

O-569-22

TRADE MARKS ACT 1994

IN THE MATTER OF REGISTRATION NO. UK3142376

IN THE NAME OF MONTOSCAR ENTERPRISES LIMITED IN RESPECT OF THE
TRADE MARK

Moose

IN CLASS 33

AND AN APPLICATION FOR A DECLARATION OF INVALIDITY THERETO
UNDER NO. 503170

By Mr Dan Pettersson

BACKGROUND AND PLEADINGS

1. Registration 3142376 stands in the name Montoscar Enterprises Limited (“the proprietor”). The relevant details of this registration are:

Moose

Filing date: 29 December 2015

Registration date: 25 March 2016

Class 33: Alcohol beverages

2. On 12 June 2020, Dan Pettersson (“the applicant”) filed an application for invalidation against all of the goods and services under this mark under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of EU mark 13722079 as follows:

MOOSESHOT

Filing date: 9 February 2015

Registration date: 27 May 2015

Class 33: bitter liqueurs

3. In its statement of grounds, the applicant argues that the respective marks are similar as they share the first five letters and that the goods are identical or at least highly similar.

4. The proprietor filed a counterstatement denying the claims made. It denies that the goods are identical or highly similar and that the marks are highly similar.

5. Only the applicant provided submissions and evidence in these proceedings and a hearing was not requested. This decision is therefore taken following a careful perusal of the papers before me.

6. The proprietor is unrepresented (although was previously represented at the beginning of proceedings). The applicant is represented by Van Innis & Delarue.

7. The applicant's above mentioned trade mark is an earlier mark, in accordance with Section 6 of the Act. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the filing date of the proprietor's mark, as per section 6A of the Act. The proprietor has requested that the applicant provides proof of use for their mark.

8. 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.

Preliminary Issues

9. At the time of filing the cancellation proceedings, the applicant's specification was for 'Spirits and liquors; Flavored tonic liquors' in class 33. This was subject to revocation proceedings at the European Union Intellectual Property Office ("EUIPO"). The current proceedings were suspended pending the outcome of the EUIPO proceedings as they had the potential to materially affect these cancellation proceedings.

10. The final decision on the EUIPO proceedings were published on 19 October 2021 and the outcome was that the applicant's specification was reduced to 'bitter liqueurs' from 2 June 2020. The date the specification was reduced from was prior to the filing date of these proceedings and therefore, the applicant can only rely on the reduced specification, which they have noted within their submissions during the evidence rounds.

Evidence

11. The applicant's evidence consists of a witness statement by Dan Pettersson, who is the registered proprietor of the earlier mark and chief executive officer of Darom AB

Spirits & Liqueurs who are the main licensee of the 'Mooseshot' mark, a position they have held since 1989. The main purpose of the evidence is to demonstrate that the earlier mark has been genuinely used for the relevant period.

12. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

DECISION

13. Section 5(2) of the Act has application in invalidation proceedings pursuant to section 47 of the Act. The relevant legislation is as follows:

14. Section 47 states:

“47. (1) [...]

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

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

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

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

(2ZA) [...]

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

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

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

(c) the use conditions are met.

(2B) The use conditions are met if –

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

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

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

section 46(1)(a) has expired, or

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

(2C) For these purposes –

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

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

(2D) [...].

(2DA) [...].

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

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

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

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

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

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

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

(3) [...]

(4) [...]

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

(5A) [...].

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made:

Provided that this shall not affect transactions past and closed.”

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

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

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

Proof of Use

16. I will begin by assessing whether there has been genuine use of the earlier mark.

17. Section 100 of the Act states that:

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

18. Pursuant to section 47(2B) of the Act, there are two relevant periods for assessing whether genuine use has been made of the earlier mark. The first is the 5 year period prior to the filing date of the proprietor’s mark, so this will be 29 December 2010 to 28 December 2015. The second is the 5 year period prior to the filing date of the TM26 form by the applicant. This will therefore be 12 June 2015 to 11 June 2020.

19. 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:

(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].

20. An assessment of genuine use is a global assessment, which includes looking at the evidential picture, not whether each individual piece of evidence shows use by itself.¹

21. 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”.

22. As the earlier mark relied upon is an EUTM, I must consider use across the EU as the market in which the applicant must show use. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the CJEU 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

¹ New Yorker SHK Jeans GmbH & Co KG v OHIM, T-415/09

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."

"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)."

23. The applicant has not provided details of market share, nor full turnover figures or figures relating to advertising. The applicant has provided sample invoices in Exhibit EP3, these can be summarised by the countries they were sold in as follows:

Sweden:

Sample Sales invoices between October 2016 – September 2017

2 different buyers

Units: 69,399

Value: 84,577.05 Euros

Denmark:

Sample Sales invoices between February 2015- September 2019

1 buyer

Units: 73,764

Value: 113,676.83 Euros

Germany:

Sample sales invoice of November 2015

1 buyer

Units: 1660

Value: 21,148.80 Euros

Norway:

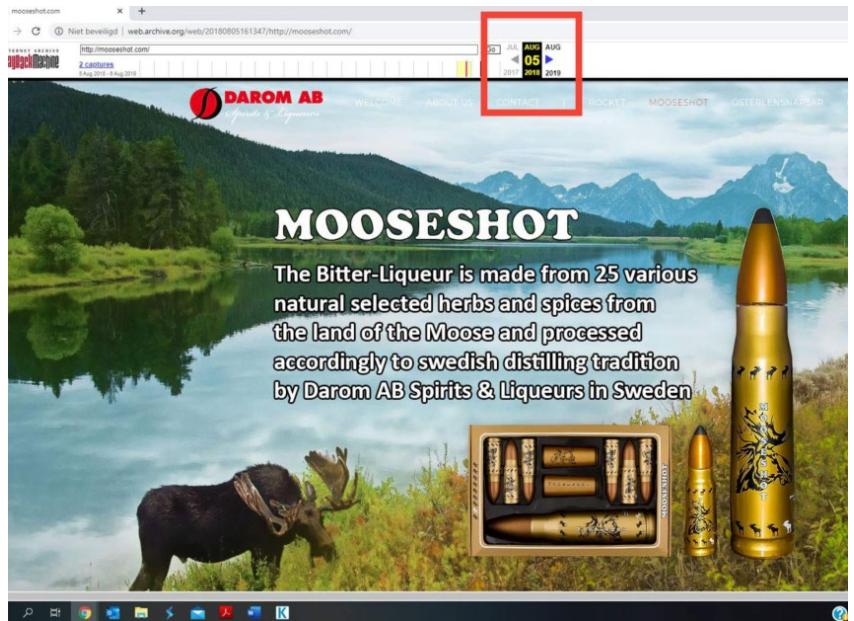
Sample sales invoices between June 2015- September 2019

1 buyer

Units: 186,135

Value: 258,392.20 Euros

24. All of the invoices showed sales of 'Mooseshot' either in 50ml or 500ml volumes. The Mooseshot website is shown in screenshots in Exhibit DP2. There are 2 dated screenshots from 5 August 2018 and 6 August 2019. These screenshots show the product is referred to as a 'bitter-liqueur'. The mark can be seen being used as follows:



25. Exhibit DP4 contains brochures which have featured the Mooseshot product from between 6 March 2016 to 3 March 2019. These brochures seem to correspond with the countries that had shown sales above. Regarding the type of product, the 'Rexim' brochure shows Mooseshot under the 'Bitter' section. I do not have any information as to where exactly these brochures are published and who might have received them.

26. Details of online stockists and screenshots from their websites which show the Mooseshot product for sale are included in Exhibit DP5. Most of these are undated. There are some dated screenshots from Taster Wine, which the applicant states is based in Denmark and delivers within Denmark. These are dated between 22 March 2016 and 4 October 2017. There are also dated screenshots from Nielsen which the

applicant states is also based in Denmark and delivers in Denmark, Finland and Sweden dated 22 April 2018 and 13 March 2018.

27. Next, looking at Exhibit DP6, the applicant has provided screenshots from social media accounts of posts that have mentioned 'Mooseshot' and have pictures of the product. These span the time frame of 3 October 2015 to 22 July 2019. Only a few of these mention locations but they do show some awareness of the brand socially.

28. Exhibit DP7 is a product catalogue from the main licensor company of Mooseshot which Mr Pettersson states was produced from January 2015 and has since been available on the company website. I do not have any information as to where exactly these brochures are published and who might have received them nor any numbers for website page visits.

29. I am already considering the applicant's reduced specification of class 33: Bitter liqueurs. All of the evidence provided, including the screenshots of the company website, points to the 'Mooseshot' product being a bitter liqueur. As I have already noted, it is located in the 'bitter' section and featured with other such liqueurs.

30. From the evidence before me and, taking into consideration that the company appears to only be selling one product, it does seem to show that not insignificant sales have been made in several EU countries (plus Norway) over both relevant periods. The earlier mark was not registered until the final year of the first relevant period; however, use is still showing that year and there is no de minimis level.² I am therefore satisfied that the applicant has demonstrated genuine use of its earlier mark during the relevant period for 'bitter liqueurs'.

Section 5(2)(b) – case law

31. The following principles are gleaned from the decisions of the Court of Justice of the European Union ("the CJEU") in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik*

² *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608

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.

Comparison of goods

32. Section 60A of the Act provides:

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

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

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

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

33. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

"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".

34. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

35. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), Case T-133/05, the General Court ("the 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 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".

36. The competing goods are as follows:

Proprietor's goods	Applicant's goods
Class 33: Alcohol beverages	Class 33: Bitter liqueurs

37. I consider that bitter liqueurs are a type of alcoholic beverage and therefore, the goods are identical under the *Meric* principles.

Average Consumer and the Purchasing Act

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

39. 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.”

40. I think that the relevant consumer of both the applicant’s and the registered proprietor’s alcoholic goods will be primarily the general public over the age of 18. There may also be a portion of professional consumers purchasing the goods on behalf of a business, or for the purpose of running a business themselves.

41. It is my view that a significant portion of members of the general public will purchase the goods fairly frequently, either in a retail or hospitality environment. The professional public will likely purchase these in a retail or wholesale environment, or via distributors. The proprietor’s goods cover the whole range of alcoholic beverages in class 33. I consider the price point of alcoholic beverages such as alcopops and ciders are reasonably low; however, I consider that there is a possibility of much more expensive products, particularly wines and whiskeys.

42. The method of purchase will likely be in a retail setting and the consumer – both public and professional- will largely rely on a visual inspection of the goods. Where the goods are purchased in a hospitality setting, the marks will most likely be displayed on and chosen from a drinks menu or displayed on the bottles or boards visible behind the bar. Hence the visual aspects of the mark will be predominant. However, as verbal orders will often be placed, aural considerations cannot be completely discounted but as in the decision of the GC in case T-187/17, *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO* even in the case of noisy bars and restaurants, consumers usually choose the goods from a menu, where again the mark can be seen. Professional consumers may also place aural orders; however, they are likely to have viewed the products prior to this.

43. When purchasing beverages, the public may consider matters such as quality, origin and taste. For the most part, the goods will attract a medium degree of attention, this is the case even for goods which are on the more expensive end of the spectrum as the factors considered are likely to be the same.

44. For professional consumers, I find the level of attention paid will be enhanced due to the increased responsibility of purchasing these goods on behalf of a business, and the increased liability that will come with serving or selling the goods to consumers. It is my view that the professional consumer will pay at least a medium level (although not to a high degree) of attention in respect of the goods.

Comparison of the marks

45. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

46. 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.

47. The respective trade marks are shown below:

The earlier mark	The contested mark
MOOESHOT	Moose

48. The earlier mark is a single word in a standard font with no other elements. The mark is registered in all upper case. I find that the average consumer might see that the mark is made up of two dictionary words 'moose' and 'shot' which have been conjoined. In terms of distinctiveness, the word 'shot' could be seen as descriptive in terms of the goods the mark is registered for, as a type of alcohol. I will discuss the conceptual meanings of the marks fully later in the decision; however, I consider that this will make 'Moose' the slightly more distinctive element of the mark.

49. The contested mark is a single word in a standard font with no other elements and therefore the overall impression lies in the word itself.

50. In terms of the visual comparison, the contested mark is made up of five letters. The earlier mark is made up of nine letters and entirely encompasses the earlier mark at the beginning. The marks differ with the inclusion of the word 'shot' in the earlier mark, which comes at the end of the mark. I therefore find the marks to be visually similar to a medium degree.

51. The contested mark comprises of a single word from the English language which will be given its ordinary dictionary pronunciation. The earlier mark will be read as two words together 'moose shot'. Both words will be given their ordinary dictionary pronunciations and the beginning of the earlier mark will be spoken identically to the contested mark. The earlier mark will be two syllables and the contested mark will be one. I therefore find the marks to be verbally similar to no more than a medium degree.

52. Conceptually, the word 'Moose' will be given its ordinary dictionary meaning of 'a large type of deer'.³ In relation to the earlier mark, I am reminded of the GC's comments in *Usinor SA v OHIM*, T-189/05:

"62. In the third place, as regards the conceptual comparison, it must be noted that while the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (Lloyd Schuhfabrik Meyer, paragraph 25), he will nevertheless, perceiving a verbal sign, break it down into verbal elements which, for him, suggest a concrete meaning or which resemble words known to him (Case T-356/02, Vitakraft-Werke Wührmann v OHIM - Krafft (VITAKRAFT) [2004] ECR II-3445, paragraph 51, and Case T-256/04 Mundipharma v OHIM - Altana Pharma (RESPICUR) [2007] ECR II-0000, paragraph 57)."

53. 'Shot' is also an ordinary dictionary word which has several potential meanings.⁴ I consider that the two most likely meanings that the average consumer would attribute to it in this instance would firstly be a shot that is a small drink, typically a spirit and that the average consumer might attribute this meaning as the goods are alcohol based. The second option would be in relation to firing a gun, as the average consumer might relate to a moose being a type of animal that could be hunted. However, I consider the first option to be the most likely in the UK given the goods at issue. The average consumer would not dissect the marks nor would they undertake a complicated analysis of the marks, and therefore, I consider that a significant proportion of average consumers would view the earlier mark as an invented word coined by juxtaposing two ordinary words in the English language. I therefore find the marks to be conceptually similar to no more than a medium degree.

³ <https://www.collinsdictionary.com/dictionary/english/moose>

⁴ <https://www.collinsdictionary.com/dictionary/english/shot>

Distinctive character of the earlier 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 C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

55. I firstly need to determine the inherent level of distinctive character of the earlier mark. I have stated above that the mark is an invented term made up of two dictionary words. Invented words would usually have the highest degree of distinctive character, with words that are descriptive of the goods/services relied upon typically having the lowest degree. In this instance, even though the word as a whole would be an invented term, the average consumer will still recognise it as made up of two fairly regularly used terms. I also must consider that a proportion of the average consumers will see ‘shot’ as referring to a measure of alcohol and I therefore find the earlier mark to be inherently distinctive to a medium degree.

56. Although the applicant has filed evidence regarding use of the mark, for this to be considered in relation to enhancement of the distinctive character of the earlier mark, the degree of knowledge must be shown for the public concerned and in this instance that would be the UK consumer.⁵ The evidence provided by the applicant is from Sweden, Denmark, Germany and Norway and therefore, I do not consider that the opponent has shown that the distinctiveness of the earlier mark has been enhanced from the perspective of the UK consumer.

Likelihood of Confusion

57. There are two types of confusion that I must consider. The first is direct confusion where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

58. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually 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.””

⁵ *General Motors* [C-375/97]

59. I have found that the contested goods are identical. I have found the marks to be visually similar to a medium degree given that the applicant's mark is wholly contained within the registered proprietors' mark. I have concluded the marks are aurally similar to no more than a medium degree. Conceptually, I have concluded that the marks are similar to no more than a medium degree. I have found the applicant's mark to be inherently distinctive to a medium degree and that the average consumer would pay a medium degree of attention when selecting the goods at issue. I have found the overall impression to lie in the word for the contested mark and that the term 'Moose' would be slightly more distinctive in the contested mark.

60. Based on the above conclusions, I am not convinced that the average consumer would mistake one of these marks for the other in this instance. The earlier mark contains a further word, albeit shown together as one word in the mark and I do not believe the average consumer will overlook the 'SHOT' element of the earlier mark. Therefore, I do not find there to be a likelihood of direct confusion.

61. I therefore need to consider likelihood of indirect confusion. Mr Iain Purvis Q.C. said further in *L.A. Sugar Limited v Back Beat Inc*:

"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).”

62. These examples are not exhaustive but provide helpful focus, as was confirmed by Arnold LJ in *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207:

“This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.”⁶

63. He also said that:

“As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] ‘a finding of likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion’. Mr Mellor went on to say that, if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion’. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”⁷

64. This type of confusion arises where the average consumer recognises that the marks are different but, because of a common element(s), concludes that the marks emanate from the same or economically linked undertakings. In the present case, I see such confusion arising because both marks contain the identical term ‘MOOSE’ and, I find that the additional word in the applicant’s mark, ‘SHOT’ could potentially be viewed as allusive or descriptive of the goods that it is registered for. Therefore, I find that the addition of this word will cause average consumers to consider that the mark is a sub-brand or brand extension by the undertaking responsible for ‘MOOSE’. Even

⁶ Paragraph 12

⁷ Paragraph 13

in the instance that some consumers might think 'SHOT' had an alternative meaning, I believe that a significant proportion of consumers would be likely to be confused to warrant an intervention.⁸

Conclusion

65. The declaration for invalidity succeeds in its entirety.

Costs

66. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale set out in Tribunal Practice Notice (TPN) 2/2016. After due consideration, I believe that an award of costs to the applicant is appropriate as follows:

Official fee	£200
Preparing the application for invalidity and considering the Counter Statement	£350
Preparing evidence	£650
TOTAL	£1200

67. I therefore order Montoscar Enterprises Limited to pay Dan Pettersson the sum of £1200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of July 2022

L Nicholas
For the Registrar

⁸ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41.