage (beer) available in the UK that is called ROUTE 1," which "appears not to have a registered Trade Mark".

37. In the TREAT case (*British Sugar PLC v. James Robertson & Sons Ltd.*, 1996 R.P.C. 281) Jacob J said as follows:

Both sides invited me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "Treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg MADAME Trade Mark ([1996] RPC 541) and the same must be true under the 1994 Act. I disregard the state of the register evidence.

38. The mere fact of the existence of other marks is not evidence of their use in the

marketplace, much less the impact of any such use. Accordingly, the existence of a third party unregistered mark in the marketplace is not relevant to the question in this case. Neither is it relevant that there are other registered marks incorporating the word ROUTE. The relevant question in this case is whether the average consumer would be confused by identical goods bearing the marks Route 46 and Route 66.

39. Earlier in this decision I have found that:

- the average consumer is a member of the general public aged over 18 who pays a level of care and attention below the norm during the selection process;
- the goods are identical;
- the marks are visually and aurally similar to a high degree, and conceptually similar to a high degree;
- the earlier mark is possessed of a normal degree of inherent distinctive character.

40. Bearing in mind the average consumer's imperfect recollection and the fact that they do not directly compare marks, the factors identified above will lead consumers to mistake one mark for another, i.e. there will be direct confusion.

41. Even if I am wrong in that the average consumer is aware of the conceptual identity of Route 66, and the earlier mark therefore differs conceptually from the less well known (or unheard of) Route 46, this would not change the outcome. This is because those who recognised the conceptual identity of Route 66 as a US Highways designation would readily infer that Route 46 was another such road, and would therefore think that a beer named Route 46 originated from a linked economic undertaking to the beer named Route 66. There would therefore be indirect confusion in these cases. Further, there would be still be a significant proportion of the public who did not know the term and who would be directly confused (*JW Spear & Sons Ltd & Ors v Zynga Inc* [2015] EWCA Civ 29).

42. As the opposition has succeeded on the basis of the Opponent's word mark there is no need to consider the case in respect of the Opponent's figurative mark.

## **CONCLUSION**

43. The opposition succeeds under Section 5(2)(b) and the application is refused.

## **COSTS**

44. The opposition having succeeded, the Opponent is entitled to a contribution towards its costs, which I assess in accordance with Tribunal Practice Notice TPN 4/2007 as follows:

Preparing a statement and considering the other side's statement:	£200
Preparing submissions:	£300

Official fee:	£100
Total	£600

45. I therefore order Wicked Hathern Brewery Limited to pay to Lodestar Anstalt the sum of **£600**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 17th day of November 2015**

**Andrew Wall  
For the Registrar**