

O/180/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003611131

BY RM SPIRITS LIMITED TO REGISTER THE FOLLOWING TRADE MARK:

EKO

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 425443 BY BBC VINS & SPIRITUEUX**

Background and Pleadings

1. On 16 March 2021, RM Spirits Limited ('the Applicant') filed an application to register the trade mark shown on the cover page of this Decision, number UK00003611131. The application was published for opposition purposes in the *Trade Marks Journal* on 14 May 2021. Registration is sought in respect of the following:

Class 33 *Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer)¹; Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages, except beer.*

2. On 9 July 2021, the application was opposed by BBC VINS & SPIRITUEUX ('the Opponent') based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the Applicant's goods. The Opponent relies on the following two earlier registrations for its section 5(2)(b) ground:

1) UK00916980351

EIKO

Filing date: 13 July 2017

Date registration completed: 3 November 2017

Priority date: 26 February 2017

Priority country: France

Relying on the following goods:

Class 33: *Alcoholic beverages (except beers); Wine; Wines of protected designation of origin; Wine with a protected geographical indication.*

¹ This is how the specification appears on the application. It is not clear why the terms have been replicated several times.

2) International Registration: WO0000001405307

EIKO

International registration date: 17 April 2018

Designation date: 22 February 2019

Date of protection of the international registration in UK: 30 May 2019

Office of origin: France.

Relying on the following goods:

Class 33: *Alcoholic beverages (except beers).*

3. The Opponent has claimed the following in its Statement of Grounds, in respect of both of its earlier marks:

The contested mark is similar to a high degree to the opponent's mark. They coincide in 3 out of 4 letters, they both start with the letter E and end with the letter O resulting in visual similarities and phonetic identity. The goods covered by the contested application are identical to the goods covered by the opponent's earlier marks. The high degree of similarity in the marks and the identical nature of the goods results in a high likelihood of confusion including likelihood of association. With this in mind, the application should be refused in its entirety.

4. The Applicant filed a Defence and Counterstatement in which it denies the claim against it in its entirety. I note the following:

The opponent has opposed the registration of 'Eko' based on similarity with their registered mark 'Eiko'. The word 'Eko' is a play on the word 'Echo' and is pronounced as such and does not bear similarity to the pronunciation of 'Eiko', which appears to relate to a Japanese word and product (a Japanese vodka). The words 'Eko' and 'Eiko' are not the same, they are spelled differently and pronounced differently. The phonetic identity is therefore not the same. The 'Eko' product branding is entirely different, the logo, design and demographic are also completely different in addition to products themselves being completely different. There is no confusion in the words and no confusion in the marks or products is, or is likely to be, present.

5. Neither party has filed evidence or requested a hearing. Both parties have filed written submissions in lieu of a hearing. The Applicant has filed a costs proforma.
6. The Opponent is represented by HGF Limited; the Applicant represents itself.

7. The following decision has been made after careful consideration of the papers before me.

Relevant dates

8. Section 6A of the Act provides that where the date on which the registration procedure of the earlier mark was completed is more than 5 years prior to the application date of the applied-for mark, the Opponent may be required to prove use of the earlier mark. The marks are earlier marks because the date upon which UK00916980351 had achieved registration, and the date upon which WO0000001405307 designated the UK for protection, fell before the filing date of the applied-for mark on 16 March 2021.

9. In the instant case, Section 6A is not engaged because the date upon which UK protection was conferred in respect of the earlier registrations, i.e. 3 November 2017 and 30 May 2019, both fell less than 5 years prior to 16 March 2021, i.e. the filing date of the Applicant's mark. Consequently, the Opponent is entitled to rely upon all the goods that it seeks to rely upon.

Decision

Section 5(2)(b) of the Act and related case law

10. Section 5(2)(b) of the Act states:

“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.”

11. The following principles are derived from the decisions of the CJEU² 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 C120/04; *Shake 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;

(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;

² Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

(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

12. The Applicant has submitted³ that its own product is ‘a craft small batch London dry gin distilled in England by a craft English distiller, [sic] it is not a Japanese spirit, rather a London dry gin, distinctively different to the opponent’s product’. It argues that ‘Eko is not a Japanese word and the product is not Japanese, it is not distilled in Japan and as such could not be confused by consumers as similar’. How the parties currently, or intend to, use their marks are not relevant factors in the assessment of whether there is a likelihood of confusion. I must only consider the ‘notional’⁴ use of the marks in relation to goods in their respective specifications. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered. Any *actual* differences between the parties’ goods are irrelevant unless they are apparent from the specifications of the respective marks.

13. The goods to be compared are as follows:

Opponent’s marks:	Applied-for mark:
i) UK00916980351 Class 33:	UK00003611131 Class 33:

³ Applicant’s written submissions in lieu of a hearing, at paragraphs 3 and 4.

⁴ A useful account of ‘notional’ use has been set out in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, where Kitchen L.J. stated that:

“78.the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”

<p><i>Alcoholic beverages (except beers); Wine; Wines of protected designation of origin; Wine with a protected geographical indication.</i></p> <p>ii) WO000000140530</p> <p>Class 33: <i>Alcoholic beverages (except beers).</i></p>	<p><i>Beverages (Alcoholic -), except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages, except beer.</i></p>
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14. The Applicant's specification consists of, essentially, the same term replicated five times. The Applicant's term appears in the specifications of both of the Opponent's earlier registrations. The Applicant's goods are therefore self-evidently identical with the Opponent's goods.

Average consumer and the purchasing act

15. The average consumer is deemed to be reasonably well-informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

16. In *Hearst Holdings Inc*⁵ Birss J. (as he then was) described the average consumer thus:

"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."

⁵ *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).

17. The Opponent has submitted that that the average consumer of the relevant goods 'will be the English speaking people at large, including businesses and [sic] the average consumer will be over the age of 18' and that 'the level of attention paid by the consumer will be average to low'. The Applicant has not made any submission on the matter of the average consumer and the purchasing act.
18. I consider that the average consumer of the respective goods will be predominantly the general public, albeit those of the legal age to purchase alcohol. I appreciate that a smaller number of purchases will be made by professional consumers in the course of their business e.g. pubs/bars and restaurants.
19. The respective goods will be purchased either as sealed goods, for consumption at a time of the purchaser's choosing, from physical shops/supermarkets or online stores; or as 'ready-to-drink' beverages from a public house/bar or restaurant. Purchases made from physical shops will, in most cases, be visual in nature; the purchaser self-selecting the goods from shelves. Some purchases will be made aurally by way of requests to retail staff. In a pub or bar setting, the average consumer will order from the bar by way of aural request. There will, in many instances, nevertheless be a visual aspect to the purchasing act to the extent that the cider taps, spirit optics and bottles containing other beverages on display along or near the bar will be viewed before the purchaser makes their choice.⁶ The average consumer may consider factors such as alcohol content and, in the case of wines, vintage and compatibility with certain foods. There is a range of pricing depending on the particular goods being purchased; some goods, for example, spirits, being more expensive than others. In my view, the level of attention displayed when making a purchase will, for all of the goods, be at least medium.

⁶ *Rani Refreshments FZCO v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-523/12 and *Simonds Farsons Cisk plc v OHIM*, Case T-3/04, both General Court.

Comparison of the marks

Opponent's (earlier) marks	Applicant's (contested) mark
EIKO⁷	EKO

20. 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.”

21. 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.

22. The Opponent has submitted the following⁸:

- the respective marks ‘are visually and phonetically similar to a high degree’.

⁷ Both earlier marks are identical and I have already found the parties’ respective goods to be identical.

⁸ Opponent’s written submissions in lieu of a hearing, paragraphs [14] – [18].

- that '[t]he contested mark has 2 syllables, pronounced E-KO, and the opponent's earlier mark has 2 syllables, pronounced E-KO, there is no way to phonetically differentiate the two, therefore when pronounced they sound the same'.
- That the average consumer 'would not understand either mark to have any semantic meaning, either generally, or in relation to the goods at issue'.

23. The Applicant has submitted the following⁹:

The company's application for the trade mark 'Eko' is based on 'Eko' being a play on the word 'Echo' and is pronounced as such, this does not bear similarity to the pronunciation of the opponent's mark 'Eiko'. The marks are therefore aurally different and we refer to the case *Bankia, SA v OHIM, Case T-323/14*, which confirms pronunciation is taken into account in assessing similarity in trade marks. The pronunciation of the opponent's mark is 'Iko' (being the Japanese word for glory), effectively meaning the 'E' at the beginning of the mark is silent and irrelevant, the marks bear similarity then in only two letters. The pronunciation of 'Iko' and 'Echo' are sufficiently different aurally. In the public perception, even if the mark 'Eko' is pronounced as 'Eco' this still does not bear sufficient similarity to the pronunciation of the opponent's mark. The phonetic identity of the marks is therefore dissimilar.

24. The Applicant has briefly addressed the matter of the visual comparison of the marks¹⁰ by way of the following: 'As can be seen from the products and marks, there is a clear visual difference'.

25. Both the Opponent's and Applicant's marks consist of the single word element 'EIKO'/'EKO', respectively, in a plain sans serif font, with all characters in upper case. In each case, the mark is a plain word which presents the word itself. The overall impressions of the marks therefore reside in the entirety of the respective marks.

26. Visual comparison

The respective marks share three letters E, K and O, in the same order. short words. The marks differ in that the Opponent's marks include the letter 'I' between the E and the K, which is absent from the Applicant's mark.

Consequently, I find the respective marks to be visually similar to a medium-high degree.

⁹ Applicant's written submissions in lieu of a hearing, paragraph [2].

¹⁰ Ibid, paragraph [5].

27. Aural comparison

In my view, the average consumer would articulate the Opponent's mark as 'EYE-COE' or 'EE-COE'. The Applicant's mark will, to my mind, be articulated as 'EK-OE' or 'EE-COE'.

28. Given the articulations that I have described, I consider that all potential forms of respective articulations give rise to at least a reasonably high degree of aural similarity, with the possibility that they may be articulated in an identical way by some consumers. They are all two-syllable articulations; ending with an 'oe' sound, all having a hard 'k' sound in them, with a similar i/e/eh sound at the beginning. It is acknowledged that some of the respective articulations have some aural differences, but this does not prevent the marks from being aurally similar.

29. Conceptual comparison

The Opponent has submitted that the Opponent's mark 'EIKO' will be perceived as a word without meaning i.e. an invented word; whereas the Applicant has submitted that 'EIKO' is 'the Japanese word for glory'.

30. It is acknowledged that a number of consumers of the relevant goods will be speakers of Japanese. However, in my view, the number of Japanese speakers in the UK will be relatively low. Although it is permissible to take into account the meaning of a word as understood only by a minority group, it is only if the minority group in question comprises a 'significant proportion' of the relevant public for the goods in question that it is likely to make a material difference. To illustrate the point, even if someone who is familiar with the Japanese language notices a conceptual difference between the marks which, in turn, might (I stress the word "might") aid them to distinguish between them marks, this does not help the vast majority of UK average consumers who do not see that conceptual difference.

31. In my view, the vast majority of relevant UK consumers would perceive 'EIKO' as an invented word. There will therefore be no concept for the mind to fix upon. I

consider that the Applicant's mark 'EKO' will also be perceived as an invented word. Consequently, I find the respective marks to be conceptually neutral.

Distinctive character of the earlier mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

33. The word 'EIKO' will be perceived by the average consumer as an invented word. It therefore neither describes nor alludes to the goods in respect of which the marks are registered. Consequently, I find that the earlier marks have a high level of inherent distinctive character.

Likelihood of confusion

34. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*¹¹. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*¹², the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that they have kept in mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark but mistakenly matches it to the imperfect image of the earlier mark in their 'mind's eye'. Indirect confusion occurs when the average consumer recognises that the competing marks are not the same in some respect, but the similarities between them, combined with the goods/services at issue leads them to conclude that the goods/services are the responsibility of the same or economically linked undertaking.

35. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [11].

36. The purchasing act will, in most cases, be visual in nature; though there will in some cases be an aural aspect. The visual aspect of the marks will play a more prominent role because the selection of, or decision to purchase, the goods will usually be made after visual exposure to the mark. In a bar/public house, purchases will usually be made after exposure to the brands on the taps/optics/bottles on display; in physical shops, the goods will be seen on shelves; online purchases will be made after viewing an image of the product on the website.

¹¹ Case BL O/375/10 at [16].

¹² *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

37. When considering all relevant factors 'in the round', I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.

38. The Opponent has submitted the following¹³:

In the present case, the goods at issue are identical. As a result any differences between the marks which may lessen the similarity between them is offset by the identity of the goods at issue. Furthermore, the average consumer rarely has the opportunity to make a side by side comparison between trade marks and must rely on his or her imperfect recollection. Therefore, when faced with the contested mark EKO, the average consumer will no doubt confuse it with the opponent's earlier mark EIKO, especially taking into account that it will be in relation to identical goods to the opponent's earlier goods.

In the present case, the opponent's earlier mark has a high level of inherent distinctiveness due to the fact that the mark has no meaning in relation to the opponent's earlier goods or the goods at issue. Due to this high level of inherent distinctiveness the risk of confusion is increased and the high degree of similarity of the contested mark to the opponent's earlier mark means the relevant public will confusingly believe that the contested mark is the opponent's earlier mark or at least connected to or authorised by the opponent and the goods on offer are being offered by the opponent.

39. The respective goods are self-evidently identical. My comparison of the marks has determined that:

- The marks are visually similar to a medium-high degree;
- As noted at [28], there is at least a reasonably high degree of aural similarity, regardless of how the marks are articulated.
- The marks are conceptually neutral.

40. I have found that the Opponent's marks are inherently distinctive to a high degree. The CJEU held in *Sabel*¹⁴ that:

¹³ Opponent's written submissions in lieu of a hearing, paragraphs [22] – [23].

¹⁴ *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”¹⁵

41. I find that a significant proportion of average consumers would confuse the marks. Both marks comprise invented words. There is therefore no conceptual ‘hook’ upon which the average consumer may grasp. The fact that the respective goods are identical, together with the levels of visual and aural similarity between the marks will, in my view, lead to direct confusion. Due to the impact of imperfect recollection, I consider that the average consumer will mis-remember/mis-recall the marks as each other. They are likely to mistake them for each other because the mind’s eye has failed to register the visual difference (i.e. the presence of the ‘l’ in the Opponent’s mark). There is a likelihood of direct confusion. I find this to be the case even though the average consumer will display at least a medium level of attention when purchasing the respective goods.

Final Remarks

42. The Opposition has succeeded in full and the Application is refused.

¹⁵ This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

COSTS

43. I award the Opponent the sum of **£600** as contribution towards its costs, calculated as follows¹⁶:

Preparation of statement and consideration of the Applicant's statement:	£200
Official fee for 5(2)(b) only:	£100
Written Submissions in lieu of hearing:	£300
Total:	£600

44. I therefore order RM Spirits Limited to pay to BBC VINS & SPIRITUEUX **the sum of £600**. 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 3rd day of March 2022

Mx N. R. Morris
For the Registrar,
the Comptroller-General

¹⁶ Based upon the scale published in Tribunal Practice Notice 2/2016.