

O/0764/25

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003936729

BY UNICORN GLOBAL LIMITED

TO REGISTER:



AS A TRADE MARK IN CLASSES 32, 33 & 35

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 444108 BY

MAISON A.E. DOR

## BACKGROUND AND PLEADINGS

1. On 21 July 2023, UNICORN GLOBAL LIMITED (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK (“the applicant’s mark”). The applicant’s mark was published for opposition purposes on 11 August 2023 and registration is sought for following goods and services:

Class 32: Flavoured carbonated beverages; Juices; Waters; Alcohol free wine; Cocktails, non-alcoholic; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit cocktails; non-carbonated soft drinks; Soft drinks; Beer and brewery products; Preparations for making beverages; Beverages containing vitamins; Aperitifs, non-alcoholic; Nut and soy-based beverages; Nutritionally fortified beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic malt drinks.

Class 33: Alcoholic extracts; alcoholic bitters; alcoholic essences; alcoholic beverages except beers; alcoholic malt coolers; alcoholic cocktail mixers; alcoholic beverages containing fruit; hydromel; mead; perry and rice alcohol; Wine; piquette; red wine; white wine; sparkling wine; port wines; cooking wine; wine punches; wine coolers being beverages; makgeolli; fortified wines; mulled wine and champagne; Alcoholic cider; hard cider and dry cider; Premixed beverages; alcoholic cocktails; cocktail mixes; alcoholic fruit extracts; prepared cocktails; prepared wine cocktails; rum punch; alcoholic daiquiri mixes; alcoholic eggnog mixes; alcoholic margarita mixes; and alcoholic mojito mixes; Spirits; liquor; anise liqueur; anisette; arrack; brandy; curacao; distilled alcoholic beverages; gin; kirsch; liqueurs; peppermint liqueurs; rum; vodka; whisky; tequila; soju and Korean distilled spirits.

Class 35: Advertising, marketing and promotional services; advertising; outdoor advertising; layout services for advertising purposes; production of advertising films; Product demonstrations and product display services; demonstration of goods; presentation of goods on communication media for retail purposes; trade show and exhibition services for promotional purposes; organization of exhibitions for commercial or advertising purposes; organization of trade fairs for commercial or advertising purposes; Provision of advertising space, time and media; rental of advertising space; rental of advertising time on communication media; Distribution of advertising; marketing and promotional material; advertising by mail order; direct mail advertising; dissemination of advertising matter; distribution of samples; advertising, marketing and promotional; Commercial trading and consumer information services; administrative processing of purchase orders; Business assistance, management and administrative services; Business consultancy and advisory services; business management consultancy; business management and organization consultancy; business organization consultancy; professional business consultancy; advisory services for business management; Market research; marketing research and marketing studies; opinion polling; Collection and systematization of business data; compilation of statistics.

2. On 13 November 2023, the applicant's mark was partially opposed by Maison A.E. DOR ("the opponent"). The opposition is aimed at the applicant's class 32 and 33 goods only and is based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The section 5(2)(b) ground is reliant upon the following mark:

A.E. DOR

UK registration no. 902543866<sup>1</sup>

Filing date 11 January 2002; registration date 23 May 2003

Relying on all goods, namely:

Class 33: Cognac, alcoholic beverages containing cognac, armagnacs,  
rum.

("the opponent's mark").

3. Under this ground, the opponent claims that the marks at issue are similar and that the goods at issue are either identical or similar. Further, the opponent claims that thanks to the use of its mark, it enjoys an enhanced degree of distinctive character. As a result, the opponent argues that there exists a likelihood of confusion between the parties' marks.
4. Under the section 5(4)(a) ground, the opponent relies on the following sign:



5. The opponent claims that it has been using the above sign throughout the UK since no later than July 2015. It is claimed that the opponent enjoys goodwill in the above sign as a result of its use on the following goods:

Class 33: Alcoholic beverages, except beer; cognac; alcoholic beverages  
containing cognac; Armagnacs.

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<sup>1</sup> The opponent's mark is a comparable mark based on an earlier EUTM. On 1 January 2021, in accordance with Article 54 of the Withdrawal Agreement between the UK and the European Union, the UK IPO created comparable UK trade marks for all right holders with existing EUTMs. These comparable marks enjoy the same filing and registration dates as their EU counterparts.

6. The opponent's position is that use of the applicant's mark for the contested goods will deceive consumers into believing that the applicant's goods originate from the opponent. It is claimed that this misrepresentation creates a risk of damage to the opponent in the form of lost sales and dilution as well as a risk of reputational harm.
7. The applicant filed a counterstatement wherein it denied the claims against it and requested that the opponent provide proof of use of its mark.
8. The applicant is represented Punyadi Kankanige Perera and the opponent is represented by Wynne-Jones IP Limited. Both parties filed evidence in chief with the opponent also electing to file submissions in reply. No hearing was requested and only the opponent filed written submissions in lieu of the same. This decision is taken after careful consideration of the papers.
9. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

10. The opponent's evidence came in the form of the witness statement of Nicolas Mandon dated 15 April 2024. Mr Mandon is an Export Director of MAISON ANSAC, trading as the opponent. This is a position he has held since February 2023. Prior to that, Mr Mandon held various roles within the company from September 2017 onwards. Mr Mandon's evidence is accompanied by six exhibits, being NM1 to NM6, and was adduced in order to prove that the opponent has genuinely used its

mark and that the business enjoys a level of protectable goodwill in the sign relied upon.

11. The applicant's evidence came in the form of the witness statement of Kshitij Dhupar dated 17 June 2024. Kshitij Dhupar is the director of the applicant. Their statement is not accompanied by any exhibits and I note that it does not include any statement of fact. Instead, it consists solely of written submissions. While filed as evidence, I will treat it as written submissions and will refer to it as such.

12. I do not intend to summarise the evidence (or submissions) in full here. However, I confirm that I have taken all filed documents into account and will summarise them to the extent that I deem necessary below.

## **DECISION**

### **Proof of use**

13. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark or international trade mark (UK) 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected

international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired.

[...]

(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.”

14. Section 6A is also relevant. It reads:

“(1) This section applies where:

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

15. Section 100 of the Act is also relevant. It reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

16. As the opponent’s mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A to the United Kingdom include the European Union”.

17. Given its filing date, the opponent’s mark qualifies as an earlier trade mark under the above provisions. The opponent’s mark completed its registration process over five years prior to the filing date of the application. As set out above, the applicant requested that the opponent provide proof of use in respect of its mark. As a result, the opponent’s mark is subject to the proof of use assessment.

18. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create

or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

19. In accordance with section 6A of the Act (cited above), the relevant period for the present assessment is the five-year period prior to the filing date of the applicant’s

mark, being 21 July 2023. The relevant period is, therefore, 22 July 2018 to 21 July 2023 (“the relevant period”). As set out above, use in the EU is relevant prior to IP Completion Day, being 31 December 2020.

20. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real”<sup>2</sup> because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark” is, therefore, not genuine use.

### Evidence of use

21. Having considered the evidence before me, I am of the view that I can deal with the issue of genuine use relatively briefly. I say this because, firstly, the evidence filed is not particularly extensive. Secondly, and more importantly, the opponent has provided specific UK sales figures related to its ‘A.E. DOR’ cognac goods between 2019 and 20 July 2023. These are as follows:

Year	Units Sold	Revenue (€)
2019	857	28,137.96
2020	300	6,108.90
2021	972	31,890.56
2022	1,300	43,070.32
2023 (to 20 July)	401	13,301.28
<b>Total</b>	<b>3,830</b>	<b>122,509.02</b>

22. What is referred to as a small selection of invoices is provided in support of this evidence.<sup>3</sup> I do not intend to summarise these in full but note that they include invoices from within the relevant period and show sales to the opponent’s UK distributor, being ‘Speciality Brands Limited’.

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<sup>2</sup> *Jumpman* BL O/222/16

<sup>3</sup> NM2

23. In addition, I note that the opponent has provided screenshots from its website showing how its goods are packaged.<sup>4</sup> The screenshots were obtained by the internet archive facility, The Wayback Machine. The first screenshot is from prior to the commencement of the relevant period but the second is dated 6 May 2021 (within the relevant period) and shows bottles of cognac that are labelled in the following ways:



24. Additional printouts are provided that show similarly branded goods listed for sale via Selfridges, the Whisky Exchange, Hedonism Wines and Master of Malt.<sup>5</sup> While noted, the Selfridge screenshot is not from within the relevant period. On this point, however, I note that the narrative evidence sets out that the goods shown in that screenshot are a reflection of how they appear on that website from 2018 to the present day.

25. Lastly, there is evidence relation to the opponent's attendance at 'the Cognac Show', which takes place in London. The opponent confirms that it has attended this event several times since 2018. Evidence regarding this event and documents confirming the opponent's attendance is provided.<sup>6</sup> While this is noted, there is nothing before me to suggest whether this event is aimed at the trade or the relevant public. Further, no evidence has been provided that demonstrates the reach of these events and neither is there anything to suggest that the opponent sold goods at these events or that it achieved an elevated level of sales thereafter. As such, I do not consider that this evidence is of any real assistance.

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<sup>4</sup> NM3a

<sup>5</sup> NM3b to NM3e

<sup>6</sup> NM6

## Assessment of evidence

26. Before assessing whether the use before me is genuine or not, I wish to briefly set out that the evidence predominantly shows use of the branding as it appears at paragraph 23 above. While these examples show the wording 'A.E. DOR' in a slightly stylised manner, I remind myself that, as a word only mark, the opponent's mark is capable of being used in any standard typeface. In my view, this fair and notional use extends to the way these words are presented in the evidence. Further, the wording appears as part of a larger composite mark. On this point, I refer to the case of *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, wherein the Court of Justice of the European Union ("CJEU") set out that use of a mark generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark. Taking this into account, I find that the way in which the opponent has used its mark is use of the mark as registered.

27. Moving to assess the level of use filed, I remind myself that it covers the sale of 3,380 bottles of cognac during the relevant period for a total turnover of €122,509. While the figures are provided in euros, the evidence confirms that this use relates to the UK only. While I consider it to be a low level of use, especially in the context of the relevant market,<sup>7</sup> the case law sets out that use need not be quantitatively significant in order for it to be deemed genuine. Instead, the opponent is only required to prove that it attempted to create or preserve a market share for the relevant goods. In the present case, having taken all of the evidence into account, I am of the view that while the level of use is low and there is no evidence as to advertising or marketing efforts undertaken by the opponent (beyond the Cognac Event which, as above, is of little assistance), the sale of over 3,000 bottles of

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<sup>7</sup> While I have no evidence on this point, I am of the view that while the UK market for 'cognac' is not very large, it is likely to still be relatively significant in size.

cognac in the UK is sufficient in order to give rise to a finding that the opponent has genuinely used its mark during the relevant period.

28. While I am satisfied that there has been genuine use of the opponent's mark, I do not consider that this finding extends to all of the goods relied upon. On this point, I remind myself that the opponent's specification is as follows:

Class 33: Cognac, alcoholic beverages containing cognac, armagnacs, rum.

29. It is clear from the evidence before me that the opponent's use extends to cognac only. There is no evidence before me showing use of the mark on any beverages that contain rum or Armagnac. Further, 'alcoholic beverages containing cognac' is, in my view, a term that describes something like a pre-made cocktail with cognac as an ingredient and not simply 'cognac' itself. There is nothing in the evidence to suggest any use of such goods or anything else that could be said fall within this term.

30. In light of the above, I consider it appropriate to limit the opponent's specification so that it may proceed in reliance upon "cognac" only. In the present circumstances, I consider that this is a fair specification that accurately reflects the opponent's use.

### **Section 5(2)(b): legislation and case law**

31. Section 5(2)(b) of the Act reads as follows:

"(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 or association with the earlier trade mark.”

32. Section 5A of the Act states as follows:

“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.”

33. The following principles 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 Harmonization 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 great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

**Comparison of goods**

34. The competing goods are as follows:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
<p><u>Class 33</u> Cognac.</p>	<p><u>Class 32</u> Flavoured carbonated beverages; Juices; Waters; Alcohol free wine; Cocktails, non-alcoholic; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit cocktails; non-carbonated soft drinks; Soft drinks; Beer and brewery products; Preparations for making beverages; Beverages containing vitamins; Aperitifs, non-alcoholic; Nut and soy-based beverages; Nutritionally fortified beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic malt drinks.</p> <p><u>Class 33</u> Alcoholic extracts; alcoholic bitters; alcoholic essences; alcoholic</p>

	beverages except beers; alcoholic malt coolers; alcoholic cocktail mixers; alcoholic beverages containing fruit; hydromel; mead; perry and rice alcohol; Wine; piquette; red wine; white wine; sparkling wine; port wines; cooking wine; wine punches; wine coolers being beverages; makgeolli; fortified wines; mulled wine and champagne; Alcoholic cider; hard cider and dry cider; Premixed beverages; alcoholic cocktails; cocktail mixes; alcoholic fruit extracts; prepared cocktails; prepared wine cocktails; rum punch; alcoholic daiquiri mixes; alcoholic eggnog mixes; alcoholic margarita mixes; and alcoholic mojito mixes; Spirits; liquor; anise liqueur; anisette; arrack; brandy; curacao; distilled alcoholic beverages; gin; kirsch; liqueurs; peppermint liqueurs; rum; vodka; whisky; tequila; soju and Korean distilled spirits.
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35. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

36. 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.

37. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court stated that:

“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.”

38. I have submissions from both parties in respect of the goods comparison. While I do not intend to repeat those here, there is one point I wish to discuss here. This relates to a claim in the applicant's submissions that the opponent's goods are of a different nature to its own because they are age-restricted and targeted at wealthy adults. The former point is not accurate as some of the applicant's own goods are alcoholic beverages so will also be age restricted. As for the latter point, this appears to have been raised on the basis that, in its evidence, the opponent's goods are shown as costing upwards of £100 per bottle<sup>8</sup> (with one even being shown as costing £8,000).<sup>9</sup> While the opponent may sell more expensive goods, this is not reflected in its specification meaning that this has no bearing on the assessment I must make. I say this because when considering the likelihood of confusion under Section 5(2)(b), the assessment must be based, in fact, on the concept of 'notional and fair use' which involves carrying out the comparison of the goods based on the specifications before me, not the goods effectively provided by the parties.<sup>10</sup>

39. For the avoidance of doubt, I can confirm that I have taken all of the submissions of the parties into account in making my comparison.

### Class 32

*Flavoured carbonated beverages; Juices; Waters; Non-alcoholic beverages containing fruit juices; Non-alcoholic fruit cocktails; non-carbonated soft drinks; Soft drinks; Beverages containing vitamins; Nut and soy-based beverages; Nutritionally fortified beverages; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic malt drinks.*

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<sup>8</sup> See NM3d and NM3e

<sup>9</sup> See NM3c

<sup>10</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06 at [66] and *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41 at [22]

40. The above goods all overlap in nature and method of use with the opponent's good, being "cognac". I say this because they all cover drinkable liquids. That being said, any overlaps here are limited due to their alcoholic content (or lack thereof). I appreciate that alcoholic drinks may be consumed for refreshment purposes, however, it is my understanding that they are commonly consumed at least partly for the effect of the alcohol. The purpose of the goods may, therefore, be somewhat similar, but I do not discount the fact that they differ in a key respect. I do not consider there to be any meaningful competition on the basis that while consumers are likely to choose between some types of alcoholic drinks, they are unlikely to choose between cognac and a range of non-alcoholic drinks such as juices and malt drinks, for example. I do not consider there to be any complementarity between these goods as, although some alcoholic beverages may be drunk with the opponent's non-alcoholic beverages, the average consumer would not expect the same undertaking to be responsible for the goods.<sup>11</sup> I appreciate that there may be an overlap in trade channels to the extent that all of the goods may be sold through supermarkets and other retail outlets. However, the goods are unlikely to be sold in close proximity. Even if they are, they are likely to be in clearly differentiated sections with non-alcoholic drinks clearly being set them apart from any alcoholic equivalents. I have no evidence before me to suggest that it is common for producers of cognac to also produce the range of non-alcoholic goods covered by the applicant's terms and nor do I consider it likely. Taking all of this into account, I am of the view that the limited nature of the overlaps is only sufficient to give rise to a finding that these goods are similar to a low degree.

*Alcohol free wine; Cocktails, non-alcoholic; Aperitifs, non-alcoholic.*

41. While the above goods are those that are specifically geared towards being replacements for ordinary alcoholic drinks, I am of the view that the finding made in the preceding paragraph applies here. I say this because while some

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<sup>11</sup> *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

undertakings that provide a range of alcoholic beverages may also seek to sell non-alcoholic versions of the same (such as zero-proof aperitifs or non-alcoholic wine, for example), I do not consider that the same applies to “cognac” in the opponent’s specification. For example, I accept that a producer of cognac may sell non-alcoholic versions of cognac but I see no reason why they would produce and sell a range of other non-alcoholic drinks such as wines, aperitifs and cocktails. Further, I do not consider that the goods at issue here would share a competitive relationship. As a result, I find that the above goods are similar to a low degree with the opponent’s “cognac”.

*Beer and brewery products.*

42. The above goods cover beers and other drinkable goods that are made in breweries. In comparing the above with the opponent’s “cognac”, I find that there exists an overlap in nature, method of use and purpose. These overlaps are not as limited as the overlaps found at paragraph 40 above on the basis that the above goods, like the opponent’s “cognac”, contain alcoholic. However, the overlaps are still limited to a degree as beers are of a lower alcoholic content than cognac, the goods differ in their ingredients/process of production and beers are usually consumed in pints or bottles, as opposed to the smaller measures commonly associated with cognac. As was the case with my assessments above, the trade channels will differ as while the goods may be found in similar locations in large supermarkets, they will not be produced by the same undertakings. I do not consider that the goods are competitive as I do not consider it common for consumers to consider choosing a pint of beer over a glass of cognac, or vice versa. Lastly, I do not consider that the goods are complementary to one another. Taking all of this into account, I find that these goods are similar to between a low and medium degree.

*Preparations for making beverages.*

43. The above goods are non-alcoholic goods that are used to make beverages and are not, therefore, beverages per se. I find no similarity in nature between these goods and the opponent's "cognac" except to the extent that some preparations for making beverages may also be liquids. This is on the basis that the applicant's goods are unlikely to be drunk on their own and will be mixed with other liquids before being consumed. Further, their respective methods of production are likely to be entirely different. The purpose of these goods is also not the same as the applicant's goods are for the purpose of making up non-alcoholic beverages which is clearly not the purpose of the opponent's cognac. I have nothing before me to suggest that a producer of cognac would provide preparations for making beverages or vice versa. Further, the goods would not be found in the same locations as one another. Lastly, the goods are not in competition and neither are they complementary. Taking all of this into account, I find that these goods are dissimilar.

Class 33

*Alcoholic beverages except beers; liquor; distilled alcoholic beverages; brandy; spirits; liqueurs.*

44. As far as I understand it, "cognac" (being the opponent's term) is a distilled alcoholic beverage that falls within the category of both a spirit and a liqueur. Further, it is my understanding that cognac is a type of brandy. As a result, the opponent's good can be said to fall within all of the above terms of the applicant. Therefore, I find that these goods are identical under the principle outlined in *Meric*.

*Alcoholic cocktail mixers; alcoholic beverages containing fruit; Premixed beverages; alcoholic cocktails; cocktail mixes; prepared cocktails.*

45. While the above goods do not directly cover the opponent's "cognac", I see no reason why they cannot be said to include it as an ingredient. While this alone is not enough for a finding of similarity,<sup>12</sup> I consider that there exists overlap in the additional factors so as to give rise to a finding of similarity. I say this because whilst the nature of the goods differs somewhat (with the above all being pre-mixed drinks whereas the opponent's is not), they are all alcoholic beverages that will be consumed in the ordinary way. Further, the purpose of these goods is the same in that whilst both parties' goods are consumed for refreshment purposes, they will both primarily be consumed for their alcoholic effects. In terms of trade channels, I see no reason why a producer of cognac would not also produce and sell cans of pre-made cocktails containing cognac, for example. Lastly, there is a degree of competition between the goods as the user may wish to consume a glass of cognac over a cocktail containing cognac or vice versa. Overall, I find that these goods are similar to a high degree.

*Hydromel; mead; perry and rice alcohol; alcoholic malt coolers; wine; piquette; red wine; white wine; sparkling wine; port wines; wine punches; wine coolers being beverages; makgeolli; fortified wines; mulled wine and champagne; Alcoholic cider; hard cider and dry cider; prepared wine cocktails; rum punch; alcoholic daiquiri mixes; alcoholic eggnog mixes; alcoholic margarita mixes; and alcoholic mojito mixes; anise liqueur; anisette; arrack; curacao; gin; kirsch; peppermint liqueurs; rum; vodka; whisky; tequila; soju and Korean distilled spirits.*

46. The above goods are all different types of alcoholic beverages. They are not, as far as I understand it, capable of containing the opponent's goods, being "cognac". That being said, I am of the view that there is a degree of overlap in nature and

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<sup>12</sup> See paragraph 61 of *Les Éditions Albert René v OHIM*, Case T-336/03

method of use between the parties' goods as they are all alcoholic drinks that will be consumed in the ordinary way. I note that the alcoholic content may differ between the goods in that, cider, for example, is lower in alcoholic content when compared to cognac. As for purpose, I find that the goods overlap in that they will both be consumed for refreshment or for the alcoholic effect of the drink. As far as I understand it, the provider of the above goods is unlikely to produce cognac, and vice versa. On this point, I have nothing before me in evidence to suggest otherwise. While the goods will be available via the same distribution channels and in the same overall sections of a supermarket, they will be found on different shelves or aisles. There is a degree of competition on the basis that, when looking to consume alcohol, the consumer may choose the above goods over cognac, or vice versa. Lastly, the goods are not complementary. Taking all of this into account, I find that the goods are similar to a medium degree.

#### *Cooking wine.*

47. In considering the above term, I am of the view that its purpose cannot be the same as the opponent's term, being "cognac". I say this because, as far as I understand it, cognac is not, as far as I am aware, usually used for cooking and while cooking wine can, technically, be drunk, that is not what it is intended for. Based on this, I find that it follows that the method of use will not be the same either. As for natures, I note that both goods are alcoholic beverages but their specific purposes are such that their natures do not wholly overlap. In terms of trade channels, I have nothing to suggest that a producer of cognac will produce and sell wine at all, let alone for cooking purposes. Further, I see no reason why the selection of the actual goods would be competitive to one another. Lastly, the goods are not complementary. Taking all of this into account, despite the fact that they are alcoholic beverages, I find that these goods are dissimilar.

*Alcoholic extracts; alcoholic bitters; alcoholic essences; alcoholic fruit extracts.*

48. Despite the fact that the above goods are alcoholic in nature, I find that the same findings I have reached at paragraph 43 above are applicable here. Adopting the same reasoning set out in that assessment above, I find that the above goods differ in nature, method of use, purpose and trade channels with the opponent's "cognac". As such, I find that these goods are dissimilar.

#### Conclusion of the goods and services comparison

49. Where there is no similarity between goods and services, there can be no likelihood of confusion under section 5(2)(b) grounds.<sup>13</sup> In light of my findings above, it follows that the present ground of opposition fails against the following goods:

Class 32: Preparations for making beverages.

Class 33: Cooking wine. Alcoholic extracts; alcoholic bitters; alcoholic essences; alcoholic fruit extracts.

50. The present ground will, however, proceed against the remaining goods, which I have found to be either identical or similar.

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

51. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem*

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<sup>13</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA.

*Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) 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.”

52. In making its submissions in respect of the average consumer, the applicant claims that the parties’ target consumers are different on the basis that the applicant’s consumers are general consumers such as weekly grocery shoppers whereas the opponent’s consumers are different as their goods are luxurious and expensive. As was the case when considering the goods above, this has no bearing on the assessment I must make here. This is because, in considering the identity of the consumer, I am required to conduct a notional assessment that is based on the goods as they appear before me and not how the parties use them.

53. I find that the average consumer of the goods at issue will consist of both members of the general public at large (for the non-alcoholic goods) and members of the general public over the age of 18 (for the alcoholic goods). The goods at issue are most likely to be sold through a range of retail outlets such as supermarkets, off-licences, specialist suppliers and their online equivalents. The goods will also be sold in restaurants, bars and public houses. In retail outlets, the goods at issue will be displayed 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. In outlets such as restaurants, bars and public houses, the goods are likely to be on display behind

the counter at bars or on drinks menus, for example. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

54. While the non-alcoholic beverages are everyday products, the alcoholic ones are not. Therefore, I find that the non-alcoholic beverages are those that will be selected with a high degree of frequency whereas the alcoholic ones are likely to be purchased on a semi-regular basis. The costs of the goods at issue will vary from cheap goods such as juices to expensive bottles of wine or spirits. When selecting the non-alcoholic goods, the consumer is likely to consider ingredients, flavour and nutritional content. As for the alcoholic goods, the consumer is likely to consider those same factors as well as more specific factors such as the origin of the goods and the alcoholic content. For the most part, when selecting non-alcoholic goods, the consumer will pay a relatively low degree of attention. This is on the basis that they are fairly casual purchases, some of which are selected from 'grab and go' sections of stores or placed in fridges near checkouts. When selecting the alcoholic goods, I am of the view that regardless of the cost, the attention paid is likely to be medium. I say this because even when the goods are expensive, the factors considered will still be relatively ordinary and they will not be considered important purchases.

### **Comparison of the marks**


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

56. 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.”

57. 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.

58. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
A. E. DOR	

59. I have submissions from both parties in respect of the comparison of the marks. While these are noted, I do not intend to repeat them in full here. Instead, I will, where necessary, discuss them further below. For the avoidance of doubt,

however, I can confirm that I have taken these submissions into account in making the following comparison.

### Overall impression

60. The applicant's mark is a figurative mark that consists of a number of different elements. The first element is the word 'D'OR' presented in a stylised typeface in gold. This word sits above the word 'Crown', which is presented in a cursive typeface in white. Both of these words are on a red background that takes the form of a circular device element which, itself, is surrounded by a black and gold border. At the top of all of these elements, and seemingly integrated into the gold border is a large, golden stylistic crown device. While there are numerous elements, I am of the view that because consumers tend to be drawn to parts of marks that can be read, the words 'D'OR' and 'Crown' will play a greater role than the device element. In the present case, I consider that 'D'OR' will play a greater role than 'Crown' due to its considerably larger size and its placement more centrally within the mark. As for the device element, this may play the lowest role, but still has an impact on the mark and its role is not negligible.

61. As for the opponent's mark, this is a word only mark. The mark is a combination of letters and a word, being 'A. E. DOR'. I am of the view that the overall impression of the mark lies across these elements equally.

### Visual comparison

62. While the typeface used by the applicant is stylised, I consider that it is an ordinary cursive typeface. Given that the opponent's mark is a word only mark, I am of the view that it too can be presented in this same typeface. While it is not legitimate to perform a comparison of the marks on this basis, I raise this point because it means

that the different typeface used by the applicant is not a point of visual distinction.<sup>14</sup> Visually, the marks share the letters 'DOR'. These are presented as one word in the opponent's mark but as 'D'OR' in the applicant's. While the apostrophe is small, I do not consider that it will be overlooked as, due to the common use of apostrophes across words in the English language and their grammatical impact on the same, consumers will be mindful of them. The marks differ in the presence of the letters 'A. E.' in the opponent's mark and the word 'Crown' in the applicant's. Further, the marks differ in the presence of the device element which, while playing a lesser role, still contributes significantly as a point of visual difference. Taking all of the above into account and bearing in mind the overall impressions of the marks, I am of the view that they are visually similar to a low degree.

#### Aural comparison

63. The aural element of the applicant's mark is the words 'D'OR Crown'. It is my view that the word 'D'OR' will be pronounced in two different ways by two different sets out consumers, both of which forming a significant proportion. The first being 'DEE-ORR' and the second being like the word 'door'. I say this because even though consumers will notice the apostrophe, I do not consider that it will automatically lead consumers to pronouncing the mark in the first way set out above. On this point, I will proceed in basing my decision on those consumers that pronounce the mark as 'door'. I do so because this clearly represents the opponent's best case and I remind myself that if a significant proportion of consumers are confused, then I am entitled to find that there exists confusion between the marks.<sup>15</sup>

64. As a result of the above, the applicant's mark will be pronounced as two syllables, being 'DOOR-CROWN'. Turning to the opponent's mark, I consider that this consists of three syllables that will be pronounced as two individual letters 'A' and

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<sup>14</sup> See *HERNO S.p.A. v Miss Sparrow Ltd*, BL O/954/22

<sup>15</sup> See paragraph 34 of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41. While an infringement case, the principle applies equally to section 5(2) grounds before the Tribunal.

'E' followed by 'DOR', which will be pronounced as the word 'door'. In comparing these marks, they share an identical syllable, being the first syllable of the applicant's mark and the last syllable of the opponent's mark. All other syllables differ. Despite the marks sharing an identical syllable, those syllables are placed at different points in the respective marks and result in the marks having different beginnings, which is where consumers tend to focus.<sup>16</sup> Further, from an aural point of view, the marks at issue are short marks and while I appreciate that there is no special test which applies to the comparison of 'short' marks,<sup>17</sup> I am of the view that in the present case, the shortness of the marks at issue means that the average consumer is more likely to notice the differences. Taking all of this into account, I am of the view that these marks are aurally similar to between a low and medium degree.

### Conceptual comparison

65. The applicant submits that the meaning associated with its own mark will be that of a golden crown. On this point, it is my understanding that 'D'OR' means 'gold' in French and while this may have been the applicant's intention, I have nothing before me to suggest that a significant proportion of consumers in the UK will understand the word this way. While I note that some foreign language words have become so well-known in the UK that consumers will understand what they mean, I do not consider 'D'OR' is one of them. Instead, the word 'D'OR' will simply be understood as a foreign language or made up word with no obvious meaning. As for 'Crown', this will have a well-known meaning, being a head adornment worn by kings or queens, meant to symbolise royalty. The only other element in the mark that carries a concept is the crown device which will simply reinforce the meaning of the word 'Crown'. When viewed as a whole, I do not consider that the applicant's mark carries any obvious concept beyond being viewed as a combination of the well-known word 'Crown' and a made-up or foreign language word.

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<sup>16</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>17</sup> See paragraph 44 of *BOSCO*, BL O/301/20

66. In respect of the opponent's mark, the applicant believes that 'A. E. DOR' is named after the founder of the opponent, being an Amedee Edouard Dor. As such, the opponent's mark will be viewed as the name of an individual which would render the marks dissimilar. In response to this, the opponent argues that there is no chance that consumers in the UK would recognise 'A. E. DOR' in this way and, instead, will think of it as a coined brand name with no discernible meaning. While it may very well be that 'A. E. DOR' does stand for Amedee Edouard Dor, I agree with the opponent in that consumers would not understand this. That being said, I consider that the construction of the mark would still evoke a person's name (i.e. two initials followed by a surname), as opposed to a meaningless word mark. Even then, the opponent's mark does not carry any obvious concept as the consumer will, plainly, not understand who the name is in reference to.

67. While neither mark, as a whole, carries any obvious meaning, I am of the view that the word 'Crown' (and the crown device) in the applicant's mark acts as a point of difference between the marks, especially when taken into account that the opponent's mark will be viewed as a person's name (again, the consumer will not know who). As a result, I find that the marks are conceptually dissimilar.

### **Distinctive character of the opponent's mark**

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

"22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

69. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with a high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of marks can be enhanced through use, and I note that the opponent has pleaded that its mark enjoys an enhanced degree of distinctive character. I will, therefore, consider whether this evidence is sufficient to give rise to a finding that the distinctiveness of the opponent’s mark has been enhanced through use. However, before doing so, I will consider the inherent position.

70. The opponent’s mark is the word only mark, ‘A. E. DOR’. As above, this will be perceived as a name of some sort but it will not be known who it is in reference to. As such, the mark has no obvious meaning to consumers in the UK. As such, it cannot be said to be descriptive or allusive of the goods relied upon. While that may be the case, I do not consider that the reference to a name, even an unknown one, in a trade mark is remarkable to the point that the opponent’s mark can be said to be inherently distinctive to an outright high degree. That being said, I still

consider that it sits at a higher than medium degree. On this point, I do wish to clarify that the distinctiveness lies equally across the mark as a whole.

71. I turn now to consider whether the opponent's mark enjoys an enhanced degree of distinctive character. In considering the evidence, I have found that the use shown was sufficient to demonstrate that the opponent has genuinely used its mark. However, I remind myself that the requirement for a finding of an enhanced distinctive character is considerably more onerous than that of genuine use. I say this on the basis that use need not be quantitatively significant in order for it to be genuine, whereas distinctive character is a measure of how strongly the mark identifies the goods/services of a single undertaking. It follows that a finding of an enhanced degree of distinctive character requires use at such a level that is capable of pointing to the fact that a proportion of consumers would identify the goods as originating from a particular undertaking.

72. Taking into account all of the evidence that I have summarised at paragraphs 21 to 25 above, I am of the view that the level of use is simply too low in order to warrant a finding that the opponent's mark enjoys an enhanced degree of distinctive character. I say this especially given that the inherent position is already at a higher than medium degree. The opponent has only sold approximately 3,800 bottles of cognac in the UK for a turnover of approximately €122,000. In the context of the market at issue, it is my view that this represents a low level of sales. In respect of enhanced distinctive character, I note that longstanding use may assist in such a finding. However, in the present case, I appreciate that the opponent was formed in 1858 but the evidence of UK use only come from sales between 2019 and 2023. In no way is this reflective of a longstanding period of use. Lastly, I remind myself that while the opponent has attended a cognac event in London since 2018. I do not consider that this evidence, especially in light of the low level of use, sufficiently demonstrates that the opponent's mark is known across the relevant consumer base.

73. Taking all of the evidence into account, I find that it falls short of the threshold for a finding on enhanced distinctive character. Therefore, the inherent position applies.

### **Likelihood of confusion**

74. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. This includes 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that they have retained in their mind.

75. I have found the goods to be either identical or similar to varying degrees, including low. The average consumer base is formed of members of the general public, either at large or those over the age of 18 (for the alcoholic goods). The consumer will select the goods by primarily visual means, although I do not discount an aural component playing a role. I have concluded that the level of attention paid will be either at a lower or medium degree, depending on what goods are selected. The marks at issue are visually similar to a low degree, aurally similar to between a low and medium degree and conceptually dissimilar. I have found that the opponent's

mark possesses a higher than medium (but not outright high) degree of inherent distinctive character.

76. In making its submissions in respect of confusion, the opponent states as follows:

“The Opponent acknowledges that the earlier mark contains the letters ‘AE’ at its beginning. However, different beginnings do not necessarily mean that confusion is any less likely. As identified in *Bristol Global Co Ltd v EUIPO*, T-194/14, the General Court held there to be a likelihood of confusion between ‘AEROSTONE’ and ‘STONE’, despite the fact that the beginnings were different, because the shared element stone was sufficient to create the necessary degree of similarity. In this regard, the Opponent submits that the shared element between the marks is DOR, and that confusion is likely despite the letters ‘AE.’”

77. While the principle set out in *Bristol Global* is noted, it is not on all fours with the present case. I say this because, as above, that case involved an assessment between ‘AEROSTONE’ and ‘STONE’. In the present case, there are several other elements present in both marks and the comparison here is not simply ‘DOR’ against ‘A.E. DOR’. It is, instead, more complex than that because the applicant’s mark consists of not only an additional word at the end of its verbal element but a rather striking device element that impacts on the mark visually. In respect of the visual impact of the device element when assessing confusion, I remind myself that I have found the visual component to play the greatest role in the selection process. This means that the visual comparison can be attributed more weight when considering the marks.<sup>18</sup> As a result, I do not consider that the reference to *Bristol Global* necessarily gets the opponent any further. That being said, I will still proceed to consider confusion in the ordinary way.

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<sup>18</sup> *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03,

78. Taking all of the above factors into account, I am not satisfied that the average consumer would mistake the parties' marks for one another. Even taking into account the high degree of distinctiveness of the opponent's mark and the fact that the marks share the letters 'DOR', I do not consider that the points of difference, being the word 'Crown' and the device element in the applicant's mark and the letters 'A. E.' in the opponent's mark, would go unnoticed. Consequently, I find that there exists no likelihood of direct confusion between the parties' marks, even when considered on identical goods or in circumstances where a lower degree of attention is paid.

79. I will now proceed to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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'.

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)".

80. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

81. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 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". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

82. The crux of the opponent's argument is that consumers will mistake the goods sold under the applicant's mark as originating from the same or economically linked

undertaking to those sold under the opponent's mark. Alternatively, the opponent submits that consumers will acknowledge that the later mark contains additional elements but will dismiss them as the type of non-distinctive elements which are consistent with a brand extension or sub brand. This argument is in line with category (b) set out by Mr Purvis Q.C. in *L.A. Sugar* (cited above).

83. While the opponent's submissions are noted, I fail to see why the present circumstances would give rise to consumers believing that the applicant's mark is a brand extension or sub-brand of 'A. E. DOR'. In this scenario, even if the apostrophe in the applicant's mark is overlooked, I do not consider that there exists any obvious reason as to why consumers would believe it logical for the undertaking responsible for the 'A. E. DOR' mark to remove the letters 'A. E.' from the beginning of its mark and add the word 'Crown' to its end. I say this because 'A. E.' forms part of the distinctive character of the opponent's mark and it is not, therefore, simply the removal of non-distinctive element. Further, while 'Crown' may play a lesser role than 'D'OR' in the applicant's mark, it does not necessarily allude to a sub-brand or brand extension. I say this because it does not indicate an alternative range of goods in the way a sub-brand or brand extension ordinarily would. On this point, I do not consider that 'Crown' fits in with the examples given by Mr Purvis Q.C. above, being 'LITE', 'WORLDWIDE' or 'EXPRESS'. As a result, I see no reason why this argument would give rise to a finding on indirect confusion. While that may be the case, the matter does not end there as I consider it necessary to discuss the additional examples set out in *L.A. Sugar*.

84. I remind myself that I have found the opponent's mark to enjoy a high degree of distinctive character. I appreciate that this may lend itself to an argument in line with category (a) of *L.A. Sugar*, namely that the opponent's mark is so strikingly distinctive that consumers would not believe that any other undertaking would use it. However, I do not consider that this argument is sustainable in the present case. I say this because the distinctiveness of the opponent's mark lies in 'A. E. DOR' as a whole and not the word 'DOR'. As such, I see no reason why consumers would

believe that only one undertaking would use the word 'DOR', regardless of whether they notice the apostrophe or not.

85. Lastly, I do not consider that the example of confusion as set out in category (c) of *L.A. Sugar* is applicable here either. I say this because the structure of the marks and the differences between them are not changes to individual elements in a way that points to confusion in this scenario. Instead, the differences involve the inclusion or removal of entire elements that are not present in the opposing party's mark.

86. While I remind myself that the examples of indirect confusion as set out in *L.A. Sugar* are not exhaustive, I note that the opponent has not provided any arguments as to the existence of indirect confusion in any other scenario. In the present case, to explore any further arguments would be a result of me formulating the opponent's case on its behalf. This would be inappropriate and, further, it would be unfair to the applicant. Therefore, without anything further from the opponent, I find that, for the reasons given above, there exists no likelihood of indirect confusion. For the avoidance of doubt, this applies regardless of the identity of some goods at issue and the level of attention paid by the average consumer.

87. The present ground fails in its entirety and I will now proceed to consider the section 5(4)(a) ground of opposition.

### **Section 5(4)(a)**

88. Section 5(4)(a) of the Act reads as follows:

“(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented-

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) .....

(b) .....

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

89. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

90. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but

it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

91. Halsbury’s Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

“Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other indicium which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon,
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

#### Relevant Date

92. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander Q.C., as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

the position would have been any different at the later date when the application was made.’ ”

93. The applicant’s mark does not have a priority date. In addition, there is no evidence before me that is capable of pointing to use that could be deemed as being the start of the behaviour complained about. Therefore, the relevant date for the present ground is the filing date of the applicant’s mark, being 21 July 2023.

### **Goodwill**

94. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in the sign relied upon as at the relevant date. I remind myself that the sign relied upon is as follows:



95. Further, I remind myself that opponent claims that its signs enjoy goodwill thanks to its use on “alcoholic beverages, except beer”, “cognac”, “alcoholic beverages containing cognac” and “armagnacs”.

96. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing

which distinguishes an old-established business from a new business at its first start.”

97. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

98. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

99. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

100. A finding of goodwill stems from trading activities aimed at UK customers. In the present case, I remind myself that the opponent has sold approximately 3,800 bottles of cognac in the UK between 2019 and 2023 for an approximate turnover

of €122,000. Those goods are confirmed in evidence as being branded with the sign relied upon. While the turnover is noted, it is not particularly longstanding and neither is it reflective of an intensive level of use. On the contrary, I consider it to be a low level of use. Further, there is no additional evidence before me that points to any actual trading activities in the UK beyond the turnover provided. I say this because even though the opponent has provided printouts of its goods listed for sale on various retailers' websites, any use associated with this is, in my view, encompassed by the turnover figures provided. Lastly, I appreciate that the opponent has provided evidence at attendance at a cognac event since 2018. However, for reasons already discussed above, this evidence is of no assistance as I am unable to discern any level of publicity stemming from the same and attaching to the sign.

101. In considering the issue of goodwill, I remind myself that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its goodwill and reputation may be small.<sup>19</sup> As such, it is not necessary for the trading activities under the present assessment to be at a high level. That being said, I am of the view that, in the present case, the opponent has fallen short of the threshold to warrant a finding of a protectable level of goods in its business. I say this because not only has the opponent demonstrated only a low level of use but it has failed to provide any further supporting evidence in regard to the opponent's presence across the UK. As a result, I find that the opponent's business does not benefit from any protectable level of goodwill in order to sustain a claim for passing off. Therefore, the present ground fails at the first hurdle.

102. Even if I am wrong to find that there exists no protectable level of goodwill in the opponent's business, any goodwill associated with the sign would be at a low level and would vest only in "cognac". In my view, I do not consider that this finding

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<sup>19</sup> For example, see *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590.

would offer any assistance to the opponent. I say this whilst bearing in mind the case of *Comic Enterprises* (cited above), wherein Kitchin L.J. set out that it seemed doubtful whether the difference between the legal tests of misrepresentation under section 5(4)(a) and confusion under section 5(2)(b) would (all other factors being equal) produce different outcomes.<sup>20</sup> This is because they are both normative tests intended to exclude the particularly careless or careful, rather than quantitative assessments.

103. In the present case, I note that the sign relied upon by the opponent is not the same as the mark relied upon under the section 5(2)(b) ground. While this may be the case, the sign is a figurative one with the words ‘A. E. DOR’ featuring prominently within it. It is my view that the ‘A. E. DOR’ element is the dominant and more distinctive element of this sign and I will proceed as such. I do not overlook that the sign contains a crown device, but the device overall differs from the applicant’s mark. The sign is different in its configuration, its inclusion of the “Estd 1858” and its non-inclusion of the word “Crown”. Given that it was the ‘A. E. DOR’ element that formed the entirety of word only mark relied upon under the section 5(2)(b) ground above, I consider that the same finding reached when considering confusion in respect of the section 5(2)(b) ground is applicable here. Therefore, applying the principle set out in *Comic Enterprise* and relying on the same reasons set out at paragraphs 77 to 86 above, I find that there is no misrepresentation in the present case. Without a misrepresentation there can be no damage suffered. Therefore, I find that the opponent’s section 5(4)(a) ground fails.

## CONCLUSION

104. The opposition fails in its entirety and, subject to any successful appeal of my decision, the applicant’s mark may proceed to registration for all goods and

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<sup>20</sup> Although this was an infringement case, the principles are equally applicable to section 5(2) of the Act: *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch).

services applied for. On this point, I will say that regardless of the outcome of any appeal, the applied for services will proceed to registration on the basis that they were not subject to the present opposition.

## **COSTS**

105. The applicant has succeeded in defending its application and is, therefore, entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the applicant the sum of £1,000 as a contribution towards its costs. The sum is calculated as follows:

Considering a notice of opposition and preparing the counterstatement:	£300
Considering the evidence of the opponent and filing written submissions during the evidence round:	£700
<b>Total:</b>	<b>£1,000</b>

106. I hereby order Maison A.E. DOR to pay UNICORN GLOBAL LIMITED the sum of £1,000. The above sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

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

**A COOPER**  
**For the Registrar**