

**O-479-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3149067 BY  
HOOD RIVER DISTILLERS, INC.**

**TO REGISTER:**

**BIG GIN**

**AS A TRADE MARK**

**IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000430 BY  
AZIENDA AGRICOLA MARTON ROBERTO**

## BACKGROUND & PLEADINGS

1. On 10 February 2016, BCTLD LLC dba Captive Spirits Distilling applied to register the trade mark **BIG GIN** for the following goods in class 33:

Alcoholic beverages except beers.

The application was published for opposition purposes on 4 March 2016. The application was subsequently assigned to Hood River Distillers, Inc. (“the applicant”). Nothing turns on this assignment and I need say no more about it in this decision.

2. The application is opposed in full by Azienda Agricola Marton Roberto (“the opponent”) under the fast track opposition procedure. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) .The European Union Trade Mark (“EUTM”) and goods relied upon are shown below:

No. 14047823 for the trade mark: **BIG GINO**; applied for on 11 May 2015 and entered in the register on 25 September 2015 for:

Alcoholic beverages (except beers).

3. The applicant filed a counterstatement. Although it admits the “respective goods are identical”, it denies there is a likelihood of confusion.

4. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

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

5. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

6. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) 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. A hearing was neither requested nor considered necessary; the opponent filed written submissions which I will refer to, as necessary, below.

## **DECISION**

7. 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 –

(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. 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.”

9. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this earlier trade mark is not subject to proof of use, the opponent is entitled to rely upon all of the goods it has identified.

### **Section 5(2)(b) – case law**

10. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

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 be dominated by one or more of its components;

(f) however, it is also 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 creates a risk that the public will 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**

11. The competing goods are, as the applicant admits, literally identical.

## **The average consumer and the nature of the purchasing act**

12. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

13. The average consumer of the goods at issue is a member of the adult general public. In its counterstatement, the applicant states:

“The applicant would lastly draw awareness to consumer habits and expectations within the alcohol industry. The applicant understands that emphasis, when assessing the respective marks, will and should be placed on the oral elements, as alcoholic drinks are habitually ordered verbally at a bar or restaurant...”

While, in its submissions, the opponent accepts that aural considerations will play a part in the selection process, it also states:

“It is quite usual for the labels used on alcoholic drinks to be displayed in bars, restaurants and on supermarket shelves...”

14. In my experience, alcoholic beverages are sold through a range of channels including retail premises such as supermarkets and off-licences (where they are normally displayed on shelves and obtained by self-selection) and in bars, public houses and restaurants (where they will be displayed, for example, on shelves behind the bar and where the trade marks will appear on drinks lists, menus etc.). I agree that when the goods are sold in bars, public houses and restaurants, there will be an oral component to the selection process. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. Consequently, while the goods may be ordered orally in bars, public houses and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottle or drinks list/menu prior to the order being placed. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part. As to the level of attention that will be paid, the cost of the goods typically, is likely to be relatively low. However, as the average consumer will wish to ensure they are selecting the correct type, flavour and size of beverage, they are likely, in my view, to pay an average degree of attention to their selection (i.e. no higher or lower than the norm).

### **Comparison of trade marks**

15. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) 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.”

16. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

BIG GIN (the application) v BIG GINO (the earlier trade mark).

17. In their submissions, both parties refer to the use of the competing trade marks in relation to, inter alia, gin. I note, however, that neither parties' specifications are so limited; rather, both specifications are for alcoholic beverages at large which, of course, includes gin.

18. Turning first to the applicant's trade mark, this consists of the words "BIG" and "GIN" presented in plain block capital letters. Although the parties agree that it is unusual to use the word "BIG" in relation to the goods at issue, both words and their meanings will be very well-known to the average consumer. When considered in relation to gin, the word "GIN" is, of course, wholly descriptive. However, as the word "BIG" qualifies the word "GIN", the words "hang together" and the overall impression the applicant's trade mark conveys and its distinctiveness lies in the combination it creates, rather than in the individual components of which it is made up. Although the word "GIN" is, arguably, more distinctive in relation to alcoholic beverages other than gin, I am of the view that the same conclusion applies.

19. As to the opponent's trade mark, this consists of the word "BIG" and "GINO" also presented in plain block capital letters. Here again, as the word "BIG" qualifies the word "GINO" (which I accept will be understood by the average consumer as a male given name most likely of Italian origin), the words "hang together" and the overall



impression the trade mark conveys and its distinctiveness, like the applicant's trade mark, lies in the totality.

20. When considered from a visual perspective both trade marks consist of two words. The first word i.e. "BIG" is identical and the second words consist of three and four letters respectively; the (first) three letters of which i.e. "G-I-N-" are identical. They differ only to the extent that the second word in the opponent's trade mark has an additional letter "O" as the final character. Considered overall, the competing trade marks are visually similar to a high degree.

21. Turning to the aural comparison, the applicant's trade mark consists of two syllables i.e. BIG-GIN, whereas the opponent's trade mark consist of three i.e. BIG-GI-NO; the first word/syllable is identical and its pronunciation predictable. As to the second word in each trade mark, I have noted the parties' competing submissions. Whilst I accept that, for example, regional accents may influence the manner in which these words are pronounced, the most likely pronunciations are, in my view, GIN (to sound like "jin") and GINO (to sound like "jee-noh"). Considered overall, the competing trademarks are most likely, in my view, to be pronounced as "BIG JIN" and "BIG JEE-NOH" respectively. As a consequence, the competing trade marks are aurally similar to a medium degree.

22. Finally, the conceptual comparison. In this regard, even though the meaning of the two words making up the trade mark will be well understood and the word "BIG" is likely to be seen as qualifying the word "GIN" such that they hang together, I agree with the applicant that its trade mark is unlikely to convey any concrete conceptual message to the average consumer (even in relation to gin). Whether considered in relation to gin or alcoholic beverages at large, the opponent's trade mark will convey the concept of a large man named Gino. The opponent's trade mark sends a clear conceptual message, whereas the applicant's trade mark does not.

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

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, 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.

24. These are fast track opposition proceedings in which it was not necessary for the opponent to provide evidence of the use it may have made of its earlier trade mark. As a consequence, I have only the inherent characteristics to consider. I have already concluded that even in relation to gin, the opponent's trade mark will convey the image of a large man named Gino. This message is neither descriptive of the goods at issue nor is it non-distinctive. Absent use, the opponent's trade mark is possessed of an above average degree of inherent distinctive character.

### **Likelihood of confusion**

25. In determining whether there is a likelihood of confusion, a number of factors need to be borne 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent'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 has retained in his mind. Earlier in this decision I concluded that:

- the competing goods are identical;

- the average consumer is a member of the adult general public who will select the goods at issue by both visual and aural means (with the visual means dominating) and will pay an average degree of attention during that process;
- the overall impression both trade marks convey and their distinctiveness lie in the totalities they create;
- the competing trade marks are visually similar to a high degree and aurally similar to a medium degree;
- the opponent's trade mark will convey a concrete conceptual message to the average consumer whereas the applicant's trade mark will not;
- the opponent's earlier trade mark is possessed of an above average degree of inherent distinctive character.

26. I begin by reminding myself that identical, low-cost goods are involved and that the average consumer will pay an average degree of attention during the selection process. In *The Picasso Estate v OHIM*, Case C-361/04 P, the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

And:

In *Nokia Oyj v OHIM*, Case T-460/07, the General Court (“GC”) stated that:

“Furthermore, it must be recalled that, in this case, although there is a real conceptual difference between the signs, it cannot be regarded as making it possible to neutralise the visual and aural similarities previously established (see, to that effect, Case C-16/06 P *Éditions Albert René* [2008] ECR I-0000, paragraph 98).”

27. I have already accepted that the opponent's trade mark will send a clear conceptual message to the average consumer whereas the applicant's trade mark will not. As the decision in *Picasso* makes clear, in some cases that may be considered sufficient to "counteract the visual and phonetic similarities" between competing trade marks. That is not, however, the case in these proceedings. In my view, the concrete conceptual message sent by the opponent's trade mark is not sufficient, to use the words of the GC in *Nokia*, to "neutralise the visual and aural similarities" between the competing trade marks, which I have characterised as high and medium respectively. In my view, the average consumer paying an average degree of attention during the selection process, given in particular the high degree of visual similarity between the trade marks at issue, is likely to mistake one trade mark for the other leading to direct confusion; the opposition succeeds accordingly.

### **Overall conclusion**

28. The opposition has been successful and, subject to any successful appeal, the application will be refused.

### **Costs**

29. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in fast track opposition proceedings filed after 1 October 2015 are governed by Tribunal Practice Notice ("TPN") 2 of 2015. Using that TPN as a guide, I award costs to opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the applicant's statement:	£200
Written submissions:	£100
<b>Total:</b>	<b>£400</b>

30. I order Hood River Distillers, Inc. to pay to Azienda Agricola Marton Roberto the sum of £400. 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 11th day of October 2016

**C J BOWEN**  
**For the Registrar**