

O/534/20

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NOS. UK00003379484 AND  
UK000003379488 BY  
SPIRIT STILL LTD  
TO REGISTER THE FOLLOWING TRADE MARKS:

**SPIRIT STILL**

AND



(SERIES OF 2)

AS TRADE MARKS IN CLASSES 33, 35 AND 41

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO  
UNDER NOS. 417026 AND 417031 BY  
TURL STREET VENTURES LTD

## BACKGROUND AND PLEADINGS

1. On 28 February 2019, Spirit Still Ltd (“the applicant”) applied to register the following trade marks in the UK:

SPIRIT STILL

(“the first application”); and



(“the second application”)

2. The first and second applications (collectively “the applications”) were published for opposition purposes on 19 April 2019. The applications share identical specifications. The applicant seeks registration for the goods and services shown in the **Annex** to this decision.
3. The applications were partially opposed on 18 July 2019 by Turl Street Ventures Ltd (“the opponent”). The opposition against the first application is based on sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opposition against the second application is based on section 5(2)(b) of the Act. For both oppositions, the opponent relies on the following mark:

Spirit Still

UK registration no. 3281752

Filing date 10 January 2018; registration date 7 February 2020

Relying on all goods and services namely:

Class 33: Alcoholic beverages (except beers); spirits; whisky, whiskey; scotch whisky; whisky liqueurs; alcoholic wines; liqueurs; alcopops; alcoholic cocktails; excluding the sale of spirit essences and flavourings, yeast, ingredients for brewing of beers and ingredients for the making of wines, spirits and liqueurs.

Class 41: Education services namely whisky, whiskey and other spirit (drink) tasting; Entertainment services namely, whisky, whiskey and other spirit (drink) tasting services; none of the aforesaid relating to beer, yeast, homebrewing, still technology, distillation equipment, spirit essences or flavourings.

("the opponent's mark")

4. The oppositions are directed against the goods and services set out at paragraph 28 below only.
5. In its notice of opposition in respect of the first application, the opponent submits that:

"As the trade marks are identical they have the same linguistic and auditory components. Thus, when reading or hearing the trade mark, they would think that they are the same mark and lead to confusion and association with the owner of the earlier mark"

6. In its notice of opposition in respect of the second application, the opponent submits that:

"As the trade marks are similar i.e. the later mark contains 'Spirit Still' written in a logo, this written component of the mark has the same linguistic and auditory components. Thus, when reading or hearing the trade mark, they would think that they are the same mark and lead to confusion and association with the owner of the earlier mark."

7. The applicant filed counterstatements denying the claims made.
8. By letter dated 29 October 2019, the Registry confirmed to the parties that the proceedings were to be consolidated pursuant to Rule 62(g) of the Trade Marks Rules 2008.
9. The applicant is represented by Trade Mark Wizards and the opponent is unrepresented. Only the opponent has filed evidence. Both parties filed written submissions during the evidence round. No hearing was requested and neither party filed written submissions in lieu of a hearing. I have taken the evidence and the written submissions into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

## **PRELIMINARY ISSUE**

10. In both of its counterstatements, the applicant stated that:

“The Applicant, however, has been trading and providing training in the realm of spirits under the name Spirit Still since 2015. Consequently, the applicant is the owner of an earlier unregistered right, resulting from heavy investment in its brand and has amassed goodwill in the same.”

11. For reasons that I will now explain, the applicant’s comments regarding its ownership of an earlier unregistered right have no bearing on the outcome of this opposition.
12. The proviso referred to by the applicant relating to ownership of an earlier unregistered right applies where an opposition or application for invalidation under section 5(4)(a) of the Act is raised. That is, where a trade mark shall not be registered (or shall be invalidated) because its use would be contrary to law of passing off, due to the fact that an earlier unregistered right exists. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent’s mark being applied for/registered, is not a defence in law to the

opposition under section 5 of the Act. Tribunal Practice Notice 4/2009 explains this as follows:

*“The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker’s mark.*

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker’s mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker’s mark.”

13. As set out in the above Tribunal Practice Notice, if the applicant wanted to challenge the validity of the opponent’s mark, then the correct course of action would have been to issue proceedings for invalidation. The applicant has not done so. The outcome of this opposition will, therefore, be determined after making a global assessment whilst taking into account all relevant factors and the existence of an earlier unregistered right by the applicant is not relevant to that assessment.

## **EVIDENCE**

14. The opponent has submitted evidence in the form of the witness statement of Adam Irvine dated 30 December 2019, being the opponent’s director. The evidence mainly focuses on the use of the opponent’s mark. The evidence shows

use of the opponent's mark in the form of the following logo and on bottles of alcohol<sup>1</sup>:



15. The evidence goes on to explain that the device element to the left of the above image is a graphical representation of a still.<sup>3</sup>

16. To the extent that the opponent's evidence may relate to its mark having obtained an enhanced level of distinctive character through use, I will deal with this issue further below where appropriate.

## **DECISION**

### **Section 5: legislation**

17. Section 5(1) of the Act reads as follows:

“(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

18. Section 5(2) of the Act reads as follows:

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

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

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<sup>1</sup> Exhibit JS2

<sup>2</sup> Exhibit JS1

<sup>3</sup> Exhibit JS3

(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 or association with the earlier trade mark.”

19. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

20. 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.”

21. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. As the opponent’s mark had not completed its registration process more than 5 years before the date of the applications in issue, it is not

subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods and services for which its mark is registered.

### **Section 5(1)**

22. The opposition based on section 5(1) of the Act is aimed at the first application only.

### **Identity of the marks**

23. It is a pre-requisite of section 5(1) of the Act that the trade marks are identical.

24. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

25. Additionally, Mr Iain Purvis QC, sitting as the Appointed Person in *Groupement Des Cartes Bancaires v China Construction Bank Corporation*, Case BL O/281/14 stated that:

“21... It is well established that a ‘word mark’ protects the word itself, not simply the word presented in the particular font or capitalization which appears in the Register of Trade Marks [...] A word may therefore be presented in a different way (for example a different font, capitals as opposed to small letters, or handwriting as opposed to print) from that which appears in the Register whilst remaining ‘identical’ to the registered mark.”

26. Both marks are word only marks. The opponent’s mark is presented as ‘Spirit Still’ whereas the first application is presented in capital letters as ‘SPIRIT STILL’. As set out in the case law above, word only marks will remain identical despite the fact

one is uppercase and the other is not. Consequently, the first application is identical to the opponent's mark and therefore, the objection under section 5(1) of the Act may proceed.

**Comparison of goods and services**

27. As the applications share identical specifications, the following comparison will apply to both of the applicant's specifications.

28. The competing goods and services are set out as follows:

The opponent's goods and services	The applicant's goods and services
<p><u>Class 33</u> Alcoholic beverages (except beers); spirits; whisky, whiskey; scotch whisky; whisky liqueurs; alcoholic wines; liqueurs; alcopops; alcoholic cocktails; excluding the sale of spirit essences and flavourings, yeast, ingredients for brewing of beers and ingredients for the making of wines, spirits and liqueurs.</p> <p><u>Class 41</u> Education services namely whisky, whiskey and other spirit (drink) tasting; Entertainment services namely, whisky, whiskey and other spirit (drink) tasting services; none of the aforesaid relating to beer, yeast, homebrewing, still technology, distillation equipment, spirit essences or flavourings.</p>	<p><u>Class 33</u> Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; raspberry cocktails; grapefruit cocktails; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk; alcoholic cocktails in the form of chilled gelatines.</p>

Class 35

Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, alcoholic extracts, alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, preparations for making alcoholic beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

Class 41

Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-

	<p>alcoholic drinks, alcoholic cocktails and other alcoholic drinks; organisation of entertainment events; education in the field of alcoholic drinks, particularly spirits; providing of training in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting and cultural activities in connection with alcoholic beverages; organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages.</p>
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29. For the purposes of this decision, I am required to assess the goods and services comparison in respect of separate objections under sections 5(1), 5(2)(a) and 5(2)(b) of the Act. For the purposes of my assessment under section 5(1) of the Act, the matter will only proceed if I find identity between the goods and services in both parties' marks. For any goods or services that are not identical, the opposition based on section 5(1) will fail. However, I will proceed to undertake a full comparison of goods and services at this stage and will refer back to it when assessing the oppositions under sections 5(2)(a) and 5(2)(b) of the Act.

30. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

31. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(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.

32. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonization in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

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

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

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

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

34. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

35. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

36. Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

37. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

38. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

39. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*<sup>4</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>5</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>6</sup>, Mr Hobbs concluded that:

“i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).”

### Class 33 goods

40. “Alcopops” in the applicant's specifications has a direct counterpart in the opponent's mark's specification. These goods are therefore identical.

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<sup>4</sup> Case C-411/13P

<sup>5</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>6</sup> Case C-398/07P

41. “Malt whisky” in the applicant’s specifications is a type of whisky and will fall within the broader category of “whisky, whiskey” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*.
42. “Alcoholic beverages” in the applicant’s specifications describes all types of alcoholic beverages. Given that these goods are listed in class 33, it follows that the alcoholic beverages referred to do not include beers. This is because the category of beers falls within class 32. These goods are therefore identical to “alcoholic beverages (except beers)” in the opponent’s mark’s specification.
43. “Alcoholic beverages containing vodka”, “vodka mixtures” and “mixed alcoholic drinks containing vodka” in the applicant’s specifications all describe a type of ready to drink beverage that contains vodka, which is an alcoholic spirit. These goods will fall within the category of “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
44. A cordial can either refer to a concentrated fruit drink or be used as another word for liqueur.<sup>7</sup> Given that both “alcoholic cordials” and “alcoholic cordials containing vodka” in the applicant’s specifications contain alcohol, I am of the view that these goods refer to liqueurs. Given that liqueur is an alcoholic beverage, these goods will fall within the category of “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
45. “Cider”, “sangria”, “alcoholic energy drinks”, “alcoholic energy drinks containing vodka” and “alcoholic beverages containing fruit and milk” in the applicant’s specifications all describe types of alcoholic beverages that are not beers. These goods will fall within the category of “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.

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<sup>7</sup> <https://www.collinsdictionary.com/dictionary/english/cordial>

46. Given that “wine”, “red wine” and “white wine” in the applicant’s specifications are listed within Class 33, they describe various types of alcoholic wine. These goods will therefore fall within the category of “alcoholic wines” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*.
47. “Port”, “sherry” and “vermouth” in the applicant’s specifications are all types of alcoholic fortified wines and will therefore fall within the categories of “alcoholic wines” and “alcoholic beverages (except beer)” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*.
48. “Vodka”, “brandy”, “gin”, “rum”, “kirsch”, “arrack”, “arak”, “cachaça”, “sake” and “schnapps” in the applicant’s specifications are all types of spirits. These goods fall within the broader categories of “spirits” and “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
49. “Grappa” and “calvados” in the applicant’s specifications describe different types of brandy. Given that brandy is a spirit, these goods will fall within the categories of “spirits” and “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*.
50. “Cocktails”, “prepared wine cocktails”, “raspberry cocktails” and “grapefruit cocktails” in the applicant’s specifications, given their inclusion in class 33 of the goods specification, all refer to cocktails that contain alcohol. As a result, they fall within the broader categories of “alcoholic cocktails” and “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods are therefore identical under the principle outlined in *Meric*.
51. “Aperitifs” in the applicant’s specifications describes an alcoholic beverage that is commonly served either before or after a meal. These goods will fall within the category of “alcoholic beverages (except beers)” in the opponent’s mark’s

specification. These goods will therefore be identical under the principle outlined in *Meric*.

52. “Anisette” in the applicant’s specifications describes an alcoholic beverage that is flavoured with anise. These goods will fall within the category of “alcoholic beverages (except beers)” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*.

53. “Alcoholic cocktails in the form of chilled gelatines” in the applicant’s specifications commonly describes some form of alcoholic cocktail that is set with gelatin. These goods will fall within the category of “alcoholic cocktails” in the opponent’s mark’s specification. These goods will therefore be identical under the principle outlined in *Meric*. However, if I am wrong in my finding that these goods are identical, they will overlap in user and purpose. The user will be the same in that it will be a member of the general public who wishes to consume alcohol. Further, the purpose for these goods will be to consume alcohol. There will also be an overlap in trade channels and a degree of competition between the goods. These goods will therefore be similar to a high degree.

54. “Alcoholic bitters containing vodka” and “alcoholic bitters” in the applicant’s specifications describe pre-mixed alcoholic beverages or liqueurs that contain alcohol. These goods will fall within the broader categories of “alcoholic beverages (except beers)” and “alcoholic cocktails” in the opponent’s mark’s specifications. These goods will therefore be identical under the principle outlined in *Meric*.

55. In the absence of any submissions to the contrary, I find that “alcoholic extracts” and “alcohol extracts containing vodka” in the applicant’s specifications describe an alcoholic ingredient that is used as a preparation for making alcoholic beverages. In the case of *Les Éditions* (cited above), the GC found that just because one good is used as a part of another product (in this case, an ingredient), that does not automatically give rise to a finding of similarity. However, I find that there may be a degree of overlap in user with “alcoholic beverages (except beers)” in the opponent’s mark’s specification. The end user of these goods may be the same in that they will include members of the general public who wish to consume

an alcoholic beverage. For example, members of the general public may either purchase ready-made alcoholic drinks, or buy products to enable them to make their own. However, the main user for these ingredients is likely to be businesses engaged in the manufacture of alcoholic beverages. Any overlap in user or any competition between these goods is, therefore, likely to be limited. I find that these goods are similar to a low degree.

### Class 35 services

56. Within its specification, the applicant seeks registration for the following services:

“Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, alcoholic extracts, alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, preparations for making alcoholic beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.”

57. As set out above, the GC has explained that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. It is common for a maker of alcoholic beverages to also retail in those beverages. For example, a whisky distillery or a vineyard will offer tours to members of the public and will commonly conclude in a gift shop or bar selling their own alcoholic beverages. The average consumer will be aware of the complementary relationship between a creator of an alcoholic beverage and the retailing of such goods. For the goods that I have found identical in my class 33 goods comparison above, it follows that a medium degree of similarity exists between the opponent's goods and the services within the

applicant's class 35 specifications which relate to identical goods. I, therefore, find that the following services in the applicant's specifications are similar to a medium degree with various goods contained in the opponent's mark's specification:

“Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, [...] alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, [...] alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, [...] raspberry cocktails, grapefruit cocktails, [...] alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.”

58. However, given the greater differences between the goods that I have found to be similar to medium or low degree, the above finding does not apply. I must therefore assess the retail and online services for those respective goods separately below.

59. As above, I have found “alcoholic cocktails in the form of chilled gelatines” in the applicant's specification to be identical or highly similar to “alcoholic beverages (except alcohol)” and “alcoholic cocktails” in the opponent's mark's specification. Given that the retail of these goods is the retail of alcoholic goods, there will be overlap in user and trade channels. The goods and services will be complementary. I therefore find “retail and online retail services in relation to the sale of [...] alcoholic cocktails in the form of chilled gelatines” is similar to a medium degree with “alcoholic beverages (except alcohol)” and “alcoholic cocktails” in the opponent's mark's specification.

60. As above, I have found “alcoholic extracts” and “alcoholic extracts containing vodka” in the applicant's specification to be similar to a low degree with “alcoholic beverages (except alcohol)” and “alcoholic cocktails” in the opponent's mark's specification. I have also found above that the main user for these ingredients is likely to be businesses engaged in the manufacture of alcoholic beverages, although some members of the general public will also use the products. As a

result, there will only be a limited degree of overlap in user of these goods and services. There will be no overlap in nature, trade channels, method of use or purpose. There will also be no competition or complementarity. I do not consider that overlap in user, in itself, is sufficient for a finding of similarity. In the absence of any submissions to assist me, I do not consider that any of the opponent's services put it in any stronger position. Therefore, I find that "retail and online retail services in relation to the sale of [...] alcoholic extracts [and] alcoholic extracts containing vodka" in the applicant's specifications is dissimilar to any goods or services listed in the opponent's specification.

61. "Retail and online retail services in relation to the sale of [...] preparations for making alcoholic beverages" does not fall within any of the goods or services within the opponent's specification. For the same reasons set out above in relation to "alcoholic extracts", I consider that there is only a limited overlap in user, which is insufficient on its own for a finding of similarity. I do not consider that any of the opponent's services put it in a stronger position. I find that these services are dissimilar to the goods and services contained in the opponent's specification.

#### Class 41 services

62. "Education services namely whisky, whiskey and other spirit (drink) tasting" and "entertainment services namely, whisky, whiskey and other spirit (drink) tasting services" in the opponent's mark's specification specifically describe education and entertainment services in relation to the tasting of whisky, whiskey and other spirits, which are alcoholic beverages. These services will, therefore, be *Merici* identical to "events relating to alcohol tastings" in the applicant's specifications. Even where the term covered by the applicant's specifications includes services that are not educational or entertainment events relating to the tasting of whisky, whiskey and other spirits, there will still be overlap in user, use, method of use, nature and trade channels in that they will still be alcohol tasting events. The services will therefore be highly similar.

63. As set out above, "entertainment services namely, whisky, whiskey and other spirit (drink) tasting services" in the opponent's mark's specification specifically

describes entertainment services in relation to the tasting of whisky, whiskey and other spirits, all of which are alcoholic beverages. These services will fall within the category of “entertainment in connection with alcoholic beverages” in the applicant’s specification. These services will therefore be identical under the principle outlined in *Meric*. Even where the term covered by the applicant’s specifications includes services that do not relate to the tasting of whisky, whiskey and other spirits, there will still be overlap in user, use, method of use, nature and trade channels in that they both describe entertainment events involving alcoholic beverages. These services will therefore be highly similar.

64. “Implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks” in the applicant’s specifications describes the carrying out of entertainment events in relation to a broad range of non-alcoholic and alcoholic cocktails and drinks. I am of the view that the provision of an entertainment service and the implementation of the entertainment event are the same thing. “Entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” will fall within this broader category. These services will therefore be identical under the principle outlined in *Meric*. Even where the term covered by the applicant’s specifications includes services that are not entertainment events relating to the tasting of whisky, whiskey and other spirits (such as in relation to non-alcoholic drinks), there will still be overlap in user, use, method of use, nature and trade channels. These services will be similar to at least a medium degree.

65. Without any submissions to the contrary, I am of the view that “sporting and cultural activities in connection with alcoholic beverages” in the applicant’s specifications describes the provision of services surrounding sporting and cultural events wherein alcoholic beverages are served. I am of the view that while these services may be for educational or entertainment purposes, they are not likely to include tastings. These services therefore have no direct counterpart in the opponent’s marks’ specification. They will however overlap in user, nature and purpose with “entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” in the opponent’s mark’s specification. The nature of these services are that they are events wherein alcohol is provided and consumed. The purpose of

these services will be to provide entertainment to the consumer and will also involve alcoholic beverages being consumed. There may also be an overlap in trade channels in that a provider of a sporting or cultural activity may also provide entertainment events. These services will therefore be similar to between a medium and high degree.

66. “Organization of exhibitions for cultural or educational purposes on alcoholic beverages” within the applicant’s specifications describes the organization of services surrounding cultural or educational exhibitions wherein the subject is alcoholic beverages. I am of the view that while these services may be for educational purposes, they are not likely to include tastings. These services therefore have no direct counterpart in the opponent’s marks’ specifications. They will however overlap in user, nature and purpose with “education services namely whisky, whiskey and other spirit (drink) tasting” in the opponent’s mark’s specification. The nature of these services are that they are events wherein alcohol is the subject. The purpose of these services will be to provide education or information to the consumer regarding alcoholic beverages. There may also be an overlap in trade channels in that a provider of a cultural or educational exhibition may also provide educational alcohol tasting events. These services will therefore be similar to between a medium and high degree.

67. Without any submissions to the contrary, I find that “organization of competitions (education or entertainment) on the subject of alcoholic beverages” in the applicant’s specifications are likely to describe events such as quizzes wherein the subject is alcoholic beverages. These services have no direct counterpart within the opponent’s mark’s specification; however, they will overlap in purpose with “entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” in the opponent’s mark’s specification. The purpose of the applicant’s services is to provide entertainment to the consumer, which is the same as the opponent’s services. The user will overlap to the extent that both events will be attended by members of the general public. Additionally, there may be a degree of competition between the services in that a consumer could choose between different types of entertainment events. I find that these services will be similar to a medium degree.

68. “Organisation of alcohol tasting events” and “organising events relating to alcohol” in the applicant’s specifications describe the services of organizing alcohol-related events and alcohol tasting events. I consider that “entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” in the opponent’s mark’s specification will fall within these broader categories. These services will therefore be identical under the principle outlined in *Meric*. Even where the term covered by the applicant’s specification includes services that are not entertainment events relating to the tasting of whisky, whiskey and other spirits, there will still be overlap in user, use, method of use, nature and trade channels and the services will be highly similar.

69. “Organisation of entertainment events” in the applicant’s specifications is a broad service that can include the organization of various entertainment events, such as music concerts or theatre productions. It can also include events such as the tasting of whisky, whiskey or other spirits for entertainment reasons. “Entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” in the opponent’s mark’s specification will fall within this broader category. Insofar as the applicant’s services will cover entertainment tasting events for whisky, whiskey or other spirits, these services will be identical under the principle outlined in *Meric*. However, in relation to services covered by the applicant’s term which are outside of the field of alcohol tasting events, I consider that the services will be dissimilar. I have given further consideration of this term in relation to the Tribunal Practice Notice 2/2012<sup>8</sup> and will address this separately in my final remarks below.

70. “Education services relating to alcohol namely whiskey” and “education in the field of alcoholic drinks, particularly spirits” in the applicant’s specifications are broad categories that cover various types of education services relating to different types of alcoholic beverages. “Education services namely whisky, whiskey and other spirit (drink) tasting” in the opponent’s mark’s specification will fall within these categories of services. These services will therefore be identical under the principle

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<sup>8</sup> <https://webarchive.nationalarchives.gov.uk/20140714074028/http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2012/p-tpn-12012.htm>

outlined in *Meric*. Even where the terms covered by the applicant's specifications include services that are not educational tasting events for whisky, whiskey or other spirits, there will still be overlap in user, use, method of use, nature and trade channels. These services will all aim to provide education to the user in respect of whiskey and other types of spirits. These services will be highly similar.

71. "Providing of training in the field of alcoholic drinks, particularly spirits" in the applicant's specifications describes a service of training people in the field of spirits. These services will overlap in nature, purpose and trade channels with "education services namely whisky, whiskey and other spirit (drink) tasting" in the opponent's mark's specification. To provide training is to educate a person so that they may become proficient in the topic within which they are trained, meaning that these services will both be educational in nature and purpose. These services may also overlap in trade channels in that an undertaking that provides educational alcoholic tasting events may also provide more in-depth training in the field of alcoholic drinks, particularly spirits. I find that these services will be similar to at least a medium degree.

72. As set out above, a requirement of an opposition based on section 5(1) of the Act is that the goods and services are identical. I have found the majority of goods and services in the applicant's first specification to be identical. The opposition against those goods and services, therefore succeeds. In relation to those goods and services that I have found to be similar (and not identical) the opposition based upon section 5(1) must fail. I will, therefore, now go on to consider the oppositions based upon sections 5(2)(a) and 5(2)(b) of the Act.

### **Section 5(2)(a) and (b)**

73. The opposition based on section 5(2)(a) of the Act is aimed at the first application only. The opposition based on section 5(2)(b) of the Act is aimed at the second application only.

74. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM"), Case C-3/03, Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.*

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

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

75. The oppositions based on sections 5(2)(a) and 5(2)(b) of the Act rely upon the same mark. It is necessary to assess the distinctive character of the opponent's mark.

76. 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-2779, 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).”

77. 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 distinctive character of the earlier mark can also be enhanced by virtue of the use made of it.

78. The opponent has not pleaded that its mark has acquired enhanced distinctiveness. However, for the sake of completeness, I note the following. The evidence provided by the opponent does not provide any information about the market share held by the opponent’s mark for the goods and services for which it is registered. It also provides no information about sales figures to enable me to assess the extent of the use that has been made of it. No information is provided about where the mark has been used to enable me to assess the geographical spread of any use. I note that Mr Irvine has provided photographs of three products bearing the logo shown at paragraph 14 above, that he states were launched in April 2018. I also note that Mr Irvine has been a director of the opponent since 2014. However, it is not clear to me from the information provided whether the mark relied upon has been used since 2014 or whether the opponent only started using it in April 2018 with the launch of the products mentioned. No information is provided by the opponent about how much has been invested in promoting the mark relied upon or what steps have been taken to advertise under the mark. I, therefore, do not consider that the evidence filed is sufficient to show that the

opponent's mark has acquired an enhanced level of distinctive character. Consequently, I have only the inherent position to consider. The opponent's mark is a work only mark that consists of the words 'Spirit Still'.

79. The word 'Spirit' has multiple meanings. It is, therefore, necessary to consider the meaning of the word in relation to the opponent's goods and services. Given that all the opponent's goods and services relate to alcohol, I am of the view that average consumers would link the word 'Spirit' to alcoholic spirits, even on goods that are not spirits (such as alcopops or cocktails). In this context, the word 'Spirit' will be descriptive of the goods and services offered by the opponent's mark. The word 'Still' also has multiple meanings. A 'still' in the context of alcoholic spirits is an apparatus for carrying out distillation that is used in the manufacture of spirits.<sup>9</sup> The word 'still' can also mean motionless or stationary. While it may be the case that the word 'Still' in this context is a reference to an apparatus used in the manufacture of spirits, I do not find that a significant proportion of average consumers would make that connection. I, therefore, find that a significant proportion of average consumers would be likely consider the word to mean motionless or stationary.

80. While the word 'Spirit' on its own will be seen as descriptive, I am of the view that, when taken as a whole, the opponent's mark will be viewed by average consumers as an unusual combination of two ordinary words that, in combination, will convey no obvious meaning. I therefore find that the distinctiveness of the mark will be attributed to the combination of the words themselves. Overall, I consider that the opponent's mark has no more than a medium degree of inherent distinctive character.

### **Comparison of the marks**

81. It is a pre-requisite of section 5(2)(a) of the Act that the trade marks are identical. I have found at paragraph 26 above that the first application and the opponent's mark are identical and, therefore, the opposition against the first application based

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<sup>9</sup> <https://www.collinsdictionary.com/dictionary/english/still>

on section 5(2)(a) of the Act may proceed. I will now move on to consider the similarity of the second application under the opposition based on section 5(2)(b) of the Act.

82. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

83. 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.”

84. 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.

85. The respective trade marks are shown below:

The opponent's mark	The second application
<p>Spirit Still ("the opponent's mark")</p>	 <p>(series of 2)</p>

### Overall Impression

86. In its counterstatement, the applicant submits that:

“the Applicant’s trade mark is a highly distinctive logo. The red shape of a spirit/creature is contained in a circle which also contained the date of foundation of the company (2015)”

87. The opponent submits that “The shape in the circle is not a spirit/creature, it is a depiction of a ‘still’, a vessel that is used to distil spirits.”

### *The second application*

88. The second application is a series of two marks. The only difference in the marks within the series is that the first in the series is maroon and white whereas the second in the series is black and white.

89. The application consists of two separate word elements and two device elements. The word elements are the words ‘Spirit Still’ and the word/number ‘ESTD 2015’. The device elements consist of an unusual shaped device that sits in the centre of the application and a circular border device that encompasses all other elements. The words ‘Spirit Still’ sit within and towards the bottom of the shaped device and are displayed in white. The word ‘ESTD’ sits to the left of the shaped device and

the number '2015' sits to the right of the shaped device. 'ESTD 2015' is displayed in maroon (in the first in the series) or black (in the second in the series).

90. I find that the word 'Spirit' will be seen by the average consumer as a reference to alcoholic spirits and, therefore, descriptive of the goods for which the applicant seeks to protect. However, when viewed together I consider that the words 'Spirit Still' will be viewed by average consumers as an unusual combination of two ordinary words that will convey no obvious meaning. The words 'ESTD 2015' indicate that the company was established in 2015 and, as a result, will have little trade mark significance.

91. I do not agree with the applicant that the shaped device will be viewed as a spirit or creature. I also do not consider that a significant proportion of average consumers will see the device as a still. I find that a significant proportion of average consumers will view the device as simply an unusual shape. The circular device acts as a border only.

92. While I am of the view that the eye is naturally drawn to the elements of the mark that can be read, I note the size of the shaped device element in relation to the other elements of the mark. Therefore, I consider that the words 'Spirit Still' and the shaped device element play equal roles in the overall impression of the mark, with the circular device and the words 'EST 2015' playing a lesser role.

#### *The opponent's mark*

93. The opponent's mark consists of the words 'Spirit Still'. There are no other elements to contribute to the overall impression, which lies in the combination of these words.

#### Visual Comparison

94. Visually, the marks coincide in the words 'Spirit Still' which are identical. The marks differ in the word/number 'ESTD 2015', the circular border element and the shaped device element that are all present in the second application and are absent in the

opponent's mark. I have found that the words 'Spirit Still' and the shaped device element play an equal role in the overall impression of the second application. Therefore, the shaped device element will not be overlooked. Further, while I have found that the, the word/number 'EST 2015' and the circular device element play a lesser role in the overall impression of the mark, they will still constitute a visual difference between the marks. I note that the opponent's mark is a word only mark and can be used in any standard typeface and registration in black and white will cover the use of the mark in different colours. Taking all of this into account, I find that the marks are visually similar to a medium degree.

### Aural Comparison

95. Aurally, the second application consists of three syllables that will be pronounced 'SPI-RIT-STILL'. The opponent's mark consists of three syllables that will also be pronounced, 'SPI-RIT-STILL'. The device elements in the second application will not be pronounced. Further, I find that 'EST 2015' within the second application will not be pronounced. I therefore conclude that the marks are aurally identical. However, if 'EST 2015' is pronounced, the marks will be aurally similar to a medium degree.

### Conceptual Comparison

96. The only parts of the marks that will convey a conceptual message to average consumers are the marks' respective word elements. As noted above, I do not consider that the device element of the second application will convey any clear conceptual message. In assessing the distinctive character of the opponent's mark and the overall impression of the marks, I have found that a significant proportion of average consumers would connect the word 'SPIRIT' on the goods and services at issue to alcoholic spirits. The word 'Spirit' in both marks is, therefore, conceptually identical. I have also found that a significant proportion of average consumers would see the word 'STILL' as meaning motionless or stationary. Even if I am wrong and a significant proportion of average consumers would connect the word to a device for distilling spirits, the same understanding of the word would be applied to both marks and the words will be conceptually identical.

97. I have found that the words 'EST 2015' will be seen as 'Established 2015' indicating when the brand was founded. While the conceptual message conveyed by 'EST 2015' will not be significant, it does act as a point of conceptual difference between the marks. Overall, I find that the conceptual meaning conveyed by the marks is similar to a high degree.

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

98. At paragraphs 40 to 71 of this decision, I have undertaken a detailed assessment on the comparison of the goods and services contained within the applicant's specifications and the opponent's mark's specification. I will apply those findings to this assessment.

99. As some degree of similarity between the goods and services is necessary to engage the test for likelihood of confusion, the opposition under sections 5(2)(a) and 5(2)(b) must fail in respect of those services in the applicant's specification that I have found to be dissimilar to the opponent's goods and services.<sup>10</sup>

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

100. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. 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

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<sup>10</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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.”

101. The opponent submits that “The average consumer of bottled spirits and entertainment services is a retail consumer.”

### Class 33 goods

102. I find that the average consumer of the goods at issue will be a member of the general public over the age of 18 or a professional user (in relation to alcoholic extracts). The goods at issue are most likely to be sold through a range of retail outlets such as supermarkets and off-licences, their online equivalents or specialist suppliers. Some of the goods will also be sold in restaurants, bars and public houses. In retail outlets, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as restaurants, bars and public houses, the goods are likely to be on display, for example, behind the counter at bars or on drinks menus. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

103. The goods at issue are not everyday beverage products but are likely to be purchased on a semi-regular basis. The costs of the goods at issue will likely be fairly inexpensive. When selecting the goods, the average consumer is likely to consider such things as the origin of the goods, the age of the goods, size, flavour, use by/best before dates and alcoholic content. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the goods.

### Class 35 services

104. I find that the average consumer of the services within class 35 of the applicant's specifications will be a member of the general public over the age of 18. These services are most likely to be selected having considered, for example, promotional material (in hard copy and online) and signage appearing on the high street. For online retail services, the services are likely to be selected after viewing online advertising or search engine links. Visual considerations will be an important part of the selection process. Such services are also very likely to be the subject of word-of-mouth recommendations meaning that aural considerations will not be an insignificant feature of the selection process. When selecting these services, the average consumer is likely to consider such things as stock, price of goods offered in comparison to other retailers, delivery method (for online retail only) and expertise/knowledge of staff. I find that the average consumer is likely to pay a medium degree of attention during the selection process of the services.

### Class 41 services

105. I find that the average consumer for the majority of the parties' class 41 services will be a member of the general public over the age of 18. While I do recognise that some members of the general public may wish to use the service "providing of training in the field of alcoholic drinks, particularly spirits" in the applicant's specification, I find that the average consumer will likely be members of the alcohol trade who are seeking to gain training in the field of alcoholic drinks, particularly spirits.

106. These services are most likely to be selected having considered promotional material (in hard copy and online). While visual considerations will be an important part of the selection process, such services are also very likely to be the subject of word-of-mouth recommendations. Additionally, I do not discount the fact that the average consumer may seek advice in person or via telephone from an organizer of such services. This means that aural considerations will not be an insignificant feature of the selection process.

107. The purchase of the majority of these services is likely to be infrequent. The costs of the services at issue will likely be fairly inexpensive. When selecting the services, the average consumer is likely to consider such things as cost, location of the service, length of the service provided, whether there will be any complementary drinks included, the type of goods on offer during the service and who will be hosting the service. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the services.

108. The purchase of the service of “providing of training in the field of alcoholic drinks, particularly spirits” and some of the applicant’s other education services, is likely to be infrequent. The cost of these services is likely to be more expensive in that it includes specialised training or education in a specific field. I am of the view that the average consumer is likely to consider such things as cost, who will be providing the training, duration of the training, whether there will be any tests/exams and possibly job/career prospects that stem from such training. The average consumer is, therefore, likely to pay between a medium and high degree of attention during the selection process of the services.

### **Likelihood of confusion**

109. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises that the marks are not the same but puts the similarity that exists between the marks and goods/services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods/services and vice versa. As mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the

opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

110. I have identified the average consumer to be a member of the general public over the age of 18 or a member of the trade. I have found that the consumer will select the goods and services through mainly visual means but I do not discount an aural component. I have concluded that the level of attention paid will be mostly medium but may be higher for some services (such as for “providing of training in the field of alcoholic drinks, particularly spirits” in the applicant’s specifications and some of the applicant’s other education services). I have found the opponent’s mark to have no more than a medium degree of inherent distinctive character. I have found the majority of the parties’ goods and services to range from being identical to similar to a low degree and I have found some services to be dissimilar.
111. I have found the opponent’s mark and the first application to be identical. Taking all of these factors into account, I am satisfied that the average consumer would likely mistake one mark for the other, even on goods or services that are similar to a low degree. This is particularly the case given the identity of the marks. I am, therefore, satisfied that there will be a likelihood of direct confusion between the first application and the opponent’s mark. I consider this to be the case notwithstanding the fact that the average consumer for some of the services may be paying a higher degree of attention during the purchasing process.
112. I have found the second application and the opponent’s mark to be visually similar to a medium degree, aurally identical (or similar to a medium degree, depending on whether all of the words/numbers are pronounced) and conceptually similar to a high degree. Taking all of these factors (and those that I have identified at paragraph 110 above) into account, I do not consider that there will be a likelihood of direct confusion between the second application and the opponent’s mark given the visual differences between them and the predominantly visual purchasing process. However, I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

“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.”

113. I have found that the words ‘Spirit Still’ and the shaped device element will play equal roles in the overall impression of the second application. Given that the opponent’s mark is a word only mark that consists of the words ‘Spirit Still’, I am of the view that the differences in stylisation and presentation of the marks will simply be seen as an alternative mark being used by the same or economically linked undertakings. For example, the marks may be used as alternatives used by the same undertaking in different contexts (such as the word only mark being used in promotional text and the device mark being used on product packaging).

114. In respect of goods and services that are similar to a medium degree or higher, I am of the view that the similarities between the marks are sufficient to offset the lesser degree of similarity in the goods. I therefore consider there to be a likelihood of indirect confusion between the opponent’s mark and the second application, even on goods that are considered similar to a medium degree. Where the goods and services are similar to only a low degree, I consider that the differences between the goods and services will offset the similarities between the marks. I therefore find that there is no likelihood of confusion between the opponent’s mark and the second application in respect of goods and services that are similar to a low degree.

## FINAL REMARKS

115. At paragraph 69 above, I discussed the term “organisation of entertainment events” in the applicant’s specifications. While I have found these services to be identical based on the principle outlined in *Meric*, I have discussed that the applicant’s term is broad and can include organisation of entertainment events such as music concerts and theatre productions. I note that organisation of these events are entirely different from the services in the opponent’s specification. I have therefore given thought to whether the applicant’s term could be amended in accordance with the Tribunal Practice Notice 1/2012<sup>11</sup>. I have concluded that the likelihood of confusion can be avoided if the applicant’s term is amended as follows: “organisation of entertainment events save for alcohol tasting events”. I therefore propose that the applicant’s specifications be amended accordingly before proceeding to registration as shown below. However, before doing so I will consider submissions from the parties.

116. Submissions on this issue must be filed within 14 days from the date of this decision. After expiration of the 14-day period, I will issue a supplemental decision whilst taking into account any submissions received. For the avoidance of doubt, the appeal period will not begin until the supplemental decision has been issued.

## CONCLUSION

117. The oppositions have had varying degrees of success which I will summarize below.

### Opposition of the first application

118. The opposition against the first application succeeds in respect of the majority of goods and services against which it was directed. The application is refused in respect of the following goods and services:

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<sup>11</sup> <https://webarchive.nationalarchives.gov.uk/20140714074028/http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2012/p-tpn-12012.htm>

**Class 33:** Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; raspberry cocktails; grapefruit cocktails; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk; alcoholic cocktails in the form of chilled gelatines.

**Class 35:** Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials [...] alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, [...] alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, [...] alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

**Class 41:** Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks; education in the field of alcoholic drinks, particularly spirits; providing of training in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting

and cultural activities in connection with alcoholic beverages; organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages.

119. As noted above, I propose that the first application proceeds to registration for the following goods and services (as amended):

**Class 33:** Preparations for making alcoholic beverages

**Class 35:** Retail and online retail services in relation to the sale of alcoholic extracts, alcoholic extracts containing vodka and preparations for making alcoholic beverages; advertising; business management; business administration; office functions; online ordering services in the field of monthly subscription food packages; online retail store services featuring monthly subscription food packages; subscription services for the delivery of prepared and fresh food; organisation of entertainment events save for alcohol tasting events; organisation, operation, management and supervision of customer loyalty schemes; sales promotions through customer loyalty programmes (for others).

**Class 41:** Publishing of newsletters in relation to alcoholic and non-alcoholic beverages; organisation of entertainment events save for alcohol tasting events; publishing of reviews; publication of books on alcoholic beverages; editing of video tapes on alcoholic beverages; electronic publication of books and journals online on alcoholic beverages.

### **Opposition of the second application**

120. The opposition against the second application succeeds in respect of the majority of goods and services against which it was directed. The second application is refused in respect of the following goods and services:

**Class 33:** Alcoholic beverages; alcoholic cordials; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; raspberry cocktails; grapefruit cocktails; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk; alcoholic cocktails in the form of chilled gelatines.

**Class 35:** Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, [...] alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, [...] alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

**Class 41:** Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks; education in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting and cultural activities in connection with alcoholic beverages;

organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages.

121. As noted above, I propose that the second application proceeds to registration for the following goods and services (as amended):

**Class 33:** Alcoholic extracts; alcoholic extracts containing vodka; preparations for making alcoholic beverages

**Class 35:** Retail and online retail services in relation to the sale of alcoholic extracts, alcoholic extracts containing vodka and preparations for making alcoholic beverages; advertising; business management; business administration; office functions; online ordering services in the field of monthly subscription food packages; online retail store services featuring monthly subscription food packages; subscription services for the delivery of prepared and fresh food; organisation, operation, management and supervision of customer loyalty schemes; sales promotions through customer loyalty programmes (for others).

**Class 41:** Publishing of newsletters in relation to alcoholic and non-alcoholic beverages; organisation of entertainment events save for alcohol tasting events; publishing of reviews; publication of books on alcoholic beverages; editing of video tapes on alcoholic beverages; electronic publication of books and journals online on alcoholic beverages.

122. The parties may file written submissions within 14 days of the date of this decision, regarding the proposed amendment to the applicant's specifications.

## **COSTS**

123. As I have provided the parties with 14 days from the date of this decision to file written submissions in respect of the proposed amendment to the applicant's specifications, I do not propose dealing with the issue of costs at this stage. Given that I will be issuing a supplementary decision after the expiry of 14 days, I reserve the position on costs until that stage.

**Dated this 28<sup>th</sup> day of October 2020**

**A COOPER**

**For the Registrar**

## Annex

Class 33: Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; alcoholic cocktails in the form of chilled gelatines; raspberry cocktails; grapefruit cocktails; preparations for making alcoholic beverages; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk.

Class 35 Advertising; business management; business administration; office functions; online ordering services in the field of monthly subscription food packages; online retail store services featuring monthly subscription food packages; subscription services for the delivery of prepared and fresh food; organisation, operation, management and supervision of customer loyalty schemes; sales promotions through customer loyalty programmes (for others); retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, alcoholic extracts, alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, preparations for making alcoholic

beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

Class 41: Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks; publishing of newsletters in relation to alcoholic and non-alcoholic beverages; organisation of entertainment events; publishing of reviews; education in the field of alcoholic drinks, particularly spirits; providing of training in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting and cultural activities in connection with alcoholic beverages; publication of books on alcoholic beverages; editing of video tapes on alcoholic beverages; organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages; electronic publication of books and journals online on alcoholic beverages.