

**O/574/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3411040  
IN THE NAME OF SACRED HILLS VINEYARDS LIMITED FOR THE TRADE  
MARK**



**IN CLASS 33**

**AND**

**THE OPPOSITION THERETO UNDER NUMBER 600001229  
BY BLONDEL CLUFF**

**AND**


**CONSOLIDATED PROCEEDINGS IN RESPECT OF UK TRADE MARK  
REGISTRATION NO. 3391658  
IN THE NAME OF BLONDEL CLUFF FOR THE TRADE MARK**

**THE WHITE CLIFFS OF DOVER**

**AND THE APPLICATION FOR THE INVALIDATION THEREOF UNDER NO.  
502961 IN THE NAME OF SACRED HILLS VINEYARDS LIMITED**

## Background and pleadings

1. These are consolidated opposition and invalidation proceedings between Sacred Hills Vineyards Limited (Party A) and Blondel Cluff (Party B).
2. On 2 July 2019, Party A applied to register the trade mark no. 3411040 in the

UK for the mark . It was accepted and published in the Trade Marks Journal on 6 September 2019 in respect of the following goods:

*Class 33: Wine and wine-based beverages; alcoholic beverages (except beer).*

3. Party B opposed the trade mark in full under the fast track opposition procedure, based on Section 5(2)(b) of the Trade Marks Act 1994 (the Act). This was on the basis of its earlier UK trade mark no. 3391658 for the mark THE WHITE CLIFFS OF DOVER. The earlier mark was filed on 12 April 2019 and registered on 28 June 2019. The following goods are relied upon in the opposition:

*Class 33: Wine.*

4. From here on out, the proceedings set out in paragraph 3 will be referred to as “the opposition”.
5. At the time of filing the opposition, Party B submitted that the marks are similar and that the goods are either identical or similar to those under the earlier mark. Party B submitted in its TM7 that “The White Cliff of Dover are also popularly known as The White Cliffs”. Party B went on to state that The White Cliffs of Dover are where they live and work, and that there are no other white cliffs in the UK. Party B submitted that as a producer from New Zealand, Party A has other names available to them, whilst Party B does not.

6. On 17 December 2019, Party A filed an application to invalidate Party B’s trade mark no. 3391658, which was the sole basis for the opposition, under Section 5(2)(b) of the Act. From here on out, this will be referred to as “the invalidation”. The invalidation was based on the three earlier trade mark registrations as below:

<b>Territory and number</b>	<b>Trade Mark</b>	<b>Goods and Services upon which the invalidation is based</b>	<b>Filing /priority date</b>	<b>Registration date</b>	<b>From here on after referred to as:</b>
EU TM no. 6882484	WHITECLIFF	Class 33: Wine	1 May 2008	17 December 2008	
EU TM no. 6942429		Class 33: Wine	28 November 2007	8 January 2009	“Party A’s stylised mark” or “the stylised mark”
UK TM no. 3387411	WHITECLIFF	Class 33: Wine	28 March 2019	14 June 2019	“Party A’s word mark” or “the word mark”

7. Party A states that Party B’s registration no. 3391658 for the mark THE WHITE CLIFFS OF DOVER contains the earlier marks in full, and that there are clear visual, aural and conceptual similarities between the marks. Party A states that THE WHITE CLIFFS OF DOVER are popularly known and referred to as WHITE CLIFFS, and that the goods are identical. Party A claims that the high level of similarity between the marks and the identity between the goods means there is a likelihood of confusion, including a likelihood of association between the marks.

8. On 23 December 2019, Party A filed its defence to the opposition via a TM8 and counterstatement, outlining its registrations in the table above, and

confirming that cancellation action had been filed against Party B's trade mark no. 3391658. The defence filed requested a suspension to the opposition proceedings, pending the outcome of the invalidation.

9. In letters dated 20 January 2020, the Registry wrote out to Party A and Party B, acknowledging the filing of the TM26(I) for the invalidation, and confirming the consolidation of the fast track opposition no. 600001229 and cancellation number 502961, with cancellation no. 502961 to become the lead case, subject to and following the receipt of Party B's defence. Within this correspondence, both parties were advised to file one set of evidence in respect of the consolidated proceedings.
  
10. Also on 20 January 2020, Party B filed its defence by way of a TM8 and Counterstatement in respect of the invalidation. The defence denies the claims made by Party A, and states that "the trademark 'The White Cliffs of Dover' differs significantly from that of the opponent who is based in New Zealand, and has been chosen as a means of identifying the iconic location of our vineyard that is the only vineyard on The White Cliffs of Dover." Within the TM8, Party B requests proof of use of "all and any trademarks in question". Party B goes on to state that the requirements for trade descriptions means its product (said to be English Sparkling Wine) "could not be passed off as a product from New Zealand". Party B states that it does not use a tree element, nor are the White Cliffs of Dover recognised by one, but that there is one present in Party A's mark. Further, Party B claims that Party A has made several erroneous and/or unfounded assertions. Party B states that contrary to these assertions, the following is true:
  - "Whitecliff" has never been used to refer to The White Cliffs of Dover;
  - That there are other white cliffs in the vicinity of The White Cliffs of Dover, and that each of these cliffs has developed its own nomenclature;
  - That Party B's mark is five words, whereas Party A's is one word which is not recognised within the English language;

- That conventional retailing procedure in the UK means that the goods would not be sold next to each other as these would be sorted by colour, country of origin and the nature of the wine (still or sparkling);
- That the retailing procedure outlined above along with the tree device and the requirement for the country of origin to appear on wine labels “permits little scope, if any scope for confusion of the two products”;
- That Party A refers to ‘Cliff’ in singular form, within a word that is not known in the English language, whereas Party B refers to Cliffs in plural form.

11. As mentioned above, both parties filed evidence during the evidence rounds. This will be summarised to the extent considered necessary. Party A filed written submissions during the evidence rounds. Both parties opted to file written submissions in lieu of a hearing in these consolidated proceedings. Submissions will not be summarised in full but will be considered and referred to where appropriate throughout this decision. This decision is taken following a careful perusal of the papers.

12. Party A is represented by Marks & Clerk LLP within these proceedings. Party B is unrepresented.

## **Evidence summary**

### Evidence from Party A

13. Party A filed evidence by way of a witness statement in the name of Mr David Harrison and Exhibits DMH1 – DMH7.

14. Mr Harrison explains he is the Company Account/Finance Manager for Party A, having held the position since 14 January 2018. Mr Harrison explains the company structure, stating Party A is part of the Sacred Hill Group, and was originally incorporated under the name of Sacred Hill Wines Ltd on 1 June 1999, but changed its name to Sacred Hill Vineyards Ltd, as recorded on 26 April 2012. Mr Harrison has provided a chart showing the company structure

at **Exhibit DMH1** referencing various companies and showing Party A falling under the ownership of Sacred Hill Winery and Jebsen & Co (China) Limited. An extract from the New Zealand Companies Office Companies Register is provided at **Exhibit DMH2** showing the details of Party A's company registration.

15. Mr Harrison explains that WHITECLIFF branded wines were developed in the 1990s, and provides at **Exhibit DMH3** label design documents showing the front and back label designs as below, and dated 11 February 2014:



16. Mr Harrison explains in his witness statement that the above labels were for export to Denmark. Exhibit DMH3 also includes label design documents dated 27 February 2018 showing a front and back bottle design as below, which Mr Harrison explains were for export to Poland:



17. Annual turnover figures for “WHITECLIFF wines in the EU for the period of 2015- 2019” are set out by Mr Harrison in his witness statement as follows:

Year	Total Annual Turnover (€) (as of year-end 14 December)
2015	14,492
2016	27,528
2017	104,712
2018	98,531
2019	240,152

18. Screenshots showing a range of WHITECLIFF wines from whitecliffwines.com are shown at **Exhibit DMH4**. The screenshots are dated 24 March 2020. The images show a range of white, red and rose wines bearing the stylised mark. Mr Harrison explains that the wines are produced by Whitecliff Vineyards Limited, a subsidiary of the Sacred Hill Group.

19. Mr Harrison explains that **Exhibit DMH5** includes invoices for sales to wholesale wine importers in the EU. Mr Harrison states the invoices are issued both by Party A, and by Sacred Hill Global Limited as part of the Sacred Hill Group, the structure of which was set out under Exhibit DMH1. Mr Harrison confirms all items listed under WC relate to Party A’s WHITECLIFF wines and explains that the accompanying “Export Eligibility Statement” shows this. The documents show this to be the case, and purchase order documents also provided within this exhibit reference Whitecliff and correspond with the use of WC on the invoices provided. The invoices provided include nine with a billing and delivery address for Novin ApS in Denmark, six with a billing and invoicing address for Platinum Wines Sp. z o. o, in Poland, and one with a billing and invoicing address of Hayward Bros (Wines) Ltd, United Kingdom. The invoices are marked with “posting dates” between 16 March 2015 – 2 December 2019, and each show orders with a minimum of several thousand New Zealand dollars, euros or GBP (all converted into GBP by Party A on the invoices themselves, apparently for the purpose of the submission as evidence in these proceedings). Eleven of the sixteen invoices are issued in the name of Party A, and five are in the name of

Sacred Hill Global Limited as mentioned by Mr Harrison. I have set out further details of the invoices under Annex A to this decision.

20. Mr Harrison states that “the goods” have been sold to a number of wine stockists and retail outlets in the EU between 2014 – 2019, and lists the following businesses in Poland and Denmark:

- **Happy Wines , Federica Vinhandel, Nielsens Specialiteter, Supervin** in Denmark
- **Makro, Auchan, Selgros, E.Leclerc** in Poland

21. Screenshots of the wines for sale on various websites showing use of both the word mark and the stylised mark are provided at **Exhibit DMH6**. These include websites ‘nielsens-specialiteter.dk’, ‘happywines.dk’ and ‘fredericlavin.dk’. The sites show prices in ‘DKK’ ‘KR’ and ‘SEK’. All the screenshots are dated 24 March 2020. The site happywines.dk also shows a copyright date of 2020 on the page itself.

22. Mr Harrison explains that Party A’s WHITECLIFF wines are featured on Vivino, which he describes as “the world’s leading wine discovery application”, stating that it “currently has over 42 million users worldwide”. Mr Harrison has provided screenshots of the site [www.vivino.com](http://www.vivino.com) showing Party A’s wines featuring the stylised mark on the bottle of several varieties of wine described as White Cliff at **Exhibit DMH7**. This Exhibit also shows WHITECLIFF in use by “Sacred Hill” in an alternative stylisation as below:



23. These screenshots all show that the pages were accessed on 24 March 2020.



## Evidence from Party B

24. Party B has filed evidence by way of a witness statement from Blondel Cluff and **Exhibits A-E**.
25. Within the witness statement, Ms Cluff explains that The White Cliffs of Dover is where Party B's Vineyard is located, and has filed an image showing the location of the vineyard and her home at **Exhibit A**. The image is an aerial photograph showing a property located on a white cliffside near the sea.
26. Ms Cluff states the remainder of the land on The White Cliffs of Dover is owned by The National Trust and a small number of residences, and **Exhibit B** includes a photograph of a National Trust signpost referencing "The White Cliffs of Dover" and admission costs. Ms Cluff states none of the additional residences have the capacity to create a vineyard, meaning Party B's vineyard is the only one on The White Cliffs of Dover.
27. Ms Cluff states that Party B's vineyard will be used to produce English Sparkling Wine, and that regulations on the UK Government's Food Standards Agency mean it must be labelled as such, with reference to it being produced in England. Ms Cluff explains that the same regulations dictate that:
- "...wines imported from 'third countries', of which New Zealand is one, must provide mandatory information, including the country of origin, and shipper of the wine that should appear on the labelling of their bottles in a legible form. As such, some of the bottles depicted in the Opposition's evidence would not be allowed entry into the UK without additional wording that would include the words: 'New Zealand' that should be clearly displayed;"
28. Exhibit C, D and E are images of wines featured on the shelves of supermarkets, which Ms Cluff identifies as Tesco, Marks & Spencer and Sainsbury's. Ms Cluff explains she has taken these images based on the shops that have been accessible to her during "lockdown". The images show wines arranged by country of origin in Exhibit C & E, and by 'type' (sparkling, rosé) in Exhibit D.

29. Ms Cluff confirms that the size of Party B's vineyard is relatively small, and as such "our venture is unlikely to become international".

### **Preliminary issues**

30. As mentioned within the evidence summary above, Party B has filed evidence relating to both the location of its vineyard, in addition to evidence concerning the regulations surrounding the labelling of wine for sale in the UK, and images showing how different varieties of wine are positioned within some shops. In the opposition, Party B has commented on the availability of names to each party, and within the invalidation Ms Cluff of Party B has made reference in her witness statement to the current difficulties the local economy faces in Dover. Whilst I sympathise with Party B's comments, I find much of what has been submitted to be irrelevant to the issues which must be decided in these proceedings. I find it appropriate to address this at the outset of these proceedings, in order to clarify why these will not be considered in more detail at a later stage.

31. The first matter concerns the labelling regulations. Party B submits that the geographical origin must be displayed on each bottle in the UK. Ms Cluff states in her witness statement that the implication of the additional details on the bottle, as well as the placement in different sections on the shelves in supermarkets is that the consumer will differentiate between the products from the parties, leaving no realistic risk of confusion.

32. In *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, the Court of Justice of the European Union (CJEU) stated at paragraph 66 of its judgment that when assessing the likelihood of confusion under Section 5(2) it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered.

33. Further, in *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

34. It is clear to me that under the registration of *wine* (as far as this is maintained for the earlier marks) I must not only consider the possibility of Party A, for example, selling white wine produced and imported from New Zealand under its mark, and Party B producing and selling sparkling wine from the UK under its mark. Instead, I must consider the protection afforded to each party under the registration of each mark, and all circumstances under which they may be used. This will include the possibility that Party A, for example, may make legitimate use of its trade mark for sparkling wine in the UK, perhaps by way of offering a license to a UK based third party or otherwise – and vice versa. A consequence of this is that even if I did take from the evidence that the wine will be labelled with the location and type, and placed apart on the shelves of supermarkets accordingly (I note the latter part of this is disputed by Party A), then I could not be swayed by this in favour of Party B, on the basis that this particular set of circumstances is subject to change under the protection offered by the marks at hand.

35. Secondly, I note Party B’s comments in the opposition, namely that they have limited names available to them, in addition to the comments submitted in the invalidation that they should benefit from the goodwill and recognition attached to The White Cliffs of Dover in order to help their business succeed and in turn stimulate the local economy. I find these comments to be either incorrect or irrelevant, and to lack some understanding of both the purpose of a trade mark and trade mark law, and the discretion available to me when deciding on matters such as the one in hand. I wish to provide some clarity on this for the parties at this stage. The purpose of a trade mark is to designate

the economic and commercial origin of a particular set of goods or services, in a way that helps to differentiate those goods or services from those of other undertakings. Granting registered protection for a trade mark offers simultaneous benefits for both the consumer and the proprietor, enabling the consumer to make or avoid a repeat purchase as they wish, as well as enabling undertakings to benefit from the investment made in a particular brand. A trade mark registration is not for the purpose of ensuring the consumer is aware of the particular geographical location of a product, indeed there are other types of rights that may be used for this purpose where appropriate. Many parties will choose a trade mark that is unrelated to the origins of the product itself, or one that has no meaning. My point, in this context, is not to comment on the choice of mark by either party, because as will likely be repeated later in the decision, all registered trade marks will be treated as valid for the purpose of these proceedings. Instead, I wish to simply address that in my view, neither party is more restricted than the other in what they may choose or use as a trade mark due to their location in the context of these proceedings, and I do not consider this a factor to weigh into my decision in this instance. Further, whilst again I sympathise with Party B's wish to add to the local economy in these particularly difficult times, I do not have discretion to take factors such as a contribution to the local economy into account within this decision.

### **Proof of use**

36. The registration upon which the opposition filed by Party B is based was under five years old at the time the opposed application was filed, and so it will not be subject to prove of use under Section 6A of the Act. In respect of the three earlier registrations relied upon by Party A in the invalidation, one of these registrations will not be subject to the use requirements under Section 47 as outlined below, namely:

<b>Territory and number</b>	<b>Trade Mark</b>	<b>Goods and Services upon which the invalidation is based</b>	<b>Filing date</b>	<b>Registration date</b>
UK TM no. 3387411	WHITECLIFF	Class 33: Wine	28 March 2019	14 June 2019

37. I note the above mark is identical in the context of these proceedings in all respects (other than territory) to Party A's third trade mark, namely EU trade mark no. 6882484. Party A's EU trade mark no. 6882484 therefore adds nothing to the strength of Party A's position in these proceedings. For procedural efficiency an assessment of the genuine use made under Party A's EU trade mark no. 6882484 will therefore not be conducted, and instead the UK word mark will be considered for the goods as relied upon.

38. The second mark Party A has provided as a basis for the invalidation is subject to proof of use requirements set out under Section 47 of the Act. Details of this mark are outlined below:

<b>Territory and number</b>	<b>Trade Mark</b>	<b>Goods and Services upon which the invalidation is based</b>	<b>Priority date</b>	<b>Registration date</b>
EU TM no. 6942429		Class 33: Wine	28 November 2007	8 January 2009

39. At this point I consider whether Party A's stylised mark (above) assists its case in a way that differs from or contributes to the case put forward under the word mark, and whether I therefore believe further consideration of the invalidation action based on this mark is required. It is my view in this instance, that there are elements in the stylised mark that are not present in word mark that may assist Party A's case, in addition to those that may

detract from it. I therefore find that it would be inappropriate to cite procedural efficiency as a reason to conduct an assessment based only on the earlier word mark in this instance. I will therefore continue with my assessment of proof of use of Party A's stylised mark no. 6942429 under Section 47 as below.

**Relevant statutory provision: Section 47:**

40. Section 47 of the Act reads as follows:

"47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

(2ZA) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 5(6).

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if –

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered-

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application where, at that date, the five year period within which the earlier trade mark should have been put to genuine use as provided in section 46(1)(a) has expired, or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (2B) or (2C) to the United Kingdom shall be construed as a reference to the European Community.

(2DA) In relation to an international trade mark (EC), the reference in subsection (2A)(a) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(2E) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(2F) Subsection (2A) does not apply where the earlier trade mark is a trade mark within section 6(1)(c)

(2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.



(2H) The reasons referred to in subsection (2G) are-

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

(c) that the application for a declaration of invalidity is based on section 5(3)(a) and the earlier trade mark had not yet acquired a reputation within the meaning of section 5(3).

(3) An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that-

(a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court;

and

(b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

(4) In the case of bad faith in the registration of a trade mark, the registrar himself may apply to the court for a declaration of the invalidity of the registration.

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

41. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark:

*Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

42. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

43. Within the invalidation, the burden is on the Party A to show genuine use of its stylised mark within the European Union, within the relevant time frame, in respect of the goods as registered.

### **Form of the mark**

44. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use, it is necessary to review the instances where the proprietor has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use ‘of the mark’ for the purpose of the assessment.

45. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally

encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)".


46. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

"33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all."

47. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

48. I note the evidence filed by Party A is in black and white. However, I note also

that the mark  has been filed using black and grey. It is my view that fair and notional use of the mark allows for the use of this in various colours, and so I am not overly concerned by the use only being shown in black and white within the evidence. If there was any particularly unusual use of colour, I believe this would be clear from any differentiation in the shading shown on the evidence. Where the mark is shown, the shade used appears to be in solid blocks, and if it is the case that the marks are used in colour, I find this would fall within fair and notional use of the mark and would be acceptable in line with *Nirvana*. Other variants of the mark shown on the evidence provided by Party A (in respect of the stylised mark only) are as follows:

#### **Variant 1**

WHITECLIFF/WHITE CLIFF

49. The evidence filed shows use of the word mark WHITECLIFF and on occasion this is shown as the two words, WHITE CLIFF. The dominant and distinctive elements of Party A's stylised mark consist primarily of the two words WHITE CLIFF, with the tree device also adding to the overall impression of the same. Further, I find that the use of the conjoined 'l' in the stacked words WHITE and CLIFF add to the distinctive character of the mark. I find the use of this mark in word format omits some of the features that contribute to the distinctive character of the stylised mark, with the result of altering its distinctive character. I therefore find the use of WHITECLIFF or WHITE CLIFF in word format is not an acceptable variant of the stylised mark, in line with *Nirvana*. As I have established previously, Party A's wordmark WHITECLIFF is not subject to proof of use and will be considered as registered, and these findings relate to the use of the stylised mark only.

## Variant 2

50. As mentioned within the evidence summary, use of the mark is also shown in the following formats:



51. As mentioned above, there are several factors that add to the distinctiveness of Party A's earlier stylised mark in addition to the words WHITE CLIFF, including the use of the tree device, and the conjoined 'l' in the stacked words. I find that the use of the mark in the above format, in one long word in this script-like font, without the tree device or the conjoined 'l' ultimately alters the distinctive character of Party A's stylised mark, and I find this to be an unacceptable variant of the same in line with *Nirvana*.



## Evidence analysis and Genuine use

52. Under Section 47(2B)(a)(i) and 47(2B)(a)(ii), the relevant time frames within which Party A must prove use of its earlier EU TM no. 6942429 are as follows:

- The 5 year period prior to filing invalidation, namely 18 December 2014 - 17 December 2019) (“the first relevant period”); and
- The 5 Year period prior to the filing date (or priority date) of the application, namely 13 April 2014 – 12 April 2019 (“the second relevant period”).

53. As mentioned in my evidence summary, exhibits DMH1 and DMH2 both provide detail on the company arrangements and structure within which Party A falls. Whilst these exhibits offer little to show that genuine use of the mark has been made, I find these useful in the context of the later exhibits provided. Whilst most of the invoices provided at DMH5 have been issued in the name of Party A, five have been issued in the name of Sacred Hill Global Limited, which appears within the company structure chart. It appears that although the use of the mark is not always clearly attributable to Party A, where the use is made by another party this is based on at least an implied consent due to the relationship between the parties. I therefore find both use by Party A, as well as use by the related parties may be considered towards the picture of genuine use, as set out in *Ansul*.

54. Not all of the evidence provided falls within the relevant timeframes for proving use of the mark. Of the invoices provided,<sup>1</sup> seven fall outside of the second relevant period for proving use. In addition, the screenshots provided showing use of the mark on various webpages<sup>2</sup> all show the date of 24 March 2020, which sits outside of both the first and second relevant periods, and there is nothing to show the content of the pages was as shown during the

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<sup>1</sup> Exhibit DMH5

<sup>2</sup> Exhibits DMH6 & Exhibits DMH7

relevant timeframe. Further, I note copyright dates of 2020 feature both on the pages provided for Happy Wines<sup>3</sup> and Neilsen's Specialiteter<sup>4</sup> which again falls outside of the relevant time periods, and so I do not find these exhibits alone contribute towards genuine use of the mark. However, I will not disregard these exhibits entirely, as I find these to be useful when considering the picture of use conjured by the evidence as a whole, and I will revert back to this point in more detail shortly.

55. In respect of the label design documents provided<sup>5</sup>, one is dated '11 February 2014'. This falls outside of both relevant timeframes. However, I note that the purpose of the documents is to agree a design to affix to a bottle, in preparation for the product to be sold at a later date. Mr Harrison confirms these documents were for use on bottles of WHITECLIFF Pinot Noir 2011 for export to Denmark, and I note the importer listed on the label matches Party A's Denmark based wholesaler as referenced on later invoices. On balance it appears likely the labels are therefore for use with bottles for export and sale in Denmark during the at least the second relevant period, which began only two months or so after the design of the label, although I note that no reference to the export or order of the 2011 Pinot Noir pictured features within the invoices, order and export documents provided. Mr Harrison explains in his witness statement that the second label design documents were for use with bottles of WHITECLIFF Sauvignon Blanc 2017 for export to Poland. The importer on the design documents appears to be Platinum Wines SP. ZO.O. These are more easily matched with the invoices and export documents provided, which evidences sales of the 2017 Whitecliff Sauvignon Blanc to both Platinum Wines SP. ZO.O. in Poland, and Novin ApS in Denmark during both the first and second relevant time periods. This evidence combined shows use of the stylised mark as registered in respect of the sale and export of wine to customers in Poland. On balance, it also appears likely that the same mark would have been placed on the bottles of the 2017 Whitecliff

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<sup>3</sup> Exhibit DMH6

<sup>4</sup> Exhibit DMH6

<sup>5</sup> Exhibit DMH3

Sauvignon Blanc sold and exported to Party A's Denmark customer, Novin ApS.

56. It is clear from the invoices and export documents provided that it is not only the 2017 Sauvignon Blanc that has been sold to the consumers during the relevant time periods, and that there have been several varieties of Whitecliff wine sold and exported during the relevant time periods to wholesalers mentioned in Poland and Denmark, as well as to the UK in respect of the first relevant period. I note that the invoices themselves do not feature Party A's stylised mark, and it is impossible to tell from the references on the invoices alone when exactly the stylised mark was used as registered. However, as I have already mentioned, images of various bottles of wine featuring on different websites have been provided by the opponent. Whilst the pages provided are dated outside of the timeframe, the products shown in these exhibits include those which match products shown on the invoices, which were sold and exported either by Party A or with its implied consent to customers in Poland and Denmark, including the following wines:

Wines sold within the first relevant period<sup>6</sup>, where images in Exhibits DMH6 & DMH7 show use of the mark as registered:

- 2018 Pinot Noir; (Sold and exported to Poland and Denmark)
- 2019 Pinot Noir; (Sold and exported to the UK, Poland and Denmark)
- 2018 Sauvignon Blanc; (Sold and exported to Poland and Denmark)
- 2019 Sauvignon Blanc; (Sold and exported to the UK, Poland and Denmark)
- 2016 Chardonnay; (Sold and exported to Denmark)

57. Wines sold within the second relevant period<sup>7</sup>, where images in Exhibits DMH6 & DMH7 show use of the mark as registered:

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<sup>6</sup> As shown from the invoices at Exhibit DMH5

<sup>7</sup> As shown from the invoices at Exhibit DMH5

- 2018 Pinot Noir; (Sold and exported to Poland)
- 2018 Sauvignon Blanc; (Sold and exported to Poland and Demark)
- 2016 Chardonnay; (Sold and exported to Demark)

58. I have no reason to believe that these vintages would have been relabelled between the sales clearly evidenced during the relevant time periods, and their subsequent feature on the websites provided which fall outside of the relevant time period. I find wines to be unusual in that the date of production of a particular variety is noted as an important feature in respect of the products sold, and the number of bottles from each year will be limited, making it less likely these will be reproduced a number of times bearing different labels. I find it is also likely that other bottles would have used this mark during these time periods, although I note I cannot rely on this too heavily due to the use of an alternative WHITECLIFF mark also displayed within the evidence. On balance, it is my view that the sum of the evidence provided shows that Party A's stylised mark has been used in respect of the sale and export of wine (the goods as registered) to customers in Denmark, Poland and the UK within the first relevant time period, and use has also occurred in respect of Denmark and Poland within the second relevant period.

59. Now that I am satisfied that use of the stylised mark has been made within the relevant timeframes, within the relevant territory, in respect of the goods as registered (both by Party A and with its implied consent), I turn to the question of whether I believe the use shown to be genuine. The picture created by the evidence filed is that the use of this mark appears to have been fairly consistent throughout the relevant time period, and although the sales are to two or three customers only, it is clear these are wholesalers that have purchased the goods in larger quantities, often purchasing several hundred bottles in one transaction, amounting to the equivalent value of several thousand pounds in each purchase. I consider that the EU market for wine will self-evidently be large, and I find I am able to take notice of this even in the absence of evidence on this point from either party. I find the turnover figures provided to show that sales of Party A's wines in the EU account for only a very small part of the market as a whole, particularly as I find that some of this

turnover may be attributed to “WHITECLIFF wines” using a variant of the mark that I have found to be unacceptable to show use of the stylised mark itself. In terms of the breadth of the use, the use evidenced has not been particularly widespread, in the sense that it has been confined to two or three territories of the 28 within the EU. The courts have had considered the extent to which the sale in one territory may satisfy use of a mark registered throughout the European Union, and whilst I note that Party A has not submitted evidence confined only to one territory, I note the guidance set by the courts to be useful for considering the interplay of the territorial scope of the use alongside the other factors for considering if use of an EU mark is genuine.

60. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

...

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid

down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

61. There has been some back and forth on the interpretation of *Leno Merken* by the courts since the decision was issued. The General Court restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

62. Of course, in this instance the facts are not that the use of the mark in question has only been used in one territory in the EU. However, I find the territorial scope of the use, which as mentioned has been limited to two or three territories within the EU, remains a relevant factor for consideration within the multifactorial assessment of whether there has been genuine use of the mark in question. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5 year period.

63. It is my view that, upon conducting a multifactorial assessment of the use shown, on balance the sum of the evidence provided by Party A is sufficient for the purpose of creating and maintaining a market share for wine in the EU during the relevant period, and as such, genuine use has been established.

### **Fair specification**

64. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr

Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“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.”

65. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

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. 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."

66. I note in this instance that Party A has not shown use of its mark for each and every type of wine that may be available to the consumer. However, on the basis of the case law as set out above, it is my view that it would be inappropriate to narrow Party A's protection only to the particular and specific categories of wine for which use has been evidenced. It is my view that the average consumer would fairly describe Party A's goods as wines, and I therefore find they may enforce the protection of the goods "wines" within the invalidation.

## **DECISION**

67. As mentioned previously, the invalidation has been filed against Party B's registration, which is the sole basis of the opposition. Should the invalidation succeed against Party B's registration, the opposition will therefore fail. For



this reason, I will firstly consider the outcome of the invalidation filed, after which I will consider what this means for the outcome of the opposition.

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

68. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

## **The Principles**

69. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 and services**

70. The invalidation filed by Party A has been based on the class 33 goods *wine* in respect of both the earlier word marks and the earlier stylised mark. Proof of use was not required for the earlier UK word mark (which, as explained is identical to the earlier EU word mark for the purpose of this invalidation), and so *wine* may be relied upon under this mark. In addition, following the analysis of the proof of use, I have found that the opponent may rely on its protection for *wine* in class 33 under its earlier stylised mark. Party B's mark which is the subject of the invalidation is registered in respect of *wine* in class 33 only. The identity between Party A's and Party B's goods is therefore self-evident in this instance, and no further analysis on this point is required.


### **Comparison of marks**

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

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

72. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

73. The respective trade marks are shown below:

WHITECLIFF	THE WHITE CLIFFS OF DOVER
	
Earlier trade marks	Contested trade mark

74. The overall impression of the earlier wordmark resides in the mark as a whole, namely WHITECLIFF. The earlier word mark is shown as one word and no element of the mark appears to be more dominant or distinctive than the other elements. In respect of the earlier stylised mark, the most dominant and distinctive elements of this mark are the words WHITE CLIFF. I find the tree device to play a subordinate role in the mark, but I find it still adds to the overall impression of the same, as does the stylisation of the wording, in particular its stacked appearance with the conjoined 'l' running from the word WHITE into the word CLIFF.

75. In respect of the contested mark, Party A appears to argue that the element “OF DOVER” simply describes the location in which the wine is made, and submits that it therefore holds no, or at best minimal distinctive character. It is further articulated by Party A that the result of this is that dominant and distinctive elements of Party B’s contested mark are the words WHITE CLIFFS, with ‘THE’ also being apparently dismissed by Party A when considering the same. I note Party A has also submitted a broader argument, namely that Party B’s mark is arguably entirely without distinctive character, as it identifies the geographical landmark at which its wine is produced.

76. I have considered the arguments made by Party A in this respect, and I note that inherently, WHITE CLIFFS will hold a higher level of distinctiveness in respect of the goods than the words THE, OF and DOVER. However, it is my view that the mark THE WHITE CLIFFS OF DOVER hangs together to identify a very specific and particularly well-known location in the UK. Whilst I appreciate that the mark does appear to reference the location within which the wine is produced, I find this is true not just for the element “OF DOVER”, but in respect of the full mark, THE WHITE CLIFFS OF DOVER (as has also been argued by Party A), where it is clear the vineyard is located. I therefore find that to dismiss only the OF DOVER element of the geographical reference and focus attention solely on WHITE CLIFFS would be wrong in this instance. I find the full mark THE WHITE CLIFFS OF DOVER to contribute as a whole to the overall impression, with no element appearing more dominant than the rest.

### **Visual comparison**

77. Visually, the earlier word mark shares ten letters in common with the contested mark, and all elements of the earlier mark are included within the contested mark. However, the contested mark is considerably longer than the earlier word mark, consisting of five separate words compared to one. The marks both begin and finish differently, with the similarities featuring in the middle of the mark where the consumer will generally pay less attention. With consideration to the

visual similarities and differences between the word mark and the contested mark, I find them to be visually similar to a medium degree.

78. In respect of the earlier stylised mark, in addition to the differences present due to the additional wording in the contested mark as referenced above, there are further points of visual difference between the marks. I note that notional and fair use of the contested word mark will allow for its use in various stylisations, and so I do not find the layout to contribute to the visual differences found. However, I do find the conjoined 'l' in the earlier stylised mark falls outside of what I consider to be notional and fair use of the word mark filed, and this creates a further point of visual difference between the marks. In addition, the presence of the tree device in the earlier stylised mark that does not feature in the contested mark creates a further point of visual difference between the same. Overall, I find the earlier stylised mark to be visually similar to the contested mark to between a low and medium degree.

### **Aural comparison**

79. The verbal elements of the two earlier marks are WHITECLIFF in the word mark, and WHITE CLIFF in the stylised mark. These will be verbalised in a highly similar way, although I find the emphasis on the words may change as these go from one word for two. It is my view that the contested mark will be verbalised in full, as THE WHITE CLIFFS OF DOVER. Aurally, the verbal elements of the earlier marks feature nearly identically within the contested mark. However, the contested mark is aurally considerably longer than both earlier marks, and contains 6 syllables compared to the two syllables featured in the same. With consideration to both the aural similarities and the aural differences, I find both earlier marks are aurally similar to the contested mark to between a low and medium degree.

### **Conceptual comparison**

80. Party A submits that the earlier word mark will be understood by the consumer as meaning 'white cliff', namely "a geographical location that

contains or pertains to a white ridge on the coastline”. They submit that conceptually the stylised mark “would be understood by the relevant consumer as pertaining to a geographical location on the coastline, consisting of a white ridge with a tree (as depicted in the mark) growing on the top”. In both instances, Party A submits that the marks are highly similar conceptually to the contested mark, which they state “will be understood by the relevant consumer as pertaining to the world famous landmark, the White Cliffs of Dover, and that the goods produced under the mark originate from this landmark”. On the contrary, Party B submits “The trade mark of the opponent refers to a ‘cliff’ singular rather than ‘cliffs plural, and the word ‘Whitecliff’ is unknown in English, or in Dover”.

81. I note at this point that when filing the opposition proceedings that have been consolidated to this invalidation action, Party B had pleaded that The White Cliffs of Dover are popularly known as The White Cliffs. This is an argument that has been repeated in a similar way (but not identically) by Party A when filing the invalidation. Subsequently, within its defence in the invalidation proceedings, Party B was quick to refute the claim, although I note that in its response Party B refers to “Whitecliff” rather than, as Party A has mentioned, White Cliffs. I have considered the back and forth that has taken place between the parties in the context of the invalidation, and I do not find that Party A has conceded to conceptual similarity between the marks on the basis of the comments made, for the following reasons:

- The original statements were made by Party A in the context of separate (albeit it now consolidated) proceedings, prior to any consolidation being made;
- The comments were made with reference to a phrase that is not identical to the Party A’s earlier marks in these proceedings;
- Although there has been no explicit denial of the claims that “White Cliffs” is used to refer to The White Cliffs of Dover by Party B (rather, there was a denial that “Whitecliff” is not used), it is clear that in the context of the invalidation, at most Party B wishes to dispute this, and at the very least Party B appears to dispute the relevance of this to

these proceedings based on the differences between “White Cliffs” or “The White Cliffs” and Party A’s mark.

82. As I find the parties remain in dispute in respect of the conceptual comparison of the marks, I find it relevant for me to state my own view on this. I agree in part with Party A that the contested mark “will be understood by the relevant consumer as pertaining to the world famous landmark, the White Cliffs of Dover..”. However, in respect of Party A’s earlier word mark, it is my view that the single word WHITECLIFF will not immediately be interpreted by the consumer as construing “a geographical location that contains or pertains to a white ridge on the coastline”. I acknowledge it is often the case that when viewing a mark, even where a word is made up, the consumer may seek out the elements which, suggest a meaning<sup>8</sup>. Whilst I have considered if this will be the case here, and I find on the contrary, that the UK consumer are instead used to viewing words such as this one, beginning with the pre-fix “White” as indicating a surname, or alternatively, a place name. It is my view that the consumer will not attempt to breakdown this mark to give the meaning of a “white ridge on a coastline”, because they will instead instantly recognise the structure of this word lends itself to a name. Whilst I recognise that there may be a few consumers for whom the concept of a white cliff is conjured, I find for the most part, these marks are conceptually dissimilar.

83. However, I note that the earlier stylised mark separates the words WHITE CLIFF in a manner that appears to make them distinct entities within the mark. It is my view that upon viewing this mark, the consumer would instantly recognise the words and would conceptualise a white cliff, as described by Party A. Further, I note the particular tree device that has been used by Party A, and I agree that this does, in the context of the mark presented, conjure the

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<sup>8</sup> (Case T-356/02 *Vitakraft-Werke Wührmann v OHIM – Krafft (VITAKRAFT)* [2004] ECR II-3445, paragraph 51, and Case T-256/04 *Mundipharma v OHIM – Altana Pharma (RESPICUR)* [2007] ECR II-0000, paragraph 57).



concept of a white cliff with a tree on top as Party A describes. Whilst I note the concept of a white cliff will be present in both marks to an extent, I do find that there remains a significant conceptual difference between the reference to a generic white cliff (with a tree on top), and the definite article, as described by Party A “the world famous landmark, the White Cliffs of Dover”, which clearly has its own conceptual significance to the consumer. At best, I find Party A’s stylised mark to be conceptually similar to the contested mark to a medium degree. Further, if I am wrong about the way the Party A’s word mark will be interpreted by the consumer, I find instead that this reasoning will apply (other than in respect of the tree) and the marks will be at best, conceptually similar to a medium degree.

### **Average consumer and the purchasing act**

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

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

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

86. Before making a decision on the likelihood of confusion, I must first identify the relevant consumer. The relevant consumer of both the Party A's and Party B's goods (wine) will primarily consist of the general public over the age of 18. There may also be a portion of professional consumers purchasing the goods on behalf of a business, or for the purpose of running a business themselves. It is my view that a significant portion of members of the general public over the age of 18 will purchase the goods fairly frequently, either in a retail or hospitality environment, whereas the professional public is more likely purchase these in a wholesale environment. I note the price point of wines may range from relatively inexpensive to very expensive, but this will not be determinative of a high level of care for wines in general, and I find the purchase will not be one undertaken by the public with a particularly heightened level of care. The general public will likely consider various factors when purchasing the goods, including the type, geographical origin, taste and alcoholic content, and so I find an average level of attention will be paid. In respect of professionals, it is my view their attention will be enhanced due to the increased responsibility of purchasing these goods on behalf of a business, and the increased liability that will come with serving or selling the goods to consumers. I find the professional consumer will pay between an average and high level of attention when purchasing wines.

87. Where these goods are purchased in a retail environment, the consumer will rely predominantly on the visual inspection of the goods on shelves. Where the goods are purchased in a café, bar, restaurant, pub or nightclub, again this will be predominantly visual with marks most likely being displayed on and chosen from a drinks menu<sup>9</sup> or displayed on the bottles or boards visible behind the bar. However, as verbal orders will often be placed in these scenarios, aural considerations cannot be completely discounted.<sup>10</sup> I find that professionals will also make predominantly visual purchases, although on occasion orders may be placed verbally and so I also cannot completely disregard the aural comparison in respect of professionals.

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<sup>9</sup> See the decision of the General Court in case T-187/17, *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*

<sup>10</sup> See the decision of the General Court in *Stock Polska sp. z o.o. v EUIPO*, case T-701/15, in which it was found verbal ordering should be considered.

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

88. 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).”

89. As mentioned, Party A has submitted that the consumer will conceptualise a white cliff (or alternatively a white cliff with a tree on top), when viewing its marks. As stated previously, it is my view that Party A's earlier word mark would more likely be viewed by the consumer as an intentional single word indicating a surname, or alternatively, a place name, but I agree with Party A's comments in respect of its stylised mark. In both instances, I find that the

marks neither descriptive nor allusive of wine. Although I note that WHITECLIFF itself may not have a meaning within the English language, I believe that due its appearance as a surname or a place name, it holds an average level of inherent distinctive character. I find the stylised mark, consisting of two English words and a tree device also holds an average level of inherent distinctive character in respect of the goods.

90. Having reviewed the evidence provided, I do not find this sufficient to show that the level of distinctive character has been enhanced through use of either of Party A's earlier marks.

### **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

91. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 69 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

92. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is

indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings<sup>11</sup>.

93. I found the two earlier marks to be inherently distinctive to an average degree, and that the overall impression of the marks to reside in both marks as a whole. However, in respect of the stylised mark, I found the word elements WHITE CLIFF to be most dominant and distinctive within the same. I found Party B's contested mark hangs together and that the overall impression resides in its entirety.

94. I found the earlier word mark to be visually similar to a medium degree, aurally similar to between a low and medium degree, and conceptually dissimilar to the earlier contested mark. I have noted that if I am wrong about the conceptual dissimilarity, that the mark is at best conceptually similar to a medium degree. I found the earlier stylised mark to be visually similar to between a low and medium degree, aurally similar to between a low and medium degree, and conceptually similar to at best, a medium degree to the contested mark.

95. I found that Party A may rely on the goods as pleaded, namely *wine*, in respect of both the word mark and the stylised mark, and I found the goods to be self-evidently identical to those contested. I found the goods will be purchased primarily on visual inspection, by both members of the general public and professionals paying between an average to above average degree of attention to the goods. I also found that aural considerations should not be discounted.

96. I consider firstly the likelihood of direct confusion between the marks, keeping in mind the factors above and the submissions of the parties. As mentioned within the preliminary issues, Party B has put forward several arguments as to why I should not find confusion between the marks that are not relevant for

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<sup>11</sup> *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10,

this decision. I will not repeat my reasoning for this at this stage. Party A submits that as products will be found side by side in stores, it is quite conceivable that the consumer paying an average degree of attention will misread the contested mark and purchase Party B's products on the mistaken belief that it bears one of Party A's earlier marks.

97. I note the identity between the goods and consider this to be a factor in favour of Party A's argument. As mentioned above, I also found the consumer will be paying an average degree of attention when making a purchase of the goods. When an average degree of attention is paid, it is my view that at the very least the consumer will absorb each mark in full with the exception of elements that have been considered negligible, but I consider also that the marks may be imperfectly recollected following the event.

98. In this instance, it is my view that the conceptual meaning of the marks, particularly the depiction of a famous landmark in the contested mark, will help to fix the marks in the mind of the consumers, and make these easier to both recall and differentiate between. I note that conceptual differences alone are not determinative of a lack of likelihood of confusion between marks, and all factors, including the strength of the conceptual and other differences should be weighed and considered.<sup>12</sup> In this instance I note the aural and visual differences, not least the significant difference in length of the marks. In addition, I note the varying conceptual differences between the marks. I find the sum of these differences will not go unnoticed by the consumer paying an average degree of attention, even when the consumers imperfect recollection is accounted for. I therefore find there will be no likelihood of direct confusion in this instance.

99. In respect of the likelihood of indirect confusion, Mr Ian Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, set out some of the scenarios in which a likelihood of indirect confusion may apply. He stated:

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<sup>12</sup> See Mr Geoffrey Hobbs QC at paragraph 28, sitting as the Appointed Person *Diramode S.A. v. Richard Turnham and Linda Turnham* ("PIMKIE"), BL O/566/19

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).”

100. I note that the categories set out above are not exhaustive, and there is no requirement for the marks to fit neatly within one of these for indirect confusion to occur. In addition, I also keep in mind the comments of Mr James Mellor Q.C., as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which he stressed that indirect confusion should not be found merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark simply calls to mind another mark. This is mere association not indirect confusion.

101. Party A has set out its arguments that there will be a likelihood of indirect confusion between the marks in the following terms within its initial submissions:

“59. It must also be recalled that consumers rarely have the chance to examine marks side by side and must rely on the imperfect picture in their mind. In this sense, the aforementioned similarities may lead consumers to confuse the marks or indeed associate them in some way. The likelihood of confusion includes the likelihood of association, which occurs when the consumer assumes that due to the similarities of the marks, they derive from the same undertaking, or indeed, an economically linked undertaking (*Canon*).

60. This is clearly the case here. The relevant consumer may see the Contested Mark as being a brand variation for the identical goods sold within the same market sector. The distinguishing word elements in the Contested Mark are “OF DOVER”. Accordingly, the mark “THE WHITE CLIFFS OF DOVER” would be confusingly understood by the relevant consumer as being a brand extension of the Applicant’s earlier WHITECLIFF mark, namely that the Applicant has begun producing a localised sub-brand produced in Dover. The Applicant argues that this is particularly likely in the alcoholic beverages sector, and refers back to paragraph 56 regarding the purchase process for alcoholic beverages in bars and restaurants where consumers are not provided with a visual representation of the respective bottles, but merely the word marks. Due to the average consumer’s imperfect recollection of a trade mark, there exists both a real likelihood of confusion and association in this instance.”

102. These arguments are echoed within Party A’s final written submissions, with a further comment that this is particularly likely in respect of wine, due to wine producers offering different types of wine under “similar umbrella brands”. These arguments appear to fall loosely within category B as set out by Mr Ian Purvis Q.C. in *L.A. Sugar*, with it being submitted that ‘OF DOVER’ will simply indicate a “localised sub-brand produced in Dover” of Party A’s WHITECLIFF goods. When considering these submissions, I also note the additional submissions that have been put forward by Party A in the course of these proceedings. Particularly, I note that Party A has made several



references to the level of distinctiveness of the contested mark, including the following comments:

“The Contested Mark “THE WHITE CLIFFS OF DOVER” is descriptive of the geographical origin of the Registered Proprietors goods specified under the mark, in other words, that they are produced and originate from the world-renowned landmark, the White Cliffs of Dover. In fact, the Registered Proprietor has stated in her counterstatement that the Contested Mark “has been chosen as a means of identifying the iconic location of our vineyard”. In particular, the Registered Proprietor has specified that the White Cliffs to which her goods are produced on or relate to are the world-famous white cliffs of Dover. While the Applicant submits that they do not believe the Contested mark has the requisite level of distinctiveness to function as a badge of origin or to qualify for registration as a trade mark, for the purposes of these proceedings, the Applicant purports that the Contested Mark is of no distinctive character, or at most, low distinctive character.”

103. Further, I note Party A also submits that the contested mark will be understood as pertaining to the “world famous landmark, the White Cliffs of Dover” when considering the conceptual comparison of the marks. It is clear from the above comments that Party A is of the view that consumers will see the mark THE WHITE CLIFFS OF DOVER and immediately view this as identifying the “world-renowned landmark”, and that accordingly the goods are derived from that area. It seems to me that the fame of the landmark and the recognition of such by the UK consumer is not in dispute by either party to these proceedings. Party A has submitted on this basis that the distinctive character of the contested mark is such that it is not functioning as a trade mark, or for the purpose of these proceedings, that it is barely functioning as one.

104. I note firstly that for the purpose of these proceedings, all registered marks are assumed to hold at least a low level of distinctive character, and that the registration of the contested mark is not in dispute on the basis of its

distinctiveness. Further, I make no assertion that where it is submitted by the opposing party that a contested mark holds no/or only a low level of distinctive character that this will preclude a finding of likelihood of confusion. I also make no comment in these proceedings on the functioning of Party B's mark as a trade mark.

105. However, I find these submissions from Party A to nonetheless be relevant at this stage. As I have previously mentioned, I agree with Party A that "the world-renowned landmark, the White Cliffs of Dover" will be immediately brought to mind by Party B's mark. It is my view that this reasoning, as set out by Party A itself and with which I agree, is incompatible with Party A's further argument that the consumer, when seeing the contested mark, would break this down in such a way that OF DOVER has no longer hangs together with THE WHITE CLIFFS element to depict the famous landmark, and that it will instead be perceived by the consumer that Party B's mark simply indicates a sub-brand of Party A's WHITECLIFF mark, which has been produced in Dover. I have considered the possibility that both of these things may occur simultaneously in the mind of the consumer, but it is my view that it is very unlikely the consumer will come to this conclusion. I have also considered the point pleaded but not substantiated by Party A that The White Cliffs of Dover are popularly known as "White Cliffs". As such, I have contemplated whether this may sway my view on the likelihood of indirect confusion in this matter. However, without further clarification or evidence on this point, I am not convinced by the same, and I find that this is not a fact upon which I may take judicial notice, never having come across this myself. Furthermore, even if this should be the case for a small number of consumers, I do not find this will be considered by a significant enough proportion of consumers (who will also need to ignore or fail to notice the difference between the WHITE CLIFFS nickname claimed and the earlier marks for this assumption to be made), to consider this sufficient for the invalidation of the earlier mark on this basis.

106. For the reasons set out above, it is my view that should the consumer notice that both marks contain WHITE CLIFF (in the earlier stylised mark),

WHITECLIFF in the earlier word mark and the words WHITE CLIFFS in the contested mark, they would put this down to coincidence, and not assume an economic connection between the marks on this basis. I therefore find no likelihood of indirect confusion between the marks.

## The opposition

107. As I have found no likelihood of confusion between the marks, the invalidation fails. As this has failed, the earlier mark in the opposition proceedings remains valid, and I must consider the outcome of the opposition filed by Party B. As a reminder, I have summarised the facts of the opposition below.

108. Party B filed an opposition based on the earlier UK trade mark no. 3391658 for the mark THE WHITE CLIFFS OF DOVER. The earlier mark was filed on 12 April 2019, and registered on 28 June 2019, and so it will not be subject to proof of use under Section 6A of the Act. The following goods are relied upon in this opposition:

Class 33: *Wine*.

109. The opposition was filed against Party A's UK trade mark application

no. 3411040 in the UK for the mark . It was accepted and published in the Trade Marks Journal on 6 September 2019 in respect of the following goods:

Class 33: *Wine and wine-based beverages; alcoholic beverages (except beer)*.

110. The opposition has been filed on the basis of Section 5(2)(b) of the Act, and the evidence filed is as set out in the evidence summary.

111. Within the invalidation proceedings above, I have established that the above marks are visually and aurally similar to between a low and medium degree, and conceptually similar to a medium degree at best. I have found that the average consumer of *wine* will be both members of the general public over the age of 18 paying an average degree of attention, as well as some professional consumers paying an above average degree of attention. I find this extends to all goods in this instance.

112. I have found identity between all goods within the invalidation above, and whilst the goods comparison in the opposition is slightly more nuanced, for the purpose of procedural economy I will assume that identity has been found. In the invalidation proceedings, I found an average level of distinctiveness of the earlier mark within the earlier. In this context, it is the distinctiveness of Party B's mark that must be considered. However, as I find the distinctiveness of the earlier mark will not exceed this level, either inherently or through use, again for the purpose of procedural efficiency, I will assume that an average level of distinctiveness held by the earlier mark. I find on the basis of these assumptions, which in my view will be generous in favour of the opponent, Party B, that the facts of this opposition mirror those of the invalidation, within which no likelihood of confusion has been found. It is therefore my view that on the basis of the reasoning set out in the invalidation proceedings, there will be no likelihood of direct or indirect confusion between the marks. As such, the opposition fails.

### **Final Remarks**

113. The outcome is no likelihood of confusion in respect of both the invalidation action and the opposition action filed, meaning both have been unsuccessful. Registration no. 3391658 for the mark THE WHITE CLIFFS OF DOVER in the name of Blondel Cluff will remain registered, and application

no. 3411040 in the UK for the mark  in the name of Sacred Hill Vineyards Limited may proceed to registration for all goods.

## **COSTS**

114. Both parties have achieved success in these consolidated proceedings in equal measure. I therefore find that each party should bear its own costs within these proceedings.

**Dated this 17th day of November 2020**

**Rosie Le Breton  
For the Registrar**

## Annex A

No.	Invoice no.	Invoice date	Sales listed (relating to "WC")	Details of recipient (billing and delivery)	Invoice issued by	Value of order (relating to WC)
1	INV35810	16/03/15	13 WC M Pinot Noir 750ml – quantity 84 14 WC H Chardonnay 750ml – quantity 84 13 WC M Sauv Blanc 750ml – quantity 15 14 WC M Sauv Blanc 750ml – quantity 49	Novin ApS Denmark	Party A	17,160 NZD
2	INV38118	21/05/16	15 WC M Sauv Blanc 750ml DE – quantity 250 15 WC M Sauv Blanc 750ml DE – quantity 128 13 WC M Pinot Noir 750ml DE – quantity 150 15 WC H Chardonnay 750ml DE – quantity 50	Novin ApS Denmark	Party A	39,180 NZD
3	INV40037	29/04/17	16 WC M Sauv Blanc 750ml DE Novin – quantity 336 15 WC H Chardonnay 750ml DE Novin – quantity 83	Novin ApS Denmark	Party A	25,638 NZD
4	INV41214	0/11/17	17 WC M Sauv Blanc 750ml DE – quantity 600 16 WC H Chardonnay 750ml DE – quantity 300 16 WC H M Pinot Noir 750ml DE – quantity 93	Novin ApS Denmark	Party A	63,984 NZD
5	INV42373	30/05/18	17 WC M Sauv Blanc 750ml DE – quantity 600	Novin ApS Denmark	Party A	36,000 NZD (prepayment discount applicable)
6	INV43418	20/11/18	18 WC M Sauv Blanc 750ml DE – quantity 448	Novin ApS Denmark	Party A	26,880 NZD (5% prepayment discount given)
7	INV44721	12/05/19	18 WC M Sauv Blanc 750ml DE – quantity 675 18 WC Sauv Blanc 750ml DE – quantity 25 18 WC M Pinot Noir 750ml DE – quantity 250	Novin ApS Denmark	Party A	51,500 NZD
8	INV000107	8/11/19	19 WC M Sauv Blanc 750ml DE – quantity 175	Novin ApS Denmark	Sacred Hill	11,462 NZD

			19 WC M Sauv Blanc 750ml DE – quantity 350 19 WC M Sauv Blanc 750ml DE – quantity 25 19 WC M Pinot Noir 750ml DE – quantity 56		Global Ltd	
9	INV000106	25/11/19	19 WC M Sauv Blanc 750ml DE – quantity 814 19 WC M Sauv Blanc 750ml DE – quantity 952 19 WC M Pinot Noir 750ml DE – quantity 712	Novin ApS Denmark	Sacred Hill Global Ltd	73, 940.50 NZD
10	INV41622	8/01/18	17 WC Sauv Blanc 750ml PL – quantity 300	Platinum Wines Sp. z o. o, Poland	Party A	9,720 Euro (including discount of 10%)
11	INV42326	28/05/18	17 WC M Sauv Blanc 750ml PL – quantity 560	Platinum Wines Sp. z o. o, Poland	Party A	16,329.60 Euros (including discounts)
12	INV43778	30/12/18	18 WC M Sauv Blanc 750ml PL – quantity 458 17 WC M Pinot Noir 750ml PL – quantity 49 18 WC M Pinot Noir 750ml PL – quantity 203	Platinum Wines Sp. z o. o, Poland	Party A	23,146.60 Euros (including discounts)
13	INV44972	07/06/19	18 WC M Sauv Blanc 750ml PL – quantity 588 18 WC M Pinot Noir 750ml PL – quantity 251	Platinum Wines Sp. z o. o, Poland	Party A	27,105.96 Euros (including discounts)
14	INV000032	06/08/19	18 WC M Sauv Blanc 750ml PL – quantity 349 19 WC M Sauv Blanc 750ml PL – quantity 239 18 WC M Pinot Noir 750ml PL – quantity 218 19 WC M Pinot Noir 750ml PL – quantity 34	Platinum Wines Sp. z o. o, Poland	Sacred Hill Global Limited	27,147.96 Euro (including discounts)
15	INV000105	25/11/19	19 WC M Sauv Blanc 750ml PL – quantity 840	Platinum Wines Sp. z o. o, Poland	Sacred Hill Global Limited	27,216.00 Euro (including discounts)
16	INV000125	02/12/2019	19 WC M Sauv Blanc 750ml UK – quantity 559 19 WC M Pinot Noir 750ml UK – quantity 55	Hayward Bros (Wines) Ltd, United Kingdom	Sacred Hill Global Limited	37,665 GBP