

**O/0919/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3827108**

**BY SHENZHEN JIUFA JEWELRY CO., LTD.**

**AND**

**JIANGSU TAIZHOU JUZICHEN TRADING CO., LTD.**

**TO REGISTER THE TRADE MARK:**



**IN CLASS 25**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 438290**

**BY MAST-JÄGERMEISTER SE**

## BACKGROUND AND PLEADINGS

1. On 7<sup>th</sup> September 2022, Shenzhen Jiufa Jewelry Co., Ltd. and Jiangsu Taizhou Juzichen Trading Co., Ltd. (“the applicants”) applied to register the trade mark shown on the cover of this decision in the United Kingdom. The application was accepted and published in the Trade Marks Journal on 23<sup>rd</sup> September 2022, in respect of the following goods:

*Class 25: Clothing; Shoes; Footwear; Sports shoes; Gloves; Neck scarves; Leather belts [clothing]; Socks; Hats; Trousers.*

2. On 23<sup>rd</sup> December 2022, Mast-Jägermeister SE (“the opponent”) opposed the application based on Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”). The opposition under these grounds is directed against all of the goods in the application and the opponent relies upon the two earlier marks shown below:

### UK00003337582 – “the first earlier mark”



Filing date: 11<sup>th</sup> September 2018.

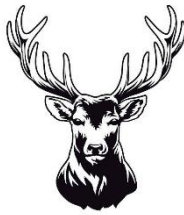
Registration date: 11<sup>th</sup> January 2019.

Relying upon the goods below.

For Section 5(2)(b): **Class 25:** *Headgear; clothing; footwear; parts and fittings of all the aforesaid goods, included in this class.*

For Section 5(3): **Class 33:** *Alcoholic beverages (except beer), in particular herbal spirits; pre-mixed alcoholic beverages.*

**UK00003337592 – “the second earlier mark”**



Filing date: 11<sup>th</sup> September 2018.

Registration date: 25<sup>th</sup> January 2019.

Relying upon the following goods:

For Section 5(2)(b): **Class 25:** *Headgear; Clothing; Footwear; Parts for all the aforesaid goods, included in this class.*

For Section 5(3): **Class 33:** *Alcoholic [sic] beverages, excluding beers, Especially herb-flavoured spirits; Alcoholic cocktails.*

3. Both the opponent's marks qualify as earlier trade marks in accordance with Section 6 of the Act, as their filing dates are earlier than that of the applicants' mark. Since the opponent's earlier marks have been protected for less than five years prior to the filing date of the applicants' mark, they are not subject to the use provisions specified in Section 6A of the Act.
4. Under section 5(2)(b) of the Act, the opponent claims that there exists a likelihood of confusion (which includes a likelihood of association) between its earlier marks and the contested application, owing to the degree of similarity between the marks and the identity between the class 25 goods in question.
5. Under Section 5(3), the opponent claims that its marks have a reputation in respect of their class 33 goods. The opponent submits that this reputation is such that registration of the applicants' mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character and repute of its earlier marks.

6. The applicants filed a defence and counterstatement denying the claims made and putting the opponent to proof of its claims that its earlier mark has a reputation. This also included the following:
  - That their mark is different, has unique character and is not identical or similar to the opponent's earlier marks.
  - The mere fact that a later trade mark brings to mind an earlier mark does not constitute likelihood of confusion.
7. In these proceedings, the opponent is represented by Marks & Clerk LLP and the applicants by IP LOILO.

## **EVIDENCE AND SUBMISSIONS**

8. Only the opponent filed evidence in the form of a witness statement from Faith Alexandra Chong Xu Jen, a trainee trade mark attorney at Marks & Clerk LLP. It is dated 23<sup>rd</sup> August 2023 and accompanied by three exhibits (FC1-FC3). The exhibits consist of evidence filed by the opponent in a previous opposition which it submits are also relevant to these proceedings.<sup>1</sup> It covers the enhanced distinctive character and reputation of the earlier marks. Due to the structuring of these documents, Exhibit FC1 contains the annex and exhibit index for that previous set of evidence and Exhibit FC2 contains the evidence itself – in the form of a witness statement from Ms Laila Gutt (dated 9<sup>th</sup> May 2022) and 17 accompanying exhibits. Ms Gutt is responsible for managing the opponent's intellectual property across the UK, Europe, USA, Canada and Latin America, a position she has held since 2012. When referring to these documents I will endeavour to refer to both the 'main' (under these proceedings) exhibit number and additional (previous) exhibit number, as best as I can for clarity.
9. Exhibit FC3 (and paragraph 6 of Ms Chang's witness statement) contains information solely in relation to confidentiality under the previous opposition and a request for Exhibits 10A and 16B contained in Exhibit FC2 to be kept confidential

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<sup>1</sup> As per paragraph 3 of Ms Chong's witness statement.

under these proceedings. I note that this confidentiality request has since been addressed by the Registry, as per the letter dated 27<sup>th</sup> September 2023, stating the preliminary view to refuse the request and the rationale for this decision. An opportunity to challenge this preliminary view was provided, but no CMC was requested, therefore this still stands and the material is not deemed confidential. However, from a practical perspective, I note that all the numerical figures in relation to 10A and 16B were, in fact, redacted when the evidence was submitted.

10. No hearing was requested and only the opponent filed written submissions in lieu of attendance. This decision is taken following careful consideration of all the papers before me. I have not summarised the evidence and the submissions in full, but they will be referenced within this decision to the extent that is necessary.

## **RELEVANCE OF EU LAW**

11. 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.

## **DECISION**

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

12. Section 5(2)(b) of the Act is as follows:

“A trade mark shall not be registered if because–

...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

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.”

13. In considering the opposition under this section, I am guided by the following principles which are taken from the decisions of the Court of Justice of the European Union (“CJEU”) 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:

### **The principles**

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks and vice versa;

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

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

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

(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

14. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court of the European Union (“GC”) 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.”

15. The opponent highlights in its written submissions that the applicants appear not to have commented upon the similarity of the goods. I agree that this has not been addressed, though I can deal with this point swiftly as the goods are self-evidently identical or encompassed within the opponent’s terms, as summarised below.

The applicants’ goods	The opponent’s goods	
<p><b>The contested mark:</b></p> <p><b>Class 25:</b> <i>Clothing; Shoes; Footwear; Sports shoes; Gloves; Neck scarves; Leather belts [clothing]; Socks; Hats; Trousers.</i></p>	<p><b>The first earlier mark:</b></p> <p><b>Class 25:</b> <i>Headgear; clothing; footwear; parts and fittings of all the aforesaid goods, included in this class.</i></p>	<p><b>The second earlier mark:</b></p> <p><b>Class 25:</b> <i>Headgear; Clothing; Footwear; Parts for all the aforesaid goods, included in this class.</i></p>

16. The terms “*Clothing*”, “*Gloves*”, “*Neck scarves*”, “*Leather belts [clothing]*”, “*Socks*” and “*Trousers*”, are all identical to, or incorporated within, the opponent’s “*Clothing*” and are therefore identical under the principles outlined in *Meric*. Similarly, “*Shoes*”, “*Footwear*” and “*Sports shoes*” are self-evidently identical to, or fall within, the opponent’s “*Footwear*”. Finally, the applicants’ “*Hats*” is identical to the opponent’s “*headgear*”.

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

17. As the case law indicates, it is necessary for me to determine who the average consumer is for the goods. I must then determine the manner in which these goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

18. Only the opponent commented on the average consumer, that this would be a member of the general public with an average degree of attention paid to the purchasing process.<sup>2</sup> I agree that the average consumer of the goods at issue will be the general public. I also consider that the purchasing act will be primarily visual, due to the goods typically being purchased based on their aesthetic appeal. They are likely to be self-selected from the shelves of high street retailers, or from photographs on Internet websites and catalogues. However, I

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<sup>2</sup> Paragraph 40 of written submissions.

do not discount the aural component playing a role by way of word-of-mouth recommendations or discussions with retail staff. Overall, the goods are likely to be purchased relatively frequently and the cost of the goods is likely to vary. Factors such as size, material, aesthetic appeal or suitability for purpose are likely to be considered by the consumer, even in relation to goods at the more inexpensive end of the spectrum. Generally speaking (and agreeing with the opponent) I find an average degree of attention is likely to be paid during the purchase.




### **Comparison of the marks**

19. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

20. It would be wrong, therefore, to dissect the marks artificially, 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.

21. The respective marks are shown below:

Applicants' mark	Opponent's marks	
<p data-bbox="236 309 545 340"><b>The contested mark:</b></p> 	<p data-bbox="624 309 956 340"><b>The first earlier mark:</b></p> 	<p data-bbox="1007 309 1386 340"><b>The second earlier mark:</b></p> 

22. The opponent submits within its statement of grounds that “overall the signs share at least a medium degree of similarity”, this assessment is revised within its written submissions, where it states, “it is clear that the Contested Mark is similar to the Earlier Marks to a high degree or at least an average-high degree”.<sup>3</sup> The applicants’ submissions focus on how its mark is “enriched with additional elements” and “has a unique and different character which gives an overall different impression to the average consumer”.<sup>4</sup>

### Overall Impression

23. The applicants’ mark is a black and white figurative representation of the head and neck of a deer (stag), with the animal’s head twisted, facing towards its right, and partially encompassed within a hexagonal border. The lower portion of the stag is fully contained within this border but, at the top of the mark, the border is intersected by the stag’s antlers, which stretch beyond. The overall impression lies in the mark as a whole.

24. The first earlier mark contains a front facing, naturalistic depiction of a stag bust in black and white. It is partially contained within a double circular border (open at

<sup>3</sup> See paragraph 11 of statement of grounds and paragraph 29 of written submissions.

<sup>4</sup> See page 3 of counterstatement.

the neck of the stag), with the outer line of the border slightly thicker than the inner one. Above the stag, is a black cross device with black straight lines radiating away, behind the deer and to the edge of the border in a 'sunburst' pattern. Although the cross device is smaller in size than the stag, the eyes are drawn to it due to the accompanying sunburst pattern. I consider the cross and stag devices to be of equal dominance within the mark and that the overall impression lies in the combination of these elements.

25. The second earlier mark features solely a front facing, naturalistic depiction of a stag bust in black and white. The overall impression lies in the mark as a whole.

### **Visual Similarity**

26. I have received detailed descriptions from both sides identifying similarities and differences between the marks which I do not consider necessary to reproduce in full here. I am mindful that some of the features, such as those identified by the opponent regarding the proportions of the stags' necks and the antlers being in the same "point in the antler cycle", are so nuanced that they are unlikely to be noted by the average consumer who perceives a mark as a whole (as per the caselaw already identified at paragraph 19).<sup>5</sup>

27. However, there are indeed clear similarities between the marks. All depict, in black and white, the head and neck of an antlered deer (stag). There are also clear differences, the most obvious and significant of these include:

- The first earlier mark has additional elements, in the form of the cross with the sunburst pattern radiating away from it.
- Two of the marks are partially enclosed within a border of differing shapes.
- The two earlier marks contain more detailed depictions of the animal, face on, with features such as the eyes, nose and fur clearly made out. By contrast, the stag in the contested mark is shown at an angle (slightly in profile) and in a manner more akin to a silhouette, with the majority of the features (apart

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<sup>5</sup> See paragraph 21 of the opponent's written submissions.

from a white portion on the ears) obscured.

28. Taking all of this into account, I consider the contested mark and first earlier mark are visually similar to a low degree, and the contested mark and second earlier mark similar to a low to medium degree.

### **Aural Similarity**

29. The opponent initially contends in its statement of grounds that, since the marks include no verbal elements, they are likely to be referred to as ‘stag’ by UK consumers, and are therefore aurally identical.<sup>6</sup> In response to this, I remind myself that the approach for conducting an aural comparison of figurative marks was clarified by the GC in *Dosenbach-Ochsner AG Schuhe und Sport v OHIM*, Case T-424/10, in which it stated:

“46. A figurative mark without word elements cannot, by definition, be pronounced. At the very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks.”

30. Given the marks are figurative depictions with no word elements, it follows that neither can be articulated and therefore an aural comparison is not appropriate.

### **Conceptual Similarity**

31. The parties agree that the concept of a deer/stag is conveyed across all of the marks. The opponent submits that this results in the marks being conceptually identical, whereas the applicants refute that their mark is identical or similar in character with the earlier marks. With regards to the first earlier mark, the opponent suggests that the cross and sunburst pattern are only “of an

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<sup>6</sup> See paragraph 9 of statement of grounds.

ornamental nature and play a weaker role in the overall impression created by the mark”.<sup>7</sup> I disagree with this, both in terms of the impact these have on the overall impression (as already covered above at paragraph 24 above) but also since this assessment fails to acknowledge the additional concept provided by these elements. Instead, as suggested by the applicants in their counterstatement, I consider that the cross (and accompanying sunburst pattern) will be perceived as the symbol of Christianity. Therefore, these add a religious concept to the first earlier mark which act as a point of difference to the contested mark.

32. Overall, I consider that the contested mark is conceptually identical to the second earlier mark but similar to the first earlier mark to only a medium degree.

### **Distinctive character of earlier mark**

33. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are descriptive or highly allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

34. Distinctive character is a measure of how strongly the earlier mark identifies the goods of services for which it is registered (and on which it may rely), determined, according to *Lloyd Schuhfabrik Meyer & Co.*, partly by assessing the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking. At paragraph 23, of its judgment, the CJEU stated:

“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

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<sup>7</sup> Paragraph 19 of written submissions.

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).

35. In terms of inherent distinctiveness, the earlier marks feature an animal (and in the case of the first earlier mark, with the additional cross and sunburst elements) which is not descriptive or allusive of its goods, or any of their characteristics. I consider the first earlier mark to have a slightly higher than average inherent distinctiveness (due to the additional religious elements) and the second earlier mark to have only an average inherent distinctiveness.

36. The assessment as to whether there is a likelihood of confusion includes considering whether the distinctive character of the earlier mark has been enhanced (i.e. more distinctiveness has been acquired) through the use made of it. The opponent submits that its marks have acquired a high level of distinctive character and that “consumers have become accustomed to seeing the stag logo on a variety of different products, including clothing, and as a result recognise a stag’s head as signifying that goods originate from the Opponent”.<sup>8</sup> In my assessment of this, I rely on the witness statement of Ms Laila Gutt and accompanying exhibits (all contained within Exhibit FC2). I bear in mind that the relevant date for the assessment regarding enhanced distinctiveness is the filing date of the contested application (7<sup>th</sup> September 2022) and that the assessment is made from the perspective of the UK average consumer and in relation to class 25 goods only.

37. The overwhelming focus of Ms Gutt’s witness statement and evidence is use of the opponent’s branding (and stag mark) on class 33 goods, more specifically its herbal liqueur. Paragraph 15 of Ms Gutt’s witness statement (found within Exhibit FC2) covers the opponent’s “expanded product range”, which she details includes glassware (since 2017), clothing (since 2018) and gift packs and barware (since 2019), all available via the opponent’s UK website. However, the

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<sup>8</sup> Paragraph 34 of written submissions.

evidence, at Ms Gutt's Exhibit 9 (contained within Exhibit FC2), only provides single examples of use on: a shot glass, bar runner, jacket, 'tap machine' (drink dispenser), gift pack and stag head bottle pourer. The drink dispenser, gift pack and bottle pourer are the only items where the stag device are visible. The sole item of clothing shown (and thus only example relevant to this assessment with respect to class 25) is a parka jacket, though notably this does not feature the stag device contained within the earlier marks. There are no references or examples provided to cover the remainder of the class 25 goods, i.e. footwear or headgear, or "parts or fittings" for the aforesaid goods.

38. Ms Gutt's Exhibit 7B (contained within Exhibit FC2) provides the opponent's annual turnover figures, however I note that no detail is supplied here regarding the breakdown of the products sold, i.e. if these turnover figures relate solely to its class 33 goods, or also include the "expanded" product range. I deem that the broader evidence certainly indicates that the vast proportion would relate to class 33 goods. This is also consistent with the information provided by Ms Gutt that the product range was only expanded from 2017 onwards, so the 2015 and 2016 figures would certainly not be expected to include any of these other products. Further, any sales regarding clothing would only be included from 2018 onwards, in keeping with when these products were launched by the opponent.

39. With all of this in mind, I come to the view that the earlier marks have not been enhanced to any material extent in so far as class 25 goods are concerned.

### **GLOBAL ASSESSMENT – conclusions on likelihood of confusion**

40. 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 goods down to the responsible undertaking being the same or related.

41. 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. The first is the interdependency principle, i.e. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the trade marks, 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 act. In doing so, I must take into account the fact that the average consumer rarely has an 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.

42. The opponent highlights in its written submissions that it “is established case law that the purchase of goods in Class 25 is based, in principle, particularly on their visual aspects”.<sup>9</sup> I agree. As at paragraph 18, I have already identified that the purchasing process for the goods is predominantly visual, though I do not rule out aural considerations. I am also mindful of *New Look Limited v OHIM*, joined cases T-117/03 to T-119/03 and T-171/03, where the GC stated that:

“50..... Generally in clothes shops customers can themselves either choose the clothes they wish to buy or be assisted by the sales staff. Whilst oral communication in respect of the product and the trade mark is not excluded, the choice of the item of clothing is generally made visually. Therefore, the visual perception of the marks in question will generally take place prior to purchase. Accordingly the visual aspect plays a greater role in the global assessment of the likelihood of confusion.”

43. The opponent also argues that marks placed on goods falling in class 25 are “likely to feature in a similar position on the goods”, are “commonly small and are often viewed from a distance, at least in the first instance” which “increases the visual similarities between the marks as the finer details of the marks would not be seen by a consumer”.<sup>10</sup> I note that no evidence has been submitted in support of this submission, nevertheless, in response to this I bear in mind *Industria De Diseno Textil, S.A. (Inditex, S.A.) v Hilary-Anne Christie*, Case BL O/040/20. Here Mr Daniel Alexander Q.C., as the Appointed Person, considered a similar

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<sup>9</sup> Paragraph 23.

<sup>10</sup> Paragraph 40 and paragraph 24 of written submissions, respectively.

principle in relation to the discreet (and small) use of marks on jewellery and leather goods. On considering this, he commented at paragraph 46 that:

“Although it is true that the marks in question are likely to appear in a discreet way in some contexts, the differences in appearance between the marks is readily visible and it would appear that consumers are well attuned to and being able to read marks appearing on or in relation to goods of this kind in a manner that is not prominent.”

44. I am content that the same rationale would be applicable here, both in terms of the differences between the marks being easily discernible, and the average consumer being accustomed to (and thus able to differentiate between) branding used on class 25 goods in a particular position and variety of sizes, which would include smaller, more discreet markings.

45. In terms of my global assessment, I have found that the purchasing process is predominantly visual, an average level of attention will be paid by the relevant consumer and the marks are visually similar to a low or low-to-medium degree, and conceptually identical or similar to a medium degree.

46. The fact that the contested mark and both earlier marks clearly represent a stag, and the parties' goods being identical, are obvious considerations in the opponent's favour. Though, in terms of the shared stag concept, I am mindful of the finding in *Sabel BV v Puma AG*, in particular at paragraph 26 which stated:

“the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.”

47. Indeed, there are differences between the contested and earlier marks which are not negligible, as summarised at paragraph 27. The presence of these differing elements within each of the earlier marks (including, but not limited to, the more naturalistic style and 'face on' depiction of the stag in both earlier marks, and the cross device and sunburst pattern, in the first earlier mark) would not, in my opinion, be overlooked by the average consumer. Therefore, I consider that the

average consumer would be able to distinguish that the marks are different, and that they would not be mistakenly recalled as each other. This is especially so, considering the average/only slightly higher than average inherent distinctiveness of the earlier marks, the emphasis on visual considerations during the purchasing process and the average level of attention being paid.

48. I consider that the differences between the marks outweigh the general visual and conceptual similarities/identity, even taking into account imperfect recollection and the fact that the average consumer will rarely have the opportunity to directly compare the marks. Accordingly, I find that there is no likelihood of direct confusion.

49. In relation to indirect confusion, which has also been claimed by the opponent, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

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)".

50. These examples are, clearly, not intended to be an exhaustive list but illustrate some of the circumstances in which indirect confusion may arise. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v 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". 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. I am also mindful that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark.<sup>11</sup>

51. The opponent, in its written submissions, argues that indirect confusion would be applicable since it is common in the clothing industry for the same trade mark to have various configurations, according to the season or a particular trend or function. In my view, once the average consumer has recalled the various differences between the competing trade marks, I cannot see any reasons why they would then assume the applicants' trade mark is a sub-brand, co-brand with a third party, or rebrand of the opponent's trade mark, or some linked undertaking. I deem it more likely that the relevant consumer will conclude that

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<sup>11</sup> As per *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

unrelated undertakings have coincidentally adopted different devices of stags to indicate the origin of their goods. Thus, I conclude that there is no likelihood of indirect confusion.

## **CONCLUSION**

52. The opposition under section 5(2)(b) fails.

### **Section 5(3)**

#### **Legislation and case law**

53. Section 5(3) of the Act states:

“(3) A trade mark which-  
  
is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

54. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected”.

55. The relevant case law can be found in the following judgments of the CJEU:

*Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas-Salomon, Case C-487/07, L'Oréal v Bellure and Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas-Salomon, paragraph 29 and Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77 and Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74* and the court's answer to question 1 in *L'Oréal v Bellure*).

56. The conditions of section 5(3) are cumulative. First, the marks at issue must be identical or similar. Secondly, the opponent must satisfy me that the earlier mark has achieved a level of knowledge, or reputation, amongst a significant part of the relevant public. Thirdly, the opponent must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier marks being brought to mind by the applicants' mark. Fourthly, assuming that the first three conditions have been met, section 5(3) requires that one or more of the three types of damage claimed by the opponent will occur. It is not necessary for the purposes of section 5(3)

that the goods/services be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

57. The relevant date for the assessment under this ground is the filing date of the applicants' mark, that being 7<sup>th</sup> September 2022.

## **Reputation**

58. The opponent can only succeed under this section 5(3) ground of opposition if it first demonstrates that it has the requisite reputation. Reputation is a knowledge threshold.<sup>12</sup> The applicants dispute that the marks are reputable in the UK, whereas the opponent submits that "the Stag Logo trade marks are extremely well known in the UK".<sup>13</sup> Under section 5(3), the opponent claims a reputation in relation to class 33 goods.

59. For my assessment, I once again rely on the witness statement of Ms Laila Gutt and accompanying exhibits (all contained within Exhibit FC2). The witness statement covers that the opponent's company was founded in 1878 in Germany, with the recipe for its 'Jägermeister' herbal liqueur created in 1934. The 'Jägermeister' name (meaning 'hunting master' in German) is often used alongside variations of the 'Jägermeister stag', also known as the 'Hubertus Stag', as per the earlier marks. Use of the stag branding on herbal liqueur goods and a brief history of the "legendary Hubertus stag" can be seen within Ms Gutt's Exhibit 1 (contained within Exhibit FC2).

60. The opponent first sold its Jägermeister liqueur in the UK in 1978 and Ms Gutt has supplied comprehensive evidence regarding sales, marketing, sponsorship

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<sup>12</sup> See the judgment of HH Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* [2018] EWHC 35 (IPEC) at paragraph 69: "(6) Reputation constitutes a knowledge threshold, to be assessed according to a combination of geographical and economic criteria."

<sup>13</sup> See paragraph 20 of Ms Gutt's witness statement, contained within Exhibit FC2.

initiatives and press coverage within the UK. Figures provided for approximate annual turnover for products sold between 2015-2020 are as follows:<sup>14</sup>

	2015	2016	2017	2018	2019	2020
Annual turnover/million (in GBP to nearest 100,000)	48.1	49.1	45.1	42.8	39.8	31.7

61. I note that Ms Gutt's evidence also includes:<sup>15</sup>

- the opponent's Jägermeister product being ranked 35th and 22nd out of 150 spirit brands by volume (per million 9 litre case sales) in 2021 and 2020 respectively.<sup>16</sup>
- excerpts from the opponent's UK 2017 Annual Business Plan detailing projected sales through a variety of UK outlets including grocery chains, 'cash and carry' channels, wholesalers, convenience stores and pubs/breweries. Extracts from the 2019 plan also provides details and strategy regarding availability of the liqueur through online retailers.<sup>17</sup>
- the opponent's herbal liqueur having a 3.9% market share in the UK beverage sector.<sup>18</sup>

62. In light of the evidence provided, including the information regarding sales (with a variety of trade channels covering the UK), marketing (including advertisements on national television and UK-focussed social media campaigns), sponsorship and press coverage, I am satisfied that it shows the opponent has a significant reputation for the first earlier mark for "*herbal spirits*" and "*herb-flavoured spirits*" in class 33. I note there are no instances in the evidence of the second earlier mark and therefore insufficient basis on which to find a reputation for this mark. However even if I am incorrect on this point, this doesn't affect the outcome under this ground and I address this further at paragraph 73 below.

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<sup>14</sup> Ms Gutt's Exhibit 7B, contained within Exhibit FC2.

<sup>15</sup> To emphasise, I have reviewed Ms Gutt's evidence in full but have not (and do not deem it necessary) to summarise its entirety here.

<sup>16</sup> Extracts from UK magazine "The Spirits Business" from Ms Gutt's Exhibit 2, contained within Exhibit FC2.

<sup>17</sup> Ms Gutt's Exhibit 6, contained within Exhibit FC2.

<sup>18</sup> Ms Gutt's Exhibit 7A, contained within Exhibit FC2 which provides estimates from data and research consultancy CGA Strategy's 2021 Annual Report, based on 'On Premise Measurement Service Data' dated July 2020.

## Link

63. Next, it is necessary for the relevant public, when confronted with the contested mark, to make a link with the earlier reputed marks and this includes the bringing to mind the earlier mark. As I noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. These factors are identified in *Intel*, as I have summarised in paragraph 55(d). I have considered each in turn below.

### *The degree of similarity between the conflicting marks*

64. I considered the similarity of the marks at paragraphs 26 to 32 and the same assessment and rationale would apply under this ground. I have found the contested marks and first earlier mark to be visually similar to a low degree, and conceptually similar to a medium degree.

### *The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.*

65. I consider that the class 33 goods for which the opponent has demonstrated a reputation are dissimilar to the applicants' class 25 goods. Clearly, the physical nature, method of use and intended purpose of these goods are completely different, and they are not in competition or complementary. The opponent's goods are consumed for a social or pleasurable drinking experience, which may include the intoxicating effects of alcohol, and are selected on price point, flavour, or strength of beverage. They are sold through a various of channels including restaurants, bars and public houses, as well as supermarkets, off licences and their online equivalents. In contrast, the applicants' goods in class 25 are to be worn for fashion or for practicality, and are chosen based on aesthetic, comfort and fit. They are sold via high street shops, catalogue, supermarkets and their online equivalents.

66. I recognise that, ostensibly, the goods may appear to have some overlap in trade channels since both would be available for purchase through supermarkets. However, since the goods would be located in entirely different areas of the store, this is not a sufficient basis for a finding of similarity. I also acknowledge that some items of clothing can, in some circumstances, be sold by the producers of alcoholic drinks, as this has been demonstrated by the opponent (albeit in very limited terms) by the parka jacket seen in Ms Gutt's Exhibit 9 (contained within Exhibit FC2). However, I do not consider, and have no evidence to suggest, that this is a significant proportion of sales or typical of the trade. Further, clothing outlets would certainly not typically be expected to sell alcohol products. Thus, once again, I find that this limited form of overlap is not sufficient to engage any overall similarity between the respective goods.

67. The relevant public for these goods will be the general public, though notably for the class 33 goods, these will be limited to members of the public who are legally permitted to purchase and consume alcohol, i.e. those over the age of 18.

*The strength of the earlier mark's reputation*

68. In my view, the evidence indicates that the first earlier mark had a significant reputation amongst the UK public (over the age of 18) for class 33 goods at the relevant date.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use.*

69. I have found the first earlier mark to be inherently distinctive to a slightly higher than average degree and consider that it has acquired an enhanced distinctive character for class 33 goods.

*Whether there is a likelihood of confusion*

70. Normally my finding that the goods are dissimilar would point towards no likelihood of confusion. However, I recognise that under section 5(3) grounds

some marks have such a reputation that there can still be confusion, irrespective of the goods or services. Therefore, I am required to take account of the distinctiveness and repute of the first earlier mark and to decide whether, in this particular case, the public may be caused to believe that the applicants' use of the contested mark for class 25 goods is connected to the opponent using their first earlier mark on class 33 goods.

71. I note that at paragraph 17 of its statement of grounds, the opponent submits this argument, in its view that "a link is likely to be made between the class 33 goods and the class 25 goods applied for under the Contested Application since the Opponent sells an extended range of products outside of class 33 in the UK". I have already addressed at paragraphs 37-38 my views on the limited evidence to support the opponent's claims regarding their "extended" range of goods. However, regarding this point in the context of the likelihood of confusion, I consider that, even taking into consideration the distinctiveness and reputation of the opponent's mark (and imperfect recollection), that the differences between the contested mark and the first earlier mark are sufficient to ensure that the relevant public familiar with the opponent's mark will not be confused. On the shared concept of a stag, I think the relevant consumer will put this down to coincidence rather than any connection between the two undertakings. This is compounded by the fact that the first earlier mark conveys an additional religious concept which is not present in the contested mark. Therefore, I do not find any likelihood of confusion between the two marks.

#### Conclusions on link

72. The enhanced distinctive character and significant reputation for the first earlier mark point in the opponent's favour. However, taking all of the above into account, i.e. also the low visual similarity, medium conceptual similarity, dissimilar goods, average degree of attention and no likelihood of confusion, I find that the relevant public would not make a link between the respective marks.

73. As addressed at paragraph 62 above, I have found that the evidence indicates that the first earlier mark had acquired a significant reputation amongst the UK public for certain class 33 goods, but that there was no evidence regarding use of the second earlier mark and thus insufficient basis on which to find a reputation for this mark. Though, in case I am wrong in this finding and, for the sake of completeness, I have also considered whether a link would be established between the contested mark and the second earlier mark. In this regard and taking into account the low-to-medium visual similarity, I consider that there are still sufficient visual differences (as detailed at paragraph 27) and that these, combined with the distance between the goods and lack of likelihood of confusion, means the average consumer will not establish a link between the contested mark and second earlier mark.

74. Since I have not found a link, it is not necessary for me to go on to consider whether any of the necessary injuries exist. However, even if I had found a link (and the opponent's mark *is* brought to mind) then I consider that this link would be so weak that it would be dismissed as no more than a coincidence.

75. The opposition under section 5(3) fails.

## **CONCLUSION**

76. The opposition has failed and the application may proceed to registration in full.

## **COSTS**

77. The applicants have been successful and are entitled to a contribution towards their costs based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the sum of £700.00, calculated as follows:

Preparing a counterstatement and considering other side's statement	£300
Considering the other side's evidence	£400

**Total**

**£700**

78. I therefore order Mast-Jägermeister SE to pay Shenzhen Jiufa Jewelry Co., Ltd. and Jiangsu Taizhou Juzichen Trading Co., Ltd. the sum of **£700.00**. This 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 20<sup>th</sup> day of September 2024**

**C IRELAND**

**For the Registrar**