TRADE MARKS ACT 1994

IN THE MATTER OF UK TRADE MARK APPLICATION NO. 3262304 IN THE NAME OF JAMES DUNCAN ABBOTT

AND IN THE MATTER OF OPPOSITION NO. 412127 IN RELATION THERETO BY ALPES MARQUES

AND IN THE MATTER OF UK DESIGNATION OF INTERNATIONAL REGISTERED TRADE MARK NO. WO705247 AND UK TRADE MARK REGISTRATION NO. 2620639 IN THE NAME OF ALPES MARQUES

AND IN THE MATTER OF APPLICATIONS FOR REVOCATION NOS 502007 AND 501863 THERETO IN THE NAME OF JAMES DUNCAN ABBOTT

DECISION

Introduction

1. This is an appeal against the decision of Mr George Salthouse, acting on behalf of the Registrar, dated 2 April 2019 (O-170-19) in which he:

   (1) Allowed the application for revocation in respect of UK Trade Mark No. 2620639;

   (2) Refused the application for revocation in respect of the UK designation of International Registered Trade Mark No. WO705247;

   (3) Rejected Opposition No. 412127 in respect of UK Trade Mark Application No. 3262304; and

   (4) Made an order that Alpes Marques pay to James Duncan Abbott the sum of £1,900 as a contribution towards his costs.

2. On 9 October 2017 James Duncan Abbott ("***JDA***") applied to register a series of two trade marks MONT BLANC WHISKY/MONT BLANC WHISKIES in respect of whiskies in Class 38 ("***the JDA Application***"). The application claimed a priority of 31 August 2017 on the basis of a French trade mark registration number 174385423.

3. By an application dated 6 November 2017 JDA applied pursuant to section 46(1)(a) of the Trade Marks Act 1994 ("***the 1994 Act***") to revoke UK trade mark registration No. 2620639 in the name of Alpes Marques ("***AM***") for the mark:

MONT BLANC whisky

registered in respect of '*Alcoholic beverages, whiskies*' in Class 33. The application for revocation was in respect of all the goods the subject of the revocation and the date from which revocation was sought with effect from 6 October 2017 ("***the First Revocation Application***"). JDA had notified AM that it intended to make the First Revocation Application on 11 October 2017.

4. The JDA Application was examined and accepted and subsequently published for opposition purposes on 5 January 2018.

5. A Notice of Defence and Counterstatement to the First Revocation Application was filed on 9 January 2018 on behalf of AM. In the said Notice AM took issue with the application for revocation and averred that AM had made use of the trade mark in respect of all the goods for which it was registered and that AM intended to submit evidence '*to support its claim to having made use of the trade mark in the United Kingdom in relation to all of the goods in Class 33*'.

6. By an application dated 8 March 2018 JDA applied pursuant to sections 46(1)(a) and 46(1)(b) of the 1994 Act to revoke IR trade mark registration No. IR705247 in the name AM for the mark:

MONT BLANC

registered in respect of '*Beers; mineral and sparking water; non-alcoholic beverages and preparations for making beverages (except those based on coffee, tea or cocoa and milk drinks); fruit beverages and fruit juices; syrups; lemonades*' in Class 32. The application for revocation was in respect of all the goods the subject of the revocation and the date from which revocation was sought with effect from 18 July 2009 pursuant to section 46(1)(a) of the 1994 Act; and with effect from 6 March 2018 pursuant to section 46(1)(b) of the 1994 Act ("***the Second Revocation Application***"). JDA had notified AM that it intended to make the Second Revocation Application on 14 December 2017.

7. On 9 March 2018 evidence in the form of the Witness Statement of Sylvian Chiron dated 9 March 2018 and James Jeffray dated 7 March 2018 were filed in the First Revocation Action on behalf of AM.

8. On 5 April 2018 AM filed a notice of Opposition to the JDA Application ("***the AM Opposition***"). The AM Opposition was based on:

   (1) Section 5(2)(b) of the 1994 Act on the basis of the IR705247 (the mark the subject of the Second Revocation Application); and

   (2) Section 5(4)(a) of the 1994 Act pursuant to the law of passing off on the basis of the earlier unregistered trade mark BRASSERIE DU MONT BLANC that was said to have been used throughout the UK since at least 2014 in respect of beer.

9. A Notice of Defence and Counterstatement to the Second Revocation Application was filed on 23 May 2018 on behalf of AM. In the said Notice AM took issue with the application for revocation and went on to:

   (1) State that AM could not locate any correspondence dated 14 December 2017 in which JDA has notified AM that it intended to make the application for revocation;

   (2) Aver that use had been made of the mark MONT BLANC in relation to beers in the UK since at least 2007; and

   (3) Confirm that a Form MM6 had been field at WIPO limiting the specification to the UK designation of the mark to 'beer' to reflect the use made of the mark.

10. On 12 June 2018 a letter was sent on behalf of the Registrar in which it was indicated that:

> The tribunal intends to consolidate the related proceedings namely [the First and Second Revocation Applications] and. if and when the TM8 is filed, [the AM Opposition]. Therefore, the evidence deadlines are being re-set . . .
> . . .
> The registry notes that [AM] has already filed evidence in respect of the [First Revocation Application]. Given that the grounds and goods and services are similar for both cancellations, the registry is under the impression that similar evidence will be filed for both. Therefore, the proprietor is given a two-week deadline in which to notify the registry whether or not they wish to file "top-up evidence" regarding [the Second Revocation Application]. If they do, a further one month will be allowed for them to file such evidence. . . .

11. On 14 June 2018 JDA filed a TM8 and Counterstatement in the AM Opposition which put AM to proof of use of the marks in respect of "*'beers', which, are the only Goods for which use is claimed out of the Goods specified*" and denied that the ground under sub-section 5(2)(b) of the 1994 was applicable.

12. On 26 June 2018 a letter was sent on behalf to AM indicating that as '*the two non-use revocation actions involve different considerations due to the different specification of goods involved in the respective trade marks*' AM wished to have a full opportunity to file evidence in the Second Revocation Application.

13. On 29 June 2018 the Registrar sent a letter in which it stated *inter alia* as follows (emphasis as in the original):

> The Registrar hereby direct under Rule 62(1)(g) of the Trade Mark Rules 2008 that [the First and Second Revocations and the AM Opposition] be consolidated, therefore all future correspondence and evidence should be headed up to relate to both (sic) cases.
>
> . . .
>
> **Restriction of Protection for IR705247**
>
> I acknowledge receipt of the partial restriction of the Goods and Services in respect of the above International Right. The Goods and Services have been restricted to:
>
> **Class 32: Beers**

The letter then went on to give directions for the filing of evidence as follows:

(1) AM was given until 29 August 2018 to file evidence/submission in respect of the Second Revocation Action and the AM Opposition;

(2) JDA was given 2 months from the filing of AM's evidence to file evidence/submissions in answer; and

(3) AM was given 1 month from the receipt of the evidence from JDA to indicate whether or not it wished to file evidence in reply and if so then a further month to file such evidence.

14. Pursuant to those directions AM filed evidence in the form of the Second Witness Statement of Sylvian Chiron dated 25 August 2018 and JDA was given until 29 October 2018 to file its evidence/submissions in answer.

15. No evidence was filed by or on behalf of JDA.

16. Neither party wished to be heard. AM filed written submissions in lieu of attendance. No submissions were filed on behalf of JDA. The Hearing Officer proceeded to make his decision on the basis of the papers before him.

The Hearing Officer's Decision

17. For the purposes of the present appeal the only findings that are relevant are those made in the context of the section 5(2)(b) Ground of Opposition in the JDA Opposition. There is no suggestion that with respect to the identification of the general legal principles applicable to the decision that he had to take that the Hearing Officer made any errors.

18. Having set out the relevant legal principles the Hearing Officer then turned to the assessment that he had to make in the present case. There is no challenge on the present appeal that the Hearing Officer was correct to find that:

    (1) With regards to the average consumer and the nature of the purchasing decision that '*the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part*' and that the average consumer would be '*likely to pay at least a reasonable level of attention to the selection of the goods at issue*' (paragraph [36] of the Decision);

    (2) The '*marks are therefore highly similar, almost identical*' (paragraph [39] of the Decision); and

    (3) '*AM's mark cannot benefit from enhanced distinctive character through use*' (paragraph [41] of the Decision).

19. With regard to the inherent distinctiveness of AM's mark the Hearing Officer put the position very shortly and found (emphasis in the original) '*AM's mark consists of the words MONT BLANC. It is not descriptive of the goods (beers) and is in fact a well-known mountain in the Alps and suggests a simple geographical location.* ***To my mind, the earlier mark is of low average inherent distinctiveness***.' (paragraph [41] of the Decision).

20. The Hearing Officer next turned to his comparison of the goods in issue. Having set out the legal principles by reference to the case law including the CJEU in Case C-39/97 Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer at paragraph [23]; Jacob J. (as he then was) in British Sugar plc v. Robertson Ltd [1996] RPC 281, in respect of which there is no challenge on this appeal, the Hearing Officer continued as follows (emphasis as in the original):

46) I also note that if the similarity between the goods/services is not self-evident, it may be necessary to adduce evidence of similarity even if the marks are identical. In *Commercy AG, v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-316/07, the General Court pointed out that:

> "43. Consequently, for the purposes of applying Article 8(1)(b) of Regulation No 40/94, it is still necessary, even where the two marks are identical, to adduce evidence of similarity between the goods or services covered by them (see, to that effect, order of 9 March 2007 in Case C-196/06 P *Alecansan v OHIM*, not published in the ECR, paragraph 24; and Case T-150/04 *Mülhens v OHIM – Minoronzoni(TOSCA BLU)* [2007] ECR II-2353, paragraph 27)."

47) Thus where the similarity between the respective goods or services is not self-evident, the opponent must show how, and in which respects, they are similar. AM contends in its submissions that:

> "Beer is considered similar to other alcoholic beverages including whisky. This is because the beverages have the same purpose, namely to accompany a meal or quench thirst. The goods are sold to the same customers through the same distribution channels, be that shops or in bars or restaurants and are in competition with one another. As stated in the evidence they can also have the same producers, as brewers often produce other alcoholic or non-alcoholic beverages. Therefore, the goods are highly similar."

48) I note that the evidence made a claim that beer producers also produce other alcoholic beverages but no evidence was provided which showed a brewer/distiller manufacturing beer and whisky and selling both under the same brand. I take note that in *Bodegas Montebello, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-430/07, the GC found that rum and wine were "manifestly different" (its analysis is at paragraphs 29-37). This was based on an assessment of the different ingredients and methods of production, which result in end products different in taste, colour and aroma. In addition, it noted that wine is often drunk with a meal, while that is not generally the case for rum, and that the goods have a markedly different alcohol content. Although the Court accepted that rum and wine may share the same distribution channels, it considered that the goods would not generally be sold on the same shelves and that the goods were neither complementary nor in competition. Using the

same logic, as rum and whisky are very similar, as are beers and wines, I conclude that the term "whiskies" in JDA's mark are neither similar nor complementary to beer.

49) I also take into account case T-584/10 *Yilmaz v OHIM* (ECLI:EU:T:2012:518) which is more comparable with the instant case. In this case, the goods found to be dissimilar were a spirit (Tequila) and beer. In making its assessment, the General Court applied the approach from *MEZZOPANE* and started at paragraph 51:

> "…the differences between those goods [that is Tequila and beer], in respect of all the relevant factors relating to them, are clearer and more substantial than the differences between beer and wine established by the Court in *MEZZOPANE*, with the result that those differences make it even more unlikely that the relevant public would believe that the same undertaking would produce and market the two types of beverage at the same time."

50) The General Court went on at paragraph 54:

> "In that regard, it must be borne in mind, in particular, that, while the goods to be compared in the present case belong to the same general category of beverages, and more specifically to the category of alcoholic beverages, they are different in particular as regards their ingredients, method of production, colour, smell and taste, with the result that the average consumer perceives them to be different in nature. Those goods are not normally displayed in the same shelves in the areas of supermarkets and other outlets selling drinks. As regards their use, a significant difference between the goods is that beer quenches thirst which is not normally the case for the alcoholic beverages covered by the mark applied for. While it is true that those goods may be consumed in the same places and on the same occasions and satisfy the same need – for example, enjoyment of a drink during a meal or as an aperitif – the fact remains that they do not belong to the same family of alcoholic beverages and that the consumer perceives them as two distinct products, as the Court held, so far as concerns beer and wine, in paragraph 66 of *MEZZOPANE*."

51) The Court then went to state that the existence of alcoholic cocktails does not affect this conclusion (paragraph 55); that Tequila and beer are not complementary (paragraph 56); and, furthermore, that there is a lower degree of competition

> between Tequila and beer than there is between wine and beer (paragraph 57). Ultimately, the Court upheld the Board of Appeal's finding that the goods were dissimilar (at paragraph 72, which upheld the finding at R 1162/2009-2 *TEQUILA CUERVO*, paragraph 44).
>
> 52) **It is therefore clear that JDA's goods "whiskies" are dissimilar to AM's goods "beers"**. I note that in *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:
>
> > "49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.
>
> 53) This determines the matter and there can be no likelihood of confusion where there is no similarity between the goods of the two parties. However, for the sake of completeness I will continue to consider the likelihood of confusion.

21. As noted in paragraph [53] of his Decision although the Hearing Officer had found no similarity as between the goods in issue he nonetheless went on to consider the likelihood of confusion. With regard to the likelihood of confusion the Hearing Officer found as follows (emphasis in the original):

> 57) As beer and whisky are such different alcoholic beverages and no evidence has been provided which shows that it is common for a single company to produce both I do not envisage that a consumer seeing both on the shelves behind a bar would consider that the same manufacturer was responsible for both, only that both originated in the region of Mont Blanc, not necessarily from the same country. In view of all of the above, and allowing for the concept of imperfect recollection there is no likelihood of consumers being confused, directly or indirectly, into believing that the goods applied for and provided by JDA are those of AM or provided by an undertaking linked to it. **The opposition under Section 5(2)(b) therefore fails in respect of all the goods applied for by JDA**.

The Appeal

22. On 30 April 2019, AM filed an appeal against the Hearing Officer's Decision pursuant to section 76 of the 1994 Act.

23. In the Grounds of Appeal AM made it clear that it appealed only in respect of the Decision in so far as it related to the dismissal of the JDA Opposition pursuant to section 5(2)(b) of the 1994 Act.

24. AM relied upon three grounds of appeal which can be summarised as follows:

    (1) The Hearing Officer erred in finding that JDA's goods, namely, "whiskies" were dissimilar to AM's goods namely "beers" (paragraph [52] of the Decision);

    (2) The Hearing Officer erred in concluding that AM's mark **MONT BLANC** was of '*low average inherent distinctiveness*' (paragraph [41] of the Decision); and

    (3) As a consequence of the aforesaid errors erred in his assessment of the likelihood of confusion concluding that there was no such likelihood.

25. AM also made an application for further evidence to be admitted on the appeal in the form of a witness statement of Anna Szpek together with four exhibits.

26. On 8 July 2019 notification of the listing of the hearing of the Appeal was sent to the parties in accordance with section 76 of the 1994 Act.

27. Under cover of letter dated 22 July 2019 a Respondent's Notice sent on behalf of JDA. Further to that letter, on 23 July 2019, the parties were informed that any applications that were to be made in the context of the appeal would be heard at the hearing of the substantive appeal.

28. A hearing of the appeal took place on 1 August 2019 at which AM was represented by Mr Jamie Muir Wood instructed by Urquhart-Dykes & Lord LLP and JDA was represented by Mr Anthony Burrows of Burrows Chambers Associates. Skeletons of argument were filed on behalf of both parties.

Standard of review

29. An appeal against decisions taken by the Registrar is by way of review. Neither surprise at a Hearing Officer's conclusion, nor a belief that he or she has reached the wrong decision suffice to justify interference in this sort of appeal. Before that is warranted, it is necessary for me to be satisfied that there was a distinct and material

error of principle in the decision in question or that the Hearing Officer was wrong. See Reef Trade Mark [2003] RPC 5; and Actavis Group PTC v. ICOS Corporation [2019] UKSC 1671 at [78] to [81].

30. Moreover where the decision below involves the making of a value judgment the decision maker on appeal must be especially cautious about interfering with that judgment on appeal: see most recently Actavis (above) at [80]:

> 80. What is a question of principle in this context? An error of principle is not confined to an error as to the law but extends to certain types of error in the application of a legal standard to the facts in an evaluation of those facts. What is the nature of such an evaluative error? In this case we are not concerned with any challenge to the trial judge's conclusions of primary fact but with the correctness of the judge's evaluation of the facts which he has found, in which he weighs a number of different factors against each other. This evaluative process is often a matter of degree upon which different judges can legitimately differ and an appellate court ought not to interfere unless it is satisfied that the judge's conclusion is outside the bounds within which reasonable disagreement is possible: *Assicurazioni Generali SpA v Arab Insurance Group (Practice Note)* [2002] EWCA Civ 1642; [2003] 1 WLR 577, paras 14-17 per Clarke LJ, a statement which the House of Lords approved in *Datec Electronic Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23; [2007] 1 WLR 1325, para 46 per Lord Mance.

31. In Fage UK Ltd v. Chobani UK Ltd [2014] EWCA Civ 5; [2014] E.T.M.R. 26 at paragraphs [114] and [115] Lewison LJ said:

> 114 Appellate courts have been repeatedly warned, by recent cases at the highest level, not to interfere with findings of fact by trial judges, unless compelled to do so. This applies not only to findings of primary fact, but also to the evaluation of those facts and to inferences to be drawn from them. The best known of these cases are: *Biogen Inc v Medeva plc* [1977] RPC 1; *Piglowska v Piglowski* [1999] 1 WLR 1360 ; *Datec Electronics Holdings Ltd v United Parcels Service Ltd* [2007] UKHL 23 [2007] 1 WLR 1325 ; *Re B (A Child) (Care Proceedings: Threshold Criteria)* [2013] UKSC 33 [2013] 1 WLR 1911 and most recently and comprehensively *McGraddie v McGraddie* [2013] UKSC 58 [2013] 1 WLR 2477 . These are all decisions either of the House of Lords or of the Supreme Court. The reasons for this approach are many. They include

> i) The expertise of a trial judge is in determining what facts are relevant to the legal issues to be decided, and what those facts are if they are disputed.
> ii) The trial is not a dress rehearsal. It is the first and last night of the show.
> iii) Duplication of the trial judge's role on appeal is a disproportionate use of the limited resources of an appellate court, and will seldom lead to a different outcome in an individual case.
> iv) In making his decisions the trial judge will have regard to the whole of the sea of evidence presented to him, whereas an appellate court will only be island hopping.
> v) The atmosphere of the courtroom cannot, in any event, be recreated by reference to documents (including transcripts of evidence).
> vi) Thus even if it were possible to duplicate the role of the trial judge, it cannot in practice be done.
>
> 115 It is also important to have in mind the role of a judgment given after trial. The primary function of a first instance judge is to find facts and identify the crucial legal points and to advance reasons for deciding them in a particular way. He should give his reasons in sufficient detail to show the parties and, if need be, the Court of Appeal the principles on which he has acted and the reasons that have led him to his decision. They need not be elaborate. There is no duty on a judge, in giving his reasons, to deal with every argument presented by counsel in support of his case. His function is to reach conclusions and give reasons to support his view, not to spell out every matter as if summing up to a jury. Nor need he deal at any length with matters that are not disputed. It is sufficient if what he says shows the basis on which he has acted. These are not controversial observations: *see Customs and Excise Commissioners v A* [2002] EWCA Civ 1039; [2003] Fam. 55; *Bekoe v Broomes* [2005] UKPC 39; *Argos Ltd v Office of Fair Trading* [2006] EWCA Civ 1318; [2006] U.K.C.L.R. 1135.

32. It is necessary to bear these principles in mind on this appeal.

Decision

The application by AM to file additional evidence on appeal

33. In the Grounds of Appeal AM sought permission to file additional evidence on appeal. JDA objected to the admission of the additional evidence on this appeal.

34. There was no dispute as between the parties as to the general principles to be applied in respect of the admissibility of fresh evidence in trade mark appeals, sought to be

introduced for the first time on appeal. These were summarised by Henry Carr J in Consolidated Developments Ltd v. Cooper [2019] FSR 2 at paragraph [33]:

> 33. The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:
>
> (i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52 . However, given the nature of such appeals, additional factors may be relevant;
> (ii) the *Ladd v Marshall* factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;
> (iii) it is useful to have regard to the Hunt-Wesson factors;
> (iv) relevant factors will vary, depending on the circumstances of each case. Neither the *Ladd v Marshall* factors nor the *Hunt-Wesson* factors are to be regarded as a straightjacket;
> (v) the admission of fresh evidence on appeal is the exception and not the rule;
> (vi) the *Gucci* decision does not establish that the court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and
> (vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence.

35. The fresh evidence that AM seeks to have admitted on this appeal consists of the witness statement of Anna Szpek together with four exhibits. Ms Szpek is a chartered trade mark attorney employed by Urquhart-Dykes & Lord LLP which is the firm that represents AM. The evidence was said to show her '*brief research on the Internet in relation to beer and whisky, in particular the connection as a result of pairing beer and whisky . . .'* that had been conducted by Ms Szpek.

36. Ms Szpek went on to explain in her witness statement that '*This evidence was not provided at first instance because it was considered that the similarities between whisky and beer (in particular the overlap in producers and their complementary nature) was so notorious and of such common general knowledge that they did not need to be proved by evidence.*'

37. Applying the relevant principles to the application for the admission of the additional evidence on appeal it seems to me that the following points are relevant.

38. First, could the fresh evidence have been filed earlier? Clearly evidence of the type now put forward could have been filed at the time directed for the filing of evidence by the Registrar in the proceedings as was quite correctly accepted by Mr Muir Wood.

39. Second, what was the explanation for the delay? The explanation for the delay was that until the decision of the Hearing Officer was received '*it was considered that the similarities between whisky and beer (in particular the overlap in producers and their complementary nature) was so notorious and of such common general knowledge that they did not need to be proved by evidence.*'

40. However, the question of similarity of goods and services is a matter of perception from the perspective of the average consumer in relation to which a number of factors are relevant as is made clear in the case law including that cited by the Hearing Officer namely Canon (supra) and British Sugar (supra).

41. The question of whether the goods were or were not similar was in issue in the present case was in issue. AM was clearly aware: (1) that the question similarity was in issue; (2) of the type of evidence that could support an averment of similarity given paragraph 20 of its written submissions which was set out by the Hearing Officer in paragraph [47] his Decision; and (3) given the history of the proceedings set out above had had plenty of opportunity to consider what evidence that it wished to file in the proceedings. No real reason is given as to why such submission was not supported by evidence. It clearly would have been open to AM to file such evidence but it chose not to do so.

42. In addition I should note that whilst it is asserted that the similarities between whisky and beer are '*notorious*' and '*common general knowledge*' it is clear from the case law referred to below that different tribunals have taken different views on the matter thus reinforcing the need for evidence.

43. Third, what is the potential significance of the additional evidence? As noted above the additional evidence consists of downloads from the internet of various searches carried out by Ms Szpek and described by her as follows '*I conducted brief research on the Internet in relation to beer and whisky, in particular the connection as a result of pairing of beer and whisky*'.

44. A number of criticisms were made of this evidence. These criticisms included: (1) that supplying a list of search results without any explanation or context given as to their relevance was of no assistance; (2) that in a number of instances the evidence related to matters that took place after the filing date and were therefore inadmissible; (3) that the '*printing off dates*' had been omitted in some instances from the

downloads contained in the exhibits and therefore it was not possible to determine whether or not the material was admissible; and (4) in some cases it was not clear whether the material did or did not relate to the position in the UK as opposed to elsewhere. In my view there is force in these criticisms.

45. In addition to these criticisms I should add that, with regard to the material relating to brewers/distillers manufacturing both beer and whisky upon which AM seeks to rely, the print outs do not demonstrate that such were to be or were to be sold under the same brand. Indeed the contrary would appear from the downloads to have been the position. Moreover, there was no evidence or no sufficient evidence to show that it was common for a brewer/distiller to manufacture and sell both beer and whisky in the UK.

46. I am not satisfied that the additional evidence which AM seek to introduce would have an important influence on the case if admitted. In the premises, AM's application to adduce further evidence on appeal is refused.

The application by JDA for permission to file the Respondent's Notice out of time

47. As noted above following the notification of the hearing of the appeal, under cover of letter dated 22 July 2019 a Respondent's Notice sent on behalf of JDA.

48. Under rule 71(4) of the Trade Mark Rules 2008 the time for serving a Respondent's Notice is 21 days after the date on which the Registrar had sent a copy of the Notice of Appeal and the Grounds.

49. It was common ground that the Respondent's Notice was not been filed within the time set by the rules. No application for an extension of time had been made for the filing of the Respondent's Notice to the Registrar on behalf of JDA. No reason for the late filing of the Respondent's Notice, other than difficulty in obtaining instructions was given.

50. JDA could not identify any rule that gave the Appointed Person the power to extend time for the filing of the Respondent's Notice. As set out in the Decision of Professor Ruth Annand in AIRBLUE Trade Mark (O-600-18) the Appointed Person does not have the power to grant an extension of time for filing the Appellant's Notice which power resides with the Registrar. The same it seems to me applies to the Respondent's Notice. However, it is possible for such a procedural irregularity to be overcome in the manner set out in AIRBLUE Trade Mark at paragraph [82].

51. At the hearing of the appeal it was made clear on behalf of AM that no point was taken on the basis of the late filing of the Respondent's Notice, including no point that an Appointed Person had no power to grant such an extension. Rather what was

submitted before me was that the ground was not relevant to the issues on the present appeal.

52. The substantive part of the Respondent's Notice stated as follows:

> Grounds for Upholding the Order
>
> [JDA] wishes the Appointed Person to uphold the Order on what might or might not be deemed to be additional grounds, namely:-
>
> [JDA] respectfully submits that the average British customer in a British pub, shop or supermarket who occasionally buys specialist bottled beers labelled in French "Rousse de Mon Blanc", etc. and later seeing a whisky labelled in English "MONT BLANC WHISKY" is very unlikely to consider that they both come from one enterprise or from commercially linked enterprises; in other words, to jump mentally in that manner, especially bearing in mind that "MONT BLANC" is a commonplace part or whole of a Mark for a wide variety of Goods.

53. The present appeal as noted above was limited to a challenge to the findings under section 5(2)(b) of the 1994 Act. That assessment requires the decision taker to make a global assessment of the type correctly set out in paragraph [33] of the Decision. Moreover, in the present case the relevant mark for sign comparison was as correctly set out in paragraph [38] of the Decision and as set out below:

AM's trade mark	**JDA's trade marks**
MONT BLANC	**MONT BLANC WHISKY** **MONT BLANC WHISKIES** A series of two

54. This does not involve the 'real life' comparison of marks or signs that seems to be suggested in the Respondent's Notice. In the premises, it seems to me that AM is correct in the submissions that the further ground(s) identified in the Respondent's Notice are irrelevant to the issues that were before me for the purposes of determining the appeal. Further in this connection I also note that there is no evidence in the proceedings to support the statement that *'"MONT BLANC" is a commonplace part or whole of a Mark for a wide variety of Goods'*.

55. In the circumstances, it seems to me that even were the procedural irregularity 'cured' such that the Respondent's Notice was effective in the context of the present appeal it could not on any view make a difference to the outcome of the appeal.

The Appeal

Ground 1: the finding that "whiskies" were dissimilar to "beers"

56. The crux of the present appeal is Ground 1. AM identified 4 errors in support of this Ground of Appeal:

    (1) That the Hearing Officer incorrectly found in paragraph [48] of his Decision that there was no evidence which showed a brewer/distiller manufacturing beer and whisky and selling them under the same brand;

    (2) That the Hearing Officer was entitled to and failed to take judicial notice of the obvious similarities between whisky and beer;

    (3) That although the Hearing Officer correctly identified the relevant factors to be considered in comparing the goods at paragraph [43] of his Decision he failed to consider any of the factors by reference to whisky or beer; and

    (4) That he failed to consider any of the case law in the EUIPO and the UKIPO in which beer and whisky had been found to be similar.

57. With regard to the first error. This is not a justified criticism of the Hearing Officer. Whilst there was evidence that AM had itself taken some preparatory steps in France to distil and then market whisky under the same brand as it sold beer in the UK and elsewhere there was no evidence before the Hearing Officer that any sales had in fact taken place in the UK (or indeed anywhere else) as of the relevant filing date. Moreover there was no evidence of any third party selling beer and whisky under the same brand in the UK as of the filing date before the Hearing Officer

58. Turning to the second and third errors it is convenient to take these two points together as they are central to this appeal.

59. As was rightly accepted on this appeal the Hearing Officer correctly identified the relevant case law namely Canon (supra) and British Sugar (supra) as identifying the factors that have conventionally been taken to have a particular bearing on the question of "similarity".

60. The Hearing Officer referred to two cases from the General Court which dealt with the issue of whether certain alcoholic beverages were similar or not namely Case T-430/07 Bodegas Montebello SA v OHIM and Case T-584/10 Yilmaz v. OHIM which applied the approach for an earlier decision of the General Court in Case T-175/06 Coca Cola v. OHIM (MEZZOPANE) for the purposes of his assessment of similarity of goods.

61. In CALEDONIAN TM (O-382-16) Phillip Johnson sitting as the Appointed Person had to consider a similar appeal in respect to an assessment of similarity made by a Hearing Officer with regard to whether whisky and beer were similar. Having referred to the same case law of the General Court as set out above Professor Johnson went on to state as follows:

> 23. While it is true that each of the three assessments by the General Court are factual findings based on a different relevant public than in the instant case, it is clear that the Court's view is that in general there is either no similarity, or very little similarly, between beer (and wine) on one hand, and spirits on the other.
>
> 24. In addition to these General Court cases, the Hearing Officer referred to a decision by Geoffrey Hobbs QC, sitting as an Appointed Person, in *BALMORAL TM* [1999] RPC 297. While the Hearing Officer did not set out the relevant passage, I will:
>
> > At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different.
> >
> > 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.

> 25. Once more these statements are factual determinations as to the British market in 1998 when the hearing took place. However, they do view the market very differently from the General Court in the cases mentioned above.
>
> 26. Having considered this case law (albeit not *Yilmaz*) the Hearing Officer, based on her own experience, considered whether whisky and beer were similar (Decision, paragraph 39, which is set out above). The Hearing Officer's decision in this respect closely followed the approach adopted by the General Court in *MEZZOPANE*. Indeed, following that approach, it would have been entirely possible to conclude that beer and whisky were not similar at all. However, the Hearing Officer, probably mindful of the points made by Mr Hobbs in *BALMORAL* as to the British market for wine and spirits, concluded that the goods were similar to only a low degree. Such a finding is entirely proper and in accordance with case law.

62. As was made clear in CALEDONIAN TM at paragraph [26] following the approach set out in the case law of the General Court it would be entirely possible to conclude that whisky and beer were not similar at all. However as also rightly made clear in that decision (1) the case law from the General Court concerned a different relevant public; and (2) the decision in BALMORAL TM indicates that at least as far as 1998 was concerned the market in the UK was viewed as being rather different from that under consideration by the General Court.

63. The approach to the assessment of similarity has been conveniently set out in the Decision of Geoffrey Hobbs QC sitting as the Appointed Person in BURN Trade Mark (O-074-19) at pages 12-13:

> Both as between marks and as between goods and services, the evaluation of "similarity" is a means to an end. It serves as a way of enabling the decision taker to gauge whether there is "similarity" of a kind and to a degree which is liable to give rise to perceptions of relatedness in the mind of the average consumer of the goods or services concerned. This calls for a realistic appraisal of the net effect of the similarities and differences between the marks and the goods or services in issue, giving the similarities and differences as much or as little significance as the relevant average consumer, who is taken to be reasonably well-informed and reasonably observant and circumspect, would have attached to them, at the relevant point in time.
>
> The factors conventionally taken to have a particular bearing on the question of "similarity" between goods and services are referred to indicatively and not exhaustively in Case C-39/97 *Canon KK* at paragraph 23 and paragraphs 44 to 47 of the Opinion of the Advocate General in that case. More than just the physical attributes of the goods and services in issue must be taken into account when forming a view on whether there is a degree of relatedness between the consumer needs and requirements fulfilled by the goods or services on one side of the issue, and those fulfilled by the goods or services on the other. The relatedness or otherwise of the trading activities involved in the comparison is ultimately a matter of consumer perception. That is recognised in the case law of the general court relating to "complementarity" as an element to be considered in the context of the overall assessment of "similarity".
>
> There is "complementarity" when the goods or services in issue are closely connected in the sense that one is indispensable or important for the use of the other, in such a way that consumers may think that the same undertaking is responsible for manufacturing those goods or providing those services. A finding of no similarity may legitimately be made, despite the existence of a degree of complementarity, if that complementarity is not sufficiently pronounced for it to be accepted that from the consumer's point of view the goods are similar within the terms of section 5(2)(b).

64. In the present case, as was the position both in BALMORAL TM and CALEDONIAN TM, no evidence was put forward on behalf of AM to address the question of how or why the goods in issue might be regarded as “similar” in a real

world consideration of their nature, respective uses and users, channels of distribution, positioning in retail outlets, competitive leanings or market segmentation in the UK (i.e. evidence of the type identified in the Canon case at paragraph [22]).

65. The only material put before the Hearing Officer was that contained in paragraph 20 of the written submissions filed on behalf of AM which was referred to by the Hearing Officer in paragraph [47] of this Decision and stated as follows:

> Beer is considered similar to other alcoholic beverages including whisky. This is because the beverages have the same purpose, namely to accompany a meal or quench thirst. The goods are sold to the same customers through the same distribution channels, be that shops or in bars or restaurants and are in competition with one another. As stated in the evidence they can also have the same producers, as brewers often produce other alcoholic or non-alcoholic beverages. Therefore, the goods are highly similar.

66. The Hearing Officer addressed each of the factors relied upon by AM in its submissions by reference to certain parts of the judgment of the General Court in Bodegas Montebello, SA and then cited various parts from the judgment of the General Court in Yilmaz. That is clearly the correct starting point for the approach to the issue that he had to determine.

67. However it seems to me that AM are correct in their criticism of the Hearing Officer in so far as he did not: (1) go through or go through adequately an analysis of the relevant factors for the assessment of the similarity of the goods in the particular case that was before him; and/or (2) did not consider the position by reference to the market in the UK.

68. In this connection I agree with the observations of Professor Johnson in paragraph [24] to [26] of his Decision in CALEDONIAN TM that: (1) the judgments from the General Court are factual findings based on a different relevant public; and (2) that the decision in BALMORAL TM indicates that at least as far as 1998 was concerned the market in the UK was viewed as being rather different from that under consideration by the General Court.

69. The Hearing Officer in the present case did not cite either BALMORAL TM or CALEDONIAN TM (whether at first instance or on appeal) in his Decision.

70. The Hearing Officer at first instance in the CALEDONIAN TM case (O-175-16) set out an analysis of the factors for the purposes of the comparison that was before her having regard to the position in the UK as of 19 May 2015. She did so having referred *inter alia* to both the decision of the General Court in Case T-175/06 Coca Cola v. OHIM (MEZZOPANE) and Case T-430/07 Bodegas Montebello, SA; and the

decision in BALMORAL TM and found as follows (in the absence of any evidence as noted above):

> 38. Beers and beverages containing beers are clearly alcoholic beverages, as are gin and whisky. The goods at issue are consumed for a pleasurable drinking experience, which may include the intoxicating effects of alcohol. The users, namely adults over 18, are identical. In addition, the goods are sold through the same channels, for example in retail premises such as supermarkets and off-licences, or in restaurants and bars.
>
> 39. Having said that, there is a notable difference in the alcoholic content of the goods at issue. In retail premises, spirits are usually sold in large bottles, while beers are sold in smaller bottles or cans. In restaurants and bars, gin would normally be dispensed into a tall glass and mixed with other spirits or a non-alcoholic beverage (such as tonic water) to make a long drink. The same may apply to whisky but whisky is also frequently sold for consumption by itself. Spirits are generally dispensed in small measures, often from optics displayed behind the bar. By contrast, beers would customarily be sold in half pint or pint measures dispensed from a tap, or be sold in bottles. While beverages containing beers are likely to consist of beers mixed with non- alcoholic beverages (for example, with lemonade to make shandy), like beer they would be sold in half pint or pint measures and are likely to be perceived as beer-based beverages. In retail premises, the goods at issue are not normally sold on the same shelf and, while I accept that they may be sold in the same aisle, there is ordinarily a clear demarcation between the area for spirits and that for beers and beverages containing beers. Although the base ingredients for all the goods at issue may be the same (e.g. grain or malt), the production methods are different, gin and whisky being made by distillation and beers by fermentation. I do not consider that there is a complementary relationship between the goods of the earlier mark and those in the applied-for specification, neither being essential or important for the consumption of the other. It is possible that there may be a degree of competition between the goods at issue, though I do not consider that the competitive choice between drinking beers (or beverages containing beers) on the one hand and gin or whisky on the other will be commonly made. In my experience, producers of beers do not routinely also produce either gin or whisky, or vice versa. Bearing all of the above in mind, I find that the goods are similar but only to a low degree.

71. In the present case the relevant date for the purposes of the assessment is the 9 October 2017. There is no material to suggest that the market has changed between 2015 and 2017 such as to alter the perception of the relevant public. It seems to me

that the analysis set out by the Hearing Officer in the CALEDONIAN TM is analogous to the present case.

72. In my view, had the Hearing Officer: (1) gone through a proper analysis of the factors relevant to his assessment of the similarity of the goods in the particular case that was before him; and (2) specifically considered the position by reference to perception of the average consumer in the UK in accordance with the approach set out in in BALMORAL TM and CALEDONIAN TM he could and would have found that beer and whisky were similar but only to a low degree.

73. With regard to the fourth error identified by AM I can deal with this shortly. It is clear from the case law that courts and tribunals in different jurisdictions within the EU have taken different views with regard to the similarity of alcoholic beverages. That that is the case should have highlighted to the Hearing Officer the need for any assessment of similarity to focus on the position within the jurisdiction concerned. In this case the UK.

74. In the circumstances, it seems to me that the Hearing Officer erred in finding that there was no similarity between whiskies and beer for the purposes of his assessment under section 5(2)(b) of the 1994 Act. In my view the Hearing Officer could and should have found that the goods in issue were similar but only to a low degree.

Ground 2: the finding that* MONT BLANC *had a 'low average degree of inherent distinctiveness'

75. On this appeal it is submitted that the Hearing Officer should not have found that AM's mark **MONT BLANC** was of '*low average inherent distinctiveness*' but instead should have found that it has '*a moderate level of distinctiveness*' for beers. In my view this ground of appeal has no substance. No error of principle has been identified. It seems to me that the Hearing Officer was entitled to make the findings that he did on the basis that AM's mark '*is not descriptive of the goods (beers) and is in fact a well-known mountain in the Alps and suggests a simple geographical location*'

Ground 3: the finding that there was no likelihood of confusion

76. This ground is not a free standing Ground of Appeal. It is put forward on the basis that the Hearing Officer was wrong to make the assessments that he did under one or both of his assessments of similarity and the level of inherent distinctiveness of the mark. Given my finding in relation to Ground 1 it follows that the Hearing Officer should have proceeded to assess the likelihood of confusion on the basis that the goods in issue were similar to only a low degree.

77. As noted above although it was not necessary for the Hearing Officer, in the light of his finding that there was no similarity between the goods in issue, to consider the likelihood of confusion he nonetheless did so and found that there was no likelihood of confusion (paragraph [57] of his Decision).

78. There is no suggestion on this appeal that the Hearing Officer erred in identifying the relevant principles to be applied in assessing the likelihood of confusion from the case law of the EU courts as he did in paragraph [33] of his Decision.

79. I am satisfied that on assessing the likelihood of confusion according to those principles from the perspective of:

(1) A finding of a low degree of similarity between the goods in issue;

and giving effect to the Hearing Officers findings as to:

(2) The characteristics of the average consumer (paragraph [36] of his Decision);

(3) The similarity of the marks (paragraph [39] of his Decision);

(4) The distinctive character of AM's mark (paragraph [41] of his Decision);

and having regard to the Hearing Officer's *obiter* finding as to

(5) The likelihood of confusion (paragraph [57] of his Decision)

that the opposition under section 5(2)(b) of the 1994 Act should fail in respect of all of the goods applied for by JDA.

Conclusion

80. To conclude, for the reasons set out above, in my view the Opposition to Trade Mark Application No. 3262304 should have been rejected under section 5(2)(b) of the 1994 Act and I therefore uphold the Hearing Officer's ultimate conclusion on this issue.

81. Therefore the appeal is dismissed.

82. At the conclusion of the hearing of the appeal before me JDA made it clear that it wished to make written submission on the question of costs in the light of my Decision on this appeal and in particular indicated that it may wish to make an application for off scale costs with regard to the application to serve additional evidence. No such indication has been given by AM. In those circumstances I direct as follows:

(1) On or before 4 pm on Monday 25 November 2019 the parties must confirm in writing whether or not they are claiming costs other than on the standard scale in respect of the application to admit further evidence, the costs relating to the late service of the Respondent's Notice and/or the other costs of the appeal.

(2) In the event that either party confirms that they intend to seek an order for off scale costs then on or before 4 pm on Monday 9 December 2019 that party must: (a) provide a bill itemising the actual costs upon which they intend to rely for that purpose; and (b) provide a reasoned statement in support of their request for costs to be awarded on an off scale basis.

83. Thereafter I shall give further directions for submissions in response to any application for off scale costs of the appeal before considering and then issuing a decision as to costs on the basis of the papers before me.

84. For the avoidance of any doubt in the event that no application is made for an order for off scale costs I will, as agreed by the parties at the hearing, proceed to make an order in relation to the costs of the appeal (including the costs of the application to admit further evidence; and relating to the costs of the late service of the Respondent's Notice) in the usual way.

EMMA HIMSWORTH QC
Appointed Person

11 November 2019