

O-464-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2620372

BY

BULLDOG ENERGY DRINK LIMITED

TO REGISTER THE TRADE MARK

BULLDOG
SHEER ENERGY

IN CLASS 25

AND

THE OPPOSITION THERETO

UNDER NO 104212

BY

ROLLINS BULLDOG TOOLS LIMITED

BACKGROUND

1. On 8 May 2012, Sun Mark Ltd KBS (the applicant) applied to register the above trade mark in class 25 of the Nice Classification system.¹ Following an assignment² the mark now stands in the name of BULLDOG Energy Drink Ltd (the applicant).

2. Following publication of the application, on 14 September 2012, Rollins Bulldog Tools Limited (the opponent) filed notice of opposition against the application. The opposition relates to the following goods:

Class 25

Clothing; footwear, headgear with respect to energy drinks (none of the aforementioned for use within the garden, horticultural and contractor industry).

3. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (the Act). The opponent relies upon United Kingdom trade mark registration no 2517987 for the following goods:

Mark details and relevant dates	Goods relied upon
Mark: BULLDOG Filed: 11 June 2009 Registered: 10 September 2010	Class 9 Articles of protective and safety clothing; headgear; hard hats; gloves; footwear; waterproof clothing; protective glasses, goggles and face masks; all the aforesaid goods for use within the garden, horticultural and contractor industry; sun glasses; radios. Class 25 Articles of clothing; footwear; headgear; trousers, shirts, sweatshirts, t-shirts, overalls, Wellington boots; all the aforesaid goods for use within the garden, horticultural and contractor industry.

4. In its statement of grounds the opponent states:

“The opposed mark is confusingly similar to the Opponent’s trade mark as it includes the whole of the opponent’s Bulldog mark as the prominent and dominant feature of that mark. Furthermore, the opposed mark covers identical or similar goods to those protected by the Opponent’s earlier mark in classes 9 and 25 of the register.”

5. The applicant filed a counterstatement on 11 March 2013. It denies the grounds on which the opposition is based. It states:

“The opposition as filed is denied by the applicant. The goods which are protected by the earlier marks are highly specific and geared towards a

¹ International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

² Dated 23 January 2013

particular target consumer, those in the horticultural and contractor industry.”

6. The applicant filed evidence. The opponent filed submissions during the period allowed for evidence and further submissions in lieu of a hearing. I will refer to these as necessary below.

Limitations to the applicant’s specification

7. All of the goods in Class 25 of the applicant’s specification include the limitation ‘*with respect to energy drinks (none of the aforementioned for use within the garden, horticultural and contractor industry)*’.

8. I am mindful of *Omega SA (Omega AG) (Omega Ltd) v Omega Engineering Incorporated* [2012] EWHC 3440 (Ch), in which Arnold J. provided the following guidance on the application of the *POSTKANTOOR*³ principle to limitations to specifications.

“43. *The POSTKANTOOR principle.* In *POSTKANTOOR* the applicant applied to register the word *POSTKANTOOR* (Dutch for *POST OFFICE*) in respect of goods and services in Classes 16, 35–39, 41 and 42. The Benelux Trade Mark Office refused registration on the grounds that the sign was descriptive. On appeal, the *Gerechtshof te s’-Gravenhage* (District Court of The Hague) referred nine questions of interpretation of the Directive to the Court of Justice, of which the eighth was as follows:

“Is it consistent with the scheme of the Directive and the Paris Convention for a sign to be registered for specific goods or services subject to the limitation that the registration applies only to those goods and services in so far as they do not possess a specific quality or specific qualities (for example, registration of the sign ‘Postkantoor’ for the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office’)?”

44. The Court of Justice answered this question as follows:

“113. ... when registration of a mark is sought in respect of an entire class within the Nice Agreement, the competent authority may, pursuant to Article 13 of the Directive, register the mark only in respect of some of the goods or services belonging to that class, if, for example, the mark is devoid of any distinctive character in relation to other goods or services mentioned in the application.

114. By contrast, where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

³ *Established in C-363/99*

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

45. The guidance given by the Court of Justice must be seen in the context of the question to which it was addressed, namely whether it was acceptable to restrict the goods or services by reference to the absence of “a specific quality”. What the District Court of The Hague meant by this can be seen from the example it gave, viz. “the services of direct mail campaigns and the issue of postage stamps provided that they are not connected with a post office”. When the Court of Justice referred in its answer to “a particular characteristic”, it must have meant the same thing as the District Court meant by “a specific quality”.

46. The application of this guidance has caused some difficulty in subsequent cases. In *Croom’s Trade Mark Application [2005] R.P.C. 2* at [28]–[29] Geoffrey Hobbs QC sitting as the Appointed Person held that the *POSTKANTOOR* principle precluded the applicant from limiting a specification of goods in Classes 18 and 25 by adding the words “none being items of haute couture” or “not including items of haute couture”. He went on at [30] to refer to “characteristics that may be present or absent without changing the nature, function or purpose of the specified goods”. Mr Hobbs QC made the same distinction in *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22* at [16].

47. In *Oska’s Ltd’s Trade Mark Application [2005] R.P.C. 20* at [56] I observed *en passant* when sitting as the Appointed Person that I did not consider that it would be permissible to limit the specification by reference to the applicant’s intended target market.

48. In *MERLIN Trade Mark (BL O/043/05) [1997] R.P.C. 871* at [27]–[28] I held when sitting as the Appointed Person held that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

49. I also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons which I expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

50. In *Patak (Spices) Ltd’s Community Trade Mark Application (R746/2005-4) [2007] E.T.M.R. 3* at [28] the Fourth Board of Appeal at OHIM refused to allow a proposed limitation “*none of the aforesaid being dart games or darts*” to a class 28 specification as offending the *POSTKANTOOR* principle. I find this decision difficult to follow, since the exclusion related to categories of goods, rather than the characteristics of goods. It appears that the objection may have been down to the fact that the exclusion was negatively worded, but as I explained in *MERLIN [1997] R.P.C. 871* that is a matter of form, not substance, and so should not have been determinative.”

And

“56. Against this background, counsel for Swiss submitted that the limitation “intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature (including such having provision to record heat or temperature over a period of time and/or to display the time of day)” contravened the *POSTKANTOOR* principle because it purported to restrict the specification of goods by reference to whether the goods possessed particular characteristics.

57. I do not accept that submission for the following reasons. First, if and insofar as the *POSTKANTOOR* principle depends on the limitation being expressed in negative terms, the limitation in the present case is expressed in positive terms. Secondly, and more importantly, I do not consider that the limitation refers to whether the goods possess particular characteristics in the sense in which the Court of Justice used that term in *POSTKANTOOR*. Rather, the limitation refers to the functions of the goods. To revert to the analogy discussed above, it is comparable to a limitation of “clocks” to “clocks incorporating radios”. Accordingly, in my judgment it falls on the right side of the line drawn by Mr Hobbs QC in *Croom’s Trade Mark Application [2005] R.P.C. 2* and *WISI Trade Mark [2007] E.T.M.R. 5; [2006] R.P.C. 22.*”

9. Following the decision in *PostKantoor* an exclusion of objectionable goods may be acceptable to the Registry at the examination stage or in response to an opposition, providing it excludes a characteristic of those goods. In my view, clothing, footwear and headgear which is 'with respect to energy drinks' lacks clarity and is not a sub-category of those goods. The limitation does not limit a characteristic of the goods in this class.

10. As to the remaining limitation, 'none of the aforementioned for use within the garden, horticultural and contractor industry', it cannot operate. As Arnold J stated in *Merlin*, 'an article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser'. The limitation does not seek to limit a characteristic of the goods, but seeks instead to limit the nature of use of the goods.

11. Consequently, neither of the limitations applied to the applicant's specification can be considered to be valid.

Limitation to the opponent's specification

12. The opponent's limitation in class 9 can operate for the goods which relate to safety which can be specifically for the garden, horticultural and contractor industry.

13. For the reasons already outlined above the limitation in class 25 is more problematic. Clothing of the type contained within class 25 is general clothing and it would be difficult to see how the use to which the purchaser will put it can be limited by the specification.⁴

EVIDENCE

Witness statement of Raminder S Ranger and 5 exhibits.

14. Mr Ranger is the Director of Bulldog Energy Drink Ltd [the applicant]; his statement is dated 13 December 2013.

15. Mr Ranger's statement consists, for the most part, of submissions. Exhibits attached to the statement include, inter alia, forms filed in the course of these proceedings and prints from the opponent's website.

16. For reasons which will become apparent later in this decision I will not itemise it here but will refer to Mr Ranger's submissions where necessary below.

DECISION

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

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

⁴ See the comments of Arnold J at paragraph 10 of this decision.

(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.”

18. 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.”

19. The opponent's mark is an earlier mark which is not subject to proof of use because, at the date of publication of the application, it had not been registered for five years.⁵

Section 5(2)(b) case law

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

The principles

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

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

⁵ See section 6A of the Act (added by virtue of the Trade Marks (Proof of Use, etc.) Regulations 2004: SI 2004/946) which came into force on 5th May 2004.

whose attention varies according to the category of goods or services in question;

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

The average consumer and the nature of the purchasing act

21. In accordance with the above cited case law, I must determine who the average consumer is and also identify the nature of the purchasing process. The average consumer is reasonably well informed and reasonably circumspect and observant but with a level of attention likely to vary according to the category of goods. The attention paid is likely to vary depending on price and, to some extent, the nature of the goods and the frequency of the purchase.

22. The average consumer of the goods at issue will be a member of the general public or a business/professional. The purchase is likely to be primarily visual as it is likely to be made from a website, catalogue, or directly from a shelf. The specifications of goods cover a wide range of products which vary in price and frequency of purchase. Consequently, the level of attention paid is likely to vary.

23. In respect of the goods in class 25, in considering the level of attention that will be paid to such a purchase and the nature of the purchasing act, I am mindful of the decision of the General Court (GC) in *New Look Ltd v Office for the Harmonization in the Internal Market (Trade Marks and Designs) Joined cases T-117/03 to T-119/03 and T-171/03*, in which it commented:

"43. It should be noted in this regard that the average consumer's level of attention may vary according to the category of goods or services in question (see, by analogy, Case C-342/97 *Lloyd Schuhfabrik Meyer* [1999] ECR I-3819, paragraph 26). As OHIM rightly pointed out, an applicant cannot simply assert that in a particular sector the consumer is particularly attentive to trademarks without supporting that claim with facts or evidence. As regards the clothing sector, the Court finds that it comprises goods which vary widely in quality and price. Whilst it is possible that the consumer is more attentive to the choice of mark where he or she buys a particularly expensive item of clothing, such an approach on the part of the consumer cannot be presumed without evidence with regard to all goods in that sector. It follows that that argument must be rejected.

...

53. Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

24. In respect of the safety clothing and apparatus in class 9, a higher level of attention is likely to be paid due to the nature of the goods and the fact that they are being purchased to ensure personal safety and reduce the risk of injury. The opponent's goods in class 9 are limited to 'use within the garden, horticultural and contractor industry', and will consequently require a higher level of attention to be paid as they are being purchased, for the most part, for use in industry for the reasons outlined above.

25. In respect of the goods in class 25 the purchase is likely to be made by a member of the general public. The level of attention paid is likely to be reasonable to the extent that they will wish to select, inter alia, the correct colour, size, material.

26. The opponent's goods in class 25 are limited to 'use within the garden, horticultural and contractor industry', and will consequently require a higher level of attention to be paid.

Comparison of goods

27. The goods to be compared are as follows:

The opponent's goods	The applicant's goods
<p>Class 9 Articles of protective and safety clothing; headgear; hard hats; gloves; footwear; waterproof clothing; protective glasses, goggles and face masks; all the aforesaid goods for use within the garden, horticultural and contractor industry; sun glasses; radios.</p> <p>Class 25 Articles of clothing; footwear; headgear; trousers, shirts, sweatshirts, t-shirts, overalls, Wellington boots; all the aforesaid goods for use within the garden, horticultural and contractor industry.</p>	<p>Class 25 Clothing; footwear, headgear with respect to energy drinks (none of the aforementioned for use within the garden, horticultural and contractor industry).</p>

28. In its evidence the applicant submits:

"The Applicant asserts that the goods are neither identical nor similar due to the facts stated below".

29. In support of this submission the applicant seeks to describe (supported by prints from both parties' websites) the nature of the parties' businesses. The opponent's earlier mark is not subject to proof of use, consequently, the opponent can rely on the full specification of its registration in classes 9 and 25.

30. The opponent submits:

"The specification of the Opponent's class 25 goods includes the general goods of "Articles of clothing; footwear; headwear [sic]". These goods are identical to the goods of "clothing, footwear, headgear" of the specification of the Applicant's mark. The limitation of the Opponent's specification refers only to the goods of "trousers, shirts; sweatshirts, t-shirts, overalls, Wellington boots, all of which are still incorporated in the wide specification of goods covered by the Applicant's mark."

31. In comparing the goods, I bear in mind the following guidance provided by the General Court (GC) in *Gérard Meric v OHIM*, Case T-133/05:

"29. ...goods can be considered identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark."

Class 25

32. The opponent's goods in class 25 include the broad terms 'Articles of clothing, footwear and headgear'. The applicant's class 25 specification includes the terms 'Clothing; footwear, headgear' which are clearly identical. In accordance with *Meric* the parties' goods are therefore identical.

Class 9

33. The opponent's goods in class 9 put it in no better position as I have already found the entirety of the applicant's goods to be identical to its goods in class 25.

Comparison of marks

34. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

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

The opponent's mark	The applicant's mark
BULLDOG	BULLDOG SHEER ENERGY

36. The opponent's mark consists of the single word BULLDOG in block capitals. No part of the word is stylised or emphasised in any way. Consequently, the distinctiveness lies in the mark as a whole.

37. The applicant's mark consists of the word BULLDOG presented in block capitals above the words SHEER ENERGY, which are considerably smaller, fitting below the letters 'DOG' of BULLDOG. The three words do not hang together as there is a clear

distinction, achieved by size and presentation of the first element, between BULLDOG and SHEER ENERGY. The type face is slightly stylised but this does not prevent the words being read as 'BULLDOG SHEER ENERGY'. The first word, 'BULLDOG', being considerably larger and presented above the remaining two words, is a distinctive and the dominant element of the mark, though the words 'sheer energy' are also distinctive within the mark as a whole.

Visual similarities

38. In respect of the visual similarities the opponent submits:

"The sign and mark are words in ordinary typescript. Comparison of the sign and mark has to be focused on those elements which will be retained in the memory of the consumer up to the first visual impression given by the sign and mark. The Applicant's sign consists of the whole of the Opponent's BULLDOG mark. The Opponent's mark and Applicant's sign are similar to the extent that they coincide in the term Bulldog."

39. The applicant submits, in its witness statement:

"25. Visually, the signs differ in the fact that the Applicant's mark is a stylized mark, whereas the Opponent's mark is a word mark. Therefore, the Opponent is wrong in stating that the Applicant's and Opponent's marks are words in ordinary typescript...The Applicant's mark comprises of three words, whereas the Opponent's mark consists only of one word. Therefore visually the Applicant's mark in the first instance appears longer."

40. It is clear from cases such as *Sadas*⁶ and *Peek & Cloppenburg v OHIM*⁷ that normal and fair use of a word trade mark includes use in a range of fonts and cases. Accordingly, the fact that the earlier mark is registered in a plain black font does not prevent its use in a different font or case.

41. Visual similarity rests in the fact that both marks contain the word 'BULLDOG'. It is the first word of the applicant's mark and the totality of the opponent's mark. Its size and positioning within the applicant's mark gives it a dominance over the smaller words 'SHEER ENERGY' which are subservient to it.

42. These marks are visually similar to high degree.

Aural similarities

43. The applicant points to the differing lengths of the marks as a distinguishing factor and submits that the unusual juxtaposition of words in its mark makes it more distinctive.

⁶ *Sadas SA v OHIM*, T-346/04

⁷ T-386/07

44. The opponent submits that the marks are aurally similar due to the shared element, 'BULLDOG'.

45. There is clearly a difference in length between the two marks, with the applicant's consisting of the three words, BULLDOG SHEER ENERGY and the opponent's being the single word 'BULLDOG'. However the common element is the first word of the applicant's mark.

46. Taking these factors into account, I find these marks to share a medium degree of aural similarity.

Conceptual similarities

47. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁸ The assessment must be made from the point of view of the average consumer.

48. The applicant submits:

"Conceptually, BULLDOG means a breed of dog. In the Applicant's mark the word 'sheer' has several meanings. However, in this concept, Applicant refers to sheer as full or complete. Therefore, 'sheer energy' means full or absolute energy. However, Opponent's mark does not refer to any kind of energy. Therefore, the wording 'sheer energy' makes the Applicant's mark differ from the Opponent's mark conceptually."

49. The opponent submits:

"...the Applicant's sign and Opponent's mark are very similar as they are both prefixed by the word "Bulldog" which is a breed of dog. The "sheer energy" element of the Applicant's sign depicts a superior breed of dog with energetic characteristics. In relation to identical and or highly similar goods, there is undoubtedly a high risk that the relevant public would make a conceptual link and assume that the Applicant's sign is either a variation of the Opponent's mark or is in some way intrinsically connected thereto."

50. The opponent's mark creates the conceptual impression of the well known breed of dog, the bulldog. The applicant's mark begins with the same word, bulldog, which will create the same conceptual impression. The second and third words in the mark, 'SHEER ENERGY', will be considered either to apply to the preceding bulldog, denoting a dog with a high level of energy or may be considered, by the average consumer, to be unrelated to the first word. Taking all of these factors into account there is a medium degree of conceptual similarity between the marks.

⁸ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

Distinctive character of the earlier mark

51. 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 for which it has been used as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger Joined Cases C-108/97 and C-109/97* [1999] ETMR 585.

52. I have no evidence from the opponent to consider in this case so need only consider the inherent distinctive character of the earlier mark. BULLDOG is a well known word in the English language. It is not descriptive or allusive of the goods. As a consequence the mark enjoys a good degree of inherent distinctive character.

Likelihood of confusion

53. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them he has kept in his mind.⁹ I must also keep in mind the average consumer for the goods, the nature of the purchasing process and have regard to 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 vice versa.

54. I have found the marks to be highly visually similar and aurally and conceptually similar to a medium degree. I have found the earlier mark to have a good level of inherent distinctive character.

55. I have found the applicant's goods to be identical to the opponent's goods. I have identified the average consumer, namely a member of the general public, and have concluded that the level of attention paid to the purchase will vary according to the nature of the goods. The opponent's goods in classes 9 and 25 are limited to 'use within the garden, horticultural and contractor industry', and will consequently require a higher level of attention to be paid.

56. In reaching a decision on the likelihood of confusion I am mindful of the guidance on how to approach issues of similarity involving composite signs which can be found in the CJEU's judgment in *Medion AG v Thomson multimedia Sales Germany & Austria GmbH*, Case C-120/04 where it was held that:

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

⁹ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27

30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

32. The finding that there is a likelihood of confusion should not be subject to the condition that the overall impression produced by the composite sign be dominated by the part of it which is represented by the earlier mark.

33. If such a condition were imposed, the owner of the earlier mark would be deprived of the exclusive right conferred by Article 5(1) of the directive even where the mark retained an independent distinctive role in the composite sign but that role was not dominant.”

57. In *Aveda Corporation v Dabur India Limited*¹⁰ Arnold J held:

“47. In my view the principle which I have attempted to articulate in paragraph 45 above is capable of applying where the consumer perceives one of the constituent parts to have significance independently of the whole, but is mistaken as to that significance. Thus in *BULOVA ACCUTRON* the earlier trade mark was *ACCURIST* and the composite sign was *BULOVA ACCUTRON*. Stamp J held that consumers familiar with the trade mark would be likely to be confused by the composite sign because they would perceive *ACCUTRON* to have significance independently of the whole and would confuse it with *ACCURIST*.

48. On that basis, I consider that the hearing officer failed correctly to apply *Medion v Thomson*. He failed to ask himself whether the average consumer would perceive *UVEDA* to have significance independently of *DABUR UVEDA* as a whole and whether that would lead to a likelihood of confusion.”

58. The word *BULLDOG* is the totality of the opponent’s mark and the first word of the applicant’s mark. There is a general rule, clear from decisions such as joined cases T-183/02 and T-184/027¹¹, that the first parts of words (and consequently, first words of marks) catch the attention of consumers. However, it is also clear that each case must be decided on its merits considering the marks as wholes. In this case the

¹⁰[2013] EWHC 589 (Ch)

¹¹ *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II – 965, paragraph 81

word BULLDOG has significance independently of SHEER ENERGY as a whole. It is a clearly understood word at the start of the mark which gives the average consumer a clear picture in their mind. The words SHEER ENERGY are more ambiguous and may be considered to relate to the bulldog, the mark denoting a bulldog with high energy levels, or may be considered to indicate that the sheer energy of a bulldog is something desirable to the average consumer. Whatever the meaning the average consumer takes from the words 'SHEER ENERGY' it does not detract from the core message which is that of a BULLDOG.

59. I am mindful of the decision in *Medion* which makes clear that a finding of a likelihood of confusion should not depend upon the overall impression of the composite mark being dominated by the part which is identical to the earlier mark. *Medion* recognises that the overall impression in a case such as this may lead the public to believe that the goods derive, at the very least, from companies which are economically linked. I also bear in mind *L.A. Sugar Limited v By Back Beat Inc*¹², in which Mr Iain Purvis Q.C. as the Appointed Person noted that:

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

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

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

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

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

¹² Case BL-O/375/10

60. In my view that is the case here. These are 'BULLDOG' marks used in respect of identical goods. The nature of the common element BULLDOG gives rise to indirect confusion where the average consumer will believe the respective goods originate from the same or a linked undertaking.

CONCLUSION

60. The opposition succeeds under section 5(2)(b) of the Act for all of the goods applied for.

Costs

61. The opposition having succeeded, the opponent, is entitled to a contribution towards its costs. I have taken into account that no hearing has taken place, but that the opponent filed written submissions in lieu of a hearing. I make the award on the following basis.

Preparing a statement and considering the other side's statement:	£ 300
Written submissions:	£ 300
Official fee:	£ 200
Total:	£ 800

62. I order BULLDOG Energy Drink Ltd to pay Rollins Bulldog Tools Limited the sum of £800. 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 29th day of October 2014

**Ms Al Skilton
For the Registrar,
the Comptroller General**