

O/960/22

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION
NO. 03622589 BY
IBRAHIM SAHIN
TO REGISTER THE TRADE MARK:**



IN CLASSES 5, 25, 28, 32 & 35

AND

**OPPOSITION THERETO
UNDER NO. 426989
BY
MAST- JÄGERMEISTER SE**

BACKGROUND & PLEADINGS

1. Ibrahim Sahin (“**the applicant**”), applied to register the trade mark shown on the front page of this decision in the United Kingdom on 7 April 2021. It was accepted and published in the Trade Marks Journal on 18 June 2021 for the following goods and services:

Class 5: Dietary supplements for pharmaceutical and veterinary purposes; dietary supplements; nutritional supplements; medical preparations for slimming purposes; herbs and herbal beverages adapted for medicinal purposes.

Class 25: Clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; Footwear; shoes; slippers; sandals; sneakers; trainers; Headgear; hats; caps with visors; berets; caps [headwear]; skull caps.

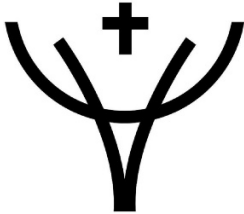
Class 28: Gymnastic and sporting articles not included in other classes.

Class 32: Energy drinks; protein-enriched sports beverages; Fruit and vegetable juices; fruit and vegetable concentrates and extracts for making beverages; non-alcoholic soft drinks; Mineral water; spring water; table water; soda water.

Class 35: The bringing together, for the benefit of others, of dietary supplements for pharmaceutical and veterinary purposes, dietary supplements, nutritional supplements, medical preparations for slimming purposes, herbs and herbal beverages adapted for medicinal purposes, Clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], footwear, shoes, slippers, sandals, sneakers, trainers Headgear, hats, caps with visors, berets, caps [headwear], skull caps, gymnastic

and sporting articles not included in other classes, energy drinks, protein-enriched sports beverages, fruit and vegetable juices, fruit and vegetable concentrates and extracts for making beverages, non-alcoholic soft drinks, Mineral water, spring water, table water, soda water, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

2. Mast-Jägermeister SE (“**the opponent**”) opposes the application on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The opponent is the proprietor of the following marks:

Trade Mark no.	UK00801389628 ('628)
Trade Mark	
Goods & Services	Classes 16,25,33,35,38,41 & 43
Relevant Dates	Filing date: 22 November 2017
	Date of entry in register: 17 July 2018

Trade Mark no.	UK00801445726 ('726)
Trade Mark	
Goods & Services	Classes 16,25,33,35,38,41 & 43
Relevant Dates	Filing date: 1 October 2018
	Date of protection in UK: 9 April 2019

3. The earlier marks relied upon by the opponent are ‘comparable’ trade marks based on the opponent’s earlier International Registrations which

have designated the EU (“IR(EU)”). On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with an existing IR(EU).

4. For the purpose of this opposition, the opponent relies on some goods and services from its earlier specifications, as follows:

Class 25: Clothing, footwear, headgear.

Class 33: Alcoholic beverages (except beer); pre-mixed alcoholic beverages, except beer; alcoholic preparations for making beverages.

Class 35: Advertising, marketing and promotional services; preparation of competitions for advertising purposes.

5. In addition, the opposition concerns only part of the contested specification for the following goods and services:

Class 25: Clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; footwear; shoes; slippers; sandals; sneakers; trainers; headgear; hats; caps with visors; berets; caps [headwear]; skull caps.

Class 32: Energy drinks; protein-enriched sports beverages; non-alcoholic soft drinks.

Class 35: The bringing together, for the benefit of others [...] clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], footwear, shoes, slippers, sandals, sneakers, trainers, headgear, hats, caps with visors, berets, caps [headwear], skull caps, energy drinks, protein-enriched sports beverages; non-alcoholic soft drinks, [...] enabling customers to

conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues

6. Under Section 6(1) of the Act, the opponent's trade marks clearly qualify as earlier trade marks. Further, as the registration of the opponent's earlier marks was completed less than five years before the application date of the contested mark, proof of use is not relevant in these proceedings, as per Section 6A of the Act.
7. In its notice of opposition, the opponent argues that the competing marks are similar visually, claiming that "the respective signs consist of a simplistic representation of a forward facing headshot of a stag, or other male species within the cervidae/deer family. The angled and triangular shape of the face is common to both signs and the use of overlapping lines give the representation of antlers on each side split into two parts. The respective marks consist of similar proportions, with the stylised face constituting approximately half of the devices, and the antlers forming the remainder." It also states that no aural comparison can be made between the signs and that conceptually the marks are identical. Further, it claims that the contested goods in Class 25 are identical, whilst the goods in Class 32 and services in Class 35 are similar to the opponent's.
8. In response, the applicant filed a counterstatement, denying any similarity between the marks. In particular he claimed that:

"[...] The Opponent's device marks could not be perceived as a stag, but rather they are deemed as letter V and U (or below half part of a circle) in intersection and a cross, which is placed upper open side of the half circle. Only informed consumer might deem is as a stag. Besides, even though they would have been perceived as a stag, as trademark law does not give a right to a trademark owner to monopolize an animal figure, a certain overall similarity is necessary

to claim the likelihood of confusion, which is absent for the subject devices.”

In relation to the identity/similarity of the respective goods in Class 32, the applicant asserts that “the cited trademarks do not cover non-alcoholic beverages in class 32, considering precedents that put forth that their places/shelves/consumers are different from the ones of alcoholic beverages.” However, the applicant does not explicitly deny the opponent’s claims for the rest of the goods and services in Classes 25 and 35, respectively. I will return to this point later in my decision.

9. Only the opponent filed evidence. It consists of a witness statement by Ms Eve Brown, who is the Intellectual Property Counsel of the opponent. I have read and considered all this evidence and will refer to the relevant parts at the appropriate points in the decision.
10. Only the opponent filed written submissions, dated 4 August 2022, which will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
11. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicant by Hatice Ahu Guneyli.
12. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

DECISION

Section 5(2)(b)

13. The relevant statutory provisions are as follows:

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

“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.”

14. The principles, considered in this opposition, stem from the decisions of the European 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 BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market* (Trade Marks and Designs) (OHIM) (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH* (Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

- 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 & Services

15. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

16. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

17. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281. At [296], he identified the following relevant factors:

“(a) The respective uses of the respective goods or services;
(b) The respective users of the respective goods or services;
(c) The physical nature of the goods or acts of service;
(d) The respective trade channels through which the goods or services reach the market;
(e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] 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.”

19. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00

Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

20. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), paragraph 12, Floyd J (as he then was) gave the following guidance on construing the words used in specifications:

“[...] 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.”

21. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

22. The competing goods and services to be compared are shown in the following table:

Opponent's Goods & Services Earlier Marks '628 & '726	Applicant's Goods & Services
Class 25: Clothing, footwear, headgear.	Class 25: Clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; footwear; shoes; slippers; sandals; sneakers; trainers; headgear; hats; caps with visors; berets; caps [headwear]; skull caps.
	Class 32: Energy drinks; protein-enriched sports beverages; non-alcoholic soft drinks.
Class 33: Alcoholic beverages (except beer); pre-mixed alcoholic beverages, except beer; alcoholic preparations for making beverages.	
Class 35: Advertising, marketing and promotional services; preparation of competitions for advertising purposes.	Class 35: The bringing together, for the benefit of others [...] clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], footwear, shoes, slippers, sandals, sneakers, trainers, headgear, hats, caps with visors, berets, caps [headwear], skull caps, energy drinks, protein-enriched sports beverages; non-alcoholic soft drinks, [...] enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues.

23. In the notice of opposition, the opponent claims that the contested goods are identical and/or similar to the earlier goods and services. In addition, the opponent made lengthy submissions, which I have taken into account but do not propose to reproduce here.
24. The applicant, in his notice of defence, states that “the cited trademarks do not cover non-alcoholic beverages in class 32, considering precedents that put forth that their places/shelves/consumers are different from the ones of alcoholic beverages. Therefore, the opposition should be refused entirely for all the goods & services opposed.” In this regard, I note that the applicant only denies the opponent’s claims in relation to Class 32 goods without putting forward a blanket denial regarding the identity/similarity of the competing specifications. Therefore, the applicant is deemed to have accepted the opponents contentions in relation to Class 25 goods and Class 35 services.¹
25. For the purpose of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way for the same reasons.²

¹ Prof. Phillip Johnson, sitting as the Appointed Person, in *SKYCLUB*, BL O/044/21, at paragraph 24 states: “The position in the Civil Procedure Rules (CPR) is clear; namely, a defendant must state which allegations are denied, which allegations a defendant is unable to admit or deny, and which allegations the defendant admits (CPR, 16.5(1)). Where a defendant fails to deal with an allegation it is taken to be admitted (CPR 16.5(5)). This is subject to the rule that where an allegation is not dealt with, but the defence sets out the nature of his case in relation to the issue to which that allegation is relevant, then the allegation must be proved by the Claimant (CPR 16.5(3)). Thus, the filing of a “blank” defence would lead to the whole of the Claimant’s case being admitted.”

² *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

Class 25

Clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing; socks; mufflers [clothing]; shawls; bandanas; scarves; belts [clothing]; footwear; shoes; slippers; sandals; sneakers; trainers; headgear; hats; caps with visors; berets; caps [headwear]; skull caps.

26. Given the applicant's admission, strictly speaking, there is nothing for me to decide for the respective goods, but in any case, I would have found them to be *Meric* identical.

Class 32

Non-alcoholic soft drinks

27. The opponent draws my attention to the finding and analysis set out in decision O/049/21, and particularly in paragraphs 26-27. However, I note that the goods compared in that decision, namely *non-alcoholic beverages v alcoholic beverages (except beer)*, are slightly different from the goods at hand. Further, the opponent asserts that "non-alcoholic soft drinks" in class 32 would cover various beverages without alcoholic content, and may include non-alcoholic versions of the Opponent's alcoholic beverages."
28. The contested goods are "*non-alcoholic soft drinks*", which cover a wide range of non-alcoholic drinks, such as fizzy pop. The opponent's goods, "*Alcoholic beverages (except beer); pre-mixed alcoholic beverages, except beer*", are all alcoholic drinks some of which may be pre-mixed with soft drinks. I agree with the opponent that the contested goods would cover the equivalent non-alcoholic versions of the opponent's goods, such as non-alcoholic cocktails and cider, as the production of such drinks and the end-products could be similar to a certain degree. In this regard, the competing goods are similar in nature to the extent that they are drinks.

They may overlap in purpose as the competing goods could be consumed for relaxation, without disregarding, though, the fact that the earlier goods could be consumed for intoxication. The trade channels may overlap as they will be sold in the same premises, such as supermarkets and off-licences, albeit they will be sold in different aisles, and in the same establishments, such as pubs, bars, and restaurants. There may be an element of competition to the extent that the contested goods may be considered as an alternative to alcoholic drinks. I find that the goods are similar to a medium degree.

Energy drinks

29. The opponent in its submissions asserts that energy drinks are similar to its “*pre-mixed alcoholic beverages, except beer*”, particularly where pre-mixed alcoholic beverages contain an energy drink mixer.
30. The contested goods are drinks containing various vitamins usually consumed before or after physical/sporting activity to boost energy levels. The closest comparable term in the earlier specification is the “*pre-mixed alcoholic beverages, except beer*” goods in Class 33. Although the competing goods are all drinks in liquid form, they differ in nature due to their composition and, most importantly, the presence/absence of alcohol. In addition, they may serve a different purpose as the earlier goods are consumed for relaxation or intoxication in social surroundings, whereas the energy/protein drinks could be used for fitness purposes apart from pleasurable taste. There is an overlap in users but only to a certain extent as the earlier goods are restricted to adults. The trade channels through which the respective goods reach the market will also overlap as they will be widely offered in the same establishments, such as bars, restaurants, and pubs, and be on sale in supermarkets and off-licence stores. However, I do not consider that the respective goods will be displayed in the same shelf or section. I consider that there might be an element of competition as I cannot dismiss the fact one can choose to drink one over the other. Even when the goods are used together, in the absence of evidence, I do

not consider that the respective goods are complementary in the sense that the average consumer would expect responsibility for them to lie with the same or an economically connected undertaking. This is also evident throughout the opponent's submissions referring to a distinct energy drinks brand, i.e. Redbull, as a typical drink mixer. I find that the respective goods are similar to a low degree.

Protein-enriched sports beverages

31. The opponent claims that there is similarity because the contested goods are forms of energy drinks, and as a result they can be used as mixers in *“pre-mixed alcoholic beverages, except beer”*.
32. The contested goods are sports beverages where additives, namely protein, have been added. Following the same approach in the preceding paragraph, the contested goods and the earlier *“pre-mixed alcoholic beverages, except beer”* goods in Class 33 are all liquids, but they differ in nature as the former goods do not contain alcohol. In addition, the competing goods may serve a different purpose. In particular, the contested goods are used to assist the consumer in performance, replenish energy, increase protein intake, and improve physical activity in general. However, as explained in the previous paragraph, the earlier goods are consumed for relaxation or intoxication in social surroundings. Furthermore, it is my view that there is a limited overlap in trade channels as the contested goods will be mainly sold in supermarkets and off-licence stores and not in establishments, such as pubs, bars or restaurants, as the earlier goods. The users overlap to a certain extent as the earlier goods are restricted to adults. Although there might be an element of competition, I do not consider that the respective goods are complementary in the absence of evidence. I find the competing goods to be similar to a very low degree.

Class 35

33. I remind myself that the applicant has not expressly denied any identity/similarity between the contested services in Class 35 and earlier specification.
34. Before conducting the assessment of these services, I will set out some further applicable case law.
35. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the GC held that although retail services are different in nature, purpose, and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.
36. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning the comparison of retail services with goods. He said at paragraph 9 of his decision that:

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

37. However, on the basis of the European Courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v OHIM*, Case T-105/05, at paragraphs 30 to 35 of the judgment, upheld on appeal in *Waterford Wedgewood Plc v Assembled Investments (Proprietary) Ltd*, Case C-398/07P, Mr Hobbs concluded that:

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

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

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

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

The bringing together, for the benefit of others [...] clothing, including underwear, sportswear and outerclothing, other than special purpose protective clothing, socks, mufflers [clothing], shawls, bandanas, scarves, belts [clothing], footwear, shoes, slippers, sandals, sneakers, trainers, headgear, hats, caps with visors, berets, caps [headwear], skull caps, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues

38. The contested services in Class 35 are provided with the aim of retailing or wholesaling a range of clothing, footwear, and headwear products via electronic media or mail order catalogues. The nature of the contested services here differs from the goods “Clothing, footwear, headgear” in Class 25 in the earlier specifications. The contested services are offered by a retailer or wholesale supplier for the sale and purchase of goods by the end users or businesses, whilst the opponent’s goods are the physical products per se. Moreover, the method of use and purpose differentiates between the goods and services. However, the ordinary method of retailing such goods creates a link where consumers are likely to believe that the same commercial undertaking could offer both the goods and the retail or wholesale services within the confines of the case law mentioned above. Thus, I find that the complementarity is sufficiently pronounced in this case. Taking all these factors into consideration, there is a medium degree of similarity between the respective goods and services.

The bringing together, for the benefit of others [...] energy drinks, protein-enriched sports beverages, non-alcoholic soft drinks, enabling customers to conveniently view and purchase those goods, such services may be provided by retail stores, wholesale outlets, by means of electronic media or through mail order catalogues

39. Following the same approach in the preceding paragraph, the closest comparable terms from the earlier specification are “Alcoholic beverages (except beer); pre-mixed alcoholic beverages”. Notwithstanding that it is

not necessary for the retailed goods to be identical to the goods of the earlier mark to find similarity between retail services and physical goods, I nevertheless find very low similarity for the retailing of the respective goods in Class 35 on the basis that the applicant admitted similarity as set out in *SKYCLUB* (cited above).

40. I note that the opponent submits that the contested services are also similar to its “*Advertising, marketing and promotional services*” in Class 35. The opponent also refers me to decision O/804/21 where similarity of a medium degree was found between the “*Advertising on communication media for retail purposes*” services in Class 35 and the “*Retailing and wholesaling, including via the internet, in relation to batteries*” services in the same Class. Nevertheless, I note that I cannot disregard the overlapping purpose of retailing in the earlier case and that the competing terms in the case at issue are different and. In any event, I consider that the respective services at issue do not put the opponent in a better position as they differ in purpose, users, and trade channels, and they are not complementary or in competition.

Average Consumer and the Purchasing Act

41. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purposes 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 and services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), at paragraph 70, Birss J (as he then was) described the average consumer in these terms:

“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 word 'average' denotes that the person is typical. The term 'average' does not denote some form of numerical mean, mode or median."

42. The Class 25 goods will be purchased by members of the general public. Such goods are usually offered for sale in stores, such as retail outlets, brochures and catalogues, and online. In retail premises, the goods will be displayed on shelves and racks, where they will be viewed and self-selected by consumers. Similarly, for online stores, consumers will select the goods relying on the images displayed on the relevant web pages. Nevertheless, the selection process may involve aural considerations, as advice may be sought from a sales assistant or representative. Therefore, visual considerations will dominate the selection of the goods in question, but aural considerations will not be ignored in the assessment.³ Even for those at the inexpensive end of the scale, the average consumer may examine the products to ensure that they select the correct type, size, material, quality, and aesthetic appearance of, for example, clothing items. Thus, the average consumer will pay an average degree of attention.
43. In relation to the Class 32 goods, the average consumer will be members of the public at large who will purchase the goods in places such as restaurants, cafés, shops, or via the internet or mail order. In retail premises, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumers. In addition, the consumers in premises such as restaurants, cafés, and pubs will select the goods by a visual perusal of a drinks menu or oral request. Although these goods are not particularly costly, the average consumer may examine the product

³ The GC highlighted this in *New Look Ltd v OHIM Cases T-117/03 to T-119/03 and T-171/03*, at paragraph 50: "Generally, in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly, the visual aspect plays a greater role in the global assessment of the likelihood of confusion."

to ensure that they select the correct type, flavour, etc., of beverage. Therefore, the selection process is predominantly a visual one, but aural considerations will also play their part. In this regard, the average consumer is likely to pay an average (but not high) level of attention to selecting the goods at issue.

44. As to the services in Class 35, the average consumer will be the general public for the retail services and, more likely, business users for the wholesale services. The selection process will be based on factors such as availability of the desired product range, price, quantity, and quality. Primarily, the average consumer's encounter with the given services will be on a visual level, such as signage on premises, promotional material, and website use. The process, therefore, will be primarily visual, but word of mouth or recommendations may also play a role. The degree of attention paid to the selection of a retailer will be average, taking into account commercial considerations. However, for wholesale services, the business users will pay an above average degree of attention in selecting the service provider owing to the importance of ensuring that the service meets the business requirements.

Comparison of Trade Marks

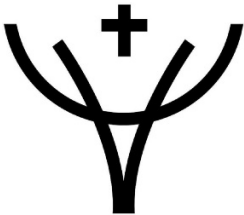
45. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference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

“[...] it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public,

and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

47. The marks to be compared are:

Opponent's Marks	Applicants' Mark
<u>Earlier mark '628</u> 	
<u>Earlier Mark '726</u> 	

Overall Impression

48. The contested mark is a figurative mark. The device comprises a rendition of a front-facing stag head in black, with a clear depiction of animal features, including antlers, ears, and eyes. The overall impression lies in the mark as a whole.

49. Both of the earlier marks comprise the figurative elements of a cross device and a composition of intersecting lines, all in black. The intersecting lines

consist of a curvy 'V' shape line and a superimposed semicircle line. I note that the earlier mark '726 is slightly more stylised than the earlier mark '628. This is due to the brush stroke effect applied to the former mark instead of the hard and well-defined lines of the latter mark. Although the cross device is smaller in size than the composition of the intersecting lines, I note that it sits above and at the centre of the earlier marks, which I consider to be a prominent position. Despite the size difference between the figurative elements, the overall impression resides in the marks as a whole.

Visual comparison

50. In its submissions, the opponent claims that:

“13. Visually, the Contested Application consists of a black and white figurative mark consisting of an abstract depiction of a stag headshot with protruding antlers, pointing upwards and outwards. The Contested Application contains no other visual or verbal elements and the stag headshot is therefore the dominant and distinctive element of the sign. Akin to the Contested Application, the Opponent's Registrations also consist of abstract line drawings of a stag headshot. The stag outline is in black against a white background. The stag headshots in the Opponent's Registrations also include spreading antlers of a similar size and dimension to the Contested Application. The 'face' of the stags in the Opponent's Registrations and the Contested Application consist of a “V” shape with a flat edge where the two lines intersect. The respective marks have faces that exclude any facial features, such as a mouth or a nose, and have a blank white space in the middle of the intersecting lines. The respective signs contain antlers that account for approximately half of the length of the signs. Overall, the visual impression is an abstract drawing of a stag, or other member of the deer family, consisting of intersecting lines, with a face that forms the appearance of an

isosceles triangle. Overall, the respective marks would be understood to constitute a black and white stag's head with spreading antlers.”

51. The applicant in his counterstatement puts forward the following:

“The Opponent's device marks could not be perceived as a stag, but rather they are deemed as letter V and U (or below half part of a circle) in intersection and a cross, which is placed upper open side of the half circle. Only informed consumer might deem is as a stag.”

52. Before conducting the visual comparison between the respective marks, I remind myself of the comments of Iain Purvis, Q.C. (as he then was), sitting as the Appointed Person, in *The Royal Academy of Arts v Errea Sport S.p.A*, BL O/010/16, where it was stated:

“13 [...] I do not have any difficulty with the notion (which Mr Stobbs appeared to be contending was illogical) that two representations of the same thing may have no visual similarity. In the world of art, the visual representation of a horse in Picasso's *Guernica* has little or nothing in common with the visual representation of a horse in one of George Stubbs' portraits. I do not think it unreasonable to say that they have no visual similarity, whilst having some limited conceptual similarity (they are both paintings of horses).”

53. Visually, it is my view that the only similarity between the marks is their geometry, in particular, their conical shape that extends downwards. There are, though, a number of visual differences between the marks. Although the opponent submits that the competing marks depict a “drawing of a stag, or other member of the deer family”, I disagree with this contention. On the one hand, the average consumer will see the depiction of a front-facing stag in the contested mark as it clearly contains key facial features, for example, antlers, ears, and eyes, of the said animal. On the other, I remind myself that the average consumer would not proceed to analyse the various details of a mark; hence, in the absence of evidence, the

average consumer will only visualise the earlier figurative marks as a composition of intersecting lines and a cross device, not as an abstract representation of a stag. I will return to this point later in this decision. This is so as there are no such characteristics in the earlier marks that would suggest a depiction of a stag or other member of the deer family or even any other animal. In addition, another point of difference is the presence/absence of the cross device in the competing marks. Considering the above factors and the overall impressions, I find that the respective marks are visually similar to a very low degree.

Aural comparison

54. The correct approach to conducting an aural comparison of figurative marks was clarified by the GC in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10, in which it stated:

“46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.”

55. Given the nature of the respective marks, particularly that they are simply figurative depictions with no word elements to speak of, it follows that neither can be articulated and therefore an aural comparison is not appropriate.

Conceptual comparison

56. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous

judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

57. The opponent in its submissions considers that:



58. However, as shown above in paragraph 51, in his counterstatement, the applicant counterargues that the earlier marks could not be perceived as a stag.

59. In terms of the contested mark, the average consumer will immediately perceive the figurative element to be a head of a stag. The presence of the antlers and the rest of the characteristics identified previously in this decision will enable the consumer to discern such a concept from the contested mark.

60. As outlined earlier in this decision, the earlier marks will not be understood as an abstract head of a stag or a member of the deer family. Although the opponent refers me to the Witness Statement of Eve Brown and Exhibit 2, which shows a product, i.e. tote bag, titled “STAG FOR LIFE TOTE BAG” bearing the earlier mark ‘726, I note that as per *Ruiz Picasso v OHIM* (cited above) the relevant test is what concept the average consumer will discern

from the mark itself and not how the product is marketed. Therefore, in the absence of evidence, I find it unlikely that the average consumer will effortlessly discern the concept of a stag from both of the earlier marks. It is my view that the composition of intersecting lines will be perceived as such, namely an abstract composition, without having any meaning. However, the cross device, which is also another point of conceptual difference, may be perceived as the religious symbol of Christianity embedding a religious concept into the earlier marks. Taking into account all the above, I find the respective marks to be conceptually dissimilar.

Distinctive Character of The Earlier Trade Mark

61. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, paragraph 22 and 23, the CJEU stated that:

“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).

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).”

62. Registered trade marks possess varying degrees of inherent distinctive character from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.
63. Whilst the opponent has provided some evidence, the material filed does not assist and it is minimal to say the least. Thus, I have only the inherent distinctiveness of the earlier marks to consider. As detailed above, the average consumer may conceptualise the cross device as a symbol of Christianity that will embed a religious concept into the earlier marks. Alternatively, they will see them as an abstract composition. I note that there is no apparent link between the marks and the goods and services concerned. That said, I do not find the marks’ aesthetic particularly elaborate. On balance, I find their inherent distinctiveness to be of a medium degree.

Likelihood of Confusion

64. In assessing the likelihood of confusion, I must adopt the global approach set out in the case law to which I have already referred above in this decision. Such a global assessment is not a mechanical exercise. I must also have regard to the interdependency principle, that 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.⁴ It is essential to keep in mind the distinctive character of the opponent’s trade mark since the more distinctive the trade mark, the greater the likelihood of confusion. I must also keep in mind that the average consumer rarely has the opportunity to

⁴ See *Canon Kabushiki Kaisha*, paragraph 17.

make direct comparisons between trade marks and must instead rely upon imperfect recollection.⁵

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion is where the consumer notices the marks are different, but concludes, due to the similarities between them, that the later mark is another brand of the owner of the earlier mark or a related undertaking (or vice versa).
66. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Iain Purvis Q.C., sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

I note that the categories identified above by Mr Purvis Q.C. are not exhaustive.⁶

67. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C. (as he then was), sitting as the Appointed Person, stressed that a

⁵ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

⁶ *Thomson Hotels LLC v TUI Travel Amber E&W LLP* BL- O-440/14 at paragraph 29.

finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

68. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

“13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Mr Mellor went on to say that, if there is no likelihood of direct confusion, "one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion". I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion.”

69. Earlier in this decision I have concluded that:

- the goods and services at issue range from identical to similar to a very low degree;
- the average consumer for the Class 25 and 32 goods is a member of the general public, who will select the goods by predominantly visual means, but without dismissing the aural means. The average consumer will examine the goods, thereby paying an average degree of attention. As for the Class 35 services, the average consumer will be the general public for the retail services and, more likely, business users for the wholesale services with the selection process conducted primarily at a visual level without dismissing

aural considerations. The degree of attention will be average for the retail services, while business users will pay an above average degree of attention for the wholesale services;

- the competing marks are visually similar to a very low degree, the aural similarity between the marks cannot be assessed, and conceptually dissimilar;
- the earlier mark is inherently distinctive to a medium degree and the use provided by the opponent is not sufficient to establish an enhanced distinctiveness of the mark.

70. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion even for identical goods. I make this finding on the basis that there is only a very low degree of visual similarity. I bear in mind that the earlier marks are distinctive to a medium degree and that the visual interaction with the goods in question will play the most important part. Notably, this finding is reinforced by the conceptual dissimilarity of the competing marks. The average consumer will view the contested mark as a representation of a stag head as opposed to the opponent's marks, where, if the earlier marks have any meaning at all, the cross device may be understood as a symbol of Christianity with a religious reference embedded into the marks and with the composition of the intersecting lines having no discernible meaning. Therefore, the average consumer would be able to distinguish that the marks are different and would not be mistakenly recalled as each other. This finding extends to the goods and services for which I found any degree of similarity. Where I found dissimilarity between the goods and services, there can be no likelihood of confusion.

OUTCOME

71. The opposition has failed, and, subject to an appeal against this decision, **the application may proceed to registration in its entirety.**

COSTS

72. This opposition has failed in its entirety and the applicant is entitled to a contribution towards his costs of defending the application. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. In this regard, I award costs to the applicant as a contribution towards the cost of the proceedings on the following basis:

Considering the other side's statement and preparing a counterstatement	£200
Total	£200

73. I, therefore, order Mast-Jägermeister SE to pay Ibrahim Sahin the sum of £200. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 3rd day of November 2022

**Dr Stylianos Alexandridis
For the Registrar,
The Comptroller General**