

BLO/415/22

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION No. 3668539

BY Jeffrey Joshua Lawrence

TO REGISTER THE TARE MARK:

Tinker Gin

IN CLASS 33

-AND-

THE OPPOSITION THERETO

UNDER No. 600002058

BY Adventure Brands Ltd

Background and pleadings

1. On 14 July 2021, Jeffrey Joshua Lawrence (“**the Applicant**”) applied to register the word mark ‘Tinker Gin’ (“**the Contested Mark**”) in the UK, under application number 3668539, claiming priority from its EU Trade Mark (“**EUTM**”) number 18193680, which has a filing date of 7 February 2020.¹ It was accepted and published in the Trade Marks Journal on 10 September 2021 in respect of the following goods in Class 33:

Alcoholic beverages (except beer); Gin; Spirits [beverages].

2. On 2 December 2021, Adventure Brands Ltd (“**the Opponent**”) filed a notice of opposition, under the Fast Track opposition procedure, against the Contested Mark. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“**the Act**”) and is directed against all the Contested Mark’s applied-for goods.
3. The Opponent relies upon its earlier UK Trade Mark number 3281103, ‘TINKER’ (“**the Earlier Mark**”). The Earlier Mark was filed on 8 January 2018 and became registered on 15 June 2018 in respect of the following goods in Class 33, all of which are relied upon for the purposes of this opposition:

Gin; spirits; distilled spirits; liquors; alcoholic carbonated beverages, except beer; alcoholic beverages.

4. The Opponent claims that the Contested Mark is similar to the Earlier Mark and that the respective goods are identical or similar, giving rise to a likelihood of confusion.
5. Given the respective filing dates, the Opponent’s mark is an earlier trade mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application (taking account of the priority claimed in respect of the Contested Mark), it is not subject to the use requirements specified within section 6A of the Act. As a consequence, the Opponent may rely

¹ The Contested Mark’s priority claim is pursuant to Article 59 of the ‘Agreement on the withdrawal of the United Kingdom of Great Britain and Northern Ireland from the European Union and the European Atomic Energy Community (2019/C 384 I/01)’, also known as the ‘Withdrawal Agreement’

upon all of the goods for which the Earlier Mark is registered without having to show any use at all.

6. The Applicant filed a counterstatement denying the claims made.
7. The Applicant states that the inclusion of the word 'Gin' in the Contested Mark *"clearly specifies the goods that [the Contested Mark] covers"*,² whereas the absence of the word 'Gin' in the Earlier Mark essentially means that the Earlier Mark *"could apply to any number of product categories in the eyes of the average consumer"*. As a result, the Applicant argues that the likelihood of confusion is *"very low [...] if any at all"*.
8. The Applicant further argues that the parties' marks are visually and aurally dissimilar, stating that *"a single word neither looks like nor sounds like two words"*. With regards to the respective marks' conceptual similarity, the Applicant states *"it is not possible to respond as to whether there is a potential likelihood of confusion at this stage"* because the *"Opponent has not specified the concept behind their trade mark"*.
9. In its counterstatement, the Applicant set out its considerations with regards to the similarity of the respective marks' goods. As these are the only comments I have from the Applicant in respect of the goods, they are reproduced in full, as written, below:

"It is the Applicant's view that the Goods could be considered as:

Identical – for Gin as this is an exact match;

Similar – for spirits, distilled spirits, liquors and alcoholic beverages as these could be considered to share similarities with the Applicant's Alcoholic beverages (except beer) and Spirits (beverages); and

Dissimilar – for alcoholic carbonated beverages, except beer as the Applicant has not included carbonated beverages in their Application."

² I note of course that the Applicant has applied for other goods in Class 33.

10. This is an opposition to which the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 applies, deemed a 'Fast Track' opposition. As there was no use requirement, the Opponent did not file any evidence with its notice of Opposition. Neither party elected to file written submissions and neither party sought leave to file evidence nor made any request to be heard. This decision has therefore been taken following a careful perusal of the papers.
11. In these proceedings, the Opponent acts on its own behalf, without professional legal representation. Angela Margaret Rose Woodford acts as the representative for the Applicant.
12. 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 Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Preliminary issues

Use of the Earlier Mark

13. In its counterstatement, the Applicant, in reply to the Opponent's claims, states that it is not "*aware of any Tinker gin available in the marketplace*".
14. Pausing here, it is important to explain why, as a matter of law, this point will have no bearing on the outcome of this opposition.
15. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered. As previously outlined (in paragraph 5) the Earlier Mark had not been registered for five years at the filing date of the Contested Mark. Consequently, the Opponent cannot be required to prove use of its mark for any of the goods for which it is registered. The Earlier Mark is therefore entitled to protection against a likelihood of confusion with the Contested Mark based on the 'notional' use of that Earlier Mark for all the goods

listed in the register.³

16. As a result, whether the Earlier Mark was in use or not at the time of the filing of the opposition is irrelevant to the assessment I am required to make.

Acquiescence

17. In its counterstatement, the Applicant argues for the dismissal of the opposition, stating that:

“The Opponent had the right to oppose the Applicant’s EU registration but did not do so.⁴ The Applicant therefore believes that this application should be allowed to proceed to registration”.

18. I consider it reasonable to interpret the Applicant’s statement, as alluding to acquiescence on the part of the Opponent. I will briefly explain why the fact that the Opponent did not oppose the Applicant’s EUTM is not relevant in the present proceedings.

19. Section 48 of the Act deals with the implications of acquiescence, and states that the proprietor of an earlier trade mark loses the right to oppose the use of a later mark if they have 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” (my underlining).

20. Firstly, it must be noted that the Contested Mark in these proceedings is an application in the UK, entirely separate from the registered EUTM. There could be no defence of acquiescence in the present proceedings because section 48 of the Act does not apply to an opposition. An opposition seeks to prevent the registration of a trade mark, therefore the Opponent cannot be said to be acquiescing in the use of a *‘registered trade mark in the United Kingdom’* because the Contested Mark has not yet been registered; indeed, the Opponent is saying that the Contested Mark should not be registered. The fact that the Applicant is the owner

³ The concept of ‘notional’ use is explained in *Compass Publishing BV v Compass Logistics Ltd* [2004] RPC 41, paragraph 22

⁴ Given the Contested Mark claims priority from EUTM number 18193680, I consider it reasonable to assume that the Applicant is referring to this EUTM as opposed to any other *“EU registration”*.

of a registered EUTM that was registered after the Earlier Mark has no bearing on this opposition.

21. Secondly, I note that the Applicant's EUTM was filed on 7 February 2020 and did not become registered until 7 April 2021. Even if the EUTM fell into the category of a '*registered trade mark in the United Kingdom*', the required five-year period under section 48 of the Act would not be met given the registration date of the Applicant's EUTM. However, for the following reasons, the Applicant's EUTM is not a '*registered trade mark in the United Kingdom*'. Under the European Union (Withdrawal Agreement) Act 2020, all EUTMs registered before 1 January 2021 were recorded as comparable UK marks in the UK trade mark register and as such have the same legal status as if they had been applied for and registered under UK law. However, any EUTM application that was pending registration on 1 January 2021 - which includes the Applicant's EUTM - did not enjoy the same legal status in the UK. Instead, EUTM applicants were able to apply to register the same trade mark as a UK right (within a prescribed time period) and retain the earlier filing date of the pending EUTM.
22. There may be good reason why the Opponent did not oppose the Applicant's EUTM application, but whatever its reasons, the fact that it did not oppose registration of that trade mark, is no bar to it opposing the registration of the Contested Mark in the UK.

DECISION

Legislation and Case Law

23. Section 5(2)(b) and 5A of the Act are as follows:

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

[...]

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood 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.”

24. I am guided by the following principles which 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

25. The goods to be compared are:

Opponent's goods	Applicant's goods
<i>Gin; spirits; distilled spirits; liquors; alcoholic carbonated beverages, except beer; alcoholic beverages.</i>	<i>Alcoholic beverages (except beer); Gin; Spirits [beverages].</i>

26. Paragraph 9 above sets out the Applicant's submissions with regards to the comparison of the parties' goods. I agree with the Applicant that 'gin' appears in both parties' specifications and is therefore self-evidently identical.

27. When comparing the term '*Spirits [beverages]*' in the Applicant's specification with '*spirits*' in the Opponent's specification, I disagree with the Applicant's submission that the terms "*share similarities*". It is my assessment that the two terms are self-evidently identical. It is noted that they are worded slightly differently but it does not affect my finding that they are identical terms.
28. '*Alcoholic beverages (except beer)*' in the Applicant's specification is self-evidently identical to '*Alcoholic beverages*' in the Opponent's specification. I therefore disagree with the Applicant's submission that the terms merely "*share similarities*". It is noted that they are worded slightly differently but it does not affect my finding that they are identical terms.
29. My findings thus far are that each of the applied-for goods is identical to goods covered by the Earlier Mark. That the Opponent's specification contains additional terms, makes no difference to that assessment.
30. For the purposes of comparing the parties' goods, there exists established case law that recognises that goods can still be considered identical if an applicant's term falls within the scope of a more general category contained in an opponent's specification and vice versa. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 ("**Meri**c"), the General Court stated that:
- "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".
31. Consequently, not only do I find that each of the Applicant's individual terms has an identical counterpart in the Opponent's specification, by applying the principle set out in *Meri*c, I also find that all the goods contained in the Opponent's specification are encompassed by the Applicant's general category '*Alcoholic beverages (except beer)*', and in turn, all the goods contained in the Applicant's specification are encompassed by the Opponent's general category '*Alcoholic*

beverages'. As such, I also find that the respective goods are identical under the principle outlined in *Meric*.

32. It should be noted that I have considered the other goods relied upon by the Opponent. However, none put the Opponent in a more favourable position.

The average consumer and the nature of the purchasing act

33. The likelihood of confusion must be viewed through the eyes of the average consumer of the goods in question. It is necessary to determine who the average consumer for the respective goods is, and how the consumer is likely to select those goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.⁵ In *Hearst Holdings Inc*,⁶ 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."

34. It is necessary to consider the perception of consumers within any relevant class who are neither deficient in the requisite characteristics of being well informed, observant and circumspect, nor top performers in the demonstration of those characteristics. That is in substance what "average" means.⁷
35. I note that there are different categories of purchasers along the supply chain of the goods at hand and that arguably each is a consumer of the goods. These range from (emphasis added): (i) wholesalers who buy directly from the producers of the goods, for the sole purpose of resale to other businesses (those 'other businesses' being businesses who purchase the goods not for their own

⁵ *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97

⁶ *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)

⁷ *Schutz (UK) Ltd v Delta Containers Ltd* [2011] EWHC 1712, paragraph 98

consumption, but for the sole purpose of resale to the general public); (ii) retail businesses who purchase the goods either directly from the producers or from wholesalers for the sole purpose of resale to the general public; (iii) hospitality businesses who purchase the goods either from wholesalers or retailers for the sole purpose of resale to the general public; and (iv) the general public who purchase the goods from retailers and hospitality businesses for their own personal consumption. With each subset, the number of purchasers grows with, logically, the fewest number being in subset (i) and the largest number being in subset (iv).

36. I make this observation because it demonstrates that the ultimate intended end user, across each subset, is the alcohol-consuming general public, as they are the likely majority consumer. The supply chain exists to ensure that the goods reach the end user, that is, the group that intend to consume (drink) the goods themselves.
37. Therefore, although businesses may buy the goods, and businesses as a general rule of thumb may pay a higher degree of attention in the purchasing process, I consider the average consumer of the goods at issue will typically be adult members of the general public, of legal drinking age (being 18 or over).
38. The price of the goods is likely to vary depending on where or how they are purchased. For instance, in certain settings they may be sold in unit measures or by the glass and in other instances the whole bottle/can is sold. In addition to price, the average consumer will consider factors such as quality, origin of the goods, taste or flavour and alcoholic content, when selecting the products (these factors in turn effect price). Generally, prices can be higher in hospitality settings, however overall, the goods are inexpensive purchases.
39. Due to the inexpensive nature of the goods, the average consumer is likely to purchase the goods relatively frequently for the purposes of quenching thirst, enjoyment and/or socialising.
40. The goods are typically sold to the average consumer in hospitality settings such as cafés, bars, restaurants, night clubs and public houses. In these environments, there will be an aural component to the selection process, such as requests to bar

and waiting staff. I do not discount that in such instances, the average consumer may not have sight of the goods themselves before placing their order and therefore, in these specific circumstances, aural considerations would dominate. However, in general, it is my view that even where the goods are ordered by making requests to bar and waiting staff, the selection process would primarily be visual in nature whereby the goods are displayed on shelves behind a bar or are listed on a drinks menu. Accordingly, visual considerations would dominate.

41. The goods are also typically sold to the average consumer through a range of retailers, such as supermarkets, off-licences, and their online equivalents, in addition to mail order/delivery subscription services. In retail outlets, the goods will be displayed on shelves or in chilled cabinets, from which they will be self-selected by the average consumer. A similar process will apply to retail websites and mail order/delivery subscription services, where the average consumer will select the goods after viewing images and product specifications on a webpage or in a brochure. Accordingly, visual considerations would dominate. However, I do not discount that aural considerations may play their part: for instance, where the goods may be placed on shelves behind a counter, accessible only by member of staff; or, in the case of orders intended for delivery, they may be placed over the telephone.
42. In all cases, the purchase is likely to be primarily a visual one, but I do not rule out that there would be an aural element where there are word of mouth recommendations.
43. Accordingly, I find that the purchasing process is likely to be more casual than careful and will not require an overly considered thought process. I find that the average consumer will demonstrate a medium level of attention in respect of the selection and purchasing of the goods.

Comparison of marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23),⁸ that the average consumer normally perceives a mark as a whole and does not proceed to analyse

⁸ Case C-251/95

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 Court of Justice of the European Union 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.”

45. It would be wrong, therefore, to dissect the trade marks artificially, although it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

46. The respective trade marks are shown below:

Earlier Mark	Contested Mark
TINKER	Tinker Gin

Overall impression

47. The Earlier Mark consists of the single word ‘TINKER’. There is no stylisation. The overall impression rests purely in the word ‘TINKER’.

48. The Contested Mark consists of the words ‘Tinker Gin’. Taking into account the goods which the Applicant has applied for, the word ‘Gin’ is entirely descriptive in relation to ‘gin’, it also describes a kind of ‘alcoholic beverage’ as well as describing a kind of ‘spirit’. Consequently, it carries no trade mark message and it is the word ‘Tinker’ which plays the distinctive, dominant role in the overall impression of the Contested Mark.

Visual comparison

49. The Earlier Mark comprises solely of the word 'TINKER' which is visually identical to the first word of the Contested Mark. The fact that 'Tinker' is presented in upper and lower case letters in the Contested Mark and in upper case letters only in the Earlier Mark, is not a point of difference since fair and notional use of word marks would allow for use in upper or lower case and it is not a factor likely to be noticed by the average consumer.⁹ Whilst the additional word 'Gin' constitutes a visual difference, it is a short, non-distinctive word and I have found that the word 'Gin' plays a lesser role in the overall impression of the Contested Mark; it is the word 'Tinker' that plays the distinctive, dominant role. Overall, I find these marks to be visually similar to a high degree.

Aural comparison

50. Aurally, the Earlier Mark would be pronounced exactly the same way as the first word of the Contested Mark. The word 'Gin' describes the Applicant's goods and therefore may or may not be articulated.

51. It is easy to imagine a real-world example in a hospitality setting, where there is an oral element in the purchasing process. It is my experience that it is not uncommon, particularly in bars that offer a wide selection of gins, for the average consumer to order a gin by its brand name. As such, the average consumer will not articulate the word 'gin' when placing the order, for example a 'Gordon's and tonic', a 'Tanqueray and tonic', a 'Hendrick's and tonic' therefore the same could be said for a 'Tinker and tonic'.

52. Where all the words in both marks are articulated, I find the marks to be aurally similar to a high degree. Evidently, if the average consumer does not articulate 'Gin', then the respective marks are aurally identical.

⁹ *Bentley Motors Limited v Bentley 1962 Limited* BL O/158/17, paragraph 16

Conceptual comparison

53. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer¹⁰. I find that it is likely that the average consumer will have at least encountered the word 'tinker'. I find the word to be most commonly used in relation to the act of repairing something, although it can be used in reference to a mischievous child and its use can also be derogatory. It therefore potentially has three concepts. Although I think the act of repairing something is predominantly how the average consumer is likely to have encountered the word. Even if they cannot define it, they will at least recognise it as an English word as opposed to an invented word.
54. The additional word 'Gin' in the Contested Mark describes the goods and beyond that simple description, it does not add or alter the conceptual message provided by the word 'tinker'. Consequently, I find the marks to be conceptually identical or at least very highly similar. Where the average consumer is not familiar with the meaning(s) of the word 'tinker' then the marks have no concept.

Distinctive character of the earlier trade mark

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

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

¹⁰ This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] E.C.R. I-643; [2006] E.T.M.R. 29.

contain an element descriptive of the goods or services for which it has been registered [...]"

56. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion may be. I note that if the distinctiveness of an earlier mark is provided by an aspect of the mark that has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion.¹¹ Consequently, it is important to ask, 'in what does the distinctive character of the earlier mark lie?'
57. Being a one-word mark, the distinctive character of the Earlier Mark lies solely in the word 'TINKER'.
58. I note that the Opponent makes no claim to enhanced distinctiveness through the use made of the Earlier Mark.
59. The word 'TINKER' is likely to be considered to relate to repairing something. It makes no descriptive or allusive reference to the Opponent's goods. It is an ordinary English word, as opposed to an invented word and it will be given its plain ordinary meaning. Consequently, it is a normal trade mark possessed of a medium degree of inherent distinctive character. For a consumer who does not know the meaning of the word 'tinker', the Earlier Mark has no meaning in relation to the goods and has at least medium distinctiveness.

Likelihood of Confusion

60. A successful opposition based on section 5(2)(b) of the Act requires a finding that the Contested Mark is similar to the Earlier Mark and in relation to goods that are identical with or similar to those for which the Earlier Mark is protected. However, this alone is not sufficient, there must also be a finding that those factors in

¹¹ *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, paragraphs 38-39

combination are such that there exists a likelihood of confusion between the marks, on the part of the public, which includes the likelihood of association with the Earlier Mark.

61. In assessing the likelihood of confusion, I must adopt the global approach advocated by case law and take into account the fact that marks are rarely recalled perfectly, the consumer relying instead on the imperfect picture of them that they have kept in mind.¹² I must also keep in mind the average consumer of the goods, the nature of the purchasing process and have regard to 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.¹³ However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused. The question is whether there is a likelihood of confusion amongst a significant proportion of the relevant public.¹⁴

62. I have made the following findings:

- (i) the goods in Class 33 are identical;
- (ii) the average consumer will be adult members of the general public;
- (iii) the level of attention paid to the purchase will be medium;
- (iv) during the purchasing process, the visual and aural elements will both be important, however the visual assessment will play a greater role;
- (v) the marks are visually similar to a high degree; aurally similar to a high degree (noting that they are aurally identical where the average consumer does not articulate the word 'gin'); and are conceptually identical or at least similar to a very high degree;

¹² *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*, Case C-342/97, paragraph 27

¹³ *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, Case C-39/97, paragraph 17

¹⁴ *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41, paragraph 34(v)

- (vi) the distinctiveness of the Earlier Mark lies solely in the word ‘tinker’ which is distinctive to a medium degree on an inherent basis, there being no enhancement through use.

63. In the Opponent’s notice of opposition, the Opponent states that it uses the Earlier Mark in relation to ‘gin’. In its counterstatement, the Applicant states that the “words ‘Tinker Gin’ [...] clearly specifies the goods that this trademark covers”.

64. The Earlier Mark is not registered solely for ‘gin’, therefore the effect of notional and fair use of the Earlier Mark must be considered in relation to all of the goods for which it is entitled to protection.¹⁵ Equally, the Contested Mark has not been applied for solely in relation to ‘gin’, therefore, when assessing the likelihood of confusion under section 5(2) it is necessary to consider all the circumstances in which the Contested Mark might be used if it were registered.¹⁶

65. With this in mind, it is easy to envisage a real-world example where the Opponent expands its product range under its brand name ‘TINKER’ and uses it on other alcoholic beverages such as rum, vodka, whiskey, wine etc. Consequently, the Opponent is likely to use the house brand, being ‘TINKER’, to identify its goods from those of another undertaking, and will likely add descriptors on its labelling (gin, rum, vodka etc) to differentiate between its products. What’s more, it is more probable than not, based on the Opponent’s submissions, that the Opponent already includes the word ‘gin’ on its labelling as a means to describe the contents of its bottles.

66. On the other hand, the Contested Mark not only seeks protection in relation to ‘gin’, it also seeks protection for the broader categories of spirits and alcoholic beverages. This has the effect that the Contested Mark could also conceivably be used in relation to a vast number of different products contained in Class 33. Although in reality, use of the mark ‘Tinker Gin’ on a bottle containing rum, vodka or wine for example would be unusual.

¹⁵ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, paragraph 78

¹⁶ *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66

67. It is my view that the additional element 'Gin' in the Contested Mark would likely be seen as descriptive (and thus non-distinctive) for the goods at issue and would likely be overlooked by the average consumer. Bearing in mind the average consumer's attention is medium in relation to the goods, along with an imperfect recollection of the marks, it is my view that at the very least, the average consumer will remember that the product they seek is an alcoholic beverage, even if they don't remember it to be 'gin'. Therefore, they are likely to directly confuse 'TINKER' for 'Tinker Gin' and vice versa. In other words, the consumer will not apply any process of reasoning when selecting one or the other, something along the lines of *"They seek out an alcoholic beverage called 'TINKER' and they see a product on the shelf called 'Tinker Gin'. This in their mind is the product they are looking for and therefore they simply mistake one for the other"*.
68. I would still find a likelihood of confusion even if my assessment were based solely in relation to 'gin'. It is easy to envisage a real-world example where a consumer has been exposed to gin bearing the trade mark 'TINKER', and subsequently encounters 'Tinker Gin', for gin. They would surely conclude that both originate from the same undertaking. Indeed, they may fail to perceive the word 'gin' as intended to be part of the brand name, but instead a description of the goods. Just as, for instance, 'Walkers' seen on a packet of crisps would be understood as a brand of crisps called 'Walkers', such that it would not help distinguish the source origin if another undertaking offered identical goods under the mark 'Walkers Crisps'.
69. In this case, taking in to account (i) all the relevant factors identified above; (ii) my finding that the marks are identical in their distinctive components; and (iii) the identical nature of the goods, a finding of confusion is inevitable. It is my view that the average consumer would directly confuse the parties' marks with one another and, such confusion would result in the average consumer associating the parties' marks with one another, believing them to be from the same undertaking.

OUTCOME

70. The opposition succeeds under section 5(2)(b) of the Act.

COSTS

71. The Opponent has been successful and would ordinarily be entitled to an award of costs. However, as the Opponent had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to bringing the proceedings. It was made clear by letter dated 10 March 2022 that, if the pro-forma was not completed, no costs would be awarded. The Opponent did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded other than the official fee of £100 for the filing of the Form TM7F.

72. I therefore order Jeffrey Joshua Lawrence, to pay Adventure Brands Ltd the sum of £100. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

Dated this 12th day of May 2022

Daniela Ferrari
For the Registrar