

**O/176/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF THE APPLICATION NO. 3327909**

**BY HAIRY DOG BREWERY LTD**

**TO REGISTER AS A SERIES OF TWO UK TRADE MARKS IN CLASS 32:**

**Hairy Dog Brewery**

**HAIRY DOG BREWERY**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 414951**

**BY CHRISTOPHER JOHN CORBETT**

## BACKGROUND AND PLEADINGS

1. On 29 July 2018, Hairy Dog Brewery Ltd<sup>1</sup> (“**the Applicant**”) filed an application to register as a series of two UK trade marks, the word marks “Hairy Dog Brewery” and “HAIRY DOG BREWERY” (together “**the contested mark**”<sup>2</sup>). The application was filed originally for “beer” in Class 32.
2. The application was published for opposition purposes in the Trade Marks Journal on 5 October 2018. On 3 January 2019, Christopher John Corbett (“**the Opponent**”) filed a Form TM7 Notice of Opposition, based on grounds under sections 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent owns UK trade mark registration No. 2147516, which was filed on 9 October 1997; it is therefore an “earlier trade mark” under the Act.<sup>3</sup> The earlier mark was registered on 24 April 1998 for the following services:  
  
*Class 42: Provision and service of food and drink; catering, restaurant, public house, bar and winebar services*<sup>4</sup>
3. On 10 June 2019 a Form 21B was filed, amending the application to stand as follows:  
  
*Class 32: Craft beer*
4. The Opponent relies on all of the services under the earlier mark. Since the earlier mark had been registered for more than five years when the contested mark was published, it is subject to the proof of use provisions under section 6A of the Act and the Opponent’s Form TM7 included a statement of use in relation to all the registered services.
5. The Opponent claims that the parties’ trade marks are identical or else highly similar and that the respective goods and services are identical or similar such that there exists a likelihood of confusion on the part of the relevant public.

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<sup>1</sup> ‘Ltd’ had been omitted from the application on filing, but was later corrected.

<sup>2</sup> The Applicant accepted that nothing turns on the different use of capitalisation in the series of 2 marks.

<sup>3</sup> Section 6(1)(a)

<sup>4</sup> I note that such services do not fall within existing Class 42 (but would rather sit in 43). Prior to 2002 there were only 42 classes and at that time all of the services now in 43, 44 and 45 fell into class 42. This discrepancy is not significant and section 60A confirms that the appearance of goods and services in either the same or different classes commands neither similarity nor dissimilarity.

6. A Form TM8 notice of defence was filed on behalf of the Applicant, which requested proof of use for all of the Opponent's services. It included a counterstatement, from which I note the following points:
- it submitted that section 5(2)(a) is not relevant because it denied that the marks are identical;
  - it accepted that the marks are similar, but denied a likelihood of confusion;
  - it claimed that *"the absence of any confusion between the parties to date would seem to support"* the Applicant's position on a likelihood of confusion;
  - it stated that *"the services of a 'pub' are completely different to those of a brewery producing beer for sale. Whilst the brewers mark will appear on the goods, usually the label under which the beer is sold will predominate, as is the case for example in [the Applicant's] Far Fetched Pale Ale. The activity of brewing is distinct and separate from offering hospitality services."*

#### **Papers filed and representation**

7. During the evidence rounds, the parties filed the following:

##### Opponent's evidence and submissions in chief

- Witness Statement: **Christopher John Corbett** dated 16 May 2019, with **Exhibits 1 – 5**
- Witness Statement: **Errol Sandiford** dated 6 June 2019, with **Exhibits ES1 – ES4**
- Written submissions dated 21 May 2019

##### Applicants' evidence and submissions

- Witness Statement Paul David Cohen, dated 3 September 2019 with **Exhibits PDC1 – PDC10**
- Written submissions dated 12 August 2019

##### Opponent's evidence in reply

- Witness Statement **Christopher John Corbett**, dated 31 October 2019 with **Exhibits CJC1 – CJC2**
- Witness Statement **Errol Sandiford** 31 October 2019

8. The Applicant requested a hearing and skeleton arguments were filed by both sides. I have read all the papers filed and shall refer to points from the evidence and submissions where warranted. The hearing took place by video conference on Monday 3 February

2020. Michael Harrison of Sandiford Tennant LLP (along with Errol Sandiford) attended on behalf of the Opponent; Charlotte Blythe of Counsel, attended for the Applicant at the instruction of Lewis Silkin LLP.

## **DECISION**

### **Proof of use**

9. The Opponent must show that its earlier mark had been put to genuine use in relation to the services for which it is registered during the 5 years up to the date when the contested mark was published for opposition purposes.<sup>5</sup> The relevant period for which the Opponent must prove genuine use in this case is therefore 6 October 2013 to 5 October 2018. The principles for determining whether the use made of a trade mark amounts to “genuine use” are well known, are not in dispute and I need not set them out here.<sup>6</sup>
10. The burden of proof falls on the Opponent to show that it has used its mark (section 100 of the Act) and section 6A(6) provides that where an earlier trade mark satisfies the use conditions in respect of some only of the services for which it is registered, it shall be treated for the purposes of proceedings as if it were registered only in respect of those services.
11. In *Euro Gida*, the Appointed Person stated: “In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose, the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”<sup>7</sup> And in *Titanic Spa*, the summary by Mr Justice Carr of relevant legal principles included the following:

“v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do.

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<sup>5</sup> Under section 6A(1A) of the Act (as amended) the relevant 5-year period ends with the date of the application for registration, but those provisions apply only in relation to proceedings commenced on/after 13 January 2019.

<sup>6</sup> Both parties accepted the principles as set out by Arnold J in *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) at paragraphs 114-115

<sup>7</sup> *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC sitting as the Appointed Person. An “Appointed Person” is a senior IP lawyer, typically a senior barrister or academic, who has been appointed to serve as an appeal tribunal in relation to decisions made by IPO tribunal hearing officers.

For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”<sup>8</sup>

12. The evidence of use is provided in the Witness Statement of Mr Corbett. The evidence shows that the Opponent has, for over two decades, operated a family-friendly pub in Minehead, Somerset, which also offers food (see: paragraphs 1, 2 and 10 of the **Witness Statement of Mr Corbett**; the pub signage shown at **Exhibit 2**; various of the reviews on TripAdvisor at **Exhibit 4**). The Applicant accepted that the evidence establishes that the Opponent has traded as a pub/restaurant under and by reference to the earlier mark in the relevant period. However, the Applicant submitted that the use shown is not across the full breadth of the specification: *Provision and service of food and drink; catering, restaurant, public house, bar and winebar services*.

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<sup>8</sup> *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), at paragraph 47 of that judgment.

13. I agree that on the basis of the evidence of use filed, the Opponent is not able to rely upon “*catering*” or “*winebar services*”; I also accept that the term “*provision and service of food and drink*” is broad and includes sub-categories of services that the Opponent has not provided. The Applicant further submitted that since the term “*public house services*” includes sub-categories “such as gastropubs, sports pubs and family pubs”, an appropriate fair specification may be “*family pub-restaurant services*”. However, in my view, the suggested limiting descriptor of “family” would be a step too far; it would, in the words of Mr Justice Carr, cut protection down to the precise services in relation to which the mark has been used and would strip the Opponent of protection for services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them. In my view a fair specification for the services in evidence would be **restaurant, public house and bar services**.

#### **The section 5(2) claims**

14. Section 5(2) of the Act reads as follows

5.(2) A trade mark shall not be registered if because

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, or

(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.

15. The only difference between the claims under sections 5(2)(a) and (b) is that the former requires that the marks be identical, whereas section 5(2)(b) requires only similarity between the marks. The question of when a mark may be considered *identical* to another was addressed by the CJEU in *LTJ Diffusion SA v. Sadas Vertbaudet SA*<sup>9</sup>, where it held that “... a sign is identical with the trade mark where it reproduces, without any

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<sup>9</sup> Case C-291/00 at paragraph 54,

*modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”* While I note the submission by Mr Harrison that the word “Brewery” in the contested mark may be considered entirely non-distinctive in relation to its goods (craft beer), I do not consider the inclusion of the word so insignificant that it would go unnoticed by the average consumer. **I find that the marks are not identical and the claim under section 5(2)(a) must inevitably fail.**

16. Determination of a section 5(2)(b) claim must be made in light of 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. The principles are:
- (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 the goods and services**

17. The relevant comparison is between the goods and services in the table below:

<b>Opponent’s fair specification</b>	<b>Applicant’s goods</b>
<i>restaurant, public house and bar services</i>	<i>Craft beer</i>

18. In determining the extent to which the goods may be considered similar, I take account of the factors identified by the CJEU in Canon<sup>10</sup> where it stated that:

*“In assessing the similarity of the goods ... all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia, their nature,*

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<sup>10</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97C-39/97, at paragraph 23.

*their intended purpose and their method of use and whether they are in competition with each other or are complementary*".<sup>11</sup>

19. In *Boston Scientific*<sup>12</sup>, the General Court described goods / services as “complementary” in circumstances where “... *there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking*”. I also take note that in *Kurt Hesse v OHIM*<sup>13</sup>, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods.
20. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>14</sup> for assessing similarity were:
  - (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.
21. The Witness Statement of Mr Cohen, acknowledges that there is no exact definition in the UK for “craft beer” (or brewers thereof), but suggests that in line with a definition adopted by the Brewers Association in the USA, he believes that most UK consumers of such goods would understand a craft beer to derive from a brewery that is “small” (which is referenced as “annual production of 6 million barrels of beer or less”) and “independent” (which is defined as “less than 25% of the craft brewery is owned or controlled (or equivalent economic interest) by a beverage alcohol industry member that is not itself a

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<sup>11</sup> The essence of case law points on similarity made in relation to goods applies correspondingly to services.

<sup>12</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

<sup>13</sup> Case C-50/15 P

<sup>14</sup> *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

craft brewer"). In my view, distinctions on such bases will not be readily apparent to the average consumer and in any event *craft beer* is a category of beer and such goods are sold in pubs, bars and restaurants.

22. The Opponent offers services, whereas the Applicant seeks protection for goods; services and goods are different in their physical nature. However, there is a clear overlap in their uses, intended purpose, method of use and channels of trade, in that beers are sold in pubs and restaurants to quench thirst / offer the intoxication effect of alcohol. There is an overlap too in their shared users and also a degree of competition in that one may choose to buy craft beer to consume at home, rather than to buy and consume the same in the pub or restaurant.
23. There was some discussion at the hearing as to the extent to which the goods and services may be considered 'complementary' in the case law sense. The Applicant argued that pubs are not breweries and sell beers that have been brewed by others, and that the close connection between beer and pubs, whilst important or indispensable, does not arise in such a way that customers may think the responsibility for those goods lies with the same undertaking. For its part, the Opponent referred to its evidence of microbreweries in the UK also selling their beers for consumption on their premises (as indeed is explicit in the Collins dictionary definition provided by the Applicant in **Exhibit PDC6**). Moreover, **Exhibit ES1** shows that some microbreweries in the UK also sell food. In my view, while it is not normally the case that a pub or restaurant sells beer that it has itself brewed, I do not rule out that the goods and services could entail at least a degree of complementarity. However, whether or not the goods and services are properly regarded as complementary, **I consider them to be similar to a medium degree.**

### **The average consumer and the purchasing process**

24. In *Hearst Holdings Inc*,<sup>15</sup> Birss J explained that "... *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 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 word "average" denotes that the person is typical*".

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<sup>15</sup> *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), at paragraph 60.

25. The Applicant characterised the average consumer of craft beer as someone who will be particularly concerned about the production genesis of those goods. However, in my view, the average consumer both for craft beer and for pub/restaurant services will be a **member of the adult general public**. Craft beer is sold in supermarkets, off-licences, delicatessens, but also in pubs, bars and restaurants. The average consumer will see the trade mark on, for example, the bottle label for the goods or on a dispenser at the bar, or on a drinks list. In that way, the purchasing process is **predominantly visual**, although asking for a particular beer also entails an aural element. The average consumer will wish to ensure that they are selecting the correct size, type, strength and flavour of beer and may therefore pay a **medium level of attention**. The pub/restaurant services at issue will likely be selected after sight, for example, of promotional material in hard copy or online and of signage on the high street; visual considerations will thus be an important part of the selection process, although aural considerations are also significant on the basis of oral recommendations. The average consumer will pay **no more than a medium level of attention**.

### **Comparison of the marks**

26. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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 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."*
27. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<b>The contested mark:</b>	Hairy Dog Brewery HAIRY DOG BREWERY
<b>The Opponent's earlier trade mark</b>	Hairy Dog

28. The respective marks are both word-only marks. The Opponent argued that the word “brewery” in the contested mark is purely descriptive in relation to craft beer and should be disregarded in the comparison since it could be taken to indicate simply that the goods are from the brewery arm of the hairy dog business. In my view, the word is relevant for the purposes of assessing the similarity of the marks, although the words “hairy dog” are clearly the distinctive and dominant component of the marks.

*Visual similarity*

29. The contested mark is directly the same as the whole of the earlier mark but with the addition of the word "Brewery" at the end. The word "brewery" in the contested mark is not distinctive given its direct relationship to craft beer. The opening words "Hairy Dog" are the dominant and distinctive element of the contested mark. The respective marks are **visually similar to a high degree**.

*Aural similarity*

30. The first two (dominant and distinctive) words of the contested mark are the same as the whole of earlier mark and will of course be pronounced identically. The addition of the final, non-distinctive word "Brewery" in the contested mark introduces an aural difference, but overall the marks are **aurally similar to a high degree**.

*Conceptual similarity*

31. The words “Hairy Dog” in both marks of course carry the identical concept of a furry canine. The average consumer will perceive the word "Brewery" in the contested mark as being descriptive of a place where beer is made by a business under the distinctive name Hairy Dog. The marks are **conceptually similar to a very high degree**.

### **Distinctiveness of the earlier mark**

32. The distinctive character of the earlier mark must be assessed, as, potentially, the more distinctive the earlier mark, either inherently or through use, the greater the likelihood of confusion.<sup>16</sup> In *Lloyd Schuhfabrik*, 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-2779, 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)”.

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark may be enhanced by virtue of the use that has been made of it.

34. The earlier mark in this case uses ordinary English words, but they have no allusive reference to restaurant or pub services. It was submitted on behalf of the Applicant that the average consumer will be accustomed to different pubs across the country using the same name such as The Red Lion, The Royal Oak and The Black Sheep and that it would

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<sup>16</sup> *Sabel* at [24]

not be assumed that there was a connection between such undertakings, and that such names are not especially distinctive. The Applicant provided evidence at **Exhibit PDC8**, through the Wayback Machine, that in April 2013, there had been a live music venue in Derby called The Hairy Dog. In my view, that evidence does not undermine the distinctiveness of the mark relied on by the Opponent; the combination of its two words in relation to the relevant services is not in line with the prevalence of, say, The Red Lion as a pub name. I consider the earlier mark to **be inherently distinctive to a medium degree**.

35. Mr Harrison made no claim at the hearing that the distinctiveness of the mark has been enhanced through its use. I note that Mr Corbett refers in his witness statement to the earlier mark having “acquired tremendous reputation and goodwill throughout the United Kingdom in relation the services.” I have noted too his references to the annual turnover figures for 2014 – 2019 that were consistently well in excess of a million pounds, expenditure of tens of thousands of pounds on marketing, TripAdvisor having ranked the pub/restaurant as No. 20 of 103 places to eat in Minehead (**Exhibit 4**), and that the pub won a national award in 2005. However, in my view, the evidence does not establish that through use of the earlier mark in relation to the Minehead pub/restaurant its distinctive character has been enhanced throughout the UK.

### **Conclusion as to likelihood of confusion**

36. In my global assessment of likelihood of confusion, I take account of my findings set out in the foregoing sections of this decision and of the various principles from case law outlined in paragraph 16 above. My findings above may be summarised as follows: the parties’ goods and services are similar to a medium degree; the purchasing process will entail a level of attention no higher than medium; the consumer will primarily encounter the marks visually and I have found the marks to have a high degree of visual similarity; the consumer may also encounter the marks by oral recommendation or reference, and I find the marks to have a high degree of aural similarity. Conceptually the marks are very highly similar. The Opponent’s earlier trade mark has a medium degree of inherent distinctiveness for its services, and the evidence is insufficient to establish enhancement of its distinctive character on the basis of use.

37. Confusion can be direct or indirect. Whereas direct confusion involves the average consumer mistaking one trade mark for the other, indirect confusion is where the average consumer realises that the trade marks are not the same but puts the similarity that exists between the trade marks/goods down to the responsible undertakings being the same or related.
38. Consideration of likelihood of confusion is prospective and not to be restricted to the current marketing or trading patterns of the parties.<sup>17</sup> It is clear from case law that actual confusion is not the issue for section 5(2) claims.<sup>18</sup> The contention in the counterstatement as to the absence of any actual confusion between the parties to date is thus of no material assistance to the Applicant.
39. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.<sup>19</sup> Ms Blythe referred me to passages from the recent decision of Mr Daniel Alexander QC sitting as the Appointed Person in *ZOHARA*<sup>20</sup>, where he stated that consideration must be given to how realistically confusion might arise and that in evaluating the likelihood of confusion, a tribunal is entitled to focus more on the typical part of the “spectrum of consumers”. Although Ms Blythe emphasised a certain profile of the average consumer of the goods at issue as part of a craft beer cognoscenti, I have found that the average consumer is simply a member of the adult public; in my view, even a more discerning consumer may believe there is some connection between the Opponent and the goods, given the near identity of the marks and the similarity of the goods and services. Notional and fair use of the trade marks would certainly permit a pub, bar or restaurant, calling itself *Hairy Dog* to sell (craft) beer marked *Hairy Dog Brewery* and in such circumstances, it seems to me that there is a significant risk at least of indirect confusion on the basis, for example, that a consumer encountering the contested mark may believe that the direct overlap in the dominant and distinctive words in relation to similar goods and services is attributable to the responsible undertakings being the same or related. **There is therefore a likelihood of confusion.**

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<sup>17</sup> See *Oakley v OHIM* (Case T-116/06) at paragraph 76.

<sup>18</sup> For example, see paragraph 78 of the judgment of Kitchin L.J in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

<sup>19</sup> Kitchin L.J. in *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 at §34

<sup>20</sup> BL O/038/20 (see in particular paragraphs 25 and 27)

40. **Outcome:** The opposition has succeeded on the basis of its claim under section 5(2)(b); the application cannot proceed to registration.

### **COSTS**

41. This opposition has succeeded and the Opponent is entitled to a contribution towards its costs in this opposition process, in line with the scale published in the annex to Tribunal practice notice (2/2016).

Reimbursement of the official fee for Form TM7 Notice of Opposition:	£100
Preparing a notice of opposition and reviewing the defence and statement:	£200
Preparation of evidence and considering and commenting on the other side's evidence:	£600
Preparing for and attending a hearing	£600
<b>Total</b>	<b>£1500</b>

42. I order Hairy Dog Brewery Ltd to pay Christopher John Corbett the sum of £1500 (one thousand five hundred pounds). This sum is to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

**Dated this 18<sup>th</sup> day of March 2020**

*Matthew Williams*

**For the Registrar**

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