

O/523/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3384047

BY

THE HUMBLE POTATO CO. LIMITED

TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33

Edwards 1902

AND OPPOSITION THERETO (NO. 416924)

BY

BARDINET

Background and Pleadings

1. The Humble Potato Co. Limited (“the Applicant”) applied to register the trade mark “Edwards 1902” on 17 March 2019 for goods in class 33, as listed below. It was accepted and published on 10 May 2019.¹

Class 33: Alcoholic Cocktails containing vodka; Alcoholic Cocktails containing gin; Alcoholic Punches containing vodka; Alcoholic Punches containing gin; Gin; Prepared Alcoholic Cocktails containing vodka; Prepared Alcoholic Cocktails containing gin; Vodka.

2. Bardinet (“the Opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) relying on its earlier European Union trade mark (“EUTM”) no. 3455491 SIR EDWARD’S filed on 28 October 2003 and registered on 18 March 2005. For the purposes of the opposition it relies on its goods in class 33, namely *alcoholic beverages (except beers)*.

3. The Opponent claims that there is a likelihood of confusion under section 5(2)(b) of the Act because the respective trade marks are similar and that the goods are identical or similar.

4. The Applicant filed a defence and counterstatement denying the claims made, putting the Opponent to proof of use of the goods relied upon.

5. Both parties are professionally represented; the Applicant by Urquhart-Dykes & Lord LLP, the Opponent by Dolleymores. The Opponent filed evidence in the form of a witness statement completed by Jean Pierre Cayard. The Applicant filed evidence in the form of a witness statement completed by Mr Richard David Arundel. The Opponent did not file evidence in reply. Following a request from the Applicant a hearing took place before me on 30 July 2020. At the hearing the Applicant was represented by Mr Allan Fiddes of Urquhart-Dykes & Lord LLP; Mr Fiddes filed a

¹ Originally the application included services in class 41, however by way of Form TM21B dated 20 September 2019 the Applicant subsequently restricted the scope of its application only to include those goods as listed.

skeleton argument prior to the hearing. The Opponent chose not to attend the hearing however filed submissions in lieu. This decision is taken following a careful perusal of the papers.

Evidence Summary

The Opponent's evidence

6. The Opponent's evidence is in the form of a witness statement filed by Mr Jean Pierre Cayard dated 12 November 2019, accompanied by 7 exhibits marked JC1-7. Mr Cayard is the President of the Opponent company, a position he has held since 1994. The facts contained in his witness statement come from his own personal knowledge and from company records. He is duly authorised to make the statement on behalf of the company.

7. Exhibit JC2 consists of copy invoices which Mr Cayard describes as showing the sale of goods under the earlier mark between 2015 and 2019. Mr Cayard refers to the column titled "Quantite U.C." within the invoices as denoting the unit of consumption and refers to the number of bottles. The Opponent's mark is referred to within the invoices as "WH SIR EDWARDS". Mr Cayard states that the invoices show sales to the following customers:

- i. easyDis – described as a logistics subsidiary of the Casino group which is a retail enterprise with 10,000 stores across France.
- ii. SCA (Ouest/Normande/Partois Alcool) - which manages the purchases and logistics for supplying the French retail cooperative E. Leclerc.
- iii. Auchan – described as a French retail group with stores in several EU countries to include France, Poland, Spain, Hungary, Luxembourg, Portugal and Romania.

iv. ITM Alimentaire International - described as a French retail chain under the Group Les Mousquetaires which has establishments in France, Belgium, Portugal and Poland.

8. Exhibit JC3 contains customer details of those companies as outlined in the preceding paragraph taken from their respective websites. They consist of background information regarding the number of stores owned by each company and the geographical extent of the businesses within the EU.

9. Exhibit JC4 consists of screenshots taken from the company's website "www.siredwards.com" generated from the internet archive website Way Back machine. Mr Cayard states that these screenshots demonstrate the continuous use of the Opponent's website since 2011. The screenshots however are only dated from 2015 onwards. The screenshots include a small number of photographs of the Opponent's mark as it appears on its goods and in an advertisement on the website. They are all within the relevant period.

10. Exhibit JC5 comprises of tariffs for the Opponent's goods provided to its customers between 2015 and 2019. The price lists include whisky goods offered by the Opponent under the SIR EDWARD'S mark.

11. Exhibit JC6 consist of screenshots taken from the WayBack Machine internet archive showing a selection of websites which sell the Opponent's whisky products namely:

- www.bereveta.com - dated 6 April 2017 Germany;
- www.spiritsandwines.lv - dated 27 April 2015 and 15 February 2019 – Latvia
- www.viinarannasta.ee – dated 20 July 2017 – Estonia.

On page 102, for example, the earlier mark is displayed on a 1 litre bottle of whisky, advertised at €16.99.

12. Exhibit JC7 is described as examples of the Opponent's trade mark in use in France on public advertising, in stores, in print media, on social media and in specialist trade press. The exhibit includes copy photographs annotated with various dates by year, all within the relevant period. The photographs consist of various billboards, posters and advertising hoardings displaying the Opponent's earlier mark alongside what appears to be a bottle of whisky. Not all the photographs are of sufficient clarity, however, for me to be able to discern the type of product or whether the earlier mark is displayed on the bottle itself. However the earlier mark itself, in written form, is clearly visible.

The Applicant's evidence

13. The Applicant's evidence consists of the witness statement of Mr Richard David Arundel, the director of the Applicant company, dated 3 February 2020. Mr Arundel gives an outline as to the background of the company and why it was established; namely in order to develop a range of alcoholic beverages based on the potato vegetable. Mr Arundel provides information as to the creation of the brand and its link to the King Edward potato being one of the oldest varieties still commercially grown in the UK. The particular date used in the trade mark, is a reference to when this variety of potato was introduced in the UK. Mr Arundel exhibits two articles taken from "www.gardenfocused.co.uk" and "en.wikipedia.org" which provides information as to the history of the King Edward potato and its geographical link to the Opponent's address. Mr Arundel states that the name and date combination used in its trade mark application was selected for its connection to King Edward VII's coronation.

14. Whilst the Opponent filed submissions in lieu of hearing and the Applicant filed skeleton arguments I do not propose to summarise those here, however I have taken both documents into account and will refer to them where necessary later in my decision.

Decision

15. Section 5(2)(b) of the Act states as follows:

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

(a)

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

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

16. In these proceedings the Opponent is relying on its EUTM registration as shown in paragraph 2 above which qualifies as an earlier mark under section 6 of the Act, because it was applied for at an earlier date than the Applicant's contested mark. Since the Opponent's mark has been registered for more than five years at the date the application was filed it is subject to the proof of use provisions contained in section 6A of the Act. Consequently, in order for the Opponent to rely upon the goods listed within class 33, it must demonstrate that genuine use has been made of its mark for those goods.

Proof of Use

17. The relevant provisions regarding Proof of Use are set out as follows:

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

6A. - (1) This section applies where -

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),
(b) or (ba) 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 relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(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 relevant period 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 (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), 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 European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

18. Section 100 of the Act is also relevant it states that:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

19. Accordingly, under section 6A(1A) of the Act the relevant period in which genuine use must be established is the five-year period ending on the filing date of the applied for mark, namely from 18 March 2014 to 17 March 2019.

20. What constitutes genuine use has been subject to a number of judgements. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. summarised the law relating to genuine use as follows:

“114.....The Court of Justice of the European Union (CJEU) has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07

Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising

campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial

justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

21. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11 are also relevant. The court noted that:

“36. It should, however, be observed that..... the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

....

50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

...

55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope

should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77).”

22. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

23. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are

to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to

that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use.”

24. The General Court (“GC”) restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where the market for the goods/services are not limited to that area of the Union.

25. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTMs, in the course of trade, sufficient to create or maintain a market for the goods/services at issue in the Union during the relevant 5 year period. In making the required assessment I am required to consider all relevant factors, including:

- a. The scale and frequency of the use shown;
- b. The nature of the use shown;
- c. The goods and services for which use has been shown;
- d. The nature of those goods/services and the market(s) for them; and
- e. The geographical extent of the use shown.

26. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

27. In the original pleadings the Opponent relied on *alcohol beverages (except beer)* at large however in its written submissions filed on 24 June 2020 it limited the extent of the goods upon which the opposition is based to “*whisky*” only. The decision will therefore proceed on this basis.

28. At the hearing Mr Fiddes conceded that the Opponent had provided sufficient evidence to demonstrate that the earlier mark had been used for *whisky* throughout Europe but not within the UK.

29. Since the earlier mark is an EUTM its scope of protection extends throughout the EU. Taking into account the decisions in *Leno* and *London Taxi*, proof of use within one member state may be sufficient to satisfy the criteria even if the use has not been demonstrated over the community area as a whole or specifically within the UK. For the avoidance of doubt, I would have found that the Opponent had demonstrated sufficient use of its earlier mark throughout Europe but moreover and in particular within France. From the evidence produced, which consisted of screenshots taken from various websites, its social media presence, the copy invoices regarding its distribution to retailers as well as its advertising campaign, I would have found this to be sufficient taken as a whole, to demonstrate that the Opponent had created and maintained a market for *whisky* in the European Union throughout the relevant period.

30. Notwithstanding that the evidence produced demonstrates use of the earlier mark in a slightly stylised form and with the addition of a device on the product itself, it is also referred to in the format in which it is registered. Although the Applicant submitted that this was not use upon which the Opponent may rely, at the hearing Mr Fiddes conceded that these additions and the stylisation did not detract from the mark as registered and accepted that it was therefore use upon which the Opponent may rely. I agree. The stylisation does not alter the distinctive character of the earlier mark and is within scope of notional and fair use. The device will purely be seen as an additional decorative element falling within an acceptable variation as envisaged by the decision in *Colloseum*.² I am satisfied that not only has sufficient use been demonstrated for

² *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12

whisky but also that the form of the earlier trade mark is one upon which the Opponent may rely.

Section 5(2)(b)

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

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

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

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

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

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

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

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

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

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

Comparison of goods

32. When conducting a goods comparison, all relevant factors should be considered as per the judgment of the CJEU in *Canon Kabushiki Kaisha v Metro Goldwyn Mayer Inc* Case C-39/97, where the court stated at paragraph 23 of its judgment that:

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

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

33. I am also guided by the relevant factors for assessing similarity identified by Jacob J in *Treat*, [1996] R.P.C. 281 namely:

(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.

34. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or Applicant relies on those goods as listed in paragraph where the goods

designated by the trade mark application are included in a more general category designated by the earlier mark”.

35. Given that the Opponent has limited its specification to *whisky*, for the purposes of this opposition, the contested goods are as follows:

Opponent's goods	Applicant's goods
Class 33: Whisky	Class 33: Alcoholic Cocktails containing vodka; Alcoholic Cocktails containing gin; Alcoholic Punches containing vodka; Alcoholic Punches containing gin; Gin; Prepared Alcoholic Cocktails containing vodka; Prepared Alcoholic Cocktails containing gin; Vodka.

36. The Opponent submits that the contested goods are similar to a high degree, sold through identical trade channels by the identical methods of purchase. In particular the it submits that:

“18. The application contains the unmixed alcoholic beverages “Gin” and “Vodka” which are spirits with a high alcohol content and, as such, are identical in nature to the Opponent's goods. The Cambridge on-line English Dictionary defines cocktails as

“a drink, usually an alcoholic one, made by mixing two or more drinks together”

And punch as,

“a cold or hot drink made by mixing fruit juices, pieces of fruit, and often wine or other alcoholic drinks”

The cocktails and punches contained within the application include those made with a single mixer ingredient such as coca-cola, orange juice, ginger ale, Red Bull etc. As such, a product made from a spirit with a single mixer, i.e. a vodka and coke will have a similar nature to the Opponent's whisky when bought to be drunk with a mixer such as coke.

19. Cocktails and punches are regularly made with more than one type of spirit. As such, the specification in the application does not prevent any of the cocktails and punches from also containing, or being made predominantly with, whisky.

20. The Intended Purpose: Both the goods in the Application and the Opponent's goods are intended to be drunk for recreational purposes. They are beverages that are intended to be used for the purpose of enjoyment both through the consumer savouring the taste and the pleasurable psychoactive effect that alcohol has on the human brain. The cocktails and punches are not limited and, therefore, must be considered to encompass all types including those made with only a single mixer ingredient. The goods are not intended to be purchased by the consumer for the purpose of hydration and nourishment. The goods in the Application have an identical purpose to the Opponent's goods.

21. Method of Use: The methods of use are identical as all of the goods are intended to be consumed as drinks. With regard to the unmixed spirits, they are also intended to be combined with a mixer or other ingredients to form cocktails and punches. As the Opponent's goods will also be purchased with the intention of being used in cocktails and punches the methods of use are also identical when used for these purposes.

22. Competition with each other or are complementary: The goods in the application are in competition with those protected in the Opponent's trade mark registration. The identical intended purpose and method of use of the goods means that they are interchangeable. These goods will be sold to the same consumers, for the same purpose, have a similar price range, be sold in the

same places (both retail establishments and establishments providing food and drink), and have the same distribution channels to market. The goods in the Application can be substituted by the consumer for the Opponent's goods and, as such, the goods are in competition."

37. In its skeleton argument the Applicant argues that the contested goods "are not similar on the basis of their nature, their respective uses or the trade channels through which they are available. In addition, the goods/services in issue are not...complementary." At the hearing Mr Fiddes accepted that the trade channels through which the products were available were the same or similar but submitted that:

"vodka, gin and whisky, are actually not goods of the same description because, quite clearly, if you are going to go and buy a bottle of whisky, you go and buy a bottle of whisky; if you want to buy a bottle of vodka, you buy a bottle of vodka; and if you want to buy a bottle of gin, you buy a bottle of gin. These are standalone products. Whilst they all fall within the broad category of spirits – alcoholic beverages -- they are not interchangeable: if you want a gin and tonic, you are not suddenly going to think "I am going to have a whisky and tonic". I think the consumers see these as separate products, not as interchangeable products: you do not replace one with the other. You might replace different brands within those groups, but you either want a bottle of whisky or you want a bottle of gin."

38. Furthermore, Mr Fiddes argued that "you do not see a cover-all range of alcoholic beverages", generally "marks are being used in relation to particular specific types of spirits. For example, you have Smirnoff Vodka but you do not see Smirnoff whisky."

39. I have taken all of these submissions into account in making my assessment, which I will make based upon the viewpoint of the average consumer taking into account the factors as set out in *Treat* and *Canon*.

40. To my mind the term "*whisky*" will be seen as an alcoholic beverage with a high percentage of alcohol content, usually made from malted barley or grains. It is usually drunk by itself, with water or ice or combined with a mixer or other beverage (soft or

alcoholic) to make a long drink or cocktail. Likewise, the Applicant's *gin* and *vodka* are alcoholic beverages with a comparable high percentage of alcohol content albeit produced by different processes and from different raw ingredients. Similarly, both gin and vodka may be drunk neat but more often than not they would be used with an accompaniment for example lemonade or tonic. I consider that consumers would regard these drinks as overlapping in nature, use, user and purpose, all being spirits consumed for pleasure and socialising. I also consider that the channels of trade would overlap since it would not be unusual for bottles of gin, vodka and whisky to be listed sold through the same retailers (such as off licences) or found in the same aisles of supermarkets albeit on different shelves but nevertheless alongside each other. There may be a degree of competition between the drinks in so far as a consumer may choose to order/purchase a whisky instead of a gin for example. I do not consider that there would be any complementarity between the contested beverages where one would be regarded as indispensable to the other. Taking all these factors into account I consider that the applicant's *vodka* and *gin* to be similar to a high degree to *whisky*.

41. In relation to the Applicant's remaining goods namely *Alcoholic Cocktails containing vodka*; *Alcoholic Cocktails containing gin*; *Alcoholic Punches containing vodka*; *Alcoholic Punches containing gin*; *Prepared Alcoholic Cocktails containing vodka*; *Prepared Alcoholic Cocktails containing gin*; they are all alcoholic beverages consisting of a spirit or several spirits mixed with other ingredients, commonly soft drinks or juices. Many cocktail and punch recipes are not restricted to only one spirit and may include several spirits mixed together. Cocktails and punches can be sold premixed in individual containers or made to order by a mixologist or by the consumer themselves. I accept the Opponent's submissions that whilst the Applicant's goods are specified as containing vodka and gin, the terms are not limited and therefore do not prevent them from containing other spirits. I consider that the Applicant's goods would overlap in channels of trade, method of use, intended purpose and user. And that there would be a degree of competition between them in so far as consumers may choose to purchase a pre-mixed cocktail, for example, rather than the individual components. Whilst whisky would be regarded as essential to a whisky based cocktail, this is not the case for cocktails and punches at large and therefore I do not consider that there is a complementary relationship between the goods as envisaged by the case law.

42. Taking these factors into account I consider that the contested goods would be similar to between a medium and high degree to the Opponent's *whisky*.

Average consumer and the purchasing process

43. When considering the opposing trade marks, I must determine, first of all, who the average consumer is for the goods. I must then determine the purchasing process for the goods. The average consumer is deemed reasonably well informed and reasonably observant and circumspect. For the purposes of assessing the likelihood of confusion the average consumer's level of attention is likely to vary according to the category of goods in question.³

44. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch)*, Birss J described the average consumer in these terms:

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

45. Both parties are in agreement that overall the average consumer of the contested goods is a member of the general public having attained 18 years of age and I agree. At the hearing Mr Fiddes accepted that both visual and aural considerations would play a part in the selection process with the respective goods being self-selected from off licences, wine merchants or supermarkets but also could be requested in a bar for example. The Opponent's submissions were limited to there being “no restriction as to price or quality” in either party's goods resulting in “the level of attention being deemed moderate at most”.

³ Lloyd Schuhfabrik Meyer, case c- 342/97.

46. To my mind the consumer would self-select the goods from display shelves of retail outlets such as supermarkets or their online equivalents where visual considerations would dominate. The goods however may also be consumed in public houses, bars and restaurants where an oral aspect to the selection process would arise following a request made to serving staff. Even in bars and restaurants, however, visual considerations will still play a part since the goods are likely to be requested following a perusal of a menu or from a display stand behind the counter or a dispenser behind a bar.⁴ Alcoholic beverages will be consumed on a fairly frequent basis with such things as the type of beverage, personal taste, alcoholic strength and cost being considerations taken into account by the consumer.

47. Taking these factors into account, I consider that the selection process will be predominantly visual but with aural considerations still paying a part, with no more than a medium degree of attention in the selection process.

Comparison of the trade marks

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

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

⁴ *Simonds Farson Cisk Plc v OHIM* T-3/04

49. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to consider 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 trade marks.

50. The respective marks are as follows:

Opponent's trade mark	Applicant's trade mark
SIR EDWARD'S	Edwards 1902

51. Whilst Mr Fiddes particularised the differences between the respective trade marks in so far as how they appear in the market place on the products themselves,⁵ at the hearing he accepted that the correct approach was to undertake the assessment of the trade marks as they appear on the register. Both parties' views regarding the comparison between the trade marks were polarised; sufficient to say the Opponent regarded the aural and visual similarities to be moderate to high whereas Mr Fiddes submitted that visually the trade marks were quite distinct and that aurally emphasis would be placed on different elements within the respective marks. At the hearing Mr Fiddes argued that conceptually the marks "look completely different... with the Opponent's product alluding to a particular individual... a member of the aristocracy or knighted person who produces whisky" with the Applicant's mark being "just a name and a date." The Opponent submitted that the marks were conceptually dissimilar "neither have a definitive conceptual identity which would allow the consumer to create a strong association with an identifiable person or thing."⁶

Overall impressions of the trade marks

52. The Opponent's trade mark consists of the words SIR EDWARD'S presented in uppercase. Since there are no other elements to contribute to the mark the overall impression resides in the combination of these words to create a phrase being an

⁵ Page 12 skeleton arguments

⁶ Para 34 Pg 12 Opponent's submissions.

honorary title and a name expressed in its possessive form; the title being qualified by the name EDWARD'S. Similarly, the Applicant's mark includes two elements, the name Edwards and a number 1902, which will be perceived as a date. The overall impression resides in these two elements each playing an equal role.

Visual comparison

53. Whilst both trade marks appear in different casing this has no bearing on the visual comparison assessment since notional and fair use allows marks to be presented in any font or typecase.⁷ The trade marks coincide in so far as they both include the element EDWARDS although in the Opponent's mark the letters D and S are separated by an apostrophe such that the name EDWARD is expressed in its possessive form. I do not consider however that consumers would necessarily notice the apostrophe when viewing the mark as a whole. The marks differ to the extent that they each include additional elements there being no counterpart in the other's trade mark namely the element SIR in the Opponent's mark and the number 1902 in the Applicant's. I consider that weighing the similarities and the differences that the respective marks share a medium degree of visual similarity.

Aural comparison

54. I consider that the ordinary dictionary pronunciation will be afforded to the respective elements in each trade mark. The marks coincide to the extent that the element EDWARD'S/Edwards will be pronounced identically; no difference in pronunciation being afforded by the addition/absence of the apostrophe. The marks differ by the addition of the elements SIR and 1902 which do not coincide in their pronunciation. I recognise that to the extent that "1902" in the Applicant's mark is identified as a date (most likely the year in which the business commenced) it may not be articulated. Weighing up the differences and the similarities, I consider that the marks are aurally similar to no more than a medium degree if the numbers 1902 are pronounced, or between medium and high otherwise.

⁷ Paragraph 47 *Sadas SA v. OHIM* Case T-364/04.

Conceptual Comparison

55. I do not accept that consumers will associate the contested mark with the King Edward potato or understand the relevance of the year as argued by the Applicant. Nor do I consider that consumers will instinctively or immediately understand that the goods are produced from the potato as its core ingredient. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.⁸ I do not consider that the meaning attributed by the Applicant will be obvious to consumers without a degree of analysis not usually undertaken when first encountering the mark or without already being familiar with the brand.

56. I consider that the respective marks will give rise to the concept of a name/surname common to UK consumers. The numbers 1902 will be perceived as a date (most likely the year in which the business was established). The word SIR in the Opponent's mark will be regarded as referring to an honorary title. When taken as a whole, the Opponent's mark will be regarded as referring to an individual with an honorary title whose name is EDWARD. Whilst the possessive form of the name EDWARD in the Opponent's mark makes a point of difference in so far as it gives rise to the goods belonging to SIR EDWARD (which could be perceived as a male forename) it may be that the apostrophe will be overlooked. This is especially so since names are commonly used with the addition of the letter "s" at their ends whether grammatically correct or not. The difference arising therefore from the apostrophe will not in my view be regarded as significant such that it is a distinguishing factor in the conceptual comparison.

57. Whilst I recognise that the elements Sir and 1902 give rise to a potential conceptual difference between the marks, the marks coincide conceptually to the extent that they both refer to an individual whose name is Edward/Edwards. I consider that the marks to be conceptually similar to a medium degree.

⁸ Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29

Distinctiveness of earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

59. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

60. Whilst the Opponent has filed evidence demonstrating that its mark has been used in the market place for whisky throughout Europe, very little if anything has been filed to demonstrate that it has achieved any sales within the UK. Consideration must be given, therefore, as to whether the use shown has enhanced the distinctive character of the mark as far as the UK public is concerned. The Opponent has not filed any overall sales or turnover figures or the percentage of sales in the context of the market share for the goods. No evidence has been filed regarding advertising or marketing expenditure targeting the UK market. I do not consider that the Opponent has established how strongly the mark identifies the goods as being the goods of the Opponent, sufficient to support a finding that its distinctiveness has been enhanced through use. I am only able to consider the position therefore based on inherent characteristics.

61. In *Becker v Harman International Industries*, Case C-51/09 P, the distinctive character of a surname was considered and the CJEU stated as follows:

“Although it is possible that, in part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate to take account of factors specific to the case and, in particular, to the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

62. The Opponent submits that “the dominant and distinctive element of its mark resides in the word EDWARD’S; this element being inherently distinctive for the goods in the registration”. To the average UK consumer, the mark as a whole will be seen as a reference to a name of an individual with an honorary title. Names are commonly used as trade marks and thus not considered as greatly distinctive. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the GC found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 *Fusco v OHIM – Fusco International (ENZO FUSCO)* [2005] ECR II-715, paragraph 54). The General Court applied a similar conclusion concerning Spanish consumers,

having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSSI), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

63. When comparing names account must be taken of whether it is unusual or, on the contrary, very common or whether the name, taken overall is of a particularly well known person so that the distinctive character of the mark would be affected. The element EDWARD in the Opponent’s mark will be recognised as a fairly common forename/surname within the UK and to the English speaking consumer. The ‘apostrophe S’ will give rise to the possessive form of the undertaking regarded as being responsible for the goods. The first element SIR will be perceived as an honorary title afforded to the individual named EDWARD. The commonality of the name EDWARD/EDWARD’S when taken individually would give rise to a relatively low degree of inherent distinctive character. However, the lower distinctive character of the mark, in my view, is offset to a degree by the title preceding it. The trade mark is not descriptive or allusive to the goods. Overall taking into account the mark in its entirety, I consider that the mark will possess between a low and medium degree of inherent distinctive character.

Likelihood of confusion

64. The purpose of a trade mark is to distinguish the goods/services of one undertaking from another. In considering whether a likelihood of confusion arises, I am required to make a global assessment of all relevant factors based on the facts before me, taken from the point of view of the average consumer, who rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

65. These factors include the interdependency principle where, for example 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. I have found that the some of the goods in this case will be considered as highly similar with the remainder similar to between a medium and high degree. I have found the marks to be similar in varying degrees from a visual, aural and conceptual perspective. The question therefore is whether the similarity between the marks is such that there is a likelihood that a member of the general public who is over the age of 18 (the average consumer in this case), paying a medium level of attention during the selection process for the goods in question, may be confused.

66. I remind myself that where the goods are selected visually, I have found the respective marks to be visually similar to a medium degree. Aurally, I have found the marks to be similar to between a medium and high degree when only the SIR EDWARD'S/Edwards elements are articulated and similar to no more than a medium degree when all the verbal elements are articulated. Conceptually, the marks share a medium degree of similarity for the reasons outlined previously. I have also found that the earlier mark overall has between a low and medium degree of inherent distinctive character, with the word EDWARD'S itself having a relatively low degree of inherent distinctive character. I bear in mind that I must consider the marks as wholes whilst keeping in mind the contribution of each component to the distinctiveness of the mark, with the distinctiveness of the common element being key.⁹

⁹ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

67. In *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

"38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it."

68. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

69. Taking into account my conclusions and notwithstanding the fact that consumers rarely have an opportunity to compare marks side by side, when encountering the marks both aurally and visually I do not consider that the additional elements contained in the respective marks would go unnoticed by the average consumer such that they would misremember or mistakenly recall one for the other. Even accepting that the number 1902 in the Applicant's mark may not be pronounced when encountered aurally and may therefore be overlooked, the same cannot be said for the element SIR in the Opponent's mark. I do not accept the Opponent's arguments that the distinctive and dominant element of its mark lies in the forename/surname EDWARD'S. It is my view that the name and title in the earlier mark, both contribute to the mark's distinctiveness, particularly given the unusual title. It is unlikely that consumers would misremember one trade mark for the other, even for highly similar goods and where

the only shared element is a commonly used forename/surname of low distinctive character. I do not consider there would be a likelihood of direct confusion.

70. In so far as indirect confusion is concerned and its distinction from direct confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, sitting 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 recognised 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, I conclude that it is another brand of the owner of the earlier mark.

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).”

71. Furthermore, in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor QC, sitting as the Appointed Person, stressed that the finding of indirect confusion should not be made merely because two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark; this is association not indirect confusion. However, I recognise that a mark possessing a low distinctive characteristic does not necessarily preclude a likelihood of confusion.¹⁰

72. This is, in my view, the position in the case before me. The shared common element is not so strikingly distinctive that consumers would assume that only the Opponent would be using it in a trade mark. In my view it would be implausible for consumers to believe that there is an economic link between them, merely because they share the name EDWARDS/EDWARD’S and unlikely that consumers would regard the goods as being provided by the same or related undertaking. Even where the number 1902 is overlooked, I see no reason why consumers would consider that the applied for mark had dropped the SIR element from its brand to diversify into a different market or product range. I do not consider that the applied for mark combining a common name with a date (and without the title SIR) would be regarded as a logical sub brand or vice versa; they are more likely to consider that the same or similar name has coincidentally been chosen. I find it improbable that consumers would acknowledge the differences between the respective marks but still conclude that the one mark is a brand extension or sub brand of the other or that the goods are provided by one and the same undertaking. I do not consider that there would be a likelihood of direct or indirect confusion.

73. Based on these conclusions, the opposition under section 5(2)(b) of the Act fails and subject to any successful appeal, the application can proceed to registration.

¹⁰ *L’Oréal SA v OHIM C-235/05 P*

Costs

74. As the Applicant has been successful it is entitled to a contribution towards its costs. Award of costs in proceedings are based upon the scale as set out in Tribunal Practice Note 2 of 2016. Applying that guidance, I award costs to the Applicant on the following basis:

Preparing a defence and counterstatement:	£200
Preparing evidence and considering the Opponent's evidence and submissions:	£500
Preparing for and attending a hearing including drafting skeleton arguments:	£1000
Total:	£1,700

75. I order Bardinnet to pay The Humble Potato Co. Ltd the sum of £1,700 as a contribution towards its costs. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case, if any appeal against this decision is unsuccessful.

Dated this 22nd day of October 2020

Leisa Davies
For the Registrar