

**O/049/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF:  
TRADE MARK APPLICATION NO. 3473849  
BY GERRY'S TONIC LIMITED TO REGISTER**

**GERRY'S**

**IN CLASS 32**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001435  
BY GERRY'S LTD**

## BACKGROUND AND PLEADINGS

1. Gerry's Tonic Limited ('the applicant') applied to register the trade mark GERRY'S in the United Kingdom ('UK') on 10 March 2020. It was accepted and published in the Trade Marks Journal on 27 March 2020 in respect of the following goods:

***Class 32: Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; soft drinks; tonic water; energy drinks; syrups and other non-alcoholic preparations for making beverages.***

2. On 27 July 2020, Gerry's Ltd ('the opponent') opposed the trade mark on the basis of section 5(2)(a) of the Trade Marks Act 1994 ('the Act') under the Fast Track opposition procedure. This is on the basis of its earlier UK Trade Mark<sup>1</sup> and the opposition is directed against all goods in the application. The details of the earlier mark and the goods relied upon are as follows:

<b>Earlier Trade Mark</b>	UK Trade Mark Registration ('UKTM') no. 3471179 for Gerry's
<b>Goods relied upon</b>	<b><i>Class 33: Alcoholic beverages (except beer)</i></b>
<b>Relevant dates</b>	<b>Filing date:</b> 01 March 2020 <b>Date of Registration:</b> 09 August 2020

3. The opponent argues that the respective goods are similar and that the marks are identical. The opponent submits that the physical nature of the goods is the same (carbonated drinks), that there are shared users (of those looking for a healthy beverage) and various distribution channels. The opponent requests the contested mark is refused in its entirety and that an award of costs is made in their favour.
4. The applicant filed a counterstatement denying the claims made, including that the average consumer and shop placement of the goods differ. Within their

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<sup>1</sup>For the avoidance of doubt, given the dates of its filing, this mark qualifies as an 'earlier mark' in accordance with section 6 of the Act.

counterstatement the applicant also requested the opponent proved that tonic is primarily used as a mixer for gin-based alcohol drinks.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Marks Rules 2008 (the provisions which provide for the filing of evidence), but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

*“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”*

6. The net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. The opponent filed a witness statement and a number of exhibits. However, the Tribunal advised the opponent that leave needed to be sought for the evidence to be admitted and that, in any event, the evidence also contained without prejudice material which would have rendered the evidence inadmissible. The opponent was given an opportunity to request a case-management conference to discuss the preliminary view that the evidence should not be admitted; none was requested. In view of this, the evidential material provided will not be taken into account.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at a proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. The applicant did not file written submissions, but I will treat the contents of its counterstatement as its written submissions. The opponent filed written submissions in lieu of a hearing. The submissions will not be summarised but will be referred to as and where appropriate during this decision, although the following should be noted:

- References in the submissions to the non-admissible evidence referred to above will not be taken into account.

- A reference to a leading tonic producer’s website will similarly not be taken into account, as this would constitute evidence for which no leave has been sought, and, in any event, no extract of the website itself was provided.
- References of fact to the respective domain names the parties hold will not be taken into account for similar reasons.

8. The opponent is self-represented by Paul Wyber, acting as its Director and CEO, and the applicant is professionally represented by Oakleigh IP Services Limited.

## **DECISION**

### **Section 5(2)(a)**

9. The opposition is based upon section 5(2)(a) of the Act which reads as follows:

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

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

*(b) .....*

*there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.*

### **Case law**

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

*(Trade Marks and Designs) ('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, 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 marks

11. The respective trade marks are shown below:

Earlier trade mark	Contested trade mark
Gerry's	GERRY'S

12. As it is a prerequisite of section 5(2)(a) that the marks be identical, I will begin by assessing whether they are identical within the meaning of the case law.

13. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union ('CJEU') held that:

*"54 ... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where,*

*viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”*

14. Both the earlier trade mark and the contested trade mark are word marks consisting only of the word ‘GERRY’S’/‘Gerry’s’. Whilst the contested mark is fully capitalised, the earlier trade mark only capitalises the G. In that respect, I point towards Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, case BL O/281/14:

*“It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks ...A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”*

Bearing the aforementioned in mind, despite the fact that one is entirely in uppercase and the other is not, these two marks are identical.

### **Comparison of goods**

15. For the purpose of the comparison of goods analysis, I find it useful to point out section 60A of the Act, which states:

*“60A (1) For the purpose of this Act goods and services-*

*(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.*

*(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.*

*...”*

Put simply, this means that whether the goods are in the same or in different classes, is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods at issue and whether they are similar or not having regard to the case law that follows.

16. When it comes to understanding what terms used in specifications mean and cover, the guidance in the case-law is to the effect that “*in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of the trade*”<sup>2</sup>. Also, that I must bear in mind that words should be given their natural meaning within the context in which they are used; they cannot be given an unnaturally narrow meaning<sup>3</sup>. As Lord Justice Arnold summarised when setting out the correct approach to interpreting broad and/or vague terms in *Sky v Skykick* [2020] EWHC 990 (Ch):

*“...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded.”*

17. In the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer*, Case C-39/97, the court stated at paragraph [23] of its judgment that:

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<sup>2</sup>See *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281

<sup>3</sup>See *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another* [2000] FSR 267



*“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”.*

18. The relevant factors for assessing similarity were identified by Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At paragraph [296], he identified the following:

*“(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.”*

19. Regarding the complementarity of goods, 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. Also, in *Boston Scientific Ltd v 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.”*

20. Additionally, in *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods is to assess whether the relevant public are liable to believe that responsibility for the goods lies with the same undertaking or with economically connected undertakings.

21. I also bear in mind the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

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

Whilst on the other hand:

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

Further, when considering complementarity, that a test too rigid should not be applied:

*“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly*

*right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, 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. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.*

22. The goods for comparison are as follows:

<b>Opponent’s goods</b>	<b>Class 33: Alcoholic beverages (except beer)</b>
<b>Applicant’s goods</b>	<b>Class 32: Non-alcoholic beverages; mineral and aerated waters; fruit beverages and fruit juices; soft drinks; tonic water; energy drinks; syrups and other non-alcoholic preparations for making beverages.</b>

23. I will make the comparison with reference to the applied for goods, grouping them together when it is relevant to do so<sup>4</sup>.

24. Much of the opponent’s focus relates to the earlier mark covering a range of pre-mixed canned alcoholic beverages where natural flavours are combined with soda or tonic water and mixed with a spirit. I accept that the specification as registered would cover such goods, although I bear in mind that the earlier mark covers other alcoholic drinks too. The opponent also highlights that tonic water (which is clearly covered by the applicant’s specification) is a mixer for gin. They further that both parties’ goods would “*sit next to each other on supermarket shelves*”.

25. The applicant highlights that their mark covers a range of goods (as applied for). The applicant stresses that there is a “*very substantial*” difference between alcoholic and non-alcoholic beverages in that alcoholic beverages can only be sold by licensed shops and are usually situated on one shop aisle, whereas non-alcoholic products can be sold without restriction and across the shop floor.

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<sup>4</sup> See *Separode Trade Mark BL O-399-10 (AP)*

## *Non-alcoholic beverages*

26. I find the applicant's "*non-alcoholic beverages*" covers various beverages without alcohol content such as fruit juices, pop, and, notably in this case, the non-alcoholic versions of alcoholic beverages (like cocktails, spirits, wine and cider). The opponent's "*alcoholic beverages (except beer)*" include alcoholic short drinks (including spirits like gin and vodka) and longer drinks (such as cider). Focusing particularly on the comparison between the alcoholic and their non-alcoholic equivalents (e.g. alcoholic spirits/cider v non-alcoholic spirits/cider), the nature and production between the parties' goods differ in that one contains alcohol and the other does not, although part of the production process may be the same and the end product (alcohol aside) will be similar. Both will be sold on tap (particularly cider) or in similar receptacles. I find some overlap in consumption for pleasure and their flavour, though note they may be consumed for differing reasons (for instance, non-alcoholic for health and alcoholic as an intoxicant). The goods may share some users (namely those over the legal age for consuming alcohol), producers and distribution channels. For example, both beverages can be served in pubs and restaurants and found together or nearby in a retail premises, over the counter at a bar and on a menu, although there may still be some differentiation within aisles on the basis of alcohol content. I additionally find an element of competition where non-alcoholic beverages (such as alcohol-free gin, wine and cider), are offered and marketed as an alternative to their alcoholic equivalent.

27. Whilst I acknowledge that other goods covered by the term non-alcoholic beverages might only have a low (or no) degree of similarity, I find that the opponent's "*alcoholic beverages (except beer)*" (for which no fall-back specification has been filed) includes goods which are similar to the applicant's "*non-alcoholic beverages*" to a medium degree.

## *Tonic water*

28. Tonic water is a carbonated drink with dissolved quinine. The opponent submits that tonic water is never used other than as a mixer and is "*primarily used as a mixing flavour for gin based alcoholic drinks*". Although there is no evidence on this

point, and although tonic water can be consumed on its own, I can take on judicial notice that it is commonly used as a mixer for alcoholic drinks, especially gin. I have also already accepted that the opponent's term alcoholic beverages would, in addition to spirits such as gin, cover ready mixed beverages, such as pre-mixed gin and tonic.

29. Comparing tonic water with the spirit gin, and whilst they are both liquid (beverages) in nature, one is an alcoholic spirit usually consumed in short measures (albeit often mixed with something else, such as tonic), whereas the other is wholly non-alcoholic and used as a longer mixer (or consumed alone). The users overlap in respect of consumers who are over the legal age for consuming alcohol, although tonic water can be purchased by those under the legal age too.

30. In terms of trade channels, whilst it is likely that categorisation and shelf placement will be different, they might be in reasonably close proximity to aid the consumer selecting gin and its common mixer, tonic water. I am also aware that gift sets can be purchased which include both gin and tonic. The goods do not compete. However, whilst I have no evidence that tonic manufacturers often produce gin (or vice versa), the average consumer would regard them as important for each other given that gin and tonic is such a synonymous combination. It is possible that the average consumer might see that relationship is one where the responsibility for those goods lies with the same undertaking. Given all this, and the synonymous link between gin and tonic, I find it difficult to say that there is no similarity. However, any similarity is of a low degree.

31. Comparing tonic water with a ready mixed drink containing, for example, both gin and tonic, there is less complementarity, but more of a competitive relationship as the average consumer may purchase an alcoholic beverage in a pre-mixed form (for instance, a gin and tonic beverage) instead of straight tonic water, of which the consumer may mix with gin after purchase. The nature of the goods is more similar in that they both contain tonic water. They could be sold in similar receptacles (such as cans) and may be in reasonably close proximity. I find the applicant's "*tonic water*" has a low level of similarity to the opponent's "*alcoholic beverages (except beer)*".

### *Mineral and aerated waters*

32. This term specifically covers still and aerated water. Whilst these are also non-alcoholic beverages, due to this term's specificity, my analysis differs. Water is a natural beverage and is consumed throughout the day typically for its health benefits and use quenching thirst. In contrast, alcoholic beverages are typically unhealthy and consumed for pleasure, their taste or for their intoxicating effects. The users can be shared consumers over the legal age for consuming alcohol, though water is also aimed at consumers of all ages. Whilst the opponent's alcoholic beverages may share trade channels (such as restaurants and retail stores) with the applicant's mineral and aerated waters, I do not consider the goods to be placed or listed in a close proximity. Neither do I consider there to be any complementarity or competitiveness. In making that finding I am aware that water could be mixed with spirits (such as whisky) but the level of importance is less (compared to tonic water/gin) and there is not the same type of synonymous relationship. I consider the goods dissimilar, or if I am wrong on that then any similarity must be very low.

33. In considering this term I bear in mind that tonic water is a type of mineral/aerated water, goods for which I have already found low similarity. However, and depending on my final outcome, this term could be excluded from the specification.

### *Fruit beverages and fruit juices*

34. I consider the opponent's "*fruit beverages and fruit juices*" to be a fairly broad term covering a range of fruit-based beverages, from the likes of apple, orange and grape juice to concentrated squash. As explained above, I consider "*alcoholic beverages (except beer)*" to broadly cover various alcoholic beverages. I consider the proximity of sale is generally very limited especially since many fruit beverages are also often in refrigerated sections (among others) away from alcohol. Whilst there may be some overlap of consumers (where they are over the legal age for consuming alcohol), this is a superficial aspect on which to base similarity. Although I acknowledge that fruit beverages may sometimes be consumed or mixed with alcohol to form a long drink or cocktail (for instance, bucks fizz), I neither

consider the goods competitive or complementary in a way that the average consumer would think that the responsibility for the goods lies with the same undertaking.

35. Weighing the various points above, I find no similarity (but if I am wrong on that then any similarity is very low) between the applicant's "*fruit beverages and fruit juices*" and the opponent's "*alcoholic beverages (except beer)*".

#### *Soft drinks*

36. I consider the applicant's "*soft drinks*" to cover typically cold non-alcoholic beverages such as those fruit-based and carbonated like lemonade, cola and tonic. I also consider the term could extend to non-alcoholic versions of alcoholic beverages, such as non-alcoholic wine and gin. To the extent that "*soft drinks*" cover non-alcoholic equivalent beverages, I find the same level of similarity explored earlier in paragraphs 26-27. Equally, to the extent the term covers tonic, waters and fruit-based beverages, my findings in paragraphs 28-31, 32-33 and 34-35 respectively apply.

37. Bearing the aforementioned analysis in mind, and in the absence of any fall-back specification, the applicant's "*soft drinks*" covers goods which range from a low (tonic water) to medium (non-alcoholic equivalents of certain alcoholic beverages) level of similarity to the opponent's "*alcoholic beverages (except beer)*".

#### *Energy drinks*

38. Energy drinks are typically non-alcoholic beverages with energy-rich ingredients consumed by the consumer for a quick release of energy. They could be consumed throughout the day or when energy is specifically needed – for instance, when one is on the go or before, during or after exercising. Although the opponent's "*alcoholic beverages (except beer)*" are also consumed for their flavour, they are an intoxicant typically consumed for pleasure and/or socialisation later in the day. Besides both being available in receptacles and consumable by mouth, their ingredients and nature differ – one is alcoholic and has a sedative effect, the other is non-alcoholic

and is energising. With such a different purpose, there is no interchangeability or level of competitiveness. Although both may be consumed at the same time (either on their own or mixed together) and some trade channels may be shared (such as supermarkets, bars and restaurants), I neither consider there is complementarity in a trade mark sense even if it might be possible to mix an energy drink with a spirit.

39. Following my above analysis, I consider the applicant's "*energy drinks*" and the opponent's "*alcoholic beverages (except beer)*" are dissimilar, or if I am wrong on that any similarity is of a very low level.

#### *Syrups and other non-alcoholic preparations for making beverages*

40. The applicant's "*syrups and other non-alcoholic preparations for making beverages*" covers a range of syrups and preparations (such as powders) used in beverages. They are often used to alter or enhance the flavouring of a beverage. As per my above analysis, I consider the opponent's "*alcoholic beverages (except beer)*" covers various alcoholic beverages – from straight spirits to premixed alcoholic beverages. The nature, intended purpose and method of use of the applicant's goods differ from the opponent's, especially bearing in mind syrups etc are typically highly concentrated and not consumed straight from the receptacle (as opposed to the alcoholic beverages which may be consumed straight or mixed). Nevertheless, I consider there is some consumer overlap where syrups and non-alcoholic preparations are used in conjunction with alcoholic beverages by way of creating a long drink or cocktail or are used as a flavouring mimicking an alcoholic beverage. Whilst complementarity could be argued, I do not consider them important or indispensable to each other so that the average consumer would consider that the responsibility for the goods lies with the same undertaking. I doubt there is any real degree of competition.

41. Overall, I consider the applicant's "*syrups and other non-alcoholic preparations for making beverages*" and the opponent's "*alcoholic beverages (except beer)*" are dissimilar, or if I am wrong on that any similarity is of a very low level.



## Average consumer and the purchasing act

42. I next consider who the average consumer is for the contested goods and the way in which those goods are purchased. 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 in question<sup>5</sup>.

43. 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."*

44. The average consumers of the goods at issue are members of the general public. The goods will be available through several trade channels; such as, cafés, restaurants, pubs and bars and retail outlets such as supermarkets and off-licences. The opponent submits that online sales is a *"dominant distribution channel"*. In *Simonds Farsons Cisk pic v OHIM* Case T-3/04 the GC said:

*"58. In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant's goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering*

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<sup>5</sup> See *Lloyd Schuhfabrik Meyer*, Case C-342/97

*them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.*

*59. Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there, consumers can perceive the marks visually since the drinks are presented on shelves, although they may not find those marks side by side.”*

45. The opponent submits that “*users of both goods are those looking for a healthier alternative to traditional beverages whether this be alcoholic or not*”. However, this argument appears based on claimed actual marketing not the general inherent characteristics of the goods at issue. The applicant contends that their average consumer differs to the opponent – as the opponent’s customers will be adults whilst the applicant’s do not have to be over the minimum legal age to consume alcohol. I agree with the applicant, but note that some consumers (namely, those over the legal age of consuming alcohol) may be shared. While the purchase of the contested goods will be a primarily visual experience, I bear in mind the aural component of ordering a beverage. The price of the contested goods will vary, though will generally be inexpensive and purchased on a reasonably frequent basis. In making their selection, a consumer may consider the flavour, type, cost and ingredients in the goods.

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

46. 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).”*

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

48. As the opponent has not claimed the mark has any enhanced distinctiveness, I only have the inherent position to consider. I consider that ‘Gerry’s’ will likely be considered a name, whether a forename or surname. I do not consider the word has any connection in relation to the goods registered by the opponent, although it is not highly unusual like an invented word. I, therefore, consider the word ‘Gerry’s’ to have a medium degree of inherent distinctiveness.

### **Likelihood of confusion**

49. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to

be borne in mind. I point particularly to the principles I referred above in paragraph 10. One of these is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services and the nature of the purchasing process.

50. Earlier in this decision I concluded that the applicant's mark is identical to the opponent's earlier mark and the earlier mark had a medium level of inherent distinctiveness. I found that the applicant's "*mineral and aerated waters*" [except tonic water], "*fruit beverages and fruit juices*", "*energy drinks*" and "*syrups and other non-alcoholic preparations for making beverages*" were dissimilar to the opponent's goods. Given that some similarity is required between the goods, the opposition must therefore fail. Nevertheless, if this is held to be wrong, any similarity is very low at best and measured from that perspective confusion would not arise. When bearing in mind the average consumer's level of attention and method of selection, I consider the level of goods similarity and the relationship between them to be insufficient to cause confusion notwithstanding the identity of the marks and the earlier mark's level of distinctiveness. I do not consider there will be a likelihood of confusion.

51. I found the remaining contested goods ranged from a low to medium level of similarity. In relation to the goods with a low degree of similarity, this is where the respective terms covered tonic water on the one hand and gin (and gin and tonic premixed) on the other. Given the identity of the marks, that the earlier mark has a medium level of distinctiveness, and the synonymous link that exists between gin and tonic, I find that the average consumer will assume that the same undertaking is offering both a gin and a tonic product. In relation to the goods with a medium similarity, this is where the terms covered the non-alcoholic versions of alcoholic products. Here, given the identity of the marks, I find that the public will inevitably believe that the same (or a related) undertaking is responsible for both. There is a likelihood of confusion.

## **CONCLUSION**

52. The opposition under section 5(2)(a) of the Act is partially successful. Subject to any successful appeal against my decision, the opponent succeeds in relation to:

*Non-alcoholic beverages; soft drinks; tonic water*

53. But fails, and the mark may be registered in relation to:

*Mineral and aerated water, but not including tonic water; energy drinks; fruit beverages and fruit juices; syrups and other non-alcoholic preparations for making beverages.*

## **COSTS**

54. The awards of costs in Fast Track proceedings are governed by Tribunal Practice Notice ('TPN') 2/2016. However, bearing in mind that both sides have achieved a measure of success, I order both parties to bear their own costs.

**Dated this 20th day of January 2021**

**B Wheeler-Fowler**

**For the Registrar**