

O/354/18

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3201586  
BY RECOGNISE LIMITED  
TO REGISTER THE FOLLOWING TRADE MARK**

**Mideltone**

**IN CLASSES 32 AND 33**

**AND IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 408701  
BY IRISH DISTILLERS LIMITED**

## Background and pleadings

1) On 11 December 2016 Recognise Limited ('the applicant') applied to register the trade mark 'Midelstone' in the UK. It was accepted and published in the Trade Marks Journal on 6 January 2017 in respect of the following goods.

*Class 32: Ginger beer; Beer; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Barley wine [Beer]; Craft beers; Malt beer; Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Low alcohol beer; Low-alcohol beer; Ginger beer; Beer and brewery products; Beer; Beers; Beer-based cocktails; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Beer-based beverages; Barley wine [Beer]; Craft beers; Beers enriched with minerals; Malt beer; Beer wort; Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Low alcohol beer; Low-alcohol beer.*

*Class 33: Pre-mixed alcoholic beverages, other than beer-based; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beers); Alcoholic carbonated beverages, except beer; Pre-mixed alcoholic beverages, other than beer-based; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beers); Alcoholic carbonated beverages, except beer.*

2) On 6 March 2017 Irish Distillers Limited ('the opponent') opposed the trade mark on the basis of Section 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ('the

Act'). The section 5(2)(b) claim is based of the following earlier European Union Trade Mark ('EUTM'):

**Mark:** MIDDLETON

**Number:** 99986

**Filing date:** 1 April 1996

**Date of entry in register:** 23 March 1998

**List of goods:** Class 33 '*Alcoholic beverages (except beers); whiskey*'

3) The opponent argues that the respective goods are identical or similar and that the marks are highly similar. Therefore, there is a likelihood of confusion and the section 5(2)(b) claim should succeed.

4) With regard to the section 5(3) claim the opponent also relies on the above EUTM No 99986. It claims to have acquired a reputation in the mark MIDDLETON in the UK for all of the goods which the registration covers. The opponent states that the application 'is an attempt by the Applicant to benefit from the power of attraction, reputation and prestige of the Earlier Mark, and to exploit those rights without being required to make autonomous efforts in that regard'. It also claims that the application would be detrimental to the distinctive character of the earlier mark, take unfair advantage, ride on the coat tails and dilute the opponent's rights by blurring, i.e. diminishing the distinctiveness of the earlier mark.

5) The section 5(4)(a) of the Act claim is based on it selling alcoholic beverages under the sign MIDDLETON since November 1999 and having acquired goodwill under the sign throughout the UK. It claims that use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the opponent's goodwill.

6) The applicant filed a counterstatement denying the claims made. It provided a number of submissions with respect to the goods and the marks being dissimilar. I shall not summarise these here but they shall be borne in mind and taken into consideration where necessary.

7) Whilst the earlier mark is old enough to be the subject of proof of use, the applicant opted not to put the opponent to proof of use. Therefore, the opponent may rely upon all of the goods for which the mark is registered.

8) Only the opponent filed evidence and submissions in these proceedings. These will be summarised to the extent that it is considered appropriate/necessary. No hearing was requested and so this decision is taken following a careful consideration of the papers.

### **Opponent's evidence**

9) Ms Wilmann-Courteau is the legal manager of the intellectual property group within Pernod Ricard SA, 'the ultimate parent company of the opponent'.

10) The witness statement outlines the history of the opponent, stating that it was formed in 1966. In 1975 the 'Old Midleton Distillery' was closed and the 'New Midleton Distillery' was opened nearby. In 1988 the opponent company joined the Pernod Ricard SA group of companies. Ms Wilmann-Courteau then states that the New Midleton Distillery has a production capacity of 64 million litres per annum and employs over 600 people at its facilities in Ireland.

11) The first use of the mark MIDDLETON was made on the opponent's range of whiskeys in Ireland in 1984 and in the UK, France, Germany, Benelux, Italy, Sweden, Portugal, Denmark, Bulgaria, Czech Republic, Greece and Iceland no later than 1999. By 2002 the use extended to Poland, Austria, Latvia, Croatia, Finland and Cyprus, then on to Hungary and Spain by 2005, Malta in 2009 and Romania in 2015.

12) In order to demonstrate the volume of whiskey being sold, the following table was provided which shows the number of 9-litre cases sold under the various MIDDLETON marks in the UK and various EU territories. As can be seen, some of the annual figures have not been provided:

Region	2011	2012	2013	2014	2015	2016
UK	104.5	57	93	94	100	209
Austria	38	34	30	50	30	-
Bulgaria	4	2	5	5	4	-
Czech Republic	-	-	-	-	-	3
Denmark	19	2	8	8	8	-
France	105	262	280	289	267	-
Germany	19	42	127	156	196	-
Netherlands	6	2	3	3	3	-
Sweden	6	22	3	3	3	-

13) Ms Wilmann-Courteau provides the following example of various Midleton bottles<sup>1</sup>:



<sup>1</sup> Exhibit EMW-1

14) Exhibit EMW-2 to the witness statement includes a press release dated April 2011 from the opponent regarding the launch of the MIDDLETON Single Pot Still Irish whiskeys. It is not stated where the press release was sent or to how many recipients. The exhibit also includes product sheets for MIDDLETON Barry Crockett Legacy whiskey and MIDDLETON Dair Ghaelach whisky, launched in 2011 and 2015 respectively. I note that the documents state that the key markets for the MIDDLETON Barry Crockett brand are Ireland, France, Germany and the UK.

15) Exhibit EMW-3 consists of an Irish Distillers Limited archive document showing the product details of the gift pack for the single pot still whiskey range, which includes the MIDDLETON Barry Crockett legacy whiskey. The document is not dated apart from the last page referring to various awards that the opponent has won, one being in 2015. Therefore, it can be inferred that the document is dated, at the very earliest, 2015. Ms Wilmann-Courteau then details the various awards that the MIDDLETON Barry Crockett Whiskey brand has won, these are:

<b>Year</b>	<b>Awarding Body</b>	<b>Award</b>
2013	International Wine and Spirits Competition <sup>2</sup>	Gold outstanding
2014	International Wine and Spirits Competition	Gold
2015	Jim Murray Whisky Bible <sup>3</sup>	Score of 94 (out of 100)
2015	International Wine and Spirits Competition	Gold
2016	International Wine and Spirits Competition	Silver
2016	The Spirits Business	Gold
2016	Ultimate Spirits Challenge	Score of 93
2017	International Wine and Spirits Competition	Silver Outstanding

16) The MIDDLETON Dair Ghaelach whiskey also won the following awards:

<sup>2</sup> 'Entries into the Competition [International Wine and Spirits Competition] are received from nearly 90 countries worldwide' (exhibit EMW-7)

<sup>3</sup> Mr Murray is an English journalist and chair judge at the International Wine Spirit Competition. His annually updated book 'Jim Murray's Whisky Bible' is sold in the UK and described as the world's leading whisky guide. Extracts of such are provided at exhibit EMW-6

<b>Year</b>	<b>Awarding body</b>	<b>Award</b>
2016	International Wine and Spirits Competition	Gold
2016	Jim Murray Whisky Bible	Third Finest Whisky of the Year
2016	The Spirits Business	Silver
2017	International Wine and Spirits Competition	Silver

17) Ms Wilmann-Courteau states that the Ultimate Spirits Challenge is a US-based company which ‘aims to set a higher standard of evaluation of spirits and wines by a panel of judges’. She states that the ‘results of these competitions can be featured in trade press published or featured within or directed to consumers in the EU and the UK.’ Specific details have not been provided.

18) Since 1984 the opponent has released products from its MIDDLETON Very Rare range<sup>4</sup> of whiskeys. There is a limited quantity available (no figures have been provided) and ‘Each vintage is highly collectible since the character of the whiskey can change significantly from year to year...this product has won numerous awards’ for these goods.

19) Exhibit EMW-8 consists of two press articles. The first is dated 4 August 2016 from ‘The Spirits Business’, an international spirits trade magazine and website publication which is based in the UK. The article states that the MIDDLETON Barry Crockett Legacy whiskey was launched in 2011 and that it is one of the ten best value for money Irish whiskeys. The second article features a review of the Irish Whiskey Masters 2016 which is an annual competition run by The Spirits Business to identify the best spirits in various categories. The opponent’s MIDDLETON Barry Crockett Legacy was awarded a gold medal in the category Single Pot Still – Ultra Premium. The MIDDLETON Dair Ghaelach whiskey was awarded a silver medal in 2016.

20) Exhibit EMW-9 includes various press articles dated between 2013 and 2016 from ‘The Spirits Business’ featuring the MIDDLETON range of whiskeys as some of

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<sup>4</sup> Exhibit EMW-4

the finest award-winning Irish whiskeys. Exhibit EMW-10 consists of an extract from the 'The Spirits Business Media Pack' website which is available to 'media partners prior to 2017'. Ms Wilmann-Courteau states that the magazine has a print circulation of up to 13,000 copies per month across 120 countries reaching more than 45,000 spirits professionals worldwide. It is stated that Europe represents 48% of the print readership and 13 EU member states including the UK and Ireland are listed in the top 25 countries.

21) The opponent submits further press articles, including one from the leading European drinks UK-based trade publication, The Drinks Business<sup>5</sup>. The article is dated 12 February 2013 and features the launch of 10 whiskeys under the MIDDLETON mark in Ireland, France, Germany and the UK.

22) A further article is from ScotchWhiskey.com, a UK magazine containing selected tasting notes for MIDDLETON Very Rare product from 1984 to 2014. The exhibit also consists of a number of other articles, press releases and social media posts about the various MIDDLETON whiskeys.

23) Ms Wilmann-Courteau states that the MIDDLETON whiskeys are not just purchased by wholesalers and retailers in the UK, Ireland and various EU territories but also through specialists such as The Whiskey Exchange's website (an on-line world specialist retailer of whiskeys and fine spirits). Other on-line retailers include The Oxford Wine Company, Nickolls and Perks, Master of Malt, Hedonism Wines, Viinikauppa, Bevco, Garrafeiranacional, Kupsidrink, La Fuente, Nevejan and voorenmooiglas. Some of these retailers have physical stores based in London, Oxford, the West Midlands and Kent. Ms Wilmann-Courteau provides various website extracts<sup>6</sup> showing the opponent's various MIDDLETON brands being offered for sale.

24) Ms Wilmann-Courteau also states MIDDLETON whiskeys are sold in various retail stores, bars and hotels in the UK including Claridges, Harvey Nichols, Harrods and Selfridges, Blind Ping bar, Hedonism Store, Merchant House, etc. The exhibit

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<sup>5</sup> Exhibit EMW-11

<sup>6</sup> Exhibit EMW-13

includes pictures from the bar menus which show the MIDDLETON brand under the heading Irish whiskey. No sales figures or volume of sales have been provided.

25) Exhibit EMW-16 consists of a number of invoices. The majority of these invoices are addressed to UK companies dated between 2012 and 2016, but they also include invoices addressed to Sweden, Benelux and Austria in 2016. The MIDDLETON mark appears on the invoices but the cost price of the goods has been redacted. The quantities purchased are not high, ranging from one to twenty.

26) Exhibit EMW-17 to the witness statement are extracts from the 'Registration Document' for the Pernod Ricard Group for the years 2015/2016 and 2016/2017. There is no reference to the MIDDLETON brand so it is difficult to see its relevance to these proceedings.

### **DECISION - Section 5(2)(b)**

27) Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

### **Comparison of goods and services**

28) In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, 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”.

29) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

30) 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 für 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”.

31) The respective list of goods are as follows:

<b>Earlier goods</b>	<b>Applicant's goods</b>
<p>Class 33: Alcoholic beverages (except beers); whiskey.</p>	<p>Class 32: <i>Ginger beer; Beer; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Barley wine [Beer]; Craft beers; Malt beer; Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Low alcohol beer; Low-alcohol beer; Ginger beer; Beer and brewery products; Beer; Beers; Beer-based cocktails; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Beer-based beverages; Barley wine [Beer]; Craft beers; Beers enriched with minerals; Malt beer; Beer wort; Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Low alcohol beer; Low-alcohol beer.</i></p> <p>Class 33: <i>Pre-mixed alcoholic beverages, other than beer-based; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beers); Alcoholic carbonated beverages, except beer; Pre-mixed alcoholic beverages, other than beer-based; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beers); Alcoholic carbonated beverages, except beer.</i></p>

## **Class 32**

*Beer; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Malt beer; Craft beers; Coffee-flavored beer; Root beer; Low alcohol beer; Low-alcohol beer; Beers; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Beer-based beverages; Craft beers; Beers enriched with minerals; Malt beer; Coffee-flavored beer; Root beer; Low alcohol beer; Low-alcohol beer; Beer-based cocktails; Barley wine [Beer]*

32) The applicant argues that since its list of goods cover beer and real beer, which are synonymous with CAMRA (the Campaign for Real Ale), they concern a different marketplace of drinkers to the opponent's goods. The earlier goods do exclude beer but this does not avoid similarity between the various goods. There are other factors (as listed above) which must be taken into account and therefore it is still possible for the respective goods to be deemed similar.

33) The opponent's "alcoholic beverages" covers a wide range of alcoholic drinks, which would include both short drinks high in alcohol, such as spirits, and longer drinks with a lower alcohol content, such as cider and perry. Since the respective goods all include alcohol, there is a degree of similarity in nature. The intended purpose of both is a pleasurable drinking experience, which may include the intoxicating effects of alcohol. The users and method of use are identical. The goods are likely to share channels of trade and in retail premises may be located not only in the same aisle but also on the same shelf. The goods may be in competition but they do not have a complementary relationship. Therefore, the various 'Beers' listed above are similar to the opponent's 'alcoholic beverages' to a medium degree.

*Non-alcoholic beer flavored beverages; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Imitation beer; Non-alcoholic beer flavored beverages; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Ginger beer*

34) The various non-alcoholic beers and drinks listed above are consumed to either quench thirst or to be consumed in social environments as a substitute to their alcoholic equivalents. Therefore, there is a certain degree of similarity in nature between the respective goods though it is limited since the opponent's goods specifically exclude beer. They are also likely to be consumed by the same end user. I also consider the distribution channels to be similar and they are in competition. They are likely to be sold within relatively close proximity to one another. Taking all of these factors into account, they are similar to a low degree.

35) The contested *Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; brewery products; Extracts of hops for making beer; Beer wort* are preparations for making beer. It must be borne in mind that the mere fact one good is used for the manufacture of another will not be sufficient in itself to show that the goods are similar.

36) In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that:

“61... The mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those components are similar since, in particular, their nature, intended purpose and the customers for those goods may be completely different.”

37) It is clear from the above that the respective goods are different in nature. Raw materials are generally intended for use in industry rather than for direct purchase by the final consumer. Further, even if a similarity could be found between the raw material for production of beer and beer per se, these are not the goods under comparison. Instead the question is whether raw materials for production of beer are similar to the opponent's alcoholic beverages (except beers). Taking into account the uses, users and nature of the goods I cannot find similarity. Further, I do not consider the trade channels of the respective goods to be the same or similar, nor are they in competition or complementary. Therefore, they are dissimilar.

### **Class 33**

38) All of the applied for Class 33 goods are various alcoholic beverages. Therefore, applying the principle set out above in *Meric*, they are all identical to the earlier alcoholic beverages.

### **Comparison of marks**

39) It is clear from *Sabel BV v Puma AG*, Case C-251/95 (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.”

40) It would be wrong, therefore, to dissect the trade marks artificially, 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.

41) The respective trade marks are shown below:

<b>Earlier mark</b>	<b>Applicant's mark</b>
MIDLETON	Mideltone

42) The earlier mark consists of the eight-letter word 'MIDDLETON'. Since it is a single word it has no dominant element and its distinctive character resides in the word itself.

43) The applicant's mark consists of the nine-letter word 'Midelstone'. As with the earlier mark, since it is a single word it has no dominant element and its distinctive character resides in the word itself.

44) Visually, the marks coincide with the first three letters, they then share the same next two letters but they are reversed in the contested mark. The final three letters of the earlier mark are also present in the later mark, but the contested mark ends with an 'e'.

45) In the applicant's counterstatement it is stated that the marks are dissimilar since 'The spelling of the trademark is different in two regards; Mideltone has two "e's" and the placement of the former "e" is after "D" and before the "L".' Whilst the applicant's statement is accurate, it is nevertheless the case that the marks share the same three letters, the middle two letters are reversed and there is an 'e' at the end of the contested mark which is not present in the earlier mark. Therefore, the visual similarities outweigh the dissimilarities to the extent that I consider them to be highly similar.

46) Aurally, the earlier trade mark will be pronounced as three syllables being pronounced as 'MID'-'EL'-'TUN'. The contested mark coincides with the same first two syllables but the last one will be pronounced as 'TONE'. Whilst the middle letters of the respective marks are inverted ('el' and 'le') they will nevertheless be pronounced in the same manner. Taking all of these factors into account I find the marks aurally similar to a high degree.

47) With regard to the conceptual comparison, in order for a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer<sup>7</sup>. In the applicant's counterstatement it states that 'Midelstone is the historical name for Milton

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<sup>7</sup> Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29)

Keynes Village, as recorded in the Domesday book'. Whilst this information is not in evidential form, I do not consider that many members of the relevant public (i.e. consumers of beer, whiskey and the various drinks in dispute) will be aware of this. Any members of the relevant public who know that fact will be negligible and for the remaining consumers I certainly do not consider such a concept to be capable of an immediate grasp.

48) The earlier mark is very similar to the well-known UK surname Middleton (the only difference being two d's in the surname and one in the earlier mark). The contested sign does not have any clear and graspable meaning. For those that recognise the earlier mark as being a surname, the respective marks are not conceptually similar. For those that do not recognise the earlier mark as being a surname, neither mark will have a meaning and a conceptual comparison is not possible.

#### **Average consumer and the purchasing act**

49) 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 & Co. GmbH v Klijsen Handel BV*, Case C-342/97 .

50) 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.”

51) The respective goods cover a variety of alcoholic and non-alcoholic drinks. The opponent correctly states that the relevant public for the alcoholic drinks will be the public at large who will be over the age of 18 years old. The non-alcoholic drinks would also be aimed at the public at large, but there will not be a lower age-limit.

52) The applicant states that since its list of goods covers beer and that real beer is synonymous with CAMRA (the Campaign for Real Ale), they concern a different marketplace of drinkers to the opponent's goods. I disagree. From my own experience, consumers of beer and real beer may also drink whiskey and vice versa. Of course, not all consumers will drink both types of drink, but a reasonable proportion will and therefore they coincide with end users.

53) In my view, the goods at issue are sold through a range of channels including restaurants, bars and public houses. They are also commonly sold in supermarkets, off-licences and their online equivalents. In restaurants, bars and public houses, the goods are likely to be on display, for example, on taps or in bottles in fridges behind the bar. They may also be shown on drinks menus, where the trade mark will be visible. While I do not discount that there may be an aural component in the selection and ordering of the goods in bars, restaurants and public houses, this is likely to take place after a visual inspection of the bottles or drinks menu (see *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T3/04 (GC)). In retail premises, the goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will most likely select the goods having viewed an image displayed on a web page. Therefore, the selection of the goods at issue will be primarily visual, although aural considerations will play a part.

54) The opponent argues that since the goods in question are relatively inexpensive and likely to be purchased on a daily basis, the level of attention paid will be low. I disagree. Whilst some of the goods may not be particularly expensive, consumers will seek to purchase a particular type, flavour of beverage or brand that they are accustomed to. Therefore, I consider the level of attention as being average.

## **Distinctive character of the earlier trade mark**

55) In *Lloyd*, Case C-342/97, the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

56) The level of distinctive character of a trade mark can vary, depending on the particular goods at issue: a mark may be more distinctive for some goods than it is for others. Distinctiveness can also be enhanced through use of the mark. There has been no explicit claim of enhanced distinctiveness but evidence of use has been filed in support of the opponent’s section 5(3) claim.

57) The opponent has not provided any sales figures. It has provided invoices but the prices and invoice totals have been redacted so I am unable to determine the extent of sales made. The invoices do show sales throughout the UK, and some EU

member states. However, the quantity sold ranges from one to twenty (presumably these are cases of 10 or 12 bottles). The opponent does provide figures relating to the volume of whiskey sold, i.e. the number of 9-litre cases (I shall proceed on the basis that these are cases of 12 750ml bottles since this represents the opponent's best claim). In 2016 it sold 209 cases which equates to around 2500 bottles and the year before approximately 1250 bottles. The opponent has not put these figures into context so that I can determine the market share. On a *prima facie* basis they are not insignificant numbers but they do not demonstrate the extent of market share or intensive sales which are necessary to determine that the opponent's use is enhanced by virtue of the use made of the mark.

58) The MIDDLETON brand of whiskeys do appear to be held in high-regard amongst whiskey aficionados, winning numerous awards and being referred to and winning Jim Murray awards. Other than this, the extent of promotion and advertising appears limited. The opponent has not stated how much it has spent on advertising and it does not appear to be widespread.

59) I do acknowledge that the opponent has been using the mark in the UK since 1999, but from the evidence provided and for the reasons set out above, it has not demonstrated that it has an enhanced degree of distinctive character from the use made of the mark.

60) From an inherent perspective, I have already stated that the earlier mark is very similar to the well-known UK surname Middleton, albeit spelt with a single 'd'. For those that recognise the earlier mark as being a surname I consider its distinctive character to be average. Consumers are used to seeing surnames being used as trade marks and use of Middleton would not be particularly unusual though I must bear in mind that it is not descriptive or suggestive of the goods in question. For those that do not recognise it as being a surname, it would be viewed as an invented word and therefore have a higher degree of inherent distinctive character.

## GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

61) Where there is no similarity between the goods, a likelihood of confusion cannot exist. Therefore, the section 5(2)(b) of the Act claim fails in respect of the following goods:

*Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; brewery products; Extracts of hops for making beer; Beer wort*

62) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon*, Case C-39/97, *Lloyd* 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.

### *The principles*

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

63) As can be seen from the above, there is no simple formula for determining whether there is a likelihood of confusion and all of these factors need to be taken into account. Confusion can be direct (where 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).

64) The applicant argues that there is no likelihood of confusion since the applicant's product is 'sufficiently different so as not to cause any confusion, especially considering the geographical nature of Bucks Star Beer who are English brewers based in Milton Keynes and Irish Distillers who are Irish Distillers based in Dublin'. Where the respective businesses are based is not a relevant consideration. The applicant is seeking to gain a UK monopoly in 'Midelstone' for various class 32 and 33 goods. It is necessary for me to consider this application against the earlier mark for all of the goods that it is registered for. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated that:

"78. ....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion."

65) In view of the above, I must simply take an abstract view based on the earlier mark as registered and the applied for mark and conclude whether I believe there is a likelihood of confusion.

66) In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC held that the beginnings of words tend to have more visual and aural impact than the ends. The court stated:

“81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters ‘lo’ which characterise the earlier marks and which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter ‘r’, which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root ‘mundico’ in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter ‘r’ at the end of the two signs. Given those similarities, the applicant’s argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix ‘mundi’ are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.

67) See also: GC cases: *Castellani SpA v OHIM*, T-149/06, *Spa Monopole, compagnie fermière de Spa SA/NV v OHIM*, T-438/07 (similar beginnings important or decisive), *CureVac GmbH v OHIM*, T-80/08 (similar beginnings not necessarily important or decisive), and *Enercon GmbH v OHIM*, T-472/07 (the latter for the application of the principle to a two word mark).

68) In the present case there are clear visual and aural similarities between the marks to the extent that I have found them to be similar to a high degree. From a conceptual perspective, I concluded that for those that view the earlier mark as being a surname, the marks are not conceptually similar and for the remaining members of the relevant public a conceptual comparison is not possible.

69) I also found that the goods will be purchased following a visual inspection, though aural considerations will also play a part. The level of attention will be average. I must also take into account the distinctive character of the earlier mark which is average for those that see the surname and higher for those that do not.

70) Turning to the respective goods, I have concluded that some are identical and the remaining goods are similar to varying degrees (this ranging from high to low). Taking all of these factors into account, I find that the high degree of visual and aural similarity between marks offsets the low similarity of goods, even for those consumers who view the earlier mark as a surname. The coinciding elements in the marks are too great, taking into consideration imperfect recollection, for confusion to be avoided.

71) In the applicant's counterstatement, it offered to withdraw class 33. If deletion of class 33 would have overcome the opposition I would have done so. However, as can be seen from the above, this proposed deletion would not have avoided the opposition being partially successful. Therefore, the applicant's fall-back position does not need to be considered any further.

### **DECISION – Section 5(3)**

72) Section 5(3) of the Act states:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

73) I remind myself of the basis of the opponent's section 5(3) of the Act claim. The opponent states that it has a reputation for its EUTM registration no. 99986 ('MIDDLETON') for class 33 '*Alcoholic beverages (except beers); whiskey*'.

74) The relevant date at which reputation must be proven is the date of the application, namely 11 December 2016.

### **Case law**

75) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; Intel, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; Intel, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; Intel, paragraphs 76 and 77.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; Intel, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; L'Oreal v Bellure NV, paragraph 40.

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

reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

## **REPUTATION**

76) The earlier mark is an EUTM and I must take into account the use made in the EU<sup>8</sup>. However, even if there is sufficient use in the EU in order to satisfy the reputation threshold, it is still necessary to establish that there is enough knowledge on the part of the UK relevant public that a link would be made.

77) In paragraphs 56 to 59 above I set out my reasons for rejecting the opponent's claim that the earlier marks had acquired an enhanced level of distinctiveness in relation to the relied upon goods for its section 5(2)(b) claim. For the same reasons, I find that its MIDDLETON mark had not acquired a reputation for its goods by the relevant date.

### **Section 5(3) outcome**

78) The section 5(3) of the Act fails and is rejected.

### **DECISION – Section 5(4)(a)**

79) Section 5(4)(a) of the Act states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

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<sup>8</sup> *PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH*, case C-301/07, CJEU.

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

### **Case-law**

80) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56 In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

81) Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;
- (c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;
- (d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances."

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

82) I remind myself of the opponent's claim under section 5(4)(a) of the Act. It states that the applicant's mark is liable to be prevented under the law of passing off, owing to its goodwill attached to the business under the sign MIDLETON, which it claims to have used throughout the UK for alcoholic beverages. The goods which the section 5(4)(a) claim is against are as follows (i.e. the goods which the sections 5(2)(b) and

5(3) claims were unsuccessful): Class 32: *Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; brewery products; Extracts of hops for making beer; Beer wort.*

### **Relevant date**

83) In *SWORDERS TM*<sup>9</sup> O-212-06 Mr Allan James acting for the Registrar summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’

84) The applicant has not submitted any evidence to demonstrate that it has been using the mark, so the relevant date is the date of application: 11 December 2016.

### **Goodwill**

85) Goodwill was considered in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where the House of Lords stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

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<sup>9</sup> Endorsed by the Daniel Alexander QC, sitting as the Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

86) I have already reviewed the evidence filed by the opponent earlier in this decision. Whilst I have found that the opponent has failed to demonstrate that it has sufficient use in order for the distinctive character of the earlier mark to be enhanced and that it has not shown that it has a reputation to support its section 5(3) claim, I am satisfied that the opponent has a protectable goodwill in its business operating under the sign 'MIDDLETON'. It clearly has an operating business which is distinguishable from competitors which has ongoing custom. This is supported by the fact that the opponent's MIDDLETON whiskey has won numerous awards and the volume of cases sold (around 100 9-litre cases per annum).

87) The opponent claims to have goodwill attached to the business under the sign MIDDLETON for sales of alcoholic beverages. This is a broad term and from the evidence it is clear that the sign is only used in connection with the sale of whiskey. There is no evidence of the sign being used in connection with any other goods. Therefore, I find that the opponent had a protectable goodwill, at the relevant date, in a business operating under the sign MIDDLETON, for whiskey.

### **Misrepresentation**

88) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in

*Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ;  
and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

89) In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, Kitchin LJ considered the role of the average consumer in the assessment of a likelihood of confusion. Kitchen L.J. concluded:

“... if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant proportion of the relevant public is likely to be confused such as to warrant the intervention of the court then it may properly find infringement.”

90) Although this was an infringement case, the principles apply equally under 5(2): see *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch). In *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, Lewinson L.J. had previously cast doubt on whether the test for misrepresentation for passing off purposes came to the same thing as the test for a likelihood of confusion under trade mark law. He pointed out that it is sufficient for passing off purposes that “*a substantial number*” of the relevant public are deceived, which might not mean that the average consumer is confused. However, in the light of the Court of Appeal's later judgment in *Comic Enterprises*, it seems doubtful whether the difference between the legal tests will (all other factors being equal) produce different outcomes. This is because they are both normative

tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

91) In order for a misrepresentation claim to succeed a substantial number of the opponent's customers or potential customers must be liable to be deceived by use of the contested mark. In the opponent's favour is that the signs (as discussed under the section 5(2)(b) comparison of marks) are highly similar. However, if the respective fields of activity differ then this is not fatal but it is an important consideration<sup>10</sup>.

92) I have found that the opponent's area of interest is 'whiskey' whereas the remaining applied for goods are, inter alia, hops extracts for manufacturing beer, beer wort, etc. As previously stated, these goods are generally intended for use in industry rather than for direct purchase by the final consumer which is different to the relevant consumer of whiskey. The relevant public is unlikely to consider that the respective goods originate from the same origin. In other words, I do not consider a substantial number of consumers are likely to be deceived into believing that the remaining applied for goods come from the same economic undertaking.

### **Section 5(4)(a) outcome**

93) The section 5(4)(a) of the Act claim fails.

### **OVERALL OUTCOME**

94) The opposition has partially succeeded and the application shall be refused registration for the following, subject to appeal:

*Class 32: Ginger beer; Beer; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Barley wine [Beer]; Craft beers; Malt beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer;*

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<sup>10</sup> *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J.

*De-alcoholized beer; Low alcohol beer; Low-alcohol beer; Ginger beer; Beer products; Beer; Beers; Beer-based cocktails; Wheat beer; Black beer [toasted-malt beer]; Black beer; Flavored beers; Flavored beer; Imitation beer; Non-alcoholic beer flavored beverages; Beer-based beverages; Barley wine [Beer]; Craft beers; Beers enriched with minerals; Malt beer; Coffee-flavored beer; Root beer; Non-alcoholic beer; Alcohol-free beers; De-alcoholised beer; De-alcoholized beer; Low alcohol beer; Low-alcohol beer.*

Class 33 in its entirety

95) The opposition has failed in respect of the following goods in Class 32: *Hops (Extracts of -) for making beer; Extracts of hops for making beer; Hop extracts for manufacturing beer; brewery products; Extracts of hops for making beer; Beer wort* and, subject to appeal, it shall proceed to registration for these goods.

## **COSTS**

96) The opponent has won more than it has lost and therefore it is entitled to a contribution towards its costs. In the circumstances I award the opponent the sum of £1200 as a contribution towards the cost of the proceedings. This sum takes into account that since the applicant did not file evidence or written submissions the opponent did not incur any costs in reviewing such materials. Therefore, the sum is calculated as follows:

Official fee	£200
Preparing a statement and considering the other side's statement	£300
Preparing evidence	£500
Written submissions	£200
<b>Total</b>	<b>£1200</b>

97) I therefore order Recognise Limited to pay Irish Distillers Limited the sum of £1200. The above 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 this 12<sup>th</sup> day of June 2018**

**Mark King**

**For the Registrar,**

**The Comptroller-General**