

O-291-17

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF TRADE MARK APPLICATIONS 3137808 & 3156663

BY BREWDOG PLC

TO REGISTER THE FOLLOWING TRADE MARKS IN CLASS 32:

ELVIS JUICE

&

BREWDOG ELVIS JUICE

AND

OPPOSITIONS THERETO (NO. 406353 & 406730) BY ABG EPE IP LLC

Background and pleadings

1. This dispute concerns whether the following trade marks should be registered:

- a) Trade mark 3137808 for the mark **ELVIS JUICE** which was filed on 25 November 2015 in respect of:

Class 32: Beer; Ale.

- b) Trade mark 3156663 for the mark **BREWDOG ELVIS JUICE** which was filed on 25 March 2016 in respect of:

Class 32: Beer and brewery products; craft beer; lager, stout, ale, pale ale, porter, pilsner, bock, saison, wheat beer, malt beer, non-alcoholic beer, low-alcohol beer, flavoured beers; processed hops for use in making beer; malt wort; non-alcoholic malt beverages; non-alcoholic beverages; syrups and other preparations for making beverages; malt syrup for beverages; extracts of hops for beer making, processed hops for beer making

2. The marks were filed by Brewdog Plc (“the applicant”) and, following acceptance by the IPO, they were published for opposition purposes on 5 February and 15 April 2016 respectively.

3. ABG EPE IP LLC (“the opponent”) opposes the registration of the marks under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Grounds initially pleaded under section 5(3) of the Act were withdrawn by the opponent. The opponent relies on the following two earlier marks:

- a) European Union Trade Mark (“EUTM”) registration 13468566 for the mark **Elvis** which was filed on 18 November 2014 and registered on 29 July 2015. Although its specification is wider, the opponent relies only on the following goods and services covered by its mark:

Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

Class 35: Wholesale stores, retail stores, online retail stores and mail order catalog service in the field of novelty items; wholesale stores, retail stores, online retail stores and mail order catalog services in the field of gift and souvenir items, namely beers, mineral and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, syrups and other preparations for making beverages...

Given its date of registration, the mark is not subject to the use conditions set out in section 6A of the Act and may, therefore, be relied upon for all of the goods and services set out.

- i) EUTM registration 13468541 for the mark **Elvis Presley** which was filed and registered on the same dates as the above earlier mark and for which the same goods and services are relied upon. Like the above earlier mark, the use conditions are not applicable.

4. There is little in the opponent's statement of case beyond the claim that the respective marks are similar, that the goods/services are identical/similar/complementary, such that there exists a likelihood of confusion.

5. The applicant filed a counterstatement denying the claims. The applicant states that it employs a variety of highly distinctive product names. It states that the marks are not confusingly similar due to there being distinct visual, aural and conceptual differences. It is conceded that some/all of the goods in class 32 (depending on which application is being considered) are identical but that the actual goods provided by the parties are very different.

6. The applicant filed evidence together with written submissions, the opponent filed written submissions only. A hearing took place before me on 7 June 2017 at which the opponent was represented by Mr Michael Hicks, of Counsel, instructed by Potter

Clarkson LLP; the applicant was represented by Ms Amanda Michaels, also of Counsel, instructed by Lawrie IP Limited. At the hearing, Mr Hicks accepted that the opponent's case was not improved by relying on its **Elvis Presley** mark. This is a sensible approach. I will, therefore, focus principally on the **Elvis** earlier mark.

The evidence

7. As I have said, the opponent filed no evidence, just a set of written submissions (and also reply submissions). I bear these submissions in mind, but I will not summarise them here beyond noting, for reasons that will become apparent, that the opponent considers the word JUICE to be generic (or at least descriptive/non-distinctive) because:

“The word “juice” is defined as “the liquid obtained from or present in fruit or vegetables”, and also refers to “a drink made from such a liquid” and specifically references “alcoholic drink””

8. For the applicant, evidence was filed by Mr Neil Simpson, its finance director. His evidence deals, essentially, with two aspects: first, the use (and distinctiveness) of the word BREWDOG, second, the use which has been made of ELVIS JUICE.

9. In relation to BREWDOG, I note the following evidence:

- Mr Simpson states that BREWDOG (and “a number of other highly distinctive marks”) has been used since 2007 in relation to beer, lager, ale (and similar products) as well as bar and restaurant services.
- Promotion is by way of unconventional methods and word of mouth with a “significant presence” on social media. It has 200k followers on Facebook, 100k on Twitter and 133k on Instagram. These numbers do not include the individual profiles of BREWDOG bars and employees.
- Exhibit NSO1 contains prints from social media websites. In each case the primary mark used on the profile (and on any beers depicted) is BREWDOG.

The depicted beers each have a sub-brand, names of which include: EQUINOX, VAGABOND, CHILLI HAMMER, NANNY STATE, DOG E and COCOA PHYSCO. The name BREWDOG also appears to signify the brewery responsible for the beer.

10. In relation to ELVIS JUICE, I note the following evidence:

- The mark has been used since July 2015.
- Exhibit NS02 contains a Google search report for ELVIS JUICE which Mr Simpson states shows that the first 20 pages of hits relate exclusively to the applicant.
- Since July 2015 415k litres have been sold with 22k of bottles and 29k of cans sold online. There has also been “significant sales in bars, restaurants and supermarkets. I assume such evidence is “to date” – the date of Mr Simpson’s witness statement is 6 January 2017.
- Turnover for the sale of ELVIS JUICE in the UK was just over 44k in 2015 and £1.9 million in 2016.
- On the website RateBeer there are 488 reviews of ELVIS JUICE. There are 38 reviews on Beer Hawk and 19 on Beer Advocate. A selection of the reviews are provided in Exhibit NS03, all are from 2016.
- Mr Simpson considers his evidence to show that ELVIS JUICE has been continuously used since July 2015, that it is recognised in the industry as indicating the origin of the product provided by the applicant, and that it enjoys a reputation.

11. Evidence was also filed by Mr Richard Street, “Legal and Property Projects” at the applicant company. He states that the applicant is a well-known craft brewer and industry leader and that its rapid growth and reputation has been well documented in the press. Exhibit RS1 contains a number of articles from before the relevant date, a

number of which are from well-known newspapers such as The Telegraph, The Guardian and the Evening Standard. Other examples include industry publications such as the Caterer. I think it reasonably clear that the applicant is a fast growing and successful independent brewing company. The rapid growth is further exemplified by information in Exhibit RS2 from the “about us” part of the applicant’s website which highlights that the business has grown from having, in 2007, 2 employees and shareholders, brewing 1k hl of beer to, by 2015, having 540 employees and 32k shareholders, brewing 134k hl of beer. Mr Street states that its customers are its fans and that the products have a cult following. He adds that the business now has over 50k shareholders who buy into “our anti-big business ethos”.

12. Exhibit RS3 contains information from the Sunday Times Fast Track 100 league table, its position in the table was 29th (2012), 38th (2013), 40th (2014), 35th (2015) and 64th (2016).

13. Mr Street states that the applicant has a unique approach to branding and marketing and that it is a leader and not a follower. He states that it has no need to ride on the coat tails of others and, indeed, it has been the subject of copycats. Exhibit RS04 contains a press release on a blog on the applicant’s website about a copycat bar in China. He states that the applicant has no desire to be associated with other brands.

14. Mr Street states that the business has won a number of awards over the years, supporting evidence is provided in Exhibit RS05. He states that this culminated in the two founders of the business being awarded MBEs. Although this was after the relevant date, Mr Street states that this still shows the recognition enjoyed by the brand.

15. In response to a submission from the opponent that BREWDOG is “somewhat non-distinctive”, Exhibit RS06 contains product branding for ELVIS JUICE showing BREWDOG as a distinctive element.

16. The final exhibit, RS07, contains a number of ratings from the mobile app Untapped which contains 32k ratings for ELVIS JUICE. He also adds that none of the

reviews indicate any confusion as to the origin of the beer or any association with the opponent.

17. As stated earlier, the applicant's evidence was accompanied by a set of written submissions which I bear in mind, but will not summarise here.

Section 5(2)(b)

18. Section 5(2)(b) of the Act states that:

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

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

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

19. The following principles are gleaned from the judgments 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 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 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/services

20. In its counterstatement the applicant accepted that some/all of its goods were identical to the opponent's goods in class 32. At the hearing Ms Michaels accepted that there was an overlap but that not everything was necessarily identical (although they were still similar). In my view, I consider that all the goods are identical on the basis of what is often referred to as the inclusion principle. In the decision of the General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ("*Meric*") it was stated:

"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 fur 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".

21. The opponent's earlier mark covers:

Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

22. The following applied for goods are identical to the term "beer" on the inclusion principle because they are all types of beer:

Beer; Ale [covered by both of the applicant's mark] craft beer; lager, stout, pale ale, porter, pilsner, bock, saison, wheat beer, malt beer, non-alcoholic beer, low-alcohol beer, flavoured beers

23. Similarly, the following goods are identical to “other non-alcoholic beverages”:

non-alcoholic malt beverages; non-alcoholic beverages

24. The following goods are identical to “syrups and other preparations for making beverages” [with most being identical to the “other preparations” as opposed to the “syrups”]:

processed hops for use in making beer; malt wort; syrups and other preparations for making beverages; malt syrup for beverages; extracts of hops for beer making, processed hops for beer making

25. I should add that there was a brief discussion at the hearing about wort, which, although it is something extracted from the mashing stage of brewing, I am satisfied is still used in the production of beer and is still, therefore, a preparation for making beverages [specifically beer].

26. The only term I have yet to comment on is: brewery products. Being in class 32 means that the only brewery products applicable can be in the nature of goods that fall in this class. To that extent, I am content that the term is broad enough to cover beer itself (a product produced by a brewery) and, also, preparations (in class 32) that are used in the brewery process. As such, I consider this term to be identical to both “beer” and “.. other preparations for making beverages”.

27. There are two further points to make in relation to the comparison:

- i) When accepting that some/all of the goods were identical in its counterstatement, the applicant went on to say that the actual goods of the parties were different. This is not a pertinent point. It is a notional assessment that must be made based upon the goods for which the respective marks are filed/registered.
- ii) The opponent also relies on its services in class 35, however, I do not intend to make a formal comparison on this basis. This is because if the opponent

does not succeed in relation to identical goods, it is not likely to succeed where the goods/services are only similar.

Average consumer and the purchasing act

28. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 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.”

29. This was another area where there was little between respective counsel.

30. In relation to beer, the average consumer will be an adult member of the general public. In relation to the level of care and consideration likely to be deployed by such a person, Ms Michaels pitched this as average, whereas Mr Hicks pitched it as low to moderate, but not high. In support, Mr Hicks referred to the comment of Lord MacNaughten in *Thomas Montgomery v Thompson and others* [1891] A.C. 217 that “Thirsty folk want beer not explanations”, although, Ms Michaels said that some people pay much more attention to the purchase of beer than that. I think that in this day and age more care will be deployed in the selection of beer than in times gone by (particularly in comparison to the time of Lord MacNaughten). They will be interested in the type of beer, its alcohol content etc. However, notwithstanding this, the selection process is not highly considered. An average level of care and consideration will be

deployed. Beer is often sold in supermarkets, off-licences or online, where the mode of selection will be primarily visual, but it also sold in licensed premises such as pubs and restaurants where it will be ordered verbally, but in circumstances where trade marks may still be visible on the pumps on the bar or in bottles etc. behind it. In *Simonds Farsons Cisk plc v OHIM* Case T-3/04 it was stated:

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

59 Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves [...]”

31. In relation to the various preparations listed in the application, counsel were agreed that there were, potentially, two average consumers. First, there would be a commercial buyer of preparations to make beer in a commercial setting, second, there would be home brewers (adult members of the general public). Both counsel also appeared to agree that the level of care and consideration would likely be higher than that used when selecting the finished product, although Mr Hicks submitted that the commercial buyer would likely pay more attention than a home brewer. I do not disagree with any of this. However, what I would say is that in none of these scenarios would the purchase represent a highly considered selection process. Thus, the selection process by home brewers may be marginally more considered than the average level than would be deployed for beer, and marginally more again for commercial brewers, but in neither case is this significantly greater than average.

These goods are not ones purchased in licensed premises and are most likely to be sold in either general shops (such as supermarkets) or specialist websites. This suggests that the selection is a visual one, although, I will not ignore the aural impact of the marks completely. In respect of non-alcoholic beverages, I think much the same analysis as per the beer assessment is applicable, albeit the average consumer is not limited to adult members of the public.

Distinctiveness of the earlier mark

32. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). 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-0000, 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).”

33. No evidence of the opponent's use (if any) has been filed, therefore, I have only its inherent qualities to consider. This is an area where respective counsel took quite different stances. Ms Michaels submitted that whilst the applicant must accept that the earlier mark is entitled to a minimum degree of distinctive character¹, it was no more distinctive than that. She referred to the comments of Robert Walker LJ in *Elvis Presley Trade Marks* [1999] RPC 567 about the low distinctiveness of ELVIS/ELVIS PRESELY marks which is best encapsulated in the following quotation:

“In my judgment the Judge was right to conclude that the ELVIS mark has very little inherent distinctiveness. That conclusion was reached by a number of intermediate steps, one of which was the Judge's finding that members of the public purchase Elvis Presley merchandise not because it comes from a particular source, but because it carries the name or image of Elvis Presley. Indeed the Judge came close to finding (although he did not in terms find) that for goods of the sort advertised by Elvisly Yours (or by Enterprises in the United States) the commemoration of the late Elvis Presley *is* the product, and the article on which his name or image appears (whether a poster, a pennant, a mug or a piece of soap) is little more than a vehicle. I consider that the Judge was right to treat all these goods as memorabilia or mementoes, and not to treat some as being in a different class of consumable commercial goods. (On any view, of course, these categories cut across the statutory classes of goods.) Given that conclusion, and given that the *Tarzan* decision was binding on him (as it is on this court) the Judge's final conclusion as to very low inherent distinctiveness followed almost inevitably, and factual distinctiveness is no longer asserted.

34. Mr Hicks submitted that **Elvis** was highly distinctive for the goods of the earlier mark. He questioned the degree to which the name was now known (as referring to Elvis Presley) but, in any event, he drew a sharp distinction between the goods at issue in the above decision (soaps etc) and the goods of the earlier mark here with the latter not being classed as memorabilia of any sort. He also argued that **Elvis** was

¹ As per *Formula One Licensing BV v OHIM* – Case C-196/11P

fanciful for the goods at issue and that it was wholly distinctive as per the guidance in the *Nicholls* case.

35. I can deal with Mr Hicks' point about the degree of knowledge of Elvis Presley fairly quickly. Put simply, and notwithstanding that Mr Presley died nearly 40 years ago, he was/is such an iconic figure, that I would be very surprised if many people (including those at the younger end of the average consumer age spectrum) had not heard of him. There may be some exceptions, but this is likely to be few and far between. The mark is, though, Elvis not Elvis Presley. However, on the basis that Elvis is a relatively uncommon name, and given that Mr Presley is the most famous of Elvises, I consider that most average consumers, on seeing the name Elvis alone, are likely to conceptualise that on the basis of Elvis Presley.

36. In terms of Mr Hicks' other points, I agree with him that there is something of a distinction between goods such as soap, and goods such as those of the earlier mark, in terms of impacting on the capacity of the mark to be used in a commemorative manner (or some other way which may lessen the distinctive character of the mark). There is no evidence showing that it is a usual practice in this field to use commemorative type marks. That being said, I do not consider that the earlier mark automatically becomes a highly distinctive mark either. My view is that the earlier **Elvis** mark is possessed of an average level of inherent distinctive character.

Comparison of marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The 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.”

38. 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. The marks to be compared are:

ELVIS JUICE v Elvis

BREWDOG ELVIS JUICE v Elvis

39. I will firstly comment on the overall impressions of the marks. The earlier mark is straightforward because it consists of a single word, Elvis, which, accordingly, comprises the sole aspect of its overall impression. In relation to ELVIS JUICE, this comprises two words, neither of which is more visually prominent than the other, other than, in this case, the fairly superficial point that ELVIS is the first word in the mark. Mr Hicks submitted that more focus would be placed on ELVIS because the word JUICE lacks distinctiveness. I will, therefore, deal with the meaning and impact that the word JUICE is likely to have on the average consumer at this juncture.

40. I noted earlier that the opponent stated in its statement of case that the word JUICE was generic, not just in relation to goods such as fruit juices, but also on the basis that one of its meanings related to alcoholic beverages. Shortly before the hearing Mr Hicks submitted a number of dictionary definitions for the word JUICE, with meanings ranging from the very obvious liquid obtained from fruit and vegetables, to more oblique definitions relating to creative juices, a juicy case or story, or juice as in power (in the sense of a car running out of juice). Although Mr Hicks did not pursue any line of argument based upon juice meaning an alcoholic beverage, his overall submission was that the word JUICE in the context of ELVIS JUICE would be seen as

a descriptive reference to the goods in the sense of a liquid with some form of power or nice new taste.

41. Ms Michaels had a number of concerns with Mr Hicks' approach. She did not accept that it was open to him to provide dictionary definitions this late in the day and that this material ought to have been filed as evidence. She also stressed that regardless of what the dictionary definitions say, the word still had to be assessed in context, namely what the average consumer will appreciate of the word when used as part of the mark (as opposed to its use in isolation) on the goods for which the mark is applied for. Ms Michaels referred to the decision of Mr Iain Purvis QC (sitting as the Appointed Person) in the *Harlequin Shellac* case (BL O-500-14) where at paragraph 27 he stated (in relation to the dictionary point):

“Thirdly, I am concerned by the Hearing Officer’s use of dictionaries at all in the present case. In many cases, where it is self-evident that a word is in common use and bears a particular meaning, the Hearing Officer may take “judicial notice” of its meaning without extrinsic evidence. This does not require the use of dictionaries, although I see no problem if a Hearing Officer wishes to use them simply to provide a precise definition of a word whose general sense and meaning is not in dispute.

and at paragraph 25 (in relation to the average consumer point)

“....Her analysis therefore missed out the step which was vital to a finding that the term was not a distinctive element within either mark, namely whether it would be recognised in its descriptive sense by the average consumer. If it would not, then the mere fact that it appeared in dictionaries was entirely irrelevant.”

42. Ms Michaels' overall submission was that ELVIS JUICE did not create any phrase where JUICE lacked distinctiveness. Her submission was that the average consumer would just see it as a fanciful combination of words – as a funny/quirky name.

43. It is clearly correct that the use of the word JUICE must be considered in context. The question is what impact will it have on the average consumer when ELVIS JUICE is used on the applied for goods. I consider there to be little merit in getting hung-up on whether Mr Hicks was right or wrong to send the dictionary definitions to the tribunal. What matters is the meaning, in context, that can be fairly taken on the basis of judicial notice. In my view ELVIS JUICE alludes to the liquid contained in the receptacle of sale which is named after Elvis. The allusion (to the liquid) is, though, mild because it is not usual, as Ms Michaels submitted, to refer to beer (or the other goods) as juice. I do not accept the power based additional meaning put forward by Mr Hicks. In terms of the overall impression of ELVIS JUICE, I consider that the average consumer will regard the two words in the mark as a unit, which hang together in the way I have just suggested. Neither word visually nor aurally dominates the other, but it likely that the mild allusion of the word JUICE (to the liquid) means that the word ELVIS may play a greater role as a point of recall than JUICE.

44. In terms of the overall impression of BREWDOG ELVIS JUICE, similar considerations apply. Notwithstanding the possibility that the mark may be seen as a single unit, juice (the liquid) named BREWDOG ELVIS, or even as three independent elements, I consider it more probable that the mark will be seen as a true composite mark, with BREWDOG being one element and ELVIS JUICE the other. On face value (I will come back to the evidence later) neither the BREWDOG element or the ELVIS JUICE element materially dominates the other, although with regard to the second element, ELVIS may play a greater role as a point of recall than JUICE. For sake of completeness, I should add that in respect of this application, in addition to beer (etc), registration is sought for non-alcoholic beverages, which would cover juice, so meaning that in this scenario the word JUICE is wholly descriptive.

45. I will firstly make the comparison between Elvis and ELVIS JUICE. There is a clear point of visual and aural similarity given that the word ELVIS appears as the first/only word in the respective marks. There is a point of aural and visual difference given the addition/absence of the word JUICE. Bearing in mind the overall impressions of the marks, I consider this equates to a reasonable (above medium but not high) level of visual and aural similarity. Conceptually, both marks make reference to Elvis and I consider that most average consumers will think of Elvis Presley. The addition

of juice gives a variation on this, but only to the extent that a reference is made to the liquid of which the goods comprise. I consider there to be a high degree of conceptual similarity.

46. That then leads to the comparison between Elvis and BREWDOG ELVIS JUICE. There is the same visual and aural point of similarity (although now the word ELVIS is in the middle of the applied for mark not the beginning), but there is an additional point of difference. Bearing in mind the overall impressions, I consider there to be a moderate (between low and medium) level of visual and aural similarity. Conceptually, both marks still make reference to Elvis. The addition of BREWDOG adds a different aspect, evoking a rather nebulous (but quirky) name based on a canine and brewing. Overall, and given that BREWDOG is independent from ELVIS JUICE, I consider there to be a medium level of conceptual similarity.

Likelihood of confusion

47. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. Confusion can be direct (which effectively occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). In terms of indirect confusion, this was dealt with by Mr Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10 where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

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

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

48. One point I can quickly rule out as pertinent is the reference, in the counterstatement, to the absence of confusion. As Mr Hicks submitted, there has been no use of the earlier mark (or at least none which has been filed) to show that any parallel trade has taken place. If there is no parallel trade then no opportunity for confusion has arisen, so the absence of any confusion thus far tells the tribunal nothing.

49. I will deal first with the ELVIS JUICE mark, focusing, for the time being, on the identical goods, beer. Mr Hicks submitted that it was inevitable that confusion would

arise because ELVIS was far more distinctive than JUICE which was either lacking in distinctiveness or much lower in distinctiveness and that the average consumer would assume that ELVIS JUICE was made by the same brewer or was otherwise brewed under licence. Ms Michaels submitted that the addition of the fanciful word JUICE to the low in distinctiveness word ELVIS rendered confusion unlikely.

50. Of course, whilst bearing the above submissions in mind, I am mindful that my view of the marks and the likely impact of the words within them do not fit either counsel's interpretation. I consider ELVIS to have an average level of inherent distinctiveness (not high as put by Mr Hicks, or low as put by Ms Michaels), and the impact of JUICE in ELVIS JUICE is mildly allusive (not lacking/very low in distinctiveness as put by Mr Hicks, or highly distinctive as put by Ms Michaels). The net effect of my findings is that, in my view, there is a likelihood of confusion. As stated earlier, ELVIS is likely to be the more memorable part of ELVIS JUICE whereas JUICE has some mild allusive characteristics. Therefore, when taking into account the concept of imperfect recollection, I consider that the average consumer may not recall the marks with a sufficient degree of accuracy and that if ELVIS is, as I have found, the more memorable aspect, then average consumers may misrecall/misremember the marks for each other, assuming they are one and the same.

51. However, even for average consumers whose recall is better, sufficient to recall with greater precision that one of the marks is ELVIS JUICE, the other ELVIS alone, then the combination would still indicate that the goods are from the same stable, with ELVIS JUICE being regarded as some form of brand extension/variant of ELVIS. It is important to bear in mind when considering these marks that even though Elvis may have a concept to aid recall, one is still looking at a brand, not the person himself. In my view, the combination of the distinctive word ELVIS with the mildly allusive word JUICE would combine so that the average would assume that no other trader would use such a mark other than the trader responsible for the ELVIS mark. The average consumer will assume that the brand ELVIS JUICE is from the same or economically linked source as the brand ELVIS.

52. In terms of the other goods of the application, I consider the same finding to be applicable. The goods are still identical. The degree of care and consideration is only

marginally greater (particularly in the case of those bought by the home brewer). The word JUICE is still mildly allusive. There is a likelihood of confusion for the reasons given above.

53. That then leads to the application for BREWDOG ELVIS JUICE. Before looking at this in more detail, it is worthwhile reflecting on what the courts have said in relation to the treatment of composite marks. Respective counsel referred to a number of cases including *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04 (“*Medion*”), *Aveda Corporation v Dabur India Ltd* [2013] EWHC 589 (Ch) (“*Aveda*”), Case C-591/12P, *Bimbo SA v OHIM (Bimbo)* and *Whyte and MacKay Ltd v Origin Wine UK Ltd & Anor* [2015] EWHC 1271 (Ch) (“*Origin*”). I do not think it necessary to quote all of these case here, but I set out below the guidance issued by The Hon Mr Justice Arnold in both *Aveda* and *Origin* which touches on the other cases (and more). The following text is taken from *Aveda*:

“22. It can be seen that paragraph (k) in the Registry's summary accurately reflects what the Court of Justice said in *Medion v Thomson* at [29], which addresses what the Court of Justice described at [30] as "the usual case". Paragraph (k) does not reflect what the Court of Justice went on to say at [30]-[37] about the impact of a sign which forms part of a composite sign, but which has an independent distinctive role, on the likelihood of confusion.

23. *Medion v Thomson* has been referred to in many subsequent cases, but for present purposes it is only necessary to refer to six. I shall take them in chronological order.

24. In *Novartis Seeds BV's Application* [2006] ETMR 82 Novartis applied to register the word CANTO. The Registrar refused the application on the ground of conflict with an earlier registration for ERIC CANTONA CANTO for identical goods. Geoffrey Hobbs QC sitting as the Appointed Person distinguished the case from *BULOVA ACCUTRON* and *Medion v Thomson* on the ground that the average consumer would perceive the earlier mark as a doubling up of a name and its nickname rather than a house mark plus invented word. Accordingly, he did not

consider that the word CANTO performed an independent distinctive role in the composite mark ERIC CANTONA CANTO.

25. In *DRILLISCH ALPHATEL Trade Mark Application* [2009] ETMR 27 the applicant applied to register "Drillisch ALPHATEL" as a trade mark in Germany. The opponent opposed the applicant on the ground of conflict with four earlier registrations for the trade mark ALCATEL for very similar goods and services. The opposition was dismissed on the ground that there was no likelihood of confusion. The opponent's appeal to the Bundespatentgericht (Federal Patent Court) was dismissed. Part of the Court's reasoning was that the opponent had failed to prove that its trade mark had acquired an enhanced distinctive character: see paragraph [7] of the ETMR report. More importantly for present purposes, the Court held that the respective signs were only very slightly similar for reasons which it expressed as follows:

"9 a) As to their overall impression, which in principle is to be given priority in assessing the risk of confusion between trade marks, irrespective of the priority in time of the signs being compared (cf. *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (C-120/04) [2005] ECR I-8551; *Sabel v Puma*), the marks being compared immediately differ visually, aurally and conceptually because of the addition of 'Drillisch' in the contested mark; moreover there are significant visual differences between the contested marks, which are merely protected as word marks, and the marks relied on, nos 1 139 897 and IR 525 160, because of their graphical format.

10 b) Contrary to the understanding of the opponent, the contested mark is also not characterised solely by the ALPHATEL component.

11 aa) Insofar as the opponent relies on the judgment of the European Court of Justice (ECJ) in *Medion* on this point, and argues that the ALPHATEL component has independent distinctive effect, it misunderstands what is said in that judgment. As the ECJ expressly emphasises, in fact (cf. cited above at [30]), the situation where

individual elements of a composite mark are independently distinctive is an exception from the general principle of assessment by reference to the overall impression, or by reference to the impression conveyed by individual component parts of the mark 'in a particular case' only when the contested mark is made up of a composite of the old mark and the company name of the proprietor of the new mark. The present case does not involve any such adoption of the old sign, however, because the ALPHATEL and ALCATEL components of the mark are not identical. There is no reason for an extension of the case law of the ECJ on 'adoption' (which, anyway conceptually speaking, is not present in this case) of a sign which is merely similar to the old mark and the addition of the company name of the proprietor of the contested mark, because of the clear wording of the judgment on the rule-exception-relationship, so that on this question no preliminary ruling will be obtained from the ECJ under art.234 EC nor any appeal on a point of law permitted under s.83(2) of the Trade Mark Law (Germany) .

12 bb) Insofar as the opponent further considers that the 'Drillisch' part of the contested mark is less significant because it is the producer's name, it also misunderstands, fundamentally, that the case law of the Federal Supreme Court does not permit such an inference to be drawn (cf. *Mustang* BGH [2004] GRUR 865, 866). For the field of telecommunications, which was the field it principally considered, the Federal Supreme Court has moreover even accorded the producer's name significance as one of the factors conveying an impression (cf. *T-INNOVA/Innova* BGH [2003] GRUR 70, 73), so that in relation to the goods and services sector at issue here, it is to be assumed that in the eyes of the public to whom the mark is directed the 'Drillisch' component of the mark not only is not of secondary importance, but in fact represents the element which actually conveys an impression. It is not necessary to decide whether it is still possible to maintain differentiation by sector in the wake of the *Medion v Thomson* judgment (critical of this, Ströbele/Hacker, *Markengesetz*, 8th edn (2006), §9 para.289), because in the opinion of the ECJ—differing in this respect from the Federal

Supreme Court—the producer's name always dominates a sign made up of more than one part (cf. *Medion v Thomson* at [34]), so that even when the more recent Supreme Court case law of the ECJ is used as a basis for decision making, the 'Drillisch' component of the mark in the contested mark has at least contributory if not dominant significance in the impression conveyed by the contested mark."

26. It can be seen from this reasoning that the Federal Patent Court held that *Medion v Thomson* did not extend to the case where the composite sign incorporated a sign which was merely similar to, rather than identical with, the earlier trade mark.

27. In *OHIM v Shaker* Shaker applied to register the following figurative mark as a Community trade mark:

.....

28. The application was opposed by Limiñana y Botell, SL on the basis of an earlier Spanish registration for word LIMONCHELO. The OHIM Opposition Division upheld the opposition, essentially because it considered that the dominant element of the mark applied for was the word LIMONCELLO which was confusingly similar to LIMONCHELO. The Second Board of Appeal dismissed Shaker's appeal. The Court of First Instance (now the General Court) allowed an appeal by Shaker. On an appeal by OHIM, the Court of Justice set aside the judgment of the CFI and remitted the case back to that court. The Court of Justice held that the CFI had misapplied Article 8(1)(b) for the following reasons:

"35. According to further settled case-law, the global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global appreciation of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole

and does not proceed to analyse its various details (see *SABEL*, paragraph 23; *Lloyd Schuhfabrik Meyer*, paragraph 25; *Medion*, paragraph 28; *Mülhens v OHIM*, paragraph 19; and order in *Matratzen Concord v OHIM*, paragraph 29).

...

37. In the present case the Court of First Instance, at paragraph 49 of the judgment under appeal, noted the case-law mentioned in paragraph 35 of the present judgment according to which the global appreciation of the likelihood of confusion must be based on the overall impression created by the signs at issue.

38. However, it stated in paragraph 54 of the judgment under appeal that, if the trade mark claimed was a complex mark which was visual in nature, the assessment of the overall impression created by that mark and the determination as to whether there was a dominant element had to be carried out on the basis of a visual analysis. It added that, in such a case, it was only to the extent to which a potentially dominant element included non-visual semantic aspects that it might become necessary to compare that element with the earlier mark, also taking into account those other semantic aspects, such as for example phonetic factors or relevant abstract concepts.

39. On the basis of those considerations, the Court of First Instance, in the context of the analysis of the signs at issue, firstly held that the mark for which registration was sought contained a dominant element comprising the representation of a round dish decorated with lemons. It then inferred, in paragraphs 62 to 64 of the judgment under appeal, that it was not necessary to examine the phonetic or conceptual features of the other elements of that mark. It finally concluded, in paragraph 66 of the judgment, that the dominance of the figurative representation of a round dish decorated with lemons in comparison with the other components of the mark prevented any likelihood of confusion arising from the visual, phonetic or conceptual similarities between the words 'limonchelo' and 'limoncello' which appear in the marks at issue.

40. However, in so doing, the Court of First Instance did not carry out a global assessment of the likelihood of confusion of the marks at issue.

41. It is important to note that, according to the case-law of the Court, in the context of consideration of the likelihood of confusion, assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in *Matratzen Concord v OHIM*, paragraph 32; *Medion*, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element."

29. It can be seen that paragraph (l) in the Registry's summary accurately reflects what the Court of Justice said in *OHIM v Shaker* at [42]. In my view it is clear that in that paragraph the Court of Justice was merely adding a slight clarification to what it had said in *Medion v Thomson* at [29], which it had repeated in the preceding paragraph. This is nothing to suggest that it intended to qualify in any way what it had said in *Medion v Thomson* at [30]-[37]. Nor did it have any occasion to do so, since *OHIM v Shaker* was factually a different kind of case to *Medion*.

30. In *Rousselon Frères et Cie v Horwood Homewares Ltd* [2008] EWHC 881 (Ch), [2008] RPC 30 Horwood was the proprietor of registrations for JUDGE SABATIER and STELLAR SABATIER. Rousselon applied for a declaration of invalidity on the ground of conflict with several earlier registrations, one of which was of the word SABATIER on its own. The hearing officer dismissed the application. Warren J allowed the appeal on the ground that the hearing officer had failed correctly to apply *Medion v Thomson*.

31. In his judgment Warren J said this:

"90. The Court in *Medion* was clear in its rejection of any precondition to a finding of likelihood of confusion that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark. In the present case, such a precondition would, of course, mean that there is no likelihood of confusion because, on Mr Foley's findings of fact, SABATIER was not the dominant element of HH's Marks. Although as noted in paragraph 23 above, the actual answer given by the Court related to the absence of such a precondition, it is clear from the decision that there will be a likelihood of confusion if the earlier mark retains an independent distinctive role in the later composite mark.

91. In this context, paragraph 34 of the Judgment is of great importance in stating that this independent distinctive role will be present in the examples given. There is no material difference between those examples and the present case, (see paragraph 93 below). It may be that, in some circumstances, an earlier mark may not retain any independent distinctive role, a possibility which is consistent with the language of paragraph 31 ('.....it is quite possible...') and paragraph 31 ('....the overall impression producedmay lead....'). But that would surely be an exceptional case. As it is said in paragraph 36 ' in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public to the owner of that mark'. Thus where the earlier mark is a word mark, and that earlier mark forms part of a composite mark itself comprising words (whether with or without a further device), it may be difficult, or so it seems to me, to resist the conclusion that the earlier mark does indeed retain an independent distinctive role.

92. Mr Arnold submits that *Medion* is simply a particular application of the ECJ's earlier case-law which I have already mentioned. I agree with that, as does Mr Vanhegan. But it is a particular application which shows

how the ECJ regards a composite mark which includes an earlier mark which retains an independent distinctive role. Of course, the actual test which must not be lost sight of remains whether, because of similarity of marks, there is a likelihood of confusion. The court in *Medion* does not in any way abandon that test. It does not say that a composite mark which contains an earlier mark will always carry a likelihood of confusion; rather, it says that there is such likelihood if the earlier mark has an independent distinctive role. However, the assessment whether the earlier mark does have such a role is, I consider, something which has to be decided before answering the question whether there is a likelihood of confusion. To elide the question of an independent distinctive role with the question of the likelihood of confusion runs the risk of answering the former question by first providing an answer to the latter. That would be to answer the question 'Is there a likelihood of confusion' with the answer 'Yes, if there is a likelihood of confusion' when the answer should be 'Yes, if the earlier mark retains an independent distinctive role'."

32. In this passage Warren J came quite close to saying that, if the earlier mark retains an independent distinctive role within the composite sign, then it must follow that there will be a likelihood of confusion. I do not think he went quite that far, however, since he recognised that the ultimate test remains whether there is a likelihood of confusion. In any event, as counsel for Dabur submitted, what the Court of Justice said at [37] of *Medion v Thomson* is that there "may be" a likelihood of confusion in those circumstances.

33. In Joined Cases T-5/08 to T-7/08 *Société des Produits Nestlé v OHIM* [2010] ECR II-1177 the applicant applied to register three Community trade marks consisting of the words GOLDEN EAGLE and an image of a red coffee mug placed on coffee beans. Nestlé opposed the applications on the grounds of conflict with various registrations consisting of a similar image of a red coffee mug on coffee beans for identical goods. The Opposition Division refused the oppositions finding the respective marks to be dissimilar. The Board of Appeal upheld the decision. Nestlé (represented, it may be noted, by the distinguished German trade mark lawyer Alexander von Mühlendahl) appealed to the General Court. The General

Court annulled the decision of the Board of Appeal. It found that Nestlé's mark and the corresponding element in the composite mark were similar and that there was some, albeit slight, overall visual and conceptual similarity between the marks. Accordingly, the Court concluded that the Board of Appeal should therefore have assessed the likelihood of confusion.

34. In this context the General Court held at [60]:

"It must also be pointed out that, according to the case-law, where a composite mark is composed by juxtaposing one element and another mark, that latter mark, even if it is not the dominant element in the composite mark, still can have an independent distinctive role therein. In such a case, the composite mark and that other mark may be held to be similar (see, to that effect, *Medion*, paragraph 28 above, paragraphs 30 and 37). It must be observed that *Medion*, paragraph 28 above, concerned a situation in which the earlier mark had been reproduced identically in the later mark. Nevertheless, it must be held that, in the event that the earlier mark is not reproduced identically in the later mark, it is still possible that the signs at issue are similar on account of the similarity between the earlier mark and one element of the later mark which has an independent distinctive role."

35. It does not appear, however, that the General Court's reasoning was based on a finding that the image of a red coffee mug on coffee beans had an independent distinctive role in the marks applied for. Rather, its reasoning was based on an overall assessment of similarity.

36. In Case T-569/10 *Bimbo SA v OHIM* [2012] ECR II-0000, [2013] ETMR 7 the applicant applied to register BIMBO DOUGHNUTS as a Community trade mark. The application was opposed on the basis of an earlier Spanish registration for DOGHNUTS covering identical and similar products. The opposition was successful. The applicant's appeal to the Board of Appeal was dismissed. The applicant appealed to the General Court. The General Court agreed with the lower tribunals that there was a likelihood of confusion and dismissed the appeal.

37. A key part of the General Court's reasoning was as follows:

"96. According to the case-law, where goods or services are identical there may be a likelihood of confusion on the part of the public where the contested sign is composed by juxtaposing the company name of another party and a registered mark which has normal distinctiveness and which, without alone determining the overall impression conveyed by the composite sign, still has an independent distinctive role therein (Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37). There may also be a likelihood of confusion in a case in which the earlier mark is not reproduced identically in the later mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestlé v OHIM – Master Beverage Industries (Golden Eagle and Golden Eagle Deluxe)* [2010] ECR II-1177, paragraph 60).

97. In this case, the 'doughnuts' element, which is almost identical to the earlier trade mark, has an independent distinctive role in the mark applied for. Indeed, contrary to what is claimed by the applicant, that element is not devoid of distinctive character but on the contrary has average distinctive character for the part of the relevant public which is not familiar with English. Furthermore, since the 'doughnuts' element is wholly meaningless for that consumer, the mark applied for, BIMBO DOUGHNUTS, does not form a unitary whole or a logical unit on its own in which the 'doughnuts' element would be merged. The part of the relevant public which is not familiar with English will not be able to understand the sign at issue as meaning that the goods concerned are doughnuts produced by the undertaking Bimbo or by the proprietor of the trade mark BIMBO."

38. It should be noted that, although the General Court held that DOUGHNUTS was "almost identical" to DOGHNUTS, it did not proceed on the basis that the average consumer would perceive it as being identical. An appeal to the CJEU against the decision of the General Court is pending as Case C-591/12 P."

54. In the *Origin* case, Mr Justice Arnold added:

17. I reviewed *Medion v Thomson* and six subsequent cases in *Aveda Corp v Dabur India Ltd* [2013] EWHC 589 (Ch), [2013] ETMR 33 at [19]-[38]. I shall take that analysis as read, and will not repeat it here. Since then, the CJEU has given judgment in Case C-591/12 P *Bimbo SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:305]. The facts of that case and the reasoning of the General Court are summarised in *Aveda v Dabur* at [36]-[38]. The Court of Justice dismissed the applicant's appeal, holding:

"22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the case-law cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37).

26. In the present case, the General Court found, in paragraphs 79 and 81 of the judgment under appeal, that, even if the element 'bimbo' were dominant in the trade mark for which registration was sought, the 'doughnuts' element was not negligible in the overall impression produced by that trade mark and, accordingly, the 'doughnuts' element had to be taken into account in the comparison of the trade marks at issue.

27. In paragraph 97 of that judgment, the General Court stated that, since the 'doughnuts' element is wholly meaningless for the relevant public, that element did not form, together with the other element of the sign, a unit having a different meaning as compared with the meaning of those elements taken separately. It accordingly found that the 'doughnuts' element still had an independent distinctive role in the trade mark for which registration was sought and had therefore to be taken into account in the global assessment of the likelihood of confusion.

28. In paragraph 100 of the judgment under appeal, the General Court held that, in the light of all factors relevant to the case, the global assessment confirmed the Board of Appeal's conclusion that there was a likelihood of confusion.

29. Accordingly, the General Court did not conclude that there was a likelihood of confusion merely from the finding that, in the trade mark applied for, the 'doughnuts' element has an independent distinctive role,

but based its conclusion in that regard on a global assessment that included the different stages of the examination required under the case-law referred to in paragraphs 19 to 25 above, and in the course of which it took into account the factors of the case. It thus correctly applied Article 8(1)(b) of Regulation No 40/94.

...

33. ... in so far as Bimbo argues that the General Court disregarded the rule that a finding that one component of a composite sign has an independent distinctive role constitutes an exception, that must be duly substantiated, to the general rule that the consumer normally perceives a trade mark as a whole, it should be pointed out that the purpose of examining whether any of the components of a composite sign has an independent distinctive role is to determine which of those components will be perceived by the target public.

34. Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

35. The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.

36. Moreover, the individual assessment of each sign, as required by the settled case-law of the Court of Justice, must be made in the light of the particular circumstances of the case and cannot therefore be regarded as being subject to general presumptions. As the Advocate General observed in point 24 of his Opinion, it is clear, in particular, from the case-law subsequent to *Medion* (EU:C:2005:594), that the Court of Justice did not introduce, in that judgment, a derogation from the principles governing the assessment of the likelihood of confusion."

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.”

55. Some of this was touched upon by Mann J in his judgment in *SoulCycle v Matalan* [2017] EWHC 496(Ch) but it does not appear that he identified any additional principles to those set out by Mr Justice Arnold.

56. My assessment is that BREWDOG forms one component in the applied for composite mark, ELVIS JUICE another. On the basis of the case-law, I consider it right to say that within the composite mark both BREWDOG and ELVIS JUICE retain an independent distinctive role within it. That second element, ELVIS JUICE, is not identical to the earlier mark, but is merely similar, but similar enough that I have already found a likelihood of confusion between Elvis and ELVIS JUICE. Similarity may be enough for a likelihood of confusion (as per *Aveda*, as submitted by Mr Hicks), although each case must be considered on its own merits. Ms Michaels submitted that the evidence filed by the applicant lessened the likelihood of confusion. If I understood the submission correctly, this was on the basis that the reputation enjoyed in respect of the BREWDOG element of the mark means that it would be given even greater significance, to the detriment of the other aspects of the mark. However, whilst I accept that BREWDOG may have something of a reputation, there would still be a significant number of average consumers who will not have heard of it and, consequently, the claimed lessening of confusion would not be applicable to them. However, even in respect of those who know of BREWDOG and its products, the ELVIS JUICE element still plays a role and will be seen, effectively, as a sub-brand and there is no reason why the sub-brand will lessen materially in significance. As touched on earlier, and irrespective of the evidence, I consider that BREWDOG and ELVIS JUICE make a roughly equal contribution to the mark.

57. Weighing all of the above, taking into account the roles the respective elements play, and irrespective of the second element not being identical to the Elvis mark, I still consider that there is a likelihood of indirect confusion and that the average consumer

will assume that the goods come from the same or a related undertaking. This is so in respect of all of the goods of the application.

Conclusion

58. The oppositions succeed and, subject to appeal, both marks are refused registration.

Costs

59. The opponent has been successful and is entitled to a contribution towards its costs. Consolidation has, though, kept costs down:

Official fees - £100 x 2 (although £200 was paid per opposition, the section 5(3) ground was withdrawn which meant that such a fee was unnecessary)

Preparing statements of case and considering the counterstatements – £400 (covering both proceedings due to the similar nature of the statements)

Considering evidence – £300

Attending the hearing - £600

Total – £1500

60. I order Brewdog Plc to pay ABG EPE IP LLC the sum of £1500 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 23rd day of June 2017

Oliver Morris

For the Registrar,

The Comptroller-General