

O/443/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003437143

BY DANNY BOY LABEL LLP

TO REGISTER THE TRADE MARK:

TITANIC

IN CLASS 30

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 419682

BY SHAMROCK GIFT COMPANY (TRADING HOUSE) UNLIMITED COMPANY

BACKGROUND AND PLEADINGS

1. On 17 October 2019, Danny Boy Label LLP applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 29 November 2019. The applicant seeks registration for the following goods:

Class 30 Ice-cream; sorbet; ices; flavourings for beverages; flavourings for food; flavouring syrups; candies; sweets; chocolates; fudge; all containing whiskey, vodka, gin or cream liqueur.

2. The application was opposed by The Shamrock Gift Company (Trading House) Unlimited Company (“the opponent”) on 2 March 2020. The opposition is based upon sections 5(1), 5(2)(a) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under sections 5(1) and 5(2)(a) the opponent relies on the following trade mark:

TITANIC

EUTM registration no. 9497331¹

Filing date 4 November 2010; registration date 30 July 2011

The opponent is relying upon some of the goods for which the mark is registered, namely:

Class 30 Confectionery.

3. Under sections 5(1) and 5(2)(a) the opponent claims that there is a likelihood of confusion because the marks are identical, and the goods are either identical or similar.

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

4. Under section 5(4)(a), the opponent relies upon the sign **TITANIC** which it claims to have used throughout the UK since “at least 2012” in relation to “foodstuffs; beverages; confectionary; fudge; chocolate; tea; candy rock; jam”.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by FRKelly and the applicant is represented by Ansons. Only the opponent filed evidence in chief. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND SUBMISSIONS

8. The opponent’s evidence consists of the witness statement of Mr Michael Dolan, which was dated 16 November 2020. Mr Dolan is the Managing Director of the opponent’s company. Mr Dolan’s statement was accompanied by 5 exhibits.

9. Whilst I do not propose to summarise it here, I have taken all of the evidence into consideration in reaching my decision and will refer to it where necessary below.

DECISION

Section 5(1) and 5(2)(a)

10. Section 5(1) of the Act reads as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trademark and the goods or services for which the trade mark is applied for are

identical with the goods or services for which the earlier trade mark is protected.”

11. Section 5(2)(a) of the Act reads as follows:

(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

(b) [...]

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

12. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered.”

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the earlier trade mark had completed its registration process

more than five years before the application date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

Proof of use

14. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

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

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(5A) [...]

(6) 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.”

15. Section 100 of the Act is also relevant, which reads:

“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.”

16. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is the five-year period ending with the date of the application in issue i.e. 18 October 2014 to 17 October 2019.

17. 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 Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken 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].”

18. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C149/11, are relevant. The court 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.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the

territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“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)”.

At paragraphs 57 and 58, the court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

At paragraphs 57 and 58, the court held that:

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or

services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

19. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames Valley. On that basis, the General Court dismissed the applicant’s challenge to the Board of Appeal’s conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant’s argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that “genuine use in the Community will in general require use in more than one Member State” but “an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State.” On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon’s analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multifactorial one which includes the geographical extent of the use.”

20. The General Court (“GC”) restated its interpretation of *Leno Marken* in Case T398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark).

21. 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/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and

e. The geographical extent of the use show

Form of the mark

22. 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 (my emphasis):

“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)". (emphasis added)

23. 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 subquestions, (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."

24. 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 required. 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.

25. Where the opponent's mark has been used as registered this will, clearly, be use upon which the opponent can rely. As the mark filed is a word mark, it may also be used in a range of standard fonts and colours, as well as in upper or lower case.

26. The opponent has also used the earlier mark in the following variants:



27. The first example is the earlier mark as registered, in a standard grey font, combined with the additional date 1912 and a red flag device, presented on a white textured background. This is use of the mark as registered as per *Colloseum*. The second example is the earlier mark as registered, in a standard yellow font, combined with additional wording R.M.S, presented on a black decorative background. I do not consider the additional text to alter its distinctive character as per *Nirvana*. Consequently, these examples are both use upon which the opponent may rely.

Sufficient/genuine use

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.²

29. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

² New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09

30. As the earlier mark relied upon is an EUTM, I must consider the EU as the market in which the opponent is required to show genuine use.

31. The opponent's evidence confirms that they have been trading under the TITANIC mark at least since 2012. Their main store is located within Belfast; however, they have other retail outlets including Dublin, Cork, Wiltshire and Liverpool. Examples have been provided of the earlier mark in use in store, however, it does not specify what store these specific examples are from.³ Examples have also been provided of the earlier mark in use in the opponent's brochure on goods such as fudge, chocolate, rock, tea in tin, marmalade and toffee, which Mr Dolan submits was distributed within the period of 2012 to 2019.⁴ Mr Dolan provides sales figures for goods sold in the UK and Ireland, from the year 2012 to 17 October 2019. The sales figures are broken down into years and, therefore, the sales figures for 2014 to 17 October 2019 amount to €276,286.59.⁵ However, I consider that part of these costs will still relate to the period before the relevant date of 18 October 2014. This was broken down into goods and relates to only those which used the TITANIC mark. I also note that the goods are broader than those covered by the opponent's specification. Therefore, the total sales figures for goods covered by the opponent's specification, including fudge (dairy cream and Irish whiskey flavoured), chocolate, rock and toffee amounted to €208,471.83. Sample invoices were also provided for the period of 2015 to 2019, all within the relevant period, for the sale of goods in the UK and Ireland, again, including those which were specifically sold under the TITANIC mark. I note that the goods are broader than those covered by the opponent's specification. However, the total sales figures for goods covered by the opponent's specification, including fudge (dairy cream and Irish whiskey flavoured), chocolate, and rock, under the TITANIC mark, amounted to €9,439.48.⁶ The opponent has also provided an article regarding the Titanic Belfast attraction.⁷ It confirms that the goods bearing the mark are sold in the Titanic Store gift shop for the Titanic Belfast attraction which, since opening in 2012, has received six million visitors from 145 countries. Again, part of these figures do fall outside the

³ Exhibit MD2

⁴ Exhibit MD5

⁵ Exhibit MD3

⁶ Exhibit MD4

⁷ Exhibit MD1

relevant period. Mr Dolan did not provide figures for what market share the opponent holds for the UK and the European Union specifically, but from the evidence, I consider that it is a modest amount of sales given the size of the market. In regard to marketing, Mr Dolan submits that the total amount spent for making the mark known in the UK and Ireland since March 2012 is estimated at €30,000, spending between €3,000 and €4,000 every year from 2015 to 2019. I note that no examples of these advertisements were provided by the opponent. Taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of the earlier mark in the EU during the relevant period in relation to fudge (dairy cream and Irish whiskey flavoured), chocolate, rock, and toffee.

Fair Specification

32. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. 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.”

33. 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."

34. The opponent's class 30 specification covers the broad category of "confectionery". The opponent has provided sales figures and invoices for goods including fudge (dairy cream and Irish whiskey flavoured), chocolate, rock, and toffee as well as others not covered by its specification. This is supported by the examples

from the opponent's brochure. I acknowledge that confectionery can be broken down into further subcategories, however, with consideration of the above case law, I find that it would be inappropriate to narrow the opponent's specification given that the mark has been used across a range of products. I find that the consumer would fairly describe the goods offered by the opponent in class 30 as "confectionery". Consequently, I consider a fair specification for the earlier mark to be:

Class 30 Confectionery.

Section 5(2) case law

35. For the purposes of the section 5(2)(a) opposition, I bear in mind the following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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.

Identity of the marks

36. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the 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 the average consumer.”

37. The marks in this case are both the word “TITANIC” in capitalised font. I consider that these marks are clearly identical.

Comparison of goods

38. The competing goods are as follows:

| Opponent’s goods | Applicant’s goods |
|-----------------------------------|--|
| <u>Class 30</u> Confectionery. | <u>Class 30</u> Ice-cream; sorbet; ices; flavourings for beverages; flavourings for food; flavouring syrups; candies; sweets; chocolates; fudge; all containing whiskey, vodka, gin or cream liqueur. |

39. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

40. Guidance on this issue has come from Jacob J. (as he then was) in 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

41. 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.”

42. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

43. 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 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 the responsibility for those goods lies with the same undertaking.”

44. 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/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, 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.”

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.”

45. “Candies”, “sweets”, “chocolates” and “fudge” (which all contain “whiskey, vodka, gin or cream liqueur”) in the applicant’s specification all fall within the broader category of “confectionery” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

46. “Ice-cream”, “sorbet” and “ices” (all containing “whiskey, vodka, gin or cream liqueur”) in the applicant’s specification overlap with “confectionery” in the opponent’s specification. The opponent has not clarified what ‘ices’ are; however, I consider them to be sweetened frozen products. Therefore, I consider that the opponent and applicant’s goods overlap in purpose, method of use and user as they are all preparations made with sugar which are typically eaten as a snack or dessert, which will be consumed by the general public. There may be some overlap in trade channels. However, they do not overlap in nature as ice cream, sorbet and ices are cold foods which would be typically stored in the freezer, whereas general confectionary would normally be stored in the cupboard and not normally eaten or served cold. They are not complementary; however, they may be in competition with each other. Taking the above into account, I consider the goods to be similar to a medium degree.

47. “Flavourings for food”, “flavourings for beverages” and “flavouring syrups” (all containing “whiskey, vodka, gin or cream liqueur”) in the applicant’s specification are dissimilar to “confectionery” in the opponent’s specification. They differ in nature, method of use and purpose as flavourings are added to food or drink in order to add

another flavour to them, whereas confectionery is a finished product ready to be consumed as it is. They do not overlap in trade channels. They may overlap in user; however, this is not enough on its own to establish similarity. They are not in competition, nor complementary. I consider the goods to be dissimilar.

48. It is a prerequisite of section 5(1) that the goods be identical. The opposition will, therefore, fail in respect of those goods that I have found to be only similar or dissimilar (and not identical).

49. The opposition under section 5(1) succeeds in respect of the following goods only:

Class 30 Candies; sweets; chocolates and fudge all containing whiskey, vodka, gin or cream liqueur.

50. As the section 5(1) ground of opposition is only partially successful, I will now continue to consider the rest of the relevant grounds of the section 5(2)(a) opposition in respect of those goods that I have found to be only similar.

The average consumer and the nature of the purchasing act

51. As the case law above indicates, 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 the goods are likely to be selected by the average consumer. 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.”

52. The average consumer for the goods will be a member of the general public. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, flavour and the ingredients. I consider that the level of attention paid during the purchasing process will be between a low and medium degree.

53. The goods are likely to be obtained by self-selection from shelves of a supermarket, retail outlet or online equivalents. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there may also be an aural component to the purchase through advice sought from sales assistants or word-of-mouth recommendations.

Distinctive character of the earlier trade mark

54. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

55. 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 distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

56. The opponent has not pleaded that its mark has acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The opponent has provided sales figures to enable me to assess the extent of the use that has been made of the mark. Sales since March 2012 until the relevant date in the UK and Ireland has amounted to €346,392.27 for the relevant goods bearing the mark TITANIC.⁸ The total amount spent on advertising the mark in the UK and Ireland for the relevant goods since March 2012 is estimated at €30,000. I note that the Republic of Ireland falls outside of the relevant UK market. Therefore, with only 3 outlets located in the UK (Belfast, Wiltshire, and Liverpool), the geographical spread of use in the UK has been limited. I also note that no market share figures have been provided and that the turnover figures do not appear to represent a particularly significant market share in what must be a fairly extensive market in the UK. I do recognise that the opponent has been using their mark for a number of years and has invested in advertising. However, the sums invested do not seem to me to be particularly high. Taking this all into account, I do not consider that the opponent has demonstrated that the distinctive character of the mark has been enhanced through use.

57. I will now consider the inherent distinctiveness of the opponent’s mark.

⁸ Exhibit MD3

58. The word 'TITANIC' will be known to the average consumer as the name of the historic ship which famously sank in 1912, which was subsequently made into a well-known film. It is neither allusive nor descriptive in relation to the goods for which the mark is registered. Therefore, I consider the opponent's mark to be inherently distinctive to a medium degree.

Likelihood of confusion

59. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related. 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. The first 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. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

60. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be identical.
- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer to be members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that between a low and medium degree of attention will be paid during the purchasing process.

- I am considering the parties' goods that I have found to be similar to a medium degree.

61. Taking all of the factors listed in paragraph 60 into account, I am satisfied that the average consumer would likely mistake one mark for the other, this is particularly the case given the identity of the marks. I am, therefore, satisfied that there will be a likelihood of direct confusion for the goods which are similar to a medium degree.

62. The opposition based upon s5(2)(a) has succeeded in relation to the following goods:

Class 30 Ice-cream; sorbet; ices all containing whiskey, vodka, gin or cream liqueur.

Section 5(4)(a)

63. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

64. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

65. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

66. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before

the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

67. The prima facie relevant date is the date of application in issue i.e. 17 October 2019. However, it is also necessary to consider what the position would have been at the start of the behaviour complained about. The applicant has pleaded in their Form TM8 that they have substantial goodwill in the UK, particularly in Northern Ireland, for their mark in respect of alcoholic beverages since 2008. However, I have no evidence before me of trading or goodwill established by the applicant at this date and, therefore, the only relevant date I have to consider is 17 October 2019.

Goodwill

68. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

69. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the

enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

70. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

71. Goodwill arises as a result of trading activities. It is clear from the revenue figures provided by Mr Dolan that The Shamrock Gift Company (Trading House) Unlimited Company has been trading under the TITANIC sign since 2012. The revenue figures from 2012 to 2019 total €447,596.17. This is broken down by year and the types of goods sold, all under the TITANIC sign. This includes the following:

- TITANIC 100g milk chocolate

- TITANIC fudge box 170g
- TITANIC luxury dairy cream fudge
- TITANIC luxury Irish whiskey fudge
- TITANIC marmalade
- TITANIC rock
- TITANIC sweet jar clear
- TITANIC sweet jar clove
- TITANIC sweet jar éclair
- TITANIC sweet jar fruit
- TITANIC sweet jar humbug
- TITANIC tea in tin
- TITANIC tin with fudge 1
- TITANIC toffee box 200g
- THOMPSON'S TITANIC tea
- TITANIC centre luxury cream fudge
- TITANIC centre stick of rock
- TITANIC dark chocolate bar
- TITANIC milk chocolate bar
- TITANIC fudge tin 100g
- TITANIC fudge tin 100g-V

72. Mr Dolan also provided advertising figures estimated at €30,000 spent since March 2012. The sales and the advertising all relate to the UK and Ireland. However, I have not been provided any evidence or exhibits of these.

73. However, I note that there is very little evidence which relates to the goods beverages and jam that the opponent claims to have used the sign in relation to. The only evidence provided by the opponent is the above revenue figures which include TITANIC tea in a tin and TITANIC marmalade. These goods are also advertised in the opponent's brochure which was distributed between 2012 to 2019.⁹ Marmalade is similar to jam,¹⁰ however, it is not the same. Therefore, I do not have any evidence of

⁹ MD5

¹⁰ <https://www.collinsdictionary.com/dictionary/english/marmalade>

use, nor has the opponent demonstrated goodwill in relation to jams, at the prima facie relevant date. As beverages and foodstuffs are such broad categories which could encompass a range of goods, I also do not consider that the opponent has demonstrated goodwill in relation to these broader categories of goods at the prima facie relevant date.

74. Taking all of the evidence into account, I am satisfied that the opponent has a modest degree of goodwill in relation to confectionery, fudge, chocolate, tea, and candy rock relied upon at the relevant dates. Mr Dolan gives evidence of the earlier mark also being used on the opponent's products and in their brochures. In light of this, I am also satisfied that the earlier sign was distinctive of the opponent's goodwill at the relevant date.

Misrepresentation and damage

75. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court’s reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

76. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

77. The goods for which the opponent has shown goodwill are identical or similar to a medium degree to candies, sweets, chocolates, fudge, ice-cream, sorbet, and ices (all containing whiskey, vodka, gin or cream liqueur) for the same reasons set out above. Taking the closeness of the parties’ fields of activity into account, as well as the marks being identical, I consider that a substantial number of members of the relevant public would be misled into purchasing the applicant’s goods in the mistaken belief that they are the goods of the opponent. Damage through diversion of sales is easily foreseeable.

78. However, for the goods which I have found to be dissimilar, I consider that the differences between the goods would be sufficient to avoid misrepresentation occurring. I consider that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the applicant’s goods in the mistaken belief that they are provided by the opponent’s business. As there is no misrepresentation, there can be no damage.

79. The opposition under section 5(4)(a) succeeds in relation to the following goods:

Class 30 Candies; sweets; chocolates; fudge; ice-cream; sorbet; ices; all containing whiskey, vodka, gin or cream liqueur.

CONCLUSION

80. The opposition has succeeded in relation to the following goods for which the application is refused:

Class 30 Candies; sweets; chocolates; fudge; ice-cream; sorbet; ices; all containing whiskey, vodka, gin or cream liqueur.

81. The opposition has been unsuccessful in relation to the following goods for which the application will proceed to registration:

Class 30 Flavourings for food; flavourings for beverages; flavouring syrups; all containing whiskey, vodka, gin or cream liqueur.

82. The opponent has achieved the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£650** as a contribution towards the costs of the proceedings. In making this award, I have applied an appropriate reduction to reflect the opponent's only partial success. The sum is calculated as follows:

| | |
|--|-------------|
| Filing a Notice of opposition and considering the applicant's counterstatement | £200 |
| Preparing and filling witness statement and exhibits | £350 |
| Official Fee | £100 |
| Total | £650 |

83. I therefore order Danny Boy Label LLP to pay The Shamrock Gift Company (Trading House) Unlimited Company the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 14th day of June 2021

L FAYTER

For the Registrar