

O-555-14

**TRADE MARKS ACT 1994**

**TRADE MARK APPLICATION NO. 3035040  
BY JEFFREY JOSHUA LAWRENCE  
TO REGISTER THE TRADE MARK**

**Tiger Gin**

**IN CLASS 33**

**AND**

**THE OPPOSITION THERETO UNDER NO. 401915  
BY EVERARDS BREWERY LIMITED**

## Background and pleadings

1. Jeffrey Joshua Lawrence applied for the trade mark Tiger Gin on 16 December 2013, in class 33, for gin. The application was published on 24 January 2014 and was subsequently opposed by Everards Brewery Limited (“the opponent”) on the basis that there is a likelihood of confusion, under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)<sup>1</sup> with the opponent’s earlier registered trade marks for TIGER, as follows:

(i) UK 1387643

TIGER

*Class 32: Bitter beer, all included in Class 32. Beer and ale, all for sale in the counties of Leicester, Derby, Northampton, Greater London, Bedford, Cambridge and Essex; but not including lager beer.*

Filing date: 15 June 1989

Date registration procedure completed: 2 October 1998

(ii) UK 2419652

TIGER

*Class 32: Beer, ale, porter, but not including lager or stout.*

*Class 43: Public house and bar services; restaurant, cafe, cafeteria, snack-bar and canteen services; catering services; hotel and boarding house services.*

Filing date: 19 April 2006

Date registration completed: 3 July 2009

2. The opponent claims that, owing to the similarities between the marks and the parties’ goods and services, there is a likelihood of confusion on the part of the relevant public. Mr Lawrence admits that the marks are similar, but denies that the goods/services are similar and therefore also denies a likelihood of confusion.

3. Although earlier mark 1387643 had been registered for more than five years on the date Mr Lawrence’s application was published, Mr Lawrence’s counterstatement did not ask the opponent to prove that it had used its mark<sup>2</sup>. Consequently, the opponent can rely upon all of its goods registered under 1387643.

4. Both parties are professionally represented. Only the applicant filed evidence. The parties were asked if they wished to be heard or for a decision to be made from

---

<sup>1</sup> Grounds under sections 5(3) and 5(4)(a) were originally pleaded, but the grounds were later struck out because no supporting evidence was filed by the opponent.

<sup>2</sup> Section 6A of the Act refers.

the papers. The applicant chose a decision from the papers; the opponent did not reply. Neither side filed written submissions in lieu of a hearing.

## **Evidence**

5. The opponent's evidence comes from Nicholas Francis Preedy, the applicant's trade mark attorney with the firm Nucleus-IP Limited. His evidence consists of copies of correspondence between the parties, which set out the applicant's position being that gin is not similar to beer, and that the applicant has no interest in beer or any beverages other than gin and gin-based drinks. Mr Preedy states that both parties are aware that the Office for Harmonisation in the Internal Market ("OHIM") has considered that "beer and wine are sufficiently different for co-existence" and that "wine and rum are sufficiently different for co-existence". In support, Mr Preedy exhibits a decision of mine, BL O/358/10 *Frederic Robinson Limited v Pavel Maslyukov* ("Old Tom"), to which I will return.

## **Decision**

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

"(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."

7. 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 great degree of similarity between the marks, and vice versa;

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

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

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

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

### Comparison of goods

8. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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.”

9. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-325/06:

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

10. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“Treat”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

11. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

12. The goods in the opponent’s earlier mark 1387643 are covered by the specification of its other mark, 2419652. As the opponent’s marks are identical, I will compare 2419652 to the application. The competing specifications are shown in the table below.

<b>Earlier mark</b>	<b>Application</b>
<p data-bbox="188 1624 699 1697">Class 32: <i>Beer, ale, porter, but not including lager or stout.</i></p> <p data-bbox="188 1733 785 1883">Class 43: <i>Public house and bar services; restaurant, cafe, cafeteria, snack-bar and canteen services; catering services; hotel and boarding house services.</i></p>	<p data-bbox="809 1624 1023 1659">Class 33: <i>Gin.</i></p>

13. The opponent has been entirely silent as to why it considers the goods and services to be similar. Its only reference to the goods and services is in its notice of opposition where it merely states that they are similar. The applicant, via Mr Preedy's evidence, relies upon my *Old Tom* decision, in which I said (the references to liqueurs and cocktails are not relevant to this decision):

"15. The Collins English Dictionary (2000 edition) primary definition of 'ale' is "a beer fermented in an open vessel using yeasts that rise to the top of the brew." Collins Dictionary gives the following definitions of liqueurs and cocktails:

*gin*: "an alcoholic drink obtained by distillation and rectification of the grain of malted barley, rye, or maize, flavoured with juniper berries";

*liqueur*: "any of several highly flavoured sweetened spirits such as kirsch or cointreau, intended to be drunk after a meal";

*cocktail*: "any mixed drink with a spirit base, usually drunk before meals."

16. Ale is sold in bottles, cans, crates or by the pint/half pint in the UK. Gin, liqueurs and cocktails are sold in much smaller measures in bars, commensurate with their much higher potency. They are sold in varying sizes of bottles in shops, but would not be drunk in the same quantity as is the case for ale. Mr Maslyukov states in his counterstatement that:

"The comparative approach may also be done by the volume of consumption. The filling method for the ale and for the gin is radically different. The gin is basically filled into the small cup of 50ml – the ale is filled into the big cup of 500-1000ml. It is enough to look on a famous art work "Gin Lane" and "Beer Street" issued by English artist William Hogarth in 1751 to understand the dramatic difference in the effect of the goods when consumed on a daily basis. Also the approach may be done by comparing the method of production which is radically different for the gin and for the ale. The smell of the two goods is radically different too, because the one is made by distillation and another - by fermentation."

Mr Maslyukov's comments are reminiscent of the findings of the GC in two cases. In *The Coca-Cola Company v OHIM*, Case T-175/06, the GC considered beer, ale and porter as opposed to wine, noting the difference in colour, taste, smell, ingredients and production methods. It considered that the relevant consumer would consider beer and wine as two distinct products, not belonging to the same family of alcoholic beverages. It found that they were not complementary but that they competed, to a certain extent, because they were both capable of meeting identical needs (consumption during a meal or as an aperitif). However, the Court said that it must be accepted that the average consumer would consider it normal for the two types of product to come from different undertakings, since the perceived differences between

them would also make it unlikely that there would be an expectation that the same undertaking would produce and market the two types of beverage. The Court noted that, in Austria, there is a tradition of producing both beer and wine and that this is done by different undertakings. Its conclusion was that there was little similarity between wines and beers (that there was any was purely on account of the possible competition between them, as mentioned above). In *Bodegas Montebello, SA v OHIM*, Case T-430/07, the Court made a comparison in that case between wine and rum. It found that wine and rum are not composed of the same ingredients, their method of production is also different, and the end products are different as regards their taste, colour and smell. Consequently, the public perceives wine and rum as different in nature. It also found that wines are normally consumed as an accompaniment to a meal but that rum is not served at a meal, so that the two types of product are consumed on different occasions. The Court observed that the alcoholic content of the two products is very different and that even though the wine and rum might share distribution channels, they will not generally be sold on the same shelves. The Court considered there was no competing or complementary consideration and concluded that wine and rum are clearly distinguished by their nature, method of production, provenance, use and alcoholic content, with the overall result that there was no similarity between them.

17. The findings of the GC are helpful in making a comparison between ale, on the one hand, and gin and gin-based drinks on the other. Although, for example, lemonade can be added to ale to make a shandy, I bear in mind that ale is generally drunk without modification whereas gin is usually drunk in combination with another component, such as tonic water or a fruit juice as a mixer. Even though they both contain alcohol, the nature of the goods is quite different: they do not belong to the same family of alcoholic beverages. As in the first of the two GC cases, it is my perception that, in the UK, the two types of product would come from different undertakings. There has been no evidence to suggest otherwise. I bear in mind that the GC said that beer and wine compete to a certain extent because they are both capable of meeting identical needs: consumption during a meal or as an aperitif. In the case before me, I think there is a further distance in that ale is not traditionally regarded as an aperitif and gin, liqueurs and cocktails are not commonly drunk during a meal. The goods are very different in relation to taste, colour, smell, alcoholic content and the measures in which they are sold. The goods are sold in different areas of shops and bars and there is no evidence of common producers of ale and gin, or of common ingredients.

18. For all these reasons, I conclude that there is no similarity between *ale* and *gin*...”

14. I went on to say that there was no similarity between ale and gin, but that if I was wrong, the similarity must be of a very low level. Having looked again at the *Coca-Cola v OHIM* judgment, it is useful to set out what the Court said. It concluded that there was little similarity between beer (and ale and porter) and wine:

“Comparison between wine and beer

63 So far as concerns, first, the nature, end users and method of use of wines and beers, ale and porter, it is correct, as argued by the applicant, that those goods constitute alcoholic beverages obtained by a fermentation process and consumed during a meal or drunk as an aperitif.

64 However, it must be stated – as did the Board of Appeal – that the basic ingredients of those beverages do not have anything in common. Alcohol is not an ingredient used in the production of those beverages, but is one of the constituents generated by that production. Moreover, although the production of each of those beverages requires a fermentation process, their respective methods of production are not limited to fermentation and are fundamentally different. Thus, crushing grapes and pouring the must into barrels cannot be assimilated to the brewing processes of beer.

65 Moreover, the fact that beer is obtained through the fermentation of malt, whereas wine is produced through the fermentation of the must of grapes, means that the end products generated differ in colour, aroma and taste. That difference in colour, aroma and taste leads the relevant consumer to perceive those two products as being different.

66 In addition, despite the fact that wine and beer may, to a certain extent, satisfy the same need – enjoyment of a drink during a meal or as an aperitif – the Court considers that the relevant consumer perceives them as two distinct products. The Board of Appeal was therefore correct to consider that wines and beers do not belong to the same family of alcoholic beverages.

67 As regards, next, the complementary nature of wine and beer as referred to in the case-law cited in paragraph 61 above, it should be borne in mind that complementary goods are goods which are closely connected in the sense that one is indispensable or important for the use of the other (see Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60). In the present case, the Court considers that wine is neither indispensable nor important for the use of beer and vice versa. There is indeed nothing to support the conclusion that a purchaser of one of those products would be led to purchase the other.

68 As to whether wine and beer are in competition with each other, it has previously been held, in a different context, that there is a degree of competition between those goods. The Court of Justice thus considered that wine and beer are, to a certain extent, capable of meeting identical needs, which means that a certain measure of mutual substitutability must be acknowledged. Nevertheless, the Court of Justice pointed out that, in view of the significant differences in quality – and, accordingly, in price – between wines, the decisive competitive relationship between wine and beer, a popular and widely consumed beverage, must be established by reference to those wines which are the most accessible to the public at large, that is to say, generally speaking, the lightest and least expensive varieties (see, by

analogy, Case 356/85 *Commission v Belgium* [1987] ECR 3299, paragraph 10; see also, Case 170/78 *Commission v United Kingdom* [1983] ECR 2265, paragraph 8, and Case C-166/98 *Socridis* [1999] ECR I-3791, paragraph 18). There appears to be nothing to indicate that that assessment does not also apply in the present case. Accordingly, it must be acknowledged, as the applicant indicates, that wine and beer are, to a certain extent, competing goods.

69 Finally, in accordance with the Board of Appeal's assessment, it must be accepted that the average Austrian consumer will consider it normal for wines, on the one hand, and beers, ale and porter, on the other, to come from different undertakings – and will therefore expect this – and that those beverages do not belong to the same family of alcoholic beverages. There is nothing to suggest that the Austrian public is not aware, and does not notice the characteristics distinguishing beer and wine as regards their composition and method of production. On the contrary, the Court considers that those differences are perceived as making it unlikely that the same undertaking would produce and market the two types of beverage at the same time. For the sake of completeness, it should be noted that it is well known that, in Austria, there is a tradition of producing both beer and wine, and that this is done by different undertakings. Consequently, the average Austrian consumer expects beers, ale and porter, on the one hand, and wines on the other, to come from different undertakings.

70 In the light of all of the preceding factors, the Court considers that, for average Austrian consumers, there is little similarity between wines and beers.”

15. I remain of the view that the element of competition between beer and gin is less than that between beer and wine. From my own experience, I think that a choice is more likely to be made between drinking wine and beer, e.g. when dining out, than between drinking beer and gin.

16. Paragraph 69 of the GC's decision refers to the fact that the average Austrian consumer would consider beer and wine to come from different undertakings. I do not see that there is any difference between an Austrian and a UK consumer as far as expectations of beer producers also producing wine is concerned: it is as unlikely in the UK as it is in Austria “that the same undertaking would produce and market the two types of beverage at the same time”. This is equally true of beer and gin. The processing of beer and spirits is very different, just as the processing of beer and wine is different. The GC did not, in *Coca-Cola*, refer to proximity of sale, although it did in *Bodegas Montebello, SA v OHIM*, finding that the alcoholic content of wine and rum is very different and that even though they might share distribution channels, they will not generally be sold on the same shelves. In that case, despite the finding about shared distribution channels, the GC found that wine and rum were “manifestly different”. Shared distribution channels was a factor considered by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Balmoral Trade Mark* [1999] RPC 297, a case earlier than the GC cases, in which he compared whisky to wine (for identical marks):

“At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different products which emanate (and are known to emanate) from producers specialising in different and distinct fields of commercial activity. This was said to render it unlikely that a producer of whisky would become (or be expected to become) a wine producer and unlikely that a producer of whisky who did become a wine producer would market (or be expected to market) his whisky and wines under the same trade mark. I was urged to accept that this made it possible for one producer to use a mark for whisky and another producer to use the same mark concurrently for wines without any real likelihood of confusion ensuing.

I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the applicant over-emphasise the part played by producers and under-emphasise the part played by other traders in the business of buying and selling whisky and wines.

It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of “own brand” or “merchant-specific” labelling. Those who supply retail customers may be licensed to do so under an “off-licence” or a licence for “on and off sales” in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well.

When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar* case (uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines.”

17. The comparison of goods factors in the two GC decisions and in *Balmoral* are weighted differently. On the one hand, the GC emphasises the different methods of production, different aroma, colour and taste of the drinks; whilst, on the other hand,

*Balmoral* cautioned against placing too much emphasis on these factors and looked, instead, at who will be selling the goods. The GC, in *Coca-Cola*, did not refer to whether there is proximity of sale or distribution channels for wine and beer. And, in *Bodegas Montebello*, although it was acknowledged that that wine and rum might share distribution channels, they will not generally be sold on the same shelves. In that decision, the weight given to the alcoholic content, methods of production, taste, smell etc of wine and rum outweighed the distribution channel similarity and so the goods were “manifestly different”. In *Coca-Cola v OHIM*, the GC considered that wine and beer were not complementary, but that there was a certain amount of competition. The conclusion was that there was “little similarity” between wine and beer. Competition does not feature in the *Balmoral* comparison.

18. Attempting to cut a path through the three authorities, the factors I have in mind in relation to the present case are:

- The different processing/manufacture of beer and gin,
- The different taste, colour and smell,
- The very different alcoholic content. Beer is a long drink and gin is a spirit, drunk in short measures
- They are not in the same ‘family’ of alcoholic beverages
- They are not complementary
- There is less competition between beer and gin than between beer and wine
- But it is common to find the sale of various alcoholic drinks in the same outlet

19. Weighing them all, including what I said in *Old Tom*, I conclude that there is a very low degree of similarity between, on the one hand, beer, ale and porter, and on the other hand, gin, based upon a very low degree of competition and the potential for shared distribution channels (and then, as in the wine v. rum GC case, they are not sold on the same shelves).

20. This leaves a comparison to be made between gin and the opponent’s services:

*Public house and bar services; restaurant, cafe, cafeteria, snack-bar and canteen services; catering services; hotel and boarding house services.*

The closest of the opponent’s services to gin are those establishments which more obviously sell alcohol, as a rule: public houses, bars, restaurants and hotels. The nature of these services, their methods of use and their purposes differ to those for gin. I bear in mind that I am not considering a service for the retailing of gin; I must consider the core meanings of the opponent’s services<sup>3</sup>. In *Balmoral*, Mr Hobbs referred to own-brand labelling. Beer is frequently sold under the brewery brand to which a pub might be tied, and a hotel or restaurant might well sell house wines under its own name (although I have never encountered the sale of own-label gin by a provider of pub, bar, restaurant or hotel services). There is no competition between the goods and the services.

---

<sup>3</sup> *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16.

Balancing the various comparison factors, there is a very low degree of similarity between public houses, bar services, restaurants, hotels and gin, and no similarity between gin and the other of the opponent's services.

#### Average consumer

21. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22. I repeat here some of what I said about the average consumer in *Old Tom*. The average consumer is the adult general public. Alcohol may be bought in shops or at a bar. In the case of beer, ale and porter, it is primarily a visual purchase; the purchaser either visually scans the hand pumps in a bar and asks for a number of pints or half pints of a particular beer or will scan the bottles on a shelf and make a self-selection. In a bar, in my experience, one asks for a gin and mixer generically, not by brand name. The gin will be dispensed from an optic at the back of the bar, where the bottle will be visible. In relation to the opponent's services, these are predominantly selected by eye. One sees the establishment's name over the doorway, but I do not discount the potential for aural reference, such as making a recommendation or arranging to meet at the place in question.

23. The level of attention in buying the goods themselves will not be of the highest level. Beer (ale and porter) is cheaper than gin. Allowing for real ale aficionados and those who simply wish to quench their thirst, and bearing in mind the relatively low cost of beer, the attention level of the consumer in the category of beer is average. Gin has an alcoholic content far above that of beer and a higher price. If self-selected, a reasonable amount of care will be taken owing to the cost. In the case of gin ordered in a bar, price is less of an issue as the price will be set as per optic measure, and less attention will be paid to the purchase, e.g. "I'll have a gin and tonic". The measure of care taken over the selection of the opponent's services will depend to a degree upon the type of occasion, such as a quick drink compared to a special meal out. Overall, there will be an average degree of attention paid to the purchase of both the goods and the services.

#### Comparison of marks

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

".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by

means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

25. 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.

26. The respective marks are:

Opponent	Applicant
TIGER	Tiger Gin

The applicant accepts in its counterstatement that the marks are similar: it states “[t]he word GIN is therefore purely descriptive and it is admitted that the trade mark aspect of the application is the word TIGER.” The overall impression created by both marks is of the word TIGER, because GIN would be accorded much less weight, for the reason given by the applicant. Although the concept of gin is missing from the earlier mark, the marks are still near identical (as acknowledged by Mr Preedy in one of the letters attached to his evidence) because gin is purely descriptive of the applicant’s goods. There is not different concept created by the combination of the two words: the mark still signifies a tiger and a description of the goods.

Distinctive character of the earlier marks

27. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*<sup>4</sup> 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 *WindsurfingChiemsee 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

---

<sup>4</sup> Case C-342/97

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).”

28. Invented words usually have the highest level of inherent distinctive character. The word TIGER is an ordinary word with a well-known meaning, albeit it does not describe or allude to a characteristic of the opponent’s goods and services. It has an average degree of inherent distinctive character. The opponent has not shown that any use it might have made of its mark has increased that average level of inherent distinctive character.

#### Likelihood of confusion

29. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between the goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.*). I have found that the goods and services are similar to a very low degree but that the marks are, to all intents and purposes, identical.

30. Despite the fact that the marks are near-identical and that the goods and services will be purchased with an average (rather than a low) degree of attention, I consider that there is no likelihood of confusion. This is because the similarity between beer and gin is of the lowest level and the inherent degree of distinctive character of the opponent’s mark is no more than average. There is no evidence that the earlier mark is known to consumers and that any greater level of distinctive character might come into play. Even encountered in the same off licence, supermarket or pub, the differences between the goods which I have listed in paragraph 18 point far more away from, than towards, consumers assuming the goods are the responsibility of a single, or economically linked, undertaking. **The opposition fails.**

#### **Outcome**

**31. The opposition fails. The application is to be registered.**

#### **Costs**

32. The applicant has been successful and is entitled to a contribution (rather than compensation) towards its costs, according to the published scale in Tribunal Practice Notice 4/2007. The applicant’s evidence consists of the opponent’s cease and desist letter, the applicant’s reply, and my *Old Tom* decision. The letters were of no assistance in making this decision and the *Old Tom* decision could have been dealt with in submissions, rather than by a witness statement. Consequently, I will treat Mr Preedy’s evidence as written submissions. It is not appropriate to make an award for the grounds not pursued because the opponent did not file evidence and

the grounds were struck out before the applicant filed its evidence (which was not evidence, in any case). It would, therefore, not have been necessary for the applicant to consider sections 5(3) or 5(4)(a) in any detail.

The breakdown is as follows:

Considering the statement and preparing a counterstatement	£200
Submissions	£250
<b>Total:</b>	<b>£450</b>

33. I order Everards Brewery Limited to pay Jeffrey Joshua Lawrence the sum of £450 which, in the absence of an appeal, should be paid within seven days of the expiry of the appeal period.

**Dated this 19th day of December 2014**

**Judi Pike  
For the Registrar,  
the Comptroller-General**