

O/0664/24

**TRADE MARKS ACT 1994
IN THE MATTER OF
APPLICATION NO. 3863312
IN THE NAME OF NICHOLAS PRINSE
TO REGISTER**

Prinse

AS A TRADE MARK IN CLASSES 14,18,25,33

AND

OPPOSITION THERETO (UNDER NO. 440215)

BY

GEISTREICH ALPINSPIRITS GMBH

Background and pleadings

1. On 29 December 2022, Nicholas Prinse (“***the Applicant***”) applied to register in the UK the trade mark shown on the cover page of this decision, under number UK00003863312 (“***the Contested Mark***”). Details of the application were published for opposition purposes on 13 January 2023. Registration is sought for the following goods:

Class 14 Jewellery; Necklaces [jewellery]; Brooches [jewellery]; Jewellery brooches; Jewellery, including imitation jewellery and plastic jewellery; Pendants [jewellery]; Bracelets [jewellery]; Brooches [jewellery, jewelry (Am.)]; Ornaments [jewellery]; Amulets being jewellery; Amulets [jewellery]; Pearls [jewellery]; Trinkets [jewellery]; Necklaces [jewellery, jewelry (Am.)]; Fashion jewellery; Jewelry; Gold jewellery; Locketts [jewellery]; Jade [jewellery]; Brooches being jewelry; Brooches [jewelry]; Jewelry brooches; Clasps for jewellery; Charms [jewellery]; Charms for jewellery; Jewellery charms; Enamelled jewellery; Costume jewellery; Items of jewellery; Jewellery items; Ornaments [jewellery, jewelry (Am.)]; Pearls [jewellery, jewelry (Am.)]; Decorative brooches [jewellery]; Rings being jewellery; Rings [jewellery]; Trinkets [jewellery, jewelry (Am.)]; Amulets [jewellery, jewelry (Am.)]; Pewter jewellery; Bracelets [jewellery, jewelry (Am.)]; Jewellery stones; Cloisonné jewellery [jewelry (Am.)]; Cloisonné jewellery; Wristlets [jewellery]; Cloisonne jewellery; Charms [jewellery, jewelry (Am.)]; Locketts [jewellery, jewelry (Am.)]; Chains [jewellery, jewelry (Am.)]; Rings [jewellery, jewelry (Am.)]; Jewellery products; Ivory [jewellery, jewelry (Am.)]; Shoe jewellery; Crucifixes as jewellery; Precious jewellery; Necklaces [jewelry]; Agate as jewellery; Pins [jewellery, jewelry (Am.)]; Jewellery chains; Chains [jewellery]; Ivory jewellery; Jewellery chain; Jewellery caskets; Jewellery in semi-precious metals; Medallions [jewellery, jewelry (Am.)]; Gold plated brooches [jewellery]; Paste jewellery [costume jewelry (Am.)]; Paste jewellery [costume jewelry [Am.]]; Pins [jewellery]; Pins being jewellery; Amber pendants being jewellery; Jewellery boxes; Jewellery for personal adornment; Pendants [jewelry]; Imitation jewellery; Cabochons for making jewellery; Jewellery chain of precious metal for necklaces; Body

jewellery; Amberoid pendants being jewellery; Paste jewelry [costume jewelry]; Jewelry (Paste -) [costume jewelry]; Beads for making jewellery; Gold thread [jewellery, jewelry (Am.)]; Personal jewellery; Jewellery in non-precious metals; Fake jewellery; Jewellery incorporating diamonds; Silver thread [jewellery, jewelry (Am.)]; Plastic costume jewellery; Imitation jewellery ornaments; Hat jewellery; Clips of silver [jewellery]; Facial jewellery; Jewellery findings; Crosses [jewellery]; Sterling silver jewellery; Jewellery in the form of beads; Paste jewellery; Jewellery (Paste -); Bracelets [jewelry]; Jewellery incorporating pearls; Amulets [jewelry]; Pearls [jewelry]; Articles of jewellery; Jewellery articles; Diamond jewelry; Jewellery made from gold; Jewellery chain of precious metal for anklets; Wire of precious metal [jewellery, jewelry (Am.)]; Jewellery made from silver; Dress ornaments in the nature of jewellery; Clasps for jewelry; Jewellery chain of precious metal for bracelets; Jewellery of precious metals; Jewellery in precious metals; Jewelry stickpins; Locketts [jewelry]; Jewellery containing gold; Trinkets [jewelry]; Threads of precious metal [jewellery, jewelry (Am.)]; Artificial jewellery; Decorative pins [jewellery]; Jewellery for personal wear; Jewellery fashioned from non-precious metals; Jewellery cases; Body costume jewellery; Jewellery rope chain for necklaces; Charms [jewelry]; Charms for jewelry; Jewelry charms; Jewellery fashioned of semi-precious stones; Jewelry hatpins.

Class 18 Leather; Leather and imitation leather; Leather and imitations of leather; Leather cloth; Tanned leather; Saddlery of leather; Polyurethane leather; Leather handbags; Laces (Leather -); Leather laces; Synthetic leather; Leather for shoes; Leather thongs; Leather straps; Straps (Leather -); Leather briefcases; Leather purses; Boxes of leather or leather board; Leather for furniture; Leather bags; Leather wallets; Vegan leather; Imitation leather; Leather (Imitation -); Studs of leather; Straps of leather [saddlery]; Pouches of leather; Leather pouches; Leather cord; Moleskin [imitation of leather]; Moleskin [imitation leather]; Leather cords; Girths of leather; Leashes (Leather -); Leather leashes; Imitations of leather; Leather for harnesses; Leather suitcases; Imitation leather bags;

Unworked leather; Bands of leather; Briefcases [leather goods]; All-purpose leather straps; Handbags made of leather; Leather boxes; Boxes of leather; Briefcases made of leather; Leather twist; Leather cases; Leather luggage straps; Trimmings of leather for furniture; Furniture (Leather trimmings for -); Leather trimmings for furniture; Thread (Leather -); Leather thread; Labels of leather; Belts (Leather shoulder -); Leather shoulder belts; Key-cases of leather and skins; Valves of leather; Straps made of imitation leather; Furniture coverings of leather; Coverings (Furniture -) of leather; Bags made of leather; Leather shoulder straps; Straps (Leather shoulder -); Leather bags and wallets; Harness made from leather; Bags made of imitation leather; Cases of imitation leather; Chin straps, of leather.

Class 25 Clothing; Knitwear [clothing]; Jackets [clothing]; Ready-to-wear clothing; Woolen clothing; Furs [clothing]; Clothing layettes; Layettes [clothing]; Garments for protecting clothing; Linen clothing; Headbands for clothing; Headbands [clothing]; Clothes; Gloves as clothing; Gloves [clothing]; Aprons [clothing]; Maternity clothing; Kerchiefs [clothing]; Jerseys [clothing]; Shorts [clothing]; Denims [clothing]; Cashmere clothing; Capes (clothing); Oilskins [clothing]; Gabardines [clothing]; Silk clothing; Clothing of leather; Leather clothing; Leather (Clothing of -); Parts of clothing, footwear and headgear; Collars [clothing]; Veils [clothing]; Knitted clothing; Corsets [clothing, foundation garments]; Embroidered clothing; Hoods [clothing]; Windproof clothing; Wristbands [clothing]; Belts for clothing; Belts [clothing]; Casual clothing; Rainproof clothing; Bandeaux [clothing]; Waterproof clothing; Jackets being sports clothing; Visors [clothing]; Jackets (Stuff -) [clothing]; Stuff jackets [clothing]; Clothing for leisure wear; Ready-made clothing; Bottoms [clothing]; Latex clothing; Trunks being clothing; Playsuits [clothing]; Woven clothing; Infant clothing; Drawers [clothing]; Drawers as clothing; Clothing for sports; Sports clothing; Leisure clothing; Athletic clothing; Ties [clothing]; Clothing for children; Muffs [clothing]; Bodies [clothing]; Clothing for infants; Clothing for babies; Tops [clothing]; Weatherproof clothing; Clothing for cycling; Water-resistant clothing; Fabric belts

[clothing]; Pockets for clothing; Handwarmers [clothing]; Clothing for skiing; Beach clothing; Triathlon clothing; Chaps (clothing); Thermal clothing; Cowls [clothing]; Fishing clothing; Men's clothing; Dance clothing; Mitts [clothing]; Braces for clothing; Plush clothing.

Class 33 Rice alcohol; Alcohol (Rice -); Rum [alcoholic beverage]; Aperitifs with a distilled alcoholic liquor base; Pre-mixed alcoholic beverages; Sugarcane-based alcoholic beverages; Alcoholic energy drinks; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Low alcoholic drinks; Pre-mixed alcoholic beverages, other than beer-based; Grain-based distilled alcoholic beverages; Alcoholic cocktails; Alcoholic fruit beverages; Alcoholic beverages of fruit; Cordials [alcoholic beverages]; Alcoholic carbonated beverages, except beer; Alcoholic wines; Alcoholic fruit cocktail drinks; Baijiu [Chinese distilled alcoholic beverage]; Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic cocktails containing milk; Fruit (Alcoholic beverages containing -); Alcoholic beverages containing fruit; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic bitters; Nira [sugarcane-based alcoholic beverage]; Alcoholic tea-based beverage; Ginseng liquor; Alcoholic aperitifs; Alcoholic punches; Alcoholic essences; Alcoholic cocktail mixes; Prepared alcoholic cocktails; Alcoholic aperitif bitters; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Distilled beverages; Beverages (Distilled -); Alcoholic extracts; Wine-based beverages; Beverages containing wine [spritzers]; Vodka.

2. On 13 April 2023, Geistreich Alpinspirits GmbH (“**the Opponent**”) opposed the application under section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”). The Opponent relies upon the prior trade mark registrations set out in the Annex to this decision (“**the Earlier Marks**”). The opposition is directed against class 33 of the application only.
3. For the purposes of the opposition, the Opponent relies upon some of the goods for which the Earlier Marks are registered as indicated in the Annex.

4. By virtue of their respective earlier filing dates, the prior registrations set out in the Annex constitute earlier marks within the meaning of section 6 of the Act.
5. The Earlier Mark 2 is a comparable mark (EU)¹ and completed its registration process over five years prior to the filing date of the applicant's mark. As such, it is subject to the proof of use requirements specified within section 6A of the Act.
6. The Earlier Mark 1 was registered on 6 September 2019 and, as such, it had not completed its registration process more than five years before the filing date of the application in issue. Thus, it is not subject to proof of use pursuant to section 6A of the Act. The Opponent can, therefore, rely upon all of the goods it has identified without having to demonstrate use.
7. In its notice of opposition, the opponent made statements of use in relation to Mark 2 and given that the Applicant requested proof of use such marks, it is subject to the proof of use requirements.
8. In its statement of grounds, the Opponent contends that there is a high degree of visual, phonetic, and conceptual similarity between the marks. The Opponent submits that due to the similarity between the Contested and Earlier Marks and the identity or similarity of the goods, there exists a likelihood of confusion on the part of the public, and that the contested application should be refused, in class 33, under S. 5(2)(b) of the Act.
9. Nicholas Prinse filed a counterstatement, denying the grounds of opposition and submitting that there are visual and phonetic differences between the competing marks. Specifically, the Applicant argues that 'Prinse' is his last name and differs from 'PRINZ' being the former of Dutch origin and the latter German. The Applicant also contends that 'Prinse' is pronounced with a "UH" vowel at the end.

Relevance of EU law

¹ Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

10. 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.

Evidence and submissions

11. During the evidence rounds the Opponent filed evidence² and written submissions³ and the Applicant filed written submissions (albeit in the form of witness statement⁴). These will not be summarised here but will be referred to as and where appropriate during this decision. Neither party requested a hearing, but the Opponent filed submissions in lieu⁵. This decision is taken following a careful perusal of the papers.

Approach

12. The Opponent relies upon two earlier registrations in the notice of opposition. Both earlier registrations are, respectively, identical to each other and each mark covers essentially the same specification. For the purposes of this opposition, if the opponent cannot succeed on the basis of its earlier mark number WO0000001451656, it is clearly in no better position based upon the other earlier mark UK00902111961 (due to the additional requirement to show evidence of genuine use for the goods relied upon in this opposition for the latter mark). I proceed accordingly.

Decision

The law

13. The relevant parts of section 5 of the Act are as follows:

“5(1) ...

² Witness statement of Robert Weiss and Exhibits RW1 to RW3 dated 18 August 2023 and witness statement of Alasdair Maciver and Exhibit AM1 dated 18 August 2023.

³ Dated 17 August 2023.

⁴ Witness statement of Nicholas Prinse dated 29 September 2023.

⁵ Dated 11 December 2023.

(2) A trade mark shall not be registered if because—

(a) ...

(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.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Case law

14. The leading authorities which guide me are from the CJEU: *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The Principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 goods

15. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

16. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

17. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. 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 fur 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”.

18. The competing goods are as follows:

Opponent’s goods	Applicant’s goods
<u>Class 33</u> (03287848)	<u>Class 33</u>

<p>Alcoholic beverages (except beers); alcoholic essences, alcoholic extracts; alcoholic fruit extracts; cider, perry; wine; spirits; distilled beverages, schnapps, kirsch, liqueurs, bitters, strong liqueurs (schnapps), whisky.</p>	<p>Rice alcohol; Alcohol (Rice -); Rum [alcoholic beverage]; Aperitifs with a distilled alcoholic liquor base; Pre-mixed alcoholic beverages; Sugarcane-based alcoholic beverages; Alcoholic energy drinks; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Low alcoholic drinks; Pre-mixed alcoholic beverages, other than beer-based; Grain-based distilled alcoholic beverages; Alcoholic cocktails; Alcoholic fruit beverages; Alcoholic beverages of fruit; Cordials [alcoholic beverages]; Alcoholic carbonated beverages, except beer; Alcoholic wines; Alcoholic fruit cocktail drinks; Baijiu [Chinese distilled alcoholic beverage]; Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic cocktails containing milk; Fruit (Alcoholic beverages containing -); Alcoholic beverages containing fruit; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic bitters; Nira [sugarcane-based alcoholic beverage]; Alcoholic tea-based beverage; Ginseng liquor; Alcoholic aperitifs; Alcoholic punches; Alcoholic essences; Alcoholic cocktail mixes; Prepared alcoholic cocktails; Alcoholic aperitif bitters; Alcoholic preparations for making beverages; Preparations for making alcoholic beverages; Distilled</p>
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	beverages; Beverages (Distilled -); Alcoholic extracts; Wine-based beverages; Beverages containing wine [spritzers]; Vodka.
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- *'Rice alcohol; Alcohol (Rice -); Aperitifs with a distilled alcoholic liquor base; Pre-mixed alcoholic beverages; Sugarcane-based alcoholic beverages; Alcoholic energy drinks; Beverages (Alcoholic -), except beer; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Low alcoholic drinks; Pre-mixed alcoholic beverages, other than beer-based; Grain-based distilled alcoholic beverages; Alcoholic cocktails; Alcoholic carbonated beverages, except beer; Baijiu [Chinese distilled alcoholic beverage]; Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic cocktails containing milk; Nira [sugarcane-based alcoholic beverage]; Alcoholic tea-based beverage; Alcoholic aperitifs; Alcoholic punches; Alcoholic cocktail mixes; Prepared alcoholic cocktails; Cordials [alcoholic beverages]; Alcoholic coffee-based beverage; Alcoholic cordials'*

19. The above terms fall within the wider scope of the Opponent's "Alcoholic beverages (except beers)". Thus, these goods are identical in line with *Meric*.

- *'Rum [alcoholic beverage]; Vodka'*

20. It is my view that the above goods fall within the wider category of the Opponent's "spirits". Thus, I find these goods to be identical in line with *Meric*.

- *'Alcoholic fruit beverages; Alcoholic beverages of fruit; Alcoholic fruit cocktail drinks; Fruit (Alcoholic beverages containing -); Alcoholic beverages containing fruit'*

21. Although worded differently, the above terms are self-evidently identical to the opponent's "alcoholic fruit extracts".

- *'Distilled beverages; Beverages (Distilled -)'*

22. The terms above are self-evidently identical to the Opponent's "distilled beverages".

- *'Alcoholic wines; Wine-based beverages; Beverages containing wine [spritzers]'*

23. The Applicant's terms above fall within the wider category of the Opponent's "Alcoholic beverages (except beer)". Thus, these goods are identical in line with *Meric*.

- *'Alcoholic bitters; Alcoholic aperitif bitters'*

24. The above terms are synonymous with the Opponent's "bitters" and thus I find them to be identical.

- ‘*Ginseng liquor*’

25. The Applicant’s term above falls within the wider scope of the Opponent’s “*liqueurs*”. Thus, these goods are identical in line with *Meric*

- ‘*Alcoholic essences*’

26. The term above is self-evidently identical to the Opponent’s “*alcoholic essences*”.

- ‘*Alcoholic preparations for making beverages; Preparations for making alcoholic beverages*’

27. The terms above fall within the wider scope of the Opponent’s “*alcoholic essences*”. Thus, these goods are identical in line with *Meric*.

- ‘*Alcoholic extracts*’

28. The term above is self-evidently identical to the Opponent’s “*alcoholic extracts*”.

The average consumer and the nature of the purchasing act

29. It is necessary to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

30. The average consumer of the category of products concerned is deemed to be reasonably well-informed and reasonably observant and circumspect (see, to that effect, Case C-210/96, *Gut Springenheide and Tusky* [1998] ECR I-4657, paragraph 31).

31. 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 in question.⁶
32. The average consumer for the goods in Class 33 (alcoholic beverages) will be a member of the general public, who is over the age of 18. The goods are items purchased fairly frequently, with consumers likely to consider factors such as flavour and alcohol by volume. All things considered, the average consumer is likely to apply a medium (or average) degree of attention to their purchase.
33. The goods are likely to be self-selected from the shelves of a retail outlet, or website equivalent. Alternatively, they may be purchased following perusal of a drinks list at a restaurant or bottles behind a bar. Consequently, visual considerations are likely to dominate the selection process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and orders may be placed verbally.

Comparison of trade marks

34. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.
35. 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”.

⁶ *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel BV*, (Case C-342/97, para 26).

36. 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 trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

37. The trade marks to be compared are as follows:

Earlier trade marks	Contested trade mark
PRINZ	Prinse

Overall impression

38. The overall impression of each mark resides in the single word of which each is composed.

Visual similarity

39. The Earlier Mark 'PRINZ' is composed of five letters and the Applicant's Mark is six letters long. The first four letters of the Applicant's Mark are identical in sequence to the Opponent's Mark and differ in their endings (respectively '-Z' and '-SE'). UK consumers read from left to right.

40. In the instant case, the visual difference created by the letter 'S' in place of the letter 'Z' and the additional letter 'E' in the Applicant's mark are tempered by the fact that all the other letters composing the two marks are identical.

41. The respective marks are in standard characters with 'PRINZ' all in capital letters.

42. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the GC noted that the beginnings of words tend to have more visual and aural impact than the ends and I find that to be the case here. The court stated:

"81. It is clear that visually the similarities between the word marks MUNDICOLOR and the mark applied for, MUNDICOR, are very pronounced. As was pointed out by the Board of Appeal, the only visual difference between the signs is in the additional letters 'lo' which characterise the earlier marks and

which are, however, preceded in those marks by six letters placed in the same position as in the mark MUNDICOR and followed by the letter 'r', which is also the final letter of the mark applied for. Given that, as the Opposition Division and the Board of Appeal rightly held, the consumer normally attaches more importance to the first part of words, the presence of the same root 'mundico' in the opposing signs gives rise to a strong visual similarity, which is, moreover, reinforced by the presence of the letter 'r' at the end of the two signs. Given those similarities, the applicant's argument based on the difference in length of the opposing signs is insufficient to dispel the existence of a strong visual similarity.

82. As regards aural characteristics, it should be noted first that all eight letters of the mark MUNDICOR are included in the MUNDICOLOR marks.

83. Second, the first two syllables of the opposing signs forming the prefix 'mundi' are the same. In that respect, it should again be emphasised that the attention of the consumer is usually directed to the beginning of the word. Those features make the sound very similar.⁷

43. Overall, I consider that there is an above-medium degree of visual similarity between the marks.

Aural similarity

44. The respective marks both comprise of one-syllable words.

45. In its defence and counterstatement, the Applicant submits that 'Prinse' is pronounced with a "UH" vowel at the end.⁸ The Opponent contends that "*the later mark ends in -se which sounds the same as -z to an English consumer.*"⁹ I do not agree with the applicant that the average consumer in the UK would pronounce an 'UH' sound at the end of his mark. I agree with the Opponent's argument. It is my view that the relevant consumer will read the endings in both marks (i.e., 'Z' and 'SE') as the letter 'S', voicing the marks as resembling the word "prince".

⁷ For similar case law on this principle see, *inter alia*, *Sport Eybl & Sports Experts v OHIM* (Case T-179/11) and *Gappol v EUIPO* (Case T-411/15).

⁸ Dated 3 May 2023.

⁹ Opponent's submissions in lieu dated 12 December 2023.

46. Therefore, I find that the marks are aurally identical. If I am wrong about that, the marks are nevertheless highly similar overall from an aural perspective, even if the respective letters ‘se’ and ‘z’ are not pronounced identically.

Conceptual similarity

47. The Applicant submits¹⁰ that ‘Prinse’ is of Dutch origin whilst ‘Prinz’ is German. The Applicant did not provide further clarification on this argument. The Opponent contends that “*conceptually, whilst neither mark has a direct meaning in English, both are very similar with the English word PRINCE, and both marks give the impression of prince to an English consumer*”.

48. It is settled case law¹¹ that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. I do not accept that the average UK consumer will know that the applicant’s mark is a Dutch word whereas the opponent’s mark is German and there is no evidence before me to suggest otherwise. I note that the applicant points out that Prinse is his surname, but I do not consider that the mark will be immediately perceived as a surname by the average consumer. This is because it does not strike me as a surname that will have been commonly encountered in the UK and there is no evidence before me to suggest that it will nevertheless be recognised as one. I acknowledge that a small number of consumers may think of the concept of a “prince” when voicing the competing marks. However, I find that that both “prinz” and “prinse” are unusual and uncommon ways to misspell the word “prince” and it is doubtful that a significant proportion of consumers will immediately perceive the competing marks in this way. Taking these factors into account I find the respective marks to be conceptually neutral.

Distinctive character of the Earlier Mark

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

¹⁰ Applicant’s counterstatement dated 3 May 2023.

¹¹ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R. 29.

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

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

50. Registered trade marks possess varying degrees of inherent distinctive character. These range from the very low, such as those which are suggestive or allusive of the services, to those with high inherent distinctive character, such as invented words. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

51. Dealing first with the inherent distinctiveness of the Earlier Mark, the Opponent submits that:¹²

“PRINZ does not have any direct and immediate meaning in relation to class 33 goods. It does not present immediately any direct and clear signification or indication about the goods for which the Earlier Marks are registered. Whilst

¹² Submissions in lieu dated 12 December 2023.

PRINZ may be seen as referring to “prince”, this is not a common term used when referring to alcoholic drinks”.

52. Thus, the Earlier Mark is not a dictionary word, it does not seem to have any meaning in the English language (or other foreign language), and it does not describe or allude in any way to the goods for which the Earlier Mark has been registered. I find that the relevant consumer is unlikely to understand ‘PRINZ’ as the misspelling of “prince”, therefore, I believe the Earlier Mark is likely to be perceived as a meaningless invented word, without any semantic link to the goods in question. Thus, I find the Earlier Mark possesses a high degree of inherent distinctive character.

53. Turning to the question of whether the inherent distinctiveness of the Earlier Mark has been enhanced through use, I remind myself that the relevant date for assessing this matter is the filing date of the contested mark i.e. 29 December 2022. The Opponent provided evidence that the Earlier Mark has been used in relation to alcoholic beverages (schnapps and liqueurs) in the EU and UK. The Opponent provided invoices evidencing the distribution of its goods in Australia, the Netherlands, and the UK, however, use in the UK did not start until May 2022. The Opponent had a turnover from EU sales exceeding 30 million in 2018 and of 40 million in 2019. In the period between May and December 2022 the turnover from the UK market was approximately 7,500 euro.¹³ This figure demonstrates very low sales in the UK in what is, undoubtedly a very large market. Further, there is no evidence showing that any significant promotion of the mark has occurred within the UK by the relevant date nor any evidence of the extent of any financial investment made in promoting the mark to the UK market. Therefore, I do not believe that the evidence provided shows that the Earlier Mark has acquired enhanced distinctiveness through use in the UK.

Likelihood of confusion

54. There is no simple formula for determining whether there is a likelihood of confusion. The factors considered above have a degree of interdependency (*Canon* at [17]). I must make a global assessment of the competing factors (*Sabel*

¹³ Witness statement of Robert Weiss dated 18 August 2023.

at [22]), considering the various factors from the perspective of the average consumer and deciding whether the average consumer is likely to be confused. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

55. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other. Indirect confusion occurs where the average consumer recognises that the marks are different but puts the similarities between them down to the respective goods coming from the same or linked undertaking(s).

56. I have found the respective goods to be identical. The consumer is likely to pay a medium (or average) level of attention in their selection. The distinctiveness of the Earlier Mark is high. The visual similarity is above medium, there is aural identity between the mark or at least, a high degree of aural similarity, and the competing marks are conceptually neutral. The purchase of the contested goods is considered to be mainly visual but the potential for aural use is borne in mind. Weighing all of these factors, and bearing in mind the effects of imperfect recollection, I find that the average consumer is likely to mistake the Earlier Mark for the Contested Mark. Thus, there is a likelihood of direct confusion. I would have reached the same conclusion even if I had found that the distinctiveness of the earlier mark is of a medium level (rather than high). Further, I should point out that, had I agreed with the opponent that both marks evoke the concept of a 'prince' to a significant proportion of average consumers, this would have led me to a finding of some conceptual similarity between the marks, which, in turn, would have made the likelihood of confusion even greater.

Conclusion

57. The opposition succeeds and registration will be refused in respect of the goods in class 33. The application may proceed to registration for the other goods applied for in classes 14, 18 & 25.

Costs

58. The opponent has been successful and is entitled to an award of costs. The relevant scale is contained in Tribunal Practice Notice (“TPN”) 1/2023. Bearing that scale in mind, I award costs to the Opponent as follows:

Official fee	£100
Preparing the notice of opposition and considering the counterstatement	£250
Preparing evidence and considering and commenting on the other side's evidence	£600
Submissions in lieu	£350
Total:	£1,300

59. I order Nicholas Prinse to pay Geistreich Alpinspirits GmbH the sum of **£1,300**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 12th day of July 2024

Andrea Rossi

For the Registrar

ANNEX

The Opponent's Earlier Marks

1) WO0000001451656

Mark 1: PRINZ

Goods relied upon for the opposition:

Class 33: Alcoholic beverages (except beers); alcoholic essences, alcoholic extracts; alcoholic fruit extracts; cider, perry; wine; spirits; distilled beverages, schnapps, kirsch, liqueurs, bitters, strong liqueurs (schnapps), whisky.

Date of designation: 29/10/2018

Protection conferred date: 06/09/2019

2) UK00902111961

Mark 2: PRINZ

Goods relied upon for the opposition:

Class 33: Alcoholic beverages (except beers); alcoholic essences, alcoholic extracts; alcoholic fruit extracts; cider, perry; wines; spirits; distilled beverages, brandy, kirsch, liqueurs, bitters, whisky.

Filed: 01/03/2001

Date of entry in the register: 12/11/2003