

O-416-11

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION No. 2550334  
BY ZELOOF LLP TO REGISTER A TRADE MARK  
IN CLASSES 16, 25, 32,  
33, 35, 36, 41 & 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 101023 BY CHARLES WELLS LIMITED**

## BACKGROUND

1. On 15 June 2010, The Zeloof Partnership applied to register **BLACK EAGLE BREWERY** as a trade mark for a range of goods and services in classes 16, 25, 32, 33, 35, 36, 41 and 43. Following examination, the application was accepted and published for opposition purposes on 2 July 2010. The application was subsequently assigned to Zeloof LLP. As nothing appears to turn on this assignment, I shall refer to the applicant as Zeloof LLP (“ZL”).

2. On 1 October 2010, Charles Wells Limited (“CW”) filed a notice of opposition. This consisted of a single ground based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). CW’s opposition is directed against the goods and services I have underlined below:

**Class 32:** Beer, ale, lager, stout, porter, shandy; mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; de-alcoholised drinks, non-alcoholic beers and wines.

**Class 33:** Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails

**Class 35:** Management of retail enterprises for others; retail services connected with food and drink; promotion and marketing services; advertising services; business management; business administration; office functions.

**Class 36:** Real estate sales and lettings; real estate management; real estate affairs.

**Class 41:** Education; providing of training; entertainment services; live shows; cultural events; art galleries; exhibitions; rental of facilities for the purpose of entertainment, sporting or cultural events.

**Class 43:** Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation; retirement home services; creche services.

On 3 October 2011, ZL filed a Form TM21 to request a change to the wording of its specification in class 33. Following amendment, the specification now reads:

**Class 33:** Alcoholic beverages; alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails; none of the aforementioned being whiskey or being primarily made from or primarily containing whiskey.

In these proceedings CW relies upon the following trade mark:

<b>Trade Mark</b>	<b>No.</b>	<b>Application date</b>	<b>Registration date</b>	<b>Goods and services</b>
EAGLE	CTM 2508463	19.12.2001	13.10.2004	<b>32</b> - Beer, ale, porter, brewed products.  <b>42</b> - Public house, bar, bistro, restaurant services.

3. In its Notice of opposition, CW indicates that its trade mark has been used upon all of the goods and services for which its stands registered, adding that it relies upon all of these goods and services for the purposes of these proceedings. CW states, inter alia:

“2. The mark applied for...is similar to the opponent’s earlier trade mark EAGLE, at least in that it reproduces the opponent’s trade mark as its only distinctive and non-descriptive element.

3. Furthermore, the application relates to goods and services that are identical with or similar to the goods and services of the opponent’s trade mark as follows:

i)The goods of the application in class 32 and 33 are all identical with or similar to [CW’s goods] at least in that they are goods of the same nature, with the same uses, customers and trade channels and are complementary to or in competition with each other. They are furthermore similar to [CW’s services], at least in that they are the subject of those services.

ii) The [opposed services in class 35] are similar to [CW’s goods] at least insofar as those goods are the subject of those services. They are furthermore similar to [CW’s services] at least in that [CW’s services] involve the retail sale of food and drink.

iii) The [opposed services in class 36] are similar to [CW’s services] at least insofar as the aforesaid services of the application relate to [CW’s services].

iv) The [opposed services in class 41] are similar to [CW’s services] at least insofar as the former services of the application relate to education or training for the provision of [CW’s services] or to entertainment services, live shows, cultural events or rental of facilities for the purpose of entertainment or cultural events, all of which are at least complementary to or in competition with [CW’s services].

v) The [opposed services in class 43] are identical with or at least similar to [CW’s services]. They are furthermore similar to [CW’s goods] at least insofar as [CW’s goods] are the subject of the aforesaid services of the application.

4. In all of the above circumstances the public is likely to attribute the origin of the goods and services covered by the application to the opponent.”

4. On 7 December 2010, ZL filed a counterstatement in which it notes that the registration upon which CW relies in these proceedings is subject to proof of use. Box 5 of the counterstatement reads:

“Do you want the opponent to provide proof of use?”

Having answered “Yes” to box 5, I note that in response to the following question which appeared in box 6 of the counterstatement:

“If you answered “yes” to question five, please state for which goods and services you require proof”,

ZL said:

“All goods in community trade mark registration 2508463”.

It went on to say:

“2. The applicant believes that the opponent has not put its CTM registration to genuine use in the form in which the mark is registered and requests the opponent provides proof of use, prior to the publication date of the mark as registered.”

5. In relation to the competing trade marks ZL said:

“3. The applicant denies that the application for BLACK EAGLE BREWERY is similar to the opponent’s registration for EAGLE. The marks must be compared in their entirety and elements of a mark cannot be ignored for the purposes of claiming similarity between the marks. The marks differ visually, aurally and conceptually to the extent that there is no likelihood of confusion, which includes a likelihood of association, on the part of the relevant purchasing public.”

6. In relation to the competing goods and services ZL said:

“4. The applicant denies that all of the goods in classes 32 and 33 of the application are identical or similar to the goods and services in the opponent’s registration. The applicant admits that, “Beer, ale, lager, stout, porter, shandy” within class 32 and “alcoholic beverages” as a whole in class 33 are similar or identical to the goods and services in the opponent’s registration. None of the other goods in classes 32 and 33 of the application are similar to the goods and services in the opponent’s registration.

5. The applicant admits that “retail services connected with drink” in class 35 insofar as they relate to “beer, ale, porter and brewed products” in the application are similar to the goods and services in the opponent’s registration. The applicant denies that “retail services connected with food and drink” insofar as they do not relate to “beer, ale, porter and brewed products” are similar to the goods and services in the opponent’s registration.

6. The applicant denies that [the opposed services in class 36] are similar to the services in the opponent’s registration.

7. The applicant denies that the services in class 41 in the application are similar to the services in the opponent’s registration.

8. The applicant admits that “Services for providing food and drink; restaurant, bar and catering services; booking and reservation services for restaurants” are similar to the goods and services in the opponent’s registration. The applicant denies that “temporary accommodation; provision of holiday accommodation; and “booking and reservation services for holiday accommodation” are similar to the goods and services in the opponent’s registration.”

7. Only CW filed evidence; it also filed written submissions at the evidence-in-chief stage of the proceedings. While neither party asked to be heard, both filed written submissions in lieu of attendance at a hearing; I will refer to these various submissions as necessary below.

## **EVIDENCE**

8. CW’s evidence consists of a witness statement from Nigel McNally of Wells and Young’s Brewing Company Limited (“W&Y”) accompanied by 15 exhibits. Mr McNally is, inter alia, a Director at CW, a position he has held since November 1996. The main facts emerging from Mr McNally’s statement are, in my view, as follows:

- From the early 1960s until 2006 CW continuously used the trade mark EAGLE in the United Kingdom and elsewhere in Europe in relation to beer brewed in its Eagle Brewery and, together with its subsidiary company Eagle Inns Company Limited (which changed its name to Charles Wells Pub Company Limited on 27 October 2006), in relation to public house, bar, bistro and restaurant services;
- Since 2006 CW has licensed its subsidiary company W&Y to use the trade mark EAGLE, together with other registered trade marks of CW (including CTM registration No. 2592913 WELLS) and from 2006 to the present W&Y has continuously used those marks with the consent of CW in the European Community, including throughout the United Kingdom, Spain and Italy, in relation to the goods and services for which they are registered;
- Exhibit NM01 consists of the following:

Extracts downloaded on 24 September 2010 from web.archive.org of pages taken from www.wellsandyoungs.co.uk showing how those pages looked on 29 November 2006 and 22 August 2008. The pages are for the most part identical and include, inter alia, the following text:

**“Wells and Young’s Beers in Focus**

The Wells and Young’s Brewing Company Ltd brews and distributes some of the UK’s favourite ale brands and some of the world’s most famous lager beers including:”

Below this text appears, inter alia, the following:



Mr McNally states that the EAGLE trade mark has been used by W&Y on their website continuously between the dates mentioned and since then at least until July 2010 (i.e. the date ZL’s trade mark was published);

An extract downloaded on the same date from the same web archive website mentioned above consists of a page taken from www.eaglebitter.co.uk as it appeared on 18 September 2007. The trade mark shown above is to be found at the top of the page accompanied by, inter alia, the following text:

**“Wells Eagle IPA”**

And:

**“Brand Background**

A complex finish of bitter hops, nuts and citrus fruits.

Wells Eagle IPA is a long standing favourite within large areas of the Midlands, East Anglia and the northern Home Counties and the brand is now emulating the outstanding success of its fellow brand, Wells Bombardier.

Well's Eagle IPA's success is based upon its pronounced citrus hop flavour and a lasting dry-bitter finish-a taste profile usually associated with bitters of a higher ABV.

Well's Eagle IPA remains synonymous with its heartland through support of sports and other clubs, as well as backing the Eagle Aid charitable trust fund."

Mr McNally explains that the trade mark EAGLE has been used on this website continuously since at least 2001 to the present;

Further extracts (downloaded on the same date and from the same web archive website) of pages taken from www.charleswells.co.uk showing how those pages looked on 28 December 2007, 14 January 2008 and 19 April 2008 are provided. The trade mark appears in the form shown above; it also appears in the following forms:



Mr McNally explains that the trade mark EAGLE has been used on this website continuously since at least 1999 to the present;

- Exhibit NM02 consists of what Mr McNally explains is a summary taken from the records of Charles Wells Pub Company Limited, showing the quantities of EAGLE beer supplied to 998 public houses in the United Kingdom between 2005 and 2010 which in Brewer's Barrels (one of which is equivalent to 288 pints) was as follows:

Year	Barrels
2005	9862.9
2006	9137.3
2007	7776.2
2008	6915.4
2009	6132.1
2010 (to September 2010)	5589.6

- Exhibit NM03 consists of copies of invoices (all of which are on the headed paper of CW) sent to four public houses namely: The Wheatsheaf, Enfield, Middlesex (dated 23 October 2006, 1 June 2007, 16 June 2008, 13 July 2009 and 22 February 2010), The Chequers, Hinkley, Leicestershire (dated 22 November 2006, 22 May 2007, 3 June 2008, 9 July 2009 and 11 February 2010), The Banbury Cross, Banbury, Oxfordshire (dated 8 November 2006, 28 June 2007, 4 June 2008, 15 July 2009 and 24 February 2010) and The Golden Crane, Upminster, Essex (dated 1 April 2008, 11 May 2009 and 8 March 2010). The product is described in various ways but the description always includes, inter alia, the words Wells Eagle Bitter;

- Exhibit NM04 consists of what Mr McNally describes as:

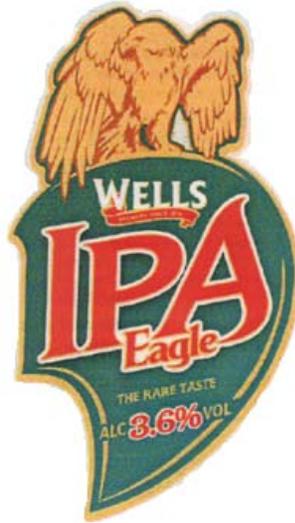
“Charts from the records of W&Y which were produced by the independent market research company The Nielsen Company and (following the transfer of ontrade research to CGA Strategy Limited) by CGA Strategy Limited, and which show the market share of the opponent’s EAGLE ale in the United Kingdom between 2005 and 2010.”

The two pages provided are entitled: “Eagle % volume share of standard ale” and “Eagle % volume share of on trade (Anglia) standard ale”, respectively. The first page shows a high of between 0.34% and 0.35% in September/November 2004 and a low of 0.31% in March 2009 (no figures are provided from November 2006 to September 2007). The second page shows a high of somewhere between 5% and 6% in September/November 2004 and a low of between 4% and 5% in July September 2008 (once again no figures are provided from November 2006 to September 2007);

- Exhibit NM05 consists of invoices issued by W&Y to H.I.T.S.E.I.N. SL of Gerona, Spain (dated 15 May 2008), Bruno Mosca C.S.R.L of Bolzano, Italy (dated 25 November 2009 and 11 February 2010), Da Pian SRL of Ponzano Veneto, Italy (dated 4 December 2009) and Mario Confalonieri di Alessandro e Valerio Confalonieri & C of Milan, Italy (dated 9 December 2009, 5 February 2010 and 24 March 2010), all of which contain, inter alia, references to EAGLE and which Mr McNally explains was “in relation to the supply of EAGLE beer to those parties...”;
- Exhibit NM06 consists of an extract from a presentation entitled: “Project Sons and Daughters: Category Management and NPD Research” prepared for CW by Adsearch Limited in April 2006. The second page under the heading “11. New Product Development” contains, inter alia, the following quotation:

“I’ve had a lot of Bombardier recently. They have an all purpose beer called Eagle and Banana Bread Beer...”

- Exhibit NM07 consists of extracts taken from magazines published by Charles Wells Pub Company Limited and distributed to what Mr McNally describes as 250 “Charles Wells” pubs. The first is an extract taken from the Summer 2007 edition of DRIVE which Mr McNally notes contains references to the top 25 stockists of, inter alia, Wells Eagle Cask together with what he describes as “promotion of public house services” through the Eagle Pub Quiz Challenge. The second extract is from the Spring 2008 edition of the same publication, which Mr McNally notes contains an offer promoting Wells Eagle IPA and related promotional merchandise (i.e. t-shirts bearing, inter alia, the words Wells Eagle). The third extract, also from DRIVE, is from Winter 2008 and contains the following: “Stock Wells Eagle IPA in Cask or Keg and receive a case of Branded Pint Glasses FREE”. In this magazine the trade mark appears in the following form:



The fourth and final extract is from the Spring/Summer 2010 edition of “Drive Your Profit” which contains the following: “Wells Eagle IPA and Carling have teamed up to create a kit to support outlets that want to build sales and profit.”

- Exhibit NM08 consists of what Mr McNally describes as:

“Extracts from the records of W&Y showing inventory movements of EAGLE beer at their warehouse between 7 November 2006 and 3 February 2009.”

Mr McNally notes that the extracts total some 16,275 firkins (a firkin consisting of 72 pints);

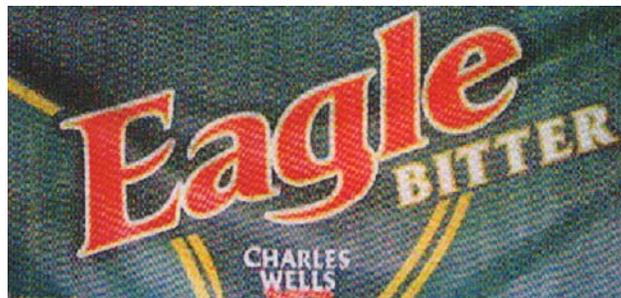
- Exhibit NM09 consists of examples of point of sale and promotional materials used continuously between April 2005 and July 2010 in the United Kingdom to promote beer. All of the materials provided contain the words Wells Eagle either alone, accompanied by the words “the rare taste”, the device of an eagle, or with all three together. Two images show the words used in the following form:



- Exhibit NM10 consists of what Mr McNally describes as “advertisements and sponsorship materials”. The first page consists of a sign displayed at Bedford Station between 2005 and October 2006. The sign is as follows:



Below the sign the following appears: “Home of Wells Eagle IPA, [www.eaglebitter.co.uk](http://www.eaglebitter.co.uk).” The second and third pages consist of photographs taken at Bedford Rugby Football Club of signs displayed at that venue continuously between 2005 and August 2010. The first page contains a photograph of a sign on which there appears an image of a pint of beer accompanied by the device of an eagle and the words Eagle and Bitter, on the right hand side of the sign the following appears:



The second page shows a ticket collection area to the left of which appears an image of a glass of beer bearing the words Wells Eagle IPA” above which the following appears on three separate lines: “Wells Eagle IPA, SUPPORTING THE “BLUES” and [www.wellseagleipa.co.uk](http://www.wellseagleipa.co.uk)”.

- Exhibit NM11 consists of what Mr McNally describes as a UK sales presenter used continuously between June 2007 and July 2010 and an export sales presenter used continuously between 2005 and 2008. I note that both presenters contain the words Wells Eagle either alone or accompanied by some or all of the other elements mentioned earlier;
- Exhibit NW12 consists of a photograph of what Mr McNally describes as “an EAGLE illuminated bar sign” which he explains has been used continuously in Italy between no later than 2005 and 2008. The bar sign contains the name Charles Wells below which appears, inter alia, the word EAGLE and the device of an eagle;
- Exhibit NM13 consists of a photograph of a can which Mr McNally explains has been used continuously in the European Community between no later than 2005 and 2008. The can looks like this:



- Exhibit NM14 consists of an extract taken from the programme of the Great British Beer Festival held at Earls Court, London in August 2009. Under the name Wells & Youngs appears, inter alia, Wells Eagle IPA 3.6%;

In paragraph 7 of his statement Mr McNally says:

“The word BLACK of the mark applied for is unlikely to distinguish it from the opponent’s mark EAGLE, especially in relation to beer or wine related services because it not only merely describes a colour but is furthermore a term commonly used to designate particular dark types of beer and wine.”

- Exhibit NM15 consists of pages downloaded on 6 August 2010 from [www.information-britain.co.uk](http://www.information-britain.co.uk), [www.zeitgeistbeer.com](http://www.zeitgeistbeer.com), [www.austrianbeer.co.uk](http://www.austrianbeer.co.uk) and [www.frenchentree.com](http://www.frenchentree.com). The websites mentioned refer to: black beer, black lager and black wine.

9. That concludes my summary of the evidence filed in these proceedings to the extent that I consider it necessary.

## **DECISION**

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

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

(a)....

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

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

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

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

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

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

12. In these proceedings CW is relying upon the trade mark shown in paragraph 2 above which constitutes an earlier trade mark under the above provisions. Given the interplay between the date on which ZL’s application was published i.e. 2 July 2010 and the date on which CW’s trade mark completed its registration procedure i.e. 13 October 2004, CW’s registration is subject to proof of use, as per The Trade Marks (Proof of Use, etc) Regulations 2004 the relevant sections of which read as follows:

**“6A Raising of relative grounds in opposition proceedings in case of non-use**

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1),(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a Community trade mark, any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

13. Earlier in this decision (and reproduced again here for ease of reference) I noted:

“Box 5 of the counterstatement reads:

“Do you want the opponent to provide proof of use?”

Having answered “yes” to box 5, I note that in response to the following question which appeared in box 6 of the counterstatement:

“If you answered “yes” to question five, please state for which goods and services you require proof”,

ZL said:

“All goods in community trade mark registration 2508463”.

It went on to say:

“2. The applicant believes that the opponent has not put its CTM registration to genuine use in the form in which the mark is registered and requests the opponent provides proof of use, prior to the publication date of the mark as registered.”

14. In its submissions dated 15 August 2011 CW said, inter alia:

“3. The applicant requested proof of use of the opponent’s mark in relation to “all goods in Community trade mark registration No. 2508463” but has neither denied

use nor requested proof of use of the opponent's mark in relation to the services for which it is registered.

4. However the opponent has filed proof of use of the opponent's mark in relation to both the goods and the services for which it is registered...

5. It is submitted that in the above circumstances the applicant (sic) was not obliged to file proof of use insofar as it relates to the services of the opponent's mark and that the grounds of the opposition should be considered in relation to the services of the opponent's mark irrespective of whether or not the proof of use filed is found to be adequate."

15. I note that in response to box 1 of the Notice of opposition which reads:

"What goods or services covered by the earlier trade mark are relied upon for the grounds stated above?"

CW ticked the first of the options provided which reads: "All".

16. As CW's earlier trade mark is registered in classes 32 and 42, it is clear that for the purposes of these proceedings CW are relying upon both the goods and services contained in its earlier trade mark. The wording entered into box 6 of the counterstatement by ZL i.e. "All goods..." is, in my view, equally clear. It only required CW to provide proof of use in relation to the goods and not the services for which its earlier trade mark is registered. The consequence of that conclusion is that in terms of proof of use, I need only assess CW's evidence in relation to the goods in class 32.

### **Proof of use**

17. In reaching a conclusion on this point, I must apply the same factors as I would if I were determining an application for revocation based on grounds of non-use; the relevant period for present purposes is the five year period ending with the date of publication of ZL's application for registration i.e. 3 July 2005 to 2 July 2010.

18. The leading authorities on the principles to be applied when determining whether there has been genuine use of a trade mark are *Ansul BV v Ajax Brandbeveiliging BV* [2003] R.P.C. 40 and *Laboratoire de la Mer Trade Mark* [2006] F.S.R. 5. From these cases I derive the following principles:

- genuine use entails use that is not merely token. It must also be consistent with the essential function of a trade mark, that is to say to guarantee the identity of the origin of goods or services to consumers or end users (*Ansul*, paragraph 36);

- the use must be 'on the market' and not just internal to the undertaking concerned (*Ansul*, paragraph 37);

- it must be with a view to creating or preserving an outlet for the goods or services (*Ansul*, paragraph 37);
- the use must relate to goods or services already marketed or about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns (*Ansul*, paragraph 37);
- all the facts and circumstances relevant to determining whether the commercial exploitation of the mark is real must be taken into account (*Ansul*, paragraph 38);
- the assessment must have regard to the nature of the goods or services, the characteristics of the market concerned and the scale and frequency of use (*Ansul*, paragraph 39);
- but the use need not be quantitatively significant for it to be deemed genuine (*Ansul*, paragraph 39);
- an act of importation could constitute putting goods on the market (*Laboratoire de la Mer*, paragraph 25 referring to the earlier reasoned order of the ECJ);
- there is no requirement that the mark must have come to the attention of the end user or consumer (*Laboratoire de la Mer*, paragraphs 32 and 48);
- what matters are the objective circumstances of each case and not just what the proprietor planned to do (*Laboratoire de la Mer*, paragraph 34);
- the need to show that the use is sufficient to create or preserve a market share should not be construed as imposing a requirement that a significant market share has to be achieved (*Laboratoire de la Mer*, paragraph 44).

19. In addition, I will keep in mind the guidance in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd* [2003] RPC 32 in relation to determining what constitutes a fair specification, namely:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the Premier Brands case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for "motor vehicles" only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under

s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to "dig deeper". But the crucial question is--how deep?

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox's Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox's Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court's task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use."

20. The comments of Mr Justice Jacob (as he then was) in *Animal Trade Mark* [2004] FSR 19 are also relevant and read:

"20 The reason for bringing the public perception in this way is because it is the public which uses and relies upon trade marks. I do not think there is anything technical about this: the consumer is not expected to think in a pernicky way because the average consumer does not do so. In coming to a fair description the notional average consumer must, I think, be taken to know the purpose of the description. Otherwise they might choose something too narrow or too wide. Thus, for instance, if there has only been use for threeholed razor blades imported from Venezuela (Mr T.A. Blanco White's brilliant and memorable example of a narrow specification) "three-holed razor blades imported from Venezuela" is an accurate description of the goods. But it is not one which an average consumer would pick for trade mark purposes. He would surely say "razor blades" or just "razors". Thus the "fair description" is one which would be given in the context of trade mark protection. So one must assume that the average consumer is told that the mark will get absolute protection ("the umbra") for use of the identical mark for any goods coming within his description and protection depending on confusability for a similar mark or the same mark on similar goods ("the penumbra"). A lot depends on the nature of the goods--are they specialist or of a more general, everyday nature? Has there been use for

just one specific item or for a range of goods? Are the goods on the High Street? And so on. The whole exercise consists in the end of forming a value judgment as to the appropriate specification having regard to the use which has been made.”

21. Finally, the comments of the Court of First Instance (now the General Court) in *Reckitt Benckiser (España), SL v OHIM*, Case T- 126/03 are also relevant where it held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or subcategories to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.

46 Although the principle of partial use operates to ensure that trade marks which have not been used for a given category of goods are not rendered unavailable, it must not, however, result in the proprietor of the earlier trade mark being stripped of all protection for goods which, although not strictly identical to those in respect of which he has succeeded in proving genuine use, are not in essence different from them and belong to a single group which cannot be divided other than in an arbitrary manner. The Court observes in that regard that in practice it is impossible for the proprietor of a trade mark to prove that the mark has been used for all conceivable variations of the goods concerned by the registration. Consequently, the concept of ‘part of the goods or services’ cannot be taken to mean all the commercial variations of similar goods or services but merely goods or services which are sufficiently distinct to constitute coherent categories or sub-categories.”

22. In its submissions ZL said:

“5. The applicant does not admit that the evidence of use provided by the opponent constitutes use as required by section 6A or genuine reasons for non-use as required by sub-section 6A(3)(b) for all the products in the class 32 specification. The evidence provided by the applicant shows the mark, when affixed to the packaging or in close proximity to the product, to be used with the mark WELLS and other distinctive matter. This appears contrary to section 6A(4)(a).

6. The applicant's class 32 specification includes the general term "brewed products" which can constitute a vast array of different products within class 32. If the Hearing Officer deems the evidence to be sufficient to prove use of the mark the applicant contests that it is not sufficient for the entire class 32 specification. At most the goods that should be considered are ale and bitter as this is the extent of the goods on which the mark has been used based on the opponent's evidence."

23. In *Pago International GmbH v Tirol Milch registrierte Genossenschaft mbH* - case C-302/07 the European Court of Justice (now the CJEU) considered the requirements for establishing a reputation in respect of a Community trade mark. It said:

"30 The answer to the first question referred is therefore that Article 9(1)(c) of the regulation must be interpreted as meaning that, in order to benefit from the protection afforded in that provision, a Community trade mark must be known by a significant part of the public concerned by the products or services covered by that trade mark, in a substantial part of the territory of the Community, and that, in view of the facts of the main proceedings, the territory of the Member State in question may be considered to constitute a substantial part of the territory of the Community."

24. It would be anomalous if reputation in one member state were enough to satisfy the requirements of Article 9(1)(c) but use in one member state could not satisfy the use requirement.

25. While ZL takes issue with the form in which CW have used the word EAGLE and the scope of the goods upon which it has been used, it does not appear to dispute that in the relevant period i.e. 3 July 2005 to 2 July 2010 CW's use was anything other than genuine; that, I think, was a sensible approach. When considered as a totality, CW's evidence clearly demonstrates that in the relevant period it made genuine use of the word EAGLE albeit accompanied by other elements (a point to which I will return below) in (at least) the United Kingdom.

#### **Section 6A(4) – use in a differing form**

26. The questions one must ask oneself when deciding this issue are well established. In his decisions in *Nirvana* and *Remus Trade Marks* (BL O/262/06 and O/061/08), Mr Richard Arnold QC (as he then was) acting as the Appointed Person considered the various case law, and having done so, expressed the test in the following way:

"33. .... The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter's distinctive character. As can be

seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

27. Insofar as question 1 above is concerned, CW have used the word EAGLE in a variety of different ways i.e. in addition to the use of the word EAGLE presented in normal typeface in WELLS EAGLE IPA – THE RARE TASTE, the word EAGLE has been used in the various forms shown above.

28. As to the first part of the second question, as CW’s earlier trade consists solely of the word EAGLE presented in upper case, the distinctive character of CW’s registration must lie in the totality. As to the second part of the second question, I now turn to consider the points of difference between the form in which CW’s trade mark is registered and the form in which it has been used. The evidence shows that the word EAGLE has been used in both upper and title case; were this the only difference, I would have no hesitation concluding that such use would not affect the distinctive character of the trade mark as registered. However, as ZL point out, the more obvious point of difference is that on the vast majority of occasions the word EAGLE is preceded by the surname WELLS whilst on other occasions it may be accompanied by the name Charles Wells and/or the device of an eagle and/or the letters “IPA” (meaning Indian Pale Ale) and/or the words “Smooth Draught Bitter” and/or the words “the rare taste”. Notwithstanding the above, the word EAGLE is for the most part (and particularly in its various logo forms) presented in a significantly larger typeface than the words that accompany it.

29. I note that in case T-29/04 *Castellblanch, SA v OHIM* the CFI (now the GC) had to consider whether in the context of an opposition to an application filed in respect of “wines and sparkling waters” the use that had been made by the opponent of a trade mark which included the word CRISTAL was sufficient to constitute use of the word CRISTAL registered alone. The GC said:

“32. The Court of First Instance points out, first, following the example of OHIM, that the applicant does not contest the place, time or extent of use of the earlier mark but only the nature of that use.

33. In the contested decision the Board of Appeal found that there is no precept in the Community trade mark system that obliges the opponent to prove the use of his earlier mark on its own, independently of any other mark. According to the Board of Appeal, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company, as is the case particularly in the context of the automobile and wine industries.

34. That approach must be followed. The situation is not that the intervener's mark is used under a form different to the one under which it was registered, but that several signs are used simultaneously without altering the distinctive character of the registered sign. As OHIM rightly pointed out, in the context of the labelling of wine products joint affixing of separate marks or indications on the same product, in particular the name of the winery and the name of the product, is a common commercial practice.

35. In the present case the mark CRISTAL appears clearly four times on the neck of the bottle marketed by the intervener and twice on the main label, accompanied by the symbol ®. On the neck that mark is separate from the other elements. In addition, the mark CRISTAL appears alone on the boxes in which bottles of the mark CRISTAL are marketed. Equally, on the invoices produced by the intervener reference is made to the term 'cristal' with the mention '1990 coffret'. It should be noted that the mark CRISTAL thus identifies the product marketed by the intervener.

36. As regards the mention 'Louis Roederer' on the main label, it merely indicates the name of the manufacturer's company, which may provide a direct link between one or more product lines and a specific undertaking. The same reasoning applies to the group of letters 'lr' which represents the initials of the intervener's name. As pointed out by OHIM, joint use of those elements on the same bottle does not undermine the function of the mark CRISTAL as a means of identifying the products at issue.

37. Furthermore, OHIM's finding that the use of the word mark together with the geographical indication 'Champagne' cannot be considered to be an addition capable of altering the distinctive character of the trade mark when used for champagne must be endorsed. In the wine sector the consumer is often particularly interested in the precise geographical origin of the product and the identity of the wine producer, since the reputation of such products often depends on whether the wine is produced in a certain geographical region by a certain winery. "

30. Although that was a decision reached in the context of "wines and sparkling waters", the conclusions reached are, I think, equally applicable to the goods at issue in these proceedings. In my view, this is not a case of CW trying to prove that its trade mark has been used in a different form to which it is registered which in turn does not alter its distinctive character, rather it is a case (to use the GC's words) of a situation where:

"several signs are used simultaneously without altering the distinctive character of the registered sign."

31. In this regard the average consumer would, in my view, treat the inclusion of the word WELLS or name Charles Wells as (once again borrowing from the GC):

“the name of the manufacturer’s company, which may provide a direct link between one or more product lines and a specific undertaking.”

32. As to the device of an eagle which appears in a number of the variations used, this would once again be seen as one of several signs being used by CW simultaneously. Finally, as to the remaining elements which appear in the various forms used, the letters “IPA” and the words “Smooth Draught Bitter” would be seen by the average consumer as a description of the product on which the trade mark is used, and the words “the rare taste” would be seen as no more than a piece of advertising puffery of a type with which the average consumer would be very familiar and to which it would, in my view, accord no trade mark significance.

33. In short, I have concluded that CW does not need to rely upon section 6(A)(4) of the Act in these proceedings as the use provided demonstrates use of its EAGLE trade mark as one of a number of trade marks used together, the bringing together of which does not affect the distinctive character of its EAGLE trade mark in the form in which it stands registered.

34. Finally, I have to identify as a matter of fact the goods on which CW have actually used its EAGLE trade mark and, having reached a conclusion on that point, I must then go on and decide what, from the perspective of the average consumer of the goods, constitutes a fair specification. CW’s EAGLE trade mark stands registered in class 32 for:

“Beer, ale, porter, brewed products.”

35. I mentioned earlier that in its submissions ZL said that in the event that I found that CW’s use of its EAGLE trade mark was acceptable then:

“At most the goods that should be considered are ale and bitter as this is the extent of the goods on which the mark has been used based on the opponent’s evidence.”

36. CW’s evidence shows its EAGLE trade mark being used in relation to what it describes as either IPA (India Pale Ale) or draught bitter. In *West (T/A Eastenders) v Fuller Smith & Turner Plc* [2002] F.S.R. 55, Mr Christopher Floyd Q.C (as he then was) sitting as a deputy judge of the High Court had to decide whether use on bitter beer was sufficient to preserve a trade mark specification registered for beer at large. He said:

“61 Lager and bitter are different types of beer, commercially more different than red and white wine, but perhaps not as different as whiskey and gin. Although there was some evidence of so called “repertoire drinking”, by which is meant the practice of a drinking different alcoholic drinks on different occasions, I take the evidence as a whole as establishing that the two types of beer are commercially quite different. Beer drinkers in the main either drink lager or bitter, not both. There is little overlap of trade marks between those two classes. The class of

articles represented by “beer” has a number of significant sub-sets of which “bitter” is only one. Non-use is established in relation to the rest.

62 Accordingly I propose to revoke the mark except insofar as it extends to bitter.”

I note that the conclusion reached by Mr Floyd was endorsed by Pumfrey J on appeal – see [2003] FSR 44.

37. Although described in different ways, the goods on which CW has actually used its EAGLE trade mark can, in my view, and as ZL suggest, be fairly described as either bitter beer or ale. While I understand the term “porter” in CW’s registration refers to a heavy, dark-brown, strongly flavoured beer, adopting the logic applied by Mr Floyd to the instant proceedings (and in the absence of submissions to the contrary), it appears to me that porter is a commercially different product to bitter beer or ale. Finally, insofar as the term “brewed products” in CW’s specification is concerned, I agree with ZL that this would encompass a wide variety of goods beyond those upon which CW have actually used its EAGLE trade mark.

38. Bearing all these considerations in mind, the average consumer would, in my view, describe the goods upon which CW has used its EAGLE trade mark as either bitter beer or ale. For the reasons indicated above that, in my view, represents a fair specification (which is neither too broad nor too pernicky) and is the basis on which I intend to proceed.

### **Section 5(2)(b) – case law**

39. The leading authorities which guide me are from the CJEU (Court of Justice of the European Union): *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77, *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* C-334/05 P (LIMONCELLO). It is clear from these cases that:

(a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; *Sabel BV v Puma AG*,

(b) the matter must be judged through the eyes of the average consumer for the goods/services in question; *Sabel BV v Puma AG*, 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; *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel B.V.*,

- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; *Sabel BV v Puma AG*,
- (d) the visual, aural and conceptual similarities of the marks must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; *Sabel BV v Puma AG*,
- (e) 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; 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; *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*
- (f) it is only when all other components of a complex mark are negligible that it is permissible to make the comparison on the basis of the dominant element; *Shaker di L. Laudato & C. Sas v OHIM*.
- (g) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (h) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either per se or because of the use that has been made of it; *Sabel BV v Puma AG*,
- (i) in determining whether similarity between the goods or services covered by two trade marks is sufficient to give rise to the likelihood of confusion, the distinctive character and reputation of the earlier mark must be taken into account; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*,
- (j) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2); *Sabel BV v Puma AG*,
- (k) further, 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; *Marca Mode CV v Adidas AG and Adidas Benelux BV*,
- (l) but if the association between the marks causes the public to wrongly believe that the respective goods come from the same or economically linked undertakings, there is a likelihood of confusion within the meaning of the section; *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*.

## **The average consumer and the nature of the purchasing process**

40. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In its submissions CW said:

“15. The average consumer of the goods at issue (all of which are drinks) will be an ordinary member of the public who will be reasonably but not excessively circumspect in making their selection. In general the goods at issue are relatively low cost items and their purchase is not likely to be given a great deal of consideration. The same may be said of those services of the application, particularly those in classes 35 and 43 that relate to the sale or serving of drinks...”

41. In its submissions ZL said:

“8. Bitter and ale have become, over the last couple of decades, drinks for the more discerning consumer. It is now commonplace for modern pubs and bars to have only one or two bitters or ales available in contrast to numerous lagers both on tap and in bottles, if they sell any bitters or ales at all. Whilst it is unusual to ask the characteristics of the taste of a lager it is a regular occurrence for the customer to ask this about ale or bitter and for the publican/bar staff to provide it.

9. In light of this, the average consumer of ale or bitter is likely to take more time considering the purchase that they are going to make and to take account of the trade marks affixed to the packaging or beer pump. The average consumer is therefore likely to pay a moderately high level of attention to the purchase that they are making and therefore pay considerable attention to the trade marks used on the goods.

10. With the increase of large chains of pubs and bars has come an increase in customer awareness of the unique selling points of each of the different chains and the particular look and feel of their establishments. Consumers take more notice of the trade marks used on pubs and bars and the characteristics of a particular chain when deciding the type of experience they want. As such, the average consumer is likely to pay a moderately high level of attention to the trade marks identifying the origin of the services provided by the opponent.”

42. Turning first to the goods at issue in these proceedings, these are all beverages of one sort or another or syrups for making such beverages. The average consumer for such goods will be the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18.

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

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

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

45. Insofar as the opposed services in class 35 are concerned i.e. retail services connected with food and drink, the average consumer would once again be the public at large. The selection (whether conducted in the physical or virtual world) will, in my view, consist primarily of a visual act with the average consumer directing his mind to matters such as the opening hours, size and location of the retail premises (if the selection takes place in the real world), together with, for example, the range of goods stocked, the quality of the goods stocked and the retail establishment’s pricing policy. While the average consumer’s level of attention will be relatively low when selecting a retail establishment for a one off purchase (perhaps in an unfamiliar location), it is, in my view, likely to be somewhat higher when selecting a retail establishment for, for example, “the weekly shop”.

46. All of the opposed services in class 36 relate to the sale, rental or management of property, the average consumer for which would again be the public at large. In my

experience the average consumer is likely to encounter entities providing the opposed services on the street, in publications in printed form and on the web, indicating that the selection process is likely to be primarily a visual one. While the average consumer wishing to buy or rent a property is unlikely to be greatly concerned with the undertaking responsible for the sale or rental of a property, the situation is, in my view, quite different when considered from the perspective of the average consumer wishing to engage an undertaking to sell, rent or manage a property for them. In those circumstances where a number of competing considerations come into play, for example, cost, location, length of contract etc. one would expect the average consumer to pay a higher than average level of attention.

47. The average consumer for the opposed services in class 41 would again be the public at large. In my view the opposed services fall into three distinct categories i.e. (i) education and training, (ii) entertainment, live shows and cultural events, and (iii) rental of facilities for entertainment or cultural events. Once again the selection process for all three categories is likely, in my view, to consist primarily of a visual act with the average consumer consulting, for example, prospectuses and a range of publications in both printed form and on the web prior to making their selection.

48. Insofar as the first category of services is concerned, given the importance of ensuring that an educational/training provider offers, for example, a course containing the most suitable content, over the most suitable timescale in a suitable location and which (if appropriate) results in a suitable qualification, suggests that the average consumer is likely to pay quite a high level of attention when selecting such services. Insofar as the second category of services is concerned, the average consumer will wish to ensure that, for example, the content of the show or event is suitable as is the time, date, venue and cost of the show or event, all of which suggests that they will pay at least a reasonable level of attention when selecting such services. Finally, the third category of services all relate to the rental of facilities for entertainment or cultural events. When selecting such services the average consumer will need to be mindful of, amongst other things, the size, cost, suitability and availability of the venue concerned, all of which indicates that they will once again pay at least a reasonable level of attention when selecting such services.

49. As to the services in class 43, once again the average consumer is the public at large. Here again the opposed services fall into three categories i.e. (i) services for providing food and drink, restaurant, bar and catering services, (ii) temporary and holiday accommodation, and (iii) booking and reservation services for restaurants and holiday accommodation. As to how services for providing food and drink etc. will be selected by the average consumer, my own experience suggest that visual considerations (having encountered the trade mark on, for example, signage in the street, in advertisements in magazines, on posters and on the web) are most likely to dominate the selection process. The level of attention paid to the selection of, for example, a restaurant by the average consumer is likely, in my experience, to vary depending on the nature of the occasion for which the restaurant is being selected and is likely to range from minimal to reasonably high. While some or all of the following

considerations may play a part in the selection of restaurants in some circumstances e.g. the style of restaurant (Italian, French, Indian, Vegetarian), the restaurant's size, location, opening hours and the cost of the items on the menu, I doubt that the average consumer would display the same degree of care selecting a venue to have an impromptu cup of coffee. As the cost and importance of their selection increases, so will the degree of care displayed by the average consumer when selecting the services.

50. As to the second category of services i.e. temporary and holiday accommodation, once again the selection process is likely to be primarily a visual one, the average consumer having become aware of the trade mark in advertisements appearing in, for example, publications both in printed form and on the web. When selecting temporary accommodation the average consumer will again need to be mindful of the sort of factors I have identified above i.e. the size, cost, suitability and availability of the accommodation, all of which once again suggests they will pay at least a reasonable level of attention when selecting such services. That leaves booking and reservation services for restaurants and holiday accommodation, the selection of which would once again, in my view, be primarily a visual one, the average consumer having selected, for example, a suitable portal on the web. Given the nature of the factors in play I have identified above, I would once again expect the average consumer to pay at least a reasonable level of attention to the selection of these services.

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

51. CW does not oppose all of the goods and services in ZL's application. In its counterstatement ZL admits that:

(1) "beer", "ale", "lager", "stout", "porter" and "shandy" (in class 32) and "alcoholic beverages" at large (in class 33) are identical or similar to the goods and services in CW's registration;

(2) "retail services connected with drink" in class 35 are (insofar as they relate to "beer ale and porter and brewed products") similar to the goods and services in CW's registration;

and:

(3) "services for providing food and drink, restaurant, bar and catering services and booking and reservation services for restaurants" are similar to the goods and services in CW's registration.

ZL denies that there is any similarity between the competing goods and services which remain.

52. The goods and services to be compared including those goods and services for which ZL have unequivocally accepted that identity or similarity exists (shown below in bold), are as follows:

CW's goods (following the proof of use assessment in relation to class 32) and services	ZL's goods and services
<p><b>32:</b> Bitter beer, ale.</p> <p><b>42:</b> Public house, bar, bistro, restaurant services.</p>	<p><b>32: Beer, ale, lager, stout, porter, shandy;</b> mineral and aerated waters; non-alcoholic drinks; fruit drinks and fruit juices; syrups for making beverages; de-alcoholised drinks, non-alcoholic beers and wines.</p> <p><b>33: Alcoholic beverages;</b> alcoholic wines; spirits and liqueurs; alcopops; alcoholic cocktails; none of the aforementioned being whiskey or being primarily made from or primarily containing whiskey.</p> <p><b>35:</b> Retail services connected with food and drink.</p> <p><b>36:</b> Real estate sales and lettings; real estate management; real estate affairs.</p> <p><b>41:</b> Education; providing of training; entertainment services; live shows; cultural events; rental of facilities for the purpose of entertainment or cultural events.</p> <p><b>43: Services for providing food and drink;</b> temporary accommodation; <b>restaurant, bar and catering services;</b> provision of holiday accommodation; <b>booking and reservation services for restaurants</b> and holiday accommodation.</p>

53. The leading authorities on how to determine similarity between goods and services are considered to be *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* [1999] R.P.C. 117 and *British Sugar Plc v James Robertson & Sons Ltd (Treat)* [1996] R.P.C. 281. In the first of these cases the CJEU accepted that all relevant factors should be taken into account including the nature of the goods/services, their intended purpose, their method of use and whether they are in competition with each other or are complementary. The criteria identified in the *Treat* case 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.

54. In reaching a conclusion I will also keep in mind the decision of the GC in *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05 i.e.

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

55. In relation to complementary goods and services the comments of the Court of First Instance (now the General Court) in *Boston Scientific Ltd v OHIM* case T-325/06 i.e.

“82 It is true that goods are complementary if there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking (see, to that effect, Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 *P Rossi v OHIM* [2006] ECR I-7057; Case T-364/05 *Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL)* [2007] ECR II-757, paragraph 94; and Case T-443/05 *El Corte Inglés v OHIM – Bolaños Sabri (PiraNAM diseño original Juan Bolaños)* [2007] ECR I-0000, paragraph 48).”

56. And finally, insofar as the comparison of services are concerned, the comments of Jacob J in *Avnet Incorporated v Isoact Limited* - [1998] FSR 16 are relevant i.e.:

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

## **Classes 32 and 33**

57. In its submissions CW said:

“7. There is a high level of similarity between non-alcoholic beers and beer. These goods share the same trade channels, with brewers producing both alcoholic and non-alcoholic versions and making these available via the same retail outlets, bars, pubs, restaurants and other locations where beer is sold to the public. Their nature is at least strongly similar as they are both beer products and they are intended to be drunk by the consumer in similar situations. The non-alcoholic drinks and de-alcoholised drinks of the application include beers and are thus, at least, in this respect also highly similar to beer.

8. The similarity of fruit drinks and fruit juices to [CW’s goods] on the basis that they share the same trade channels, have the same purpose (liquid refreshment) and are intended to be drunk by the consumer in similar situations is further enhanced by the fact that many beers contain fruit and/or are fruit-flavoured and are promoted on the basis of this characteristic, meaning that they share a similar nature.

9. Furthermore, syrups for making beverages are complementary to or are in competition with beer, ale, porter, brewed products at least insofar as they are syrups for making those beverages.

10. Contrary to [ZL’s] denial, the alcoholic wines, spirits and liqueurs, alcopops, alcoholic cocktails of the application in class 33 are similar to [CW’s goods]. They are all alcoholic beverages for consumption and they are often made from the same ingredients (such as fruit and/or cereals), they are often sold in close proximity to each other in retail outlets and also appear side-by-side on drinks menus in restaurants and bars. They therefore share the same end consumer.

11. Furthermore, mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruit juices, de-alcoholised drinks, non-alcoholic beers and wines and alcoholic wines, spirits and liqueurs, alcopops, alcoholic cocktails are all commonly served in public house, bars, bistros and restaurants and are the subject of the public house, bar, bistro, restaurant services of [CW]. Contrary to [ZL’s] denial, all of these goods are thus clearly similar to the services of [CW]. This similarity arises for the same reason as does the similarity between the other goods of the application in class 32 and 33 and the services of [CW] that is admitted by [ZL].”

58. In its submissions ZL said:

“12. The following goods in class 32 are not similar to the goods on which [CW] has used its EAGLE mark:

Mineral and aerated waters, non-alcoholic drinks, fruit drinks and fruit juices, syrups for making beverages, de-alcoholised drinks (other than beer, ale, lager, stout, porter and shandy), non-alcoholic wines.

Whilst soft drinks may be sold in the same establishments as bitter and ale the method of sale is different. As noted above, consideration is given by the average consumer to the trade marks when purchasing ale or bitter in pubs, restaurants etc. whereas these types of establishments tend to sell soft drinks under the generic name such as orange juice without specifying the trade mark. Within supermarkets these products are on display in different aisles let alone on different shelves. These drinks are neither in competition with bitter and ale nor complementary to them.”

59. Broadly speaking all of the competing goods in classes 32 and 33 are beverages or syrups for making such beverages. Notwithstanding that following my proof of use assessment CW's goods in class 32 have been limited to “bitter beer, ale” (hereafter “CW's goods”) given the uses, users, nature and channels of trade of these goods they remain, in my view, either identical or highly similar to the “beer, ale, lager, stout, porter, shandy and non-alcoholic beer appearing in ZL's application in class 32. As for ZL's “syrups for making beverages”, the fact that these goods may be used to make CW's goods results, in my view, in them being similar to CW's goods to a reasonable degree.

60. Turning to the clash between CW's goods and “mineral and aerated water, non-alcoholic drinks, fruit drinks, and fruit juices” appearing in ZL's application, once again the users may be the same i.e. members of the general public over the age of 18. The goods at issue are all beverages that will normally be served cold and which will normally be consumed in long measures. They are goods that may be marketed in bottles, tins or from mass dispensers at a bar. Whilst CW's goods are the subject of a brewing process, the goods mentioned above are not; they differ in this respect. However, overall the goods have a similar, if not identical, nature. If one is thirsty bitter beer, ale, water or a soft drink can all be drunk to quench the thirst. All of the beverages could be drunk before, after or during a meal and all of the beverages could be purchased in a public house. All of the goods could have the same end use, to quench the thirst, or to give a pleasurable drinking experience. As the average consumer may choose either a bitter beer, ale, water or a soft drink to quench the thirst, there is a degree of competition between the competing goods. While I accept that in supermarkets and bars bitter beers and ales will be found in different areas to water and soft drinks, when considered overall, I consider there to be a reasonable degree of similarity between the competing goods.

61. That leaves “de-alcoholised drinks” and “non-alcoholic beers and wines” (I have already dealt with non-alcoholic beer in para. 59). That said, I note that in its written submissions (at paragraph 12) ZL appear to accept that de-alcoholised drinks (insofar as they relate to CW’s goods) and non-alcoholic beer constitute similar goods to those upon which CW has used its EAGLE trade mark. However, ZL do not accept that de-alcoholised drinks at large (other than those identified above) are similar to CW’s goods. As I understand it, the phrase “de-alcoholised drinks” means drinks from which the alcohol has been removed. Neither in its counterstatement nor in its written submissions do ZL explain why, in its view, de-alcoholised drinks (other than those which it accepts are similar) would not be similar to CW’s goods. Had ZL wished to proceed for only a sub-set of goods that fall within the general phrase de-alcoholised drinks it could have provided a limited specification for consideration; it did not. The average consumer for CW’s goods and de-alcoholised drinks will be the public at large over the age of 18. When one considers that the average consumer is likely to be the same, the similarity in the respective uses of CW’s goods and goods that would fall within the general phrase de-alcoholised drinks, the potential similarity in the nature of the drinks concerned and their channels of trade, it must, in my view, result in finding there to be at least a reasonable degree of similarity between them.

62. Insofar as class 33 is concerned, ZL accept that “alcoholic beverages” at large are identical or similar to CW’s goods and services, but deny that there is any similarity between the goods which remain and those of CW. ZL’s named goods in class 33 are wines, spirits and liqueurs, alcopops and alcoholic cocktails, albeit that none of these goods are whiskey or are primarily made from or primarily contain whiskey. The competing goods are all alcoholic beverages of one sort or another and will have the same average consumer i.e. the public at large over the age of 18. While CW’s goods will be the subject of a brewing process, wines are fermented and spirits and liqueurs distilled. In my experience, cocktails generally contain spirits, while alcopops can contain beer, wine or spirits to which (for example) a fruit juice may be added. Generally speaking, the competing beverages will be served cold but will be sold in differing measures. Unlike CW’s goods wines, spirits, liqueurs, alcopops and cocktails are not, in my experience, likely to be selected to quench the thirst, although all may be selected to provide an enjoyable drinking experience. Insofar as channels of trade are concerned, all of the goods will be sold in public houses, restaurants, bars etc. and will be stocked in the same general area of a supermarket, albeit on different shelves. Notwithstanding the differences I have identified above, overall I consider there to be a low to moderate degree of similarity between the competing goods.

63. In approaching the specifications which contain services, I will keep in mind the comments of Jacob J in *Avnet* mentioned above i.e. it is the core of the possible meanings that is important.

### **Class 35**

64. In its notice of opposition CW said:

“ii) The [opposed services in class 35] are similar to [CW’s goods] at least insofar as those goods are the subject of those services. They are furthermore similar to [CW’s services] at least in that [CW’s services] involve the retail sale of food and drink.”

65. In its submissions ZL said:

“13. Class 35 of the application includes “retail services connected with food” which [CW] incorrectly claims are similar to its services in class 42. Class 35 concerns services bringing together food and drink produced by others in order to enable consumers to conveniently purchase them from that retail establishment, be it a shop or supermarket or other form of retail outlet. [CW’s] class 42 services concern the preparation of food and drink where the applicable service is the “preparation” enabling the customer to consume it in [CW’s] establishment.”

66. In its counterstatement ZL admitted that “retail services connected with drink” are similar to CW’s goods and services (insofar as the retail services mentioned related to the named goods), but denied that retail services connected with other drinks and food were similar to CW’s goods and services. In *Oakley, Inc. v OHIM* – case T-116/06 the CFI (now the GC) held that:

“services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services”

were similar to goods in classes 18 and 25:

“having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale.”

67. For the reasons expressed in that decision, I similarly find that the “retail services connected with drink” (at large) in ZL’s application are similar to CW’s goods in class 32. In relation to “retail services connected with food” in ZL’s application, as CW’s registration does not specify any food items on which it can rely to create the link mentioned above in *Oakley*, it cannot succeed on this basis. While I accept that the average consumer of a retail service provided in, for example, a supermarket or corner store and the average consumer of a public house, bar, bistro or restaurant service may be the same i.e. the public at large, when one bears in mind the comments in *Avnet* the core meanings of the respective services i.e. the bringing together of a range of food items from which the average consumer may select and the provision of public house, bar, bistro and restaurant services are, when considered in the context of their intended purpose, channels of trade etc. different. In addition, the respective services are not in any meaningful way either competitive with one another nor are they (in terms of the

comments in *Boston Scientific*) complementary. If there is any similarity between the competing services, it must, in my view, be at a low level.

### **Class 36**

68. In its notice of opposition CW said:

“iii) The [opposed services in class 36] are similar to [CW’s services] at least insofar as the aforesaid services of the application relate to [CW’s services].”

69. In its submissions ZL said:

“14. [CW] also considers that [ZL’s services in class 36] are similar to its services in class 42. The uses, users and physical nature of [ZL’s] services in class 36 are completely different as are the respective trade channels through which they reach the market. The respective services are neither in competition or complementary and, as such, are in no way similar.”

70. All of ZL’s services in this class relate to real estate in one form or another. While at a very high level of generality the users of the competing services may be the same, the intended purpose of the competing services are clearly different. They are provided through different trade channels and are neither in competition with nor complementary to one another. Having applied the comments in *Avnet*, there appears to me to be no similarity between the core meanings of the competing services.

### **Class 41**

71. In its Notice of opposition CW said:

“iv) The [opposed services in class 41] are similar to [CW’s services] at least insofar as the former services of the application relate to education or training for the provision of [CW’s services] or to entertainment services, live shows, cultural events or rental of facilities for the purpose of entertainment or cultural events, all of which are at least complementary to or in competition with [CW’s services].”

72. In its counterstatement ZL said:

“7. The applicant denies that the services in class 41 in the application are similar to the services in the opponent’s registration.”

73. In its submissions ZL said:

“15. The comments in paragraph 14 also apply to “Education and providing of training” in class 41. [CW’s] services do not establish the criteria as set out in the [Treat] case to the extent that the services would be considered similar.”

74. In my view, ZL's services in this class fall into three categories: (i) education and providing of training, (2) entertainment services, live shows, cultural events, and (3) rental of facilities for the purpose of entertainment or cultural events. Although the users of all the competing services may once again be the same i.e. the public at large, insofar as the first category of services is concerned the intended purposes and trade channels of the competing services are clearly different and the services are neither competitive nor complementary to one another. As to the second category of services, while it is, in my experience, commonplace for entertainment services including live shows etc. to take place in the premises where CW's services are offered, the intended purposes of the competing services are different and once again they are neither competitive nor are they (in the sense outlined in *Boston Scientific*) complementary to one another. Finally, in relation to the third category of services, while the intended purposes of the competing services is different, as it is commonplace for the premises listed in CW's registration to hire out their facilities for a multitude of different events e.g. weddings, birthdays etc. I think there is an element of complementarity between the competing services, which in turns results in a reasonable degree of similarity between them.

### **Class 43**

75. In its submissions CW said:

“12. Contrary to [ZL's] denials, the temporary accommodation, provision of holiday accommodation services of the application are similar or identical to [CW's services] at least to the extent that public house, bar and restaurant services commonly involve the provision of temporary accommodation and/or holiday accommodation and furthermore temporary and/or holiday accommodation services commonly involve bar and restaurant services.”

76. In its counterstatement ZL admitted that “services for providing food and drink”, “restaurant, bar and catering services” and “booking and reservation services for restaurants” were similar to the “goods and services” in CW's registration. Clearly the services mentioned above are either identical or highly similar to CW's services in class 42. Insofar as the remaining services are concerned i.e. the provision of temporary accommodation and related booking services, CW argue that as it is commonplace for public houses and bars/restaurants to provide temporary accommodation the competing services should be considered identical or similar. While the uses of the competing services would be different, the users would be the same. In addition, I agree with paragraph 12 of CW's submission to the effect that “public house, bar and restaurant services commonly involve the provision of temporary accommodation and/or holiday accommodation.” While not all establishments of this type provide temporary accommodation, the practice of such establishments providing temporary accommodation is long established and leads me to conclude that the average consumer may consider the competing services to be complementary and as a consequence similar to at least a reasonable degree.

## Comparison of trade marks

77. The trade marks to be compared are: **EAGLE** v **BLACK EAGLE BREWERY**. The average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must identify what I consider to be the distinctive and dominant components of the respective trade marks and, with that conclusion in mind, I must then go on and compare the respective trade marks from the visual, aural and conceptual perspectives.

### Distinctive and dominant components

78. CW's trade mark consists of the word EAGLE presented in upper case. As no part of the trade mark is emphasised or highlighted in any way, its distinctiveness must lie in its totality. ZL's trade mark consists of the words BLACK EAGLE BREWERY. In its submissions CW said:

“3...It is submitted that the first element of the mark, BLACK describes a colour and is thus devoid of distinctive character at least in relation to all of the goods of the application. The average consumer is likely to consider the word BLACK in the context of the mark as being used as an adjective to describe the noun EAGLE. This is especially the case in the context of the goods and services of the application that relate to beers and wines because, as explained by Mr McNally in his witness statement, the term black is commonly used to designate particular types of these goods.

4. The word BREWERY is descriptive of any goods that might be produced in or sold by a brewery, including in particular all of the goods of the application that are identical with or similar to those of the opponent's [registration] as well as any services that might typically be provided by a brewery business, including in particular the services of the application that are the subject of the opposition.

5. In all of the above circumstances the dominant and only truly distinctive element of the mark applied for is the word EAGLE...”

79. In its submissions ZL said:

“18. The opponent has argued that the words BLACK and BREWERY in the application are devoid of distinctive character and should not, therefore, be considered as elements of the mark as the average consumer would consider them to be descriptive of the goods in the application. In this argument the opponent appears to be artificially separating each element of the mark in order to manufacture a similarity in the marks that does not exist. As stated in the *Shaker* decision, the mark must be considered as a whole and the comparison

must not be based on a single element of the composite mark. Each element should be considered in the context of the mark as a whole as to whether it is negligible. In BLACK EAGLE BREWERY none of the words are negligible as they all contribute to form a highly distinctive mark.”

80. ZL’s trade mark consists of three elements. As to the distinctiveness of these various elements, I note CW’s evidence and submissions to the effect that the word BLACK would be construed by the average consumer as a descriptive reference to a characteristic of beer and wine. However, as the words BLACK EAGLE refer to a known bird of prey, it is, in my view, far more likely that when considered in the context of the trade mark as a whole that the words BLACK EAGLE will “hang together” and will be understood by the average consumer in this manner. As far as I am aware, the words BLACK EAGLE have no descriptive meaning nor are they non-distinctive for the goods and services at issue in these proceedings; they are then both a distinctive, and, given their positioning at the first two words in ZL’s trade mark, a dominant element.

81. In its submissions CW argue that the word BREWERY is: “descriptive of any goods that might be produced in or sold by a brewery... as well as any services that might typically be provided by a brewery business.” The Oxford Dictionary of English 2010 defines BREWERY as: “a place where beer is made commercially”. Consequently, while I accept that when considered in the context of goods and services which are closely associated with brewers and the brewing industry such as beer, ale, lager, stout, porter, shandy, de-alcoholised drinks (which would include de-alcoholised beer) non-alcoholic beer and syrups for making such goods and services for providing food and drink, temporary accommodation, restaurant, bar and catering services, provision of holiday accommodation, booking and reservation services for restaurants and holiday accommodation (hereafter “the brewery goods and services”) that the word BREWERY would be descriptive and non-distinctive, I am less convinced that the word would be similarly descriptive or non-distinctive for the other goods in classes 32 and 33 or any of the other opposed services. In short, although the word BREWERY is not (given its position within the totality of ZL’s trade mark) a dominant element, it is, in relation to the majority of the opposed goods and services, in my view, a distinctive element. I shall approach the comparison with those conclusions in mind.

### **Visual similarity**

82. In its submissions ZL said:

“19. [ZL’s trade mark] is visually very different to [CW’s trade mark]. The mark in the application consists of three words whilst the opponent’s mark is a single word leading to a vast visual disparity between the marks. This is further enhanced by the difference in the number of letters within the marks which are 17 and 5 respectively. When considering marks which consist exclusively of words with no embellishment or distinctive devices the length of the marks are crucial in the perception of the average consumer. In this case the considerable

difference in the length of the marks means that the average consumer will not consider them to be confusingly similar.”

83. In relation to the brewery goods and services, the word BREWERY would not be a distinctive or dominant element of ZL’s trade mark and although it would not be overlooked by the average consumer, his attention is more likely, in my view, to focus on the BLACK EAGLE element of the trade mark. In those circumstances, there would, in my view, be a reasonable degree of visual similarity between the distinctive and dominant element of ZL’s trade mark and the EAGLE trade mark of CW. The presence of the word BREWERY in ZL’s trade mark when considered in the context of those goods and services where the word BREWERY would be a distinctive but not dominant element is likely, in my view, to reduce the degree of visual similarity to a relatively low level.

### **Aural similarity**

84. In its submissions ZL said:

“20. There is also a considerable aural dissimilarity between the marks. It is a general rule of thumb in trade mark law that, aurally, the beginning of a mark is more important than the ending. In the application both the beginning and the ending of the mark are different to the opponent’s mark with the only similarity being the word in the middle. There is also a considerable difference in the number of syllables with each mark. The mark BLACK EAGLE BREWERY consists of 6 syllables whereas the opponent’s mark EAGLE merely consists of 2. When considering the aural similarity the differences in syllables will create a significant difference in the mind of the average consumer.”

85. My comments in para. 83 above apply equally here i.e. in relation to the brewery goods and services there would be a reasonable degree of aural similarity, with this level of similarity reducing to a relatively low level in relation to the other opposed goods and services.

### **Conceptual similarity**

86. In its submissions ZL said:

“21. The marks are conceptually dissimilar. The opponent’s mark is an English dictionary word which will put the consumer in mind of a well known bird of prey. The applicant’s mark will bring to the consumer’s mind images of buildings and other infrastructure related to a brewery.”

87. I agree with ZL that the conceptual image CW’s trade mark will convey to the average consumer is one of a bird of prey. Insofar as ZL’s trade mark is concerned, my comments above are relevant. While I accept that ZL’s trade mark may convey the concept of a brewery, the fact remains that the brewery concerned is named BLACK

EAGLE. In relation to the brewery goods and services the average consumer is far more likely, in my view, to focus on the imagery created by the words BLACK EAGLE than on the word BREWERY. In those circumstances, the conceptual messages both parties' trade marks are likely to send to the average consumer would relate to birds of prey belonging to the same family, which in turn results, in my view, in a high degree of conceptual similarity between them. However, when considered in the context of the other opposed goods and services, I think the average consumer will have a different focus and in so doing it is likely to create in his mind the imagery ZL suggest i.e. one of brewery buildings, infrastructure etc. In those circumstances, the conceptual messages the respective trade marks are likely to send to the average consumer will differ.

### **Distinctive character of CW's earlier trade mark**

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

89. In its submissions CW said:

“14. It is submitted that the opponent's mark has strong distinctive character in relation to the goods and services for which it is registered, being conceptually abstract in relation to those goods and services.”

90. Whilst not in the category of an invented word, I agree with CW that as a word which is neither descriptive of nor non-distinctive for the goods and services for which it stands registered, CW's EAGLE trade mark is, absent use, possessed of a reasonably high degree of inherent distinctive character. When CW's evidence is considered as a totality, the use it has made of its EAGLE trade mark since 1960 will inevitably have built upon its inherent credentials, resulting, in my view, in CW's EAGLE trade mark possessing a high degree of acquired distinctiveness in relation to the goods upon which it has been used.

### **Likelihood of confusion**

91. In determining whether there is a likelihood of confusion, I need to bear a number of factors in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of

similarity between the respective goods and services and vice versa. It is also necessary for me to keep in mind the distinctive character of CW's earlier trade mark (as the more distinctive this trade mark is the greater the likelihood of confusion), the average consumer for the goods and services, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

92. Earlier in this decision I concluded that:

- the average consumer for all of the competing goods and services was a member of the general public, albeit on some occasions a member of the general public over the age of 18;
- that in relation to the goods in classes 32 and 33 the selection process was likely to be predominantly a visual one (although I accepted that aural consideration may be a factor), with the average consumer paying a reasonable level of attention to the selection of the goods;
- that in relation to the services in class 35, 36, 41 and 43, the selection process would again be primarily a visual one;
- in relation to class 35, the average consumer will display a low to moderate degree of attention to the selection of the services;
- in relation to the services in class 36, the average consumer will display a higher than average degree of attention to the selection of the services;
- in relation to the services in class 41 the average consumer will display quite a high level of attention to the selection of education and training services, and at least a reasonable level of attention when selecting services relating to entertainment, live shows, cultural events and rental of facilities for entertainment etc;
- in relation to the services in class 43, the average consumer's level of attention will vary from minimal to reasonably high in relation to the selection of services for providing food and drink, restaurant, bar and catering services, and at least a reasonable level of attention will be paid to the selection of temporary and holiday accommodation and the related booking services;
- beer, ale, lager, stout, porter, shandy, de-alcoholised drinks and non-alcoholic beer in ZL's application in class 32 were identical or highly similar to the goods upon which CW had used its EAGLE trade mark, and that the remainder of the goods in ZL's application in class 32 were similar to CW's goods to a reasonable degree;

- other than alcoholic beverages (at large) in class 33 (which ZL accept are similar to CW's goods and services), the remainder of ZL's goods in class 33 are similar to CW's goods to a low to moderate degree;
- while retail services connected with drink in class 35 of ZL's application are similar to CW's goods in class 32, if there is any similarity between retail services connected with food in ZL's application and CW's goods and services it must be at a low level;
- there is no similarity between ZL's services in class 36 and CW's goods and services;
- while there is no similarity between education and training and entertainment services, live shows and cultural events in class 41 of ZL's application and CW's goods and services, there is, a reasonable degree of similarity between CW's services and rental of facilities for entertainment or cultural events;
- services for providing food and drink", "restaurant, bar and catering services" and "booking and reservation services for restaurants" in class 43 of ZL's application were (as ZL admit) either identical or highly similar to CW's services in class 42 and that the remaining services in ZL's application in class 43 were similar to CW's services to at least a reasonable degree;
- that the distinctive character of CW's EAGLE trade mark lies in its totality;
- that the words BLACK EAGLE appearing in ZL's trade mark hang together and form a distinctive and dominant element of the trade mark;
- that while the word BREWERY would not be a distinctive element when considered in the context of the brewery goods and services it would be a distinctive (but not a dominant element) in relation to the other opposed goods and services;
- when considered in the context of the brewery goods and services there would be a reasonable degree of both visual and aural similarity between the competing trade marks, but only a relatively low degree of visual and aural similarity in relation to the other opposed goods and services;
- while when considered in relation to the brewery goods and services there would be a high degree of conceptual similarity, in the context of the other opposed goods and services the conceptual messages conveyed by the respective trade marks are likely to differ;
- CW's EAGLE trade is, absent use, possessed of a reasonably high degree of inherent distinctive character, and that in the context of the goods upon which it

had been used, the use made of the trade mark had added to its inherent credentials.

93. I must now bring all of the factors together in my assessment of the likelihood of confusion. Of course, as the test for likelihood of confusion is cumulative i.e. there must be similarities in both the trade marks and the competing goods and services. Where I have found there to be no similarity between the competing goods and services there can be no likelihood of confusion. Having weighed all of the factors listed above, I have come to the conclusion that in relation to the brewery goods and services (for which the word BREWERY is likely to be considered descriptive by the average consumer), the similarities in the trade marks combined with the identity/similarity in the goods is likely to result in a likelihood of indirect confusion i.e. where the average consumer will assume that the goods originate from economically linked undertakings. However, when considered in relation to goods and services which are less similar than the brewery goods and services, the presence of the word BREWERY appearing in ZL's trade mark (as a distinctive if not dominant element) changes the concept underlying ZL's trade mark and is, in my view, sufficient, to militate against the likelihood of confusion.

94. In summary, CW's opposition has succeeded in relation to the following goods and services in classes 32 and 43:

Beer, ale, lager, stout, porter, shandy, syrups for making beverages, de-alcoholised drinks, non-alcoholic beer;

Services for providing food and drink; temporary accommodation; restaurant, bar and catering services; provision of holiday accommodation; booking and reservation services for restaurants and holiday accommodation,

but has failed in relation to all the other opposed goods and services.

### **Costs**

95. Although CW has been successful in relation to the goods and services mentioned above, it has failed in relation to all the other goods and services it opposed in classes 33, 35, 36 and 41; in effect, ZL has been substantially successful and as such is entitled to an award of costs. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide I award costs to ZL on the following basis:

Preparing a statement and considering CW's statement:	£300
Considering CW's evidence	£500
Written submissions	£400
<b>Total:</b>	<b>£1200</b>

96. I order Charles Wells Limited to pay to Zeloof LLP the sum of **£1200**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of November 2011**

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