

**O/106/18**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3178157  
BY CAPREOLUS DISTILLERY LTD  
TO REGISTER THE TRADE MARK**

**Garden Tiger**

**FOR GOODS IN CLASS 33**

**AND**

**IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 407941  
BY JEFFREY JOSHUA LAWRENCE**

## BACKGROUND AND PLEADINGS

1. On 3 August 2016, Capreolus Distillery Ltd (“the Applicant”) applied to register as a trade mark the words “Garden Tiger”, in respect of “*spirits and liqueurs*” in class 33. The application was published for opposition purposes in the Trade Marks Journal on 26 August 2016.
2. Registration of the mark is opposed by Jeffrey Joshua Lawrence (“the Opponent”). The Opponent relies on its ownership of four trade marks registered in the United Kingdom and one international registration giving protection in the European Union, with details as follows:

### Mark A:

Word mark  
Registration No. 3035040  
Tiger Gin Filed on 16 December 2013  
Entered in the register on 14 August 2015  
Goods in Class 33: Gin

### Mark B:

Word mark  
Registration No. 3140526  
Tiger Spirits Filed on 14 December 2015  
Entered in the register on 25 March 2016  
Goods in Class 33: Spirits

### Mark C:

Word mark  
Registration No. 3141544  
Blind Tiger Filed on 20 December 2015  
Entered in the register on 11 March 2016  
Goods in Class 33: Gin

**Mark D:**

Word mark  
Registration No. 3174628  
Filed on 14 July 2016  
Tiger Vodka  
Entered in the register on 9 December 2016  
Goods in Class 33: Alcoholic beverages (except beers);  
Alcoholic cocktails; Beverages (Alcoholic -), except beer;  
Cocktails; Spirits and liqueurs; Spirits [beverages]; Vodka.

**International Registration designating the European Union:**

Word mark  
Registration No. WE1287051  
Date of EU designation: 18 December 2015  
Tiger Gin  
(claiming seniority from 16 December 2013 based on UK  
trade mark 3035040)  
Protection conferred in the EU: 13 December 2016  
Goods in Class 33: Gin

3. The Opponent requests that the application be refused in its entirety. The opposition is based on sections 5(2)(b), 5(3) and 3(6) of the Trade Marks Act 1994 (“the Act”).
4. Under the **section 5(2)(b)** ground the Opponent claims that the mark applied for is similar to its earlier trade marks set out above<sup>1</sup> and that the respective goods are identical or similar. The Opponent states that a significant number of trade marks in its portfolio contain the *“...word ‘Tiger’ which shows the importance of this key word to the brand. Although there is no visual similarity between the two bottles there is the possibility of visual confusion between ‘Tiger Gin’ and ‘Garden Tiger Gin’ given the dominant and distinctive Tiger component. There is also the potential for aural confusion due to the similarities in the names. Gin is a spirit.”*
5. In respect of its claim under **section 5(3)** of the Act, the Opponent claims to have a reputation in the United Kingdom for gin arising from its registered trade mark “Tiger Gin”<sup>2</sup>.

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<sup>1</sup> i.e. what I have described as “Marks A – D”, plus the International Registration designating the EU.

<sup>2</sup> Trade Mark A.

The Opponent contrasts its “76,000 likes on Facebook” and “4,845 followers on Facebook” with the Applicant’s much lower figures. It states: “as you can see Tiger Gin has established a significant reputation compared to Garden Tiger, despite these both having been launched this year. This has come at a significant cost for advertising and marketing. Given the likelihood of confusion it is considered unfair that someone else should take advantage of the time and money that has gone into creating and developing the Tiger Gin brand.” The Opponent further states that “Tiger Gin has been awarded silver medals in both The International Spirits Challenge 2016 and The Gin Masters 2016 so is recognised as being one of the best gins in the world. These silver medals demonstrate the quality of Tiger Gin. Garden Tiger could take unfair advantage of this reputation by association with our brand. It could also affect our brand through production of inferior product.”

6. The Opponent also claims that the trade mark application must be refused on the basis of bad faith under **section 3(6)** of the Act. This claim is founded largely on the basis that the Opponent, shortly before the application was filed, had made the Applicant aware of various of its registered trade marks containing the word “tiger” in respect of the goods at issue and raised the prospect of infringement proceedings. It also claims that the Applicant founded its distillery “in 2014 although it took over two years to have product bottled and ready to sell. The application for the Tiger Gin trade mark was filed on 16 December 2013. The Applicant maintains that he was unaware of the Tiger Gin brand until after launch, but he proceeded to apply for his trade mark after our letter knowing full well that our brand existed.”
7. The Opponent filed evidence - both in chief and in reply to evidence from the Applicant – including submissions within a witness statement. I summarise the evidence below. I shall refer to points submitted by the Opponent, in its statement of grounds and elsewhere, so far as I consider appropriate in this decision.
8. The Applicant filed a notice of defence and a counterstatement in which it contests all the grounds of the opposition. I set out here substantial extracts from the counterstatement as it sets a clear context for the opposing viewpoints.
9. The Applicant states that the parties “are working in an extremely crowded field, the gin boom has resulted in a large amount of products and [the parties] own strong brand identities are clearly heavily distinguishable. The reality is that we are producing products that are bought by educated and discerning clients - they are typically not impulse buys but

educated decisions made through research or direct recommendation by on trade staff. Confusion is extremely unlikely.

...

*The diversity each brand provides means that there is an inconsequential cross over in identity. In a similar vein we would not be offended if another company used a moth logo and certainly feel no threat when many venues are opening "gin gardens" or for the spirits and drinks that share "garden" in their title (for example; Seedlip Garden, Garden Bramble, Garden Mead, Court Garden and Garden of Eden). We therefore suggest that "aural confusion" is extremely unlikely to occur."*

10. The Applicant contends that *"given the extent of gin market ... it is unavoidable to have some brands that share elements of name or appearance."* It then refers to other tiger brands for gin, from various countries, including *"Blind Tiger Gin"* from Belgium, which the Applicant says he knows to be *"a very popular brand in the UK and appears to directly contravene [the Opponent's] "Blind Tiger" trade mark."*
11. The Applicant acknowledges the Opponent's success in *"garnering large amounts of followers on Facebook and Twitter. In this matter we congratulate them. However, we observe that they use many "re-tweet and follow" and "like and follow" competitions to win a bottle of gin. People are quick to follow these promotions, we all like something for free, but it is certainly not an indication of brand support - it is viral marketing at its best."*
12. The Applicant also congratulates the Opponent on producing a good product, but seeks to give context to the claim that Tiger Gin *"is recognised as one of the best gins in the world"* by commenting on how the competitions operate. *"A large fee is paid and then if the spirit scores within certain thresholds they are awarded a medal, there can be many bronze, silver and gold winners. In the International Spirits Challenge 2017 there were 104 medals awarded to different gins. In the Gin Masters 2016 13 categories of gin saw 236 medals awarded."* It claims that *"paid competitions simply do not equate to an overall market recognition."*
13. The Applicant rejects any suggestion that it is seeking to take advantage of *"a small brand released within a few of months of its own product"*. It states that its brand name of Garden Tiger is *"named after a daytime flying moth and not a tiger"*. It states that the Opponent's company *"appear to be particularly focused on trademarking"* including *"such catchphrases*

as: *Cool for Cats; Get into the Spirit; The Tiger who came for G&T; The Cats Whiskers; Party Like an Animal; Catnip for Tigers; Easy Tiger.*” The Applicant states that it had registered its mark as it feared that the Opponent’s company “*would attempt to copyright our own brand name.*”

14. The Applicant also filed evidence, which I summarise below.
15. The Applicant is self-represented in these proceedings and Angela Woolford acts as the Opponent’s representative. Neither party requested a hearing and I take this decision based on a careful reading of the papers filed.

### **EVIDENCE SUMMARY**

16. The parties filed evidence running to several hundred pages in total, including submissions and respective responses from each party. Immediately below, I summarise the most relevant points of the evidence relating to the claims under sections 5(2)(b) and 5(3). Later in this decision, I refer separately to the evidence relating to the claim of bad faith, to the extent that I consider necessary.

#### *The Opponent’s evidence in chief*

17. The Opponent’s evidence in chief comprises a 13-page witness statement dated 20 April 2017, made by Angela Woolford, supported by 137 pages of exhibits labelled **Exhibit AW-1 – Exhibit AW-13E**. The witness is a business consultant acting as the Appointed Representative in relation to the Opponent’s trade marks and the statement is said to be based on her own knowledge.
18. The witness refers to the upward trajectory of the Opponent’s Facebook followers between the launch of its Tiger Gin in March 2016 and the milestone of 25,000 followers reached on 29 May 2016, which by 17 July 2016 had risen to over 50,000 followers. **Exhibit AW-4H** and **Exhibit AW- 4I** evidence the numbers of Facebook followers.
19. The witness responds to contentions in the Applicant’s counterstatement that the social media figures are attributable to viral marketing and not an indication of brand support. The witness counters that if that were true, “*the number of followers would decrease as people*

*lost interest and 'unfollowed' and 'unliked'. That has not happened and the numbers continue to rise. Indeed, the numbers quoted in the TM7 of in excess of 76,000 likes on Facebook vs the Applicant's 166, and 4,845 followers on Twitter vs the Applicant's 110, have now changed to 137,746 (Exhibit AW-6) vs 240 (Exhibit AW-6A) Facebook followers and 18, 100 (Exhibit AW-6B) vs 182 (Exhibit AW-6C) on Twitter. The Opponent's evidence shows both significant engagement and interest as demonstrated by 6,884 new page likes on Facebook and 6,293 likes on Twitter against 4,420 tweets vs the Applicant's 38 likes against 157 tweets. The evidence presented here indicates significant enhanced distinctiveness as a result of brand awareness and engagement."*

20. **Exhibit AW-5** is a page printed from a search of Amazon.co.uk for "Tiger Gin" which shows the products of the Applicant and Opponent side by side. The witness states likelihood of confusion in the descriptions is "*demonstrated by this exhibit as 'Tiger Gin' and 'Garden Tiger Gin' have both been produced as results on Amazon.*" **Exhibit AW-5A** contains two pages from the Applicant's website showing products under the Garden Tiger mark, where the products are described as "Garden Tiger dry gin" and "Garden Tiger Gin – Aged in Apple Eau de Vie, Mulberry Wood Barrel 2016". I note that the label in each case appears to read "*beautifully complex dry gin distilled from 34 botanicals prepared by hand in the heart of the Cotswolds.*"
  
21. The witness statement also contains submissions, allied to various exhibits, in respect of conceptual similarity leading to a risk of confusion on the part of the public that the goods are from the same or economically-linked undertakings. The witness submits that a likelihood of confusion would be "*harmful to the Opponent's business*" and "*could potentially affect the Opponent's reputation too.*" The Opponent explains that it "*made a deliberate choice to use a Master Distiller with many years' experience in his craft rather than attempt to produce his recipe himself.*" I note that the Applicant acts as its own manufacturer. The Opponent includes exhibits providing various recent industry comment on the delicate intricacies of gin production and the view that "*a contract distiller lives and dies on ensuring their clients get a quality product*", and that although many "*smaller brands are very successful local passion projects, if they were to grow and become a global brand, it would be close to impossible.*"

22. The witness also addresses points from the Applicant's counterstatement relating to the Opponent's award of "Silver" at the International Spirits Challenge 2016 (which signifies "Fine product, above average"). The witness acknowledges that there is an entry fee for the competition (£190 per entry plus VAT) but argues that the number of countries entering the competition (1300 entries from 70 countries) "*makes this a truly international competition and the quality of the judges and other brands in the competition go towards proving reputation.*" Exhibits offered in evidence include profiles of the gin judges, whose credentials certainly indicate significant experience and industry recognition. The evidence shows the judging to be based on blind tasting to score on criteria such as aroma, taste, finish and overall balance. **Exhibit AW-8J** lists all winners in the 2016 tasting awards showing Tiger Gin as one of around thirty Silver awards, and that only four products achieved Gold. **Exhibit AW-9A** shows that the Opponent was one of twelve medal winners awarded in the 'Ultra-Premium" gin category at the Global Spirits Masters 2016, again gaining a "Silver" award.
23. The Opponent's evidence also shows that there has been some media coverage of its Tiger Gin, although the witness states that since the Opponent's micro company is still in its infancy, the evidence on press coverage is light. **Exhibits AW10 – AW10E** are various online articles from March 2016 – March 2017, from local or specialised publications, including blogs and websites. Coverage includes: the Shropshire Star, marking the launch of Tiger Gin, having overcome a High Court trade mark challenge from Tiger Beer; shropshirelive.com, covering the ISC Silver Medal award; various reviews of Tiger Gin, including from the Gin Foundry, and a blog, including an interview with the Opponent by the Ludlow Food Festival under the heading "*Cool Britannia. The Great British Tiger Gin*".
24. The coverage includes an article from OffLicenceNews dated 21 March 2017 from which I note the following extracts: "*Sales manager Angela Woolford said: "This small family firm has seen sales increase rapidly with demand initially coming from the local Shropshire area, then national and now international with many repeat orders from happy customers ... the company aims to focus on trade shows and also food festivals around the country."*
25. The Opponent's evidence presents very little information as to levels of sales. The witness explains that "*given that the Opponent's micro company is in its infancy, and due to the commercial sensitivities surrounding such information, it is not deemed vital to the outcome*

*to present such information. Whilst the market share component is considered to be irrelevant, as the only companies that can realistically lay claim to having a percentage are the major groups, the Opponent can give some indication of intensity of use. Although not divulging any financial details as to size of purchase orders we have included examples at Exhibits AW-11, AW-11A, AW-118, AW-11C and AW-110 as copies of emails from Just Miniatures, just 1 of the Opponent's distributors, between 21st June 2016 and 9th January 2017."*

26. The first of the emails from Just Miniatures (dated June 2016) refers to an invoice for "2 cases of miniatures to start off with." No amounts are mentioned in the other emails. The witness states (supported by an exhibited email) that the Opponent made its first export sale at a trade fair in the Netherlands. No information is given as to what was sold or in what quantity and, anyway, since the sale was not on the UK market it appears to have no bearing for the section 5(2) or 5(3) claims.
27. The witness also states that "*the Opponent has no full time employees as the business, being in its infancy, is not yet self-sustaining so all monies received are being put straight back into the business to pay suppliers and other statutory fees, and all non-production work is carried out by the Opponent, his family and friends.*"
28. The Opponent's evidence as to its expenditure on promotion and advertising is also very limited, although the witness submits that its evidence demonstrates the variety and volume of that spend. The witness states that while the sums spent on advertising and on promotional material to establish his brand may be "*comparatively small*", they are "*significant*" and "*large for them*" since the Opponent is an infant micro company.
29. **Exhibits AW-12A and AW-12B** are stated to be advertising pages run in April, May and June 2016 editions of GQ Magazine. The promotional content in each case (for example under the heading "*Happy Hour ... Drink to That!*") shows a small picture and description of Tiger Gin, in the company of a dozen or so alcoholic drinks from other producers (some of which feature far larger in the piece). The cost of the advert is not specified and the witness states that it does not consider that "*providing commercially sensitive information would ... be liable to affect the outcome.*" Instead the evidence exhibits at **AW-12C** the GQ Magazine advertising rates according to size and position – for example one page of "promotion"

appears to be £16,792. Whatever the applicable descriptor for the pieces at **Exhibits AW-12A** and **AW-12B**, it may be reasonable to presume that the cost would be divisible in some proportionate way among all producers whose products featured on the page.

30. The witness states that “*the amounts spent on Facebook and Twitter advertising have, no doubt, contributed to the meteoric rise in followers of the Opponent’s Tiger Gin brand*”, but no figure is given to indicate what the Opponent has spent. Instead the exhibits provided are simply an extract from Facebook explaining how its advert auction process works and an extract from Twitter explaining how to advertise. **Exhibit AW-12G** is a photograph showing Tiger Gin as the official sponsor of the Shrewsbury Food Festival in June 2016. No sponsorship cost is given.
31. Other exhibits show Tiger Gin for sale on various websites such as Just Miniatures and thedrinkshop.com (“Global Brands Delivered Worldwide”). Again, no evidence of sales is given.

#### *The Applicant’s Evidence*

32. The Applicant’s evidence comprises a 12-page witness statement in the name of Barney Wilczak dated 7 July 2017 together with **Exhibits BW1 to BW36**. The witness has been the Director of Capreolus Distillery Ltd since 2014. Most of the statements made are composed of points of argument responding to points within the Opponent’s evidence and revisiting points in the Applicant’s counterstatement. As I have already indicated, my findings in this decision take account of the parties’ submissions and there is no substantive benefit in rehearsing their content at this point.
33. Noting that the Applicant is without professional representation in these proceedings, at various points in this decision, particularly where I consider likelihood of confusion, I address common (if understandable) misconceptions about this area of law. In light of those clarifications<sup>3</sup>, it should be clear why I consider it unnecessary to summarise much of the

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<sup>3</sup> Points of clarification and legal context include: an emphasis that the comparisons under section 5(2) are on a notional basis; that this opposition cannot concern itself with the reputation or sales of the Applicant’s products, nor does it focus primarily on the quality or esteem of the Opponent’s goods; and that decisions are made on a case-by-case basis, so the fact that there may be other marks that share a contested component is not generally relevant.

evidence from the Applicant. It is enough to note that the witness himself summarises the evidence, broadly, as going to: the individuality of its brand and a lack of confusion between the Opponent's trade marks (or other gin brands linked by "Tiger"); the Applicant having itself secured a "significant reputation" over an international market; points of contention as to the strength of evidence as to the relative success of the Opponent's brand; rebuttal of the bad faith claims.

34. For example, the Applicant filed: evidence as to retail interest and sales of the Applicant's Garden Tiger gin in the UK and overseas (including sample invoices, customer reviews and coverage in such media as *The Guardian* and *Tatler* magazine); and various items going to the extent to which there has been peer recognition of the quality of the parties' respective products, including the Applicant's product receiving the award by The Whisky Exchange of "Spirit of the Year 2017"; and submissions contesting the implication in the Opponent's evidence that "*local passion projects*" cannot grow to a global scale.

*Opponent's Evidence in reply*

35. The Opponent's evidence in reply comprises a second witness statement from Angela Woolford (7 pages), together with **Exhibits AW14 – AW18**. It is unnecessary to detail the contents of this evidence, which responds on points such as issues of the relative success achieved by the parties, and highlights shortcomings in the Applicant's exhibits, including that some of the evidence from the Applicant appears to date from after the Applicant applied for its mark. Much of this, it will be clear, has no material relevance to the decision before me.
36. That completes my summary of the evidence filed for the purposes of sections 5(2) and 5(3).

## DECISION

### The claim under section 5(2)(b) of the Act

*My approach to this decision*

37. The Opponent commented in correspondence to the tribunal that although it refers to its other trade marks in its submissions, “*it is obvious that Tiger Gin is its ‘best case’ trade mark*”. Since the submissions and evidence refer almost exclusively to the Opponent’s trade mark “Tiger Gin” (which I described as Mark A above) I will in this decision focus on the Opponent’s case under section 5(2)(b) on that mark. I will, however, also mention Mark D “Tiger Vodka”, since it specifies goods in terms identical to those of the Applicant.

38. The Opponent’s claim is based on section 5(2)(b) of the Act, which 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.”*

39. Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”) defines an “earlier trade mark”, as including “*a registered trade mark ... which has a date of application for registration earlier than that of the trade mark in question ...*”. The Opponent’s Mark A was filed in December 2013, so is clearly an earlier trade mark under the Act, as indeed are all the marks relied on by the Opponent for its section 5(2)(b) claim.

40. Since none of the marks relied on had been registered for five years or more when the Applicant’s mark was published for opposition, those earlier marks are not subject to the proof of use provisions under section 6A of the Act. Consequently, for the purposes of its section 5(2)(b) claim, there is no obligation on the Opponent to show that it has used those marks at all.

41. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

*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.

42. The principles are that:

- (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 the goods

The goods to be compared are:

Opponent's class 33 goods	Applicant's class 33 goods
<p><b>Mark A</b> - "Tiger Gin":      <i>Gin</i></p> <p><b>Mark D</b> - "Tiger Vodka":</p> <p><i>Alcoholic beverages (except beers); Alcoholic cocktails; Beverages (Alcoholic -), except beer; Cocktails; Spirits and liqueurs; Spirits [beverages]; Vodka.</i></p>	<p><i>Spirits and liqueurs</i></p>

43. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated<sup>4</sup> that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application (and vice versa). The Opponent's Tiger Gin mark is registered only for "gin". The Applicant has applied to register its mark for "spirits and liqueurs". Gin is a spirit so, based on *Meric*, those goods are identical.
44. In considering the extent to which there is similarity between "gin" and "liqueurs", I take account of the factors identified by the Court of Justice of the European Union ("the CJEU") in *Canon*<sup>5</sup> where it states that:
45. *"In assessing the similarity of the goods ... all the relevant factors relating to those goods .. themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary"*.
46. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case<sup>6</sup> for assessing similarity were:

4 Case T- 133/05 at paragraph 29 of that judgment.

5 Case C-39/97, at paragraph 23.

6 *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

- (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.

47. A liqueur may be defined as a “*strong, sweet alcoholic spirit, usually drunk after a meal.*”<sup>7</sup> Gin may therefore provide the spirit basis of a liqueur. They are both drinks involving distilled alcohol and are to be consumed in relatively small quantities. The goods therefore share the same physical nature, users, purpose and method of use. A gin manufacturer may commonly also make liqueurs, and gins and liqueurs are commonly found alongside each other (or at least in fairly close proximity) on shelves in supermarkets. There is at least a degree of competition between the goods as one may choose one over the other in a restaurant or if buying a bottle from an off-licence for consumption at home. Overall I find “gin” and “liqueurs” to be goods that are highly similar.

48. The Opponent’s registration for Tiger Vodka designates “spirits and liqueurs”, so the goods under Mark D are directly identical to those of the Applicant. However, given that I have found the Opponent’s goods under its Mark A to be identical or highly similar to the goods applied for, and noting the focus of evidence and submissions filed, I find that the Opponent would not be in a significantly stronger position were I to decide the section 5(2)(b) claim on

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<sup>7</sup> oxforddictionaries.com

the basis of “Tiger Vodka” as well as “Tiger Gin”. I therefore decide the section 5(2)(b) claim only on the basis of Mark A.

### **The average consumer and the purchasing process**

49. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select the goods. It must be borne in mind that the average consumer’s level of attention is likely to vary according to the category of goods in question<sup>8</sup>. In *Hearst Holdings Inc*,<sup>9</sup> 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 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... [it] does not denote some form of numerical mean, mode or median.”*

50. The average consumer in this case is the adult general public. Alcoholic drinks may be bought in supermarkets, off-licences, department stores and so on. The online equivalents of such businesses are also relevant. This all suggests a more visual selection process, where a consumer will peruse shelves and browse the internet to select the goods. While the goods may also be purchased in bars and similar establishments, where they may be requested orally, the goods will still, ordinarily, be on display so that they can be seen<sup>10</sup>. Therefore, overall, I consider the purchase to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations and requests, so I also take into account the aural impact of the marks in the assessment.
51. I have noted the Applicant’s claims that those who buy the parties’ products are “*educated and discerning*” and that “*they are typically not impulse buys but educated decisions made through research or direct recommendation by on trade staff.*” However, as indicated above,

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<sup>8</sup> Lloyd Schuhfabrik Meyer, Case C-342/97

<sup>9</sup> 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),

<sup>10</sup> See Simonds Farsons Cisk plc v OHIM Case T-3/04

the average consumer is a notional construct for these trade mark questions and is deemed reasonably well informed and circumspect. Whilst some buyers may fit the profile outlined by the Applicant, other members of the adult public will not. I find that the level of attention of the average consumer in buying the goods specified in this case will not, generally speaking, be of a high level – a medium or average level of care will be taken.

**Comparison of the marks**

52. It is clear from *Sabel* that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (CJEU) stated in *Bimbo* 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.”
53. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

<b>Opponent’s earlier registered trade mark:</b>	Tiger Gin
<b>Applicant’s contested trade mark:</b>	Garden Tiger

54. The Opponent’s mark consists of two words, “Tiger” and “Gin”. Given that Gin is a purely descriptive term, the word Tiger is clearly the component which has by far the greatest relative weight in the overall impression of the Opponent’s mark.

55. The Applicant's mark combines the two ordinary words "Garden" and "Tiger". Both words contribute approximately equally to the overall impression of the Applicant's mark.

Visual similarity

56. Both marks comprise two words. In each case one of those words is the same distinctive word "Tiger", which is the fully dominant component in the Opponent's mark and which, in the Applicant's mark, makes an approximately equal contribution in the overall impression. Notwithstanding that "Tiger" is the second of the two words in the Applicant's mark and the first of the two words in the Opponent's earlier mark, I find the marks to be visually similar to a medium degree.

Aural similarity

57. The marks include words that are not present in the other party's mark, but in light of the shared presence of the distinctive and dominant word "tiger", and since the word "gin" is purely and directly descriptive, I find that the marks are aurally similar to a medium degree.

Conceptual similarity

58. The Opponent's mark will clearly be conceptualised on the basis of the name of an animal, being a striped big cat. I note the Applicant's explanation in its counterstatement that its mark is the name of a daytime-flying moth. However, I do not think that the average consumer would be aware of that creature. Encountering the words "Garden Tiger", I find it likely that the average consumer would perceive this is a reference to a striped big cat – just as in the Opponent's mark – albeit in conjunction with the word "Garden", which would evoke the concept of a tiger in a garden. I therefore find that the marks are conceptually similar to at least a medium degree.

## Distinctive character of earlier trade mark

59. The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel*). In *Lloyd Schuhfabrik*<sup>11</sup> 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 .....*

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

60. Mark A comprises two familiar and standard English words. The word “Gin” directly describes the relevant goods and is therefore not distinctive in this case (in the sense that any gin product may be marked as gin – it does not distinguish those goods as originating from a particular source).
61. The word “Tiger” is not at all suggestive of the goods, so at least has a normal or average level of inherent distinctiveness. The level of distinctiveness of a mark may be enhanced through use, although it is only UK use that counts for enhanced distinctiveness because the issue is the effect that any use has on the perception of the UK consumer.

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<sup>11</sup> *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

62. I take account of the evidence from the Opponent, noting in particular: the evidence as to a certain level of social media following (although it is not clear whether those followers are based in the UK); its achievements in competition; its advertising in GQ magazine; and the various other coverage identified. I also take into account that the Opponent's Mark A has only been used since the product launched in 2016, so its use is far from long-standing; that the Opponent admits to having no market share of any note; that the evidence reveals very little in terms of levels of sales, nor on amounts spent on advertising and promotion, other than the admission that the amounts are "*comparatively small*" (although significant for a young micro-business); and that neither is there relevant supportive evidence from chambers of commerce or other trade associations.
63. On balance, I find that the Opponent's evidence has not established that through use of Mark A in relation to gin that the mark has achieved an enhanced level of distinctiveness.

#### **Conclusion as to likelihood of confusion**

64. I now turn to reach a conclusion as to the likelihood of confusion between the word marks "Garden Tiger" and "Tiger Gin" in relation to the identical or highly similar goods I am considering.
65. The statement of grounds reads that "*a significant number of trade marks in its portfolio contain the "word 'Tiger' which shows the importance of this key word to the brand."* It is submitted elsewhere that "*given the quantity of National and International trademarks owned by the Opponent containing the dominant and distinctive component 'Tiger' it is distinctly possible that the relevant public would consider the Applicant's trademark to be another trade mark from the Opponent's portfolio."* It is possible that these references may be taken as akin to a 'family of marks' argument.
66. However, had it been the intention to run such an argument, the Opponent would need to have expressly made the claim and to have furnished proof of use in the UK of all the marks belonging to the claimed. Therefore, I dismiss any argument made on the basis of the Opponent having a number of Tiger-based marks.
67. Confusion can be either direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not

the same, but puts the similarity that exists between the marks/services down to the responsible undertakings being the same or related). Indirect confusion (and the difference between direct confusion), was considered by Mr Iain Purvis QC, sitting as the Appointed Person<sup>12</sup>, in *L.A. Sugar Limited v By Back Beat Inc*,<sup>13</sup> where he noted 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 recognised 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.).*

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<sup>12</sup> An Appointed Person is a senior lawyer, expert in intellectual property law, who hears appeals against decisions of the trade mark tribunal.

<sup>13</sup> Case BL-O/375/10

(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).”*

68. No likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). Sitting as the Appointed Person in *Eden Chocolat*<sup>14</sup>, James Mellor QC stated as follows:

*“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>15</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.’ (my emphasis).”*

69. I have noted that the task of comparing the goods had to be made on the basis of notional and fair use<sup>16</sup> of the services in the parties’ respective specifications. Submissions and evidence in this case have touched on: the differences between the bottles in which the goods are currently sold; references on the goods to the name of the distillery and the inclusion of a moth on the Applicant’s label; and discerning clients reading background material. These are not pertinent issues given that I am required to make a notional assessment based on the mark applied for and the mark as registered. In this case the comparison is between the plain words “Tiger Gin” and “Garden Tiger” in respect of goods that are identical or highly similar.

70. The Applicant has also pointed to the existence of other marks containing “Tiger”. However, the Applicant has not put forward evidence of use sufficient to show the impact on the average consumer of the marks and whether the result is that the average consumer will more readily distinguish between Tiger-based marks. It should also be noted that it is for the owner of a trade mark to protect its intellectual property rights as it sees fit. It may not be able or it may not wish to take action in certain circumstances. For example, a trade mark registration gives protection in a specific territory. Thus a mark registered only in the

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<sup>14</sup> Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

<sup>15</sup> In *L.A. Sugar Limited v By Back Beat Inc* Case BL-O/375/10 –above.

<sup>16</sup> See *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchin L.J. at paragraph 78.

UK would not be able to prevent use of the same mark for the same goods in another country. (Submissions in this case clarify that the Opponent has in fact taken action to enforce in the UK its trade mark against “Blind Tiger Gin” from Belgium.)

71. I also note the evidence and submissions from the Applicant relating to the extent to which it has achieved sales under the mark applied for and to which its goods have been well received. However, such considerations cannot feature in the decision before me.<sup>17</sup> Ms Anna Carboni, sitting as the Appointed Person,<sup>18</sup> has made clear that defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark are wrong in law: *“If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”* In the present circumstances, it is anyway clear that the Opponent’s Mark A had protection as of its filing date in December 2013, whereas the Applicant only established its company in September 2014.
72. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of weighing up the combined effect of all relevant factors in accordance with the authorities I have set out in this decision. My findings have included: that Mark A is distinctive overall to a medium degree; the concept of “Tiger” is distinctive for the goods at issue and is dominant in the overall impression of the Opponent’s mark; the concept of a large striped cat is not materially changed by the addition of the word “Garden”; the marks are conceptually similar to at least a medium degree, and visually and aurally similar to a medium degree.
73. Bearing in mind that the average consumer 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, I find that the average consumer, paying a medium or average level of attention seeing or hearing the marks used on goods that are identical or highly similar, may directly confuse the two, mistaking one for the other. If I am wrong about that and the average consumer would recall the word “Garden” in the Applicant’s mark and note its absence from the earlier mark, then when I take account of the common element of the word “Tiger” in the

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<sup>17</sup> See Trade Mark Practice Notice TPN 4/2009 “Trade mark opposition and invalidation proceedings – defences.”

<sup>18</sup> Ion Associates Ltd v Philip Stainton and Another, BL O-211-09

context of the Applicant's mark as a whole, I find in the alternative that there is a likelihood of indirect confusion. I note the references in the evidence to "botanicals" and to "gin gardens" and I find that the change of one element of the earlier mark may appear to the average consumer entirely logical and consistent with a brand extension.

74. **Consequently, the opposition succeeds on the basis of section 5(2)(b).** The Opponent has succeeded in full on the basis of Mark A and would be in no better a position in respect of its other earlier marks. In the circumstances, I do not consider it proportionate or necessary to consider the Opponent's claim in relation to those marks.

#### **The claim under section 5(3) of the Act**

75. Section 5(3) states that a trade mark that is similar to an earlier trade mark shall not be registered to the extent that the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark. In my assessment under the section 5(2)(b) claim, I have found medium visual and aural similarity, and at least medium conceptual similarity. On an overall assessment, for the purposes of section 5(3), Mark A satisfies the requirement of being "similar" to the Applicant's mark.
76. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:
- (a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.
  - (b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

- (c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph*
- (d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*
- (e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.
- (f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.
- (g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.
- (h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

- (i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

### Reputation

77. The Opponent has claimed a reputation for Mark A in relation to gin. The Opponent must show a reputation as at 3 August 2016, when the Applicant applied to register its mark ("the relevant date").
78. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I "take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it."
79. Those factors also arose in the assessment of enhancement of distinctive character<sup>19</sup> where I found the Opponent's evidence of use of Mark A to be insufficient to enhance its distinctiveness. However, that was a different context so I proceed to consider to an assessment of each of those factors as part of an overall assessment reputation.
80. In *Enterprise Holdings Inc. v Europcar Group UK Ltd*,<sup>20</sup> Arnold J. stated that proving a reputation "is not a particularly onerous requirement." However, the evidence before Arnold J. in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that

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<sup>19</sup> See extract from *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 above  
<sup>20</sup> [2015] EWHC 17 (Ch)

proving a reputation “*is not a particularly onerous requirement.*” He had no reason to turn his mind to situations where the claimant had only a tiny and/or unquantified share of the relevant market, which is clearly the circumstance in the present case.

81. The market share enjoyed by the goods offered or sold under the mark and the position it occupies in the market are valuable indications for assessing reputation. A small market share will generally be an indication against reputation, and in the present case, the Opponent has acknowledged that it has no significant share of the UK gin market. Nonetheless, I take note of the comments of the General Court in *Farmeco AE Dermokallyntika v OHIM*,<sup>21</sup> where it stated that a finding that an earlier mark had a reputation:

*“... is not called into question by the applicant’s argument that the turnover figures for sales and the amount spent on promoting the goods covered by the earlier marks ... have not been proved. It should be pointed out that the absence of figures is not, in itself, capable of calling into question the finding as to reputation. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all the relevant evidence in the case must be taken into consideration and, second, the other detailed and verifiable evidence produced by the opposing party is already sufficient in itself to prove the reputation of its mark ...”*

82. It is, therefore, not necessarily fatal that market share does not form part of the Applicant’s evidence; it depends on what else the Applicant has been able to prove.
83. The intensity of use of a mark may be demonstrated by sales volumes (the number of units sold) and turnover (the total value of those sales) attained by the opponent for goods bearing the mark. The Opponent’s evidence of sales figures is very limited and clearly not sufficient to contribute towards establishing a claim of reputation. Likewise the evidence on promotion and advertising is not sufficient. No clear figures of actual spend are evidenced and no information is given on readership numbers for the GQ magazine. No evidence is given on promotional spend at the food festivals mentioned nor on the numbers of attendees who may have encountered the Opponent’s mark in that context. Any expenditure arising from

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<sup>21</sup> Case T-131/09 at paragraph 59

social media activity is far from clear and nor is it fully clear whether the social media figures relate only to the UK.

84. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is known by a significant part of the public. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.
85. The evidence in this case shows that the Opponent's Tiger Gin brand has been in existence for a relatively short period, operating essentially as a small family business, although the witness has indicated ambitions for expansion. The quality of the product has been recognised in the form of international awards, but case law has made clear that reputation constitutes a knowledge threshold.<sup>22</sup>
86. In the present case, I find that the evidence provided does not establish that Mark A had acquired a reputation at the relevant date. Since the component conditions of section 5(3) are cumulative, there is no need to consider the ground further. **The claim under section 5(3) fails.**

#### **The claim under section 3(6) of the Act**

87. The Opponent wrote a letter (**Exhibit AW-4A**) to Barney Wilczak of Capreolus Distillery Ltd (the Applicant) dated 20 July 2016, in which it informed him that the Opponent owned UK trade marks for Tiger Gin, Tiger Spirits and Blind Tiger. The letter stated that "*Tiger Gin has already developed a significant reputation and is an award-winning gin*" and alleged that the use of "*Garden Tiger Gin*" infringed the Opponent's trade marks (and referred to infringement provisions under section 10 of the Act).
88. The Applicant replied by email on 25 July 2016 (**Exhibit AW-4B**) in which he contended that the allegation of "*copyright infringement*" was "*groundless*". The Applicant refers to over two years of intensive work on its product and states that the parties' "*branding, products, packaging and communications*" bear no relation to each other. The Applicant states that it

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<sup>22</sup> See for example para 69 of judgment of Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* Case No: IP-2015-000175 [2018] EWHC 35 (IPEC)

*“was unaware of [the Opponent’s] brand until after launch” and appreciated that both have “Tiger” in their gin titles, but was “sure there will be no grounds for confusion amongst a well educated and discerning public who are looking to purchase the respective products.”*

89. The Opponent submits that the fact that there were only six working days from date of Applicant’s email (**Exhibit AW-4B**) to its application shows undue haste that it considers *“outside the bounds of normal commercial practice”* and so evidence of bad faith.
90. The Opponent takes exception to various phrases used by the Applicant – for example, the Applicant’s description of the Opponent’s claims as *“completely unrealistic”* and the Applicant’s views that the claim of infringement was *“groundless”* and that it was *“fanciful”*<sup>23</sup> to claim that it would try to take advantage of a small brand, released within a few of months of its own product. The Opponent considers such characterisations as *“unnecessary and unprofessional”* and other submissions are *“frivolous”*, all of which should contribute to a finding of bad faith.
91. **Exhibit AW-4C** is a brand creation profile, attributable to the Applicant, confirming that the Applicant’s product launched in June 2016. The Opponent’s witness submits that had the Applicant at any point from the founding of his company/distillery in 2014 to the point of launch in 2016 checked the websites of any of the UK, EU or international (WIPO) trade mark registries, he would likely have seen the Opponent’s Tiger Gin application details among the other “Tiger” trade marks in class 33. The Opponent also submits that *“had the Applicant researched social media, he would most likely have seen some reference to Tiger Gin given the upward trajectory of Facebook followers ...”*

### **Legal principles on bad faith**

92. There is no definition of bad faith under section 3(6) of the Act or in the case law, but there are some key considerations that need to be taken into account when deciding a bad faith case. These were helpfully summarised by Arnold J in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch). The main considerations are as follows:

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<sup>23</sup> This is the term used by the Applicant in its counterstatement.

- Bad faith should be assessed at the date of filing the contested application.<sup>24</sup>
- However, later evidence may potentially be relevant if it helps to elucidate the position as it was at the application date.<sup>25</sup>
- A person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith.<sup>26</sup>
- Bad faith includes dishonesty and “*some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.*”<sup>27</sup>
- Section 3(6) of the 1994 Act, and comparable provisions under EU legislation, are intended to prevent abuse of the trade mark system.<sup>28</sup> As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties.<sup>29</sup>
- Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case.<sup>30</sup>
- Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own

<sup>24</sup> Case C- 529/07 *Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35]

<sup>25</sup> see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and Case C-192/03 *Alcon Inc v OHIM* [2004] ECR I-8993 at [41]

<sup>26</sup> see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

<sup>27</sup> see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999] RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

<sup>28</sup> see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21].

<sup>29</sup> see *Cipriani* at [185].

<sup>30</sup> see *Lindt v Hauswirth* at [37]

standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry.<sup>31</sup>

- Eighthly, consideration must be given to the applicant's intention. Arnold J refers<sup>32</sup> to the statements of the CJEU<sup>33</sup> in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, *Joined Cases C-456/01 P and C-457/01 P Henkel v OHIM [2004] ECR I-5089, paragraph 48*)."

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<sup>31</sup> see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

<sup>32</sup> See paragraph 138 Red Bull.

<sup>33</sup> The Court of Justice of the European Union

### *Decision on the bad faith claim*

93. In order to determine whether the conduct of the Applicant, in applying to register its UK mark, was dishonest, or otherwise fell short of the standards of acceptable commercial behaviour judged by ordinary standards of honest people, I consider what the Applicant knew about the matters in question and I try to discern what the Applicant intended when it applied to register its mark on 3 August 2016.
94. It is clear and uncontested that when the Applicant applied to register “Garden Tiger” as a trade mark, it knew of the Opponent’s earlier marks. In *Hotel Cipriani*<sup>34</sup>, Arnold J stated that it does not constitute bad faith for a party to apply to register a *“trade mark merely because he knows that third parties are using the same mark in relation to identical goods or services, let alone where the third parties are using similar marks and/or are using them in relation to similar goods or services. The applicant may believe that he has a superior right to registration and use of the mark. .... Even if the applicant does not believe that he has a superior right to registration and use of the mark, he may still believe that he is entitled to registration.”* In the present case, the mark for which the Applicant applied was not the same as the mark applied for, but was merely similar to the extent that it shared a common word. It is routine and commonplace for applications for trade marks to be made and defended in circumstances where the Applicant is fully aware that a third party proprietor of a trade mark contends that there is similarity to the Applicant’s mark and a registered mark. Whether there is or is not a conflict in a given case is the subject of proceedings that come before a tribunal or court. It is also routine and unobjectionable for one party to contest a trade mark claim made against it, and an assertion that a claim is “groundless” or “fanciful” can hardly be sufficient to sustain a claim of bad faith.
95. In this case, the Applicant does not appear well versed in matters of trade mark law and it is not clear what steps, if any, it took ahead of launching its product to look into the existence of other marks featuring aspects of its trade mark. However, I do not consider that to be conduct that falls *“short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area.”* The Applicant’s statement to the effect that it registered its trade mark to protect its brand is perfectly reasonable. It had

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<sup>34</sup> *SRL and others v Cipriani (Grosvenor Street) Limited and others* [2009] RPC 9 (approved by the COA in [2010] RPC 16) – paragraph 189.

spent time and resources developing its product to a point where it was launched just a few months after the Opponent's own goods. Its application appears entirely consistent with acting in good faith. An accusation of bad faith is a serious allegation and I find nothing in the evidence to sustain the claim. Therefore **the opposition on the ground of bad faith fails.**

**Costs**

96. The Opponent has been successful in its opposition based on section 5(2)(b) of the Act and is entitled to a contribution towards its costs. The Opponent filed a completed proforma for costs, which is a document provided in cases where the relevant party is a litigant in person (acting without professional representation). The level of compensation for litigants in person in proceedings is generally £19 an hour and the proforma indicates tasks totalling over 90 hours, although it should be noted that costs before the tribunal are awarded on a contributory basis, not a fully compensatory basis.
97. I note that in this case that Angela Woolford acts as the Appointed Representative for the Opponent in her capacity as a business consultant in relation to his trade mark. The Opponent does not therefore appear to be a litigant in person and I therefore assess costs based on the guidance in Tribunal Practice Notice 2/2016 rather than on the proforma submitted.
98. I award the Opponent the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Reimbursement of the official fee <sup>35</sup> for Notice of Opposition and Statement of Grounds:	£100
Preparing a statement of grounds and considering the other side's statement:	£200
Preparing evidence and considering and commenting on the other side's evidence	£700
<b>Total:</b>	<b>£1000</b>

<sup>35</sup> The fee for filing a claim on section 5(1) and/or 5(2) grounds only is £100; the reimbursement reflects that the Opponent succeeded only on its section 5(2) claim.

99. I therefore order Capreolus Distillery Ltd to pay Jeffrey Joshua Lawrence the sum of £1000 (one thousand pounds) to be paid within fourteen days of the expiry of the appeal period, or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 15<sup>th</sup> day of February 2018**

Matthew Williams

**For the Registrar,  
the Comptroller-General**

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