

**O/0763/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3892337  
IN THE NAME OF LONGDAN LTD  
TO REGISTER AS A TRADE MARK**



**IN CLASSES 29, 30, 31, 32  
AND 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NUMBER 442589  
BY SAZERAC BRANDS, LLC**

## **BACKGROUND AND PLEADINGS**

1. On 23 March 2023, Longdan Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 19 May 2023, in respect of goods in classes 29, 30, 31, 32 and 33.

2. The application is opposed by Sazerac Brands, LLC (“the opponent”). The opposition was filed on 18 August 2023 and is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).<sup>1</sup> The opposition is directed against the goods in classes 32 and 33 only of the application, as listed in the table under paragraph 16 of this decision.<sup>2</sup> The opponent relies upon the following four marks:

### **BUFFALO TRACE**

UK trade mark registration number 901199611

Filing date: 8 June 1999

Registration date: 3 August 2000

Registered in Class 33

Relying on all goods, as listed in the table under paragraph 16 of this decision.

(The ‘611 mark); and



UK trade mark registration number 918013089

Filing date: 22 January 2019

Registration date: 25 May 2019

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<sup>1</sup> As the opponent elected not to file evidence within the given period in relation to the section 5(3) and section 5(4)(a) grounds as originally filed, the Registry considered that in accordance with Rule 20(3) of the Trade Mark Rules 2008, those grounds should be deemed withdrawn. As this went unchallenged, the withdrawal of those grounds was confirmed by the Tribunal in the official letter sent to both parties, dated 18 June 2024. The opposition therefore proceeds in respect of section 5(2)(b) grounds only.

<sup>2</sup> I note that the applicant filed form TM21B to amend the Class 32 goods to those listed under the table in paragraph 16 of this decision. The opponent was requested to confirm whether the amendment was sufficient to allow the opposition to be withdrawn. However, it was confirmed in an email sent on 4 September 2023 that the opponent wished to continue with the opposition.

Registered in Class 33

Relying on all goods, as listed in the table under paragraph 16 of this decision.

(The '089 mark); and

### **BUFFALO TRACE**

UK trade mark registration number 3919622

Filing date: 6 June 2023

Registration date: 13 October 2023

Registered in Classes 6, 8, 9, 14, 16, 18, 19, 20, 21, 22, 24, 28 and 34

Relying on goods in class 21 only, as listed in the table under paragraph 16 of this decision.

(The '622 mark); and



UK trade mark registration number 3919628

Filing date: 6 June 2023

Registration date: 29 September 2023

Registered in Classes 4, 6, 8, 9, 14, 16, 18, 19, 20, 21, 22, 24, 28 and 34

Relying on goods in class 21 only, as listed in the table under paragraph 16 of this decision.

(The '628 mark).

3. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent's '611 mark and its '089 mark were each converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.<sup>3</sup>

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<sup>3</sup> See also Tribunal Practice Notice ("TPN") 2/2020 End of Transition Period – impact on tribunal proceedings.

4. The above marks all qualify as an earlier mark under section 6(1) of the Act. As the earlier '611 mark was registered more than 5 years before the application date of the applicant's mark, it is, in principle, subject to the provisions on use under Section 6A of the Act. The opponent made a statement of use in relation to all of the goods relied upon. Although the applicant could have required the opponent to provide proof of use of the earlier '611 mark under section 6A of the Act, it did not do so.<sup>4</sup> As a result, the opponent is able to rely on all the goods for which it made a statement of use on the notice of opposition (form TM7), without having to provide evidence that it has used its mark in relation to any of those goods. As the remaining marks relied upon had not completed their registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act.

5. The opponent submits that because of the high degree of similarity between its earlier marks and the applied-for mark and the goods, there exists a likelihood of confusion on the part of the public in the UK. Therefore, it submits that the application offends under the provisions of section 5(2)(b) of the Act.

6. The applicant filed a counterstatement denying the claims. It acknowledges that all of the marks incorporate the word "Buffalo", but submits that the distinctive visual elements clearly differentiate the marks from one another, that its own mark merits registration, and that its coexistence with the opponent's mark would not lead to any confusion.

7. Neither party elected to file evidence or written submissions during the evidence rounds. Neither party requested a hearing; only the opponent filed written submissions in lieu of a hearing, which will be referred to as and where appropriate in this decision. This decision is taken following careful consideration of the papers on file.

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<sup>4</sup> As per question 7 of the form TM8 where the applicant has ticked 'No' in answer to the question: 'Do you want the opponent to provide "proof of use"?'.

8. In these proceedings, the opponent is represented by Fieldfisher LLP; the applicant is not professionally represented.

## PRELIMINARY ISSUE

9. I note that in its written submissions in lieu of a hearing, the opponent refers to the applicant's counterstatement, which the opponent submits includes conflicting statements regarding the distinctiveness of the applicant's mark. I reproduce the opponent's submissions in this respect, below:

31. The Opponent notes the conflicting statements in the Counterstatement regarding the distinctiveness of the Sign. On the one hand, the Applicant argues, and therefore agreed with the Opponent, that Sign is distinctive; on the other hand, the Applicant states that '*we emphasize the significance of the water buffalo in Vietnamese culture, as it holds national importance. The inclusion of **this symbol is essential in effectively conveying the nature of the products we intend to offer, particularly Vietnamese, food and beverages** (emphasis added)*'.
32. We leave for the Office to take a view of the whether the admissions made in the Counterstatement create a difficulty for registration (in that the Applicant appears to be saying the mark is descriptive) but the Opponent's position is that its marks are distinctive and the Sign includes a distinctive and dominant component of those marks.

10. The applicant's mark is a composite mark containing words and a figurative (device) element, which was accepted *prima facie* during the examination of the application. In the counterstatement, the applicant submits that its mark embodies a highly distinctive visual element, although I acknowledge that it also mentions that it considers the word "Buffalo" to be "generic and devoid of inherent exclusivity". I also note that the applicant has referred to the significance of the water buffalo in Vietnamese culture and that the inclusion of the symbol is intended to convey the nature of the products being offered under the mark.

11. A trade mark may be considered to possess sufficient distinctive character in order to satisfy the requirements under section 3(1) of the Act, even where the mark contains elements which are considered allusive of the type of goods or services. I disagree with the opponent that the applicant has made any admission that its mark *as a whole* is descriptive and I consider that it has taken the words out of context. I will proceed

to make my decision based on a multi-factorial assessment of the likelihood of confusion between the marks.

## **DECISION**

12. 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.

### **Section 5(2)(b)**

13. Section 5(2)(b) is relied on and reads as follows:

“5(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”.

14. Section 5A states:

“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.”

15. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 to mind the earlier mark, 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

16. The goods to be compared are:

<b>Applicant's goods</b>
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<u>Class 32</u>
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<i>Beer and brewery products; Preparations for making beverages; fruit juices / fruit juice; fruit nectars, non-alcoholic; ginger beer / ginger ale; lemonades; smoothies; soda water; soya-based beverages, other than milk substitutes; syrups for beverages; syrups for lemonade; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; mineral and aerated waters; carbonated beverages; Fruit-flavoured beverages; Non-alcoholic beers; Orange juice; Melon juice; Alcohol-free beers; Ale; Ales; Aloe juice beverages; Aloe vera drinks; Aloe</i>
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*vera juices; Apple juice beverages; Apple juice drinks; Barley wine [Beer]; Beer; Beer wort; Beer-based beverages; Beer-based cocktails; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking waters; Dry ginger ale; none of the aforesaid products being energy drinks, or containing or mixed with energy drinks or formulated caffeinated drinks and/or being beverages containing taurine and/or caffeine and/or guarana.*

**Class 33**

*Alcoholic beverages (except beer); Preparations for making alcoholic beverages; alcoholic beverages, except beer; alcoholic beverages containing fruit; bitters; brandy; cider; cocktails\*; curacao; digesters [liqueurs and spirits]; distilled beverages; alcoholic essences; alcoholic extracts; fruit extracts, alcoholic; gin; rice alcohol; rum; sake; spirits [beverages]; vodka; whisky; wine; Alcoholic beverages; cooking wine; plum wine; spirits; cocktails; Aperitifs; distilled rice spirits [Awamori]; Sake substitute; Japanese white liquor [Shochu]; Japanese sweet rice-based mixed liquor [Shiro-zake]; Naoshi [Japanese liquor]; Japanese Shochu-based mixed liquor [Mirin]; Japanese Shochu-based beverages [Chuhai]; Chinese liquors in general; liquor flavored with Japanese plum extracts; wine for cooking; sake for cooking; flavored liquors.*

**Opponent's goods**

**The '611 mark**

**Class 33**

*Bourbon.*

**The '089 mark**

**Class 33**

*Alcoholic beverages, except beers; alcoholic preparations for making beverages; spirits and liquors; distilled spirits; distilled beverages; digesters [liqueurs and spirits]; whiskey; blended whiskey; bourbon whiskey; whiskey based liqueurs; flavoured whiskey; flavoured bourbon; wine; cider; aperitifs; gin; vodka; rum; cocktails; pre-mixed alcoholic beverages, other than beer-based.*

**The '622 mark**

Class 21

*Decanters; Napkin holders; Bar mats; Insulated containers for beverage cans for domestic use; Cutting boards; Fruit muddlers; Leather coasters; Cocktail jiggers; Serving trays; Beverage bottle holder.*

**The '628 mark**

Class 21

*Decanters; Napkin holders; Insulated containers for beverage cans for domestic use; Cutting boards; Fruit muddlers; Leather coasters; Cocktail jiggers; Serving trays; Beverage bottle holder.*

17. Where the goods in the specification of one party are included in a broader term from the other party's specification, those goods are considered to be identical: See *Gérard Meric v OHIM*, Case T-133/05 at [29].

18. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

"23. In assessing the similarity of the goods or services concerned, ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary".

19. Additionally, the factors for assessing similarity between goods and services identified in *British Sugar Plc v James Robertson & Sons Limited* ("Treat") [1996] R.P.C. 281 include an assessment of the users and the channels of trade of the respective goods or services.

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 OHIM*, Case T-325/06, the General Court (“GC”) stated that “complementary” means:

“82. ...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

21. For the purposes of considering the issue of similarity of the goods and/or services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.<sup>5</sup>

22. Pursuant to section 60A of the Act, goods (and/or services) are not to be automatically regarded as being similar to each other on the ground that they appear in the same class, nor automatically regarded as dissimilar from each other on the ground that they appear in different classes.

23. In its written submissions in lieu of a hearing, the opponent submits that the broad categories of goods in the ‘089 mark, namely “*Alcoholic beverages, except beers; alcoholic preparations for making beverages*”, are identical to all of the goods covered by the application in class 33. Furthermore, it submits that “*bourbon*”, as covered under the ‘611 mark, is identical or highly similar to the broad categories of goods covered by the application in class 33. The opponent further submits that there is at least some similarity between the opponent’s goods in class 33 and the applicant’s “*beer and brewery products; Alcohol-free beers; Ale; Ales; Barley wine [Beer]; Non-alcoholic beers; Beer; Beer wort; Beer-based beverages; Beer-based cocktails*” in class 32, and at least some similarity between the opponent’s goods in class 33 and the applicant’s non-alcoholic goods in class 32. Finally, the opponent submits that the class 21 goods covered by its ‘622 and ‘628 marks are similar to the applicant’s goods in that they are used in connection with each other and are therefore complementary.

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<sup>5</sup> Paragraph 5

## The contested goods in Class 32

24. I note the limitation at the end of the applicant's class 32 specification, being "*none of the aforesaid products being energy drinks, or containing or mixed with energy drinks or formulated caffeinated drinks and/or being beverages containing taurine and/or caffeine and/or guarana.*" However, none of the goods relied upon by the opponent under any of the earlier marks would fall under the type of goods per se which the limitation seeks to restrict. As such, the negative limitation will have no real bearing on my comparison of the goods at hand.

*Preparations for making beverages; syrups for beverages; syrups for lemonade.*

25. Although the Nice Classification is purely administrative,<sup>6</sup> aside from beers, class 32 essentially covers non-alcoholic beverages and preparations for making non-alcoholic beverages. In *Altecnic Ltd's Trade Mark Application*, the Court of Appeal ("COA") decided that "the registrar is entitled to treat the class number in the application as relevant to the interpretation of the scope of the application, for example, in the case of an ambiguity in the list of the specification of goods."<sup>7</sup> Whilst the term "*Preparations for making beverages*" does not specify exactly what the preparations consist of, given that protection is sought under class 32, the applicant's preparations are interpreted as being non-alcoholic. By the same token, the opponent's "*alcoholic preparations for making beverages*" in class 33 of the '089 mark are similarly unspecified as to exactly what the preparations contain, other than to confirm that they are of an alcoholic nature. I consider that such preparations could also include alcoholic syrups. The opposing goods overlap in intended purpose i.e. both are used in the making of beverages, and there is likely to be an overlap in users, as well in trade channels. There may also be an element of competition between the goods, with the consumer electing either an alcoholic ingredient or a non-alcoholic alternative when preparing its beverage of choice. Taking all of the above into account, I consider the applicant's "*Preparations for making beverages; syrups for beverages; syrups for lemonade*" to be similar to a medium degree to the opponent's

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<sup>6</sup> See *Mould Pro* decision Case T-794/21 at [22-28].

<sup>7</sup> *Altecnic Ltd's Trade Mark Application* [2002] RPC 34 (COA) at [42].

*“alcoholic preparations for making beverages”* under the ‘089 mark. In relation to the earlier ‘611 mark, while the applicant’s preparations and syrups may be used in conjunction with the opponent’s *“bourbon”* in order to make, for example, a bourbon-based cocktail, they are not complementary in a trade mark sense and I see no reason why the consumer would expect the distinct goods to come from the same undertaking. The goods are different in nature and in their fundamental purpose and method of use. I do not consider that any overlap in users or trade channels to be sufficient for a finding of similarity. If there is any similarity at all, then I find it to be to only a very low degree.

*Beer ... ; Ale; Ales; Barley wine [Beer]; Beer; Beer-based beverages; Beer-based cocktails.*

26. There is an overlap in purpose of the applicant’s beer based beverages and the opponent’s *“Alcoholic beverages, except beers”* (the ‘089 mark) and its *“Bourbon”* (the ‘611 mark) inasmuch they are all intended for consumption by adults (i.e. over 18 years of age) and are consumed for pleasure, with a shared method of use, being oral consumption. I consider that while beer may also be consumed in order to quench thirst, the same is unlikely to apply to the likes of spirits and liqueurs. The opposing goods are likely to be positioned in relatively close proximity in physical retail outlets such as supermarkets and off-licences, although not necessarily in the same aisle, as well as being found close together in restaurants and bars. There is an element of competition between the goods, with the consumer making an informed choice between the different alcoholic beverages at issue, although as the taste and content, including the level of alcoholic content, of the goods is quite distinct, in my view, the element of competition is low. I do not consider the goods to be complementary and I do not consider that the average consumer would expect the likes of beers to originate from the same undertaking as other alcoholic beverages such as wines, spirits (including bourbon), cocktails and liqueurs, particularly given their different methods of production. Considered overall, if there is any similarity between the goods at issue, then I find it to be to only a low degree.<sup>8</sup>

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<sup>8</sup> See T-584/10 *Yilmaz v OHIM*, EU:T:2012:518; T-175/06 *Coca Cola v OHIM* [2008] ECR II-1055 (MEZZOPANE); *CALEDONIAN* trade mark case BL O-382-16, at [26].

*Non-alcoholic beers; Alcohol-free beers.*

27. Given my earlier finding of a low degree of similarity, at best, between the applicant's beers and the opponent's "*Alcoholic beverages, except beers*" under the '089 mark and its "*Bourbon*" under the '611 mark, I consider the non-alcoholic beers to be even further removed from the opponent's goods in class 33. Therefore, again taking into account *Yilmaz, et al*, I find the opposing goods to be dissimilar, or at best similar to a very low degree.

*Beer wort.*

28. To my understanding, beer wort is the liquid extracted during the brewing of beer and as such, I consider it to be one step removed from beer itself. Therefore, having already considered the degree of similarity between the applicant's various beer products and the goods relied upon under the opponent's '089 and '611 marks, I find the applicant's "*beer wort*" to be dissimilar to the opponent's goods in class 33.

*... and brewery products.*

29. The above term lacks clarity and could refer to ingredients which fall under class 32 such as "*beer wort*" (see above), or it may relate to various different brewery products that are essentially types of beer or ale, such as porter or stout. As such, for the reasons given earlier under paragraphs 26 and 28 of this decision, I consider "*brewery products*" to be either dissimilar, or, at best, similar to a low degree, to the opponent's goods in class 33 as specified under the '089 and '611 marks.

*Fruit juices / fruit juice; fruit nectars, non-alcoholic; ginger beer / ginger ale; lemonades; smoothies; soda water; soya-based beverages, other than milk substitutes; table waters; tomato juice [beverage]; vegetable juices [beverages]; waters [beverages]; mineral and aerated waters; carbonated beverages; Fruit-flavoured beverages; Orange juice; Melon juice; Aloe juice beverages; Aloe vera drinks; Aloe vera juices; Apple juice beverages; Apple juice drinks; Distilled drinking water; Douzhi (fermented*

*bean drink*); *Drinking mineral water*; *Drinking spring water*; *Drinking water*; *Drinking waters*; *Dry ginger ale*;

30. The above goods are all non-alcoholic beverages or ‘soft drinks’, including various fruit and vegetable juices, waters, smoothies and sodas, which are often intended to hydrate and/or quench thirst. I do not consider the same can be said of the opponent’s various alcoholic beverages in class 33, which are more likely to be imbibed for pleasure. I do not consider that the opposing goods would be found in particularly close proximity in retail premises such as supermarkets (and certainly not in the same aisles), and although there is an overlap in nature and method of use, with all of the goods being drinks which are consumed orally, pragmatically, this is insufficient for a finding of similarity. In *Wesergold Getrankeindustrie GmbH & Co KG v EUIPO*, case T-278/10, the GC held that the Board of Appeal did not make an error of judgement in finding a low level of similarity between spirits at issue in class 33 and the non-alcoholic beverages at issue in class 32,<sup>9</sup> and that the average consumer makes a distinction when comparing spirits with non-alcoholic beverages, even when they choose a beverage on impulse. While the likes of sodas and juices may, of course, be mixed with spirits such as the opponent’s bourbon, I do not consider them to be complementary in a trade mark sense and, as outlined in *Boston Scientific*, I see no reason why the consumer would expect the distinct goods to come from the same undertaking. In *Cooperativa Vitivinícola Arousana v OHMI (ROSALIA DE CASTRO)* [2011], case T-421/10, a low degree of similarity was found between alcoholic and non-alcoholic beverages. I consider that the same rationale could be applied to the opponent’s various alcoholic beverages under the ‘089 mark and its “*Bourbon*” under the ‘611 mark against the applicant’s above-listed goods. In the *ELUX* trade mark case, BL O/0488/25, Phillip Johnson, sitting as Appointed Person, noted that it was worth mentioning R 1720/2017-G *ICEBERG*, 21 January 2019, where the Grand Board found Vodka and non-alcoholic beverages to be dissimilar. In his decision, Mr Johnson upheld the Hearing Officer’s findings of, at best, a very low degree of similarity between drinks including “*Cola*; *Smoothies [fruit beverages, fruit predominating]*; *Waters [beverages]*; *Fruit flavored drinks*; *Fruit drinks*; *Fruit smoothies*; *Frozen fruit beverages*; *Vegetable drinks*; *Iced fruit beverages*; *Fruit*

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<sup>9</sup> At [41].

*flavored soft drinks*” in class 32 and the opponent’s “*vodka*” in class 33. Applying the same reasoning, I consider the applicant’s above-listed goods in class 32 to be similar to a very low degree, at best, to the opponent’s goods in class 33 under both the ‘611 and the ‘089 marks.

#### The contested goods in Class 33

*Alcoholic beverages (except beer); alcoholic beverages, except beer.*

31. The applicant’s above listed goods are self-evidently identical to the opponent’s “*Alcoholic beverages, except beers*” as relied upon under class 33 of the earlier ‘089 mark. I also consider that the applicant’s broad terms would encompass the opponent’s “*bourbon*” as registered under class 33 of the earlier ‘611 mark, rendering the opposing goods identical as per the principle outlined in *Meric*.

*Preparations for making alcoholic beverages.*

32. The above goods are self-evidently identical to the opponent’s “*alcoholic preparations for making beverages*” as relied upon under class 33 of the earlier ‘089 mark. In relation to the opponent’s “*bourbon*” as relied upon under the ‘611 mark, applying the same reasoning as given in paragraph 25 of this decision in relation to the class 32 goods “*Preparations for making beverages*”, I find that if there is any similarity at all, it is to only a very low degree.

*Alcoholic beverages.*

33. The applicant’s broad term “*Alcoholic beverages*” encompasses the opponent’s “*Bourbon*”, as relied upon under the earlier ‘611 mark, as well as encompassing the opponent’s “*Alcoholic beverages, except beers; spirits and liquors; distilled spirits; distilled beverages; digesters [liqueurs and spirits]; whiskey; blended whiskey; bourbon whiskey; whiskey based liqueurs; flavoured whiskey; flavoured bourbon; wine; cider; aperitifs; gin; vodka; rum; cocktails; pre-mixed alcoholic beverages, other than beer-based*”, as relied upon under class 33 of the earlier ‘089 mark. As such, I consider the opposing goods to be identical as per *Meric*.

*Alcoholic beverages containing fruit; bitters; brandy; cider; cocktails\*;<sup>10</sup> curacao; digesters [liqueurs and spirits]; distilled beverages; gin; rum; sake; spirits [beverages]; vodka; whisky; wine; plum wine; spirits; cocktails; Aperitifs; distilled rice spirits [Awamori]; Sake substitute; Japanese white liquor [Shochu]; Japanese sweet rice-based mixed liquor [Shiro-zake]; Naoshi [Japanese liquor]; Japanese Shochu-based mixed liquor [Mirin]; Japanese Shochu-based beverages [Chuhai]; Chinese liquors in general; liquor flavored with Japanese plum extracts; flavored liquors.*

34. All of the above-listed goods may be taken as a form of alcoholic beverage and are therefore *Meric*-identical to the broad term “*Alcoholic beverages, except beers*” as relied upon by the opponent under the ‘089 mark. Some of the broader terms included above, namely, “*distilled beverages; spirits [beverages]; spirits*”, would also encompass the opponent’s “*bourbon*” under the earlier ‘611 mark and as such are also identical as per *Meric*. For the applicant’s remaining goods, above, I consider them to be similar in nature to the opponent’s “*bourbon*” under the earlier ‘611 mark, in as much they all contain alcohol and may be consumed orally for pleasure, with an overlap in users and channels of trade. Therefore, I find those goods similar to “*bourbon*” to a medium degree.

*Alcoholic essences; alcoholic extracts; fruit extracts, alcoholic; rice alcohol.*

35. I consider that all of the above goods may be used in making other alcoholic beverages and are therefore encompassed under the opponent’s broad term “*alcoholic preparations for making beverages*” as included under the class 33 specification of the opponent’s ‘089 mark. As such, the goods are identical as per *Meric*. In relation to the opponent’s “*bourbon*” as relied upon under the earlier ‘611 mark, as the applicant’s alcoholic essences and extracts could be derived from bourbon, it would not be unreasonable for the average consumer to assume that the goods all originate from the same undertaking. I consider these goods to be highly similar. However, the “*fruit extracts, alcoholic; rice alcohol*” are one step removed

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<sup>10</sup> As there is no corresponding submission in relation to cocktails, I assume the asterisk to be an erroneous entry in the listed specification of goods .

from the finished bourbon product, and they would each have different taste profiles. Without evidence to the contrary, overall I consider “*fruit extracts, alcoholic; rice alcohol*” to be dissimilar to the opponent’s “*bourbon*”, or at best, similar to a very low degree.

*Cooking wine; wine for cooking; sake for cooking.*

36. While the above listed goods are all qualified as being specifically for cooking purposes, they are still a variant of wine or alcoholic beverage (with sake being a Japanese alcoholic drink made from rice), although they are not recommended to be consumed as a beverage. Therefore, both the intended purpose and the method of use are different to the opponent’s “*Alcoholic beverages, except beers; alcoholic preparations for making beverages*” under the ‘089 mark or its “*bourbon*” under the ‘611 mark. While there is an overlap in trade channels, the goods are unlikely to be found in the same aisle in physical retail outlets such as supermarkets, and the goods are neither complementary nor in competition. Consequently, I consider that the opposing goods are similar to only a low degree.

The ‘622 mark and the ‘628 mark.

37. With regards to the opposed goods in both class 32 and class 33, I disagree with the opponent’s submissions that the class 21 goods covered by its ‘622 and ‘628 marks are similar to the applicant’s goods in that they are used in connection with each other and are therefore complementary. While there may be an overlap in users with the likes of, inter alia, the opponent’s “*Decanters*”, “*Insulated containers for beverage cans for domestic use*” and “*Serving trays*”, the physical nature of the goods is different, as are their respective uses. The goods are not in competition, and although they could be used together, I do not consider them to be complementary. As Mr Daniel Alexander Q.C. (as he then was) noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Holdings Limited* BL-O-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.”<sup>11</sup>

I do not consider that the goods would be found in particularly close proximity in retail premises such as supermarkets, and pragmatically, I consider that any overlap between them is insufficient for a finding of similarity. In *Unicorn Studio Inc v Veronese* Case CH-2023-000214, Iain Purvis, KC, sitting as deputy High Court judge, stated that any finding of similarity requires the exercise of common sense.<sup>12</sup> Taking a realistic approach to the comparison of these particular goods, I find the goods at issue to be dissimilar.

38. Under section 5(2)(b), a degree of similarity between the goods is essential for there to be a finding of likelihood of confusion: see paragraph 49 of *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA. In relation to the goods which I have found to be dissimilar,<sup>13</sup> as there can be no likelihood of confusion under section 5(2)(b), I will take no further account of such goods, with the opposition failing to that extent.

39. Given my finding that the goods relied upon under the '622 mark and the '628 mark are dissimilar to the applicant's opposed goods, there can be no likelihood of confusion under section 5(2)(b). The net effect of my findings in relation to these two earlier marks is that the opposition under section 5(2)(b) fails at the first hurdle in that any level of similarity between the goods at issue has not been established.

40. From this point forward I will base my decision on the likelihood of confusion between the applicant's mark against the earlier '611 and '089 marks.

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<sup>11</sup> Paragraph 18.

<sup>12</sup> At [24].

<sup>13</sup> With the proviso that if I am wrong in my assessment that the goods are at best similar to only a low or very low degree.

## **The average consumer and the nature of the purchasing act**

41. The average consumer is a legal construct, deemed to be reasonably well informed and reasonably circumspect: see *Hearst Holdings Inc & Anor v A.V.E.L.A. Inc & Ors*, [2014] EWHC 439 (Ch), paragraph 60. For the purpose 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 or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97, at [26].

42. The opponent submits that the goods are directed at the public at large and that the level of attention will be average, or just above average, but not high.<sup>14</sup>

43. The overlapping goods at issue are predominantly alcoholic and non-alcoholic beverages and preparations used in their production. The average consumer of the goods will be the general public, although insofar as alcoholic drinks are concerned, they will be adults over the age of 18. They will include connoisseurs alongside 'pleasure drinkers' whose knowledge will be more rudimentary, both of whom may purchase the goods for consumption at home or in a social setting such as a bar or restaurant. The goods will also be purchased by buyers for venues such as public bars and restaurants.

44. The goods are sold through a range of channels including wholesale outlets and retail outlets such as supermarkets and off-licences, as well as through specialist suppliers and online. In bricks and mortar stores, the goods will be sold on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The goods will also be sold in restaurants, bars and public houses, where they are likely to be displayed behind the counter or listed on a drinks menu. Considered overall, the selection process is predominantly visual, although I do not discount aural considerations, particularly in bars and restaurants, where the goods may also be selected and requested verbally. I bear in mind the comments of the GC in *Simonds Farsons Cisk plc v OHIM*, Case T-3/04, who said:

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<sup>14</sup> At points 24-25 of the written submissions in lieu of a hearing.

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

45. The value of the goods, which are likely to be purchased on a semi-regular basis by the general public, will vary in price but are generally considered to be relatively inexpensive. I accept that high-end spirits will be more expensive than the likes of soft drinks, which may give rise to an elevated degree of attention being paid to such goods. In my view, neither alcoholic nor non-alcoholic drinks are commonly highly-considered purchases. I consider that the general public will base their selection on personal taste and whim at the time of purchase, as well as the particular occasion for which it is being purchased, and that overall they will pay a medium level of attention during the selection process, with the professional buyer paying a slightly higher degree of attention.

### **Comparison of marks**



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

"34. ....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.”

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

48. The respective trade marks are shown below:

Opponent’s trade marks	Applicant’s trade mark
<p data-bbox="204 882 416 916"><u>The ‘611 mark</u></p> <p data-bbox="341 967 707 1010"><b>BUFFALO TRACE</b></p>	
<p data-bbox="204 1140 416 1173"><u>The ‘089 mark</u></p> 	

**Overall impression**

49. The opponent’s ‘611 mark consists of the words “BUFFALO TRACE”, presented in capital letters in a standard black typeface, with no other elements to contribute to the overall impression. I do not consider that either word dominates, therefore, the overall impression of the mark rests in the mark as a whole.

50. The opponent’s ‘089 mark comprises the stylised words “BUFFALO TRACE”, presented side by side in capital letters in a 3D-effect typeface. The first letter of each

word, being the letters B and T respectively, are in a slightly larger font size to the remaining letters of each word. The words are separated by a device element in the form of a line drawing which I consider will be perceived to be a buffalo, with the shoulders emanating from the top of the last three letters of the word BUFFALO. The animal is incomplete in that the rear end and legs are not visible, while the head is positioned in the space between the two words “BUFFALO” and “TRACE”. Again, I do not consider that either of the word elements dominate. Given that the depiction of the buffalo is incorporated between the word elements, in my view the overall impression of the mark rests in the combination of the word and device elements.

51. The applicant’s mark consists of the words “BUFFALO BRAND”, presented in capital letters in a standard black typeface within a thin, uneven rectangular border, which gives the appearance of a label. Above the wording is an artistic impression in silhouette of a person playing what appears to be a musical instrument,<sup>15</sup> sat on the back of a buffalo. The buffalo and ‘rider’ are encased in an incomplete circle which is conjoined with the top of the label element containing the word elements.<sup>16</sup> Although in many instances of composite words and device marks it is the words which dominate,<sup>17</sup> in this case, given the size and prominent position of the device element, I consider that the device and the words play an equal role in the overall impression of the mark.

52. It is well-established that the beginning of words tend to have more visual and aural impact than the ends,<sup>18</sup> although I accept that this is not always the case.

### **Visual comparison**

53. In the written submissions in lieu of a hearing, referring to the *Matratzen* decision (Case T-6/01, paragraph 30), the opponent submits that two marks are similar when,

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<sup>15</sup> I acknowledge the applicant’s submissions that the instrument represents a flute.

<sup>16</sup> I note that the mark includes the ® symbol which is conventionally used to designate that a trade mark has been registered, although at the time of writing this decision, the application had not been registered. The symbol does not form part of the mark itself and as such, I take no account of it in my comparison of the marks at hand.

<sup>17</sup> *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, at [37].

<sup>18</sup> See, inter alia, *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02; *Trubion Pharmaceuticals, Inc. v OHIM*, Case T-412/08; and Case T-109/07L’Oréal v OHIM – *Spa Monopole (SPA THERAPY)* [2009].

from the point of view of the relevant public, they are at least partly identical as regards one or more relevant aspects.<sup>19</sup> I note that in the following paragraph of that same decision, (paragraph 31), it goes on to say that “However, that finding is not in itself a sufficient basis for holding that the two trade marks in question, each considered as a whole, are similar.” (My emphasis).

#### The ‘611 mark

54. Both marks consist of two separate words, with the first word of each being the identical word “BUFFALO”. The second word in each mark is different, being “TRACE” in the opponent’s mark and “BRAND” in the applicant’s mark, which creates a visual disparity, as does the additional device element present only in the applicant’s mark, as described above under paragraph 51. Taking into account the differences and similarities between the marks, including that the identical word element “BUFFALO” is positioned at the start of the verbal elements in each of the marks, I consider the marks to be visually similar overall to a low to medium degree.

#### The ‘089 mark

55. The opposing marks both contain the identical word “BUFFALO”, positioned at the start of the verbal element of each mark, although the second word in each mark is different. The words in the opponent’s mark are presented to give a 3D effect. While both marks include an artistic impression of a buffalo, these illustrations are visually distinct from one another. The buffalo in the opponent’s mark is incomplete, showing the animal’s head and shoulders only, while the applicant’s device incorporates the whole animal and has the additional element of a person sat on its back playing the flute. While I accept that the average consumer does not tend to break down the various details of a mark, I consider that they would readily distinguish the differences between the buffalo illustrations present in each mark. Further, the buffalo devices are situated in noticeably different positions within the marks as a whole, being intrinsically integrated between the words in the case of the opponent’s mark, while in

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<sup>19</sup> Point 35 of the written submissions.

the applicant's mark, it is positioned centrally above the word elements. Overall, I consider the marks to be visually similar to a low to medium degree.

### **Aural comparison**

56. The figurative element in the opponent's '089 mark would not be voiced, therefore the two earlier marks would be pronounced identically, as four syllables, BUFF-UH-LOW-TRAYSS. Neither do I consider that the device element in the applicant's mark would be articulated, the mark being pronounced as four syllables, BUFF-UH-LOW-BRAND. The common element, at the start of each mark, is the word "BUFFALO", which would have the same pronunciation in all of three marks. The fourth and final syllable differs between the applicant's mark and the opponent's '089 and '611 marks, resulting in aural commonality between the first three syllables only of the competing marks. Overall, I consider the marks to be aurally similar to a medium degree.

### **Conceptual comparison**

57. For a conceptual message to be relevant, it must be capable of immediate grasp by the average consumer - Case C-361/04 P *Ruiz-Picasso and others v OHIM* [2006]<sup>20</sup>.

58. I acknowledge the applicant's submissions in the counterstatement that its composite mark draws inspiration from Vietnamese culture, and that the water buffalo holds national importance in that culture. It further submits that the inclusion of the symbol is essential in effectively conveying the nature of the products that it intends to offer, particularly Vietnamese (food and) beverages. However, the goods at issue being provided under the brand are largely everyday goods which are targeted towards the UK consumer, rather than goods specific to a niche Vietnamese enclave within the UK. In my view, a significant proportion of consumers are unlikely to attribute any symbolic importance to the device element. Instead, they are likely to see the buffalo device as merely reinforcing the name of the brand.

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<sup>20</sup> Paragraph 56.

59. The word “BUFFALO”, present in each of the marks, will be identified by the average consumer as a type of animal. As mentioned in paragraph 10 of this decision, the applicant has submitted that the word is “generic”. By this, I interpret that the applicant is referring to the fact that the word is a well-known, dictionary-defined word in English, rather than being an invented word.

60. To my mind, although the respective “buffalo” illustrations in the opponent’s ‘089 mark and the applicant’s mark are quite different, the average consumer will see the individual depictions as each reinforcing the word element “BUFFALO” within the marks as a whole, and as such there is a conceptual overlap in this respect.

61. The word “BRAND” in the applicant’s mark has various different defined meanings. In this instance, and in the absence of any submissions by either party to the contrary, I consider that it will be seen by a significant proportion of consumers as qualifying the “BUFFALO” element as the name used on the goods to identify the provider (i.e. the “BUFFALO” trade mark/brand). As such, in combination with the distinctive word “BUFFALO”, the “BRAND” element will be seen as non-distinctive.

62. In relation to the opponent’s marks, the dictionary defined word “TRACE” has various meanings, including “to find (something) after investigation”; “to copy (the outline of a pattern or shape)”; or “a very small quantity (of something)”. The opponent has not provided any submissions on the concept of the combined words which make up the marks, but submits that the “BUFFALO” element dominates the meaning of its marks and that the additional “TRACE” element in the earlier marks and the “BRAND” element in the applicant’s mark do not alter the meanings of the marks overall.<sup>21</sup> In whichever way the word “TRACE” is interpreted, to my mind, the words “BUFFALO” and “TRACE” do not naturally fit together, and are equally dominant and distinctive.<sup>22</sup>

63. The additional word “TRACE” in the earlier marks serves to create a point of conceptual disparity between the competing marks overall, as does the additional element of a person playing a musical instrument in the applicant’s mark. Taking these

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<sup>21</sup> Point 42 of the written submissions in lieu of a hearing.

<sup>22</sup> *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

differences into consideration, as well as the presence in each of the identical word “BUFFALO”, I consider that overall, the marks share a medium degree of conceptual similarity.

### **Distinctive character of the earlier marks**

64. The distinctive character of a trade mark can be appraised only, first, by reference to the goods 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. The factors I must take into account in assessing the level of distinctive character were set out by the CJEU in *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97:

“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).”

65. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. The opponent has not claimed that its mark has enhanced distinctiveness and no evidence has been filed. Therefore, I only have the inherent characteristics of the mark to consider.

66. I take into account that the assessment of the distinctive character of trade marks for the purposes of assessing whether there is a likelihood of confusion between them

must be assessed from the perspective of the average consumer in the relevant territory.<sup>23</sup> It is the distinctiveness of the common element that is important here: *Kurt Geiger v A-List Corporate Limited*, BL O/075/13.<sup>24</sup>

67. The '611 mark comprises the words "BUFFALO TRACE". At paragraph 49 of this decision, I considered the words to be equally dominant and distinctive. However, it is the word "BUFFALO" which is the common element with the applicant's mark. I do not consider either the combined words, or the word "BUFFALO" when taken solus, to be descriptive or allusive in relation to the goods themselves. Overall, I consider the mark to be inherently distinctive to a medium degree.

68. The '089 mark comprises the same two words "BUFFALO TRACE", with the additional buffalo device element, which as mentioned earlier in this decision, I consider merely reinforces the perception of the "BUFFALO" element as an animal. Therefore, for the same reasons given above in relation to the words only mark, I consider the '089 mark to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

69. There is no simple formula for determining whether there is a likelihood of confusion. It is clear that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them 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 (*Canon* at [17]). I must consider the various factors from the perspective of the average consumer, bearing 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]).

70. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer recognises

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<sup>23</sup> *Matratzen Concord AG v OHIM*, Case T-6/01 at [27].

<sup>24</sup> At [39].

that the marks are different, but assumes that the goods and/or services are the responsibility of the same or connected undertakings. The distinction between these was explained by Mr Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

“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.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

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

71. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

72. Earlier in this decision, I found the goods relied upon under the '622 mark and the '628 mark to be dissimilar to the applicant's opposed goods, and therefore there could be no likelihood of confusion between the marks under section 5(2)(b). For the remaining '611 and '089 marks, I found that the contested goods ranged between self-evidently identical/identical as per the principle set out in *Meric* to dissimilar (or as an alternative, at best similar to only a low or very low degree) to the opponent's goods. I considered that the selection process for the overlapping goods would be made by predominantly visual means, although I did not discount oral considerations, and that the general public would pay a medium level of attention, at lowest, during the selection process, with the professional buyer paying a slightly higher degree of attention. I considered the applicant's mark to be visually similar to the '611 mark to a low to medium degree; to be aurally similar to a medium degree; and to be conceptually similar overall to a medium degree. I considered the applicant's mark to be visually similar to the '089 mark to a low to medium degree; to be aurally similar to a medium degree; and to be conceptually similar to a medium degree. I found the earlier marks to each possess a medium degree of inherent distinctive character.

#### The '611 mark.

73. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. I take into account the medium degree of inherent distinctive character of the earlier mark and the medium degree of attention (at its lowest) of the general public as the average consumer of the goods. I also factor in the degree of visual similarity and the conceptual overlap of the marks conveyed through the word "BUFFALO" in the combined words "BUFFALO TRACE" in the '611 mark. In *Matratzen*, it was held that a complex trade mark cannot be regarded as being similar to another trade mark which is identical or similar to one of the components of the complex mark, unless that component forms the dominant element within the overall impression created by the

complex mark.<sup>25</sup> As mentioned previously, given the size and prominent position of the device element in the applicant's mark, I consider that neither the word elements nor the device element dominates the mark as a whole. As such, the presence of the device in the applicant's mark will not be overlooked or forgotten by the average consumer. Therefore, I do not consider there to be any likelihood of direct confusion, even where the respective goods are held to be identical, as per *Meric*, which offsets a lesser degree of similarity between the marks.

### The '089 mark

74. Turning to the opponent's '089 mark, I have weighed up each of the competing factors in my decision, taking into account both the differences and the similarities between the competing marks, including the degree of visual, aural and conceptual similarity between them, as identified above, all of which play a part. While allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that the average consumer would mistake one mark for the other. In my view, the average consumer will notice and recall the differences, and in particular the visual differences, between the marks. I find this even where the respective goods are held to be identical. Overall, I do not consider there to be any likelihood of direct confusion.

75. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. (as he then was), in *L.A. Sugar*, I will now consider whether there might be a likelihood of indirect confusion. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

76. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, Lord Justice Arnold referred to the comments of James Mellor QC (as he then was) sitting as the Appointed Person in *Cheeky Italian Ltd v*

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<sup>25</sup> *Matratzen Concord GmbH v OHIM*, Case T-6/01 ECLI:EU:T:2002:261, at [33].

*Sutaria* (O/219/16), where he said (at [16]) that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Lord Justice Arnold added that there must be "a proper basis" for concluding that there is a likelihood of indirect confusion when there is no likelihood of direct confusion.

77. I acknowledge that the categories listed by Mr Iain Purvis Q.C. (as he then was) are not exhaustive. Having made a multi-factorial assessment of the various considerations in play, although each of the marks share the same word "BUFFALO", and for some consumers, sight of one mark may bring to mind the other mark, I do not believe that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark. Particularly in relation to the earlier '089 mark, it would be highly unusual for a company to rebrand its mark or launch a sub-brand by changing the pictorial elements to such an extent. I say this because the buffalo illustration in each of the marks is a noticeably different beast, albeit that they both represent a buffalo. I find no likelihood of indirect confusion in relation to either of the earlier marks.

78. The opposition under section 5(2)(b) of the Act fails in its entirety.

## **CONCLUSION**

79. The applicant has been wholly successful. Subject to any successful appeal, the application by Longdan Ltd may proceed to registration in its entirety.

## **COSTS**

80. As the applicant has been successful, it is, in principle, entitled to a contribution towards its costs. For parties without professional representation, as outlined in Tribunal Practice Notice ("TPN") 1/2023, such costs would be based on £19 per hour, reflecting the number of hours spent on the different stages of the opposition. In a letter to the parties dated 6 November 2024, the Tribunal invited the unrepresented applicant to indicate whether he wished to make a request for an award of costs and, if so, to complete and return the attached costs pro-forma by **4 December 2024**. The

letter stated that “If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded. You must include a breakdown of the actual costs, including accurate estimates of the number of hours spent on each of the activities listed and any travel costs”. As the pro-forma was not returned, and as no official fees have been incurred in defence of the application, I make no order as to costs in this case.

**Dated this 19<sup>th</sup> day of August 2025**

**Suzanne Hitchings  
For the Registrar,  
the Comptroller-General**