

O/249/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003260675

BY BREWDOG PLC

TO REGISTER THE TRADE MARK:

BREWDOG DOGHOUSE

IN CLASSES 40, 41 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 411705 BY

DOGHOUSE DISTILLERY LTD

BACKGROUND AND PLEADINGS

1. On 2 October 2017, BrewDog plc (“the applicant”) applied to register the trade mark **BREWDOG DOGHOUSE** in the UK. The application was published for opposition purposes on 17 November 2017 and is for the following services:

Class 40 Brewing services; distilling services; brewing of beer; beverage canning services; beverage bottling services; rental of machines and apparatus for processing beverages; rental of machines and apparatus for brewing beer; leasing of machines and apparatus for processing beverages; leasing of machines and apparatus for brewing beer; information, advisory and consultancy services relating to all of the aforesaid services.

Class 41 Education and training services; entertainment services; arranging and conducting of training courses; arranging and conducting of educational courses and seminars; preparation of educational courses and examinations; development and production of educational and instructional materials; arranging and conducting competitions; arranging and conducting of demonstrations for entertainment purposes; arranging and conducting of demonstrations for instructional purposes; educational demonstrations; live demonstrations for entertainment and instructional purposes; arranging and conducting beer tasting events for educational and entertainment purposes; arranging and conducting spirits tasting events for educational and entertainment purposes; organisation of entertainment events and activities; organisation of exhibitions; organisation of live shows; presentation of live show performances; presentation of live entertainment events; arranging and conducting live music events; information, advisory and consultancy services relating to all of the aforesaid services.

Class 43 Services for providing food and drink; bar services; restaurant services; restaurant services incorporating licensed bar facilities; serving of

alcoholic beverages; snack-bar services; hotel accommodation services; temporary accommodation services; beer tasting services including the provision of beverages; providing information in the nature of recipes for beverages; information, advisory and consultancy services in connection with all of the aforesaid services.

2. The application was opposed by Doghouse Distillery Ltd (“the opponent”) based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opposition is directed against the applicant’s class 40 and class 43 services only. The opponent relies upon the earlier UK trade mark registration no. 3161406 for the following mark:



3. The opponent’s mark has an application date of 26 April 2016 and a registration date of 5 August 2016. The opponent relies on the following goods and services for which the earlier mark is registered:

Class 32 Beer and non-alcoholic drinks.

Class 33 Alcoholic beverages (except beers); alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.

Class 43 Services for providing food and drink. Pubs and bars.

4. The opponent argues that the respective goods and services are identical or similar and that the marks are similar.

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

6. The applicant is represented by Lawrie IP Limited and the opponent is unrepresented. The opponent filed evidence in chief in the form of the witness statement of Braden Saunders dated 1 September 2018 which was accompanied by submissions in the form of a cover letter dated the same date. Mr Saunders is a Director of the opponent. The applicant filed evidence in the form of the witness statement of Sharon Mackison dated 3 December 2018 which was accompanied by written submissions dated the same date. Ms Mackison is the Trade Mark Attorney acting for the applicant. The opponent filed evidence in reply in the form of the witness statement of Braden Saunders dated 4 February 2019 which was accompanied by written submissions dated the same date. No hearing was requested and neither party filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

Opponent's Evidence in Chief

7. As noted above, the opponent's evidence in chief consists of the witness statement of Braden Saunders with 11 exhibits.

8. Mr Saunders states that the mark actually being used by the applicant is for the word only DOGHOUSE¹. He states that this means that the parties' marks are closely similar. Mr Saunders also states that the applicant's plans to expand into hotel services are closely tied with their existing brewery and distillery operations because the hotel rooms will be in the same building and overlooking the brewery². Mr Saunders has also provided various examples of other brewery businesses which have offered experiences linked with their existing services³.

¹ Exhibit BS1

² Exhibits BS3 and BS4

³ Exhibit BS6 to BS11

9. The opponent's evidence was accompanied by written submissions which I do not propose to reproduce here, but which I have taken into consideration in reaching my decision.

Applicant's Evidence

10. As noted above, the applicant's evidence consists of the witness statement of Sharon Mackison with 3 exhibits.

11. Ms Mackison states that the applicant has used both DOGHOUSE and BREWDOG DOGHOUSE since October 2015. Ms Mackison states that this use pre-dates the opponent's earlier mark. Ms Mackison has produced print outs from the applicant's website dating back to October 2015 announcing the arrival of DOGHOUSE in Glasgow, which was introduced as a new "mega-hub for everything BrewDog"⁴. Ms Mackison has also produced a print out from the applicant's Twitter page (described as "DogHouse Merch City") which shows that the applicant joined Twitter in August 2015 and a print out from TripAdvisor which lists DogHouse Merchant City as a restaurant in Glasgow⁵. Ms Mackison has also provided undated print outs, from what appear to be review websites, which refer to BREWDOG DOGHOUSE⁶.

12. The applicant's evidence was accompanied by written submissions which I do not propose to reproduce here, but which I have taken into consideration in reaching my decision and will refer to below if necessary.

Opponent's Evidence in Reply

13. The opponent's evidence in reply consists of the second witness statement of Mr Saunders with 2 exhibits. Mr Saunders has provided a print out from the applicant's website which details their plans to launch a craft beer hotel⁷.

⁴ Exhibit SM01

⁵ Exhibit SM02

⁶ Exhibit SM03

⁷ Exhibit BS13

14. The opponent's evidence in reply was accompanied by further written submissions that I keep in mind.

15. That concludes my summary of the evidence insofar as I consider it necessary.

PRELIMINARY ISSUES

16. Firstly, the applicant has made reference to their use of the mark applied for which it claims pre-dates the registration of the opponent's mark. The applicant states that this use dates back to October 2015. However, in Tribunal Practice Notice 4/2009 it states:

“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its 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.”

17. As the applicant has not sought to invalidate the opponent's earlier mark, this line of argument is irrelevant to the decision I must make.

18. Secondly, the opponent has claimed that the applicant has used the word BREWDOG alone, rather than the mark as applied for. However, there is no requirement for the applicant to demonstrate use of its applied for mark in order to obtain registration. The applicant has applied for the mark BREWDOG DOGHOUSE and it is this mark which is relevant for the purpose of the comparison I must undertake.

DECISION

19. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(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.”

20. 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.”

21. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services it has identified.

Section 5(2)(b) – case law

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

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

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

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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 will 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 and services

23. The competing goods and services are as follows:

Opponent's goods and services	Applicant's services
<p data-bbox="193 246 794 291"><u>Class 32</u></p> <p data-bbox="193 302 794 347">Beer and non-alcoholic drinks.</p> <p data-bbox="193 414 794 459"><u>Class 33</u></p> <p data-bbox="193 470 794 616">Alcoholic beverages (except beers); alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails.</p> <p data-bbox="193 683 794 728"><u>Class 43</u></p> <p data-bbox="193 739 794 840">Services for providing food and drink. Pubs and bars.</p>	<p data-bbox="798 246 1399 291"><u>Class 40</u></p> <p data-bbox="798 302 1399 952">Brewing services; distilling services; brewing of beer; beverage canning services; beverage bottling services; rental of machines and apparatus for processing beverages; rental of machines and apparatus for brewing beer; leasing of machines and apparatus for processing beverages; leasing of machines and apparatus for brewing beer; information, advisory and consultancy services relating to all of the aforesaid services.</p> <p data-bbox="798 1019 1399 1064"><u>Class 43</u></p> <p data-bbox="798 1075 1399 1785">Services for providing food and drink; bar services; restaurant services; restaurant services incorporating licensed bar facilities; serving of alcoholic beverages; snack-bar services; hotel accommodation services; temporary accommodation services; beer tasting services including the provision of beverages; providing information in the nature of recipes for beverages; information, advisory and consultancy services in connection with all of the aforesaid services.</p>

24. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the

Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services 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.”

25. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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.

26. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of ‘dessert sauce’ did not include jam, or because the ordinary and natural description of jam was not ‘a dessert sauce’. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

27. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

28. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as the then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 *Institut for Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

30. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“... there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think the responsibility for those goods lies with the same undertaking.”

31. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted, as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense – but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“... it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

32. I have submissions from both parties on the similarity of the goods and services and, whilst I do not propose to reproduce those here, I have taken them into account in reaching my decision. However, I note that the parties have both made reference to the actual goods and services that the parties provide (or intend to provide). The applicant's evidence refers to the close connection between the hotel and brewery operated by the opponent, presumably with the intention of demonstrating similarity between the services. For the avoidance of doubt, I must make my decision based upon the goods and services for which the marks are registered/applied for. This is a notional assessment and differences or similarities arising from the actual services that the parties provide or intend to provide are not relevant, unless they are apparent from the specifications of the marks in issue.

Class 40

33. "Brewing services" and "brewing of beer" in the applicant's specification describe the process of producing beer (or similar beverages). These are essential for the end product "beer" in the opponent's specification. It is common for businesses that produce beer to sell it themselves and there will, therefore, be overlap in trade channels. The users will overlap. The nature of the goods and services are clearly different. They are complementary in that one is indispensable for the other. The same applies to "distilling services" in the applicant's specification and "spirits and liqueurs" in the opponent's specification. I consider these goods and services to be highly similar.

34. "Beverage canning services" and "beverage bottling services" in the applicant's specification are more likely to be services which are used by beverage producers. That is, distilleries and breweries may outsource the bottling of their beverages to third parties. Whilst I accept that this may also be done in house, breweries that bottle their own beverages cannot be said to be providing these services. The trade channels and users of the goods and services will, therefore, differ. The uses and nature of the goods and services are clearly different. The goods and services are neither complimentary nor competitive. I consider these services to be dissimilar to all of the opponent's goods and services. If I am wrong, then they will be similar to only a low degree. I can

see no further point of similarity between these services and the opponent's goods and services which would put the opponent in a stronger position.

35. "Rental of machines and apparatus for processing beverages", "rental of machines and apparatus for brewing beer", "leasing of machines and apparatus for processing beverages" and "leasing of machines and apparatus for brewing beer" in the applicant's specification are all services which are most likely to be provided to businesses which produce these beverages, although I recognise that they may also be provided to individuals who undertake home-brewing. Whilst I recognise that there will be some overlap in users on a superficial level (in that both the goods and services may be provided by to the general public), the services are more likely to be sold to beverage producers. There is, therefore, only a limited overlap in user. The beverages in the opponent's specification will be sold through public houses, bars, restaurants and retail outlets, whereas these services in the applicant's specification will be sold through specialist hire companies. They will not be sold through the same trade channels. The nature and uses of these services are clearly different to the opponent's goods and services. These goods and services are neither complementary nor competitive. I consider these goods and services to be dissimilar. If I am wrong in this finding, then they will be similar to only a low degree. I can see no further point of similarity between these services and the opponent's goods and services which would put the opponent in a stronger position.

36. "Information, advisory and consultancy services relating to all of the aforesaid services" in the applicant's specification will cover a broad range of services. The "advisory and consultancy services" are likely to be provided to breweries and distilleries themselves. "Information...services" are likely to be provided to breweries and distilleries. However, they may also be provided to members of the general public via pubs and bars (such as at special informative events or tasting activities). I therefore consider that there will be an overlap in users and trade channels in respect of the applicant's information services, but not in respect of its advisory and consultancy services, with "pubs and bars" in the opponent's specification. The nature and uses of all of the services will clearly differ. They are neither complementary nor competitive. Overall, I consider there to be a medium degree of similarity between "information services relating to all of the aforesaid services" in the applicant's

specification and “pubs and bars” in the opponent’s specification. I do not consider there to be any similarity between “advisory and consultancy services relating to all of the aforesaid services” in the applicant’s specification and “pubs and bars” in the opponent’s specification. If I am wrong in this finding then they will be similar to only a low degree. I can see no further point of similarity which would put the opponent in a better position.

Class 43

37. The applicant accepts that “services for providing food and drink”, “bar services”, “restaurant services”, “restaurant services incorporating licensed bar facilities”, “serving of alcoholic beverages” and “snack-bar services” in its specification are identical to the opponent’s goods and services. I agree with the applicant and consider these services are identical to “services for providing food and drink” and “pubs and bars” in the opponent’s specification.

38. “Hotel accommodation services” and “temporary accommodation services” in the applicant’s specification will share the same user on a superficial level with “services for providing food and drink” and “pubs and bars” in the opponent’s specification as they will all be used by members of the general public. The trade channels may overlap as it is not uncommon for hotel services and pub or restaurant services to be provided through the same outlets. For example, pubs often offer rooms and hotels will often have bars or restaurant facilities available for their customers. However, the use of these services is different as the applicant’s services are intended to provide somewhere for the consumer to stay for a short period of time whereas the opponent’s services are intended to provide food and drink to the consumer. The services are neither complementary nor competitive. I consider these services to be similar to a medium degree.

39. “Beer tasting services including the provision of beverages” in the applicant’s specification, in my view, fall within the broader categories of “services for providing food and drink” and “pubs and bars” in the opponent’s specification. Such services can, therefore, be considered identical on the principle outlined in *Merix*. If I am wrong,

then they will overlap in user, uses, method of use and trade channels and will be highly similar.

40. “Providing information in the nature of recipes for beverages” in the applicant’s specification is a service which may be provided at specialist events which might take place in pubs or bars. There may, therefore, be an overlap in trade channels with “pubs and bars” in the opponent’s specification. There may also be an overlap in user. The nature of the services is different with one involving the provision of drinks and the other involving the provision of information. For the same reason, the use of the services will be different. I do not consider them to be either competitive or complimentary. In my view, these services are similar to a medium degree.

41. That leaves “information, advisory and consultancy services in connection with all of the aforesaid services” in the applicant’s specification. Again, I consider that advisory and consultancy services are more likely to be provided to businesses than to members of the general public, whereas the goods and services in the opponent’s specification are more likely to be provided to members of the general public. The goods and services will, therefore, differ in user. I recognise that information about such services may be provided to the general public, but it will be provided through specialist businesses (such as restaurant and hotel guides). Whilst there may, therefore, be an overlap in user on a superficial level, the services will differ in trade channels. The nature and uses of the services are clearly different. I can, therefore, see no point of similarity between “information, advisory and consultancy services in connection with all of the aforesaid services” in the applicant’s specification and the opponent’s goods and services.

42. As some degree of similarity between the goods and services is required for there to be a likelihood of confusion⁸, the opposition must fail in respect of the following services in the applicant’s specification:

Class 40 Beverage canning services; beverage bottling services; rental of machines and apparatus for processing beverages; rental of machines

⁸ *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

and apparatus for brewing beer; leasing of machines and apparatus for processing beverages; leasing of machines and apparatus for brewing beer; advisory and consultancy services relating to all of the aforesaid services.

Class 43 Information, advisory and consultancy services in connection with all of the aforesaid services.

The average consumer and the nature of the purchasing act

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

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

44. I have no submissions from either party on the average consumer or the purchasing process for the goods and services in issue. The average consumer for the opponent's goods will be members of the general public, over the age of 18. I recognise that there will be some goods that fall within these broader categories that are particularly expensive and that will be purchased by connoisseurs of such products. However, that is not the average transaction upon which my assessment must focus. In any event, a variety of factors will be taken into consideration during the purchasing process such as flavour, alcohol content and quality. Overall, I consider

that an average degree of attention will be paid during the purchasing process for the goods.

45. The average consumer for the parties' services will be either members of the general public or business users. The frequency of purchase of the services in issue will vary (from snack bar services which are likely to be purchased fairly frequently to beer tasting services which are likely to be purchased infrequently). The cost of the services is also likely to vary significantly. Various factors will be taken into consideration during the purchasing process for all of the services such as price, quality and suitability. Consequently, I consider that the level of attention paid by the average consumer during the purchasing process will be at least average.

46. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. I acknowledge that verbal advice may be sought from a sales assistant or representative. Alternatively, the goods may be purchased in bars or restaurants. However, even in these circumstances, orders are likely to be placed following perusal of a drinks/wine list or perusal of the products themselves on a shelf behind a bar. Consequently, visual considerations will dominate the selection process, although I do not discount that there will also be an aural component to the purchase of the goods.

47. The services are likely to be purchased from specialist retail or food and drink outlets or their online equivalents. The purchasing process for the services is likely to be dominated by visual considerations, as the average consumer is likely to select the services at issue following inspection of the premises' frontage on the high street, on websites and in advertisements (such as flyers, posters or online adverts). However, given that word-of-mouth recommendations may also play a part, I do not discount that there will be an aural component to the selection of the services.

Comparison of the trade marks

48. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and

conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated, at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

49. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

50. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
	BREWDOG DOGHOUSE

51. I have lengthy submissions from the parties on the similarity of the marks and, whilst I do not propose to reproduce those here, I have taken them into consideration in reaching my decision.

52. The opponent's mark consists of the word DOGHOUSE presented in a stylised font beneath a large device of a dog's head. The wording is smaller than the device element, although the eye is naturally drawn to the element of the mark that can be read. I consider that these elements play an equal role in the overall impression of the mark. The applicant's mark consists of the words BREWDOG DOGHOUSE. There are no other elements to contribute to the overall impression which lie in the words themselves. The words do not have any particular meaning when used in combination so will not be viewed as a unit. I consider that they play an equal role in the overall impression.

53. Visually, the marks coincide in the presence of the word DOGHOUSE in each. They differ in the presence of the word BREWDOG in the applicant's mark which has no counterpart in the opponent's mark and the presence of the dog head device in the opponent's mark which has no counterpart in the applicant's mark. I consider the marks to be visually similar to no more than a medium degree.

54. Aurally, the word DOGHOUSE in each of the marks will be pronounced identically in the same way as the two ordinary English words DOG and HOUSE. The dog head device in the opponent's mark will not be pronounced by the consumer. The point of aural difference between the marks is, therefore, the presence of the word BREWDOG in the applicant's mark which has no counterpart in the opponent's mark. I consider the marks to be aurally similar to a medium degree.

55. Conceptually, the word DOGHOUSE will have the same meaning in both marks. I agree with the applicant that the word may be seen as a reference to a kennel for a dog, but I also accept that opponent's submission that it may be seen as a reference to the saying "being in the doghouse". The word BREWDOG in the applicant's mark is an invented word made up of two ordinary English words which, when combined, have no particular sensible meaning. However, the presence of the word BREW in the mark may allude to the services being related to beer and/or other similar beverages. The image of the dog head device in the opponent's mark will convey the image of a dog which reinforces the word DOGHOUSE. I consider the marks to be conceptually similar to a medium to high degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

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

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

58. As the opponent has not pleaded that its mark has acquired enhanced distinctive character through use, I have only the inherent position to consider. I have no submissions from either party on the inherent distinctive character of the earlier mark.

59. I must make an assessment of the inherent distinctive character of the earlier mark as a whole. As noted above, the word DOGHOUSE will be seen as a reference to a kennel for a dog or to the saying “being in the doghouse”. This is neither allusive nor descriptive of the goods and services for which the mark is registered. I consider this word to be inherently distinctive to a higher than average degree. The image of the dog’s head in the opponent’s mark adds to its distinctive character as it acts as a further conceptual hook in the mind of the consumer.

Likelihood of confusion

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

61. I have found the parties marks to be visually similar to no more than a medium degree, aurally similar to a medium degree and conceptually similar to a medium to high degree. I have identified the average consumer to be a member of the general public or a business user who will select the goods and services primarily by visual means (although I do not discount an aural component). I have concluded that the average consumer will pay at least an average degree of attention when selecting the goods and services. I have found the parties goods and services to range from similar to a low degree to identical (except for those in respect of which I have found no

similarity). I have found the opponent's mark to have a higher than average degree of inherent distinctive character.

62. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient visual differences between the marks to avoid them being mistakenly recalled as each other. I do not consider that the presence of the dog head device in the opponent's mark and the presence of the word BREWDOG in the applicant's mark will be forgotten by the average consumer. I am satisfied that there is no likelihood of direct confusion.

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

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

64. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an

earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

65. I also bear in mind the decision of the GC in *Anncò, Inc. v OHIM*, Case T-385/09, in which it considered an appeal against OHIM’s decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public’s level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue.”

66. I have found that the words in the applicant’s mark will not be viewed as a unit and that the word DOGHOUSE has distinctive character which is independent of the significance of the whole. DOGHOUSE is the only word element of the opponent’s mark and I have found that it has a higher than average degree of distinctive character on its own which is further enhanced by the presence of the dog head device. Bearing in mind all of my findings summarised at paragraph 61 above, I consider that the presence of the word DOGHOUSE in both marks will lead the average consumer to conclude that the parties’ marks indicate goods and services sold by the same or

economically linked undertakings. I consider there is a likelihood of indirect confusion in respect of those goods and services which I have found to be identical or similar to the opponent's goods and services, but not those goods and services which are similar to only a low degree.

CONCLUSION

67. The opposition has succeeded in relation to the following services, for which the application is refused:

Class 40 Brewing services; distilling services; brewing of beer; information services relating to all of the aforesaid services.

Class 43 Services for providing food and drink; bar services; restaurant services; restaurant services incorporating licensed bar facilities; serving of alcoholic beverages; snack-bar services; hotel accommodation services; temporary accommodation services; beer tasting services including the provision of beverages; providing information in the nature of recipes for beverages; information services relating to all of the aforesaid services.

68. The application will proceed to registration in respect of the following services only (and includes those services not subject to this opposition):

Class 40 Beverage canning services; beverage bottling services; rental of machines and apparatus for processing beverages; rental of machines and apparatus for brewing beer; leasing of machines and apparatus for processing beverages; leasing of machines and apparatus for brewing beer; advisory and consultancy services relating to all of the aforesaid services.

Class 41 Education and training services; entertainment services; arranging and conducting of training courses; arranging and conducting of educational courses and seminars; preparation of educational courses and examinations; development and production of educational and

instructional materials; arranging and conducting competitions; arranging and conducting of demonstrations for entertainment purposes; arranging and conducting of demonstrations for instructional purposes; educational demonstrations; live demonstrations for entertainment and instructional purposes; arranging and conducting beer tasting events for educational and entertainment purposes; arranging and conducting spirits tasting events for educational and entertainment purposes; organisation of entertainment events and activities; organisation of exhibitions; organisation of live shows; presentation of live show performances; presentation of live entertainment events; arranging and conducting live music events; information, advisory and consultancy services relating to all of the aforesaid services.

Class 43 Advisory and consultancy services in connection with services for providing food and drink, bar services, restaurant services, restaurant services incorporating licensed bar facilities, serving of alcoholic beverages, snack-bar services, hotel accommodation services, temporary accommodation services, beer tasting services including the provision of beverages, providing information in the nature of recipes for beverages.

COSTS

69. The opposition has succeeded in relation to 15 terms in the applicant's specification but failed in respect of 8. As the opponent has achieved the greater degree of success it is entitled to a contribution towards its costs. However, I have taken the fact that the opponent has only succeeded in part into account when deciding the amount to be awarded. The opponent is unrepresented and has submitted a costs proforma outlining the number of hours spent on these proceedings.

70. I consider that the time claimed by the opponent for considering forms filed by the applicant, preparing evidence and further evidence, and reviewing the applicant's evidence to be high. Whilst both sides filed evidence, each witness statement was no more than a page in length and the accompanying exhibits were not lengthy.

71. I consider a cost award for the following number of hours to be reasonable:

- Completing the Notice of Opposition	2 hours
- Considering forms filed by the applicant	1 hour
- Preparing evidence in chief	4 hours
- Reviewing the applicant's evidence	3 hours
- Preparing evidence in reply	2 hours
Total	12 hours

72. The opponent is also entitled to the official fee for filing the Notice of Opposition in the sum of £100.

73. In relation to the hours expended, I note that The Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 per hour. I see no reason to award anything other than this. I award the opponent the sum of £228 (12 hours at £19 per hour) plus the official fee of £100, totalling £328.

74. I therefore order BrewDog plc to pay Doghouse Distillery Ltd the sum of £328. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 13 May 2019

S WILSON

For the Registrar