

O-221-18

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No. 3216567
BY BOUTIQUE COFFEE BRANDS LIMITED
TO REGISTER THE TRADE MARK**



IN CLASSES 16, 32, 33, 35 & 43

AND

**IN THE MATTER OF OPPOSITION
THERE TO UNDER No. 409555 BY
CHIVAS HOLDINGS (IP) LIMITED**

BACKGROUND

1) On 3 March 2017, Boutique Coffee Brands Limited (hereinafter the applicant) applied to register the trade mark shown on the front page in respect of the following goods and services:

In Class 16: Packaging.

In class 32: Beers; beer based beverages; ale; lager; stout; porter; non alcoholic beverages; non alcoholic beer; cider non alcoholic; shandy; syrups and other preparations for making beverages.

In Class 33: Alcoholic beverages (except beer); wine; cider; spirits; distilled spirits; bitters; sparkling wines.



In Class 35: Advertising.

In Class 43: Restaurant and Bar Services, provision of food and drink, provision of alcoholic beverages, beers, wines and ales.

2) The application was examined and accepted, and subsequently published for opposition purposes on 17 March 2017 in Trade Marks Journal No.2017/011.

3) On 20 June 2017 Chivas Holdings (IP) Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade marks:




Mark	Number	Dates of filing and registration	Class	Specification relied upon
PLYMOUTH	EU 908723	17.08.98 28.10.99	33	Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs.

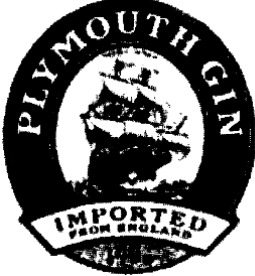
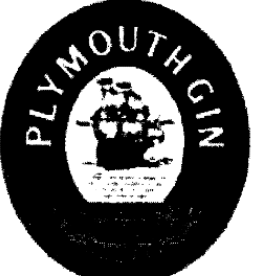
 <p>Colours Claimed/ Indication: Red, black, white, light brown</p>	EU 9921644	26.04.11 30.09.11	32	Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages.
			33	Alcoholic beverages (except beers); spirits; wines; liqueurs; distilled beverages; gin; whisky; whisky liqueurs; beverages from or containing whisky; beverages from or containing gin; aperitifs; cocktails.
			43	Services for providing food and drink.
 <p>Colours Claimed/ Indication: Navy, white, gold</p>	EU 9893306	13.04.11 16.09.11	32	Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages.
			33	Alcoholic beverages (except beers).
			43	Services for providing food and drink.

- a) The opponent contends that the marks of the two parties are highly similar and the respective goods and services in classes 32, 33 and 43 are identical and/or similar. The opposition does not include the class 16 goods or services in class 35. As such it contends that the application offends against Section 5(2)(b) of the Act.
- b) The opponent contends that it has acquired reputation in the three marks shown above such that use of the mark in suit in classes 32, 33 and 43 will take unfair advantage of the distinctive character and repute of the earlier marks. It contends that the mark in suit is seeking to benefit from the earlier marks reputation by free riding. The opponent also contends that use of the mark in suit will result in blurring of the distinguishing characteristics of its earlier marks and is

likely to tarnish the opponent's reputation. The mark in suit therefore offends against section 5(3) of the Act.

- c) The opponent also contends that it has used the following marks throughout the UK on "Alcoholic beverages; gin".

	Mark	Since
1	PLYMOUTH	1793
2		2011
3	 *See note below	1991
4		1998

5		2003
6		2011

* Image 3 above is barely legible but this what was supplied by the opponent.

- d) The opponent states that as a result of the use of the above signs in the UK it has acquired goodwill in each of the signs such that use of the mark in suit will cause misrepresentation, which will lead to damage. As such the mark in suit offends against section 5(4)(a) of the Act.

4) On 2 July 2017 the applicant filed a counterstatement, denying all the grounds and pointing out that its ship device is a historically accurate representation of the Mayflower. The applicant did not put the opponent to Proof Of Use.

5) Both parties seek an award of costs in their favour. Only the opponent provided evidence. Neither side wished to be heard. Both parties provided written submissions which I shall refer to as and when necessary in my decision.

OPPONENT'S EVIDENCE

6) The opponent filed a witness statement, dated 22 September 2017, by Eve-Marie Wilmann-Courteau the Legal Manager within the Group Intellectual Property hub of Pernod-Ricard SA the parent company of the opponent, a position she has held since 2014. Amongst other brands she states that PLYMOUTH gin is one of the world's leading English gins. She states that it was first

formulated in 1793, and was used in the first formulation of a Marguerite in 1882. She provides the following sales and promotional figures for PLYMOUTH gin.

Year	9 ltr Cases sold in EU (12x 750 bottles)	Promotional spending in EU € EUROS
2013	23,800	727,900
2014	15,800	671,100
2015	23,200	1,370,600
2016	28,100	1,579,300
2017	37,600 (431,200 bottles)	962,300

7) She provides the following exhibits:

- EMW1: A history of Plymouth Gin and the distillery. This shows a book of cocktail recipes issued in 1925, it also shows the rebrand to various versions of logo six above in 2011.
- EMW2: Archive documents showing the history of PLYMOUTH gin packaging since the late 1880s. These have include images of friars, ships and simple word labels. A ship device was first used in 1980. In my opinion this image appears not to be the Mayflower but more like a ship of the line from the 1800s such as HMS Agamemnon or HMS Victory. The Mayflower image first appears in 1998. The image altered again in 2002 (see logo five above). In 2006 it only has the name PLYMOUTH and no device of a ship, and then shows logo six as of 2011, with versions of mark 9893306 also used on “Navy strength” versions of gin. At page 35 it shows three different versions of mark 9893306 used in 2012.
- EMW3 & 4: Undated photographs of the distillery showing use there of the ship device on the large gates into the factory.
- EMW5: Archive documents containing a history of PLYMOUTH gin cocktails dating back to 1882. It does not show any images of actual bottles of gin with the relevant labels upon them.

- EMW6: Documents showing the advertising history of PLYMOUTH gin from the 1800s to 2012. No details are provided as to where these advertisements appeared apart from the country. Most appear to be from the USA.
- EMW7: Documents showing events held by and/or sponsored by PLYMOUTH gin from 1982 - 2013, although there is nothing of any significance.
- EMW8: A list of awards won by PLYMOUTH gin between 1998 and 2016.

8) That concludes my summary of the evidence filed, insofar as I consider it necessary.

DECISION

9) The first ground of opposition is under section 5(2)(b) which reads:

“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.”

10) An “earlier trade mark” is defined in section 6, the relevant part of which states:

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

(a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

11) The opponent is relying upon its trade marks listed in paragraph 3 above which are clearly earlier filed trade marks. Whilst the interplay between the dates of the instant mark being published and the opponent's marks being registered mean that the proof of use (pou) requirements would normally bite, the applicant did not require pou. The opponent is, therefore, able to rely on the specifications of the earlier marks without having to show genuine use.

12) When considering the issue under section 5(2)(b) I take into account the following principles which 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.

(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.

The average consumer and the nature of the purchasing process

13) As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods/services. I must then determine the manner in which these goods/services are likely to be selected by the average consumer in the course of trade.

14) The goods at issue in these proceedings are all beverages of one sort or another, whilst the services also involve food and drink. The average consumer for such goods/services will be the public at large (including businesses), albeit insofar as those goods/services which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18.

15) All of the goods at issue may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self-selection) and in public houses (where the goods are displayed on, for example,

shelves behind the bar and where the trade marks will appear on dispensers at the bar etc.). When the goods are sold in, for example, public houses the ordering/selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04, the Court of First Instance (now the General Court) said:

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

16) Consequently, while the goods may be ordered orally in public houses, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will display when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are, in my view, **likely to pay at least a reasonable level of attention to the selection of the goods at issue.**

17) The services in class 43 cover the provision of food and drink in restaurants and bars. I believe that the selection would be mainly visual, from seeing the actual premises and outside signage, to reading an advertisement in a magazine/paper or on-line. There is the aspect of a word of mouth recommendation and so aural issues cannot be ignored. Use of such services can be spur of the minute or pre-planned, but in general the average consumer will know what they require in terms of food and drink, the type of establishment they wish to frequent and the cost they are willing to incur. **As such they will pay a reasonable amount of attention to the selection of such services in class 43.**

Comparison of goods and services

18) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

19) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

20) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... 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”.

21) In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) OHIM*) case T-133/05, the General Court (“GC”) stated:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

22) In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

23) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature

and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

24) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-316/07, the General Court pointed out that:

“43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27).”

25) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. The opponent did not provide comments against each of the items within the various specifications of its registered marks but provided merely a set of overall comments which I have set out below:

“31. The various alcoholic beverages in class 32 of the mark applied for are highly similar to the various alcoholic beverages in class 33 covered by the earlier marks. The goods have the same

purpose and nature. They can coincide in end user and distribution channels. Furthermore they are in competition.

32. The various non-alcoholic beverages in class 32 of the mark applied for are similar to the various alcoholic beverages in class 33 of the earlier marks. The goods can coincide in end user, distribution channels and method of use. Furthermore they are in competition.

33. The class 33 goods covered by the respective marks are identical.

34. The various services relating to the provision of food and drink covered in class 43 of the mark applied for are similar to the various alcoholic beverages in class 33 of the earlier marks. The goods and services can coincide in producer and distribution channels and they are complementary.”

26) I shall first compare both sides’ class 33 specifications, which are as follows:

Opponent’s goods	Applicant’s goods
<p>EU 908723: Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs.</p> <p>EU 9921644: Alcoholic beverages (except beers); spirits; wines; liqueurs; distilled beverages; gin; whisky; whisky liqueurs; beverages from or containing whisky; beverages from or containing gin; aperitifs; cocktails.</p> <p>EU 9893306: Alcoholic beverages (except beers).</p>	<p>In Class 33: Alcoholic beverages (except beer); wine; cider; spirits; distilled spirits; bitters; sparkling wines.</p>

27) It is clear that the term “alcoholic beverages (except beers)” in the applicant’s specification is identical to the same terminology found in both of the opponent’s specifications for marks 9921644 and 9893306. The applicant’s specification also includes “wine; cider; spirits; distilled spirits; bitters and sparkling wine” all of which would be encompassed by the term “alcoholic beverages”. **The class 33 specification of the mark in suit is identical to the class 33 specifications of the opponent’s marks 9921644 and 9893306.**

28) It is also clear that the terms “Alcoholic beverages (except beer); spirits; distilled spirits; bitters;” encompass the terms “Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs” found in the opponent’s 908723. **These terms must be regarded as identical.**

29) This leaves the terms “wine; cider; sparkling wines” in the applicant’s class 33 specification. I must compare this to the opponent’s specification in 908723 which reads “Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs”. I take note that in *Bodegas Montebello, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-430/07, the GC found that rum and wine were “manifestly different” (its analysis is at paragraphs 29-37). This was based on an assessment of the different ingredients and methods of production, which result in end products different in taste, colour and aroma. In addition, it noted that wine is often drunk with a meal, while that is not generally the case for rum, and that the goods have a markedly different alcohol content. Although the Court accepted that rum and wine may share the same distribution channels, it considered that the goods would not generally be sold on the same shelves and that the goods were neither complementary nor in competition. Using the same logic, as rum and gin are very similar, I conclude that the terms “wine; cider; sparkling wines” in the applicant’s mark are neither similar nor complementary to gin.

30) I next turn to the applicant’s specification in class 32 which reads “Beers; beer based beverages; ale; lager; stout; porter; non-alcoholic beverages; non-alcoholic beer; cider non-alcoholic; shandy; syrups and other preparations for making beverages”. These must be compared to the opponent’s class 32 & 33 specifications. The opponent’s marks 9921644 and 9893306 have identical class 32 specifications of “Beers; Mineral and aerated waters and other non-alcoholic drinks; Fruit drinks and fruit juices; Syrups and other preparations for making beverages”. **It is clear that the opponent’s specifications encompass the whole of the applicant’s specification and so they must be regarded as identical.**

31) As the opponent’s mark 908723 is only registered for goods in class 33 I must compare these goods to the applicant’s goods in class 32. In making this comparison I take into account the views in *Wesergold Getrankeindustrie GmbH & bCo KG v EUIPO*, case T-278/10, where the General Court held that ‘spirits, particularly whisky’ was not similar to non-alcoholic beverages. Accepting that the respective goods were sometimes mixed together by consumers, the court nevertheless found that

consumers would not expect the goods to originate from the same, or economically related, undertakings. Therefore the goods were not complementary within the meaning of the case law.

32) I also take into account case T-584/10 *Yilmaz v OHIM* (ECLI:EU:T:2012:518). In this case, the goods found to be dissimilar were a spirit (Tequila) and beer. In making its assessment, the General Court applied the approach from *MEZZOPANE* and started at paragraph 51:

“...the differences between those goods [that is Tequila and beer], in respect of all the relevant factors relating to them, are clearer and more substantial than the differences between beer and wine established by the Court in *MEZZOPANE*, with the result that those differences make it even more unlikely that the relevant public would believe that the same undertaking would produce and market the two types of beverage at the same time.”

33) The General Court went on at paragraph 54:

“In that regard, it must be borne in mind, in particular, that, while the goods to be compared in the present case belong to the same general category of beverages, and more specifically to the category of alcoholic beverages, they are different in particular as regards their ingredients, method of production, colour, smell and taste, with the result that the average consumer perceives them to be different in nature. Those goods are not normally displayed in the same shelves in the areas of supermarkets and other outlets selling drinks. As regards their use, a significant difference between the goods is that beer quenches thirst which is not normally the case for the alcoholic beverages covered by the mark applied for. While it is true that those goods may be consumed in the same places and on the same occasions and satisfy the same need – for example, enjoyment of a drink during a meal or as an aperitif – the fact remains that they do not belong to the same family of alcoholic beverages and that the consumer perceives them as two distinct products, as the Court held, so far as concerns beer and wine, in paragraph 66 of *MEZZOPANE*.”

34) The Court then went to state that the existence of alcoholic cocktails does not affect this conclusion (paragraph 55); that Tequila and beer are not complementary (paragraph 56); and, furthermore, that there is a lower degree of competition between Tequila and beer than there is between wine and beer (paragraph 57). Ultimately, the Court upheld the Board of Appeal's finding

that the goods were dissimilar (at paragraph 72, which upheld the finding at R 1162/2009-2 *TEQUILA CUERVO*, paragraph 44).

35) I also take note of the case previously cited at paragraph 29 above. Taking all the above into consideration I consider there to be no similarity or complementarity between the applicant's goods in class 32 and the opponent's class 33 goods for which mark 908723 is registered.

36) Lastly, I turn to consider the applicant's services applied for in Class 43 which reads: "Restaurant and Bar Services, provision of food and drink, provision of alcoholic beverages, beers, wines and ales". The opponent's marks 9921644 and 9893306 are registered for identical specifications in class 43 which read: "Services for providing food and drink". The opponent's specification clearly incorporates the whole of the applicant's specification. I must also compare the class 33 goods for which the opponent's mark 908723 is registered to the applicant's class 43 services. In making this comparison I take into account *Group Lotus Corp., SL v OHIM*, Case T-161/07, where the General Court held that there was a "lesser" [low] degree of similarity between beers and bar, nightclub and cocktail bar services.

37) I am willing to accept that there is a low degree of similarity between the following class 43 services of the mark in suit "Bar Services, provision of drink, provision of alcoholic beverages, beers, wines and ales" and the opponent's class 33 goods of "Gin; prepared alcoholic cocktails containing gin; gin-based liqueurs". However, I do not believe there is any similarity between the opponent's class 33 goods and the following class 43 services of the applicant "Restaurant Services, provision of food". This is based on the view of the average consumer who would not expect a manufacturer of ardent spirits to run restaurants or catering services, and the opponent has provided no evidence to persuade me otherwise.

38) For ease of reference, I summarise my findings regarding the similarity of goods and services as follows:

Applicant's goods	908723:	9921644:	9893306
Class 33: Alcoholic beverages (except beer); spirits; distilled spirits; bitters;	Class 33: identical.	Class 33: identical.	Class 33: identical.

Class 33: wine; cider; sparkling wines.	Class 33: not similar not complementary.	Class 33: identical.	Class 33: identical.
Class 32: Beers; beer based beverages; ale; lager; stout; porter; non-alcoholic beverages; non-alcoholic beer; cider non-alcoholic; shandy; syrups and other preparations for making beverages”	Class 33: not similar not complementary.	Class 32: identical.	Class 32: identical.
Class 43: Bar Services, provision of drink, provision of alcoholic beverages, beers, wines and ales”.	Class 33: low similarity.	Class 43: identical.	Class 43: identical.
Class 43: Restaurant Services, provision of food.	Class 33: not similar not complementary.	Class 43: identical.	Class 43: identical.



Comparison of trade marks

39) 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 them, bearing in mind their distinctive and dominant components. The 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.”

40) It would be wrong, therefore, to artificially 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 created by them. The trade marks to be compared are:

Opponent's trade marks	Applicant's trade mark
908723 : PLYMOUTH	 <p>The logo consists of a central illustration of a three-masted sailing ship with white sails and a dark hull, set within a circular frame. Green wheat stalks are positioned on either side of the ship. Above the ship, the word 'PLYMOUTH' is written in a red, stylized, arched font, with the word 'THE' in a smaller font above it. Below the ship, a dark banner with a gold border contains the word 'BREWERIES' in a red, serif font.</p>
9921644:  Colours Claimed/ Indication: Red, black, white, light brown	

9893306:



Colours Claimed/ Indication: Navy, white, gold

41) In its written submissions the opponent stated:

“Applying the well-known test set out in ***Sabel v Puma***, the Opponent contends that:

(i) The dominant and distinctive components of its earlier marks are the word PLYMOUTH and the device of a ship;

(ii) Both elements are reproduced/conveyed in the trade mark applied for;

(iii) The overall impression conveyed by the marks is similar;

(iv) The fact that consumers rarely have the chance to compare marks side by side but have to rely on the imperfect picture they have of them in their mind makes confusion more likely in the present case;

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

(vi) The identity and similarity of the goods and services offsets any lesser degree of similarity between the marks;

(vii) There is a greater likelihood of confusion because the earlier marks have a highly distinctive character as a result of the extensive use which has been made of them.”

42) I shall first compare the mark in suit to the opponent’s mark 908723, which consists simply of the word PLYMOUTH. Visually the marks have the word PLYMOUTH in common but the applicant’s mark has a very large device element of a ship in an oval with ears of barley or wheat on either side complete with a “ribbon” device at the base and the words “The” above, and “BREWERIES” below the word “PLYMOUTH”. Aurally the device element will not be verbalised, and so the common element remains the same, the word “PLYMOUTH”, whilst the differences are reduced to the words “The” and “BREWERIES”. Conceptually the opponent’s mark consists of the name of the well-known South-Western city, whereas the mark in suit is specific to a conglomerate of breweries within the city. **To my mind, overall there is a low degree of similarity between the mark in suit and the opponent’s 908723 mark.**

43) I next turn to consider the opponent’s mark 9921644 to the mark in suit. The opponent’s mark consists of the device of an old sailing ship. Visually there is a degree of similarity in that the mark in suit also has a ship device, albeit slightly different. The mark in suit has far more going on in it such as the oval, the ribbon and the words. Aurally the opponent’s mark cannot be pronounced merely described, whereas the mark in suit has the words “The PLYMOUTH BREWERIES”, and so are very different. Conceptually the marks are highly different, with the opponent’s mark only having a vague image of a bygone time, whereas the mark in suit is clearly tied to a location and origin. **To my mind, overall there is a very low degree of similarity between the mark in suit and the opponent’s 9921644 mark.**

44) Lastly, I consider the opponent’s mark 9893306 to the mark in suit. The opponent’s mark is visually very busy. In addition to the words “PLYMOUTH GIN” it has a device of an old sailing ship (claimed to be the Mayflower), and identified as such by the wording “In 1620 the Mayflower set sail from Plymouth on a journey of hope and discovery”. It also has the words “Blackfriars Distillery” and “Coates & Co” as well as details regarding the amount in the bottle, its alcoholic rating by volume and proof, and the claim that it is distilled in a Victorian copper still. When used upon gin, the word “gin” is clearly descriptive. However, on any of the other goods such as whisky or non-alcoholic drinks it is deceptive and would be highly unusual such that the average consumer would pay considerable attention to the word and attach great meaning to it. Visually it has similarities with the mark in suit but, to my mind far more differences. Aurally there is the similarity of the word “Plymouth”, otherwise

there are considerable differences, particularly when used on anything than gin, where the use of the word “gin” would be both deceptive and highly unusual. Conceptually, the mark in suit is clearly linked to a conglomerate of breweries in Plymouth. The opponent’s mark might be felt to be describing a form of gin equivalent to “London dry gin”, as it is described as being made at the Blackfriars distillery (Blackfriars being a well-known London district), and having the name of the manufacturer Coates & Co. prominent on the front label. Having said all this, the most prominent elements of both parties marks are the word “PLYMOUTH” and the device of an old sailing ship. **To my mind, overall there is a medium degree of similarity between the mark in suit and the opponent’s 9893306 mark.**

Distinctive character of the earlier trade mark

45) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

46) The opponent has provided sales figures for PLYMOUTH gin in the EU. I note that the opponent’s marks are registered for considerably more goods and services than merely gin but no sales figures are provided for such goods and services. I also note that from the opponent’s exhibits there are a

number of different labels that have been used over the time span of the sales figures. It is not clear which of these labels the sales figures relates to. Even if I were to accept that all the labels use the word PLYMOUTH the opponent has not put these figures into context of the overall market in the EU for gin. It has not provided its market share or given figures for the number of bottles or cases of gin that were sold in the relevant years in the numerous countries that make up the EU. There is no evidence to show what if any impact it has made upon the average UK consumer whose perspective is at issue here. **None of the opponent's marks can benefit from enhanced distinctiveness through use.** The opponent's mark 908723 consists of the word PLYMOUTH. It is not descriptive of the goods and is in fact a well-known city in the south-west of England and suggests a simple geographical location. **To my mind, the earlier mark 908723 is of low average inherent distinctiveness.** Turning to mark 9921644, which consists of a device of a sailing ship from the 17th century. Whilst it is said to be the Mayflower, I doubt if the average consumer would immediately draw to mind this name, it is more likely to be seen as simply a galleon from the time of Drake and pirates. **To my mind, the earlier mark 9921644 is of low to average inherent distinctiveness.** Lastly, I turn to the opponent's mark 9893306. This is a very "busy" mark with a great deal of wording, but the word "Plymouth" and the ship device are prominent. **To my mind, the earlier mark 9893306 is of average inherent distinctiveness.**

Likelihood of confusion

47) 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 services 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 and services, 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 average consumer is a member of the general public (including businesses), who will select the goods and services by predominantly visual means, although not discounting aural considerations and that they will pay at least a reasonable degree of attention to the selection of such goods and services.

- the opponent's mark 9893306 has an average degree of inherent distinctiveness, whilst marks 9921644 and 908723 are of low to average inherent distinctiveness. None of the opponent's marks can benefit from an enhanced distinctiveness through use.
- there is a low degree of similarity between the mark in suit and the opponent's 908723 mark; a very low degree of similarity between the mark in suit and the opponent's 9921644 mark, and a medium degree of similarity between the mark in suit and the opponent's 9893306 mark.
- I made the following findings with regard to the similarity of the parties' goods and services:

Applicant's goods	908723:	9921644:	9893306
Class 33: Alcoholic beverages (except beer); spirits; distilled spirits; bitters;	Class 33: identical	Class 33: identical	Class 33: identical
Class 33: wine; cider; sparkling wines.	Class 33: not similar not complementary	Class 33: identical	Class 33: identical
Class 32: Beers; beer based beverages; ale; lager; stout; porter; non-alcoholic beverages; non-alcoholic beer; cider non-alcoholic; shandy; syrups and other preparations for making beverages"	Class 33: not similar not complementary	Class 32: identical	Class 32: identical
Class 43: Bar Services, provision of drink, provision of alcoholic beverages, beers, wines and ales".	Class 33: low similarity.	Class 43: identical	Class 43: identical
Class 43: Restaurant Services, provision of food.	Class 33: not similar not complementary	Class 43: identical	Class 43: identical

48) In view of the above, and allowing for the concept of imperfect recollection, in respect of mark 9921644 there is a no likelihood of consumers being confused into believing that any of the goods and services applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of this mark fails.**

49) In view of the above, and allowing for the concept of imperfect recollection, in respect of the opponent's mark 908723 there is a likelihood of consumers being confused into believing that the

following goods in class 33 (Alcoholic beverages (except beer); spirits; distilled spirits; bitters) and the following services in class 43 (Bar Services, provision of drink, provision of alcoholic beverages, beers, wines and ales) applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under section 5(2)(b) succeeds in relation to these goods and services.**

50) In respect of the opponent's mark 908723 there is no likelihood of consumers being confused into believing that the following goods in class 32 (Beers; beer based beverages; ale; lager; stout; porter; non-alcoholic beverages; non-alcoholic beer; cider non-alcoholic; shandy; syrups and other preparations for making beverages), the following goods in class 33 (wine; cider; sparkling wines) and the following services in class 43 (Restaurant Services, provision of food) applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under section 5(2)(b) fails in relation to these goods and services.**

51) In view of the above, and allowing for the concept of imperfect recollection, in respect of the opponent's mark 9893306 there is a likelihood of consumers being confused into believing that the goods and services applied for in classes 32, 33 & 43 under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under section 5(2)(b) succeeds in relation to all goods and services in classes 32, 33 & 43.**

52) The other two grounds of opposition are under sections 5(3) and 5(4) which read:

“5(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

And:

“5(4): A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

53) In respect of section 5(3) the relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Addidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*).

54) In respect of section 5(4)(a) Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

"The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff's goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant's misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House's previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House."

55) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

"To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

56) It can be seen from the above that in order to succeed under these grounds the opponent needs to show that in respect of the marks/ signs it relies upon, it has a reputation with a significant proportion of the public and that it has goodwill. The opponent has supplied figures for the number of cases of gin sold in the EU, but has not stated where these are sold nor has it put these figures into context of the total market for gin in the EU. Further, it has not identified a single mark or sign under which these sales were made. Even if it had satisfied this last point, the fact that it is not clear where sales have been made and the extent of market share mean that it is impossible to state that a significant part of the relevant public are aware of the opponent's mark. As such I find that the opponent has no reputation in the EU. Even if it had managed to overcome this hurdle and show that

it had a reputation in the EU, I would not have been able to determine what impact it had made amongst the relevant UK consumers as per *Iron & Smith Kft v Unilever NV* C-125/14. I also note that there is no independent evidence to corroborate the opponent's claim. Similarly, in respect of section 5(4)(a) the opponent has not provided any evidence of goodwill in the UK. It has therefore failed to show that it enjoys either reputation or goodwill under any of its marks or signs set out in its statement of grounds. **The grounds of opposition based upon sections 5(3) and 5(4) therefore fail.**

CONCLUSION

57) The opposition under Section 5(2)(b) was successful in relation to all the goods and services sought to be registered in classes 32, 33 & 43. The opposition under Sections 5(3) and 5(4)(a) were completely unsuccessful in relation to the classes of goods and services.

58) The goods and services applied for in classes 16 and 35 were not opposed and so the mark can continue to registration for these goods and services as well as those listed in paragraph 59 above.

COSTS

59) Although the opponent has succeeded in full under its section 5(2)(b) ground it has failed completely under both section 5(3) and 5(4)(a). Therefore, I propose to award costs but on a reduced scale.

Preparing a statement and considering the other side's statement	£200
Expenses	£200
Preparing evidence	£100
Providing submissions	£200
TOTAL	£700

60) I order Boutique Coffee Brands Limited to pay Chivas Holdings (IP) Limited the sum of £700. This sum 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 9th day of April 2018

George W Salthouse
For the Registrar,

