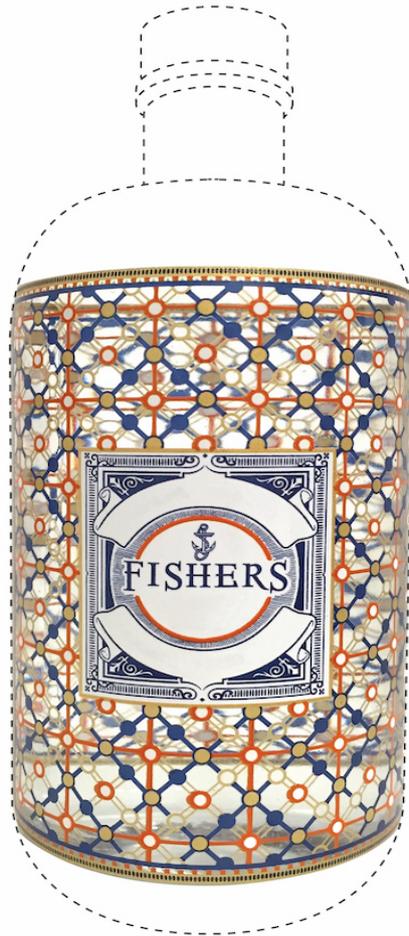


O-647-17

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3156611 FOR THE TRADE MARK



BY FISHERS GIN LTD

AND

OPPOSITION THERETO UNDER NO 60000455 BY ROBERT BIRNECKER

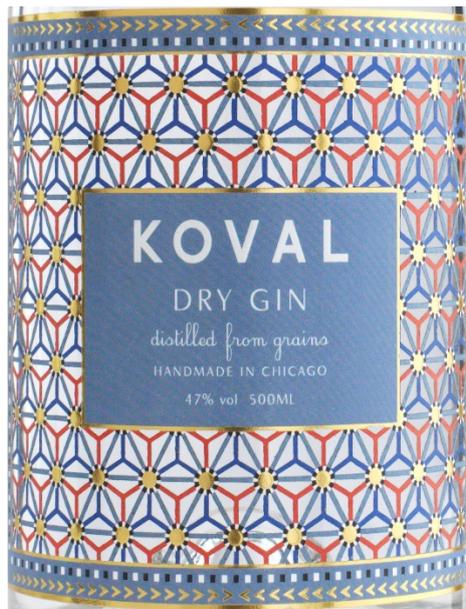
Background

1. Application no 3156611 seeks registration of the trade mark shown on the cover page of this decision. It has a filing date of 24 March 2016, stands in the name of Fishers Gin Ltd (“the applicant”) and seeks registration for the following goods:

Class 33

Gin

2. Following publication in the *Trade Marks Journal* on 22 April 2016, Robert Birnecker (“the opponent”) filed a notice of opposition. There is a single ground of opposition under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) under which the opponent relies on European Union Trade Mark (“EUTM”) no 15236755 insofar as it is also registered for *Gin*:



3. The EUTM claims the colours Light Blue, Blue, Orange, Black, White and Gold. It has a filing date of 19 March 2016 and was entered in the register on 12 August 2016. Whilst the filing dates of the respective marks differ only by a matter of days, the EUTM is the earlier mark within the meaning of section 6 of the Act. It is not subject to the requirement that proof of its use be shown.

4. The applicant filed a counterstatement in which it accepts that identical goods are involved but otherwise denies the grounds of opposition.

5. Both parties filed evidence and written submissions which I have read and do not summarise but will refer to as necessary in this decision. The matter came before me for a hearing where the applicant was represented by Mr Stephen Kinsey of Wildbore & Gibbons, its professional representatives in these proceedings. The opponent was represented by Mr Jonathan Turner of Counsel.

Decision

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

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

(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 greater degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings 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.

Comparison of goods, the average consumer and the nature of the purchasing process

8. As the case law above indicates, it is necessary for me to determine who the average consumer is for the goods at issue; I must then determine the manner in which these goods 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 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.”

9. There is no dispute that the respective goods are identical. Gin is a spirit and its sale is subject to various legal restrictions which lead me to find that the average consumer will be an adult member of the general public. In respect of the degree of attention paid to the purchase, in its written submissions the opponent submits the goods are “moderately expensive products” and that:

“The degree of attention needs to be considered as average increasing the likelihood for the products to be mistaken for each other.”

10. For its part, the applicant states:

“...consumers of [gin] will undertake a reasonable degree of examination of the goods to ensure that they are appropriate to their needs.

It goes on to submit:

“...the high quality and relatively expensive nature of these respective gin products should result in greater consumer care and sophistication which would also significantly reduce any likelihood of confusion”.

11. At the hearing, Mr Kinsey made reference to the parties' goods being craft gins. As I pointed out, I have to take the specifications as applied for and registered. The quality, type and cost of the respective goods are not reflected in those specifications. The goods are not likely to be an everyday purchase. Whilst they are likely to be more expensive than other drinks such as e.g. soft drinks, wine or beer, the costs of the goods, typically, is likely to be moderate. Nevertheless, as the average consumer will wish to ensure they are selecting the correct type, flavour and volume of beverage (whether bought as a complete bottle or an individual serving), they are likely to pay an average degree of attention to their selection (i.e. no higher or lower than the norm).

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

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

Consequently, while the goods may be ordered orally in bars, public houses and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottle or drinks list/menu prior to the order being placed. Considered overall, I find the selection process will be a predominantly visual one, although aural considerations will play their part.

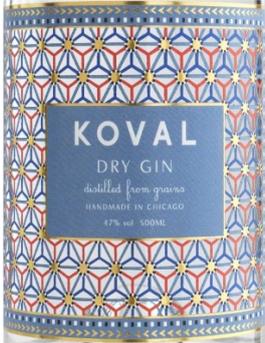
Comparison of the respective marks

13. It is clear from *Sabel BV 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 them, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“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.”

It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

14. The marks to be compared are:

The earlier EUTM	The application
	

15. The opponent's EUTM is registered with the following description:

“A rectangle bearing a gold and blue boarder containing gold arrowheads and black and white squares. The interior of the rectangle contains a textured laser-cut interwoven lattice series of interlocking orange and blue hexagons. Light blue laser-cut out triangles appear within the orange hexagons. Gold foil circles appear at each angle of the blue triangles and there are back and white rays around each of the gold circles. Centered against a light blue background are the word elements.”

16. The word elements which appear in the central light blue rectangle consist of the word KOVAL in plain block capitals. Below this, and in smaller font on separate lines, are the words DRY GIN again in plain block capitals, “distilled from grains” in cursive script and “HANDMADE IN CHICAGO” in plain block capitals, the latter two lines being presented in an even smaller font, all of which are non-distinctive. I consider that both the background pattern and the word KOVAL are distinctive elements of

the mark. Whilst it is not negligible, the busy background pattern is just that-background, whereas the word KOVAL is presented on a plain blue background which adds focus to the word appearing on it and this, coupled with its central location and size, leads me to find that it is the word KOVAL which is the dominant distinctive element of the mark.

17. The applicant's mark consists of the outline of a capped bottle on which appears a label made up of a background pattern with a top and bottom border and on which is a central feature in the shape of a square. Placed centrally within that square is the word FISHERS above which is a device of an anchor, the whole surrounded by what Mr Kinsey referred to at the hearing as a lifebelt device. I think it more likely that, if noticed at all, it will simply be seen as a circle bordering the word and anchor device however I will use Mr Kinsey's descriptor for convenience. Above and below these elements, and partially overlapping the lifebelt, are curved blank ribands. The central square has a continuous decorative border to the left and right hand sides and a similar border to the top and bottom which is split in the middle. Each external corner of the square contains a heart device and each internal corner has what appears to be a flower device and scrolls. The background pattern is made up of a series of squares interlocked with diamond shapes with circles at each intersection. The mark is not limited as to colour. The outline of a bottle is not distinctive for gin. The background pattern, the word Fishers and the anchor device are distinctive elements of the mark. If it is noticed at all, the lifebelt element is of little distinctiveness as are the ribands. The background pattern is a busy one whereas the word FISHERS is presented on a white background and is placed between the curved ribands above and below it which adds focus to it and this, coupled with its central location and size, leads me to find that it is the word FISHERS which is the dominant distinctive element of the applicant's mark.

18. Visually, there are some similarities between the respective marks in that each includes a geometric background pattern having a top and bottom border and each has a central element containing words. There are also some visual dissimilarities between them in that the application has the shape of a bottle which is not present in the earlier mark, the respective background patterns, and the shape and in particular

the words within the central elements, all differ. When viewed as wholes, the degree of visual similarity is fairly low.

19. The respective marks are both composite marks consisting of both words and design elements but both will be referred to by the words within them. The earlier mark will be referred to by the word KOVAL. The applicant's mark will be referred to by the word FISHERS. The respective marks are aurally dissimilar.

20. The conceptual meaning accorded to the respective marks will stem from the words within them, the background pattern unlikely to have any particular conceptual meaning to the average consumer of the goods. The word KOVAL has no meaning in the English language that I have been made aware of and I consider it will be seen as an invented word. The word FISHERS is likely to be taken as the plural or (though grammatically incorrect) the possessive form of the family name FISHER perhaps stemming from an association with the sea which is supported by the inclusion of the anchor device and, if noticed and taken as such, the lifebelt. The respective marks are conceptually dissimilar.

The distinctiveness of the earlier mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

22. Whilst the opponent has filed evidence, it has not filed any which shows the extent of any trade under its earlier mark in terms of e.g. where, when or how it has sold or advertised its goods nor has it provided any details of turnover, advertising costs or market share. Indeed, Mr Turner submitted at the hearing that:

“This is a case where we would not rely on extensive use giving rise to extended rights or greater rights. Quite frankly, it is not being used on a massive scale. I am not going to suggest that. The evidence does not support that and, actually it is not really true.”

23. In the circumstances, I do not need to determine whether any use of the mark has increased its inherent distinctiveness. Nevertheless, I find that it is a mark with a relatively high level of inherent distinctiveness.

Likelihood of confusion

24. In determining whether there is a likelihood of confusion, 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 and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the earlier trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely

upon the imperfect picture of them he has retained in his mind, a factor Mr Turner submitted was particularly important in this case.

25. Earlier in this decision I found:

- The respective goods are identical;
- The average consumer is an adult member of the general public who will pay an average degree of attention to the purchasing process;
- The purchase is likely to be predominantly visual but aural considerations will play a part;
- The respective marks have a fairly low degree of visual similarity and are aurally and conceptually dissimilar;
- The earlier mark has a relatively high degree of inherent distinctiveness.

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

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

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

27. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive

character of the earlier mark lie? Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

28. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

29. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite

mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

30. In their witness statements Mr De Simone, Ms Lucero and Mr Mattersberger all give evidence of either themselves or their companies receiving enquiries or comments about the similarities between respective parties’ trade marks. None of those making the enquiries or comments are identified. Dr Birnecker also gives evidence of an enquiry received by email in December 2016 from a named individual. None of these people referred to, whether identified or not, have given evidence themselves.

31. At the hearing, Mr Turner submitted that this evidence:

“...should give you pause for thought, if you were inclining the other way, or reinforce your conviction that there is some similarity between these labels and indeed some similarity to give rise to a possibility of confusion or, at any rate, to a need to assess whether there is a possibility of confusion resulting from it.”

32. The issue I have to determine, of course, is not whether there is a *possibility* of confusion but whether there is a *likelihood* of confusion. The hearsay evidence provided, much of which comes from people in or connected with the gin or alcohol business, does not assist me in that regard. Mr Mattersberger also submits in his witness statement that he “finds the similarities [between the respective marks] overwhelming” but I have to consider what the average consumer of the marks will make of them.

33. Mr Turner submitted that the respective marks:

“contain [-] a different brand name”

though he also submitted that:

“the mere fact that is a different name is not really enough in this case to avoid a real likelihood that people will, with their imperfect recollection...think that this is the same brand that they saw and enjoyed before”.

34. I accept that there is some similarity between the respective marks stemming from the fact that each consists of words on a squared background placed centrally on a geometric background pattern. I do not consider, however, that these similarities are sufficient to give rise to a likelihood of confusion, whether direct or indirect, even where the goods are identical. In my experience, it is not unusual to find this “central feature on a background arrangement” in trade marks or labelling and Mr Turner’s reference to the “different brand names” supports my own view that the average consumer will refer to the marks by the words appearing in them and that whilst the geometrical designs forming the background patterns are not without distinctiveness and are not negligible in the mark as a whole, they are just that, background. When compared as wholes, the differences between the marks far outweigh their similarities, not least because the background patterns on each are not the same and because of the very different words appearing in them and which I have found to be the dominant elements of the marks. The objection under section 5(2)(b) of the Act fails.

Summary

35. The opposition fails and the application may, subject to any appeal, proceed to registration.

Costs

36. Both parties accept that this is a case where costs from the usual scale applies though Mr Kinsey asked that an additional contribution be ordered to take account of the fact that the applicant filed an amended Form TM8 and counterstatement following an amendment of the notice of opposition. This latter amendment stemmed from the opponent's intended reliance on other grounds (grounds which were later withdrawn). Mr Kinsey accepted that the amount of additional costs were "small".

37. The applicable scale of costs for proceedings commenced after 1 July 2016, as is the case here, is set out in Tribunal Practice Notice (TPN) 2/2016. In line with that TPN, I award costs as follows:

For preparing a statement and considering the opponent's statement:	£200
For preparing evidence and considering and commenting on the opponent's evidence:	£800
Preparing for and attending the hearing:	£800
Additional amount for amended statements:	£50
Total:	£1850

38. I order Dr Robert Birnecker to pay Fishers Gin Limited the sum of £1850 as a contribution towards its costs. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of December 2017

Ann Corbett
For the Registrar
The Comptroller-General