

BL O-522-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3486773

BY HEATHER ALE LTD

TO REGISTER:

JUICE TIGER

AS A TRADE MARK IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421223 BY

HEINEKEN ASIA PACIFIC PTE. LTD.

BACKGROUND & PLEADINGS

1. On 4 May 2020, Heather Ale Ltd (“the applicant”) applied to register the trade mark **JUICE TIGER** in the UK. It was accepted and published in the Trade Marks Journal for opposition purposes on 22 May 2020. The specification of the application was twice amended on 22 and 24 June 2020 and (re)published on 26 June 2020, as follows:

Class 32: Non-alcoholic beer; Non-alcoholic malt drinks; Pale ale; Flavored beer; IPA (Indian Pale Ale); Alcohol-free beers; Ale; Beer; Beer-based beverages; Craft beer; Craft beers.

2. On 20 August 2020, the application was opposed in full by Heineken Asia Pacific Pte. Ltd. (“the opponent”); based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon three Trade Mark registrations, the relevant details of which are as follows:

Number	UK00002240911 (“UK911”)
Mark	TIGER
Dates	Filing date: 28 July 2000 Date of completion of registration process: 23 November 2001
Classes and Terms	Class 32: Lager and goods in the nature of lager.

Number	WO0000000880266 (“IR266”)
Mark	TIGER
Dates	Designation date: 5 May 2006 ; Priority date of 28 October 2005 (from Singapore). Date of protection of the international registration in UK: 10 February 2008

Classes and Terms	<p>Class 21 Drinking glasses; mugs, not of precious metal; bottles; jugs, not of precious metal; jugs made of glass; glassware for household use; ice buckets (other than of precious metal); serving trays (other than of precious metal); menu card holders; coasters, not of paper and other than table linen; not including vacuum flasks, and thermally insulated containers for food; vacuum bottles and vacuum insulated containers.</p> <p>Class 32: Lager and goods in the nature of lager.</p>
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Number	WE00000839125 ("EU125")
Mark	TIGER
Date	Filing date: 16 November 2004 Date of completion of registration process: 10 March 2008
Classes and Terms	Class 32: Beer.

3. The opponent claims that the contested mark is "highly similar or even almost identical" to its UK911, IR266 and EU125 marks; that the goods under the respective marks are also either identical or at least highly similar; and that the applicant's mark infringes the prior rights of said earlier registrations.

4. The applicant filed a counterstatement in which it denies the grounds of opposition. In particular, the applicant emphasises that notwithstanding the fact that the "JUICE TIGER mark shares the word 'TIGER' in common with the opponent's marks, the average consumer makes a global appreciation of a mark based on the overall impression that the mark as a whole provides". The applicant further contends that there is no likelihood of confusion between the marks; that the opposition should be dismissed in its entirety; the application be permitted to pass to registration; and an award of costs be granted in its favour.

5. The opponent's trade marks (which qualify as earlier marks in accordance with section 6 of the Act), have been registered for more than five years on the date on which the contested application was filed. They are, therefore, subject to the proof of use provisions under section 6A of the Act. The opponent has formally declared that it has made genuine use of its trade marks for all of the goods under its respective registrations; nevertheless, the applicant has put the opponent to proof of use of the earlier marks. The relevant date for these purposes is the five years prior to, and ending on, the date of filing of the contested application: 5 May 2015 to 4 May 2020.
6. In these proceedings, the opponent is represented by Chiever B.V. and the applicant by jtTM Consultancy Limited. The opponent filed evidence and a response to the applicant's counterstatement. Neither party requested a hearing, nor did they elect to file written submissions in lieu. I have reviewed all of these submissions and will, to the extent I consider it necessary, refer to them later in this decision. The evidence is summarised below to the extent I consider necessary.

The evidence in relation to proof of use

7. This consists of a witness statement from Mr Willem van den Wijngaart, the Global Tiger Marketing Manager of Heineken Asia Pacific Pte. Ltd; with whom he commenced employment in 2011 and has held said position since July 2019. Mr van den Wijngaart adduces evidence marked as Exhibit 1 to Exhibit 15, each piece of which, he asserts, "confirms sales of the TIGER mark for beers", "in pounds", "directed to the English market"; that "it properly reflects current use of the mark in the UK"; and in some instances, "use in the past years":

Exhibit 1 reproduces a printout from *www.amazon.co.uk* showing that "Tiger Beer Lager" (in plain text) was listed for sale as at 17 January 2020; with prices indicated in British Pound Sterling (GBP). The listing includes an image of an opaque bottle with a label bearing a stylised rendition of the mark "Tiger".

Exhibit 2 consists of webpage printouts dated 17 January 2020 from supermarket chain, *Sainsbury's*, displaying a listing for "Tiger Beer", priced in GBP; with an image of the bottled item, to which a stylised version of the mark is affixed; and a description of the item, including the words in plain text "Tiger Beer" and details of its UK-based brewery operations.

Exhibit 3 shows a comparative GBP price listing of "Tiger Lager Beer" (written in standard text) on *www.mysupermarket.co.uk* dated 17 January 2020; displaying different price points at UK retailers: *ASDA*, *Ocado*, *Tesco's* and *Sainsbury's* for what appears to be a box of 12 bottles of the beverage, (as "12 x 330ml" is written on the box), with one such bottle positioned next to the box (both displaying a stylised version of the "Tiger" mark) .

Exhibit 4 comprises a January 17th 2020 printout from *www.ocado.com*, presenting a twelve-case, GBP offering of the beverage, with one of its bottles set next to the box; both bearing a stylised version of the mark "Tiger", with the words "Tiger Beer" (in standard font) written above the image.

Exhibit 5 is a printout from the website *https://uk.the-sub.com/tiger-torp.html* dated 17 January 2020; with the caption: "Taste the famous Tiger beer from Singapore in the UK"; featuring a promotional offer for Tiger Beer. The "Tiger" mark is affixed to the item on offer, with a reference to trade in GBP.

Exhibit 6 reproduces an article titled: "Heineken benefits from strong Tiger beer sales during first half", published "By Contributor" on *www.foodbev.com* on 29 July 2019. Pertinent remarks from the article, which shows a truncated image of a beer bottle bearing the "Tiger" mark, include:

Beer sales volumes increased in all the company's markets except Europe, which declined as a result of poor weather and an unfavourable comparison to last year when the football World Cup took place.

Tiger performed strongly in Vietnam and more than doubled its volume in Cambodia, while Amstel grew strongly in Brazil, South Africa, Russia and the UK.

Exhibit 7 is an excerpt from an article titled: "Deliveroo's most popular beers by city"; written by Phoebe French, dated 4 August 2017; and published at www.thedrinkbusiness.com. Reference to "Tiger Beer" is made in its opening paragraph, as follows: "*With its 'Balti Triangle,' Birmingham has often been cited as the curry capital of the UK. It doesn't come as a surprise, therefore, that Tiger beer owned by Heineken Asia Pacific, traditionally served in Britain's Indian restaurants, is the preferred brew of the region*".

Exhibit 8 is an article promoting: "Tiger Beer Chinese New Year Edition", published on www.ccllabel.com, dated January 2016. The limited-edition, Chinese-themed design is explained in the article, with graphic illustrations of same, on which the "Tiger" mark is visible.

Exhibit 9 reproduces webpages from www.heineken.co.uk, dated 17 January 2020; featuring images of bottles and a beer glass, bearing the "Tiger" trade mark; as well as the word "TIGER" (in standard type), appearing below and adjacent to the respective images.

Exhibit 10 is the CampaignLive.com article: "Tiger Beer ramps up Chilli Crab marketing push", dated 5 August 2009, with an image of the "Tiger" mark, in which it is said:

The Tiger Beer Chilli Crab Tour ... will visit cities including Glasgow, Brighton and London over weekends throughout this month.

...

Previously held as a free food festival in London, this year is the first time the Scottish & Newcastle-owned lager has gone on tour.

To date, draught Tiger has been introduced in more than 80 on-trade outlets that complement the brand's identity.

Exhibit 11 consists of an article published at *PopSop.com* on 21 October 2010: "Tiger Beer Encouraging the British to 'Know The Not Known'". The article documents a 2010 Tiger Beer UK ad campaign, which it states included "a range of digital, outdoor, media partnerships", with collaborations from across the creative industries. "The brand also launched an *iPhone* application, which provides the users with a bunch of information on ... events hosted by tiger beer." The article also reproduces images of promotional material bearing the "Tiger" mark and product.

Exhibit 12 reproduces a *CampaignLive.co.uk* article ("Tiger beer kicks off global advertising review"), dated 23 February 2012. This article recounts that: *In the UK, Tiger has previously worked with CHI & Partners, which created a controversial 2008 campaign that depicted a bottle of Tiger and a "ladyboy" as two of Asia's most desirable exports. The Advertising Standards Authority subsequently banned the ad.* An image showing the "Tiger" product and mark is also included in the article.

Exhibit 13, a *Telegraph.co.uk* article dated 8 December 2012, indicates Heineken's acquisition of Tiger beer-maker, Asia Pacific Breweries.

Exhibit 14 tenders an article titled: "Tiger beer launches new multi-pack can format", as evidence "confirming sales of the TIGER mark in the UK mark[et] for beers". The article dated 26 June 2017 was published on *TalkingRetail.com* (a UK online retail magazine, according to Mr van den Wijngaart's statement); and includes an image depicting the canned offering (with the Tiger mark affixed to same); as well as the advertisement that Tiger's "new can packs retail at £4.40 ... [and are] also available in 640ml bottles retailing at £2".

Exhibit 15 puts forward another *TalkingRetail.com* article: "Celebrate Chinese New Year with Tiger beer", dated 30 January 2015. In common with Exhibit 8, it shows limited-edition packaging incorporating the Tiger mark. The article further explains that: "*Tiger has teamed up with multiple supermarkets to offer shoppers promotions and sampling linked to Asian food in store*".

8. This concludes my summary of the evidence filed to the extent I consider it necessary.

DECISION

9. The opposition is based upon section 5(2)(b) of the Act which 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 earlier 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.”

10. An earlier trade mark is defined in section 6 of the Act, which states:

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

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application 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.”

Proof of use

11. As the earlier mark had been registered for more than five years on the date on which the contested designation was published, Section 6A of the Act is engaged:

“6A. - (1) This section applies where –

an application for registration of a trade mark has been published,

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

the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 -

use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

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.

(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.”

12. 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 Trade Marks 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.

13. 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 I-9223, 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:

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].

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].

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].

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].

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].

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].

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].

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

14. The onus is on the opponent to show use because Section 100 of the Act states:

- a. “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.”

15. In considering the opponent’s evidence I remind myself of the comments of Mr Daniel Alexander Q.C., sitting as the Appointed Person in *Awareness Limited v Plymouth City Council*, Case BL O/236/13:

“22. The burden lies on the Proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be skeptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

16. The comments of Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person in *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, are also relevant. He opined as follows:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The

evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

Overview of the opponent’s evidence

17. As the above case law establishes, all of the circumstances of a case must be taken into account collectively, in order to determine whether the mark in question has been genuinely used. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole; with regard to place, time, extent and nature of use. Therefore, a separate assessment of the various relevant factors, each considered in isolation, is not suitable.
18. The case law also makes clear that, genuine use 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.
19. The opponent’s evidence, in narrative form, is that “the mark TIGER is currently being used and has been used in the past years, and at least since 2009, in the UK for ‘beers’”. There are exhibits (excluding exhibits 10, 11, 12, 13 and 15, as they disclose dates prior to the relevant period), which clearly show that the opponent’s goods are offered for sale in the UK. I accept that the evidence before me is a narrative, substantiated by exhibits, which clearly demonstrate, despite not having any sales figures or particulars on promotional expenditure, that Tiger beer has been offered for sale throughout the UK. The evidence shows that the product is offered for sale at nationwide distributors, including: *Amazon, ASDA, Ocado, Sainsbury’s* and *Tesco’s*. I am therefore satisfied that there is clear evidence showing proof of use (even after discounting Exhibit 6 and the evidence dated outside of the relevant period); that the opponent’s use is not merely “token use”, nor undertaken solely to preserve the registration of the mark.

20. On the evidence before me, I am satisfied that the opponent has made genuine use of the TIGER mark in relation to “Beer” and “Lager and goods in the nature of lager”, in the UK in the five years prior to the filing of the contested application. As previously stated, the TIGER mark adduced into evidence takes the form of a stylised version of the registrations relied upon by the opponent. Nevertheless, for the sake of completeness, I will now review whether the variant form of the marks (examples of which are shown below), amounts to an acceptable variant of the registered marks.



21. 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 Court of Justice of the European Union found that:

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

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, 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 by 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)

22. 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 s.46(2) of the Act as follows:

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

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

23. In *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Professor Philip Johnson, sitting as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use.

The image shows the word "dreams" written in a black, cursive, lowercase font. The letters are connected and have a fluid, handwritten appearance. The 'd' has a long tail that loops under the 'r', and the 's' has a similar tail that loops under the 'm'. The overall style is elegant and modern.

24. There are examples in the opponent's evidence of the mark being used as registered, in the form of listings for TIGER in archetypal font on ecommerce websites. Clearly, these will be use upon which the opponent may rely. It is also important to note that registration of a mark in black and white will cover use of that mark in any colour. Therefore, where the evidence shows the marks being used in different colours, this will be acceptable variant use of the mark/s upon which the opponent may rely.

25. The TIGER mark, in its variant form, appears as stylised letters (in either yellow, orange or yellow with a red glow) sometimes linked to or containing a figurative element; that is, a stylised or heraldic tiger; typically against a blue background; and at times with additional inscriptions (such as: *Since 1932; World Acclaimed; Lager Beer* and/or *Asian Lager*). I find that the distinctive character of the registered marks is essentially derived from the word element itself. Further, the variant forms of the marks, appearing as stylised versions, do not alter the distinctiveness of the registered marks. Therefore, those forms of use are acceptable variants of the registered marks. In considering use of the TIGER mark in combination with a figurative element, as well as additional wording (as highlighted above), I am satisfied that such use falls within the terms of genuine use as set out in *Colloseum*. Therefore, this too, is use of the mark upon which the opponent may rely.

What constitutes a fair specification?

26. Having concluded that the opponent has made genuine use of its TIGER trade marks, I must now decide what constitutes a fair specification. In this regard, I am guided by the following cases. 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.”

27. 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.”

28. It is abundantly clear that the evidence does not support the claim for use in relation to all of the goods relied upon in the notice of opposition. There is stark emphasis in the evidence of use in relation to *beer/lager* (in class 32), as opposed to the class 21 specification. I have already found that there is evidence of use with respect to the former. In view of the relevant identifiable items in the evidence, in the context of the above guidance (on identifying and defining the particular categories of goods or services they should realistically be taken to exemplify from the average consumer’s perspective, for example), I do not consider that the opponent may rely upon any of its class 21 specification.

29. I am satisfied, after having applied the above guidance to the totality of the evidence provided, that the following represent fair specifications: “*Lager and goods in the nature of lager*” (in class 32 under UK911 and IR266); and “*Beer*” (in class 32 under EU125). I will therefore conduct the comparison with these conclusions in mind.

Relevant case law in relation to likelihood of confusion – section 5(2)(b)

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

The principles:

- a. The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- b. the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- c. the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- d. the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- e. nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- f. however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- g. a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;
- h. there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- i. mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- j. the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- k. if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

31. The competing services are as follows:

The opponent's goods	The applicant's goods
<p><u>Goods under the UK911 mark</u></p> <p>Class 32 – Lager and goods in the nature of lager.</p> <p>Class 32 – Lager and goods in the nature of lager.</p> <p><u>Goods under the EU125 mark</u></p> <p>Class 32 – Beer.</p>	<p>Class 32 - Non-alcoholic beer; Non-alcoholic malt drinks; Pale ale; Flavored beer; IPA (Indian Pale Ale); Alcohol-free beers; Ale; Beer; Beer-based beverages; Craft beer; Craft beers.</p>

32. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment:

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

33. Guidance on this issue has also 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.

34. 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."

35. 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."

36. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court 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".

37. 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."

38. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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 für 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".

39. In its notice of opposition, the opponent states: “The goods for which appl. no. UK00003486773 has been filed must be considered identical or at least similar to the goods which the prior mark TIGER ... is being used and registered. First, they all concern or relate to beers. Further (and thus) they could well be produced and/or sold within the same establishments, shops and/or social environment. As such they share end-user and production and distribution channels”.

40. The term “Beer” appears in both (the opponent’s and applicant’s) specifications; therefore, these goods are self-evidently identical. “Flavored beer”; “Beer-based beverages”; “Craft beer”; and “Craft beers” in the applicant’s specification are also encompassed by “Beer” in the opponent’s specification. Therefore, they are identical under the principle outlined in *Meric*.

41. Beer can be alcoholic or non-alcoholic and as such, the applicant’s terms: “Non-alcoholic beer”, “Non-alcoholic malt drinks” and “Alcohol-free beers” are also encompassed by the opponent’s “Beer” specification. These goods are therefore identical under *Meric*. Notwithstanding this finding, in the alternative, I also consider that they share purpose, users, channels of trade and method of use; they may originate from the same undertaking; and furthermore, are in competition. Therefore, “Non-alcoholic beer”, “Non-alcoholic malt drinks” and “Alcohol-free beers” would still be highly similar to “Beer” (which includes non-alcoholic beers).

42. The same rationale applies to the contested “Pale ale”, “IPA (Indian Pale Ale)” and “Ale”; as they are likely to coincide in purpose, trade channels and consumers. They can also be considered as alternatives to the earlier term and so can be directly competitive. Therefore, these are also highly similar to the earlier “Beer” specification.

43. In the interest of clarity, I must point out that the same reasoning applies to the earlier term “Lager and goods in the nature of lager”. “Beer” can be substituted with this term; because lager is a type of beer (as is ale). The technical difference between the categories of beer is in how they are brewed. However,

this is irrelevant to the assessment of similarity between the goods. In the *Balmoral* case Mr Geoffrey Hobbs QC, sitting as the Appointed Person, cautioned against placing too much emphasis on factors such as the methods of production and difference in colour and taste of the drinks, and focussed instead on the shared channels of trade.¹ The respective goods: beer, lager, ale are alternatives and so can be directly competitive. Their purpose is likely to coincide, as are the relevant trade channels, consumer and producer. Therefore, the competing goods are also at least highly similar to “Lager and goods in the nature of lager”.

The average consumer and the nature of the purchasing act

44. 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 services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 47.

45. 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.”

¹ *Balmoral Trade Mark* [1999] RPC 297

46. The goods at issue are alcoholic beverages or related to them. The average consumer of the goods is (for the most part) a member of the adult general public; as well as business users. The goods may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where they are normally displayed on shelves) and online; in such circumstances, the goods will be obtained by self-selection. They are also sold in public houses, bars and restaurants; where they will be displayed on bottles; and where the trade mark will appear on drinks lists or menus (for example). When the competing goods are sold in public houses, bars and restaurants, for example, there will be an oral component to the selection process; though not to the exclusion of visual considerations.

47. I turn now to consider the level of attention the average consumer will display when selecting the goods. For the most part, the cost of the goods is likely to be relatively low, as illustrated in the evidence. Bearing in mind that the average consumer will wish to ensure they are selecting the correct (type, flavour, strength, et cetera) beverage; they are, in my view, likely to pay at least a moderate level of attention during the selection process.

Comparison of the marks

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

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception

of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

50. The respective trade marks are shown below:

<p>TIGER ("UK911")</p> <p>TIGER ("IR266")</p> <p>TIGER ("EU125")</p>	<p>JUICE TIGER</p>
<p>Earlier trade marks</p>	<p>Contested trade mark</p>

Overall Impression

51. In its counterstatement, the applicant argues that:

“Whilst [its] JUICE TIGER mark shares the word “TIGER” in common with the opponent’s marks, the average consumer makes a global appreciation of a mark based on the overall impression that the mark as a whole provides. Yet further, the average consumer rarely gets the chance to make a direct comparison between marks, and instead imperfect recollection is involved. As a result, and because the average consumer retains only an imperfect image of respective marks in his mind, there is an increased importance of any elements which are

particularly visible and easy to detect in the sign being compared. [*Sabel v Puma*, ECJ Case C-251/95 and *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97].

“The word JUICE in [its] mark is visible and easy to detect, being positioned at the start of the mark as a whole. It is submitted that when comparing the respective marks, “the overall impression conveyed by each sign is different” [*Laboratorios RTB, SL v OHIM – GIORGIO AIRE*, Case T-156/01]. It is denied that TIGER is the dominant element of JUICE TIGER, and that the respective marks are “almost identical”, as submitted by the opponent.”

52. The opponent, on the other hand, contends that the applicant’s mark “incorporates the earlier mark TIGER in its entirety, and element (sic) TIGER is far more distinctive, and thus more dominant, than the element JUICE, which is descriptive when used in relation to goods in Class 32”. I agree with the opponent’s submission in relation to the greater and lesser dominance of the respective words of the applicant’s mark. “TIGER” is likely to have greater impact upon the perception than “JUICE”. “TIGER” has greater distinctiveness by reason of the fact that the element “JUICE” is an allusive word; and plays a secondary role (to the “TIGER” element), despite its placement at the beginning of the mark.

53. The opponent’s UK911 mark is a word only mark. Whilst its IR266 mark is displayed in a different typeface, it is a standard typeface, which carries no trade mark significance. There are no other elements that contribute to the overall impression of these marks, which lies in the word “TIGER” itself.

54. The opponent’s EU125 mark, however, is the word “TIGER” in a weathered effect bold typeface, which will be noticed. Nevertheless, “TIGER” continues to play the greater role in the overall impression of the mark; with the moderately stylised typeface playing a lesser role.

Visual Comparison

55. Visually, the fact that the trade marks at issue consist either exclusively, or contain, the dominant and distinctive word “TIGER”, results in at least a medium degree of visual similarity between them. I maintain this view even in relation to the moderately stylised EU125 mark, bearing in mind that the applicant’s mark is a word only mark that can be displayed in any standard typeface²; and that “TIGER” retains its dominance and distinctives despite the moderate stylisation in that mark.

Aural Comparison

56. The likely pronunciation of the words within the respective marks requires no explanation given that they are ordinary, everyday English words. Although the word “JUICE” will be spoken first in the applicant’s mark, like the visual similarity, the presence of the identical aural component “TIGER” (albeit one that will be spoken second, in the applicant’s mark) results, once again, in at least a medium degree of aural similarity between the competing marks.

Conceptual Comparison

57. On the issue of concept, the applicant puts forward its perspective of “JUICE”, preferring not to offer a definition of “TIGER”, as follows: “Conceptually, the word JUICE is most commonly understood to refer to the extracts of a fruit or vegetable, ie: noun - the natural fluid, fluid content, or liquid part that can be extracted from a plant or one of its parts, especially of a fruit: (from dictionary.com)”.

58. I consider that the distinctive element, “TIGER” (present in both marks), will convey an identical conceptual message to the average consumer. The word “JUICE”, as earlier indicated, plays a lesser distinctive role in the applicant’s mark. However, it will still act as a point of conceptual difference between the

² As notional and fair use means that the word mark could be used in any standard typeface, differences created by presentation in capital or lower case will not be relevant.

marks. For these reasons, I find that the marks are conceptually similar to an above average degree.

Distinctive character of the earlier trade mark

59. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion³. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

60. 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;

³ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

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).”

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

62. In its counterstatement the applicant cites a number of UK trade mark registrations in support of its argument that: “TIGER marks are commonplace in the alcoholic beverages (or substitutes therefor) industry. These UK registrations in class 32 are owned by commercially separate parties which are not the opponent. The opponent does not own exclusive rights to any and all uses of the word TIGER in this sector, such that it can bar registration of the applicant's JUICE TIGER mark”. The applicant provides details of some of the specifications, for some of the marks identified from its cross search of the Register; and highlights that some of the goods fall in class 32, whereas others relate to class 33. However, there is no evidence as to whether any or all of them are in use in the market place.

63. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the Applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The Applicant did not dispute that finding before the Board of Appeal but none the less

reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 *GfK v OHIM – BUS(Online Bus)* [2005] ECR II 4865, paragraph 68, and Case T 29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II 5309, paragraph 71).”

64. As the above caselaw establishes, the state of the register (alone) is not enough to establish that the distinctive character of the TIGER element has been weakened because of its frequent use in the field concerned. There is no evidence that the registrations cited by the applicant are actually in use. Therefore, I must disregard its submission as to the state of the register; and focus my consideration on the potential for conflict between the mark applied for and the earlier marks.

65. On the issue of inherent distinctive character, as previously indicated, the opponent's marks consist of one word only, "TIGER"; the UK911 mark is a word only mark; whereas the IR266 mark is displayed in a different, standardised typeface. I find that the typography of these two marks will have no effect on the distinctive character of the mark. The typeface of the EU125 mark, however, will slightly increase the distinctiveness of that mark; because it is more pronounced and will be noticed.

66. The word "TIGER" is an ordinary word, to which the average consumer will attribute its dictionary meaning, generally being "a large wild animal of the cat family with yellowish-orange fur with black lines".⁴ As this dictionary word does not describe or allude to the goods for which it is registered, I find that the opponent's marks are inherently distinctive (not considering use) to an average to above average degree, with the UK911 and IR266 marks being average and

⁴ Cambridge Dictionary: <https://dictionary.cambridge.org/dictionary/english/tiger>.

the EU125 at above average. However, as the opponent has filed evidence of its use of its trade marks, I must now go on and determine whether they have acquired enhanced distinctiveness by virtue of the use made of them.

67. In his evidence, Mr van den Wijngaart asserts that “the mark TIGER is currently being used and has been used in the past years, and at least since 2009, in the UK for ‘beers’”. However, the evidence provided by the opponent, though not devoid of evidential value in relation to proof of use, does not give me any clear opportunity to assess the acquisition of distinctive character through use. Although the evidence includes a number of printouts from various nationwide retailers showing that the products are available for sale to UK consumers, it provides no information about sales figures to enable me to assess the extent of the use that has been made of the marks. Whilst there are a number of articles on the topic of sales of Tiger Beer in the UK, I do not consider this sufficient to enable me to assess the geographical spread of any use of the mark. The articles, for example, which respectively highlight that Tiger beer is the preferred brew in Birmingham and that the Tiger Beer Chilli Crab Tour included planned visits to Glasgow, Brighton and London, are not considered sufficient to enable me to conclude that the mark was at the relevant date, well-known to the general public or to a substantial proportion of the relevant general public. My position is reinforced further by the evidence of Exhibit 6 (for example), which discloses that “Beer sales volumes increased in all the company’s markets except Europe, which declined as a result of poor weather and an unfavourable comparison to last year when the football World Cup took place”.

68. The opponent has also chosen not to provide any information in relation to its share of the market concerned (which must be an immense market). Although there are reports of promotional activities during the relevant period, no information is provided in relation to advertising expenditure for the marks at issue. In the circumstances, I consider that the evidence filed is insufficient to show that the opponent’s marks have acquired an enhanced level of distinctiveness. Therefore, my earlier assessment on the inherent distinctive character of the marks remains unchanged.

Likelihood of confusion

69. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle; that is, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer of the goods and services, the nature of the purchasing process and 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 they have retained in their mind.

70. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other; and indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10. He said:

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

element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

71. These categories are not exhaustive, but illustrative;⁵ and provide a helpful focus for my analysis on the likelihood of confusion. I earlier found that the competing goods are identical or highly similar. The average consumer is an adult member of the general public, who will select those goods by both visual and oral means (albeit the visual considerations are likely to dominate); and who will pay a moderate level of attention in selection process.

⁵ See *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14; § 29.

72. The overall impression of the opponent's marks is of a single word. I also concluded that the word element "TIGER" in the contested mark is more dominant than the word element, "JUICE". The competing marks are visually and aurally similar to an average degree; and are conceptually similar to an above average degree. I have found that the opponent's marks are inherently distinctive to an average to above average degree, with the UK911 and IR266 marks being average and the EU125 at above average.

73. Given the visual, aural and conceptual similarity I have identified above, in the context of the identity or high similarity of the goods, even if considering the average degree of inherent distinctive character of the opponent's TIGER mark, I am satisfied that the fact that the word "JUICE" in it will be construed as a reference to either the type of goods or its contents, is sufficient to lead to a likelihood of direct confusion; that is, the competing trade marks are likely to be mistaken for one another. As the differences between the competing trade marks do not play a significant role in their respective overall impressions, I find the shared dominant, distinctive element is likely to trigger perceptions and recollections leading to the marks being mistaken for one another; that is, there will be direct confusion. However, if I am wrong on my finding of direct confusion, I will proceed to consider indirect confusion.

74. Even if the average consumer notices the differences between the marks, in view of my conclusions on the identity or high degree of similarity between the goods; the visual and aural similarities between the marks; the overall impression conveyed by the common distinctive element of the marks (that is, TIGER); that its impression is perceived independently within the overall impression of the marks; and that that impression remains largely unaffected, notwithstanding the additional, descriptive element in the applicant's mark; I am satisfied that they are likely to perceive the identical or highly similar goods as originating from the same or economically linked undertaking. Further, any differences in the presentation of the word elements of the marks will be seen as alternative marks used by the same or economically linked undertakings. Consequently, I find there to be a likelihood of indirect confusion between the marks.

Conclusion

75. The opposition based upon section 5(2)(b) of the Act succeeds and, subject to any successful appeal, the designation will be refused.

Costs

76. As the opponent has been successful, it is entitled to a contribution towards its costs. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying the above guidance, I award costs to the opponent on the following basis:

Preparing a Notice of Opposition and reviewing the counterstatement:	£300
Preparing Evidence	£500
Official fee:	£100
Total:	£900

77. I therefore order Heather Ale Ltd to pay Heineken Asia Pacific PTE Ltd the sum of £900. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 9th day of July 2021

**Denzil Johnson,
For the Registrar**