

O/193/18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3209564

BY LIAM MANTON

TO REGISTER THE TRADE MARK

Alderman's

FOR GOODS IN CLASS 33

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 408915

BY GELDERMANN PRIVATSEKTKELLEREI GMBH

BACKGROUND AND PLEADINGS

1. On 30 January 2017, Liam Manton (“the Applicant”) applied to register as a trade mark the word “Alderman’s”, in respect of numerous alcohol-based goods in Class 33 as follows:

Absinthe; Alcoholic aperitif bitters; Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages of fruit; Alcoholic bitters
Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches; Alcoholic tea-based beverage; Alcopops; Amontillado; Anise [liqueur]; Anisette; Anisette [liqueur]; Aperitif wines; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Beverages (Distilled -); Bitters; Black raspberry wine (Bokbunjaju); Blackcurrant liqueur; Blended whisky; Bourbon whiskey; Brandy; Cachaca; Calvados; Cherry brandy; Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy; Cooking wine; Cordials [alcoholic beverages]; Cream liqueurs; Curacao; Digesters [liqueurs and spirits]; Distilled beverages; Distilled rice spirits [awamori]; Distilled spirits; Distilled spirits of rice (awamori); Dry cider; Edible alcoholic beverages; Extracts of spiritous liquors; Fermented spirit; Flavored tonic liquors; Fruit (Alcoholic beverages containing -); Fruit extracts, alcoholic; Fruit wine; Gin; Ginseng liquor; Grape wine; Liqueurs; Low alcoholic drinks; Low-alcoholic wine; Malt whisky; Mulled wines; Natural sparkling wines; Naturally sparkling wines; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Red wine; Red wines; Rice alcohol; Rose wines; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Shochu (spirits); Sorghum-based Chinese spirits; Sparkling fruit wine; Sparkling grape wine; Sparkling red wines; Sparkling white wines; Sparkling wine; Sparkling wines; Spirits;

Spirits and liquors; Spirits [beverages]; Still wine; Strawberry wine; Sugar cane juice rum; Sweet cider; Sweet wine; Sweet wines; Table wines; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; White wine; White wines; Wine; Wine coolers [drinks]; Wine punch; Wine-based aperitifs; Wine-based drinks; Wines; Wines of protected appellation of origin; Wines of protected geographical indication.

2. The application was published for opposition purposes in the Trade Marks Journal on 10 February 2017. Registration of the mark is opposed by Geldermann Privatsektkellerei GmbH (“the Opponent”), relying on its ownership of a European Union trade mark (“EUTM”) and an international registration (“IR”) giving protection in the European Union (together “the Opponent’s marks”), with details as follows:

EU trade mark No. EU004701702: “GELDERMANN” (Word mark)

Filed: 24 October 2005 **Entered in the register:** 18 October 2006

Registered goods in Class 33: Sparkling wines

International Registration No. WE00001115057 designating the European Union:



(Stylised Word mark)

Date of EU designation: 28 February 2012

Protection conferred in the EU: 27 March 2013

Registered for goods in Class 33: Alcoholic beverages (except beers)

(as well as for goods in Classes 30 and 32)

3. Section 6(1)(a) of the Trade Marks Act 1994 (“the Act”) defines an “earlier trade mark”, as including “*European Union trade mark or international trade mark (EC) ... which has a date of application for registration earlier than that of the trade mark in question ...*”. Both of the Opponent’s marks are therefore earlier trade marks under the Act.

4. The Opponent requests that the application be refused in its entirety. It bases its opposition on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), claiming that the mark applied for is similar to the earlier marks of the Opponent and that the Applicant’s goods are identical or similar to the Opponent’s goods in Class 33 (“the Opponent’s goods”).
5. As both the Opponent’s marks had been registered for more than five years when the Applicant’s mark was published for opposition, each of those earlier marks is subject to the proof of use provisions set out in section 6A of the Act. The Opponent has duly provided a statement of use of both its marks in respect of its goods in Class 33.
6. The Opponent claims in its statement of grounds that there is a “*high degree of similarity*” between its marks and the mark applied for, that the Opponent’s marks have a “*strong inherent distinctive character*” and that there is identity or similarity between the parties’ contested goods, such that “*there is a likelihood of confusion on behalf of the public, which includes a likelihood of association, in the UK between the respective marks*”. The statement of grounds also makes numerous particular points in support of the Opponent’s claim (for example as to similarity of the marks); I shall refer to such points as I consider appropriate in this decision.
7. The Applicant filed a notice of defence and a counterstatement contesting the opposition and requesting that the Opponent provide proof of use of the earlier marks in relation to the goods relied on by the Opponent. The Applicant contends in its counterstatement that there are “strong visual, phonetic and conceptual differences between the respective marks” such that there is no likelihood of confusion, “*regardless of any identity or similarity between the respective goods*”. The Applicant also denies that the Opponent’s marks have a strong degree of inherent distinctive character.

Papers filed and representation

8. In addition to its Form TM7 Notice of Opposition and Statement of Grounds, the Opponent filed evidence, which I summarise below. The evidence was accompanied by written submissions (dated 7 August 2017) and the Opponent later also filed written submissions in lieu of a hearing (dated 28 November 2017), all of which I have read and considered.

There is a good deal of commonality between the points made in the statement of grounds and in each of the two sets submissions; I shall refer to points submitted by the Opponent so far as I consider appropriate in this decision. The Applicant filed no evidence or submissions.

9. The Applicant is represented in these proceedings by Wilson Gunn; the Opponent by Miller Sturt Kenyon. Neither party requested a hearing and I take this decision based on a careful reading of all the papers filed.

EVIDENCE SUMMARY

10. The Opponent's evidence comprises:
 - a **Witness Statement** executed by **Mr Richard Mark Hiddleston**, signed and dated 4 August 2017 with **Exhibit RMH 1**.
 - a **Witness Statement** (4 pages) executed by **Ms Cathrin Duppel**, signed and dated 5 August 2017 on behalf of the Opponent's Company Group, along with supporting **Exhibits CD1 - CD9**.

Evidence of Mr Hiddleston

11. Mr Hiddleston states that he is a trade mark attorney authorised to act on instructions from the Opponent's legal representatives. On 4 August 2017 he conducted a search of the UK and EU IPO trade mark databases. **Exhibit RMH1** shows the result of that search, revealing no trade mark registrations extending to the UK on either database "*for marks portrayed as one word containing the stem LDERMAN in relation to classes 32, 33 and 43.*"

Evidence of Ms Duppel

12. Cathrin Duppel states that she has, since 1 January 2016, been Head of Marketing at Rotkäppchen-Mumm Sektkellereien GmbH, owner of the Opponent company. She is

authorised to make her Witness Statement on behalf of the Opponent and its owner company and provides information from her own knowledge or the records of the two companies. She states that the facts in her Statement are intended to address the Applicant's request for proof of use of the EUTM and IR relied on by the Opponent. A central point made in Ms Duppel's Statement is that the Opponent's marks have been in continuous use in the EU and in particular in Germany since 1995.

13. **Exhibit CD2** is an historical document relating to an older wine maker featuring the name Geldermann. Ms Duppel states that GELDERMANN was first used on its own from 1995 in relation to sparkling wine.
14. Ms Duppel states that the Opponent and its successors in title have made "*substantial*" sales of a range of sparkling wines under the trade marks in Germany, Austria, Bulgaria and Latvia. Ms Duppel presents figures as to how many bottles of the Opponent's sparkling wine were sold in Germany alone in each year during the period 2012 – 2017. Broadly approximated, those figures are in excess of one and half million annually. Ms Duppel cites the figures based on the companies' records, but no corroborating evidence is exhibited.
15. Ms Duppel states that the Opponent has "*traditionally concentrated on the "on trade" in the sense of food providers and retailers and restaurants, placing advertisements in targeted magazines and publications and promoting the Trade Marks at specific high profile events in Germany. As such, the Opponent's advertising and expenditure has been quite low, but has been extremely successful.*" Ms Duppel states the approximate advertising expenditure in Germany and the EU under the Trade Marks in relation to the Opponent's Goods. I reproduce below the table of expenditure for the period 2012 – 2017:

Financial Year	Advertising expenditure in euros
2012	274,770
2013	100,520
2014	65,510
2015	9,450
2016	3,140
2017	22,800
Total	476,200

16. Ms Duppel states that the Opponent promotes its goods under its marks by placing advertisements in trade and other magazines. **Exhibit CD3** is described as a selection of advertisements said to have “*circulated in Germany, Austria, Bulgaria and Latvia*”, bearing the Opponent’s marks. The content of the exhibit includes numerous glossy images advertising various sparkling wines in bottles clearly bearing the Geldermann mark as rendered in figurative form under the IR. One set of images is accompanied by English text promoting the Geldermann sparkling wines and mentioning Peter Geldermann as the founding the wine producer in 1838.
17. In the twenty or so pages of the **Exhibit CD3** itself, there is no clear indication where, when or whether the promotional material was actually used (beyond the description given by Ms Duppel in her Statement). Certainly there is no itemisation of publications in which advertisements may have been placed. However, some of the pages of the exhibit include words such as “*Stand: Januar 2016*” or “*Stand: März 2015*”, which may indicate that the associated images presented in the exhibit were deployed as advertising stands at promotional events. Ms Duppel also states that the “*Opponent further promotes the Opponent's Goods under the Trade Marks by holding trial and promotional events and placing advertisements in theatres and other events and venues*” including, for example, the Wagner Bayreuth Festival; and particularly as **Exhibit CD4** is said to show “*a selection of photographs showing the Opponent's stands and bottles bearing the Trade Marks at a number of such promotional events in Germany*”. Examples specified include a Porsche Classic Tennis Tournament in 2013 and a Mercedes Benz Opera Lounge in Mannheim in 2017. The images feature some of the materials presented under **Exhibit CD3**.

18. Ms Duppel states that the Opponent also promotes its goods under its marks on its website at www.geldermann.de. Ms Duppel states that **Exhibit CD5** consists of “*relevant extracts from these websites for the years 2012 – 2017*”, that “*the Opponent also operates an online retail store from this site*” and that “*it can also be seen that the price of the Opponent’s bottles sold under the mark varies from about 8 to 22 EUROS for a 0.75 L bottle*”. The extracted print outs from the website clearly show the www.geldermann.de (German) domain name at their foot, and the content also shows (by use of the words in the header) a Geldermann online shop. The extracts naturally include repeated references to ‘Geldermann’ as part of the website’s details of various sparkling wines sold by the Opponent. The extracts also show various images bottles of sparkling wine, bearing the mark in the form under the IR. However, the exhibit, so far as I could see, shows no information on pricing.
19. Ms Duppel states that the records of the Opponent show that the www.geldermann.de website is viewed by “*a substantial number of potential customers from the EU.*” Ms Duppel seeks to illustrate the point by stating that “*the website was viewed by approximately 2,900 potential customers per week during the period November 2016 to March 2017.*” It is not clear, however, how much of that figure may be attributable to viewers accessing the site on dates subsequent to the date on which the Applicant applied for its mark (10 February 2017).
20. Ms Duppel states that to promote the Opponent’s marks the Opponent operates guided tours of its winery and cellars. This is supported **Exhibit CD6**, which consists of extracts from a German tourist information website, from www.tripadvisor.co.uk and from the Geldermann website. The Opponent’s marks are again visible in the images of the winery and cellars, including as advertising boards and on bottles of wine.
21. As evidence of the Opponent’s use of its marks on packaging and labels, **Exhibit CD7** is a selection of six physical labels for various sparkling wines (Brut, Rosé Sec, Classique Sec etc) all showing the mark in its figurative form beneath a crown and castle device, and some of the labels also include the plain word version of the EUTM. Ms Duppel states that those labels are “used on bottles sold in the EU, including Germany, Austria, Bulgaria and Latvia”.

22. Ms Duppel states that **Exhibit CD8** consists of a selection of invoices to customers in Germany, Austria, Bulgaria and Latvia for each of the years 2012 – 2017, to illustrate claimed “substantial sales” of the Opponent’s goods under the mark, in those countries, during that period. **Exhibit CD8** appears to be around seventy pages of invoices, all bearing the brand of the Opponent’s owner company (Rotkäppchen-Mumm Sektkellereien GmbH) and wherein each price reference has been scored through with a black marker pen. The documents are in German, but it seems that some of the invoices relate to countries not in the EU (Switzerland, United Arab Emirates, Democratic Republic of Congo, Hong Kong). The vast majority of them relate to Germany. I noted only one invoice in the exhibit that related to Austria – dating from July 2012 in respect of goods described in the exhibit as “GM HM EE” and where the quantity appears to be around 450. It is not clear from the evidence that that description relates to goods under the Geldermann mark. I noted no evidence in respect of Bulgaria and only two invoices relating to Latvia (“Lettland” in German) – one dates from February 2013 and is for 24 bottles that appear free of charge; the other is dated 21 March 2014 and appears to be in respect of 144 bottles.
23. The exhibit does, though, include dozens of invoices relating to places in Germany (such as Cologne, Munich, Hamburg and Berlin) in various months from the years 2012 - 2017. For example the evidence shows an invoice dated 22 October 2012 in respect of an address in Hamburg for more than 560 bottles; another dated 6 February 2013 for 600 bottles relating to an address in Munich; an address in Hamburg in May 2014 for 552 bottles (plus 432 free); an address in Berlin buying 300 bottles or more in May and in November 2015; and an address in Hamburg buying more than 550 bottle in December 2016.
24. Ms Duppel states that “so successful has been the sales of the Opponent's Goods under the Trade Marks that the Opponent has generated a substantial reputation in the Trade Marks in the EU.” **Exhibit CD9** is said to be filed to support that claim and is an extract from <https://de.wikipedia.org> relating the Opponent. I note that the article was last edited on 2 May 2015. The exhibit is both in German and in English and it gives the history of the Opponent and its trade marks, confirming much of what Ms Duppel stated in relation to **Exhibit CD2**. I note that the article states that “*the goal of expanding sales to up to*

4.5 million bottles ... has been seen as a failure: in 2007, only 1.9 million bottles were sold. Thus the takeover could not stop the long-term decline of the champagne cellar."

25. Ms Duppel concludes her Witness Statement by stating that to her knowledge *"the Opponent is the only business selling sparkling wines in the UK or EU under a mark containing the stem LDERMAN as one word."*

PROOF OF USE

26. The Opponent must show that during the 5 years up to the date when the Applicant's mark was published for opposition purposes the Opponent's earlier marks have been put to genuine use in relation to the goods on which it relies. The relevant period for proving use in this case is therefore 11 February 2012 to 10 February 2017.

27. Section 6A states that the use conditions are met if:

- " ... (3) (a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.
- (4) For these purposes -
- (a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and
- (b)
- (5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.
- (6)"

28. Section 100 of the Act makes it clear that the burden of proof falls on the Opponent to show that it has used its marks.
29. My initial task is therefore to determine whether the submitted evidence is sufficient to show that the Opponent's marks have been put to genuine use during the relevant period in relation to "sparkling wines" and "alcoholic beverages (except beers)".
30. This determination must be made in light of the numerous principles established in relevant case law. The case law on genuine use of trade marks was summarised by Arnold J in *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Anor*, [2016] EWHC 52, who said as follows:

"217. In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the Court of Justice of the European Union (CJEU) in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* 2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

[218] ...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of

Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].
- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

31. Since the Opponent’s marks are registered in respect of the European Union, it is also necessary to bear in mind judicial comment in leading cases that have considered the geographic extent of the use required to be shown.

32. In *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, the Court of Justice of the European Union noted that:

“36. It should, however, be observed that the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine

use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

33. The Court in *Leno Merken* held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark

has been put to 'genuine use in the Community' within the meaning of that provision.

A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

34. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

"228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not

sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."
35. The General Court restated its interpretation of *Leno Marken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). That case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition (and cancellation) proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.
36. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create

or maintain a market for the goods/services at issue in the Union during the relevant five year period. In making the required assessment I must consider all relevant factors, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

37. In making my determination as to whether the evidence presented shows the necessary genuine use, I also take account of judicial comment as to probative and evidential issues in such cases. In *Awareness Limited v Plymouth City Council*¹, Mr Daniel Alexander Q.C. sitting as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use [...]. However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

38. In *Dosenbach-Ochsner*², Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person stated that:

¹ Case BL O/230/13

² *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13

- “22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”
39. The Opponent has contended that there is clear evidence of use of the Opponent’s marks in relation to the Opponent’s goods, although in its submissions in lieu of a hearing, it states that it “has provided proof of use of the Opponent’s marks at least in relation to sparkling wines.”
40. I find from the combination of **Exhibits CD3, CD4, CD5, CD6** and **CD8** that there is reasonably good evidence that the Opponent has promoted and sold sparkling wine under the marks in Germany. That is the case despite possible shortcomings in those exhibits as I have mentioned in my summary. While there is no clear indication of market share, there is good evidence as to scale and frequency of use of the earlier marks in relation to sparkling wine. I especially note the stated sale in Germany alone of in excess of one and half million bottles in each year during the period 2012 – 2017, and the stated advertising expenditure arising from various high-profile promotional events in Germany during that period.
41. The promotion and sales evidenced in relation to Germany undoubtedly show real commercial exploitation of the mark, for sparkling wines. However, there is no evidence at all in relation to goods other than sparkling wine and the evidence as to use of the mark elsewhere in the EU is not strong. Ms Duppel states that the Opponent promotes its goods under its marks by placing advertisements in trade and other magazines circulated in Germany, Austria, Bulgaria and Latvia, but I do not find that claim to be substantiated by **Exhibits CD3** or **CD4**. And although Ms Duppel states that the www.geldermann.de website is viewed by “a substantial number of potential customers from the EU”, **Exhibit CD5** gives no information on the source of visits to the website or of purchases from its online shop.

42. Likewise, I note Ms Duppel's statements that the Opponent has made substantial sales in Germany, Austria, Bulgaria and Latvia for each of the years 2012 – 2017, but I find in the exhibits filed no supporting evidence for that claim insofar as it relates to the latter three territories. In **Exhibit CD8** I noted just a single (2012) invoice relating to Austria for goods described in the invoice as "GM HM EE" and where the quantity appears to be around 450. While the "GM" component of the description of the goods in that invoice may well relate to the Opponent's mark and wines, it is certainly not clear. I noted no evidence in respect of Bulgaria and only two invoices relating to Latvia (2013 and 2014) where the number of bottles provided appears to be 168 in total. I do not find that the evidence shows claimed "substantial sales" of the Opponent's goods under the mark, in Austria, Bulgaria and Latvia during the five-year period. However, even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. Taken together with the evidence of substantial sales in Germany, I conclude that the evidence filed satisfies the proof of use requirements for Opponent's marks in the EU, but only in relation to sparkling wines, not alcoholic beverages more widely. Since sparkling wines are present too in the specification of the Applicant, my conclusion as to proof of use provides the Opponent with its best case (i.e. identical goods). Therefore, for procedural economy, I shall consider the issue of a fair specification only if necessary if it proves necessary to do so.
43. Consequently, the Opponent may rely on its marks as a basis of its claim under section 5(2)(b) of the Act in relation to its registration for sparkling wines in class 33.

DECISION

My approach to this decision

44. "Sparkling wines" are goods in class 33 specified both by the Opponent in respect of its EUTM and by the Applicant; thus, to that extent, the Applicant's goods are clearly identical to the Opponent's goods under its EUTM. The Opponent's IR is figurative, rendering the word Geldermann in a manuscript-style font, involving curlicues and stylisation not present in its EUTM. It is clear therefore that the EUTM itself, being a plain word mark,

is closer to the Applicant's mark than is the IR. For procedural economy, I will therefore make this decision on the basis of the EUTM.

Applicable law

45. 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."

46. 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.

47. 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

48. As noted, the Applicant's goods in Class 33 include "sparkling wines", which are clearly identical with the Opponent's goods under its EUTM. For reasons of procedural economy, I will not consider the level of similarity between the Opponent's sparkling wine and the remaining goods in the Applicant's specification.

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 question³. In *Hearst Holdings Inc*,⁴ 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. Sparkling wines may be bought in supermarkets, off-licences or online equivalents of such businesses. This 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 restaurants and bars and similar establishments, where they may be requested orally, the goods may still, commonly, be selected from a wine list or may be on display so that they can be seen⁵. 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

³ Lloyd Schuhfabrik Meyer, Case C-342/97

⁴ 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),

⁵ See *Simonds Farsons Cisk plc v OHIM* Case T-3/04

recommendations and requests, so I also take into account the aural impact of the marks in the assessment.

- 51. While a sparkling wine may well be purchased to mark a particular celebration, the goods are not typically especially costly. I find that the level of attention of the average consumer in buying the goods at issue 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. 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:

Opponent’s earlier EUTM:	GELDERMANN
Applicant’s contested trade mark:	Alderman’s

- 53. The overall impression of the Opponent’s mark derives from the single word “Geldermann”, which the average consumer in the UK would find to have no meaning in English (since it has none). The average consumer in the UK would likely perceive it as a surname, and likely as a surname that is Germanic in nature.
- 54. The overall impression of the Applicant’s mark derives from the single word “Alderman’s”, which the average consumer in the UK would perceive as a surname, and one that is seemingly English. The average consumer in the UK is deemed reasonably well

informed and may therefore also recognise as a word with a meaning in English. The average consumer would perceive the inclusion of the apostrophe with the letter s as the common indication of ownership or possession.

Visual similarity

55. Both marks comprise just a single word and have in common seven letters in the same order “-LDERMAN”. The Applicant’s mark differs from the Opponent’s mark in that the former begins with the letter A and ends with the single -N with an apostrophe S, whereas the latter begins with the letters GE and has an additional final letter -N. The Opponent claims that the respective marks are visually highly similar. Notwithstanding their common component, I find that the differences would be noted by the average consumer. Case law⁶ supports the view that as a general rule of thumb, the beginnings of word tend to have more visual (and aural) impact than their ends. I find that rule of thumb holds good in this case. I find the marks to be visually similar to a low to medium degree.

Aural similarity

56. The Opponent claims that the respective marks are phonetically highly similar. It submits that phonetically the “stem -ANN and -AN would be pronounced identically. Moreover, in conversation ... the goods ... could be referred to as “Alderman’s products” or “GELDERMANN’s products” and, as such the final apostrophe S will not help differentiate.” I note both those points, but I also note the quite different opening sounds of the marks - between the “AW” sound of the Applicant’s mark (pronounced as in “cauldron” or “alternative”) or possibly an “AH” as in “Allan”, as against the GE sound of the Opponent’s mark (pronounced more or less as in “guest”). I find that the average consumer would notice those differences in opening sounds. Again, taking account of the general rule of thumb that the beginnings of word tend to have more impact than the ends, I find the marks to be aurally similar to a low to medium degree.

⁶ See for example the judgment of the General Court in *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Conceptual similarity

57. Geldermann is a word without meaning or concept in the UK. By contrast, from their respective claims and submissions it is common ground between the parties that the word “alderman” in English means *“a member of a borough or county council.”* Although the notional average consumer is deemed reasonably well informed, I find that some of the UK public may have no understanding of the word and may not even have encountered it. At the same time, some members of the public will have a clear understanding of the word, and I find that at least a substantial proportion of the average consumer would not only recognise “alderman” as an English word, but would also have at least an approximate understanding of the concept as, say, signifying the holder of some sort of office. For the latter proportion of the average consumer, one mark has a meaning or concept in the English language, the other does not, with the consequence that the marks are conceptually dissimilar in that regard.
58. It is also common ground between the parties that both Geldermann and Alderman will be seen as surnames. (The Opponent’s submissions gives examples of notable persons having Alderman as a surname.) The Opponent argues in its submissions in lieu that *“it is possible that the relevant consumer will not recognise any conceptual difference in relation to either mark. If so, the conceptual significance of either mark would clearly not help to differentiate the marks.”*
59. I find that the average consumer will see both parties’ marks as surnames. They will be seen as surnames with some elements in common – but they are different surnames, signifying different origins. I find that Geldermann will be perceived as a surname that is not characteristically English, more Germanic in character. (This is not to assert or ascribe any necessarily accurate etymology of the word; it is only a comment on its general overall impression.) Indeed, the Opponent states in its own submissions that *“if the relevant consumer recognises GELDERMANN as a surname, this surname would be viewed as a German surname and therefore not common in the UK.”*
60. Even where the average consumer, unaware of an English language meaning of the word “alderman”, sees no conceptual dissimilarity from “Geldermann” on that basis, I still find the marks conceptually dissimilar, since they would be seen as surnames, one seemingly

English, the other seemingly Germanic and a core function of a surname is denote separate and distinct family origins. If I am wrong about the two particular surnames in this case giving rise to a conceptual dissimilarity, then in the alternative I find neutrality in relation to a conceptual comparison between the marks.

Distinctive character of earlier trade mark

61. 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*⁷ 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).”*

62. The Opponent makes various submissions as to the distinctiveness of its earlier marks. It submits that “conceptually the Opponent’s marks have no significance in the English language in relation to the Opponent’s goods” and therefore has “a strong inherent distinctive character and should be afforded a broader ambit of protection.” The Opponent refers to the UK IPO’s Work Manual which quotes the judgment of the CJEU

⁷ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

in Case C-404/02, *Nichols plc v Registrar of Trade Marks*, confirming that “*assessing the distinctive character of a surname must be carried out according to the specific circumstances of the case. Clearly it is the case that (like all other types of marks) the presence or absence of distinctive character depends upon the perception of relevant consumers, having regard to the essential origin function of a trade mark.*”

63. The Opponent submits that it is common in the wine and alcoholic beverage industry to use the surname of a producer as a trade mark in relation to wines and alcoholic beverages; it gives the examples of GORDON’s for gin, GRANT’s for whisky and Moët & Chandon for champagne. The Opponent also submits that “*since there is no evidence provided to indicate that the surname GELDERMANN is common in the UK ... the mark must be seen as having a strong distinctive character.*”
64. By contrast, the Applicant submits that the Opponent’s marks “*will be viewed as a surname by the average consumer and therefore will have either a low or normal level of distinctive character in relation to the relevant goods.*”
65. “Geldermann” does not describe or allude to sparkling wines and I find it is inherently distinctive to an average degree. There is no suggestion of enhancement of the mark’s distinctive through use, and clearly there can be no such enhancement since there is no evidence of use on the UK market that could affect the average consumer in this jurisdiction. (For the avoidance of doubt, I find that the stylisation that is present in the figurative rendering of Geldermann under the IR, does not have a material impact sufficient to elevate the degree of inherent distinctiveness of that earlier mark.)

Conclusion as to likelihood of confusion

66. I now turn to make a global assessment as to the likelihood of confusion between the marks if they were used in relation to the goods at issue. 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 (at paragraphs 46 - 47).
67. Earlier in this decision I have found that the relevant goods of the parties – sparkling wines – are identical. The average consumer will be a member of general public who is an adult

(to buy alcohol legally), who will pay a medium or average level of care in selecting and buying sparkling wines and will be influenced in the selection process mainly by the visual presentation of mark – what it looks like – but partly too by how the mark sounds. I have found that the Geldermann mark is visually and aurally similar to the Applicant's mark to a low to medium degree.

68. On the one hand, in my assessment of likelihood of confusion, I take account of the average inherent distinctiveness of the earlier mark, the imperfect picture of the marks in the mind of the average consumer, and the interdependence principle that allows that a lesser degree of similarity between the marks at issue may be offset by a greater degree of similarity between the goods (which here are identical).
69. I note too the points made by Ms Duppel and Mr Hiddleston as to the scarcity of marks containing the stem –LDERMAN registered in the classes mentioned, but I do not find this influential in my decision. The central task before me is to compare the marks at issue in light of the principles from case law and determine whether any similarity between them is such that confusion would be likely if they were used in relation to identical (or similar goods). It would be implausible to suggest that a proprietor may properly have a trade mark monopoly over –LDERMAN, whatever other components may be present in the mark.
70. On the other hand, I note that the 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.”
71. In this case I have found that although both marks will be seen as surnames, they will be seen as different and distinct surnames, especially factoring in case-law principle that the average consumer normally attaches more importance to the first part of words, and my finding that one mark appears English, the other Germanic. The overall impressions of the marks are therefore different and consumers are clearly used to distinguishing between surnames to identify the source of goods, especially in the field of drinks (as the Opponent's own submissions confirm).

72. In my conceptual comparison of the marks, I found that the marks will be conceptually dissimilar to a proportion of the average consumer who may readily perceive that one mark has a meaning in the English language and the other not. I also found that where the average consumer is unaware of an English language meaning of the word “alderman”, the marks would still be conceptually dissimilar as they would be seen as different and distinct surnames. I consider this the most likely impression of the average consumer. As a fall back, I found in the alternative conceptual neutrality.
73. I find it helpful here to note various points arising from the appeal decision of Iain Purvis QC, sitting as the Appointed Person in Case O-049-17⁸, which involved a comparison of the marks Rochester and Dorchester (for cigarettes). Mr Purvis referred to the judgment of the CJEU in *Ruiz-Picasso v OHIM* [C-361/04] which may serve as authority for the principle that “*conceptual differences can in certain circumstances counteract the visual and phonetic similarities between the signs concerned. For there to be such a counteraction, at least one of the signs at issue must have, from the point of view of the relevant public, a clear and specific meaning so that the public is capable of grasping it immediately ...*”⁹
74. In the *Ruiz-Picasso* case the mark involved the word PICASSO, which is inextricably linked in the mind of the average consumer with the famous painter. In the present case, the concept of alderman (as signifying “*a member of a borough or county council*” or even the vague approximation I suggested of some sort of office-holder) has a far lower profile in the consciousness of the average consumer. If it is the case that that concept falls short of having “*a clear and specific meaning so that the public is capable of grasping it immediately*”, I anyway favour the conceptual differences I have found between the marks at issue based on their being distinct and different surnames. By contrast, I understand the Opponent to have submitted that since both marks will be seen as surnames, there is conceptual similarity. In the Rochester appeal decision, Mr Purvis explained:

“42. Before considering the impact of ‘concept’ on the likelihood of confusion, one first has to decide what concept if any each sign conveys to the average consumer. Here

⁸ See in particular paragraphs 38 – 49 of that appeal decision.

⁹ See paragraph 56 of that judgment, where it also cited [Case T-292/01 *Phillips-Van Heusen v OHIM - Pash Textilvertrieb und Einzelhandel (BASS)* [2003] ECR II-4335, paragraph 54].

one must be careful about levels of generality. We are concerned not with theoretical abstractions but how the sign would actually strike the average consumer in real life.

43. In the present case, at a high level of generality, each mark could theoretically be said to convey the same concept – a town, or perhaps a town in Southern England. However, I do not believe that this is a reasonable way to understand the way in which the individual marks would strike the average consumer. The concept of JT’s mark is the town of Dorchester, not any old town in Southern England. It is clear and specific. The concept of the Proprietor’s mark is the town of Rochester. Once again, that is clear and specific and is a different concept from Dorchester. The conceptual difference will tend to reduce any risk of confusion.”

75. While two marks, being surnames, just like marks comprising two town names, could theoretically, at a high level of generality, be said to convey the same concept, I find that that is not a reasonable way to understand the way in which the individual marks would strike the average consumer.
76. I note that in Rochester the Appointed Person found that the Hearing Officer’s decision contained no error of principle in circumstances where the Hearing Officer considered that the conceptual differences between the marks were sufficient to outweigh what he had considered to be the ‘reasonably high’ and ‘medium’ levels of visual and aural similarity between them. The public would be clear that Rochester and Dorchester were different towns and were well used to distinguishing between different towns by their names. In the present case, I have found the visual and aural similarity between the marks at issue to be lower still.
77. Weighing in the balance all of the above factors I find in this case that there is no real likelihood of the average UK consumer, exercising ordinary care, being confused as to the origin of the goods. I find that holds true even on the basis of fall-back finding of conceptual neutrality, based on the overall impressions of marks and the low to medium degree to which the marks are visually and aurally similar.
78. **Consequently, the opposition fails.** Since the IR only renders in figurative form the same word presented plainly in the EUTM, the opposition fails on the basis of that mark too. I also recall that I have not conducted a fair specification analysis, which may have

found the Opponent entitled to rely on a broader list of goods. However, since my substantive finding in this case is based on both parties having the identical “sparkling wine” in their respective specifications, a broader fair specification would not have improved its case.

Costs

- 79. The opposition has failed and the Applicant is entitled to a contribution towards its costs.
- 80. I award the Opponent the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement of grounds and considering the other side’s statement:	£200
Considering the other side's evidence	£500
Total:	£700

- 81. I therefore order Geldermann Privatsektkellerei GmbH to pay Liam Manton the sum of £700 (seven hundred 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 27th day of March 2018

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