

**O/574/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION  
NO. 01555605 BY**

**SHAFEEQ KHIMANI**

**TO REGISTER THE TRADE MARK:**

**POWER PLAY**

**IN CLASS 33**

**AND**

**OPPOSITION THERETO**

**UNDER NO. 424135**

**BY**

**IRISH DISTILLERS INTERNATIONAL LIMITED**

## BACKGROUND & PLEADINGS


1. **Shafeeq Khimani** (“the applicant”) is the holder of the International Registration (“IR”) WO0000001555605 (“the designation”) in respect of the mark shown on the front page of this decision. Protection in the UK was requested on 2 September 2020. The IR was accepted and published in the Trade Marks Journal for opposition purposes on 26 February 2021 in respect of the following goods:

**Class 33:** Vodka.

2. **Irish Distillers International Limited** (“the opponent”) opposes the applications on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent is the proprietor of the following marks:

<b>Trade Mark no.</b>	EU00099960 ('960)
<b>Trade Mark</b>	POWER'S
<b>Goods Relied Upon</b>	<b>Class 33:</b> Alcoholic beverages (except beers); spirits (beverages).
<b>Relevant Dates</b>	Filing date: 1 April 1996
	Date of entry in register: 18 April 2002

<b>Trade Mark no.</b>	UK0000080886 ('886)
<b>Trade Mark</b>	POWER
<b>Goods Relied Upon</b>	<b>Class 33:</b> Whisky.
<b>Relevant Dates</b>	Filing date: 4 October 1888
	Date of entry in register: 4 October 1888

<b>Trade Mark no.</b>	EU018086292 ('292)
<b>Trade Mark</b>	

<b>Goods Relied Upon</b>	<b>Class 33:</b> Alcoholic beverages, except beers.
<b>Relevant Dates</b>	Filing date: 25 June 2019
	Date of entry in register: 11 October 2019

3. Although the UK has left the EU and the EUTMs relied upon by the opponent now enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the opposition was filed before the end of the Transition Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it existed before the end of the Transition Period.
4. For the purpose of this opposition, the opponent, as shown above, relies on all or part of the goods in Class 33 of the earlier marks.
5. In its notice of opposition, the opponent argues that the competing marks are visually and phonetically highly similar, sharing a highly similar meaning. In addition, the opponent claims that the respective goods are identical or highly similar. Therefore, registration of the contested marks should be refused under Section 5(2)(b) of the Act.
6. The applicant filed a notice of defence and counterstatement denying the claims made. Also, the applicant made particular contentions as to the conceptual meaning of the competing marks, a point that I will return to later in this decision.
7. I note that the applicant did not request proof of use of the earlier marks; thus, the opponent can rely on its '960 and '886 marks for the claimed goods without having to prove that it has used the marks.
8. On 26 August 2021, the Registrar issued a preliminary indication under Rule 19 of the Trade Marks Rules 2008 and Tribunal Practice Notice 3/2007. The finding, which I confirm is not binding upon me, was that there is insufficient similarity between the competing trade marks to give rise to

a likelihood of either direct or indirect confusion under Section 5(2)(b). On 22 September 2021, the opponent responded to the Tribunal and filed a Form TM53, requesting that the opposition proceedings continued to the evidence rounds.

9. Only the opponent filed evidence in these proceedings, which will not be summarised but will be referred to as and where appropriate during this decision.
10. Only the opponent filed written submissions in lieu of a hearing which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
11. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicant by Nicholas Spencer.
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. I will begin my decision by focusing initially on the opponent's '960 and '886 earlier marks and will return to the other earlier mark ('292) to the extent necessary.

## EVIDENCE

### Opponent's Witness Statement

14. The opponent filed a witness statement, dated 21 December 2021, of Eve-Marie Wilmann-Courteau, the Legal Manager, Intellectual Property within the Group Intellectual Property Hub of Pernod Ricard, who has held this position since November 2014.
15. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

## DECISION

### Section 5(2)(b)

16. Section 5(2)(b) of the Act states:

“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”.

17. The principles, considered in this opposition, stem from the decisions of the European Courts in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di*

*L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 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**

18. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

19. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- “(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.”

20. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“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”.

21. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

23. The competing goods to be compared are shown in the following table:

Opponent’s Goods Earlier Mark ‘960	Applicant’s Goods
Class 33: Alcoholic beverages (except beers); spirits (beverages).	Class 33: Vodka.
Opponent’s Goods Earlier Mark ‘886	
Class 33: Whisky.	

24. The opponent submitted that:

“33. The Earlier Registrations cover 'alcoholic beverages except beers' and 'spirits (beverages)' in class 33 which encompasses 'vodka' and to this extent the goods are identical.

34. The Earlier Registrations also cover 'whisky' which are highly similar to 'vodka' as both are a type of alcoholic spirit with a high percentage of alcohol content that can be drunk neat or with an accompaniment.

35. The UK Intellectual Property Office has recently held such goods to be highly similar to one another (please see decision 0/286/21 dated 20 April 2021 INCHCRUIN at paragraph 50)

"While...."vodka" ... in the application and "whisky" in the opponent's mark are produced using different processes and using different raw ingredients, they will overlap in nature in that they are all considered different types of spirits. All of these spirits can be consumed neat as a short drink or combined with a soft drink (such as coke or tonic water) or other types of mixers (as ingredients in cocktails) meaning that they will overlap in method of use. These goods are also commonly consumed for pleasure, whilst socialising or with an intention to become intoxicated and, as a result, overlap in purpose. There is also likely to be an overlap in user due to the broad user base for all of these drinks. Further, there is likely to be a competitive relationship between these goods as a consumer, for example, may choose to have a vodka and coke over a whisky and coke..... They also overlap in trade channels because they are likely to be sold through the same retailers, being displayed on shelves in close proximity to one another. Further, at bars, the goods are likely to be displayed near each other behind or above the bar. Overall, I consider these goods to be similar to a high degree'.

36. In view of the above, the Opponent submits that the Earlier Goods and Contested Goods are therefore identical or highly similar to one another.” (sic)

25. The applicant, in his notice of defence, has not denied the identity/similarity of the goods at issue.

Earlier mark ‘960 goods

26. I agree with the opponent’s submissions and consider that the contested goods will be encompassed by the opponent’s broad terms in the earlier specification. Therefore, the competing goods are identical as per *Meric*.

Earlier mark ‘886 goods

27. There is similarity between the term “*whisky*” of the earlier mark and the contested goods. The goods share the same general nature, and there is an overlap in purpose in that the goods offer pleasurable drinking experiences. The goods share the same method of use (the drinking of beverages) and are sold side by side or in very close proximity in similar receptacles. Further, the goods at issue are marketed or consumed at the same places, such as bars, public houses and restaurants. Thus, there will be competition between these goods, and consumers could choose to drink one over the other. In this regard, I find a high degree of similarity between the respective goods.

**Average Consumer and the Purchasing Act**

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch),

at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word ‘average’ denotes that the person is typical. The term ‘average’ does not denote some form of numerical mean, mode or median.”

29. The average consumer for the respective goods will be the adult members of the public. All of the goods may be sold through a range of channels. They may be purchased in retail premises, such as supermarkets and off-licence stores, online or by mail order. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumers. Similarly, for the online stores, the consumers will select the goods relying on the images displayed on the relevant web pages. They may also be sold through bars, clubs, restaurants and public houses, where the goods are displayed on, for example, shelves behind the bar, and may be requested orally from a member of staff. In this regard, I bear in mind the Case T-3/04, *Simonds Farsons Cisk Plc v OHIM*, where the Court of First Instance (now the General Court) stated that:

“[...] as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a

position to make a visual inspection of the bottle which is served to them.”

30. Consequently, even if these goods can be ordered orally in the premises exemplified above, a visual inspection of the bottles containing the goods is most likely to occur. Although these goods are not particularly costly, the average consumer may examine the product to ensure that they select the correct type of beverage. Therefore, the selection process is predominantly a visual one, but aural considerations will also play their part. In this regard, the average consumer is likely to pay a reasonable (but not high) level of attention to selecting the goods at issue.

### **Comparison of Trade Marks**

31. 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.”

32. 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.

33. The marks to be compared are:

Earlier Marks	Contested Mark
<u>Earlier mark '960</u> POWER'S	<b>POWER PLAY</b>
<u>Earlier mark '886</u> POWER	

### Overall Impression

34. The contested mark consists of the words “POWER PLAY”, presented in upper case and standard font. I note that the words create a phrase that ‘hangs together’ so they are perceived as a unit and form the dominant and distinctive element of the mark. Registration of a word mark protects the word itself presented in any normal font and irrespective of capitalisation.<sup>1</sup> Therefore, the overall impression of the mark lies in the words themselves.
35. The same approach applies to the earlier marks ‘960 and ‘886 as laid out in the preceding paragraph. Therefore, the overall impression of the word marks “POWER’S” and “POWER”, presented in upper case and standard font, rests in the words themselves.

### Visual Comparison

#### *Contested mark and earlier mark ‘960*

36. The earlier mark, “POWER’S”, consists of one word, whereas the contested mark, “POWER PLAY”, of two. I bear in mind that the beginnings of words tend to have more impact than the ends, although this is just a rule of thumb.<sup>2</sup> The contested mark incorporates the earlier mark, save for

---

<sup>1</sup> See *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

<sup>2</sup> See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

the apostrophe and the letter 'S' (POWER'S/POWER PLAY). However, the competing marks differ in the presence/absence of the word element "PLAY" in the contested mark. Considering the overall impressions of the marks and the similarities and differences, I find a low to medium degree of visual similarity between the competing marks.

*Contested mark and earlier mark '886*

37. Following the analysis in the preceding paragraph, there is a point of visual similarity between the competing marks, with the word element of the earlier mark, "POWER", fully incorporated into the contested mark. However, there is a visual difference in the presence/absence of the second word element, "PLAY", in the contested mark. Taking into account the overall impression of the marks and the similarities and differences, I find there is a medium degree of visual similarity.

Aural Comparison

*Contested mark and earlier mark '960*

38. The earlier mark will be pronounced as "POU-UHZ" and the contested mark "POU-UH PLAY". The earlier mark consists of two syllables, whilst the contested mark is three syllables long. The competing marks share only the first syllable and part of the second syllable, namely "POU-UH", differing in the rest word elements. Considering the above factors, there is a low to medium degree of aural similarity between the earlier mark and the contested mark.

*Contested mark and earlier mark '886*

39. The earlier mark will be verbalised in the same as the first word element of the contested mark "POU-UH". The only aural difference amounts to the articulation of the second word element of the contested mark "PLAY". Therefore, I find a medium degree of aural similarity between the respective marks, as delineated in the preceding paragraph.

## Conceptual Comparison

40. With their submissions, both parties have made contentions regarding the conceptual aspects of the respective marks. On the one hand, with its notice of opposition, the opponent claims that:

“[...] there is similarity between the marks to the extent that they share the identical word 'POWER', which UK consumers will perceive to mean the ability or capacity to do something in a particular way/ move or travel with great force. POWERS will be understood as the plural of POWER and therefore share a highly similar meaning. The element 'PLAY' will be perceived as meaning to take part in a game/sport or engage in recreation. Therefore, when viewed as a whole, consumers will interpret POWER PLAY to mean engaging in the above, with great ability or with great force.”

41. The applicant has argued in its notice of defence that:

“We believe that the reasonable UK consumer understands that POWER is a common surname of Irish origin and that a product called POWERS has some relation to an individual or family with the surname POWER and that POWER PLAY has a completely different meaning. Secondly POWER PLAY has a distinctive meaning which is different to the one mentioned in the objection. POWER PLAY is a particular sporting term used in a number of sports including Ice Hockey, Lacrosse, Netball, Cricket, Snooker and others. For example in limited overs cricket, POWER PLAY is a fielding restriction stipulating the way that fielders can be spread out at various times of an innings.”

42. In its submissions in lieu, the opponent made lengthy submissions that I do not propose to reproduce in full here. In summary, the opponent reiterates its initial claim made with the notice of opposition and submits that: “POWER' and 'PLAY' are both words in the English dictionary with



which the average consumer will be very familiar. [...] Therefore, when viewed as a whole, consumers will interpret POWER PLAY to mean engaging in an activity with great ability or with great force and is therefore conceptually similar due to the shared term POWER". Further, the opponent contends that "whilst POWER is a surname deriving from Irish origin, it is denied that consumers will immediately perceive POWER, POWER'S or POWERS to mean this, rather than the ordinary dictionary meaning of POWER[.]" Lastly, the opponent asserts that "POWER PLAY as a sporting term [...] [is] highly specific and [...] not commonly understood by a significant proportion of UK consumers, particularly in the context of alcoholic beverages."

43. The earlier mark '960 consists of the word "POWER'S". Because of the apostrophe before the final S, the average consumer will, in my view, understand this to be a surname and that the goods belong to, or are produced by, someone named Power.
44. Contrary to the conceptual meaning defined above, the word element "POWER" in the earlier mark '886 will be conceptualised differently. I have no evidence to confirm the applicant's submission that "POWER" is a common surname. It is my view that the average consumer will attribute to the mark the ordinary meaning of the dictionary word "POWER", namely strength.
45. The contested mark consists of the ordinary words "POWER PLAY", which the average consumer will perceive as a unit. Both parties made contentions as to the meaning of the contested mark. However, in the absence of evidence, I will rely on the ordinary dictionary meaning of the words. In accordance with the Cambridge Dictionary Online, 'power play' is defined as "in ice hockey, lacrosse, and some other sports, a situation in which one team has more players than the other because that team has had one or more players temporarily sent off" or "a situation in which a person or organization tries to get an advantage by showing that they are

more powerful than another”.<sup>3</sup> Notably, in the absence of evidence and despite the former dictionary reference, I am unwilling to conclude that the entirety of the consumers in the UK will be aware of the sporting term. As a result, in my view, a significant proportion of consumers will conceptualise the term as the advantage gained by exerting power over someone/something,<sup>4</sup> whilst a smaller one will be familiar with the sporting term. In either case, I find the contested mark to be conceptually different to the earlier marks. In more detail, even though the contested mark and the earlier mark ‘886 share the word “POWER”, the addition of the element “PLAY” in the contested mark results in a change of meaning compared to the common component “POWER” when considered separately. In this respect, whilst considering all the factors and the points of the overall impression, I find that there is a conceptual dissimilarity between the respective marks. However, if I am wrong on the finding in relation to the earlier mark ‘886, I find that there is a low degree of conceptual similarity, created by the word “POWER”, for the significant proportion of consumers, as identified in the preceding paragraph. As to the contested mark and the earlier mark ‘960, I find them conceptually dissimilar.

### **Distinctive Character of the Earlier Trade Marks**

46. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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

---

<sup>3</sup> See Cambridge Dictionary Online <https://dictionary.cambridge.org/dictionary/english/power-play>.

<sup>4</sup> See *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch).

*Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

47. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
48. As outlined in the previous section, the opponent’s word mark ‘960, “POWER’S”, will be likely recognised as a surname, and the word mark ‘886, “POWER”, will be understood based on its ordinary meaning. I note that they are not descriptive or allusive of the goods. Thus, the distinctiveness of the word marks will be of an average degree.

#### Enhanced Distinctiveness

49. With its submissions, the opponent claims enhanced distinctiveness of its marks. Taking into account the evidence, I will now consider whether the earlier marks have acquired enhanced distinctive character through use. Although the opponent has filed a spreadsheet with the volume of sales

and number of invoices,<sup>5</sup> part of the latter ones has been redacted such that it is not possible to infer any information relevant to the costs but only to the quantities exceeding 16,000 units between 2019 and 2021, with the vast majority of them invoiced to UK retailers. Also, based on the trade listings provided with the evidence,<sup>6</sup> which Ms Wilmann-Courteau states that they cover the period 2020-2021, over 7,000 units were sold via Tesco, Waitrose, and Amazon. In addition, as a result of a coupon campaign, there was an increase in sales where an “uplift in excess of £100k” took place in 2020.<sup>7</sup> Notably, there is no indication of the annual turnover of sales or the market share held by each of the marks in the industry of the alcoholic beverages, which undoubtedly is a very significant one.

50. Further, no figures in relation to the annual marketing expenditure of the given marks are provided with the evidence. However, the opponent’s advertising and promotional activities include the promotional material;<sup>8</sup> social media posts;<sup>9</sup> national coupon campaign;<sup>10</sup> and various national press and media articles from 2015-2021, aimed at the end-consumers,<sup>11</sup> for example, the online article from the *Cambridge-news.co.uk* website, titled “*Traditional Irish whiskey brands unveil winter warming twist on classic cocktails*”, which also appeared in other local online news websites (e.g. Coventry, Lancashire, Leeds, London, North Wales, Surrey, etc.), and the online article from *gq.com* website, titled “*The Latest Cult Whiskeys Are Irish: 4 Bottles to Buy Now*”; and trade publications, such as the online articles from the *thespiritbusiness.com* website, titled “*Powers*

---

<sup>5</sup> Exhibit EMW 5.

<sup>6</sup> Exhibit EMW 6 and paragraph 10 of the witness statement.

<sup>7</sup> Exhibit EMW 4.

<sup>8</sup> Exhibit EMW 3.

<sup>9</sup> Ibid.

<sup>10</sup> Exhibit EMW 4.

<sup>11</sup> Exhibit EMW 7.

*moves into bottled cocktail market*" and "*Powers Irish whiskey unveils new bottle design*"; and the awards won for whiskey products,<sup>12</sup> although it is not clear how known they are among UK consumers. The above are indications that the opponent has undertaken activities to raise awareness of its marks in the UK.

51. I note that there are shortcomings in the evidence in relation to the market share the opponent possesses in the UK market and the absence of figures on amounts spent on advertising and promotion for each of the marks. However, due to the promotion activities, including the coupon campaign, in the UK, I find on balance that the distinctiveness of the marks has been moderately enhanced in relation to whisky, to just above an average degree.

### **Likelihood of Confusion**

52. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.<sup>13</sup> It is essential to keep in mind the distinctive character of the opponent's trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon imperfect recollection.<sup>14</sup>
53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the differences between the marks but concludes that

---

<sup>12</sup> Exhibit EMW 8.

<sup>13</sup> See *Canon Kabushiki Kaisha*, paragraph 17.

<sup>14</sup> See *Lloyd Schuhfabrik Meyer*, paragraph 27.

the later mark is another brand of the owner of the earlier mark or a related undertaking.

54. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting 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.

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).”

I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.<sup>15</sup>

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

56. Earlier in this decision I have concluded that:

- the goods at issue are identical against the earlier mark '960; and highly similar against the earlier mark '886;
- the average consumer of the parties' goods is the adult members of the public, who will select the goods by predominantly visual means, but without dismissing the aural means. The level of attention will normally be reasonable (but not high);
- the contested mark and the earlier mark '960 are visually and aurally similar to a low to medium degree, and conceptually dissimilar;
- the contested mark and the earlier mark '886 are visually and aurally similar to a medium degree, and there is a conceptual dissimilarity, or, if I am wrong, there is a low degree of conceptual similarity created by the word "POWER", for the significant proportion of consumers;

---

<sup>15</sup> *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

- I have found that the earlier marks benefit from an average degree of inherent distinctiveness and I am allowing that the evidence of use of the marks in the UK is sufficient to moderately enhance their distinctiveness, such that the earlier marks are distinctive just above an average degree in relation to whisky.

57. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion for identical goods concerning the '960 earlier mark or highly similar ones concerning the '886 earlier mark. The visual interaction with the goods at issue and the reasonable degree of attention will play a significant part. Notwithstanding imperfect recollection, it is my view that the average consumer will recall that the earlier marks '960 and '886, "POWER'S" and "POWER", respectively, are single-worded marks against the applicant's two-worded mark, "POWER PLAY", the words of which together form a distinctive unit. In this regard, and despite the enhanced distinctiveness of the earlier marks, I consider that the average consumer will not overlook the conceptual difference between the competing marks, where "POWER PLAY" will be perceived as a unit, and, thus, it is unlikely to mistake one mark for the other.

58. In the case where there is a low degree of conceptual similarity (for the significant proportion of the consumers) between the earlier mark '886 and the contested mark, this will not alter the outcome for the reasons that I have advanced above. For completeness, I note that this finding extends to the smaller group of consumers that will identify the contested mark as the sporting term.

59. Even if the average consumer recalls the points of similarity between the marks, such as that they contain the word "POWER", I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,<sup>16</sup> James Mellor QC stated:

---

<sup>16</sup> Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).



“81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining<sup>17</sup> in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’” (Emphasis added)

I also bear in mind the comments of Professor Ruth Annand, sitting as the Appointed Person in O/476/14, where she stated:

“26. On the contrary, the CJEU makes clear in *Bimbo* that “hanging together” is not the determinative criteria in assessing a composite mark: the decisive question being whether the composite mark forms a unit having a different meaning as compared to its components taken separately (*Bimbo*, para. 25).

27. Mr. Malynicz referred me to 2 earlier decisions of Mr. Geoffrey Hobbs Q.C. sitting as the Appointed Person in *CARDINAL PLACE* Trade Mark, BL O/339/04<sup>3</sup> [fn<sup>3</sup> *CARDINAL PLACE* geographical whereas *CARDINAL* religious] and *CANTO* Trade Mark, BL O/021/064 , as similarly expressing the same point that marks must be compared as wholes, considering the blend of meaning given by the composite mark against the single term.”

In accordance with the rationales above, the words of the contested mark hang together to form a cohesive whole with a different meaning to its constituent elements. The overall impression lies within the unit of these words. In this regard, the average consumer will not consider the respective marks as variants or sub-brands of each other nor that the goods in question are from the same or economically linked undertakings. Lastly, the word element “PLAY” does not represent an obvious brand

---

<sup>17</sup> In *L.A. Sugar*.

extension or sub-brand. I, therefore, find there is no likelihood of indirect confusion between the earlier marks and the contested mark.

## OUTCOME

60. There is no likelihood of confusion. **The opposition on the basis of the claim under Section 5(2)(b) fails.**
61. It is not strictly necessary to consider the earlier figurative mark '292 as it is unlikely to put the opponent in a better position. For completeness, though, I find that the **opposition fails to the same extent for its earlier figurative mark '292**, due to the further visual differences on account of the additional letter elements "POWERS P", and the stylisation and diamond-shaped device aspects, adding to the aural and conceptual differences as well.

## COSTS

62. This opposition has failed in its entirety and the applicant is entitled to a contribution towards their costs of defending their application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Considering the other side's statement and preparing a counterstatement	<b>£350</b>
Total	<b>£350</b>

63. I, therefore, order, Irish Distillers International Limited to pay Shafeeq Khimani the sum of £350. 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 6<sup>th</sup> day of July 2022**

**Dr Stylianos Alexandridis  
For the Registrar,  
The Comptroller General**