O/0029/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3882180

BY PICASSO GROUP CO., LTD

TO REGISTER:

PICASSO

AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 442347 BY

FLORIAN RUIZ-PICASSO

BACKGROUND AND PLEADINGS

1. On 24 February 2023, Picasso Group Co., Ltd ("the applicant") applied to register **PICASSO** as a trade mark in the United Kingdom. Following an amendment of the specification, the goods in respect of which registration is sought are the following:

> *Class 33*
> *Whiskey.*

2. On 7 August 2023, the application was opposed by Florian Ruiz-Picasso ("the opponent"), a member of the family of the famous artist Pablo Picasso.[1] The opposition was initially based on sections 5(2)(b) and 3(6) of the Trade Marks Act 1994 ("the Act") but the claim under section 3(6) has been withdrawn.

3. Under the remaining section 5(2)(b) ground, the opponent is relying on UKTM No. 801522721, **Florian Picasso**, which has a priority date of 27 September 2019 and a registration date of 19 August 2020.[2] The mark is registered for goods and services in Classes 9, 16, 25, 32 and 41. The opponent is relying on the following goods:

> *Class 32*
> *Bières; boissons sans alcool; eaux minérales et gazeuses; boissons énergisantes*.

4. This is the specification that appears on the Register of Trade Marks. It will be noted that it is in French. The earlier mark is a comparable mark that was created from IR(EU) 1522721, pursuant to Article 54 of the Agreement on the Withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community. As part of this process, the records from the EU Intellectual Property Office ("EUIPO") were used to create the entries on the UK Register. The parties are agreed that the specification should be translated as follows:[3]

> *Class 32*
> *Beers; soft drinks; mineral and aerated waters; energy drinks.*

[1] See paragraph 2 of Mr Ruiz-Picasso's witness statement.
[2] Priority is claimed from Swiss Trade Mark No. 741633.
[3] See paragraph 13ff of the opponent's written submissions and paragraph 33 of the applicant's written submissions.

5. The mark qualifies as an earlier mark under section 6(1) of the Act by virtue of its earlier priority date. As the mark was registered less than five years before the application date of the contested mark, the opponent does not have to prove that he has used the mark and may rely on all the goods listed above. In passing, I note that the applicant has filed an application for a partial revocation of this mark in relation to the goods in Class 32.[4] However, as the earliest possible date of revocation is 20 August 2025, that application has no bearing on the present proceedings.

6. The opponent claims that the marks are highly similar, as the contested mark consists of the surname “Picasso”. It also claims that there is a high degree of similarity between the parties’ goods. Consequently, it argues that there is a likelihood of confusion between the marks, including the likelihood of association.

7. The applicant filed a defence and counterstatement denying the claims made. In particular, it asserts that the marks are dissimilar and that the goods are totally dissimilar. It points to the high alcohol content of its own goods, in contrast to the goods of the opponent, being either non-alcoholic beverages or beers with a lower alcohol content than whiskey.

8. Only the opponent filed evidence, and I shall summarise this briefly below. He also filed written submissions during the evidence rounds. These are dated 27 August 2024. Neither side requested a hearing; and the applicant filed written submissions in lieu of the same, dated 9 December 2024. I have taken this decision after a careful consideration of the papers.

9. In these proceedings, the opponent is represented by Murgitroyd & Company and the applicant is represented by Mathys & Squire LLP.

EVIDENCE

10. The opponent’s evidence consists of two witness statements. The first comes from the applicant himself. It is dated 20 August 2024 and is unaccompanied by any exhibits. Mr Ruiz-Picasso states that he is, by adoption, the great-grandson of Pablo Picasso and that he had the family’s permission to register the earlier mark. The second witness statement is from Ms Anna Teresa Szpek, a Chartered Trade Mark

[4] CA509845.

Attorney employed by the opponent's legal representative. It is dated 27 August 2024 and is accompanied by nine exhibits which contain the results of internet searches on the retailing of alcoholic drinks and the relationship between alcoholic beverages and low- or no-alcohol alternatives and soft drinks.

RELEVANCE OF EU LAW

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

DECISION

12. Section 5(2)(b) of the Act is as follows:

> "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."

13. In considering the opposition, I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union ("CJEU") 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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their mind, and whose attention varies according to the category of goods or services in question;

c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

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

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

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

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

Comparison of goods

14. It is settled case law that I must make my comparison of the goods on the basis of all relevant factors. These include the nature of the goods, their purpose, their users and method of use, the trade channels through which they reach the market, and whether they are in competition with each other or are complementary: see *Canon*, paragraph 23, and *British Sugar Plc v James Robertson & Sons Limited (TREAT Trade Mark)* [1996] RPC 281 at [296]. As the General Court ("GC") said in *Boston Scientific Ltd v OHIM*, Case T-325/06, goods (and services) are complementary when

> "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."

15. The goods to be compared are shown in the table below:

Contested goods	**Earlier goods**
Class 33 *Whiskey*	*Class 32* *Beers; soft drinks; mineral and aerated waters; energy drinks.*

16. Both parties referred me to previous decisions of this Tribunal, the GC and the EUIPO to support their submissions. I note that the outcomes of these decisions are not strictly binding, but I have taken them all into account in coming to my decision on

the similarity of the goods. I shall refer to them where appropriate in the analysis that follows.

17. First, though, I note that in an Appeal decision issued after the parties had made their written submissions, Professor Phillip Johnson, sitting as the Appointed Person, considered the case law of the GC on the assessment of the similarity between alcoholic products and other beverages.[5] He said:

> "12. It is important to remember that the outcomes of all these cases are fact dependent and that they are not binding (in the strict sense) in relation to other cases involving similar pairs of goods. This is because the relevant public will be different (whether in terms of time or place) on the relevant date. There are, however, relevant considerations set out in all these decisions which may be applied in other cases.
>
> 13. First, the fact that spirits are mixed with soft-drinks (mixers) does not make the products complementary (*Yilmaz*, [55]; *Wesergold*, [40]; *CHIC*, [53 to 55]), but it does mean there is a partial (but not significant) overlap between spirits and soft drinks (*Wesergold*, [32 and 33]).
>
> 14. Second, soft-drinks, water and (possibly) beer are drunk to quench the thirst (*Yilmaz*, [54]); *Wesergold*, [35 and 36]; *ROSALIA DE CASTRO*, [31]; the *CHIC* case takes a different view that low alcoholic drinks are not consumed to quench thirst, *CHIC*, [44]), but in any event spirits are not consumed to quench a thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]).
>
> 15. Thirdly, the methods of production for alcoholic drinks (and between alcoholic drinks and non-alcoholic drinks) differ and this is relevant to the similarity between them: *Mezzopane*, [64 and 69]; *Bodegas*, [29]; *Yilmaz*,

[5] *ELUX Trade* Mark, BL O/0488/25. The cases mentioned in the passage cited are the following: *Coca Cola v OHIM (Mezzopane)*, Case T-175/06; *Bodegas Montebello*, Case T-430/07; *Cooperativa Vitivinicola Arousana v OHMI (ROSALIA DE CASTRO)*, Case T-421/10; *Wesergold Getrankeindustrie v EUIPO*, Case T-278/10; *Yilmaz v OHIM*, Case T-584/10; *Asola Ltd v EUIPO (FLÜGEL)*, Case T-150/17; *La Zaragozana v EUIPO (CERVISIA)*, Case T-378/17; *Sociedade da Água de Monchique, SA v EUIPO (CHIC)*, Case T-195/20; and *Vanhove v EUIPO*, Case T-437/22. The Appointed Person noted that the last two are not assimilated law.

[54]. Likewise, products which are processed versions of each other might be more similar (eg wine and Brandy): *Vanhove*, [87].

16. Fourthly, the differences between the colour, aroma and taste of two alcoholic drinks suggests to consumers that they are different: *Mezzopane*, [65]; *Yilmaz* [54].

17. Finally, the alcoholic content of the goods is a very relevant factor in determining the similarity of the goods: *Bodegas*, [32]; *Wesergold*, [31]; *CHIC*, [40 and 41]; *FLÜGEL*, [84]. However, a non-alcoholic version of an equivalent alcoholic drink is likely to be highly similar to it: *CERVISIA*, [20]. Nevertheless, the Grand Board highlighted that a drink's alcoholic content is only a factor in the assessment of similarity and is not determinative: *ZORAYA*, [68]."

18. I remind myself that it is the perception of the average consumer in the United Kingdom that is relevant. I also bear in mind the guidance given by the courts on the construction of terms in specifications. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"12. … 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."

19. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin said:

> "365. … The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 195; [2004] RPC 40 at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specification of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case."

20. I consider that the average consumer in the UK would understand the term *Soft drinks* to refer to cold, frequently sweet, non-alcoholic drinks. I agree with the opponent that they are drunk in order to quench the consumer's thirst. I accept that Ms Szpek's evidence shows that non-alcoholic whiskey is available on the market, but I consider that this would be drunk, like its alcoholic equivalent, in small quantities and not to quench the thirst. Therefore, it is my view that the average consumer in the UK would not describe non-alcoholic whiskey as a *soft drink*. The parties' goods serve different purposes, as the applicant's *Whiskey* is drunk in order to experience the effects of alcohol and/or enjoy the flavour of the drink. The applicant's goods are targeted towards adults, while the opponent's goods may be purchased by anyone. There is likely to be an overlap in trade channels, but, while both parties' goods may be sold in the drinks sections of supermarkets, soft drinks and whiskey are likely to be displayed in different aisles. In my view, *Whiskey* is dissimilar to *Soft drinks*.

21. I shall now consider whether there is any similarity between the applicant's *Whiskey* and the opponent's *Beers*. The opponent submits that another Hearing Officer found in *Tiger Cider Trade Mark*, BL O/568/20, that the term *Alcoholic beverages* was similar to *Beer, ale and stout* to at least a medium degree and that, as whiskey is an alcoholic beverage, I should make the same finding here. However, the

term *Alcoholic beverages* is a broad one, including a wide range of different goods, some of which may be dissimilar to each other. Some goods that fall under the broader term are likely to be similar to *Beer* to a medium degree, but that does not mean that *Whiskey* is necessarily similar to *Beer*.

22. Both parties have referred me to the decision of another Hearing Officer in *JACK & VICTOR Trade Mark*, BL O/0453/23. The opponent cites paragraph 82, while the applicant refers me to paragraph 83:

> "*Beer; Flavoured beers; Low-alcohol beer; Lager; Lager tops; Shandy*
>
> 82. The 'alcoholic beverages' of the 'JACK ROCKS' mark includes all kinds of alcoholic beverage, including drinks such as ciders and punches. The same goods are covered by the term 'whiskey-based beverages' in the 'JACK DANIEL'S' and 'JACK' marks' specifications. Whilst there are some differences, these goods also overlap with the contested goods in nature, purpose, method of use and users. The drinks are likely to be on different shelves in supermarkets but will be fairly close to one another in both retailers and in licensed premises. They are not complementary but there is a competitive relationship between the goods. They are similar to a high degree.
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> 83. For reasons which will become apparent, it is also necessary to compare the above goods with 'whisky'. Although the contested goods are, like whisky, alcoholic beverages which may be drunk by the same users for a pleasurable drinking experience which may include the intoxicating effects of alcohol, there are significant differences between the goods. The production methods are different and the resulting drinks, long on the one hand with a lower alcohol content and short with a high alcohol content on the other, will be perceived as belonging to different families of alcoholic beverages. Whilst there will be an overlap in the channels of trade, the respective goods would normally both be sold in the alcoholic beverage aisles in supermarkets but they are likely to be in discrete sections of those aisles; in licensed premises, spirits are generally displayed in optics or as bottles together behind a bar, whilst beers and lagers would be on taps at

the front of the bar or in fridges. There may be a degree of competition between the goods but given the differences between them, I do not consider that the competitive choice between the contested goods and whisky will be commonly made. There is a low degree of similarity between these goods."

23. It will be seen that it is paragraph 83 that deals with the comparison I am required to make. I am in agreement with the Hearing Officer that there is an overlap in purpose and trade channels and that the parties' goods will be targeted towards the same users. Given the differences in alcohol content and length of the drinks, I consider that if there is any competition between the goods, it will be very slight. I note that the opponent has filed evidence of a collaboration between a whisky producer and a brewer *"to create a whisky beer using our smoky single malt"*.[6] However, this is a single example of joint activity between two separate undertakings and, as such, I find that it does not show that there is a complementary relationship between the goods. I am also disinclined to read much into the grouping of goods on supermarket websites under broad headings, such as "Drinks", as shown in Exhibits ATS1-ATS5. To my mind, this is an online equivalent of a Drinks section in a shop. I agree that both parties' goods will be sold in these sections, but I do not consider that they would be displayed on the same shelves, and the spirits and beers sections tend, in my experience, to be clearly demarcated. Taking all these factors into account, I find that the applicant's *Whiskey* is similar to the opponent's *Beers* to a low degree.

24. I cannot see that a comparison between the applicant's goods and the opponent's *Mineral and aerated waters* or *Energy drinks* would put the opponent in any better a position. These are not alcoholic drinks and neither are they non-alcoholic versions of *Whiskey*. The purposes, nature and production methods of the goods are different, and they are likely to be sold in less close proximity to the applicant's goods than the ones I have already considered. They are not in competition or complementary. While there is an overlap in user, this is not sufficient, in my view, for me to find that the goods are similar.

[6] Exhibit ATS9.

Average consumer and the purchasing process

25. The average consumer is deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. 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: see *Lloyd Schuhfabrik Meyer*, paragraph 26.

26. Both parties submit that the average consumer would be a member of the general public. However, I would qualify this by saying that they will be an adult. The applicant also submits that there is a further group, i.e. collectors of rare or expensive whiskies, and that consequently the average consumer will pay a high degree of attention during the purchasing process. I agree that some people will very carefully consider the origin of the whiskies, their flavour characteristics, age, and so on, but it is my view that there will also be a group of consumers who simply want to buy a bottle of whiskey or a glass of whiskey in a bar or restaurant. In *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454, Arnold LJ said:

> "31. The point of assessment from the perspective of the average consumer is that one excludes from consideration those who are either ignorant or have specialist knowledge and those who are either careless or excessively careful, but otherwise one takes into account the characteristics of the relevant class of consumers. Such consumers are not an undifferentiated mass, but have the spread of relevant characteristics that human beings have. Moreover, it is sufficient to establish a likelihood of confusion that a significant proportion of the relevant class of consumers is likely to be confused even if many would not be: see *Interflora Inc v Marks & Spencer plc* [2014] EWCA Civ 1403, [2015] Bus LR 492 at [129] (Kitchin LJ giving the judgment of the Court of Appeal)."

27. In my view, the collectors of rare or expensive whiskies are consumers with specialist knowledge and likely to be excessively careful and so I shall proceed on the basis that the average consumer is a member of the general public who wishes to purchase whiskey. While they may consider the particular flavour or strength of

individual whiskies, they will also pay attention to the price. In my view, they are likely to pay a medium degree of attention during the purchasing process. I do not think that this level of attention will be different if they are buying beer.

28. I agree with the opponent that the goods are likely to be self-selected from the shelves of supermarkets or off-licences, or their online equivalents. In a bar or restaurant, the consumer is likely to see the marks on optics behind a bar, on handpumps, on bottles in a refrigerator, or on a drinks menu. Consequently, I find that the purchasing process is predominantly visual. However, the goods may be ordered by asking bar staff for a particular product. There is also likely to be a role for word-of-mouth recommendations and assistance from sales staff. Therefore, the aural aspects of the mark are also relevant.

Comparison of marks

29. It is clear from *SABEL* (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 in *Bimbo* that:

> "34. … it is necessary to ascertain in each individual case, the overall impression made on the target public by the sign for which the 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."

30. Artificial dissection of the marks would therefore be wrong, although it is necessary for me to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

31. The respective marks are shown below:

Contested mark	Earlier mark
PICASSO	**Florian Picasso**

32. Both marks are word marks. In *LA Superquimica v EUIPO*, Case T-24/17, the GC held that such plain word marks protected the word or words contained in the mark which may be used in any form, colour or typeface: see paragraph 39. Consequently, the fact that the contested mark is shown entirely in upper case, while the earlier mark is in title case, is immaterial.

33. The contested mark is a single word, and, by necessity, the overall impression of the mark lies in the word "PICASSO".

34. Both parties agree that the two words that make up the earlier mark are a forename and a surname. They differ on the roles that each word plays: for the opponent, it is the surname "Picasso" that is dominant, while the applicant submits that "Florian" is the dominant element. In *Barbara Becker v Harman International Industries, Inc.,* Case C-51/09 P, the CJEU said:

> "36. Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character …"

35. Picasso is not a common surname in the UK and I shall say more about the conceptual content of the contested mark (i.e. the word Picasso) in due course. However, Florian is not a common forename either. The earlier mark therefore consists of two uncommon names. In my view, both names make roughly equal contributions to the overall impression of the mark. The contribution of the surname may be slightly greater, but I do not consider that there is much in it.

Visual comparison

36. The earlier mark consists of fourteen letters, spread over two words, each of seven letters. The second word is identical to the contested mark. I find that the marks are visually similar to a medium degree.

Aural comparison

37. The earlier mark has six syllables, the last three of which are identical to the contested mark. The opponent submits that the word “Florian” could go unnoticed as the focus of the consumer will be on the word “Picasso”. Given the findings I have already made on the relative contribution of each word to the overall impression of the mark, I do not agree with this submission. I find that the marks are aurally similar to a medium degree.

Conceptual comparison

38. I have already noted that the parties agree that both marks would be perceived as names. The contested mark is the surname of the renowned Spanish artist Pablo Picasso and his fame is such that even that section of the public that does not have a particular interest in the visual arts would be aware of him. The earlier mark would be seen as referring to a specific person, i.e. Florian Picasso. The opponent states that he is a member of the famous artist’s family and this is confirmed by the witness statement of Mr Ruiz-Picasso. The applicant submits that the average consumer would not be aware of this fact or understand the mark to refer to a relative of the artist. I agree with the applicant. While I accept that Picasso is not a common surname in the UK, and that Pablo Picasso is a renowned artist, I do not consider that the earlier mark would convey a clear message that the individual called Florian Picasso is a member of the artist’s family. I find that the marks are conceptually dissimilar.

Distinctive character of the earlier mark

39. Distinctive character is a measure of how strongly a mark distinguishes the goods or services of one undertaking from those of others. The factors that I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer*:

> "23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered, the market share held by the mark, how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark, the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking, and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)."

40. 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. The distinctiveness of the mark can be enhanced by the use that has been made of it.

41. There is no evidence that the earlier mark has been used for the goods at issue and so I have only the inherent position to consider. The combination of the two names indicates a specific individual. I found that both names were uncommon in the UK. Therefore, I find that the mark is inherently distinctive to a slightly higher than medium degree.

Conclusions on likelihood of confusion

42. Making an assessment of the likelihood of confusion is a matter of considering the relevant factors from the viewpoint of the average consumer of the goods at issue and determining whether they are likely to be confused. When doing this, I am required to bear in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them that they have in their mind. This means that the global assessment emulates what happens in the mind of the average consumer on encountering the later mark with an imperfect recollection of the earlier mark. The courts have not said what weight should be attached to each of the factors or provided a formula that can be applied to any set of circumstances. However, I am required to take account of the

interdependency principle, i.e. that a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods or vice versa.

43. There are two types of confusion: direct and indirect. In *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, Mr Iain Purvis QC, 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 recognised 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.
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> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> > (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).
> >
> > (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI', etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

44. In *Liverpool Gin Distillery Limited & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ commented that:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition.

13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/291/16) at [16] 'a finding of 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."

45. Earlier in my decision, I found that:

a) The applicant's goods are similar to the opponent's *Beers* to a low degree and dissimilar to the other goods in the opponent's specification;

b) The average consumer will be paying a medium degree of attention and the purchasing process may involve both visual and aural aspects of the mark;

c) The overall impression of the contested mark lies in the single word that makes up the mark, while both the words "Florian" and "Picasso" make roughly equal contributions to the overall impression of the earlier mark;

d) The marks are visually and aurally similar to a medium degree and conceptually dissimilar; and

e) The earlier mark has a slightly higher than medium degree of inherent distinctiveness which has not been enhanced through use.

46. The opponent submits that the average consumer is likely to purchase the applicant's goods in the mistaken belief that they are the responsibility of the opponent. This submission, in my view, depends on a finding that the word "PICASSO" is the dominant and distinctive element of the earlier mark and I have not made such a finding. In my view, the differences between the marks are such that the marks will not be mistaken one for the other. Both names are unusual in the UK and so I do not consider that "Florian" would be overlooked. I find no likelihood of direct confusion.

47. The opponent also makes submissions on the likelihood of indirect confusion. He argues that the facts of this case align with examples (a) and (c) given by the Appointed Person in *LA Sugar.* In the first of these, the distinctiveness of the common element is so striking that the average consumer would assume that no one but the opponent would be using it in a trade mark at all. It is important to bear in mind that here we are talking about distinctiveness in a trade mark context. At this point, I find it helpful to refer to the decision of the CJEU in *Ruiz-Picasso & Ors v OHIM*, Case C-361/04 P. The court said:

> "29. By the second part of the plea in law, the appellants claim that the Court of First Instance infringed Article 8(1)(b) of Regulation No 40/94 in incorrectly applying the rule according to which the greater the distinctive character, either per se or because of the reputation it possesses on the market, the broader the protection which a mark enjoys (*SABEL*, paragraph 24, *Canon*, paragraph 18, and *Lloyd Schuhfabrik Meyer*, paragraph 20).
>
> 30. In this connection, they note that in determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, an overall assessment must be made 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, in particular, *Lloyd Schuhfabrik Meyer*, paragraph 22).

> 31. According to them, the sign PICASSO, which does not contain any element descriptive of motor vehicles, is highly distinctive per se. In confining itself to considering, in paragraph 61 of the judgment under appeal, the sign PICASSO without relating it to the goods concerned, the Court of First Instance failed to consider the inherent distinctive qualities of that mark, that is its greater or lesser ability to identify those goods as coming from a particular undertaking.
>
> 32. In that regard, it is enough to note that, as the Advocate General correctly observed in point 47 of his Opinion, it is apparent by implication but nevertheless clear from paragraph 57 in conjunction with paragraph 61 of the judgment under appeal that the Court of First Instance did consider, after a factual assessment which may not be reviewed by the Court in the context of an appeal, that the sign PICASSO is devoid of any highly distinctive character per se with respect to motor vehicles.
>
> 33. It follows that the second part of the plea in law must be rejected."

48. Similarly, in this case, there is no evidence that the PICASSO element of the earlier mark has a high distinctive character, such that the average consumer would assume that no other undertaking would use it in a trade mark. I have no evidence before me that the average consumer would understand that the Picasso family have any role in owning or promoting trade marks containing that element.

49. The Appointed Person's third example is logical brand extension. The opponent submits that

> "35. … The inclusion of the word Florian refers to the Opponent's first name as one of the family members of the artist Pablo Picasso. Therefore, it would be an entirely logical brand extension or sub-brand for the Opponent. Consequently, there is a real risk that the average consumer will conclude that the marks are, at the very least, economically linked."

50. The opponent's argument is predicated on the fact of his membership of the family of Pablo Picasso. I have no evidence to indicate that the average consumer is aware

of this, and so it seems to me unlikely that they would assume that it was a logical brand extension, particularly given the low degree of similarity between the goods.

51. I find that there is no likelihood of indirect confusion. The opposition therefore fails.

OUTCOME

52. The opposition has failed. Application No. 3882180 may, subject to a successful appeal, proceed to registration.

COSTS

53. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice No. 1/2023. The award is calculated as follows:

> *£250 for preparing a statement and considering the other side's statement;*
> *£400 for preparing written submissions in lieu of a hearing.*
> ***£650 in total***

54. I therefore order Florian Ruiz-Picasso to pay Picasso Group Co., Ltd the sum of £650. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 19th day of January 2026

Clare Boucher
For the Registrar,
Comptroller-General