O-0943-24

TRADE MARKS ACT 1994

IN THE MATTER OF CONSOLIDATED PROCEEDINGS

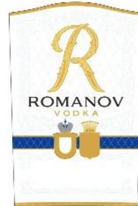
CONCERNING THE UK DESIGNATION OF

INTERNATIONAL REGISTRATION NOS 1636506 & 1634895

AND TRADE MARK REGISTRATION NOS 1518516 & 1193611

IN THE NAME OF WTM ESTABLISHMENT FOR THE FOLLOWING MARKS:

&



&

ROMANOV
POMAHOB

&

ROMANOV

AND

OPPOSITION THERETO/CANCELLATION THEREOF (UNDER NOS. 433995, 434002, 505221 & 505222)

BY CARLSBERG MARSTON'S BREWING COMPANY LIMITED

BACKGROUND

1) WTM Establishment ('WTM') is the holder of the following International Registrations ('IR(s)'):

- IR 1636506 ('the bottle mark')

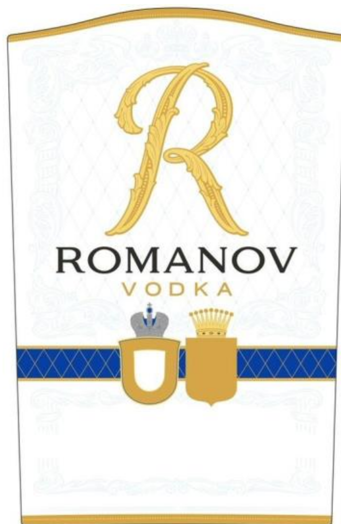
Class 33: Vodka produced in Russia.

Priority date: 19 April 2021
UK designation date: 17 May 2021

Type of mark: Three dimensional

Disclaimer: Wording 'VODKA'; shape of the bottle.
Colours claimed: White, blue, grey, black and gold.

- IR 1634895 ('the label mark')



Class 33: Vodka produced in Russia.

Priority date: 17 April 2021
UK designation date: 20 May 2021

Disclaimer: Wording 'VODKA'
Colours claimed: White, blue, brown, brown-yellow, light blue, grey and black.

- IR 1518516 ('the ROMANOV POMAHOB mark')

ROMANOV
POMAHOB

Class 32: Beer; ginger beer; malt beer; preparations for making liqueurs; beer wort; malt wort; extracts of hops for making beer.

Class 33: Aperitifs; arrack [arak]; brandy; wine; sparkling wine; piquette; whisky; vodka; kirsch; gin; cocktails; curacao; liqueurs; alcoholic beverages, except beer; pre-mixed alcoholic beverages, other than beer-based; alcoholic beverages containing fruit; distilled beverages; peppermint liqueurs; bitters; rum; sake; perry; cider; rice alcohol; alcoholic extracts; fruit extracts, alcoholic; alcoholic essences.

International registration date/UK designation date: 20 May 2021
Date of protection in the UK: 22 October 2020

- IR 1193611 (‘the ROMANOV mark’)

ROMANOV

Class 33: Alcoholic beverages (except beers).

International registration date/UK designation date: 27 November 2013
Date of protection in the UK: 14 August 2014

2) Carlsberg Marston’s Brewing Company Limited (‘Carlsberg’) opposes the registration of the bottle mark and the label mark in the UK and requests that the ROMANOV POMAHOB and ROMANOV designations in the UK are cancelled. The opponent claims that the bottle mark and the label mark offend under Section 5(2)(b) of the Trade Marks Act 1994 (‘the Act’). It claims that the ROMANOV POMAHOB mark offends under Sections 47(2)(a) and 5(2)(a) & 5(2)(b) of the Act and that the ROMANOV mark offends under Sections 47(2)(a), 5(1) and 5(2)(b) of the Act.

3) Although two marks were originally relied upon, at the hearing Ms Blythe confirmed that the opponent now relies upon the following mark in respect of ‘vodka’ only:

- **UKTM 2028806**

ROMANOFF

Class 39: Vodka.

Filing date: 01 August 1995
Date of entry in register: 17 May 1996

4) The trade mark relied upon by the opponent is an earlier mark, in accordance with section 6 of the Act. As it completed its registration procedure more than five years prior to the priority/application date (as applicable) of the contested marks, it is, in principle, subject to the proof of use conditions, as per section 6A of the Act. However, given the applicant's concession that the earlier mark has been used for 'VODKA'[1], Carlsberg is not required to furnish proof of use.

5) The holder filed a counterstatement in defence of each of its marks, denying that there is a likelihood of confusion/identity between the marks. As I have already said, it accepts that the earlier ROMANOV mark has been put to genuine use in respect of 'Vodka'. It also makes concessions as to the phonetic identity and similarity between the words ROMANOV and ROMANOFF. The defences of 'honest concurrent use' and 'statutory acquiescence'[2] are relied upon.

6) Carlsberg is represented by Barker Brettell LLP; WTM is represented by M.J.P. Deans. Carlsberg's evidence in chief consists of a witness statement in the name of Paul Waller with six exhibits. WTM's evidence consists of three witness statements. The first is from David Rose (with one exhibit), the second is from Mike Heaton and the third is from Frederick Fullman (with twelve exhibits). Carlsberg filed evidence in reply consisting of a second witness statement from Mr Waller. A hearing took place before me at which Carlsberg was represented by Ms Charlotte Blythe, of Counsel, instructed by Barker Brettell LLP and WTM was represented by Mr Andrew Norris, of Counsel, instructed by M.J.P. Deans.

DECISION

[1] As per the counterstatements at [3].
[2] See, in this connection, Mr Norris' skeleton argument, [40] – [51]

7) I do not consider it necessary to set out sections 5(1) and 5(2)(a) of the Act. Both of these sections require that the respective marks be identical and it is plain to see that none of the respective marks are identical. Section 5(2)(b) of the Act states:

> "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.
>
> 5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only."

8) Section 47(2)(a) of the Act is also relevant insofar as the applications for cancellation are concerned. It provides that:

> "47. (1) […]
>
> (2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-
>
> > (a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
> >
> > (b) …
> >
> > unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

9) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P.

The principles

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10) Both the label mark and the bottle mark are applied for in respect of ‘Vodka produced in Russia’ in class 33. These goods are plainly identical to Carlsberg’s ‘Vodka’ in class 33.

11) WTM concedes that the goods covered by the ROMANOV mark, namely, ‘alcoholic beverages (except beer)’ in class 33 incorporate Carlsberg’s ‘Vodka’ and those goods are therefore identical.

12) Turning to the ROMANOV POMAHOB mark, this is protected for the following goods:

Class 32: Beer; ginger beer; malt beer; preparations for making liqueurs; beer wort; malt wort; extracts of hops for making beer.

Class 33: Aperitifs; arrack [arak]; brandy; wine; sparkling wine; piquette; whisky; vodka; kirsch; gin; cocktails; curacao; liqueurs; alcoholic beverages, except beer; pre-mixed alcoholic beverages, other than beer-based; alcoholic beverages containing fruit; distilled beverages; peppermint liqueurs; bitters; rum; sake; perry; cider; rice alcohol; alcoholic extracts; fruit extracts, alcoholic; alcoholic essences.

WTM accepts that the underlined goods shown above are identical to Carlsberg's 'Vodka'. As for the remaining goods in the contested specification, it accepts that these are similar to 'Vodka', with the degree of similarity being low to moderate[3]. Bearing in mind the interdependency principle (that a greater degree of similarity between the respective marks may outweigh a lower degree of similarity between the goods and vice versa), I will consider whether there is any greater degree of similarity between the opponent's 'vodka' and the applicant's goods than has already been conceded (with the exception of those that have been conceded to be identical). I will first consider the contested goods in class 32, grouping terms together where I consider it appropriate to do so, before moving on to consider the contested goods in class 33.

Class 32

Beer; ginger beer; malt beer

13) There is some degree of overlap in nature, purpose and method of use between these goods and the opponent's vodka because they are all alcoholic drinks that will be drunk and the trade channels will overlap. However, the respective goods are produced in different ways; the applicant's goods being produced by brewing (involving fermentation) whereas the opponent's vodka is produced by distillation. The respective goods also taste very different and typically have quite different alcoholic

[3] See Mr Norris' skeleton argument at [24] and his oral submissions made at the hearing (page 20 -21 of the hearing transcript at the final paragraph and first paragraph, respectively).

strengths with the ‘alcohol-by-volume’ content of the applicant’s goods being a lot lower than for the opponent’s vodka. As such, there is unlikely to be any significant degree of competition between the goods and nor are they complementary. Bearing all of this in mind, I cannot see that there is any greater degree of similarity between the holder’s ‘beer; ginger beer; malt beer’ and the opponent’s ‘vodka’ than has already been conceded by the holder. I therefore proceed on the basis of that concession which is that there is a <u>low to moderate</u> degree of similarity between the relevant goods.

beer wort; malt wort; extracts of hops for making beer

14) The goods listed above are obviously no closer to the opponent’s ‘vodka’ than those considered in the preceding paragraph. I therefore proceed on the basis of the holder’s concession which is that there is a <u>low to moderate</u> degree of similarity between the relevant goods.

Preparations for making liqueurs

15) In my experience liqueurs are usually made from spirits and, frequently, from vodka. There is, therefore, some overlap in purpose because both parties’ goods may be used to make liqueurs. Their respective nature is similar because the holder’s goods may be in the form of a liquid containing, amongst other ingredients, spirits/vodka and they are likely to share trade channels. I find an <u>above-medium</u> degree of similarity between the relevant goods.

<u>Class 33</u>

Cocktails; pre-mixed alcoholic beverages, other than beer-based; alcoholic beverages containing fruit; fruit extracts, alcoholic; alcoholic essences; alcoholic extracts

16) All of the above goods could be based upon vodka or have vodka as a principal ingredient. Their respective nature is therefore similar and they are likely to share trade channels and users. I find an <u>above-medium</u> degree of similarity between the relevant goods.

Aperitifs; curacao; liqueurs; peppermint liqueurs; Bitters

17) The above goods are produced from spirits with additional flavourings and typically have a fairly high ‘alcohol by volume’ content. That being so, I find that these goods are similar in nature to the opponent’s vodka, being also a type of spirit with a high ‘alcohol by volume’ content. The respective goods are likely to share trade channels and users and there may be some competition between them. I find an above-medium degree of similarity between the relevant goods.

Arrack; Kirsch; brandy; whisky; gin; rum

18) Like the opponent’s goods, these are spirits made by the process of distillation. They tend to have a similar ‘alcohol by volume’ content to that of vodka and are likely to be stocked in fairly close proximity in a retail establishment. There may also be a good degree of competition in play between the relevant goods. I find a high degree of similarity between the relevant goods.

perry; cider

19) There is some degree of overlap in nature, purpose and method of use between these goods and the opponent’s vodka because they are all alcoholic drinks that will be drunk and the trade channels will overlap. However, the respective goods taste very different and are produced in quite different ways; the applicant’s goods being produced by fermentation of fruit, whereas the opponent’s vodka is produced by distillation. The respective goods also typically have very different alcoholic strengths with the ‘alcohol-by-volume’ content of the applicant’s goods being a lot lower than for the opponent’s vodka such that there is unlikely to be any real competition between the goods and there is also no complementary relationship in play. Bearing all of this in mind, I cannot see that there is any greater degree of similarity between the holder’s ‘perry; cider’ and the opponent’s ‘vodka’ than has already been conceded by the holder. I therefore proceed on the basis of that concession which is that there is a low to moderate degree of similarity between the relevant goods.

wine; sparkling wine; piquette; sake; rice alcohol

20) There is some degree of overlap in nature, purpose and method of use between these goods and the opponent's vodka because they are all alcoholic drinks that will be drunk and the trade channels will overlap. However, the respective goods taste quite different and are produced in quite different ways; the applicant's goods being produced by fermentation of fruit (e.g. grapes) or fermentation and brewing of rice, whereas the opponent's vodka is produced through distillation. The 'alcohol-by-volume' content of the holder's goods is also typically somewhat lower than that of vodka such that they are not interchangeable and nor are they complementary. Bearing all of this in mind, I cannot see that there is any greater degree of similarity between the holder's 'wine; sparkling wine; piquette; sake; rice alcohol' and the opponent's 'vodka' than has already been conceded by the holder. I therefore proceed on the basis of that concession which is that there is a low to moderate degree of similarity between the relevant goods.

Average consumer and the purchasing process

21) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. 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."

22) The average consumer of the goods at issue is a member of the general public over the age of 18 and businesses such as pubs, bars and restaurants. These are

goods which are, generally, not particularly expensive and are likely to be purchased fairly frequently. The average consumer may, however, wish to ensure that they are selecting a preferred type, strength, or flavour before making their selection. I find that a medium level attention will likely be paid. I bear in mind that the goods may be requested orally in bars and restaurants and therefore aural considerations must be borne in mind. However, in those circumstances, the average consumer is still likely to encounter the marks visually before placing their order due to exposure of the marks on beer taps at a bar and/or spirit bottles visible behind the bar, for instance.[4] The goods will also be sought out visually on supermarket/off-license shelves (or from trade catalogues/brochures in the case of a business consumer) where the visual aspect will dominate the selection process.

Comparison of marks

23) 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."

It would be wrong, therefore, to dissect the marks artificially, although it is necessary to take account of their distinctive and dominant components and to give due weight

[4] *Rani Refreshments FZCO v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-523/12 and *Simonds Farsons Cisk plc v OHIM*, Case T-3/04.

to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24) I will consider each of WTM's marks in turn, comparing it with Carlsberg's mark. Before I do so, I note here that the earlier mark consists solely of the word, ROMANOFF, and therefore the overall impression of that mark lies solely in that word.

The ROMANOV mark

25) The overall impression of the contested mark, ROMANOV, lies solely in that word.

26) WTM concedes that the respective marks, ROMANOV and ROMANOFF, are visually similar, aurally identical and conceptually highly similar[5] (with both being likely to be perceived as similar Russian surnames[6]). Overall, they are clearly highly similar marks.

The ROMANOV POMAHOB mark

27) The relevant contested mark looks like this:

ROMANOV
POMAHOB

28) The contested mark consists of two identifiable elements: ROMANOV and POMAHOB. Neither appears to be materially more dominant than the other in the overall impression of the mark. Both elements are distinctive.

29) WTM concedes that the word ROMANOV in the contested mark is, of itself, highly similar to the earlier mark for the same reasons as set out above (in the comparison

[5] See the relevant Form TM8 and counterstatement, [6]
[6] Mr Norris' skeleton argument, [14]

with the ROMANOV mark)[7]. It is now necessary to consider the effect that the additional word, POMOHOB, has on the similarity between the marks overall.

30) The word POMAHOB in the contested mark has no counterpart in the earlier mark and therefore creates a clear point of aural and visual difference between the marks as wholes. Visually, I find there to be a medium degree of similarity overall between the marks. Aurally, POMAHOB is likely to be articulated as a three-syllable word (POM-A-HOB). This results in the contested mark having six syllables overall, the last three of which have no counterpart in the earlier mark. Overall, there is a medium degree of aural similarity between the marks.

31) Turning to the conceptual aspect, Mr Norris submitted that the contested mark may be perceived as a composite name. However, I agree with Ms Blythe's submission that the contested mark is unlikely to be perceived as a person's full name, bearing in mind that both parties are agreed that ROMANOV will be perceived as a surname[8]. Having recognised the first word in the mark as being a surname rather than a forename, this does not naturally lead one to perceive the mark, as a whole, as a person's full name because, ordinarily, one would expect a full name to begin with a recognisable forename rather than a surname. I also do not consider that the two words in the mark combine to form any other kind of instantly recognisable conceptual unit. Carlsberg further submits that 'POMAHOB' is the Russian translation of 'ROMANOV' and therefore both words in the contested mark have the same concept. I do not consider that the average consumer in the UK will know that POMAHOB has the same meaning as ROMANOV. In my view, the average consumer, having recognised that ROMANOV is a Russian surname in the contested mark (as agreed by the parties) is likely to perceive POMAHOB as another Russian word of some sort, perhaps as another Russian surname or some other Russian word of unknown meaning. Either way, I find that there is at least a medium degree of conceptual similarity between the marks overall, stemming from the respective ROMANOV and ROMANAFF elements being perceived as similar Russian surnames.

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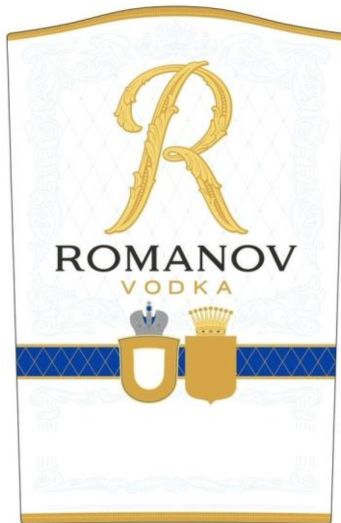
[7] As per the relevant Form TM8 and counterstatement, [6]
[8] ibid

The label mark

32) The relevant mark looks like this:



33) The contested mark consists of a number of elements. There is the stylised letter 'R', the word ROMANOV, the descriptive word 'VODKA', the blue ribbon with shields and the border. The particular colours in which those elements are presented are also claimed as a feature of the mark. Of all of those elements, I find that it is the stylised letter 'R' and the word ROMANOV which have the greatest weight in the overall impression, and roughly equally so, owing to their visual prominence and relatively greater degree of distinctiveness, as compared to the other elements in the mark. The other elements of the mark contribute to the overall impression but to a lesser extent than the letter 'R' and the word 'ROMANOV'.

34) Visually, there is a high degree of similarity between the word ROMANOV in the contested mark with the earlier mark, ROMANOFF. In all other respects, the marks are visually different. None of the other elements of the contested mark (as highlighted in the preceding paragraph) are present in the earlier mark. I find there to be a low-medium degree of visual similarity between the marks overall.

35) Aurally, WTM contends that, if the contested mark is articulated, it will be by the letter 'R' only. I do not accept this. It is far more likely that the average consumer will refer to the contested mark by the ROMANOV element. It is unlikely, in my view, that

the consumer will also articulate the letter ‘R’ or any of the other elements within the mark. On that basis, the marks would be aurally identical (given that WTM has already conceded that the words ROMANOV and ROMANOFF are phonetically identical). If I am wrong about that, and the consumer does articulate the letter ‘R’, this is likely to be in conjunction with the word ROMANOV i.e. the mark will be pronounced as ‘R ROMANOV’. In that scenario, the marks would still be aurally highly similar overall.

36) Conceptually, WTM points out that the contested mark will be perceived as a label and the earlier mark is a word. It does, though, accept that ROMANOV on the label will be perceived as being a Russian surname which is similar to the Russian surname, ROMANOFF. Given that the word ROMANOV is one of the more dominant elements of the contested mark and that the letter ‘R’ portrays nothing more than the concept of a single letter, the marks are highly similar from a conceptual point of view. I find this to be the case whether or not any of the other elements of the contested mark also contribute to the conceptual hook.

The bottle mark

37) The relevant mark looks like this:

38) The contested mark is a three-dimensional one consisting of a bottle with a gold-coloured neck and top which is adorned with the same front label as is depicted in the contested label mark. There is also a second label on the rear of the bottle which has the word ROMANOV written upon it and a blue horizontal ribbon-type element. Within that rear label, it is the word ROMANOV which is the most dominant element. Considering the mark overall, I find that it is the front label which will attract the most focus from the average consumer and, within that label it is the word ROMANOV and the stylised letter ‘R’ which have the greatest weight for reasons already given above in relation to the label mark.

39) Visually, the contested mark is a three-dimensional shape of a bottle with a gold-coloured neck and top, which has no counterpart in the earlier word-only mark. Nevertheless, the aspect of the contested mark which will attract the greatest amount of focus is the front label (and to a lesser extent the back label). I have already found that the word ROMANOV is the dominant element of the rear label and is one of the most dominant elements of the front label. Bearing in mind my assessment of the visual similarities between the word ROMANOFF and the front label (as already

conducted earlier), I find that the word-mark ROMANOFF is visually similar to the contested three-dimensional mark to a low degree.

40) Aurally, the average consumer is most likely to articulate an element/elements which are on the front label of the bottle. Accordingly, the same findings apply to this mark as those given above in relation to the label mark. I adopt those same findings here. The marks are therefore aurally identical or at least highly similar.

41) Conceptually, WTM points out that the contested mark will be perceived as a bottle whereas the earlier mark is simply a word. It accepts, though, that ROMANOV on the labels will be perceived as being a Russian surname which is similar to the Russian surname, ROMANOFF[9]. Given that the word ROMANOV is one of the more dominant elements of the contested mark and that the letter 'R' portrays nothing more than the concept of a single letter, I find that the marks are highly similar from a conceptual point of view. I find this to be the case whether or not any of the other elements of the contested mark also contribute to the conceptual hook.

Distinctive character of the earlier mark

42) The distinctive character of the earlier mark must be considered. The more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

[9] See the relevant counterstatement, [8]

> 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)."

43) The earlier mark consists of the word ROMANOFF absent any stylisation. The parties agree that the mark will be perceived as a Russian surname. Ms Blythe argued that the earlier mark is inherently highly distinctive. Mr Norris, on the other hand, argued that the mark is low in distinctiveness. In support of this he referred to certain cases concerning names/surnames[10]. I do not consider that either of these cases establish a general rule that surnames should always be found to be low in distinctiveness merely because they are surnames. As Ms Blythe submitted, each case turns on its own facts.

44) I bear in mind that ROMANOFF is likely to be perceived as a Russian surname and is therefore unlikely to be a surname which is commonly encountered in use in the UK. Whilst I accept that vodka is notoriously associated with Russia, as highlighted by Mr Norris, I do not consider that this means that the particular Russian surname under consideration here, ROMANOFF, should automatically be attributed a low level of distinctiveness for such goods and there is no evidence before me to suggest otherwise. I find the earlier mark to have a medium degree of inherent distinctiveness.

45) Although Carlsberg filed evidence of use during the evidence rounds, Ms Blythe did not rely upon any enhanced distinctiveness though use. Her submissions at the hearing were based solely upon the inherent distinctiveness of the earlier mark.

[10] *Rossi v OHIM* (Case T-169/03) [83]; *Pia Hallstrom* (BL O/303/17)

Indeed, the only reference made by Ms Blythe to Mr Waller's evidence during the hearing was in relation to the matter of acquiescence. In any event, I find that the scale of use shown in the evidence before me is insufficient to demonstrate that there has been any enhancement to the inherent distinctiveness of the earlier mark. Although there have clearly been sales of vodka in the UK to various 'free trade customers' such as pubs, clubs and wholesalers, the scale of use is not particularly substantial and there is limited evidence of advertising or promotion of the mark and no evidence as to market share.

Likelihood of confusion

46) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V).*

<u>The label mark</u>

47) The respective marks are visually similar to a low-medium degree, aurally identical or at least highly similar and conceptually similar to a high degree. The respective goods are identical. The average consumer is likely to pay a medium degree of attention during a mainly visual purchase. The earlier mark has a medium degree of distinctiveness. Bearing all of these factors in mind, I find that there is a likelihood of the average consumer confusing the marks when used on the goods at issue. Even if they recall the differences between the marks, they are, at the very least, likely to believe that the respective goods come from the same undertaking. **The opposition succeeds against the label mark.**

<u>The bottle mark</u>

48) The respective marks are visually similar to a low degree, aurally identical or at least highly similar and conceptually similar to a high degree. The respective goods are identical. The average consumer is likely to pay a medium degree of attention during a mainly visual purchase. The earlier mark has a medium degree of distinctiveness. Bearing all of these factors in mind, I find that there is a likelihood of the average consumer confusing the marks when used on the goods at issue. Even if they recall the differences between the marks, they are, at the very least, likely to believe that the respective goods come from the same undertaking. **The opposition succeeds against the bottle mark.**

The ROMANOV mark

49) The respective marks are visually similar to a high degree, aurally identical and conceptually similar to a high degree. The respective goods are identical on the basis that the contested specification covers the opponent's goods. The average consumer is likely to pay a medium degree of attention during a mainly visual purchase. The earlier mark has a medium degree of distinctiveness. Bearing all of these factors in mind, I find that there is a likelihood of the average consumer imperfectly recalling the relevant marks and being directly confused between them in respect of all of the goods at issue. In reaching this conclusion, I have borne in mind the fall-back specification put forward by the holder[11]. However, I remind myself that the holder has conceded that the goods in the fall-back specification are similar to vodka to at least a low-moderate degree[12]. Bearing in mind this concession together with the high degree of similarity between the marks and the likelihood of them being imperfectly recalled as being the same, I find that there is still a likelihood of confusion in respect of such goods, having due regard for the interdependency principle. **The application for cancellation succeeds entirely against the ROMANOV mark.**

[11] Mr Norris' skeleton argument, [30]
[12] The goods in the fall-back being the same as those covered by the ROMANOV POMAHOB mark in class 33.

The ROMANOV POMAHOB mark

50) The respective marks are visually, aurally and conceptually similar to a medium degree. Some of the respective goods are identical; others are similar to varying degrees ranging from low-moderate to above-medium to high. The average consumer is likely to pay a medium degree of attention during a mainly visual purchase. The earlier mark has a medium degree of distinctiveness. Bearing all of these factors in mind, I find that there is no likelihood of the marks being imperfectly recalled as being the same in relation to any of the goods at issue; there is no likelihood of direct confusion.

51) I will now consider the likelihood of indirect confusion. This is when the average consumer recognises that the marks are not the same but puts the similarities between them (and the goods) down to the respective goods coming from the same or linked undertaking(s). In this connection, I bear in mind that in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10 (*L.A. Sugar),* Mr Iain Purvis Q.C. (as he then was), sitting 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)".

52) I also keep in mind that 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. Furthermore, it is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17. This is mere association not indirect confusion.

53) The categories listed above in *L.A. Sugar* are, of course, not an exhaustive list of all the ways in which indirect confusion can occur; they are merely examples of the way in which it tends to occur.

54) In the case before me, I find that the average consumer is likely, where there is at least an above-medium degree of similarity between the goods, to believe that they come from the same or linked undertaking(s). In reaching this view, I have borne in mind that the average consumer may misremember the respective words ROMANOV and ROMANOFF as being the same. In those circumstances, I find that the presence of the additional word, POMAHOB, in the contested mark is likely to be put down to a

sub-branding or co-branding of the earlier mark where the goods are similar to at least an above-medium degree. There is, therefore, a likelihood of indirect confusion between the marks in respect of such goods. However, where there is only a low-moderate degree of similarity between the respective goods, I find that there is no likelihood of indirect confusion bearing in mind that there is no more than a medium degree of similarity between the marks overall and that the earlier mark has no more than a medium level of distinctiveness.

55) **The application for cancellation succeeds against the following underlined goods covered by the ROMANOV POMAHOB mark only:**

> **Class 32:** Beer; ginger beer; malt beer; preparations for making liqueurs; beer wort; malt wort; extracts of hops for making beer.
>
> **Class 33:** Aperitifs; arrack [arak]; brandy; wine; sparkling wine; piquette; whisky; vodka; kirsch; gin; cocktails; curacao; liqueurs; alcoholic beverages, except beer; pre-mixed alcoholic beverages, other than beer-based; alcoholic beverages containing fruit; distilled beverages; peppermint liqueurs; bitters; rum; sake; perry; cider; rice alcohol; alcoholic extracts; fruit extracts, alcoholic; alcoholic essences.

Statutory Acquiescence

56) The holder relies upon the defence of statutory acquiescence in relation to the ROMANOV mark. The relevant part of Section 48 of the Act provides, as follows:

> "(1) Where the proprietor of an earlier trade mark or other earlier right has acquiesced for a continuous period of five years in the use of a registered trade mark in the United Kingdom, being aware of that use, there shall cease to be any entitlement on the basis of that earlier trade mark or other right – (a) to apply for a declaration that the registration of the later trade mark is invalid, or (b) to oppose the use of the later trade mark in relation to the goods and services in relation to which it has been so used, unless the registration of the later trade mark was applied for in bad faith.

(2) Where subsection (1) applies, the proprietor of the later trade mark is not entitled to oppose the use of the earlier trade mark or, as the case may be, the exploitation of the earlier right, notwithstanding that the earlier trade mark or right may no longer be invoked against his later trade mark."

57) As Ms Blythe pointed out at the hearing, the earliest date of use shown in the holder's evidence is 30 August 2017[13], being less than five years prior to the date on which the application to cancel the mark was filed (27 July 2022). Although Mr Norris pointed to Mr Heaton's statement where he refers to a date of 2016, Mr Heaton merely states that he has worked with the holder since 2016/2017 on a number of their brands and that he was aware of the ROMANOV brand "at this time". This does not show that the brand was actually in use on the market in 2016. Further, Mr Rose makes clear that ROMANOV vodka was brought to market in 2017[14] (not 2016) which is consistent with the dated invoices in exhibit FF5, the earliest of which is 30 August 2017, and I can see no other evidence which suggests that the mark was in use any earlier than 30 August 2017. That being so, the defence of statutory acquiescence must fail for that reason alone. For completeness, I add that, even if the evidence had established the requisite five years of use by the holder, I find that the opponent was not, in any event, aware of that use for the reasons advanced by Ms Blythe at the hearing[15].

Honest concurrent use

58) The holder also relies upon the defence of honest concurrent use in respect of the ROMANOV mark. Both parties' marks have been used on the market for a short period of time (less than five years). Moreover, it is clear from the evidence before me that the parties' goods have not been stocked in the same establishments or market segments. Indeed, the holder's evidence makes very clear that its vodka is 'niche' and 'aimed predominantly at exclusive, high-end establishments'[16]. The niche nature of its product is also reflected in the low annual revenue figures from 2017 – 2022[17]. Mr

[13] Exhibit FF5, page 1
[14] Mr Rose's statement, [3]
[15] Ms Blythe's skeleton argument, [38]
[16] Mr Fullman's statement, [12] & [9]
[17] Mr Fullman's statement, [10]

Fullman also states that “The brands of Carlsberg’s ROMANOFF vs Ellustria’s ROMANOV are completely different, from product quality, sales outlets, to target audience’. The opponent’s vodka, on the other hand is a ‘value/house’[18] vodka with a much lower price point and is sold in bulk to entities such as pubs, clubs and wholesalers[19]. It therefore seems clear that the reason there may have been no confusion to date is because the opportunity for it to occur has simply not arisen due to the parties’ operating in different sectors of the market. The defence of honest concurrent use fails.

SUMMARY

59) **The oppositions against the label mark and the bottle mark <u>succeed.</u>**

60) **The application for cancellation against the ROMANOV mark <u>succeeds entirely.</u>**

61) **The application for cancellation against the ROMANOV POMAHOB mark <u>succeeds against the following underlined goods</u> only:**

> **Class 32:** Beer; ginger beer; malt beer; <u>preparations for making liqueurs;</u> beer wort; malt wort; extracts of hops for making beer.
>
> **Class 33:** <u>Aperitifs; arrack [arak]; brandy;</u> wine; sparkling wine; piquette; <u>whisky; vodka; kirsch; gin; cocktails; curacao; liqueurs; alcoholic beverages, except beer; pre-mixed alcoholic beverages, other than beer-based; alcoholic beverages containing fruit; distilled beverages; peppermint liqueurs; bitters; rum;</u> sake; perry; cider; rice alcohol; <u>alcoholic extracts; fruit extracts, alcoholic; alcoholic essences.</u>

COSTS

[18] Mr Waller’s first statement.[11]
[19] Mr Waller’s first statement.[11]

62) Carlsberg has had the lion's share of success and is entitled to a contribution towards its costs. I will, however, take account of the small degree of success enjoyed by the holder in retaining some of its goods for the ROMANOV POMAHOB mark.

63) At the hearing, Mr Norris also urged me to take account of the time spent by the holder considering the opponent's 'proof of use' evidence which all related to the sale of vodka. Mr Norris pointed out that the holder had conceded in its counterstatements that the earlier ROMANOFF mark had been put to genuine use for 'vodka'. I agree that this is a relevant factor which I should take into account when approaching the costs award. In the light of the concession made by the holder that genuine use was not required for vodka, the opponent's evidence showing use for vodka was unnecessary. The opponent has also not argued that that evidence serves any other purpose such as, for example, showing enhanced distinctiveness through use. As such, I do not consider it appropriate to make an award for the filing of that evidence. The award will, though, take account of the opponent's evidence which relates to showing that vodka and spirits generally are similar[20]. I will also make an award to the opponent for the time spent considering the holder's evidence and filing evidence in reply.

64) Mr Norris also pointed out that reliance upon the VODKA ROMANOFF mark had been dropped by the opponent shortly before the hearing (as per Ms Blythe's skeleton argument) and that the award should also take this factor into account. In this regard, Mr Norris referred to the time spent by him dealing with that mark in his skeleton argument. However, I agree with Ms Blythe's submission in response where she submitted that there is very little in Mr Norris' skeleton dealing with said mark. I also note that there do not appear to be any other submissions/evidence filed by the holder, earlier in the proceedings, which deal more than minimally with that mark. I therefore do not consider that the award made to the opponent should be reduced on that basis.

[20] See exhibit PW04

65) Applying the guidance in Tribunal Practice Notice 2/2016 and, bearing in mind that the four cases were consolidated upon receipt of the defences, I award Carlsberg costs on the following basis:

Preparing a statement and considering the other side's statement	£500
Official fee (Form TM7) x 2	£200
Official fee (Form TM26I) x 2	£400
Considering the other side's evidence and filing evidence	£600
Preparing for and attending the hearing	£900
Less £150 to allow for the holder's degree of success	
Total:	**£2450**

66) I order WTM Establishment to pay Carlsberg Marston's Brewing Company Limited the sum of **£2450**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 2nd day of October 2024

Beverley Hedley
For the Registrar,
the Comptroller-General