

# O-048-18

IN THE MATTER OF THE TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATIONS NOS 3,137,808 AND 3,156,663 IN THE NAME OF BREWDOG PLC

AND IN THE MATTER OF AN APPEAL FROM THE DECISIONS OF OLIVER MORRIS DATED 23 JUNE 2017 (O/291/17)

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## DECISION

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### Introduction

1. This is an appeal from the decision of Oliver Morris, for the Registrar, dated 23 June 2017 in which he dismissed the opposition of ABG EPE IP LLC (“ABG”) under sections 5(2)(b) of the Trade Marks Act 1994 to Brewdog plc’s application numbers 3,137,808 and 3,156,663. ABG relied upon its earlier marks EUTM 13,468,566 and EUTM 13,468,541. Brewdog appeals the decision.
2. Brewdog applied to register the marks ELVIS JUICE (No 3,137,808) and BREWDOG ELVIS JUICE (No 3,156,663). In respect of both marks, the appeal is now pursued only in relation to goods in Class 32, namely Beer and Ale.
3. ABG’s first earlier mark (No 13,468,566) is ELVIS and its second (No 13,468,541) is ELVIS PRESLEY. Both marks were registered for goods in Class 32 and services in Class 35, in particular they were both registered for Beer. Brewdog does not challenge the finding by the Hearing Officer that its goods “Beer and Ale” are identical to “Beer” covered by ABG’s earlier marks.
4. Furthermore, the Hearing Officer took the view that the mark ELVIS PRESLEY did not take the case further than the single word mark ELVIS. Thus, the hearing below and this appeal addressed only the ELVIS mark.

### Standard of appeal

5. The principles applicable on appeal from the registrar were considered in *TT Education Ltd v Pie Corbett Consultancy* [2017] ETMR 26 by Daniel Alexander QC sitting as the Appointed Person. These principles have now been approved and applied by the High Court; see for instance: *Royal Mint Ltd v The Commonwealth Mint and Philatelic Bureau Ltd* [2017] EWHC 417 (Ch) at paragraph 18 and *Apple Inc v Arcadia Trading Ltd* [2017] EWHC 440 (Ch) at paragraph 11.

6. Mr Alexander summarised the position at paragraph 52 of his Decision (I made a few minor updates to this summary in *Grill’O Express* (O/140/17), paragraph 6, which I have incorporated in square brackets):

52. Drawing these threads together, so far as relevant for the present case, the principles can therefore be summarized as follows.

- (i) Appeals to the Appointed Person are limited to a review of the decision of Registrar (CPR [52.21]). The Appointed Person will overturn a decision of the Registrar if, but only if, it is wrong ([...][CPR 52.21]).
- (ii) The approach required depends on the nature of decision in question (*REEF*). There is spectrum of appropriate respect for the Registrar’s determination depending on the nature of the decision. At one end of the spectrum are decisions of primary fact reached after an evaluation of oral evidence where credibility is in issue and purely discretionary decisions. Further along the spectrum are multi-factorial decisions often dependent on inferences and an analysis of documentary material (*REEF, DuPont*).
- (iii) In the case of conclusions on primary facts it is only in a rare case, such as where that conclusion was one for which there was no evidence in support, which was based on a misunderstanding of the evidence, or which no reasonable judge could have reached, that the Appointed Person should interfere with it (*Re: B and others*).
- (iv) In the case of a multifactorial assessment or evaluation, the Appointed Person should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions. In particular, where an Appointed Person has doubts as to whether the Registrar was right, he or she should consider with particular care whether the decision really was wrong or whether it is just not one which the appellate court would have made in a situation where reasonable people may differ as to the outcome of such a multifactorial evaluation (*REEF, BUD, Fine & Country and others*).
- (v) Situations where the Registrar’s decision will be treated as wrong encompass those in which a decision is (a) unsupportable, (b) simply wrong (c) where the view expressed by the Registrar is one about which the Appointed Person is doubtful but, on balance, concludes was wrong. It is not necessary for the degree of error to be “clearly” or “plainly” wrong to warrant appellate interference but mere doubt about the decision will not suffice. However, in the case of a doubtful decision, if and only if, after anxious consideration, the Appointed Person adheres to his or her view that the Registrar’s decision was wrong, should the appeal be allowed (*Re: B*).
- (vi) The Appointed Person should not treat a decision as containing an error of principle simply because of a belief that the decision could have been better expressed. Appellate courts should not rush to find misdirections warranting reversal simply because they might have reached a different conclusion on the facts or expressed themselves differently. Moreover, in evaluating the evidence the Appointed Person is entitled to assume, absent good reason to the contrary, that the Registrar has taken all of the evidence into account. (*REEF, Henderson and others*).

Bearing in mind the repeated reminders that different points are likely to be particularly relevant in other cases, this is not intended to be a summary of universal application for other cases where particular aspects of the approach may require different emphasis.

7. I will apply those principles.

### Judicial Notice

8. Ms Michaels submits that the Hearing Officer was not entitled to take judicial notice of certain facts regarding Elvis Presley and the mark ELVIS. The relevant part of the Hearing Officer’s decision is at paragraph 35:

I can deal with Mr Hicks’ point about the degree of knowledge of Elvis Presley fairly quickly. Put simply, and notwithstanding that Mr Presley died nearly 40 years ago, he was/is such an

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iconic figure, that I would be very surprised if many people (including those at the younger end of the average consumer age spectrum) had not heard of him. There may be some exceptions, but this is likely to be few and far between. The mark is, though, Elvis not Elvis Presley. However, on the basis that Elvis is a relatively uncommon name, and given that Mr Presley is the most famous of Elvises, I consider that most average consumers, on seeing the name Elvis alone, are likely to conceptualise that on the basis of Elvis Presley.

9. Ms Michaels accepted that the Hearing Officer was entitled to take judicial notice of the fact that Elvis Presley was a very famous singer. Notice was taken of the same fact twenty years ago by Laddie J in *Elvis Presley TM* [1997] RPC 543 at 545 and similarly on appeal [1999] RPC 567. While twenty years have passed and fame diminishes, Ms Michaels does not seek to challenge the finding that the name Elvis Presley is well-known as that of the now deceased singer.
10. She took issue with the judicial notice being take on other facts, namely that when seeing the name Elvis (as an unusual name) the average consumer is likely to conceptualise that on the basis of Elvis Presley.
11. Ms Michael also suggests that the finding by the Hearing Officer that consumers would ‘conceptualise’ Elvis as referring to Elvis Presley was not a finding of fact but was an inference from other facts the Hearing Officer had already noticed. While there was clearly no evidence about consumer conceptualisation, it was still a finding of fact as to the mental processes which notional consumers go through. Even if it was inferred from other findings of fact (by notice or evidence) it remains a finding of fact. The question relating to this finding, as for the others, was whether it was something which could be found proved by way of judicial notice.

### *The breadth of notice*

12. Judicial notice is a mechanism of proof whereby a court or tribunal can find a fact proven without having evidence led to support it. While there are different types of judicial notice, what is relevant for these purposes is where a judge can take judicial notice of a fact because it is notorious.
13. Hearing Officers routinely rely on their own experience when making findings of fact. Indeed, as the quality of evidence filed by parties is sometimes so poor (or there is none at all), Hearing Officers are often compelled to make findings of fact without evidence at all as otherwise the outcome of oppositions might be arbitrary or capricious. For instance, in the instant case, a finding was made as to the usual places where the relevant goods are sold without any evidence being led (see paragraph 31 for instance).
14. The basis for this aspect of tribunal practice was considered at length by Daniel Alexander QC, sitting as the Appointed Person, in *O2 Holdings Ltd's Trade Mark Application* [2011] RPC 22. Where, after setting out the authorities, he summarised the position at paragraphs 49 and 50:

While none of these cases is conclusive, they do reflect a discernable trend in cases of diverse kinds, involving the assessment of the meaning and significance of representations made in trade, to be fairly generous in the latitude given to tribunals of fact to determine such issues for

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themselves, while at the same time suggesting caution where the determination involves issues far from the tribunals' day to day experience.

The cases also underline the need to proportionality in this regard and reflect degree of underlying unease as to whether the quality of decision-making is improved by over-egging of the evidential pudding. If the approach to exactly what is required by way of evidence in this area were more pernickety and if the courts had shown themselves to be systematically mistrustful of tribunals' abilities to make the relevant determinations for themselves, one would expect actual evidence from real people of this kind to be treated with greater reverence. Instead, quite often it is viewed as a costly distraction, sometimes doing no more than teaching an otherwise competent tribunal to suck eggs.

15. Indeed, one of the markers of when a judge or tribunal is straying away from taking notice of everyday things is the inclination to actually state that judicial notice is being taken of something. Thus, a Hearing Officer would probably not say that he or she is taking judicial notice of the fact that cheese is sold in supermarkets. As a matter of proof, however, the Hearing Officer is taking notice of this notorious fact. Yet the fact is far too well-known or indisputable for it to be marked as an instance of a proof by notice.
16. As *O2 Holding* indicates, the further away the fact is from the tribunal's day-to-day experience the less appropriate it is for it be found without evidence. Importantly, in this sense it is not the particular Hearing Officer's day-to-day experience which is relevant, but that of the notional tribunal. In other words, it is a fact so well-known that all Hearing Officers are likely to be aware of it and nobody could reasonably dispute it.
17. Before moving on, it is important to remember that Hearing Officers all lead very different lives and some will have hobbies and interests meaning that *in fact* they do have day-to-day knowledge of something of which other Hearing Officers have no knowledge. In such an instance it may be that the Hearing Officer's particular expertise can assist with making the decision, but before this occurs other considerations apply in the same way as they would when a justice uses his or her local knowledge: see *Bowman v DPP* [1991] RTR 263; *Clift v Long* [1961] Crim LR 121. In any event, as *Bowman* (at p 269) makes clear, this practice is not part of judicial notice and so it need not be considered here.
18. Finally, the decision to take judicial notice of a fact is an exercise of discretion by the Hearing Officer and it should only be interfered with on appeal where it is manifestly wrong: see *K T&G v BAT* (O/165/16) paragraph 18 adopting *Phipson on Evidence* (18<sup>th</sup> Ed, Sweet and Maxwell 2013), par 3-03.
19. Ms Michaels suggests the flaw with the Hearing Officer's finding is that while seeing the word Elvis on some goods might bring to mind Elvis Presley; on other goods it would not. For instance, she suggests, seeing Elvis on radiator keys would not bring to mind Elvis Presley even if the name Elvis would do so in "a pop star context".
20. In respect of a pop star context, Ms Michaels also made reference to Elvis Costello and suggested the name Elvis might bring him to mind as well. While nothing turns on it, my understanding is that Elvis Costello was adopted by Declan MacManus as a stage

name by taking Elvis Presley's first name and combining it with his father's stage name. The stage name was therefore adopted to evoke Elvis Presley in any event.

21. On balance I do not think that the Hearing Officer was entitled to take judicial notice that beer consumers who see the word Elvis will always think of Elvis Presley. It is well beyond day-to-day knowledge and is based on supposition. Such a finding therefore would require evidence.
22. I come to this view despite the fact that when I first saw the mark ELVIS JUICE (and before I had read any of the papers), it brought to my mind Elvis Presley. Similarly, in my own mind when I hear the name ELVIS in the abstract I tend to think of Elvis Presley.
23. However, when a similar fact was found by Laddie J in *Elvis Presley TM* [1997] RPC 543 at 551, it was based upon at least *some* evidence:

It seems to me that Mr. Meade was right when he said that the word ELVIS had very low inherent distinctiveness. Not only is this a well known given name, it also will be taken by many members of the public to refer back to Elvis Presley. This accords with the view expressed by Mr. Tuck:

“To me, therefore, the name Elvis means Elvis Presley.”
24. While I agree that that the Hearing Officer's finding about the word Elvis conceptualising Elvis Presley should be set aside, I do not agree with Ms Michaels that this error taints the entire decision.
25. During the hearing before me, Ms Michaels accepted that the mark ELVIS has an average level of inherent distinctive character. This was one of the findings resulting from the now, set aside, conceptualising finding. In this respect, therefore, the error falls away. The other instance where the conceptualisation finding was relied upon was in relation to the conceptual meaning of the respective marks. Before considering that aspect of the decision, it is necessary to consider the meaning given to the word “juice”.

“*Juice*”

26. The Hearing Officer's findings in relation to the word juice were at paragraph 43:

It is clearly correct that the use of the word JUICE must be considered in context. The question is what impact will it have on the average consumer when ELVIS JUICE is used on the applied for goods. I consider there to be little merit in getting hung-up on whether Mr Hicks was right or wrong to send the dictionary definitions to the tribunal. What matters is the meaning, in context, that can be fairly taken on the basis of judicial notice. In my view ELVIS JUICE alludes to the liquid contained in the receptacle of sale which is named after Elvis. The allusion (to the liquid) is, though, mild because it is not usual, as Ms Michaels submitted, to refer to beer (or the other goods) as juice. I do not accept the power based additional meaning put forward by Mr Hicks. In terms of the overall impression of ELVIS JUICE, I consider that the average consumer will regard the two words in the mark as a unit, which hang together in the way I have just suggested. Neither word visually nor aurally dominates the other, but it likely that the mild allusion of the word JUICE (to the liquid) means that the word ELVIS may play a greater role as a point of recall than JUICE.

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27. Ms Michaels submitted below that the word “juice” would be seen as fanciful when it was used on the relevant goods (see paragraph 42). Mr Hicks had argued that the word “juice” meant a liquid with some form of power or nice new taste (see paragraph 40).
28. In her submissions before me, Ms Michaels accepts that the Hearing Officer was right that the word JUICE must be considered in the context of its use in relation to beer or ale. She maintained, essentially, that the further findings of the Hearing Officer were based on his taking judicial notice of something that he was not entitled to do.
29. As I put to Ms Michaels during the hearing, “juice” is a word of ordinary English and so it would not be usual to have evidence put forward as to its meaning unless a party was seeking to establish that it had an unusual meaning. I accept (as the Hearing Officer did) that the word juice would not normally be used to mean beer (or ale). Nevertheless, his finding that the word juice mildly alludes to *a* liquid (of some sort) is entirely proper. As the word has a mild allusion, I also think the Hearing Officer’s conclusion as to roles played by the two elements of the marks (ELVIS and JUICE) naturally follows.
30. Ms Michaels also took objection to the phrase “a liquid contained in the receptacle of sale which is named after Elvis”. While I accept the Hearing Officer was referring to Elvis Presley, I think his conclusion could not have been different if Elvis was just taken as an arbitrary personal name or manufacturer’s name (say it had been Peter Juice). I therefore see do not accept her point.

### *Likelihood of confusion: ELVIS JUICE*

31. Likewise, if the word “Elvis” is taken to be a person’s name (rather than a reference to Elvis Presley in particular), the analysis by the Hearing Officer in paragraph 45 still appears to be appropriate in relation to the aural and visual similarity. The remaining finding, as to conceptual similarity, would be slightly different. The conceptual link between an arbitrary name and that same name followed by the word JUICE is slightly lower than if that name was that of a particular person (Elvis Presley). Nevertheless, there would still be at least a medium degree of conceptual similarity.
32. Even with this lower degree of conceptual similarity, I adopt the Hearing Officer’s analysis that at the very least the average consumer would consider ELVIS JUICE beer and ELVIS beer to come from the “same stable” or more precisely from the same or an economically linked source (see paragraph 51). Accordingly, there would be a likelihood of confusion. I therefore dismiss the appeal in relation to the mark ELVIS JUICE.

### *Likelihood of confusion: BREWDOG ELVIS JUICE*

33. The Hearing Officer concluded that BREWDOG ELVIS JUICE would be seen as a composite mark with BREWDOG being one element and ELVIS JUICE being another (paragraph 44). Ms Michaels suggests that there was no reasoning for reaching this conclusion or the subsequent finding that the two elements had independent distinctive characters.

34. After deciding it was a composite mark at paragraphs 53 and 54, the Hearing Officer then set out the guidance on independent distinctive character from Arnold J in *Aveda Corporation v Dabur India* [2013] EWHC 589 (Ch), paragraphs 22 to 38 and then the additional points he made in *Whyte and MacKay v Origin Wine* [2015] EWHC 1271 (Ch) paragraph 17 to 21. These two judgments summarise the legal developments following the Court of Justice's judgment in C-120/04 *Medion v Thomson Multimedia Sales* [2005] ECR I-8551 and C-591/12P *Bimbo SA v OHIM* ECLI:EU:C:2014:305.
35. What these cases indicate (and is clear from the standard principles set out in paragraph 19(f) of the Hearing Officer's decision) is that before finding that the elements of a composite mark have independent distinctive character, it is necessary to identify that at least one element is either the same or similar to a third party's earlier trade mark. However, the Hearing Officer simply stated at paragraph 56:
- My assessment is that BREWDOG forms one component in the applied for composite mark, ELVIS JUICE another. On the basis of the case-law, I consider it right to say that within the composite mark both BREWDOG and ELVIS JUICE retain an independent distinctive role within it...
36. The only third party mark included in BREWDOG ELVIS JUICE is ELVIS. While the included earlier mark need not be identical, it must be very similar. The General Court in T-569/10 *Bimbo v OHIM* (2012) ECLI:EU:T:2012:535 considered that an element DOUGHNUT (in BIMBO DOUGHNUT) could have an independent distinctive character because it was "almost identical to" DOGHNUTS (paragraph 97). The General Court decision was upheld by the Court of Justice C-591/12 *Bimbo v OHIM* (2014) ECLI:EU:C:2014:305.
37. Arnold J concludes that *Bimbo* means that the rule in *Medion* applies to marks which are similar as well as those which are identical: *Whyte and MacKay v Origin Wine* [2015] EWHC 1271 (Ch), paragraph 18. This word "similar" should be read in the context of the General Court's phrase "almost identical" rather than in a more expansive way.
38. The Hearing Officer did not explain how ELVIS JUICE is similar enough to ELVIS for ELVIS JUICE to be considered to be the house mark of ABG, thereby treating that element as having an independent distinctive character. Even if BREWDOG might be seen as having an independent distinctive character it is not the mark being compared.
39. Accordingly, the Hearing Officer fell into error when he made the comparison between ELVIS and BREWDOG ELVIS JUICE. Furthermore, I do not take the view that the mark ELVIS has independent distinctive significant on its own and so the mark should have been considered as a whole.

*New comparison: likelihood of confusion*

40. The principles to be applied when making an assessment under section 5(2)(b) were set out by the Hearing Officer in paragraph 19 of his Decision (these are based on, although slightly different from, those endorsed by the Court of Appeal in *Maier v ASOS plc* [2015] EWCA Civ 220 at paragraph 75; also see *Comic Enterprises Ltd v Twentieth*

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*Century Fox Film Corporation* [2016] EWCA Civ 41 at paragraph 31). There was no criticism of these principles by the parties and so I will apply them.

41. Ms Michaels points out that invented words are more likely to draw the attention of the average consumer: T-356/02 *Vitakraft-Werke Wührmann v OHMI* [2004] ECR II-3445 at paragraph 52. While this is true, it is also true that unusual names (such as ELVIS) are also likely to get more attention than more common names. Further, suggestive, descriptive, or even words that merely make allusions, will play a less dominant role.
42. The mark ELVIS has been found to have only average distinctiveness and the word BREWDOG is at least, if not more, distinctive than ELVIS.
43. As the mark ELVIS is in the middle of the mark BREWDOG ELVIS JUICE and, furthermore, it follows an invented or least unusual word, the visual and aural similarity between the two marks will be much lower than for ELVIS and ELVIS JUICE. The assessment of the Hearing Officer that it falls between low and medium is right.
44. In terms of conceptual similarity both marks include the name ELVIS (which, for reasons set out above should not be treated as evoking Elvis Presley). The word BREWDOG, which evokes concepts of dogs brewing and JUICE, as the Hearing Officer found, alludes to a liquid. So BREWDOG ELVIS JUICE has numerous concepts (names, dogs, brewing, and liquids) conjured in the mind, whereas ELVIS is just a name. As none of the elements dominate, there is a low level of conceptual similarity between the marks.
45. The two marks are too different for there to be direct confusion. Even with imperfect recollection the average consumer will not mistake BREWDOG ELVIS JUICE for ELVIS. In general, consumers are more likely to remember the first word of a mark, particularly where it is invented or unusual, and so in any comparison between the two marks the average consumer would be aware of the difference.
46. To use the Hearing Officer's phrase, the issue is whether the consumer would consider BREWDOG ELVIS JUICE to be from the same stable as ELVIS; that is, put more formally, whether the two are economically linked. The mark ELVIS has been found to be only averagely distinctive, the addition of BREWDOG is adding an averagely distinctive element, and the evolution from ELVIS to BREWDOG ELVIS JUICE is far from logical. Put simply, the common element of ELVIS is not enough on its own to make consumers think there is a link between the mark ELVIS and BREWDOG ELVIS JUICE.
47. Accordingly, I find there would be no likelihood of confusion between ELVIS and BREWDOG ELVIS JUICE and allow the appeal in this respect only.

**Conclusion**

48. I dismiss the appeal in relation to ELVIS JUICE and uphold the Hearing Officer's Decision. I allow the appeal in relation to BREWDOG ELVIS JUICE for beer and ale in Class 32 and the mark can proceed to registration. The other goods covered by the mark BREWDOG ELVIS JUICE were not pursued on appeal and so the Hearing Officer's decision is upheld in respect of those goods.
49. As both sides were partially successful, I make no order as to costs in respect of the appeal and I discharge the costs order made by the Hearing Officer. Accordingly, no costs are now payable by either party.

PHILLIP JOHNSON  
THE APPOINTED PERSON  
16 January 2018