

o/0940/24

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003871067

BY MALCOLM FARQUHARSON

TO REGISTER THE TRADE MARK:

BIG WHALE VODKA

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 440565

BY GRAY WHALE TRADEMARK OWNER, LLC

BACKGROUND AND PLEADINGS

1. On 24 January 2023, Malcolm Farquharson (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 3 February 2023. The applicant seeks registration for the following goods:

Class 33 Alcoholic beverages, except beer; Alcoholic beverages (except beer);
Alcoholic beverages except beers; Alcoholic beverages (except beers);
Alcoholic beverages [except beers]; all being vodka or vodka based
alcoholic beverages.

2. The application was opposed in full by Gray Whale Trademark Owner, LLC (“the opponent”) on 2 May 2023 based upon sections 5(2)(b) and 3(3)(b) of the Trade Marks Act (“the Act”). However, the opponent withdrew its section 3(3)(b) ground in writing within its submissions in lieu dated 15 March 2024. Therefore, under section 5(2)(b), the opponent relies upon the following trade mark:

GRAY WHALE

Comparable trade mark (IR) registration no. UK0000801454155¹

Filing date 9 January 2019; Registration date 13 August 2019.

Relying upon all of the goods for which the earlier mark is registered, namely:

Class 33 Distilled spirits; gin; liquor.

3. Under section 5(2)(b), the opponent opposes all of the applicant’s goods, claiming that there is a likelihood of confusion because the marks are similar and the goods are identical/similar.

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

4. The applicant filed a counterstatement denying the claims made.

5. The opponent is represented by Beck Greener LLP and the applicant is represented by BDB Pitmans LLP.² Neither party requested a hearing, however, the applicant filed evidence in chief, and both the applicant and the opponent filed written submissions in lieu. I make this decision having taken full account of all the papers, referring to them below as necessary.

6. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

EVIDENCE AND PRELIMINARY ISSUES

7. The applicant's evidence consists of the witness statement of Malcom Farquharson dated 18 January 2024. Mr Farquharson's statement is accompanied by 16 exhibits (MF01-MF16).

8. I note that within Mr Farquharson's statement, he submits that the opponent only produces and sells gin. This is supported by a screenshot of the opponent's website contained in **exhibit MF02**. Whilst this evidence has been filed with the intention to show that the goods sold by the opponent are more limited than its specification, it does not assist the applicant. The opponent's mark qualifies as an earlier mark in accordance with section 6(1)(ab) as its filing date is earlier than the filing date of the applicant's mark. The opponent's mark had not completed its registration process more than five years before the relevant date (the filing date of the applicant's mark). Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely upon all of its goods without demonstrating that it has used its mark.

² A Form TM33 was filed on 14 June 2023 which assigned BDB Pitmans LLP as the applicant's representative.

9. For the sake of completeness, I also note that within paragraph 13 of the applicant's submissions, they list 4 example IPO decisions "where the difference in the first letter of a mark was considered sufficient to avoid a likelihood of confusion under section 5(2)(b) let alone a whole word". However, each case is decided on its own facts and in this case, as highlighted by the applicant, the facts of these cases do not mirror each other (difference in first letter v difference in first word). Therefore the finding of no confusion in these decisions has no weight in these proceedings. Moreover, I am not bound by previous decisions of this Tribunal. This submission, therefore, does not assist the applicant.

10. Lastly, I note that the applicant's specification contained within paragraph 1 of this decision did not originally contain the limitation "all being vodka or vodka based alcoholic beverages". This was added by way of a Form TM21B which was filed by the applicant on 4 January 2024 (which is exhibited at **MF05**).

11. On 8 January 2024, the Registry issued an official letter confirming the specification amendment and asking the opponent whether the limitation allowed the opposition to be withdrawn. However, on 9 January 2024, the opponent confirmed that the opposition is maintained.

DECISION

Section 5(2)(b)

12. Section 5(2)(b) reads as follows:

"5(2) A trade mark shall not be registered if because –

(a)...

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

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

Section 5(2)(b) case law

13. 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 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

14. The competing goods are as follows:

Opponent's goods	Applicants' goods
<u>Class 33</u> Distilled spirits; gin; liquor.	<u>Class 33</u> Alcoholic beverages, except beer; Alcoholic beverages (except beer);

	Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; all being vodka or vodka based alcoholic beverages.
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15. When making the comparison, all relevant factors relating to the goods 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:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

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

- (a) The respective 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

17. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, Case T-133/05, the General Court (“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.”

18. While expressed slightly differently, all of the applicant’s terms listed within its class 33 specification are alcoholic beverages, except beers. I note that the addition of the limitation “all being vodka or vodka based alcoholic beverages” limits the goods further.

19. The term “distilled spirits” in the opponent’s specification would cover vodka. Therefore all of the applicant’s “alcoholic beverages, except beer [...] all being vodka [...]”, would fall within the broader category of “distilled spirits” in the opponent’s specification, making the goods identical on the principle outlined in *Meric*.

20. For all of the remaining “alcoholic beverages, except beer [...] all being [...] vodka based alcoholic beverages”, I consider that these goods are similar to the opponent’s “distilled spirits”. I consider that the goods are all alcoholic drinks, which are commonly consumed for pleasure whilst socialising, or with the intention of becoming intoxicated. As a result, the goods overlap in nature, method of use and purpose. The goods also overlap in user, being consumed by adults over the age of 18. Taking the above into account, I consider that the goods would be sold by the same vodka undertakings and located in close proximity within the same retailers and displayed near each other

behind a bar. I also consider that the goods are likely to be in competition. Consequently, I consider that the goods are similar to a high degree.

The average consumer and the nature of the purchasing act

21. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the 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 (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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

22. The average consumers for the goods will be adult members of the general public over the age of 18. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the origin of the goods, the cost, flavour, ingredients and alcohol percentage. I therefore agree with the opponent that a medium degree of attention will be paid during the purchasing process.

23. The goods are likely to be purchased by self-selection from the shelves of retail outlets such as supermarkets and off-licences, and their online equivalents. Such goods are also sold in bars and restaurants, being displayed behind the counter or on a drink's menu. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the

purchase given that the goods could be verbally ordered at a table or bar, or if stocked behind a counter, the average consumer may have to ask the sales assistant for them.

Comparison of the trade marks

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

25. 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.

26. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
GRAY WHALE	BIG WHALE VODKA

27. The opponent's mark consists of the words “GRAY WHALE”. I consider that the overall impression lies in the combination of these elements.

28. The applicant's mark consists of the words "BIG WHALE VODKA". The word "VODKA" is descriptive of the applicant's goods, as indicated by its specification's limitation. Therefore the word "VODKA" plays a lesser role in the overall impression of the mark, with the words "BIG" and "WHALE" playing an equal and greater role.

29. Visually, the marks coincide in the word "WHALE". This acts as a visual point of similarity. However, the opponent's mark starts with the word "GRAY" and the applicant's mark starts with the word "BIG", which as noted by the applicant, is a position to which the average consumer pays more attention to.³ This acts as a visual point of difference. The applicant's mark also ends in the word "VODKA". I note that the opponent states that this word should be "discounted for the purposes of comparison", however, whilst it is descriptive, it is not negligible. Therefore, it still acts as visual points of difference. As a result, I consider that the marks are visually similar to between a low and medium degree.

30. Aurally, the opponent's and applicant's marks consist of ordinary dictionary words which would be given their usual pronunciation. On this basis, the marks only overlap on the pronunciation of the word "WHALE", and therefore the marks are aurally similar to between a low and medium degree.

31. Conceptually, the ordinary dictionary word "GRAY" is another spelling of the word "grey". The word "WHALE" is also an ordinary dictionary word, which will be recognised by the average consumer as a marine mammal. I therefore consider that the opponent's mark evokes the meaning of "a whale that is the colour grey". The applicant's mark evokes the meaning of a vodka called "BIG WHALE" (a whale which is big). Therefore as the marks overlap in the concept of a whale, I consider that they are conceptually similar to no more than a medium degree.

Distinctive character of the earlier trade mark

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

³ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

“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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

33. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

34. Firstly, I note that the applicant has filed evidence to support its statement that the word “whale” “in conjunction with other words is in common use in connection with the production and sale of alcoholic beverages”. Exhibited at **MF06** is a list of UK IPO registered word marks which use the word “WHALE” for class 33 goods.

35. The applicant has also provided evidence which they claim suggests that the word “WHALE” is commonly used to market alcoholic beverages. **Exhibits MF07 to MF11**,

and **MF13**, **MF15** and **MF16** contains google searches, dated 19 October 2023, for the following phrases:

- a) "WHALE CALLER".
- b) "WHALE POINT".
- c) "GHOST WHALE".
- d) "WHALE'S TALE WINE".
- e) "WHALE WATCHER WINE".
- f) "WHALE WHISKY".
- g) "WHALE'S TALE PALE ALE".
- h) "WHALE PARKING".

36. The searches indicate that the above marks are used on wine, beers and whiskey.

37. Moreover, **exhibit MF12** contains screenshots from the website kujirawhisky.com dated 19 October 2023. Whilst Mr Farquharson states that Kujira's website makes extensive use of whales in its branding and refers to the goods as "WHALE WHISKEY", I note that within the exhibit, there is no reference or use of the words "WHALE WHISKEY". However, the bottle labels of Kujira's goods depict a whale.

38. Lastly, I note that **exhibit MF14** contains Kujira's logo on the IPO register, however, the word "whale" is not contained within it.⁴

39. I note the following discrepancies with the applicant's above evidence:

- a) The printouts are all dated 19 October 2023, after the relevant date.
- b) Apart from Kujira's website (which does not use the word "WHALE"), I have only been provided with google search screenshots, and no examples of how these goods have been used in practice (such as screenshots from the actual websites themselves, or from other retailers, showing these goods actually for sale, with a price etc.)

⁴ Whilst I note that the applicant states that "Kujira" is Japanese for "whale", I do not have any evidence of this translation, nor do I consider that the UK average consumer would know the meaning of "Kujira". Therefore exhibit MF14 does not assist the applicant.

- c) I have no turnover or sales information, or market share percentage, for any of the registrations.
- d) Kujira's website is a ".com" site which can be accessed worldwide, and therefore does not specifically pertain to the UK.

40. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II-4865, paragraph 68, and Case T-29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II-5309, paragraph 71)."

41. The mere fact that **exhibit MF06** shows that there are multiple marks on the Register which contain the word "WHALE" for class 33 goods in the UK is not relevant to my assessment. Whilst Mr Farquharson has tried to support this evidence, with google search examples of other "WHALE" marks, as noted in paragraph 39 above, the evidence contains multiple deficiencies. Consequently, I do not consider that the evidence sufficiently shows that the distinctive character of the word "WHALE" has been weakened because of its frequent use in the fields concerned. Consequently, the evidence does not assist the applicant.

42. Therefore, as the opponent has not filed any evidence to show that the distinctiveness of its mark has been enhanced through use, I only have the inherent position to consider.

43. I note that the opponent submits that its mark is inherently distinctive to a high degree. However, as noted above, the ordinary dictionary word “GRAY” is another spelling of the word “grey”, and a “WHALE” (also an ordinary dictionary word) will be recognised by the average consumer as a marine mammal. Therefore, as a whole, the average consumer will see the opponent’s “GRAY WHALE” mark as evoking the meaning of “a whale that is the colour grey”. Whilst this is neither descriptive or allusive of the opponent’s goods, it is a graspable and recognisable concept and thus, I find that the opponent’s mark is inherently distinctive to a medium degree.

Likelihood of confusion

44. 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 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. The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. 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 he has retained in his mind.

45. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually and aurally similar to between a low and medium degree.
- I have found the marks to be conceptually similar to no more than a medium degree.

- I have found the earlier mark to be inherently distinctive to a medium degree.
- I have identified the average consumer for the goods to be adult members of the general public over the age of 18, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical or similar to a high degree.

46. Taking all of the above factors listed in paragraph 45 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. Whilst the descriptive word "VODKA" at the end of the applicant's mark could be overlooked, as noted above, the beginning of the marks tend to make more of an impact than the ends, and the average consumer will be paying a medium degree of attention when selecting the goods. Therefore, I do not consider that the average consumer would overlook the words "GRAY" or "BIG" which appears at the beginning of the parties' marks, which contributes equally to their overall impressions, alongside the word "WHALE". I do not consider there to be a likelihood of direct confusion.

47. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"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)".

48. 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.

49. As highlighted above, Mr Purvis Q.C. in *L.A. Sugar Limited* sets out that there are three main categories of indirect confusion, and that indirect confusion 'tends' to fall in one of them. I note that the opponent has not stated specifically what category this

case would fall within or suggested any alternative way in which indirect confusion might arise. However, for the sake of completeness, I will go through each category.

50. Firstly, indirect confusion might arise where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. In this instance, I do not consider that the ordinary dictionary word, WHALE, which has a recognisable meaning to the average consumer, is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. As established above, the opponent's mark is inherently distinctive to a medium degree, which has not been enhanced. The first category is therefore not satisfied.

51. This leads to the second category from *L.A. Sugar*, where the later mark simply adds a non-distinctive element to the earlier mark. For this category to be satisfied, the opponent's mark as a whole, that being "GRAY WHALE", would need to be reproduced, with an addition of a non-distinctive element. However, in this case, it is not. Therefore, this category is also not satisfied.

52. Lastly, where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, the word "WHALE" in both marks are preceded with either the words "GRAY" or "BIG". I do not consider that changing the word "GRAY" to "BIG", or vice versa, is neither logical, nor consistent with a brand extension. Firstly, as highlighted above, the words "GRAY WHALE" and "BIG WHALE" play an equal role in the overall impression of the parties' marks. Secondly, whilst the words "GRAY" and "BIG" are both words which are used to describe the "whale", they are different types of descriptors; one is commenting on the colour of the whale and the other is commenting on the size. I therefore consider that the applicant's mark is a step too-far removed from being a logical brand extension, or a logical sub-brand of the opponent's mark. I therefore do not consider that the third category is satisfied.

53. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the applicant's mark could be indirectly confused with the opponent's and the

opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

54. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

55. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023.

56. As noted above, the applicant's evidence did not assist the applicant. On this basis, I shall not be awarding any costs in relation to it. Consequently, I award the applicant the sum of **£600** as a contribution towards the costs of the proceedings.

57. The sum is therefore calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£250
Preparing and filing written submissions in lieu	£350
Total	£600

58. I therefore order Gray Whale Trademark Owner, LLC to pay Malcolm Farquharson the sum of £600. This sum is to 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 30th day of September 2024

L FAYTER

For the Registrar