

O-072-20

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3373051
BY THE TRUSTEES OF THORESBY SETTLEMENT**

TO REGISTER:

Thoresby

AS A TRADE MARK IN CLASSES 29, 31, 32, 33, 35, 36, 43 & 44

AND

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 416346
BY BOURNE LEISURE LIMITED**

BACKGROUND & PLEADINGS

1. On 6 February 2019, The Trustees of Thoresby Settlement (“the applicant”) applied to register the word **Thorseby** as a trade mark for the goods and services shown in the Annex of this decision. The application was published for opposition purposes on 15 February 2019.
2. On 15 May 2019, the application was opposed in full by Bourne Leisure Limited (“the opponent”). Although the opposition was originally based upon sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”), in its written submissions dated 12 August 2019, the opponent indicated that it no longer intended to pursue its objection based upon section 5(3) of the Act.
3. In its Notice of opposition, the opponent indicated that it relied upon all the services (shown in paragraph 14 below) in UK trade mark registration no. 2493908 for the words **THORESBY HALL**. This trade mark was applied for on 29 July 2008 and was entered in the register on 19 December 2008. In its Notice of opposition, the opponent claims that the competing trade marks are “highly similar”, the services in class 43 of the application are “identical, if not highly similar...” to, one assumes, its own services in class 43 and that the remaining goods and services in the application are “similar” to its own services.
4. However, in its written submissions of 12 August 2019, the opponent restricted its opposition to the goods and services in the application shown in paragraph 14.
5. The applicant filed a counterstatement which consists, in essence, of a denial of the grounds upon which the opposition is based. Attached to the counterstatement is a letter dated 9 May 2019 from the opponent to the applicant, suggesting how formal opposition to the application in suit might be avoided. In its counterstatement, inter alia, the applicant states:

“The applicant has been the owner of the estate known as Thoresby since 1633 and was the original owner of Thoresby Hall. The Thoresby Settlement Trust was established in 1953 and continues in existence today owning

several thousands acres of land known as Thoresby Estate which surrounds the opponent's property..."

6. In these proceedings, the opponent is represented by Potter Clarkson LLP; the applicant represents itself. Although neither party filed evidence, the opponent filed written submissions during the evidence rounds. While neither party requested a hearing, both elected to file written submissions in lieu of attendance. I shall keep all of these written submissions in mind, referring to them to the extent I consider it necessary.

DECISION

7. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"5(2) 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.

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."

8. An earlier trade mark is defined in section 6 of the Act, which states:

"6. - (1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK), Community trade mark or international trade mark (EC) which has a date of application for

registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks, (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

9. The trade mark relied upon by the opponent qualifies as an earlier trade mark under the above provisions. Given the interplay between the dates on which the opponent’s trade mark was entered in the register and the filing date of the application for registration, the earlier trade mark is, in principle, subject to the proof of use provisions. In its Notice of opposition, the opponent indicated that it had used its trade mark in relation to all services for which it stands registered and upon which it relies.

10. However, as in its counterstatement the applicant elected not to ask the opponent to provide proof of use, the opponent can rely upon all the services for which its trade mark is registered without having to demonstrate genuine use.

The correct approach to the comparison

11. I note that in its submissions filed in lieu of a hearing, the applicant provides information on the history of the “Thoresby estate”. In its submissions filed on 12 August 2019, the opponent stated:

“5.4...we respectfully submit that the commercial use by the parties (actual or intended) has absolutely no bearing on the course of trade mark opposition proceedings.”

12. Although the applicant might regard it as somewhat odd, as no evidence has been filed by either party to these proceedings, the opponent’s position is correct. Any use either party may have made or intends to make of the trade marks in issue in these proceedings is not a factor I can take into account. What I must do is compare the competing trade marks/goods and services on a notional and fair basis.

Case law

13. The following principles are gleaned from the decisions of the courts of the European Union 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 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods and services

14. The competing goods and services are as follows:

Opponent's services	Applicant's goods and services now being opposed
Class 41 - Provision of entertainer, amusement, leisure and recreation facilities, services and amenities; night-club, discotheque, music hall, concert, dance hall, ballroom, cabaret, cinema	Class 29 - Bacon; Beef; Carrots; Chicken; Duck; Fish; Fresh chicken; Fresh meat; Fresh poultry; Fresh turkey; Game; Lamb products; Meat; Meat burgers; Meatballs; Meats; Minced

<p>and theatre services; amusement park, arcade and centre services; gaming, gambling and casino services; snooker and pool club services; theme park services; leisure centre, boating lake and water-shute complex services; funfair, circus and bingo hall services; provision of public baths, aquatic recreation, swimming, windsurfing, water skiing and outdoor recreation facilities, services and amenities; tennis courts; health and fitness club services; provision of gym facilities; health clubs for physical exercise; tenpin bowling and bowling green services; sports instruction services; organisation of recreational activities, namely golf, tennis, croquet, hot air ballooning, helicopter rides, clay pigeon shooting, painting, boules, quad biking, off-road driving, driving courses, archery, snooker, billiards, pool, cycling, horse racing, walks, abseiling, boat trips, canal trips, canoeing, kayaking, fishing, gliding, horse riding, rock climbing, sailing, wind surfing; organization of quizzes, games and competitions; production of shows and of cabarets; organisation of beauty competitions; instruction and tuition in association with all of the aforesaid; educational services; provision of education and entertainment services for club</p>	<p>meat; Mincemeat [chopped meat]; Pork; Poultry; Sausages; Venison.</p> <p>Class 31 - Carrots (Fresh -); Fresh beets; Fresh cabbage; Fresh carrots; Fresh fruits and vegetables; Fresh onions; Fresh parsnips; Fresh potatoes; Fresh vegetables; Onions; Potatoes, fresh; Vegetables, fresh.</p> <p>Class 32 - Ale; Ales; Barley wine [Beer]; Beer; Beer and brewery products; Beers; Craft beer; Craft beers; Ginger ale; Ginger beer; IPA (Indian Pale Ale); Lager; Lagers; Pale ale; Stouts; Wheat beer.</p> <p>Class 33 - Alcoholic beverages, except beer.</p> <p>Class 43 - Accommodation (Rental of temporary -); Accommodation services; Agency services for the reservation of temporary accommodation; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists; Arranging of holiday accommodation; Arranging of temporary accommodation; Booking of temporary accommodation; Booking of temporary</p>
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<p>members; publication of books, booklets, magazines, journals, manuals, brochures, leaflets or pamphlets in printed or electronic form; information services relating to all of the aforesaid.</p> <p>Class 43 - Hotel, motel and boarding house services; provision of tourist house and accommodation services, cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of holiday camp and camp ground services, facilities and amenities; operation of nurseries and creches; provision of exhibition facilities and amenities; provision of facilities and amenities, all for conferences, seminars and banquets; provision of holiday accommodation; reservation, booking and reception services for hotels and other temporary accommodation; information services relating to all of the aforesaid.</p> <p>Class 44 - Spa and beauty salon services; hairdressing salons; provision of sauna and solarium services, facilities and amenities.</p>	<p>accommodation via the Internet; Booking services for accommodation; Cafés; Camp services (Holiday -) [lodging]; Campground facilities (Providing -); Caravan park facilities (Provision of -); Catering; Catering (Food and drink -); Catering services for conference centers; Hospitality services [accommodation]; Hospitality services [food and drink]; Provision of camp ground facilities; Provision of caravan park facilities; Provision of conference, exhibition and meeting facilities; Provision of conference facilities; Provision of exhibition facilities; Provision of facilities for conventions; Provision of facilities for exhibitions; Provision of holiday accommodation; Provision of temporary accommodation; Provision of temporary furnished accommodation; Rental of conference rooms; Rental of holiday cabins; Rental of meeting rooms; Rental of rooms as temporary living accommodations; Rental of temporary accommodation; Reservation of temporary accommodation; Restaurants; Room rental for exhibitions.</p>
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15. I note that in its submissions of 12 August 2019, the opponent only seeks to compare the applicant's named goods and services with its own services in class 43 (shown above in bold). As the opponent makes no mention of its services in classes 41 and 44, it is, I think, reasonable for me to infer that it is its services in class 43 which it regards as offering it the best prospect of success. It is on that basis I intend to proceed.

16. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the Court 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".

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

18. In *YouView TV Ltd v Total Ltd* ,[2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

19. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated:

"I should add that I see no reason to give the word "cosmetics" and "toilet preparations"... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context."

20. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

“...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”.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

22. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the GC stated:

“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 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”.

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

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

24. In relation to the applicant’s goods in classes 29, 31, 32, and 33, in its submissions of 12 August 2019, the opponent states:

“23. It is respectfully submitted that these goods are similar to those covered by the Opponent's Class 43 services *"cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services"*.

24. In particular, it should be noted that all the goods stated...are sold in restaurants, bars and the like and are common items to be provided during catered events. Consequently, the respective goods and services are clearly complimentary. The similarities increase further when taking into account that the same end users will be faced by these goods. As such, when the same consumer is exposed to branded meat, poultry, fish, fruit, vegetables, beers and other beverages, and is then faced with highly similar branded restaurants, cafes, etc. it is natural that the consumer will consider there to be a connection between them.

25. In addition, it is likely that consumers will consider that the Opponent's services and the Applicant's goods coincide in the producer and provider, such that they originate from the same or economically linked undertakings.

26. This is particularly the case when, in reality, the consumer is one who travels to a remote hotel, in its own grounds, surrounded by fields and livestock and also partakes in the restaurant services in that location.”

25. In its submissions filed in lieu of a hearing, it further stated:

“16. It is further submitted that where the goods and/or services covered by the respective marks are not considered to be identical, there is nevertheless a good deal of nexus between them by virtue of, amongst other factors, complementarity.

17. Goods and services can be considered similar when consumers may think that the responsibility for the production of those goods, or provision of those services, lies with the same undertaking...

18. In the present case it is respectfully submitted that consumers are very well acquainted to observing that the goods and services covered by the Contested Application and the Registration are frequently provided by the same commercial undertaking. We ask that the Office takes judicial note of this.

19. By way of example, hotels will also provide food and drink offerings. Further, the Registration covers "*provision of. .. banquets*" and, at such banquets, attendees will be provided with all of the goods covered by the Contested Application. Such services will be notionally provided under the THORESBY HALL trade mark.

20. As such, if consumers are faced with the Applicant's goods under the 'Thoresby' trade mark, it is highly conceivable that they will consider that these goods originate from the Opponent.”

26. I note that in its submissions, the opponent specifically identifies the following of its services in class 43 as being similar to the applicant's goods in classes: 29, 31, 32 and 33:

Cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services; provision of facilities and amenities, all for. .. banquets.

27. Once again, it is, in my view, reasonable for me to infer that the opponent has identified those of its services in class 43 which it considers offers it the best prospect of success in relation to the goods mentioned. It is upon the basis of those services that I shall conduct the comparison, dealing with the matter on a class-by-class basis

Class 29 - Bacon; Beef; Carrots; Chicken; Duck; Fish; Fresh chicken; Fresh meat; Fresh poultry; Fresh turkey; Game; Lamb products; Meat; Meat burgers; Meatballs; Meats; Minced meat; Mincemeat [chopped meat]; Pork; Poultry; Sausages; Venison.

28. In his decision in BL-O-106-19, the Hearing Officer was seized of a similar comparison I am required to make in these proceedings. In his decision, he stated:

“37. I will begin by considering the goods applied for that fall correctly in class 29. The applied for ‘*meat, fish, poultry and game*’ are considered to be similar to a low degree to the earlier ‘*Restaurant, bar and catering services; providing winemaker dinners featuring wine*’. Some butchers or charcuteries may roast chickens or other types of meat. Although those goods are not necessarily consumed on the premises, there is an overlap with the services of a fast food restaurant or take away. The same is true with regard to some fishmongers who offer their customers a selection of fish and seafood to take away or to be cooked and eaten on the premises (in an adjoining restaurant).

38. The Appointed Person found in *J Sainsbury Plc v Top Dog Eats Limited* (BL-O/044/16) that class 29 is concerned with goods, mainly foodstuffs of animal origin, that have been prepared for consumption or conservation, and that ‘*meat, fish, poultry and game*’, forming a part of the class heading, could therefore encompass, as a subset, items such as hotdogs; meat pies; hamburgers; beef burgers and other snack foods, that the average consumer would expect to find on offer from a restaurant, bar or catering outlet. These goods and services are therefore found to be similar to a low degree.”

29. I adopt the Hearing Officer's reasoning in relation to the following:

Fish, Fresh meat, Meat, Meats, Poultry, Fresh poultry and Game,
Bacon, Beef, Chicken, Duck, Fresh chicken, Fresh turkey, Lamb products,
Meat burgers, Meatballs, Pork; Sausages and Venison.

30. I find that these goods are similar to a low degree to the opponent's "restaurant" and "catering" services.

31. In *Les Editions Albert Rene Sari v OHIM* Case C-16/06, the CJEU held that:

"the mere fact that a particular item is used as a part, element or component of another does not suffice to show that the finished goods containing that item are similar since their nature, intended purpose and intended customers may be completely different."

32. Although "Carrots", "Minced meat" and "Mincemeat [chopped meat]" in the application are all foodstuffs that will form part of a meal, having applied the relevant case law, I am unable to detect any meaningful degree of similarity between these goods and the opponent's named services.

Class 31 - Carrots (Fresh -); Fresh beets; Fresh cabbage; Fresh carrots; Fresh fruits and vegetables; Fresh onions; Fresh parsnips; Fresh potatoes; Fresh vegetables; Onions; Potatoes, fresh; Vegetables, fresh.

33. In its submission, the opponent requests that I take judicial notice of the fact that "the goods and services covered by the Contested Application and the Registration are frequently provided by the same commercial undertaking". However, it is not, in my view, a notorious fact that undertakings engaged in the provision of restaurant and catering services also conduct a trade in fresh fruit and vegetables. That being the case, having applied the relevant case law, I find that the applicant's goods in class 31 are not similar to the opponent's named services in class 43.

Class 32 - Ale; Ales; Barley wine [Beer]; Beer; Beer and brewery products; Beers; Craft beer; Craft beers; Ginger ale; Ginger beer; IPA (Indian Pale Ale); Lager; Lagers; Pale ale; Stouts; Wheat beer.

34. In *Group Lottus Corp., SL v OHIM*, Case T-161/07, the GC held that in view of the complementarity, target audience and overlapping points of sale, there was a “lesser” [low] degree of similarity between beers and bar, nightclub and cocktail bar services. As the vast majority of the applicant’s goods are beers of one sort or another, the same logic applies to them as, in my view, it does to all the goods in the applicant’s specification. The applicant’s goods are similar to a low degree to the opponent’s “bar services” in class 43.

Class 33 - Alcoholic beverages, except beer.

35. My above findings in relation to the applicant’s goods in class 32 also apply to its goods in class 33. The applicant’s goods are similar to a low degree to the opponent’s “bar services” in class 43.

Class 43

Accommodation (Rental of temporary -); Accommodation services; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists; Arranging of holiday accommodation; Arranging of temporary accommodation; Camp services (Holiday -) [lodging]; Hospitality services [accommodation]; Provision of holiday accommodation; Provision of temporary accommodation; Provision of temporary furnished accommodation; Rental of holiday cabins; Rental of rooms as temporary living accommodations; Rental of temporary accommodation.

36. As the opponent’s specification includes, inter alia, “Provision of...accommodation services” and “provision of holiday accommodation”, the

competing wordings are simply alternative ways of describing the same services and are, as a consequence, to be regarded as identical.

**Agency services for the reservation of temporary accommodation;
Booking of temporary accommodation; Booking of temporary
accommodation via the Internet; Booking services for accommodation;
Reservation of temporary accommodation;**

37. The applicant's services above all relate to the booking/reservation of accommodation, whereas the opponent's specification includes: "reservation, booking and reception services for hotels and other temporary accommodation." The competing services are, once again, identical.

**Cafés; Catering; Catering (Food and drink -); Catering services for
conference centers; Hospitality services [food and drink]; Restaurants.**

38. As the opponent's specification includes: "cafe, cafeteria, canteen, bar, coffee shop, snack-bar and restaurant services; catering services", the competing services are, once again, identical.

**Campground facilities (Providing -); Caravan park facilities (Provision of
-); Provision of camp ground facilities; Provision of caravan park
facilities.**

39. The opponent's specification includes the "provision of holiday camp and camp ground services, facilities and amenities", the latter of which are identical to the applicant's "Campground facilities (Providing -);" and "Provision of camp ground facilities." Given the overlap in, at least, the users, intended purpose and the likely competitive/complementary relationship that exists between the opponent's "provision of camp ground services, facilities and amenities" and the applicant's "provision of caravan park facilities", it results in what I regard as a high degree of similarity between them.

Provision of conference, exhibition and meeting facilities; Provision of conference facilities; Provision of exhibition facilities; Provision of facilities for conventions; Provision of facilities for exhibitions; Rental of conference rooms; Rental of meeting rooms; Room rental for exhibitions.

40. As the opponent's specification includes: "provision of exhibition facilities and amenities; provision of facilities and amenities, all for conferences, seminars and banquets", once again, the services are to be regarded as identical.

41. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated:

"49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity."

42. Having found that the applicant's "Carrots", "Minced meat" and "Mincemeat [chopped meat]" in class 29 and all of its goods in class 31 are not similar to the opponent's named services in class 43, there can be no likelihood of confusion and the opposition to these goods fails and is dismissed accordingly.

The average consumer and the nature of the purchasing act

43. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods and services I have found to be identical or similar. I must then determine the manner in which these goods and services 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.”

44. In its submissions filed on 12 August 2019, the opponent stated:

“27. The average consumer of the above products [i.e. the goods in classes 29, 31, 32 and 33] is not a specialist one. The provision of accommodation and food will be targeted towards the public at large. In the case of alcoholic drinks, the average consumer will be the adult public. In either case, the consumers will pay an average degree of attention to the marks.”

45. I agree that the average consumer of all the goods and services will be a member of the general public and, in respect of all the goods in class 33 and, with the possible exception of “ginger ale” and “ginger beer” in class 32, a member of the adult general public.

Class 29

46. The goods in this class are, in my experience, most likely, be obtained by self-selection from bricks and mortar retail outlets such as supermarkets and butchers and their online equivalents. Although that points to visual considerations dominating the selection process, aural considerations in the form of, for example, requests to sales assistants are also relevant. As to the degree of care that will be displayed when selecting such goods, the goods at issue are likely to be frequent, inexpensive purchases. The opponent suggests that the average consumer will pay an “average” degree of attention to their selection; I am content to proceed on that basis.

Classes 32 and 33

47. The vast majority of the goods at issue are alcoholic beverages. Such goods are sold through a range of channels, including retail premises such as supermarkets and off-licences (where they will normally be displayed on shelves) and on-line; in such circumstances, the goods will be obtained by self-selection. Such goods are also sold in public houses, bars and restaurants (where they will be displayed on, for example, bar pumps and bottles and where the trade mark will appear on drinks lists etc.) When the goods are sold in public houses, bars and restaurants, there will be an oral component to the selection process. However, there is nothing to suggest that such goods are sold in such a manner as to preclude a visual inspection. Consequently, while the goods may be ordered orally in public houses, bars and restaurants, it is likely to be in the context of, for example, a visual inspection of the bar pump, bottle or drinks lists prior to the order being placed. Considered overall, the selection process will, in my view, be a predominantly visual one, although aural considerations will play their part. Once again the opponent suggests that an average degree of attention will be paid to the selection of such goods. Although relatively inexpensive, an average consumer selecting such goods will wish to ensure they are selecting, for example, the correct type, origin and flavour of beverage. As a consequence, I agree that average is a fair characterisation of the degree of attention that will be paid to their selection. I see no reason why the same conclusions are not equally applicable to the applicant's "ginger ale" and "ginger beer".

Class 43

48. My own experience as an average consumer (which I do not regard as atypical), informs me that such services are most likely to be selected having considered, for example, promotional material and reviews (in hard copy and on-line) and on signage appearing on the high street; as a consequence, visual considerations will be an important part of and are likely to dominate the selection process. However, as such services are also, in my experience, very likely to be the subject of word-of-mouth recommendations, aural considerations will be a not-insignificant feature of the process. Once again, the opponent suggests that the degree of care paid to the

selection of such services will be average. While that may true of some of the services at issue, in my view, the degree of care the average consumer will display when selecting such services is likely to vary. Compare for example, the low degree of care likely to be taken when one selects a venue for an inexpensive, impromptu snack, with the fairly high degree of attention one is likely to pay when selecting holiday accommodation.

Comparison of trade marks

49. 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 them, 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.”

50. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create. The trade marks to be compared are as follows:

Opponent's trade mark	Applicant's trade mark
THORESBY HALL	Thoresby

51. The applicant's trade mark consists of the word "Thoresby" presented in title case. As no part of the word is highlighted or emphasised in any way, the overall impression it conveys and its distinctiveness lies in the single word of which it is composed.

52. The opponent's trade mark consists of the two words "THORESBY" and "HALL" presented in block capital letters. In my view, these words create a unit, the meaning of which is different to the individual words of which it is composed (I shall return to this point below). It is this unit which creates the overall impression and in which the distinctiveness lies.

Visual and aural similarity

53. As their presentations in title case and block capital letters respectively have no bearing on the matter, the applicant's trade mark and the first word of the opponent's trade mark are, effectively, identical. Although the opponent's trade mark also contains the word "HALL" which is alien to the applicant's trade mark, considered overall, the fact that the word "Thoresby" is the only word in the applicant's trade mark and the first word in the opponent's trade mark, results in what I regard as an above medium degree of both visual and aural similarity between the competing trade marks.

Conceptual similarity

54. There are submissions to the effect that "Thoresby" has geographical significance. However, even without such a submission, I would have concluded that the average consumer is most likely to construe the word "Thoresby" as either geographical or surnominal in nature. Having done so, the word "HALL" will, in my view, be construed in the context defined in collinsdictionary.com as: "is sometimes used as part of the name of a large house in the country." It is for that reason, I concluded earlier that the opponent's trade mark formed a unit. However, as the average consumer may accord the word "Thoresby" the same meaning whether used alone or with the word "HALL", it results in at least a medium degree of conceptual similarity between the trade marks at issue.

Distinctive character of the earlier trade mark

55. The distinctive character of a trade mark can be appraised only, first, by reference to the services in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the services for which it has been registered as coming from a particular undertaking and thus to distinguish those services from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

56. As the opponent has filed no evidence of any use it may have made of its earlier trade mark, I have only its inherent characteristics to consider. Although I have no evidence in this regard, it appears that “Thoresby” may be geographical in nature. However even that is the case, as I have no evidence as to its size, the opponent’s earlier trade mark enjoys a fairly high degree of inherent distinctive character.

Likelihood of confusion

57. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and the fact 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.

58. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods/services down to the responsible undertakings being the same or related.

59. Earlier in this decision I concluded:

- certain goods in class 29 and all of the goods in classes 32 and 33 of the application are similar to the opponent's named services to a low degree;
- the applicant's services in class 43 are either identical or highly similar to those of the opponent in class 43;
- the average consumer is a member of the general public and, in relation to some goods, a member of the adult general public;
- whilst not forgetting aural considerations, the average consumer will select the goods and services at issue by predominantly visual means whilst paying, for the most part, an average degree of attention during that process;
- the competing trade marks are visually and aurally similar to an above medium degree and conceptually similar to at least a medium degree;
- the earlier trade mark being relied upon is possessed of a fairly high degree of inherent distinctive character.

60. As the word "HALL" in the opponent's trade mark forms part of the unit created and the overall impression it conveys, there is, in my view, unlikely to be direct confusion. That leaves indirect confusion to be considered. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

61. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two trade marks share a common element. In this connection, he pointed out that it is not sufficient that a trade mark merely calls to mind another trade mark. This is mere association not indirect confusion.

62. I shall begin by considering those goods in classes 29, 32 and 33 of the application that I have found to be similar to only a low degree. However, even in relation to these goods, the presence of the word “THORESBY” in both parties’ trade marks together with, inter alia, the fairly high degree of distinctiveness the opponent’s trade mark possesses is, in my view, likely to lead a consumer paying even a high degree of attention during the selection process to conclude that the applicant’s goods originate from the opponent or a commercially linked undertaking. That conclusion has even more force when one recalls that I actually found that the consumer will pay an average degree of attention to the selection of such goods, thus making him/her more prone to the effects of imperfect recollection. The above conclusions are, of course, even more pronounced in relation to the services in class 43, which I found to be identical/highly similar.

63. As a consequence of the above conclusions, the opposition based upon section 5(2)(b) succeeds in relation to those goods and services I have found to be

similar/identical and, subject to any successful appeal, the application will be refused in relation to such goods and services.

Summary of conclusions

64. The goods and services which are either no longer being opposed or in relation to which I have found no similarity (the latter shown in bold) are as follows:

Class 29 - Carrots; Minced meat; Mincemeat [chopped meat].

Class 31 - Animals (Live -); Beef cattle; **Carrots (Fresh -);** Christmas trees; Conifer trees; Crop seeds; Fish, live; **Fresh beets; Fresh cabbage; Fresh carrots; Fresh fruits and vegetables; Fresh onions; Fresh parsnips; Fresh potatoes; Fresh vegetables;** Live eels; Live fish; Live game; Live pigs; Live poultry; Live sheep; Live trees; **Onions;** Pigs; **Potatoes, fresh;** Raw and unprocessed agricultural products; Raw and unprocessed forestry products; Raw and unprocessed grains; Raw and unprocessed horticultural products; Raw timber; Raw vegetables; Seed potatoes; Sheep; Timber (Unsawn -); Trees and forestry products; Unprocessed forestry products; Unprocessed grain; Unprocessed onions; Unprocessed potatoes; Unprocessed sugar beets; Unprocessed vegetables; Unseasoned timber; **Vegetables, fresh.**

Class 35 - Commercial consultancy; Consultancy and advisory services for business management; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise.

Class 36 - Real estate affairs.

Class 44 - Agricultural advice; Agricultural advisory services; Agricultural consultancy; Agricultural services; Agriculture, aquaculture, horticulture and forestry services; Agriculture, horticulture and forestry services; Agriculture services; Animal breeding; Animal husbandry; Consultancy relating to agriculture, horticulture and forestry; Consultancy relating to farming;

Consultancy services relating to farming; Farming (animals); Farming (crops); Farming services; Forestry services; Livestock farming services; Tree nurseries; Tree nursery services; Tree planting; Tree surgeons' services; Tree surgery; Vermin exterminating for agriculture; Vermin exterminating for agriculture, horticulture and forestry; Wildlife casualty euthanasia services.

65. The application may proceed to registration in relation to those goods and services not shown in bold regardless and, subject to any successful appeal, also in relation to those goods shown in bold.

66. The goods and services in relation to which the opposition has succeeded are as follows:

Class 29 - Bacon; Beef; Chicken; Duck; Fish; Fresh chicken; Fresh meat; Fresh poultry; Fresh turkey; Game; Lamb products; Meat; Meat burgers; Meatballs; Meats; Pork; Poultry; Sausages; Venison.

Class 32 - Ale; Ales; Barley wine [Beer]; Beer; Beer and brewery products; Beers; Craft beer; Craft beers; Ginger ale; Ginger beer; IPA (Indian Pale Ale); Lager; Lagers; Pale ale; Stouts; Wheat beer.

Class 33 - Alcoholic beverages, except beer.

Class 43 - Accommodation (Rental of temporary -); Accommodation services; Agency services for the reservation of temporary accommodation; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists; Arranging of holiday accommodation; Arranging of temporary accommodation; Booking of temporary accommodation; Booking of temporary accommodation via the Internet; Booking services for accommodation; Cafés; Camp services (Holiday -) [lodging]; Campground facilities (Providing -); Caravan park facilities (Provision of -); Catering; Catering (Food and drink -); Catering services for conference centers; Hospitality services [accommodation]; Hospitality services [food and drink]; Provision of camp

ground facilities; Provision of caravan park facilities; Provision of conference, exhibition and meeting facilities; Provision of conference facilities; Provision of exhibition facilities; Provision of facilities for conventions; Provision of facilities for exhibitions; Provision of holiday accommodation; Provision of temporary accommodation; Provision of temporary furnished accommodation; Rental of conference rooms; Rental of holiday cabins; Rental of meeting rooms; Rental of rooms as temporary living accommodations; Rental of temporary accommodation; Reservation of temporary accommodation; Restaurants; Room rental for exhibitions.

67. Subject to any successful appeal, the application will be refused in respect of the above goods and services.

Costs

68. Although the opponent originally opposed all the goods and services in the application on the basis of sections 5(2)(b) and 5(3) of the Act, as I mentioned earlier, in its written submissions of 12 August 2019, it abandoned its claim based upon section 5(3) and limited its opposition to only those goods and services above. However, as the opponent has been overwhelming successful and as its change in approach has not, in my view, placed any material burden on the applicant, the opponent is entitled to a contribution to the costs it has incurred.

69. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Bearing the above in mind and, as the opposition based upon section 5(3) was abandoned, only awarding £100 in respect of the official fee, I award costs to the opponent on the following basis:

Preparing the Notice of opposition and considering the counterstatement:	£200
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Written submissions (x2)	£300
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Official fee: £100

Total: £600

70. I order The Trustees of Thoresby Settlement to pay to Bourne Leisure Limited the sum of **£600**. 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 05th day of February 2020

C J BOWEN

For the Registrar

Annex

Class 29 - Bacon; Beef; Carrots; Chicken; Duck; Fish; Fresh chicken; Fresh meat; Fresh poultry; Fresh turkey; Game; Lamb products; Meat; Meat burgers; Meatballs; Meats; Minced meat; Mincemeat [chopped meat]; Pork; Poultry; Sausages; Venison.

Class 31 - Animals (Live -); Beef cattle; Carrots (Fresh -); Christmas trees; Conifer trees; Crop seeds; Fish, live; Fresh beets; Fresh cabbage; Fresh carrots; Fresh fruits and vegetables; Fresh onions; Fresh parsnips; Fresh potatoes; Fresh vegetables; Live eels; Live fish; Live game; Live pigs; Live poultry; Live sheep; Live trees; Onions; Pigs; Potatoes, fresh; Raw and unprocessed agricultural products; Raw and unprocessed forestry products; Raw and unprocessed grains; Raw and unprocessed horticultural products; Raw timber; Raw vegetables; Seed potatoes; Sheep; Timber (Unsawn -); Trees and forestry products; Unprocessed forestry products; Unprocessed grain; Unprocessed onions; Unprocessed potatoes; Unprocessed sugar beets; Unprocessed vegetables; Unseasoned timber; Vegetables, fresh.

Class 32 - Ale; Ales; Barley wine [Beer]; Beer; Beer and brewery products; Beers; Craft beer; Craft beers; Ginger ale; Ginger beer; IPA (Indian Pale Ale); Lager; Lagers; Pale ale; Stouts; Wheat beer.

Class 33 - Alcoholic beverages, except beer.

Class 35 - Commercial consultancy; Consultancy and advisory services for business management; Help in the management of business affairs or commercial functions of an industrial or commercial enterprise.

Class 36 - Real estate affairs.

Class 43 - Accommodation (Rental of temporary -); Accommodation services; Agency services for the reservation of temporary accommodation; Arranging and providing temporary accommodation; Arranging holiday accommodation; Arranging of accommodation for holiday makers; Arranging of accommodation for tourists;

Arranging of holiday accommodation; Arranging of temporary accommodation; Booking of temporary accommodation; Booking of temporary accommodation via the Internet; Booking services for accommodation; Cafés; Camp services (Holiday -) [lodging]; Campground facilities (Providing -); Caravan park facilities (Provision of -); Catering; Catering (Food and drink -); Catering services for conference centers; Hospitality services [accommodation]; Hospitality services [food and drink]; Provision of camp ground facilities; Provision of caravan park facilities; Provision of conference, exhibition and meeting facilities; Provision of conference facilities; Provision of exhibition facilities; Provision of facilities for conventions; Provision of facilities for exhibitions; Provision of holiday accommodation; Provision of temporary accommodation; Provision of temporary furnished accommodation; Rental of conference rooms; Rental of holiday cabins; Rental of meeting rooms; Rental of rooms as temporary living accommodations; Rental of temporary accommodation; Reservation of temporary accommodation; Restaurants; Room rental for exhibitions.

Class 44 - Agricultural advice; Agricultural advisory services; Agricultural consultancy; Agricultural services; Agriculture, aquaculture, horticulture and forestry services; Agriculture, horticulture and forestry services; Agriculture services; Animal breeding; Animal husbandry; Consultancy relating to agriculture, horticulture and forestry; Consultancy relating to farming; Consultancy services relating to farming; Farming (animals); Farming (crops); Farming services; Forestry services; Livestock farming services; Tree nurseries; Tree nursery services; Tree planting; Tree surgeons' services; Tree surgery; Vermin exterminating for agriculture; Vermin exterminating for agriculture, horticulture and forestry; Wildlife casualty euthanasia services.