

O-646-20

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS  
IN THE MATTER OF  
TRADE MARK APPLICATION NOS. 3406653 AND 3406648  
BY BLACK SHEEP DISPENSARIES LTD  
TO REGISTER**

**BLACK SHEEP DISPENSARIES**

**AND**



**AS TRADE MARKS IN CLASSES 1 AND 5**

**AND**

**OPPOSITION THERETO  
UNDER NOS. 417797 AND 417819  
BY CONILON LTD**

## Background and pleadings

1. Black Sheep Dispensaries LTD (“the applicant”) applied to register the following trade marks shown below under numbers 3406653 (“word mark”) and 3406648 (“logo mark”) in Classes 1 and 5 on 13 June 2019 and 18 July 19, respectively:

word mark: Black Sheep Dispensaries

logo mark:



2. The applications for word mark and logo mark were published for opposition purposes on 21 June 2019 and 5 July 2019, respectively.
3. Registration of the applicant’s marks is opposed by Conilon Ltd (“the opponent”). It filed two notices of opposition based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The section 5 (3) claims were later dropped from both the oppositions as the opponent did not file evidence in relation to those claims. The oppositions therefore proceed solely based upon section 5(2)(b) of the Act. The oppositions are directed against all the goods in the applications, namely:

Class 1      Antioxidants for use in the manufacture of food supplements;  
                 Proteins for use in the manufacture of food supplements;  
                 Vitamins for use in the manufacture of food supplements.

Class 5      Food supplements; Food supplements consisting of amino  
                 acids; Food supplements consisting of trace elements; Food  
                 supplements for non-medical purposes; Food supplements for  
                 sportsmen; Food supplements for veterinary use; Food  
                 supplements in liquid form; Dietary food supplements; Health

food supplements for persons with special dietary requirements; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Medicated food supplements; Medicated supplements for foodstuffs for animals; Mineral food supplements; Mineral supplements to foodstuffs; Vitamin and mineral food supplements; Vitamin preparations in the nature of food supplements; Anti-oxidant food supplements; Antibiotic food supplements for animals;

4. For both oppositions, the opponent relies upon the following United Kingdom (“UK”) and European Union (“EU”) trade mark registrations:

UK trade marks -

**Mark 1:** BLACK SHEEP

Filing no.: 3212500

Filing date: 13 February 2017

Not yet registered.

Services:

Class 43 Services for providing food and drink; café services; bar services; coffee shops; cocktail bars.

**Mark 2:** BLACK SHEEP COFFEE

Filing no.: 3331402

Filing date: 13 August 2018

Registration date: 09 November 2018



**Mark 3:**

Filing no.: 3331403

Filing date: 13 August 2018

Registration date: 09 November 2018

The opponent's Marks 2 and 3 are registered in respect of goods and services specified in precisely the same terms as one another. They are as follows:

Class 30 Coffee; coffee based beverages; coffee based beverages containing butter; coffee based beverages containing oil; brewed coffee; unroasted coffee; coffee beans; iced coffee; frappes; coffee mixtures; coffee flavourings; instant coffee ; coffee substitutes; chocolate; chocolate extracts; chocolate sauces; chocolate beverages; coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastry and confectionery; ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; pasta; biscuits; buns; sushi; tarts; prepared foods; prepared meals; fruit sauces; convenience food and savoury snacks namely corn, cereal, flour and sesame based snacks, crackers, dumplings, pancakes, pasta, rice and cereal dishes, pies and pastry dishes, sandwiches and pizzas, spring and seaweed rolls, steamed buns, tortilla bread dishes; salts, seasonings, flavourings and condiments; baked goods, confectionery, chocolate and desserts; sugars, natural sweeteners, sweet coatings and fillings, bee products; ice, ice creams, frozen yogurts and sorbets; processed grains, starches, and goods made thereof, baking preparations and yeasts.

Class 43 Services for providing food and drink; mobile coffee shop service; supplying of meals for immediate consumption; bar services; bistro services; cafe services; cafés; cafeteria services; cafeterias; canteen services; canteens; catering (food and drink-); catering for the provision of food and beverages; catering of food and drinks; catering services; catering services for the provision of food; catering services for the provision of food and drink; club services for the provision of food and drink;

coffee shop services; coffee shops; consultancy services relating to food; consultancy services relating to food preparation; delicatessens [restaurants]; drink dispensing machines (rental of); fast food restaurant services; fast-food restaurants; food cooking services; food preparation; food preparation services; food service apparatus (rental of -); food takeaway service; hospitality services [food and drink]; mobile catering services; provision of food and drink; provision of food and drink in restaurants; provision of information relating to the preparation of food and drink; rental of food service apparatus; rental of food service equipment; restaurant services; restaurants; tea room services; tea rooms.

EU trade mark registration:

**Mark 4:** Black Sheep Coffee

Filing no.: 012654828

Filing date: 03 March 2014

Date of entry in register: 30 June 2014

Goods and services relied upon:

Class 30 Coffee; Coffee drinks; Coffee beverages; Coffee mixtures; Substitutes (Coffee -); Artificial coffee; Coffee concentrates; Coffee oils; Coffee beans; Coffee (Unroasted -); Flavoured coffee; Chocolate coffee; Instant coffee; Ground coffee; Coffee essence; Artificial coffee; Coffee flavourings; Unroasted coffee; Iced coffee; Coffee extracts; Coffee essences; Decaffeinated coffee; Beverages (Coffee-based -); Mixtures of coffee; Mixtures of malt coffee with coffee; Coffee based fillings; Prepared coffee and coffee-based beverages; Freeze-dried coffee; Caffeine-free coffee; Ground coffee beans; Chicory [coffee substitute]; Coffee based drinks; Coffee-based beverages; Roasted coffee beans; Mixtures of malt coffee extracts with coffee; Mixtures of coffee essences and coffee extracts; Coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; Beverages made

from coffee; Beverages made of coffee; Beverages with coffee base; Beverages based on coffee; Artificial coffee and tea; Coffee extracts for use as substitutes for coffee; Coffee essences for use as substitutes for coffee; Vegetable based coffee whiteners; Coffee in brewed form; Chicory based coffee substitute; Sugar-coated coffee beans; Coffee in ground form; Coffee beverages with milk; Beverages consisting principally of coffee; Coffee-based beverage containing milk; Coffee in whole-bean form; Coffee substitutes [grain or chicory based]; Ice beverages with a coffee base; Preparations for making beverages [coffee based]; Mixtures of malt coffee with cocoa; Chocolate bark containing ground coffee beans; Coffee substitutes (Vegetal preparations for use as -); Coffee, teas and cocoa and substitutes therefor; Coffee [roasted, powdered, granulated, or in drinks]; Chicory for use as substitutes for coffee; Vegetal preparations for use as coffee substitutes; Chicory mixtures for use as substitutes for coffee; Aerated beverages [with coffee, cocoa or chocolate base]; Aerated drinks [with coffee, cocoa or chocolate base]; Extracts of coffee for use as flavours in foodstuffs; Extracts of coffee for use as flavours in beverages; Roasted barley and malt for use as substitute for coffee; Filters in the form of paper bags filled with coffee; Chicory and chicory mixtures, all for use as substitutes for coffee.

Class 43 Coffee shops; Coffee shop services.

5. The opponent argues that there is a likelihood of confusion, including a likelihood of association, because the respective marks are either identical or similar, and the goods and services are similar. The applicant filed a counterstatement denying the grounds of oppositions.
6. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.

7. The oppositions were subsequently consolidated.
  
8. The opponent is represented by Bird & Bird LLP, and the applicant is a litigant in person. Neither of the parties filed evidence or written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

## **DECISION**

### Section 5(2)(b)

9. 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”.

### Section 5(2)(b) – case law

10. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *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 the 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 greater 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;

the earlier mark, is not sufficient;



(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

11. When making the comparison, all relevant factors relating to the goods and services in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (CJEU) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

12. Guidance on this issue has also come from Jacob J. (as he then was) *British Sugar Plc v James Robertson & Sons Ltd* (the Treat case), [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular

whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

14. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

15. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

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

whilst on the other hand:

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

### **My approach in comparing the parties' goods/services**

16. I note that there is an overlap in the specifications of Marks 2, 3 and 4 so far as coffee-related goods and services are concerned. I will, therefore, consider the specifications of those marks together. Where there is no overlap in the specifications of those three earlier marks, I will refer to any such goods and services so far as I consider it necessary. For reasons that will become apparent, I will consider the opponent's Mark 1 later in the decision.

### Applicant's goods v Opponent's goods / services under Marks 2, 3 and 4

### **Contested goods in Class 1**

Antioxidants for use in the manufacture of food supplements; Proteins for use in the manufacture of food supplements; Vitamins for use in the manufacture of food supplements.

17. The applicant's goods are ingredients used in the manufacture of food supplements. The opponent's goods in Class 30 include coffee, coffee-based or coffee substitute products. Those respective goods of the parties differ in nature and purpose. Their channels of trade do not coincide. It does not appear, nor there is evidence, that the applicant's goods are important for the use of the opponent's goods. They are, therefore, not complementary in the sense

described by the case law. The goods do not compete. Considering these factors, I find that these goods are dissimilar.

18. I do not consider that the remainder of the goods in the opponent's specification would place the opponent in any better position. They also differ in nature, purpose and method of use. Their channels of trade do not coincide. They are neither complementary nor do they compete. The applicant's goods are dissimilar to all of the goods covered by the opponent's specification under Marks 2,3 and 4.

19. I also do not consider that the applicant's goods are similar to any of the opponent's services under Class 43. The opponent specifies various services around providing food and drink, including café, coffee shop, bar or cocktail bar services. There is an intrinsic difference between the nature and the method of use of the applicant's goods and the opponent's services, as is the case with any goods and services. The purpose of the opponent's services is to provide facilities for the consumption of food and beverages, while the applicant's goods are nutrients used for the preparation of food supplements. The competing goods and services, therefore, differ in their purposes. The users may overlap on a high level of generality. The goods and services are not complementary in the sense described by the case law, nor do they compete. Weighing up these factors, I find that the applicant's Class 1 goods are dissimilar to the opponent's various food and drink services in Class 43.

20. I also consider that the opponent's consultancy and rental services covered by Class 43 of Marks 3 and 4 are also dissimilar to the applicant's goods due to the difference in nature, purpose, method of use and channels of trade. The competing goods and services are neither complementary nor in competition.

### **Contested goods in Class 5**

Food supplements; Medicated food supplements; Food supplements consisting of amino acids; Food supplements consisting of trace elements; Food supplements for non-medical purposes; Food supplements for sportsmen; Food supplements in

liquid form; Dietary food supplements; Health food supplements for persons with special dietary requirements; Health food supplements made principally of minerals; Health food supplements made principally of vitamins; Mineral food supplements; Mineral supplements to foodstuffs; Vitamin and mineral food supplements; Vitamin preparations in the nature of food supplements; Anti-oxidant food supplements

21. The applicant's Class 5 goods are intended to balance nutritional deficiencies which is not the same purpose as the opponent's coffee, coffee-based or coffee substitute products that are usually consumed for their taste or to feel energised. I am mindful that the applicant's goods are also available in liquid form; however, I do not consider that that overlap in nature with the opponent's goods is particularly strong. The competing goods are not complementary in the sense described by the case law. Their channels of trade do not coincide. The goods do not compete. The users may overlap, but that factor alone is not determinative of a finding of similarity. Considering all these factors, I find that the competing goods are dissimilar. However, if I am wrong in this finding, then the goods are similar only to (at best) a very low degree.

22. Although I have found that there is only (at best) a very low degree of similarity between the opponent's coffee or coffee-based products, the opponent's Mark 3 and 4 also cover other items such as honey, cereals, prepared meals or rice, which I think are similar to a low degree to the applicant's goods for the following reasons. Goods such as honey, cereals, prepared meals or rice may be consumed not only for their taste or to satiate hunger but also for their health benefits. To that extent, I consider that there is a partial overlap in purpose with the applicant's goods which are also consumed to improve health. The users may overlap. The food supplements which are generally available in capsule, liquid or powder form differ in their nature from the opponent's cereals, prepared meals or rice. They also differ in nature from the opponent's honey which is usually slightly thick and sluggish in nature. Although the applicant claims that its products are food supplement which contain cannabidiol-based coconut oils and honey, I do not consider that that any correlation between the competing goods is enough for it to be accepted from the customer's point of view that the

goods originate from the same undertaking. The competing goods are not complementary in the sense described by the case law. The goods may be available in the same stores such as supermarkets; however, there is nothing to suggest that they are sold in close proximity. The goods do not compete. It is considering these factors, that I find that the competing goods are similar to a low degree.

Food supplements for veterinary use; Medicated supplements for foodstuffs for animals; Antibiotic food supplements for animals;

23. I see no obvious similarity between any of the opponent's goods and the food supplements for veterinary use, nor have I any submission from the opponent on why it considers its goods to be similar to the applicant's goods. These contested goods of the applicant are consumed by animals, while the opponent's goods are meant for human use. The nature and purpose of the goods are, therefore, different. The competing goods are not complementary in the sense described by the case law, nor do they compete. Considering these factors, I find that the competing goods are dissimilar.

24. I also consider that the applicant's goods are dissimilar to the opponent's services of provision of food and drink. The goods and services inherently differ in nature, purpose and method of use. Their channels of trade do not coincide. They are neither complementary nor do they compete.

25. In *Waterford Wedgwood plc v OHIM – C-398/07 P* (CJEU), it was held that some similarity of goods is essential to establish a likelihood of confusion.

26. As I have concluded that there is no degree of similarity between the opponent's goods and services covered by Marks 2, 3 and 4 and the applicant's following goods:

Class 1: Antioxidants for use in the manufacture of food supplements; Proteins for use in the manufacture of food supplements; Vitamins for use in the manufacture of food supplements.

Class 5: Food supplements for veterinary use; Medicated supplements for foodstuffs for animals; Antibiotic food supplements for animals

the opposition against these goods fails.

### Opponent's Mark 1

27. I note that the opposition filed against this mark has been suspended pending a High Court proceeding. As this mark has not been registered yet, were the opposition to succeed on the basis of this earlier mark, any such outcome could only be provisional, pending the earlier mark achieving registration. However, Mark 1 covers services for providing food and drink; café services; bar services; coffee shops; cocktail bars in Class 43 – and I have already concluded at paragraphs 19 and 24 that the above-mentioned services are dissimilar to the applicant's goods.

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

28. It is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods and services are likely to be selected by the average consumer.

29. 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”.

30. The average consumer of the goods is a member of the general public. The goods are likely to be subject to self-selection from retail premises, ranging from supermarkets to pharmacies, and any online equivalents, where visual considerations will dominate. I do not, however, rule out an aural aspect to the purchase process. The average consumer may pay attention to factors such as ingredients or price. In the case of food supplements, the packaging is likely to be subject to closer scrutiny to ensure that it is fit for the desired purpose. Food supplements covered by the applicant's mark are less frequently purchased than the opponent's goods and are generally fairly low cost. I consider that the average consumer is likely to pay a medium degree of attention to the purchase process of all the goods.

#### **Distinctiveness of the earlier marks**

31. The distinctive character of the earlier marks must be considered. The more distinctive they are, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).

32. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested



by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

33. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods/services have the lowest. Distinctiveness can also be enhanced through use of the mark. The opponent has not filed any evidence of use of the marks. Therefore, I have only the inherent position to consider.

34. I will first consider the position in relation to the opponent’s Marks 2 and 4. The marks contain the words “Black Sheep Coffee”. The expression “black sheep” is not a novel coinage and has the metaphorical connotations of standing out from the herd. Black Sheep is neither allusive nor descriptive of any of the goods. The term coffee is descriptive of some of the goods such as coffee or coffee substitutes. The combination in my view, has no more than a medium degree of inherent distinctive character.

35. In addition to the words “Black Sheep”, the opponent’s Mark 3 contains the phrase “Special Coffee Beans” and a figurative representation of a sheep head, seemingly wearing sunglasses. The sheep’s head merely purports to reinforce the concept of sheep in the mark. The phrase “Special Coffee Beans” is descriptive or allusive of some of the goods in the specification. Considering these factors, I find that the mark as a whole is distinctive to a medium degree.

36. My conclusion applies equally to goods related to coffee as well as to the remainder of the goods in the opponent’s specification.


## **Comparison of marks**

37. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated 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.”

38. It would be wrong, therefore, artificially to 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.

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

Opponent's trade marks	Applicant's word mark
<p>Mark 2: BLACK SHEEP COFFEE</p> <p>Mark 4: Black Sheep Coffee</p> <p>Mark 3:</p> 	<p>BLACK SHEEP DISPENSARIES</p>

## Marks 2 and 4

40. The only difference between the Marks 2 and 4 is that they differ in their letter case. As notional and fair use would entitle the opponent to use its word mark in upper or lower type cases, there is no material difference between these two earlier marks. I will, therefore, consider these marks together for the purpose of comparison. The opponent's marks are comprised of the words "Black Sheep Coffee". I have already concluded that the opponent's mark possesses no more than a medium degree of distinctive character. The word coffee is presented in an identical size as "Black Sheep". In so far as the opponent's goods are coffee/ coffee-related, the words 'black sheep' bear alone the distinctive message of the mark. This is not the case in respect of goods that are not coffee related, where each of the words contributes more equally to the overall impression. However, since the words black sheep are the opening words of the opponent's mark, I allow that those two words may still be marginally more dominant in the overall impression.

41. The applicant's mark is comprised of the words "Black Sheep Dispensaries". *Collins English Dictionary* defines dispensary as a place where medicine and medical supplies are dispensed.<sup>1</sup> The term is, therefore, clearly not descriptive of the applicant's goods. The applicant's food supplements are not considered medicines *per se*; however, the term "dispensaries" is likely to invoke a connection in the average consumer's mind between the applicant's goods and a dispensary. In this regard, I bear in mind that food supplements are routinely available for purchase in a dispensary. Although limited in distinctive character, the word "Dispensaries" is longer in length than and presented in an identical size as "Black Sheep". In my view, all the words make roughly an equal contribution to the overall impression of the mark.

42. In terms of visual and aural comparison, both marks coincide in words "Black Sheep". This creates a degree of visual and aural similarity. However, there is also a visual and aural difference due to the presence of the word dispensaries

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<sup>1</sup> See <https://www.collinsdictionary.com/dictionary/english/dispensaries> [Accessed 11 December 2020]

in the applicant's mark and coffee in the opponent's mark. Considering these factors, I find that the marks are visually and aurally similar to a medium degree.

43. In a conceptual comparison, both marks invoke an identical concept of black sheep. However, the words "dispensaries" and "coffee" in the respective marks create a degree of conceptual difference. Weighing up these factors, I find that the marks are conceptually similar to a medium degree.

### Mark 3

44. The opponent's Mark 3 consists of a number of elements, (i) a stylised circular device, presented in black, with a roughly scalloped edge, forms the background, (ii) the words BLACK SHEEP are presented in capital letters at the top, (iii) a device of a sheep head wearing sunglasses appears at the center, (ii) a semi-circular device presented at the bottom contains the words (a) COFFEE in capital letters at the center, (b) presented on either side of the word COFFEE are the words SPECIAL and BEANS in capital letters with borders on top and bottom (iv) two stylised rounded devices in black separate the words BLACK SHEEP and the semi-circular device. I have already concluded that the opponent's mark possesses a medium degree of distinctive character.

45. Given its size and position, I consider that the words BLACK SHEEP, which are likely to be read together, and the device of a sheep head dominate the overall impression of the mark. The word COFFEE does contribute to the overall impression of the mark, but due to its size and positioning, a lesser role. The remaining elements are very small and will make only a very limited contribution to the overall impression conveyed.



46. Visually both marks coincide in the presence of the words BLACK SHEEP. In terms of differences, the opponent's mark contains a number of additional elements including a stylized circular device, the word COFFEE and an image of a sheep head none of which feature in the applicant's mark. The applicant's mark also contains the word dispensaries which is absent from the opponent's mark. Considering the similarities and differences, and my assessment of the

overall impression of the marks, I find that the visual similarity between the competing marks is low.

47. In an aural comparison, it is well-established that when a trade mark consists of a combination of words and figurative components, the trade mark is most likely to be referred to by the words. Bearing in mind my assessment of the overall impression of the mark, the word elements that are likely to be vocalised in the opponent's mark are "BLACK SHEEP"; the limited (at best) distinctiveness of the other elements in the mark makes it unlikely that they will be articulated. The competing marks, therefore, coincide in the pronunciation of the word BLACK SHEEP. The aural difference is then introduced by the word dispensaries in the applicant's mark which does not have a counterpart in the opponent's mark. Considering these factors, I find that the marks are aurally similar to a medium degree.

48. In a conceptual comparison, both marks coincide in the concept of a black sheep. The opponent's mark also contains an image of a sheep head presented in white. I bear in mind that the opponent's mark is registered in black and white and, therefore, the notional and fair use would entitle the opponent to use the mark in colour. Accordingly, sheep presented in white is unlikely to represent a contrasting concept from that of a black sheep. The opponent's mark also contains the concept of coffee which is absent from the applicant's mark. The concept of dispensaries in the applicant's mark does not have a counterpart in the opponent's mark either. Considering these factors, I find that the marks are conceptually similar to a medium degree.

49. The trade mark to be compared are as follows:

Opponent's marks	Applicant's logo mark
<p>Mark 2: BLACK SHEEP COFFEE</p> <p>Mark 4: Black Sheep Coffee</p> <p>Mark 3:</p> 	

### Marks 2 and 4

50. I have already commented on the overall impression and distinctiveness of the earlier rights at paragraphs 40 and 44.

51. The applicant's mark consists of a circular device within which appears (i) the words BLACK SHEEP DISPENSARIES in white, (ii) a faintly etched image of a sheep head at the centre, (iii) two leaf devices in green on either side that separate the words BLACK SHEEP from DISPENSARIES. The words and devices are presented on a black background, and the outer layer of the circular device is presented in green.

52. Visually, both marks coincide in the presence of the words BLACK SHEEP. In terms of differences, the applicant's mark contains a number of additional elements including a circular device, leaf device and an image of a sheep head none of which have counterparts in the opponent's mark. The applicant's mark also contains the word dispensaries which is absent from the opponent's mark and the opponent's mark contains the word "coffee" which is absent from the applicant's mark. Considering the similarities and differences, and my assessment of the overall impression of the marks, I find that the visual similarity between the applicant's mark and Marks 2 / 4 is low.

53. In an aural comparison, the competing marks coincide in the pronunciation of the word BLACK SHEEP. The aural difference is introduced by the words “dispensaries” and “coffee” in the respective marks. Considering these factors, I find that the marks are aurally similar to a medium degree.

54. In a conceptual comparison, both marks coincide in the concept of a black sheep. The image of a sheep head in the applicant’s mark is likely to reinforce the concept of sheep. In terms of differences, the opponent’s mark also contains the concept of coffee, which is absent from the applicant’s mark. The concept of dispensaries in the applicant’s mark does not have a counterpart in the opponent’s mark either. Given that food supplements covered by the applicant’s specification can include cannabis-based supplements, the average consumer is likely to recognise the leaf devices in the applicant’s mark as cannabis leaf, although I accept that that will not be the case for all consumers. Considering these factors, I find that the marks are conceptually similar to a low degree.

### Mark 3

55. Visually both marks coincide in the presence of the words BLACK SHEEP. There are a number of differences between the marks. Although both marks are presented in a circular device, the device in the opponent’s mark is stylized. There are also striking differences between the presentation of the sheep head in both marks. The words BLACK SHEEP in the opponent’s mark is presented in a bigger size than the rest of the words while all the words in the applicant’s mark are presented in identical size. There are also differences in the devices that separate the words BLACK SHEEP from the rest of the words in the respective marks. Considering the similarities and differences, and my assessment of the overall impression of the marks, I find that the visual similarity between the competing marks is low.

56. In an aural comparison, I have already concluded at paragraph 47 that the opponent’s mark is likely to be articulated as BLACK SHEEP. The competing marks, therefore, coincide in the pronunciation of the word BLACK SHEEP. The

aural difference is then introduced by the word “dispensaries” in the applicant’s mark which does not have a counterpart in the opponent’s mark. Considering these factors, I find that the marks are aurally similar to a medium degree.

57. Conceptually, both marks coincide in the concept of a black sheep. The sheep head in the respective marks is likely to reinforce the concept of sheep, although the sheep depictions are notably different in their stylings. The opponent’s mark also contains the concept of coffee, which is absent from the applicant’s mark. The concept of dispensaries in the applicant’s mark does not have a counterpart in the opponent’s mark either. As already mentioned, some average consumers are likely to recognise the leaf devices as cannabis leaves, although I consider that that will not be the case all consumers. Considering these factors, I find that the marks are conceptually similar to a degree that is between low and medium.

### **Likelihood of confusion**

58. I must consider the matter in relation to those goods in the applications that I have found to have a degree of similarity to the opponent’s goods (even if low or very low).

59. The case law factors for assessing likelihood of confusion that I set out above have a degree of interdependency and must be weighed against one another in a global assessment (Canon at [17]; Sabel at [22]). They must be considered from the perspective of the average consumer and a determination made as to whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

60. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the



marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertaking being the same or related).

61. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

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

62. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

63. I will first consider the position in relation to the opponent’s Marks 2 and 4. In my view, even taking into account the effects of imperfect recollection, the words “coffee” and “dispensaries” are prominent enough to avoid direct confusion. The leaves only indirect confusion to be considered.

64. Earlier in the decision, I concluded that the respective marks are visually, aurally and conceptually similar to a medium degree. I also concluded that the goods will be selected primarily by visual means with a medium degree of attention and the goods are similar to either low or (at best) a very low degree. I also found that the earlier mark is distinctive to no more than a medium degree in respect of the goods where any similarity exists.

65. Although the marks are visually, aurally and conceptually similar to a medium degree, the medium degree of the distinctive character of the opponent's mark and the distance between the goods is sufficient, in my view, to dispel a likelihood of indirect confusion. I am of the view that the average consumer, when faced with the competing goods which are similar to no higher than a low degree, is likely to put the similarities between the marks down to co-incidence as opposed to economic connection. There is no likelihood of indirect confusion.

66. Concerning the opponent's Mark 3, the non-coinciding elements in the competing marks are sufficiently prominent to avoid direct confusion.

67. I concluded that the respective marks are visually and conceptually similar to a low degree and aurally similar to a medium degree. I also concluded that the goods will be selected primarily by visual means with a medium degree of attention and the goods are, at best, similar to a low degree or (at best) very low degree. I also found that the earlier mark is distinctive to a medium degree in respect of the goods where any similarity exists.

68. Balancing these factors, I find that the average consumer who pays a medium degree of attention to the purchase process would retain the differences between the marks as part of his or her recollection of each mark. Considering the distance between the goods and the medium degree of distinctive of the earlier mark, I find that there is no likelihood of indirect confusion.

## **Conclusion**

69. The oppositions have failed, and the applications will proceed to registration.

### **Costs**

70. The applicant has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016.

Preparing the counterstatement and

considering the notice of opposition: £200

Total: **£200**

71. I order Conilon Ltd to pay Black Sheep Dispensaries LTD the sum of £200. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 18<sup>th</sup> of December 2020**

**Karol Thomas**

**For the Registrar**

**The Comptroller-General**