

O/0551/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**TRADE MARK REGISTRATIONS NOS. 3794152 & 3794135
IN THE NAME OF ANGELS DARE COCKTAILS LTD
IN RESPECT OF THE FOLLOWING TRADE MARKS:**

(SERIES OF TWO)



IN CLASSES 25, 32 & 33

AND

(SERIES OF TWO)

**Angels Dare Cocktails
Angels Dare Crafted Cocktails**

IN CLASSES 25, 32 & 33

AND

**TWO APPLICATIONS FOR DECLARATIONS OF INVALIDITY
THERE TO UNDER NOS. 505623 & 505624
BY INTERCONTINENTAL BRANDS (ICB) LIMITED**

BACKGROUND & PLEADINGS

- These are consolidated invalidation proceedings between Angels Dare Cocktails Ltd (“**the registered proprietor**”) and Intercontinental Brands (ICB) Limited¹ (“**the cancellation applicant/applicant**”) concerning the following trade mark registrations as shown on the cover page of this decisions:

Trade Mark no.	UK00003794152 ('152)	
Trade Mark (Series of two)		
Goods Registered	<p>Class 25: Clothing; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Leather clothing; Gloves [clothing]; Waterproof clothing; Jackets [clothing]; Belts [clothing]; Windproof clothing; Woolen clothing; Ladies' clothing; Knitwear [clothing]; Casual clothing; Denims [clothing]; Shorts [clothing].</p> <p>Class 32: Cocktails, non-alcoholic; Non-alcoholic cocktails; Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic fruit extracts; Fruit nectars, non-alcoholic; Non-alcoholic fruit cocktails; Fruit extracts (Non-alcoholic -); Non-alcoholic fruit juice beverages; Essences for making non-alcoholic beverages; Non-alcoholic syrups for making beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic essences for making non-alcoholic beverages, not in the nature of essential</p>	

¹ On 6 April 2023, ICB Brands Holdings Limited filed Form TM16 to record a change of ownership. The assignment was duly recorded in the Register and had the effect of assigning the owner of the registered trade mark UK00002412597 from ICB Brands Holdings Limited to Intercontinental Brands (ICB) Limited. I note that the applicant in the submissions is referred to as “ICB”, which is the abbreviated name of the newly identified owner.

	<p>oils; Non-alcoholic fruit extracts used in the preparation of beverages; Fruit juice; Fruit nectars.</p> <p>Class 33: Alcoholic cocktails; Prepared wine cocktails; Prepared alcoholic cocktails; Alcoholic fruit cocktail drinks; Spirits; Spirits [beverages]; Cocktails; Alcoholic cocktail mixes; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic aperitifs; Fruit extracts, alcoholic; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Fruit (Alcoholic beverages containing -); Alcoholic tea-based beverage; Alcoholic coffee-based beverage; Alcoholic carbonated beverages, except beer; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Alcoholic fruit extracts; Alcoholic extracts; Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky.</p>
Relevant Dates	Filing date: 31 May 2022
	Date of entry in register: 30 September 2022

Trade Mark no.	UK00003794135 ('135)
Trade Mark (Series of two)	Angels Dare Cocktails Angels Dare Crafted Cocktails
Goods Registered	<p>Class 25: Clothing; Clothes; Wristbands [clothing]; Tops [clothing]; Knitted clothing; Hoods [clothing]; Leisure clothing; Sports clothing; Waterproof clothing; Knitwear [clothing]; Jerseys [clothing]; Weatherproof clothing; Casual clothing; Denims [clothing]; Cashmere clothing; Women's clothing; Jackets [clothing].</p> <p>Class 32: Non-alcoholic punches; Cordials [non-alcoholic]; Non-alcoholic beverages; Cocktails, non-alcoholic; Non-alcoholic cocktails; Non-alcoholic punch; Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic fruit punch; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic cocktail mixes; Non-alcoholic fruit cocktails; Fruit extracts (Non-</p>

	<p>alcoholic -); Non-alcoholic flavored carbonated beverages; Non-alcoholic beverages containing fruit juices.</p> <p>Class 33: Alcoholic aperitifs; Alcoholic extracts; Alcoholic cocktails; Alcoholic cordials; Alcoholic essences; Cordials [alcoholic beverages]; Alcoholic cocktail mixes; Rum [alcoholic beverage]; Fruit extracts, alcoholic; Alcoholic fruit beverages; Alcoholic beverages of fruit; Alcoholic cocktails containing milk; Alcoholic fruit extracts; Prepared alcoholic cocktails; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Fruit (Alcoholic beverages containing -); Alcoholic fruit cocktail drinks; Alcoholic carbonated beverages, except beer; Prepared wine cocktails; Alcoholic cocktails in the form of chilled gelatins; Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky; Cocktails.</p>
Relevant Dates	Filing date: 31 May 2022
	Date of entry in register: 30 September 2022

2. For ease of reference, I will refer to the series of the contested marks as the proprietor’s “mark ‘152” and “mark ‘135”, unless it becomes necessary to differentiate between the marks which comprise the series.

3. On 12 December 2022, the applicant filed two applications (nos. 505623 and 505624) to have these trade marks declared invalid under the provisions of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”)², which are relevant in invalidation proceedings under Section 47 of the Act. The applications for invalidation concern only the goods in Classes 32 and

² 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.

33 for which the contested marks stand registered.³ The applicant relies upon its UK trade mark registration 2412597 for the word mark:

ANGELS PEACH SCHNAPPS

4. The mark was filed on 25 January 2006 and was registered on 4 August 2006 for "*Peach schnapps*" in Class 33 upon which the applicant relies on for the purposes of these proceedings.

The Applicant's Statement of Grounds

5. In its statement of grounds, regarding the application for invalidation no. 505623, the applicant claims that:

“6. The dominant and distinctive element of both trade marks is the word ANGELS.

7. The marks are visually, phonetically and conceptually similar.

8. The goods of the Registration are similar to the goods covered by the Earlier Registration. The goods of the Registered Owner may be sold through the same trade channels, have the same customer base and are in direct competition with those covered by the Earlier Registration.

9. Given the high similarity of the marks and the similarity of the goods, the Registered Owner's use of the marks which are the subject of the Registration will result in a likelihood of confusion on the part of the public, including a likelihood of association. Customers of the Invalidity Applicant and members of the public will be confused into believing that goods provided by the Registered Owner bearing such

³ The applicant with its submissions in lieu of a hearing amended the scope of the consolidated invalidation actions and requested the proceedings to be directed only against the goods in Classes 32 and 33 of the registered goods.

a similar mark originate from the Invalidity Applicant, or that the Registered Owner is somehow linked to the Invalidity Applicant.

[...]

11. It is submitted that the Registration is contrary to Section 5(2)(b) of the Act. Therefore, the Registration should be declared invalid in its entirety.”

6. The applicant put forward the same claims regarding the application for invalidation no. 505624 using the same wording as reproduced above with the additional assertion that “the mark of the Registration is not a true series and should not have been accepted by the Office. The marks contained within the series differ by more than minor differences.”

The Registered Proprietor’s Defence

7. The proprietor filed notices of defence in each case.
8. In relation to the application for invalidation no. 505623, the proprietor with its counterstatement denied the opponent’s claims in the following terms:

“[...]

5. The Cancellation Applicant's Trade Mark is registered in respect of Class 33, but it seeks to cancel the Trade Mark in its entirety (Class 25, Class 32 and Class 33). It is not figurative. The Cancellation Applicant's Trade Mark is not registered in Classes 25 or 32.

6. The dominant and distinctive element of both trade marks is not the same.

6.1. The Cancellation Applicant states that the dominant and distinctive element of the Cancellation Applicant's Trade Mark is the single word "Angels". The dominant and distinctive element of the Trade Mark consists of the two words "Angels Dare".

6.2. The word "Angels" is not dominant and distinctive. The degree of distinctiveness enjoyed by the Cancellation Applicant's Trade Mark is low. Within Class 33 there are 93 live entries containing the word "Angel" and 41 live entries containing the word "Angels".

7. The marks are visually, phonetically and conceptually distinct.

7.1. Both trade marks include wording that describes the type of drink that the respective trade mark owner produces. The drink types are narrated in unequivocal terms and there is no overlap between the respective trade marks. The Cancellation Applicant's Trade Mark contains the words "Peach Schnapps". The Proprietor's Trade Mark contains the words "Cocktails" (mark 1) and "Crafted Cocktails" (mark 2).

7.2. The terms "Angels" and "Angels Dare" are visually, phonetically and conceptually distinct from each other. The "Dare" element is key to the Proprietor's product and brand, and is a distinct element of the Trade Mark."

Further, in terms of the competing goods, the proprietor claims the following:

"8. The goods of the Trade Mark are not similar to the goods covered by the Cancellation Applicant's Trade Mark. The goods of the Proprietor are not sold through the same trade channels, they do not have the same customer base and they are not in direct competition with those covered by the Cancellation Applicant's Trade Mark.

8.1. The Proprietor's products are not similar to those of the Cancellation Applicant. The Proprietor is a premium, single serve, ready-to-drink canned cocktail range. It is a premium end product that retails at £5.00 - £5.50 per can and comes in a variety of flavours. The Proprietor's target customer base is individuals with high disposable income. The Proprietor is the sole distributor of the product. The product is sold on-line and in

independent boutique retailers, such as farm shops, delis and specialist bottle shops. It is not stocked by supermarkets.

8.2. The Cancellation Applicant's product is a peach flavoured schnapps drink. It is sold in 70cl glass bottles. It is a mass market product. It is sold in supermarkets and has a retail price of around £6. The goods, trade channels, target audience, distribution lines and stockists of the Proprietor are distinct from those of the Cancellation Applicant and they are not in competition.”

9. In relation to the application for invalidation no. 505624, the proprietor with its counterstatement denied the opponent's claims mirroring the same claims as in the preceding paragraphs, which I will not reproduce in this instance. In addition, I note that it responded to the applicant's claim in relation to the series of the marks by stating that “Mark 1 and Mark 2 of the Trade Mark are a true series; the differences between them can be properly categorised as minor.”

Papers Filed and Representation

10. Only the proprietor filed evidence in these proceedings. This comes in the form of a witness statement from Michael David Crozier, who is the director of the proprietor, a position which he has held since 23 February 2021. His witness statement is dated 13 July 2023 and consists of two Exhibits containing screenshots from the registered proprietor's website and a list of retail orders.
11. Only the applicant filed submissions in lieu of a hearing.
12. No hearing was requested and so this decision is taken following a careful perusal of the papers.
13. In these proceedings, the registered proprietor is represented by Emma Forrester of Ennova Law and the applicant by HGF Limited.

DECISION

14. Section 47 of the Act states that:

“[...]

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless –

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

15. The invalidation application is based specifically on Section 5(2)(b) of the Act which states that:

“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.”

16. Under Section 6(1) of the Act, the applicant’s trade mark clearly qualifies as an earlier trade mark. Further, the applicant’s trade mark did complete its registration process more than five years before the filing date of the contested marks, but as the proprietor did not require the applicant to prove use of this mark, the applicant may rely on all the goods listed above. Therefore, my assessment will be based on the notional use of the earlier mark for the goods that it relies upon as registered.
17. The principles, considered in these applications for invalidity, 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 might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods at issue

18. 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 [...], 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.”

19. 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.”

20. 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”.

21. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term ‘computer software’. In the course of his judgment, he set out the following summary of the correct approach to interpreting specifications:

“[...] the applicable principles of interpretation are as follows:

(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.

(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.

(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.

(4) A term which cannot be interpreted is to be disregarded.”

22. 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.”

23. 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.”

Invalidation no. 505623

24. The competing goods to be compared are shown in the following table:

Applicant’s Goods	Registered Proprietor’s Goods
<p>Class 33: Peach schnapps.</p>	<p>Class 32: Cocktails, non-alcoholic; Non-alcoholic cocktails; Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic fruit extracts; Fruit nectars, non-alcoholic; Non-alcoholic fruit cocktails; Fruit extracts (Non-alcoholic -); Non-alcoholic fruit juice beverages; Essences for making non-alcoholic beverages; Non-alcoholic syrups for making beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic essences for making non-alcoholic beverages, not in the nature of essential oils; Non-alcoholic fruit extracts used in the preparation of beverages; Fruit juice; Fruit nectars.</p> <p>Class 33: Alcoholic cocktails; Prepared wine cocktails; Prepared alcoholic cocktails; Alcoholic fruit cocktail drinks; Spirits; Spirits [beverages]; Cocktails; Alcoholic cocktail mixes; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic aperitifs; Fruit extracts, alcoholic; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Fruit (Alcoholic beverages containing -); Alcoholic tea-based beverage; Alcoholic coffee-based beverage; Alcoholic carbonated beverages, except beer; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Alcoholic fruit extracts; Alcoholic extracts; Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky.</p>

25. With its submissions, the applicant provided a detailed comparison between the competing goods which I have taken into account but will not reproduce here.
26. As quoted earlier in this decision, the registered proprietor denied any similarity between the competing goods.
27. In addition, for the avoidance of doubt, pursuant to Section 60A(1) of the Act, goods are not to be regarded as similar or dissimilar simply because they fall in the same or different Class.
28. 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.⁴

Class 32

Cocktails, non-alcoholic; Non-alcoholic cocktails; Non-alcoholic fruit cocktails

29. The contested goods are mixed drinks often made with various ingredients such as juice and/or herbs but do not contain any alcohol, while the applicant's goods, "*peach schnapps*", are a type of alcoholic beverage which is distilled from fermented peaches. Even where non-alcoholic or de-alcoholised schnapps are used as ingredients in preparing non-alcoholic cocktails, the end-products are sold to the customers in a premixed form. Although the goods overlap in nature to a degree, as they are all liquids, I note that there is a difference due to the presence/absence of alcohol. The users and method of use will overlap, as will the channels of trade. There is a degree of competition as one may choose one over the other in a bar or if buying a bottle or a can from an off-licence/supermarket for

⁴ *Separode Trade Mark* BL O-399-10 and *BVBA Management, Training en Consultancy v BeneluxMerkenbureau* [2007] ETMR 35 at paragraphs 30 to 38.

consumption at home. However, they are not complementary in the sense defined in the case law. Considering these factors, I find that the competing goods to be similar to a medium degree.

Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic fruit juice beverages; Non-alcoholic sparkling fruit juice drinks; Fruit juice; Fruit nectars; Fruit nectars, non-alcoholic

30. The goods in question are non-alcoholic and largely fruit beverages, encompassing an array of drinks such as carbonated soda and fresh juices. The contested goods could overlap to a degree in nature with the earlier term “*peach schnapps*” since such goods may come in the same form, namely liquid, and the earlier term is also fruit-flavoured. To that extent, they coincide in the method of use but differ in purpose, as the contested goods are designed to quench thirst or for nutritional purposes, whereas the earlier goods are consumed for the alcoholic effects and taste or for social reasons. Moreover, the users and trade channels will be the same, but I note that the competing goods will be sold, for example, in supermarkets, displayed in different sections, not near each other. I do not consider that there is any degree of competition or complementarity. I find that there is a low degree of similarity.

Essences for making non-alcoholic beverages; Non-alcoholic essences for making non-alcoholic beverages, not in the nature of essential oils; Non-alcoholic fruit extracts used in the preparation of beverages; Fruit extracts (Non-alcoholic -); Non-alcoholic fruit extracts; Non-alcoholic syrups for making beverages

31. The contested terms relate to essences, syrups or fruit extracts where natural or synthetic essential oils have been extracted from plants or fruits for making non-alcoholic beverages. These goods have different nature, purpose and method of use from the earlier goods “*peach schnapps*”. These products are sold in different sections of supermarkets. In addition, they are not complementary as I do not consider them important or

indispensable to each other, and there is no evidence before me to show that the average consumer is likely to think that the ingredients used in preparing the applicant's goods or the alcoholic versions of those ingredients come from the same undertaking. Also, there is no degree of competition, as I consider it to be unlikely that producers of the earlier goods would also be engaged in production of essences or preparations for making non-alcoholic beverages and vice versa. Nevertheless, I consider there is some overlap in users where non-alcoholic preparations are used in conjunction with alcoholic beverages by way of creating a long drink or cocktail or are used as a flavouring mimicking an alcoholic beverage. However, I do not consider that this factor would be sufficient to find any similarity between the competing goods, or if I am wrong on that any similarity is of a very low level.

32. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's goods.⁵ **The invalidation action cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

Class 32: Essences for making non-alcoholic beverages; Non-alcoholic essences for making non-alcoholic beverages, not in the nature of essential oils; Non-alcoholic fruit extracts used in the preparation of beverages; Fruit extracts (Non-alcoholic -); Non-alcoholic fruit extracts; Non-alcoholic syrups for making beverages.

Class 33

Spirits; Spirits [beverages]; Beverages (Alcoholic-), except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Fruit (Alcoholic beverages containing-); Alcoholic carbonated beverages, except beer

⁵ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

33. The contested terms are broad terms that would readily cover the earlier goods. Therefore, I find them to be identical as per *Meric*.

Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky

34. The contested goods are similar to the earlier goods, “*peach schnapps*”. The earlier goods constitute a strong, dry, peach-flavoured spirit. Therefore, the competing goods share the same nature to an extent, as they are all distilled alcoholic drinks usually consumed in short measures. However, I note that the earlier term is a peach-flavoured alcoholic drink, whereas the contested goods are traditionally neutral alcoholic drinks. The goods share the same purpose, method of use, users, and trade channels as they are sold in close proximity to each other. There is a degree of competition as one may choose one over the other in a restaurant or, if buying a bottle from an off-licence/supermarket, for consumption at home. However, they are not complementary in the sense defined in the case law. Overall, I find the competing goods to be similar to a very high degree.

Alcoholic tea-based beverage; Alcoholic coffee-based beverage

35. The contested terms are either tea- or coffee-based alcoholic beverages. Following the same approach in the preceding paragraph, although the contested goods are peach-based goods, the competing goods share the same nature (all being alcoholic drinks), purpose, method of use, users, trade channels, and there is a degree of competition. I find the competing goods similar to a very high degree.

Alcoholic cocktails; Prepared wine cocktails; Prepared alcoholic cocktails; Alcoholic fruit cocktail drinks; Cocktails; Alcoholic cocktail mixes; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic aperitifs; Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages

36. The contested goods are similar in general nature to the opponent's "peach schnapps" to the extent that they are all alcoholic drinks. I note that schnapps could be used as ingredients in preparing (pre-)mixed alcoholic beverages like cocktails. The competing goods share the same nature and general purpose, namely to be consumed for pleasure, and may overlap in users, method of use, and trade channels as they could be sold in the same retail outlets such as supermarkets, off-licences, and bars, and they may be sold next to each other. However, I note that the earlier goods are usually short drinks and are likely to have a higher 'alcohol by volume' content than the contested goods. They are also in competition as one can choose one over the other. Overall, I find them to be similar to between a medium and high degree.

Fruit extracts, alcoholic; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Alcoholic fruit extracts; Alcoholic extracts

37. These goods have different nature, purpose and method of use from the earlier goods "peach schnapps". These products are sold in different sections of supermarkets. In addition, they are not complementary as I do not consider them important or indispensable to each other so that the average consumer would consider that the responsibility for the goods lies with the same undertaking. There is no degree of competition, as I consider it to be unlikely that producers of alcoholic beverages would also be engaged in production of such extracts or preparations for making alcoholic beverages and vice versa. Nevertheless, I consider there is some consumer overlap. Overall, I find that they are dissimilar, or if I am wrong on that any similarity is of a very low level.

38. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's goods.⁶ **The invalidation**

⁶ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

action cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:

Class 33: Fruit extracts, alcoholic; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Alcoholic fruit extracts; Alcoholic extracts.

Invalidation no. 505624

39. The competing goods to be compared are shown in the following table:

Applicant's Goods	Registered Proprietor's Goods
Class 33: Peach schnapps.	<p>Class 32: Non-alcoholic punches; Cordials [non-alcoholic]; Non-alcoholic beverages; Cocktails, non-alcoholic; Non-alcoholic cocktails; Non-alcoholic punch; Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic fruit punch; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic cocktail mixes; Non-alcoholic fruit cocktails; Fruit extracts (Non-alcoholic -); Non-alcoholic flavored carbonated beverages; Non-alcoholic beverages containing fruit juices.</p> <p>Class 33: Alcoholic aperitifs; Alcoholic extracts; Alcoholic cocktails; Alcoholic cordials; Alcoholic essences; Cordials [alcoholic beverages]; Alcoholic cocktail mixes; Rum [alcoholic beverage]; Fruit extracts, alcoholic; Alcoholic fruit beverages; Alcoholic beverages of fruit; Alcoholic cocktails containing milk; Alcoholic fruit extracts; Prepared alcoholic cocktails; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Fruit (Alcoholic beverages containing -); Alcoholic fruit cocktail drinks; Alcoholic carbonated beverages, except beer; Prepared wine cocktails; Alcoholic cocktails in the form of chilled gelatins; Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky; Cocktails.</p>

40. As mentioned in the beginning of this decision, the opponent claims similarity between the contested goods.

41. The applicant denied any similarity between the goods.

Class 32

Non-alcoholic punches; Cordials [non-alcoholic]; Non-alcoholic punch;
Non-alcoholic fruit punch;

42. The contested terms are the non-alcoholic versions of drinks that generally contain fruits/fruit juice or they are fruit-flavoured. Although the contested goods could overlap to a degree in nature with the earlier term “*peach schnapps*” since such goods may come in the same liquid form, I note that there is a difference emanating from the presence/absence of alcohol. The users and method of use will overlap. The competing goods will share channels of trade, and there is a degree of competition as one may choose one over the other. However, the competing goods are not complementary. Considering these factors, I find that the competing goods to be similar to a medium degree.

Cocktails, non-alcoholic; Non-alcoholic cocktails; Non-alcoholic cocktail mixes; Non-alcoholic fruit cocktails

43. I adopt the same finding made at paragraph 29 above.

Fruit beverages (non-alcoholic); Carbonated non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit drinks; Non-alcoholic beverages

44. I adopt the same findings made at paragraphs 30 above.

Non-alcoholic fruit extracts; Fruit extracts (Non-alcoholic -)

45. I adopt the same findings made at paragraphs 31 above.

46. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's goods.⁷ **The invalidation action cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

Class 32: Non-alcoholic fruit extracts; Fruit extracts (Non-alcoholic-).

Class 33

Alcoholic aperitifs; Alcoholic cordials; Cordials [alcoholic beverages]; Alcoholic fruit beverages; Alcoholic beverages of fruit; Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Pre-mixed alcoholic beverages; Fruit (Alcoholic beverages containing -)

47. The contested goods are broad terms that would encapsulate the earlier goods. Therefore, I find them to be identical as per *Meric*.

Vodka; Gin; Rum; Rum punch; Rum-based beverages; Whisky; Malt whisky; Blended whisky; Rum [alcoholic beverage];

48. I adopt the same finding made at paragraph 34 above.

Alcoholic carbonated beverages, except beer

49. I adopt the same finding made at paragraph 35 above.

Alcoholic cocktails; Alcoholic cocktails containing milk; Prepared alcoholic cocktails; Alcoholic fruit cocktail drinks; Prepared wine cocktails; Alcoholic cocktails in the form of chilled gelatins; Cocktails

50. I adopt the same finding made at paragraph 36 above.

⁷ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

Alcoholic extracts; Alcoholic essences; Fruit extracts, alcoholic; Alcoholic fruit extracts; Alcoholic cocktail mixes

51. I adopt the same finding made at paragraph 37 above.
52. The likelihood of confusion does not arise in relation to the contested goods which are dissimilar to the earlier mark's goods.⁸ **The invalidation action cannot succeed against dissimilar goods and, therefore, is dismissed insofar as it concerns the following terms:**

Class 33: Alcoholic extracts; Alcoholic essences; Fruit extracts, alcoholic; Alcoholic fruit extracts; Alcoholic cocktail mixes.

Average Consumer and the Purchasing Act

53. 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.”

⁸ Case C-398/07, *Waterford Wedgwood plc v OHIM*; and *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, para 49.

54. The average consumers of the goods at issue are members of the general public. Insofar as the goods are alcoholic, this will be limited to individuals over the age of 18. Non-alcoholic beverages are likely to be purchased frequently for the purpose of refreshment and enjoyment, whilst those containing alcohol will be purchased relatively frequently for enjoyment and socialising. All of the goods may be sold through a range of channels. They may be purchased in retail premises, such as supermarkets and off-licence stores, online or by 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. Similarly, for the online stores, the consumers will select the goods relying on the images displayed on the relevant web pages. They may also be sold through bars, clubs, restaurants and public houses, where the goods are displayed on, for example, shelves behind the bar, and may be requested orally from a member of staff. In this regard, I bear in mind the Case T-3/04, *Simonds Farsons Cisk Plc v OHIM*, where the Court of First Instance (now the General Court) stated that:

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

Consequently, even if these goods can be ordered orally in the premises exemplified above, a visual inspection of the bottles containing the goods is most likely to occur. Although these goods are not particularly costly, the average consumer may examine the product to ensure that they select the correct type of beverage while considering factors such as taste, cost,

nutritional content, and (in the case of alcoholic beverages) the alcohol content. However, taking all of the above into account, I find that the level of attention of the general public would be between low and medium.

Comparison of Trade Marks

55. 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.”

56. 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.

57. The marks to be compared are:

Applicant's Mark
ANGELS PEACH SCHNAPPS
Registered Proprietor's Marks
<u>'152 Mark (Series of two)</u> 
<u>'135 Mark (Series of two)</u> Angels Dare Cocktails Angels Dare Crafted Cocktails

Invalidation no. 505623

Overall Impression

58. The applicant's mark consists of the words "ANGELS PEACH SCHNAPPS" presented in upper case and standard typeface. Registration of a word mark protects the words themselves.⁹ The greatest weight in the overall impression will reside in the word "ANGELS", which is also the dominant element in the mark, while the words "PEACH SCHNAPPS" will be seen as descriptive of the goods, having a less significant weight in the overall impression.

⁹ See *LA Superquimica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

59. The proprietor's mark '152 is a composite mark and series of two. It consists of both word and figurative elements in two versions, one with black font on a white background and the other with white font on a black background. At the top of the mark, there is a prominent device resembling a pair of upside-down wings. Underneath it, there are the word elements "angels dare", with the former word placed above the latter, both presented in bold and lowercase font and slightly stylised typeface, with a halo device positioned above the letter 'a' in "angels" and a pointy tail device incorporated into the letter 'a' in the word "dare". By comparison, the strapline "CRAFTED COCKTAILS" is the smallest element in the mark, which appears at the bottom in uppercase, standard typeface, and a slightly curved format. The word elements "angels dare" and the pair of wings device make a roughly equal contribution to the overall impression. While the pair of wings device is slightly larger in size, I find, in accordance with settled case law,¹⁰ that the word elements "angels dare" will have more impact as the relevant public is more likely to keep verbal elements in mind to identify and quote the mark instead of describing its figurative element. The strapline "CRAFTED COCKTAILS" will be descriptive of the goods under the mark, thereby having a less significant weight in the overall impression. Lastly, the halo and the pointy tail devices, due to their small size, will have some but even less relative weight in the overall impression of the mark.

Visual comparison

60. Visually, the competing marks share the common word element "Angels/ANGELS". There are, though, various visual differences between the marks. In particular, there is no counterpart of the word elements "dare", "CRAFTED COCKTAILS" and "PEACH SCHNAPPS" in the competing marks. Another point of visual difference is the presence/absence of the figurative elements, i.e. the prominent pair of wings, halo, and pointy tail, in the competing marks. Taking into account

¹⁰ See for instance: *MigrosGenossenschafts-Bund v EUIPO*, T-68/17; and *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37.

the above factors, including the overall impression of the competing marks, I find that the marks are visually similar to a low degree.

Aural comparison

61. The applicant's mark consists of four syllables and will be articulated as "AYN-JUHLS PEECH SHNAPS". The proprietor's composite mark contains verbal elements, which will be pronounced as "AYN-JUHLS DAIR", and the strapline "KRAFF-TID KOCK-TAYLZ". Thus, the competing marks share the common verbal element "AYN-JUHLS". However, there are no phonetic counterparts for the word elements "DAIR", "KRAFF-TID KOCK-TAYLZ" and "PEECH SHNAPS" in the competing marks. Further, I do not consider that the average consumer will attempt to articulate the figurative elements of the proprietor's mark. I find that there is a between low to medium degree of aural similarity.

Conceptual comparison

62. The applicant submits that:

"28. There is conceptual similarity as both marks convey the concept of angels (spiritual beings being believed to act as attendants or messengers of God; a person of exemplary conduct or virtue)."

63. The applicant's mark contains the word "ANGELS" which is a well-known dictionary word that the average consumer will understand immediately, conveying the concept of the non-physical, spiritual being attending upon a deity/divine entity. The terms "PEACH SCHNAPPS" are descriptive of the goods and will be understood as such by the average consumer.
64. The verbal elements "angels dare" in the proprietor's mark are dictionary words that the average consumer in the UK will readily understand and perceive as a unit, with the former word qualifying the latter. The verbal element "angels" carries the same meaning described in the previous

paragraph, and the word “dare” will be construed as to be brave or bold enough to do something. These words together will form a unit and will be conceptualised as an encouraging statement promoting boldness. In addition, the average consumer will perceive the strapline “CRAFTED COCKTAILS” as being descriptive of the goods. Further, whilst the concepts of the wings, halo, and pointy tail devices in the contested mark will introduce additional concepts that are not present in the earlier mark, I note that the wings and halo devices will reinforce the concept of the word element “angels”.

65. The competing marks overlap in the concept stemming from the common word ‘angels’. However, they are conceptually different insofar as the contested mark also conveys the meaning associated with the phrase “angels dare”. In addition, they differ in the absence/presence of the figurative elements, and the word elements “PEACH SCHNAPPS” and “CRAFTED COCKTAILS”, which have a descriptive quality. Taking into account all the above, including the overall impressions, I find that the degree of conceptual similarity falls between low and medium.

Invalidation no. 505624

Overall Impression

66. I adopt the same finding at paragraph 58 above, namely the word “ANGELS” will have the greatest weight in the overall impression, while the words “PEACH SCHNAPPS” will be seen as descriptive of the goods, having a less significant weight.
67. The registered proprietor’s mark ‘135 is a series of two which consists of the words “Angels Dare Cocktails” and “Angels Dare Crafted Cocktails” capitalised and in standard typeface. These marks have been accepted and published as a series of two marks, pursuant to Section 41(2) of the Act which states that:

“A series of trade marks means a number of trade marks which resemble each other as to their material particulars and differ only as to matters of a nondistinctive character not substantially affecting the identity of the trade mark.”

However, in its statement of grounds, the applicant argues that the registration is not a true series, claiming that the differences between the marks are more than minor. I note that the addition of the term “Crafted” in the second mark of the series is considered non-distinctive and does not affect the overall identity of the mark. Therefore, in the context of Section 41(2), the marks comprise a series, and the applicant’s claim is unfounded and has no merit. Further, I note that the registration of word marks protects the words themselves.¹¹ The greatest weight in the overall impression will reside in the words “Angels Dare”, while the words “Cocktails” and “Crafted Cocktails” are likely to be seen as descriptive by the average consumer, having a less significant weight in the overall impression.

Visual comparison

68. The series of the contested mark consists of three, “Angels Dare Cocktails”, and four words “Angels Dare Crafted Cocktails”, respectively. The earlier mark is a three-worded mark, “ANGELS PEACH SCHNAPPS”. Bearing in mind, as a rule of thumb, that the beginnings of words tend to have more impact than the ends,¹² the competing word marks share only the first common word element “Angels”, differing in the subsequent word elements. More specifically, the marks differ in the word elements “Dare”, “PEACH SCHNAPPS” and “Cocktails/Crafted Cocktails”. Considering all the factors, including the overall impression of the marks, I find them to be visually similar to a below medium degree.

¹¹ See *LA Superquímica v EUIPO*, T-24/17, para 39; and *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17, paragraph 16.

¹² See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Aural comparison

69. As shown above in this decision, the earlier mark is four syllables long and will be pronounced as “AYN-JUHLS PEECH SHNAPS”. In this instance, the first mark in the series of the contested mark consists of five syllables, “AYN-JUHLS DAIR KOCK-TAYLZ”, and the second mark of six syllables, “AYN-JUHLS DAIR KRAFF-TID KOCK-TAYLZ”. The first word element, “AYN-JUHLS”, in the proprietor’s mark will be identically pronounced as in the applicant’s mark. However, the presence/absence of the word elements, “DAIR”, “PEECH SHNAPS”, “KOCK-TAYLZ/KRAFF-TID KOCK-TAYLZ” introduce phonetic differences. Therefore, I find that they are aurally similar to a below medium degree.

Conceptual comparison

70. I adopt the same findings made at paragraphs 63-65 regarding the conceptualisation of the word elements relevant to the competing marks in this instance.

71. The competing marks share the same concept stemming from the common word element “Angels”, whereas the rest of the word elements “Dare”, “PEACH SCHNAPPS” and “Cocktails/Crafted Cocktails” introduce points of conceptual difference. Taking into account the overall impressions, and despite these differences, I find the competing marks to be conceptually similar no more than a medium degree.

DISTINCTIVE CHARACTER OF THE EARLIER TRADE MARK

72. 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).”

73. 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.
74. The applicant has not shown use of its mark and thus cannot benefit from any enhanced distinctiveness. In this respect, I have only the inherent distinctiveness of the applicant’s mark to consider. The applicant’s mark consists of the ordinary and dictionary words “ANGELS PEACH SCHNAPPS” with the meaning identified earlier in this decision. As explained earlier in this decision, the word element “ANGELS” will be more distinctive as the remaining word elements “PEACH SCHNAPPS” have descriptive significance in relation to the goods for which the mark is

registered. I consider that the mark as a whole is inherently distinctive to a medium degree.

LIKELIHOOD OF CONFUSION

75. 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.¹³ 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 make direct comparisons between trade marks and must instead rely upon imperfect recollection.¹⁴
76. 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 differences between the marks but concludes that the later mark is another brand of the owner of the earlier mark or a related undertaking.
77. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Iain Purvis K.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

¹³ See *Canon Kabushiki Kaisha*, paragraph 17.

¹⁴ See *Lloyd Schuhfabrik Meyer*, paragraph 27.

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.”

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).”

These examples are not exhaustive. Rather, they were intended to be illustrative of the general approach.¹⁵

¹⁵ See *Liverpool Gin Distillery and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207.

78. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, on the court's earlier judgment in *Medion v Thomson*. He stated:

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

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

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).”

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

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

80. 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.”

81. Earlier in this decision I have concluded that:

- the goods at issue range from identical to dissimilar;

- the average consumer is a member of the general public. The level of attention paid will be between low and medium. The selection process is predominantly visual without discounting aural considerations;
- the proprietor's mark '152 and the applicant's mark: the degree of visual similarity is low, the aurally similarity between a low to medium degree, and the degree of conceptual similarity falls somewhere between low and medium;
- the proprietor's mark '135 and the applicant's mark: they are visually and aurally similar to a below medium degree, and conceptually similar to no more than a medium degree;
- the earlier mark is inherently distinctive to a medium degree.

Registered mark '152

82. Taking into account the above factors, I am persuaded that there is no likelihood of direct confusion even for identical goods. Notwithstanding the principle of imperfect recollection, the average consumer would not overlook the presence/absence of the prominent wings device and potentially the additional word element "dare" by virtue of their position and size in the proprietor's mark. Therefore, the average consumer will not mistakenly recall or misremember the competing marks as each other.

83. Even if the average consumer recalls the points of similarity between the marks, such as that they contain the word "angels", I still consider the marks would not be indirectly confused. Sitting as the Appointed Person in *Eden Chocolat*,¹⁶ James Mellor KC stated:

"81.4 [...] I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁷ in more formal

¹⁶ Case BL O/547/17 *Duebros Limited v Heirler Cenovis GmbH* (27 October 2017).

¹⁷ In *L.A. Sugar*.

terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (Emphasis added)

84. In accordance with the rationale above, the words of the contested mark “angels dare” hang together to form a cohesive whole. The overall impression lies within the unit of these words and the common element in the contested mark does not retain an independent distinctive role. In this regard, the average consumer will not consider the respective marks as variants or sub-brands of each other nor that the goods in question are from the same or economically linked undertakings. Even accounting for the independency principle and factoring imperfect recollection the inclusion of the word element “angels” together with a wholly different word, namely “dare”, will be sufficient to counteract the similarities between the competing marks. Furthermore, if the opponent’s mark is brought to mind, this will be a mere association, not confusion.¹⁸ I also consider that the addition of the word “dare” does not represent an obvious brand extension or sub-brand. I, therefore, find there is no likelihood of indirect confusion between the competing marks. This finding extends to the goods that I found to be similar to any degree.

Registered mark ‘135

85. Weighing up all the factors, I am satisfied that there is no likelihood of direct confusion for identical goods. Similarly, in this case, there are sufficient differences between the marks to guard against the average consumer mistaking one mark for the other, even where the goods are identical. I find that there is no likelihood of direct confusion.

86. Turning to indirect confusion, despite the use of the shared word element “Angels”, appearing at the beginnings of the competing marks, I do not

¹⁸ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81

consider there is a likelihood of indirect confusion. This is because the contested mark will be perceived as a unit, and the word “Angels” qualifying the word “Dare”, in combination having a different meaning and context to the word “angels” on its own.¹⁹ It is my view that there is nothing logical about ‘extending’ the earlier mark to become the contested mark. The latter has its own distinct meaning, which is not consistent with it being a sub-brand, brand extension or a variant. Thus, I find that the guidance given in *Duebros* applies to this case, namely that an average consumer may merely associate the common word element in the marks but would not confuse them. Consequently, I find that there is no likelihood of indirect confusion. This finding extends to the goods that I found to be similar to any degree.

OUTCOME

87. Both of the applications for invalidation have been unsuccessful. **The registered trade marks will remain registered, subject to an appeal against this decision.**

COSTS

88. The registered proprietor has been successful and is entitled to a contribution towards its costs.
89. As mentioned earlier in this decision, the registered proprietor is represented in these proceedings. However, I note that a costs pro-forma was submitted in error since this is only applicable to unrepresented parties. The costs award for represented parties is determined based upon the scale published in Tribunal Practice Notice 2/2016. Therefore, I will award costs on the scale, and the sum is calculated as follows:

¹⁹ See *Eden Chocolat* above.

Considering the other side's statements and preparing counterstatements	£500
Preparing evidence and considering the applicant's submissions	£500
Total	£1,000

90. I, therefore, order Intercontinental Brands (ICB) Limited to pay Angels Dare Cocktails Ltd the sum of £1,000. 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 14th day of June 2024

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