

O/0689/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003763296

BY RM SPIRITS LIMITED

TO REGISTER THE TRADE MARK:



THE EKO GIN BOUTIQUE

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 433719

BY BBC VINS & SPIRITUEUX

BACKGROUND AND PLEADINGS

1. On 8 March 2022, RM Spirits Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 25 March 2022. The applicant seeks registration for the following goods:

Class 33 Gin.

2. The application was opposed by BBC VINS & SPIRITUEUX (“the opponent”) on 24 May 2022. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

EIKO

Comparable UK trade mark (EU) registration no. UK00916980351

Filing date 13 July 2017.

Registration date 3 November 2017.

French priority date 26 February 2016.

(“The First Earlier Mark”)

EIKO

International trade mark registration no. 1405307

International registration date 17 April 2018.

Date of designation 22 February 2019.

Date of protection granted in the UK 30 May 2019.

(“The Second Earlier Mark”)

3. The opponent relies upon all of the class 33 goods for which its earlier marks are registered, as set out in the Annex below.

4. The opposition is based upon the opponent's First Earlier comparable UK trade mark (EU),¹ and the Second Earlier International trade mark, claiming that there is a likelihood of confusion because the goods are identical and the marks are similar to a high degree.

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

6. The opponent is represented by HGF Limited and the applicant is unrepresented. Neither party requested a hearing, however, the applicant filed submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

RELEVANCE OF EU LAW

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

DECISION

Section 5(2)(b)

8. Section 5(2)(b) reads as follows:

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

(a)...

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks (“EUTM”) registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A ‘comparable trade mark (EU)’ retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

(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.”

9. The earlier marks had not completed their registration process more than five years before the relevant date (the filing date of the mark in issue). Accordingly, the use provisions at s.6A of the Act do not apply.

10. The opponent may rely on all of the goods it has identified without demonstrating that it has used the marks.

Section 5(2)(b) case law

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

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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.”

13. The applicant’s “gin” falls within the broader category of “alcoholic beverages (except beers)” in both the First and Second Earlier Mark’s specifications. They are identical on the principle outlined in *Merici*.

The average consumer and the nature of the purchasing act

14. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

15. The average consumer of the goods will be adult members of the general public over the age of 18. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, flavour, ingredients and alcohol percentage. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

16. The goods are likely to be purchased by self-selection from the shelves of a range of retail outlets such as supermarkets and off-licences, and their online equivalents. Such goods are also sold in public houses, bars, and restaurants where they will be publicly displayed behind the counter or on a drinks menu. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be verbally ordered at a bar, or if stocked behind a counter, the average consumer may have to ask the sales assistant for them.

Comparison of the trade marks

17. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade 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.”

18. 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.

19. The respective trade marks are shown below:

Opponent’s First and Second marks	Applicant’s trade mark
<p data-bbox="343 1077 647 1182">EIKO</p>	 <p data-bbox="979 1476 1217 1503">THE EKO GIN BOUTIQUE</p>

20. The First and Second Earlier Marks consists of the word EIKO. There are no other elements to contribute to the overall impression which lies in the word itself.

21. The applicant’s mark consists of the words “THE EKO GIN BOUTIQUE” which is presented in a gold capitalised typeface at the bottom of the mark. I note that it is presented significantly smaller in size to the letters and device above it. I consider that the average consumer would recognise the highly stylised letters, intertwined with the golden decorative foliage, as “eko”, as they are large in size, and the word EKO is

written below it. The letters e, k and o, are presented vertically in a highly stylised blue, lower-case typeface, with a gold outline, and a gold line pattern down the left-hand side of the letters. The letters are presented in front of, and intertwined with, a gold depiction of foliage with berries, and half a lemon and lemon peel by the letter “o”. I also note that there is a gold butterfly at the top of the mark by the letter “e”. I consider that some consumers may assume that the “berry” element of this device is most likely the juniper berry, from which gin derives. However, they would be so few in number that it wouldn’t amount to a significant proportion. Regardless, even if they are recognised as ordinary berries, for reasons I will come to discuss in the conceptual comparison, these are still allusive of what the gin could be flavoured with. Given the size and positioning of the golden berry foliage device intertwined with the word “eko”, which as a whole amounts the biggest element which is placed at the beginning of the applicant’s mark, I consider that they dominate the mark, and therefore plays a greater role in the overall impression. For the remainder of this decision, I will refer to the blue and gold “eko” letters and the decorative foliage device, as a whole, as the “eko foliage device”. As the word EKO at the bottom of the mark is smaller, I consider it is more likely to play a lesser role, and for reasons I will come to discuss in the conceptual comparison, the words “THE” and “GIN BOUTIQUE” also play a lesser role in the overall impression.

22. Visually, the marks overlap in the letters E, K and O. This is a visual point of similarity. However, the applicant’s mark consists of the large blue and gold eko foliage device at the beginning of the mark, and the words “THE” and “GIN BOUTIQUE”. The opponent’s mark also contains the second letter “I”. These act as visual points of difference. I also bear in mind that the average consumer tends to pay more attention to the beginning of the marks. Consequently, I consider that the marks are visually similar to between a low and medium degree.

23. Aurally, I consider that the opponent’s mark will either be articulated as EYE-CO or EE-COO. I consider that the applicant’s mark will be articulated as EK-KO THE-EK-KO-GIN-BOO-TEA-KH. On the basis the marks only overlap in the “E” and “O” sounds, and the “C” and “K” sounds which are also aurally similar, I consider that the marks are aurally similar to between a low and medium degree.

24. Conceptually, the opponent submits that its mark “has no meaning”. I agree. I consider that the average consumer would recognise the word EKIO as an invented word with no conceptual meaning. I also consider that the EKO element in the applicant’s mark will also be recognised as an invented word with no apparent meaning. On this basis, the marks are conceptually neutral.

25. However, I also note that the applicant’s mark includes the depiction of the golden berries, lemons and foliage, and the words GIN and BOUTIQUE, which are both ordinary dictionary words. The depiction of the berries and lemons are somewhat allusive of what the gin could be flavoured with. I also note that the word GIN is descriptive of the goods, and the word BOUTIQUE connotes that the gin derives from a smaller shop. On this basis, the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see Windsurfing Chiemsee, paragraph 51).”

27. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

28. As highlighted above, the opponent’s mark consists of the invented word, EIKO, which has no conceptual meaning. It is therefore neither descriptive nor allusive of the opponent’s goods. It is inherently distinctive to a high degree.

Likelihood of confusion

29. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

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

- I have found the marks to be visually and aurally similar to between a low and medium degree.
- I have found the marks to be conceptually dissimilar.
- I have found the opponent's mark to be inherently distinctive to a high degree.
- I have identified the average consumer for the goods to be adult members of general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical.

31. Taking all of the factors listed in paragraph 30 into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given that the marks are visually similar to between a low and medium degree because of the golden foliage device and the highly stylised font used in the applicant's mark, which are also the largest elements, and the fact that the purchasing process is predominantly visual. I therefore do not consider there to be a likelihood of direct confusion.

32. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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.”

33. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

34. Bearing in mind that the average consumer rarely has the chance to compare the marks side-by-side, will encounter them in different settings at different times, and therefore must rely upon the imperfect picture of them retained in its mind, I consider there to be a likelihood of indirect confusion, on the basis of imperfect recollection.

35. I am of the view that although the average consumer will recognise and remember the heavy stylisation and the golden foliage device in the applicant’s mark, they are still likely to imperfectly recall the differences in spelling between the words EIKO and EKO, overlooking the letter “I” in the opponent’s mark. This is on the basis that conceptually, both are invented words with no conceptual meanings. Consequently there is no significant conceptual hook in order to differentiate the marks. This is particularly the case bearing in mind the high level of distinctiveness of the opponent’s mark on the basis it is an invented word, with is neither allusive nor descriptive of the goods.

37. Albeit I appreciate that the words “THE” and “GIN BOUTIQUE”, and the foliage, berry and lemon device, are present to create a conceptual distinction between the marks, the word GIN is descriptive of the goods, the word BOUTIQUE connotes where the gin derives from (a smaller shop), and the berries and lemon devices are somewhat allusive of what the gin could be flavoured with.

38. Therefore, it is my view that the average consumer will view the applicant's mark as an alternative mark being used on identical goods, by the same or economically linked undertakings, perhaps being an updated version of the same mark and therefore indicative of re-branding. I consider that it is not uncommon for undertakings re-brand themselves from time to time to accommodate changes in marketing considerations. Consequently, I consider there to be a likelihood of indirect confusion.

COSTS

39. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£300** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£200
Official Fee	£100
Total	£300

40. I therefore order RM Spirits Limited to pay BBC VINS & SPIRITUEUX the sum of £300. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of July 2023

L FAYTER

For the Registrar

ANNEX

The First Earlier Mark

Class 33

Alcoholic beverages (except beers); Wine; Wines of protected designation of origin;
Wine with a protected geographical indication.

The Second Earlier Mark

Class 33

Alcoholic beverages (except beers).