

O-178-14

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 2653702 BY
WIMBLEDON GIN CO TO REGISTER:**

WIMBLEDON GIN Co

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 400256 BY
THE WIMBLEDON BREWERY COMPANY LIMITED**

BACKGROUND

1. On 26 February 2013, Wimbledon Gin Co (“the applicant”) applied to register the mark shown on the cover page of this decision. The application was published for opposition purposes on 15 March 2013, for the following goods in class 33:

Alcoholic Wines, Spirits, Liqueurs, Alcoholic Cocktails.

2. The application is opposed by The Wimbledon Brewery Company Limited (“the opponent”). Proceedings before the Tribunal are governed by the Trade Marks Act 1994 (the Act). The Act implements, inter alia, Directive 2008/95/EC of the European Parliament and the Council of 22 October 2008 (the Directive) (as it is now). Consequently, interpretation of the Act is made on the basis of judgments of the Court of Justice of the European Union (CJEU) and the General Court (GC), both with their seats in Luxembourg, as well as those of the courts in the United Kingdom. All of the judgments of the GC (previously the Court of First Instance) and the CJEU can be found at the url:

<http://curia.europa.eu/jurisp/cgi-bin/form.pl?lang=en>

Judgments preceded by the letter C are from the CJEU and judgments preceded by the letter T are from the GC. The former is the higher court.

Decisions of the appointed persons, who are one of the two fora for appeal from decisions of the registrar, can be found on the website of the Intellectual Property Office at the url:

<http://www.ipo.gov.uk/types/tm/t-os/t-find/t-challenge-decision-results.htm>

Decisions of the appointed persons can be identified by the prefix BL (decisions of the registrar also have this prefix). (The other fora of appeal are the High Court of England and Wales, the High Court of Northern Ireland and the Court of Session (in Scotland).)

The acronyms RPC, FSR and ETMR refer to Reports of Patent, Design and Trade Mark Cases, Fleet Street Reports and European Trade Mark Reports respectively. These are publications in which various decisions and judgments in relation to intellectual property and the law of passing-off are reported.

3. The opposition, which is directed against all of the goods in the application, is based upon a single ground under section 5(2)(b) of the Act, for which the opponent relies upon all of the goods (shown below) in the following trade mark registration:

UK no. 2651034 for the mark: **THE WIMBLEDON BREWERY COMPANY LIMITED** which was applied for on 8 February 2013 and for which the registration procedure was completed on 24 May 2013.

Class 32 - Beers; ale; bitter beer; lager; stout; porter; mineral and aerated waters and other non-alcoholic beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines; fruit beverages and fruit juices; carbonated non-alcoholic drinks; syrups and other preparations for making beverages.

Class 33 - Alcoholic beverages (except beers); cider; perry; wines, spirits, liqueurs and cocktails; pre-mixed cocktails.

4. In its Notice of opposition, the opponent states:

“The mark of the application is visually, phonetically and conceptually similar to the opponent’s mark and the application covers goods identical to those covered by the opponent’s mark. The average consumer will therefore believe that the applicant’s goods originate from the opponent or from an undertaking economically linked to the opponent.”

5. The applicant filed a counterstatement, in which it states:

“WIMBLEDON – Place of business municipal address in common use in public domain (ipo advice 35.7).

GIN – Distilled spirit.

BREWERY – HMRC registered premises for the production of beer and ciders only (euro 32 Beer Brewery Products).

A globally appreciated every day choice of drink with NO likelihood of consumer confusion.”

Attached to the counterstatement are three pages (pages 2-4) taken from *The Beer Regulations 1993 No.1228* (which appears to consist of 15 pages in total), in which attention is drawn to the following text:

“*registered brewery*” – means any premises in respect of which a registered brewer is registered under section 47 of the Act;”

(3) Where the Commissioners are satisfied that a registered brewer has failed to produce any beer or has ceased to produce beer at any registered brewery, they make revoke his registration as a registered brewer with respect to that registered brewery at any time.”

Also included is the first page of *The Beer from Small Breweries (Extension of Reduced Rates of Excise Duty) Order 2004*.

6. Although neither party filed evidence, both filed written submissions during the course of the evidence rounds. Neither party asked to be heard nor did they file written submissions in lieu of attendance at a hearing. I will, as necessary, refer to the parties' submissions below.

DECISION

7. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

8. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3 above, which qualifies as an earlier trade mark under the above provisions. The application was published for opposition purposes on 15 March 2013 and the earlier trade mark completed its registration process on 24 May 2013. As the registration process of the earlier trade mark had not been completed 5 years or more before the application was published, the earlier trade mark is not (despite the applicant's request) subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004. As a consequence, the opponent can rely upon all of the goods for which its earlier mark is registered.

Section 5(2)(b) – case law

10. In his decision in *La Chemise Lacoste SA v Baker Street Clothing Ltd* - BL O/330/10 (approved by Arnold J in *Och-Ziff Management Europe Ltd v Och Capital LLP* [2011] FSR 11), the Appointed Person, Mr Geoffrey Hobbs QC, expressed the test under this section (by reference to the CJEU cases mentioned) on the basis indicated below:

The CJEU cases

Sabel BV v Puma AG [1998] RPC 199; Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc [1999] RPC 117; Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. [2000] F.S.R. 77; Marca Mode CV v Adidas AG & Adidas Benelux BV [2000] E.T.M.R. 723; Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM), Case T-6/01; Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH C-120/04; Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P.

The principles

“(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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 causes the public to wrongly believe that the respective goods [or services] come from the same or economically-linked undertakings, there is a likelihood of confusion.”

Comparison of goods

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
Class 32 - Beers; ale; bitter beer; lager; stout; porter; mineral and aerated waters and other non-alcoholic beverages; shandy, de-alcoholised drinks, non-alcoholic beers and wines; fruit beverages and fruit juices; carbonated non-alcoholic drinks; syrups and other preparations for making beverages. Class 33 - Alcoholic beverages (except beers); cider; perry; wines, spirits, liqueurs and cocktails; pre-mixed cocktails.	Class 33 - Alcoholic Wines, Spirits, Liqueurs, Alcoholic Cocktails.

12. Although the opponent's mark is also registered in classes 32, as it is registered in class 33 for, inter alia, wines, spirits, liqueurs and cocktails, these competing goods are clearly identical.

The average consumer and the nature of the purchasing decision

13. 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 these goods are likely to be selected by the average consumer in the course of trade. The goods at issue in these proceedings in class 33 are alcoholic beverages, the average consumer for which will be the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18.

14. All of the goods at issue may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self selection) and in public houses and restaurants (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar, menus etc.). When the goods are sold in, for example, public houses, the selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04, the Court of First Instance (now the General Court) said:

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

15. Consequently, while the goods may be ordered orally in public houses and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. As to the level of attention the average consumer will display when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are likely, in my view, to pay a reasonable level of attention to the selection of the goods at issue.

Comparison of marks

16. The marks to be compared are:

Opponent’s mark	Applicant’s mark
THE WIMBLEDON BREWERY COMPANY LIMITED	WIMBLEDON GIN Co

17. It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as a whole and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant elements of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives. In its submissions, the opponent states:

“4...it is submitted that the distinctive and dominant element of the earlier mark is WIMBLEDON BREWERY and the distinctive and dominant element of the application is WIMBLEDON as the other elements of the earlier mark and the application are negligible.

18. In its submissions, the applicant states:

“Wimbledon Gin Co (14 letters)
The Wimbledon Brewery Company Limited (33 letters)

Wimbledon (IPO advice 35.7)

Wimbledon is a civic, commercial and domestic address in common.
Visually, aurally in the public domain in every day common use.

Gin – Distilled alcoholic drink globally appreciated. Common everyday purchase.

Brewery – Building or premises that is/was used for brewing. Confusingly often subject to change of use.”

19. Both marks consist of words all of which will be well known to the average consumer. The word GIN in the applicant’s mark will be understood as a reference to the goods traded in by the applicant and the word Co (a well known abbreviation for the word Company) as a reference to the manner in which the applicant is organised (as opposed to it being, for example, a partnership). As a consequence, I agree with the opponent that it is the word WIMBLEDON which is the dominant element of the applicant’s mark.

20. Insofar as the opponent’s mark is concerned, similar considerations apply. The definite article is likely, in my view, to be largely overlooked by the average consumer. The words BREWERY and COMPANY LIMITED, will be understood as a reference to the area of trade in which the opponent is engaged and its legal status, respectively. In those circumstances, it is the word WIMBLEDON or, as the opponent suggests, the words WIMBLEDON BREWERY (which will be seen as a reference to an individual economic undertaking), which are the dominant element(s) of the opponent’s mark. Whilst the word WIMBLEDON will be well known to the average consumer as a

reference to a geographical area in south west London where a famous annual tennis tournament is held, there is no evidence or any suggestion in the submissions that it has any reputation for the goods at issue in these proceedings. It is, as a consequence, a distinctive element of both parties' marks.

21. The fact that both marks share the word WIMBLEDON together with an element which relates to the manner in which they are constituted i.e. Co and COMPANY LIMITED, results, in my view, in a reasonably high degree of visual similarity between them. Insofar as aural similarity is concerned, the competing marks are most likely, in my view, to be referred to as WIMBLEDON GIN Company (or WIMBLEDON GIN) and THE WIMBLEDON BREWERY COMPANY (or THE WIMBLEDON BREWERY or WIMBLEDON BREWERY). There is, in my view, a reasonably high degree of aural similarity between WIMBLEDON GIN COMPANY and THE WIMBLEDON BREWERY COMPANY and a slightly lower level of aural similarity between the other variants I have identified. In its submission, the opponent comments upon the conceptual position in the following terms:

“6. Conceptually, the earlier mark is likely to be seen by the relevant public as describing a company in Wimbledon producing alcoholic drinks. Similarly, the application is likely to be seen by the relevant public as describing a company in Wimbledon that produces drinks consisting of gin, a sub-category of alcoholic drinks, and is therefore likely to be seen as an extension of the earlier mark. Accordingly, the earlier mark and the application are to be considered conceptually similar.”

22. I agree with the opponent's submissions. For the reasons the opponent suggests, the competing marks are likely, in my view, to trigger very similar conceptual images in the mind of the average consumer and, as a consequence, are conceptually similar to a high degree.

Distinctive character of the opponent's earlier trade mark

23. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

24. As the opponent has not filed any evidence in these proceedings, I have only the inherent characteristics of its mark to consider. Whilst WIMBLEDON is a well known geographical location in south west London, when this word is combined with the words BREWERY and COMPANY LIMITED, it serves to limit the scope of the word to one

which refers to a specific economic undertaking based in that location which is engaged in a defined and limited area of trade and which has a particular legal status. It is possessed, in my view, of a moderate degree of inherent distinctive character.

Likelihood of confusion

25. In determining whether there is a likelihood of confusion, 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. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's mark as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and 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 he has retained in his mind.

26. In reaching a conclusion, I remind myself that in its counterstatement the applicant refers to, inter alia, *The Beer Regulations 1993 No.1228*. The purpose of the pages attached to the counterstatement (which, I note have not been provided, as per section 69 of the Act and rule 64 of the Trade Marks Rules 2008, in the proper evidential format) is, I assume, an attempt to draw a distinction between the goods of interest to the applicant and, given the use of the word BREWERY in the opponent's mark, the goods the applicant assumes are of interest to the opponent. However, even if these pages had been provided as evidence, they do not assist the applicant. As I mentioned above, given the interplay between the dates in issue in these proceedings, the opponent does not have to provide any evidence of the use it may have made of its mark (it may not as yet have used its mark at all). What I must do in those circumstances, is compare the goods for which the opponent's mark is registered with those for which the applicant seeks registration. Having done so, I concluded that the competing goods were identical. I also concluded that:

- The average consumer is the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18;
- Considered overall, the selection process is likely to be predominantly a visual one, although aural considerations will also play their part;
- The average consumer will pay a reasonable level of attention to the selection of the goods at issue;
- The competing marks are visually similar to a reasonably high degree and in part aurally similar to the same extent;
- The competing marks are conceptually similar to a high degree;

- The opponent's mark is possessed of a moderate degree of inherent distinctive character.

27. In its submissions, the applicant states:

"We would submit that the public is capable grasping immediately between a drink and a building or a brewed product vs. spirit based drink two radically different products. Would not be confused by the composite mark, example, Wimbledon Train, Wimbledon Tube, Wimbledon Village. The opposition is without merit."

28. In its submissions, the opponent states:

"10. In view of the identity or similarity of the marks, and in view of the prominent presence of the element WIMBLEDON in both the earlier mark and the application, the opponent considers that there exists a strong likelihood of confusion including the likelihood that the average consumer will be confused into mistakenly believing that the applicant and the opponent are commercially linked and is likely to assume that the products produced under the application have a common origin to those produced under the earlier mark."

29. In *L.A. Sugar Limited v By Back Beat Inc* (BL-O/375/10), the Appointed Person, Mr Iain Purvis Q.C, commented on the difference between direct and indirect confusion in the following terms:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark."

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where

the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

30. In my view, the visual, aural and conceptual differences between, inter alia, the word GIN in the applicant’s mark and the word BREWERY in the opponent’s mark are likely to be sufficient to avoid direct confusion i.e. where one mark is mistaken for the other. However, in my view, the reasonably high degree of both visual and aural similarity and the high degree of conceptual similarity between the competing marks is likely, in circumstances where identical goods are involved, to, as the opponent argues, lead the average consumer to: “be confused into mistakenly believing that the applicant and the opponent are commercially linked and [he] is likely to assume that the products produced under the application have a common origin to those produced under the earlier mark.” As a consequence, there is, in my view, a likelihood of indirect confusion and **the opposition based upon section 5(2)(b) of the Act to all of the goods in the application succeeds in full.**

Conclusion

31. The opposition based upon section 5(2)(b) of the Act to all the goods in the application succeeds in full and, subject to any successful appeal, the application will be refused.

Costs

32. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. Using that TPN as a guide, I award costs to the opponent on the following basis:

Preparing a statement and considering the applicant’s statement:	£200
Written submissions:	£300
Opposition fee:	£200

Total:

£700

33. I order Wimbledon Gin Co to pay to The Wimbledon Brewery Company Limited the sum of **£700**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 23rd day of April 2014

**C J BOWEN
For the Registrar
The Comptroller-General**