

O-512-19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3340324

BY BREWDOG PLC

TO REGISTER THE FOLLOWING TRADE MARK:

SONIC

IN CLASS 33

AND

OPPOSITION THERETO UNDER NO. 414923

BY NIGEL OVENS

BACKGROUND AND PLEADINGS

1. On 21 September 2018, BrewDog plc (“the applicant”) filed trade mark application number UK00003340324 for the mark **SONIC**. The application was accepted and published for opposition purposes on 28 September 2018, in respect of the following goods:

Class 33 Alcoholic beverages (except beer); spirits; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; cider.

2. Nigel Ovens (“the opponent”) opposes the application in full under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon International Registration designating the EU (“IR(EU)”) no. WE00001399846 and United Kingdom trade mark (“UKTM”) no. UK00003246970, the pertinent details of which are as follows:

UKTM UK00003246970

Representation: SUPERSONIC

Filing date: 28 July 2017

Registration date: 27 October 2017

Goods (as relied upon): Classes 32 and 33¹

IR(EU) WE00001399846

Representation: SUPERSONIC

International registration date: 9 November 2017

Date of Designation of the EU: 9 November 2017

Date protection granted in EU: 6 August 2019

Priority date: 28 July 2017

Goods (as relied upon): Classes 32 and 33²

¹ I will list these when I come to the goods comparison

² I will deal with these in due course

3. The opponent's UKTM qualifies as an earlier mark in accordance with section 6 of the Act. Given its registration date, it is not subject to the proof of use provisions contained in section 6A of the Act.

4. By virtue of having a priority date that predates the filing date of the contested mark, the opponent's IR(EU) qualifies, under section 6 of the Act, as an earlier mark for the purpose of these proceedings. As the IR(EU) has a date of protection that is after the filing date of the applied-for mark, it is not subject to the proof of use conditions set out under section 6A of the Act.

5. Since these proceedings have started, the opponent's IR(EU) has had its protection restricted by the European Union Intellectual Property Office ("EUIPO"), meaning the goods for which it is registered have been limited. Given that the opponent's UKTM is an identical mark to the IR(EU) and is registered for a wider specification of goods, it is the UKTM that represents the opponent's best case in these proceedings and I will restrict my considerations of the opponent's case as based upon this earlier mark.

6. The opponent's case under section 5(2)(b) is that the applied-for mark is "phonetically, visually and conceptually very similar" to its earlier marks and that the goods at issue are "identical and highly similar", resulting in a strong likelihood of confusion.

7. The applicant filed a counterstatement in which it denies a likelihood of confusion based on the fact that there are "distinct visual, aural, and conceptual differences" between the marks at issue.

8. Neither party filed evidence. Neither party requested a hearing. Both parties filed written submissions in lieu of a hearing. The opponent is represented by Murgitroyd & Company. The applicant is represented by Lawrie IP Limited.

DECISION

Section 5(2)(b)

9. Section 5(2)(b) of the Act states that:

“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.”

Relevant 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 might 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 shown in the table below:

Earlier UKTM	Applied-for mark
<p>Class 32: Beers; beer and brewery products; non-alcoholic beers; craft beers; beer wort; non-alcoholic beverages; water; mineral water; sparkling water; bottled water; drinking waters; flavoured water; aerated water; carbonated water; drinking water with vitamins; vitamin enriched water; nutritionally fortified water; fruit juices; fruit based beverages; fruit drinks and fruit juices; fruit squashes; sodas; colas; protein enriched sports drinks; energy drinks enhanced with proteins; sports drinks, namely, energy drinks; sport drinks, namely, performance drinks; sports drinks, namely, recovery drinks; concentrates, syrups and powders used in the preparation of sports and energy drinks.</p> <p>Class 33: Alcoholic beverages (except beer); spirits; distilled spirits; gin; vodka; whisky; Irish whiskey; Scotch whisky and scotch whisky based liqueurs; rum; rum</p>	<p>Class 33: Alcoholic beverages (except beer); spirits; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; cider.</p>

based beverages; tequila; wine; fortified wines; sparkling wines; cider; alcopops; cordials; preparations for making alcoholic beverages; alcoholic essences; alcoholic extracts; bitters; alcoholic energy drinks; blended spirits; cocktails; liqueurs; pre-mixed alcoholic beverages.	
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12. It is self-evident that the parties' 'alcoholic beverages (except beer); spirits; distilled spirits; whisky; liqueurs; gin; vodka; cider' are, due to their identical wording, identical goods.

13. The General Court ("GC") confirmed in *Gérard Meric v OHIM*³ that even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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 trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

14. In accordance with *Meric*, the applicant's 'blended whisky' falls within the scope of the opponent's 'whisky'. These goods are identical.

The average consumer and the nature of the purchasing act

15. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion,

³ Case T-133/05

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*.⁴

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*,⁵ 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 the goods at issue will be a member of the adult general public. The goods will be purchased fairly frequently and, although alcoholic beverages can vary quite significantly in cost, they are not, generally speaking, an expensive purchase. The goods will be inspected for different characteristics such as quality, flavour and alcohol by volume (“abv”) level, for example. I find that, taking all of these factors into account, the level of care and consideration that will be adopted during the purchasing process would be average. The consumer will, for the most part, encounter the marks visually; the purchaser either visually peruses a menu at a bar or scans the shelves behind the bar and then orders, or visually scans shelves in a shop or pages on a website and makes a self-selection. However, in a bar, for example, the goods will be ordered by word of mouth and, therefore, there is an aural element to the purchase.

⁴ Case C-342/97

⁵ [2014] EWHC 439 (Ch)

Comparison of marks

18. It is clear from *Sabel* 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 *Bimbo*, 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 relevant 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.”

19. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

20. The trade marks to be compared are as follows:

Earlier UKTM	Applied-for mark
SUPERSONIC	SONIC

21. The parties have made various submissions on the similarities and differences of the marks. I have considered them all in reaching my decision and will refer below to some of the arguments raised (although I do not propose to reproduce the submissions in full).

Overall impression

22. The applied-for mark consists solely of the word SONIC, with no stylisation or figurative elements. The overall impression of the mark rests in the word itself. The earlier UKTM consists solely of the word SUPERSONIC, with no stylisation or figurative elements. Again, the overall impression of the mark rests in the word itself.

Visual comparison

23. The similarity between the marks rests in the five letters 'SONIC', meaning the entirety of the applied-for mark is visible within the earlier UKTM. The difference is in the addition of the preceding five letters 'SUPER' in the earlier UKTM. Overall, I find a medium degree of visual similarity between the marks.

Aural comparison

24. Both marks will be articulated in their entirety: the earlier UKTM as the four-syllable 'SU-PER-SON-IC' and the applied-for mark as the two-syllable 'SON-IC'. 'SONIC' in both marks will be articulated identically. Overall, I find a medium to high degree of aural similarity between the marks.

Conceptual comparison

25. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.⁶ The assessment must be made from the point of view of the average consumer.

26. Both marks are ordinary dictionary words, the meaning of which will be obvious to the average consumer. 'Sonic' is an adjective meaning "of sound or the speed at which sound travels in air"⁷ and 'supersonic' is an adjective meaning "faster than the speed of sound".⁸ I agree with the opponent that the word 'super' preceding the adjective

⁶ [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

⁷ www.dictionary.cambridge.org

⁸ As above

'sonic' in the earlier UKTM will be seen as a qualifier, simply increasing the quality signified by the word 'sonic'. Overall, I find a high degree of conceptual similarity between the marks.

Distinctive character of the earlier mark

27. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel*). In *Lloyd Schuhfabrik Meyer* 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).”

28. The opponent has not claimed to have used its earlier mark to the extent that it has an enhanced degree of distinctive character. However, even if it had, I have not been provided with any evidence to determine whether the earlier mark has an

enhanced distinctive character. Accordingly, I have only the inherent distinctiveness of the earlier mark to consider.

29. The opponent's earlier UKTM is an ordinary dictionary word, the meaning of which will be obvious to the average consumer. However, the word SUPERSONIC is not descriptive or allusive of the goods for which the mark is registered. Consequently, I find the earlier mark to have an average degree of distinctive character.

Likelihood of confusion

30. The factors assessed so far have a degree of interdependency (*Canon*); a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel*). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

31. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/services down to the responsible undertaking being the same or related).

32. The marks have been found to be visually similar to a medium degree, aurally similar to a medium to high degree and conceptually highly similar. The goods at issue have been found to be identical.

33. Due to the visual and aural differences I have highlighted, particularly that the earlier UKTM contains the additional word SUPER, which will not go unnoticed by the average consumer, I do not find that the average consumer would mistake one mark for the other. There is no likelihood of direct confusion.

34. I go on now to consider indirect confusion. This was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*:⁹

⁹ BL O/375/10

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI”, etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

35. I have borne in mind that the examples given by Mr Purvis are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁰

36. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common elements of both marks and determines, through an instinctive mental process, that the marks are related and originate from the same, or an economically linked undertaking.

37. I have borne in mind the guidance of Mr James Mellor QC¹¹ that a finding of indirect confusion should not be made merely because the two marks share a common element. However, given that I have found that the word 'SUPER' within the earlier UKTM will likely be seen as a qualifier for the word 'SONIC' and that SUPERSONIC and SONIC (the meanings of which will be familiar to the average consumer) have a highly similar concept, the consumer will consider the difference between the two marks as logical and consistent with a brand extension. Taking into account that the goods at issue are identical and the purchase of such goods is not a particularly considered one, the consumer will see the marks used on identical goods, consider that they come from the same or linked undertakings, and will be confused. There is a likelihood of indirect confusion.

CONCLUSION

38. The opposition under section 5(2)(b) has been successful. The application is refused registration.

COSTS

39. As the opponent has been successful I consider that it is entitled to an award of costs in its favour. Awards of costs are governed by Annex A of Tribunal Practice Notice ("TPN") 2/2016. Using that TPN as a guide, I award costs to the opponent on the following basis:

¹⁰ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 at paragraphs [81] to [82]

¹¹ Sitting as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Official fee:	£100
Preparing a statement and considering the other side's statement:	£200
Preparing written submissions and considering the other side's written submissions:	£400
Total:	£700

40. I order BrewDog plc to pay Nigel Ovens the sum of **£700**. 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 3rd September 2019

Emily Venables
For the Registrar,
The Comptroller-General