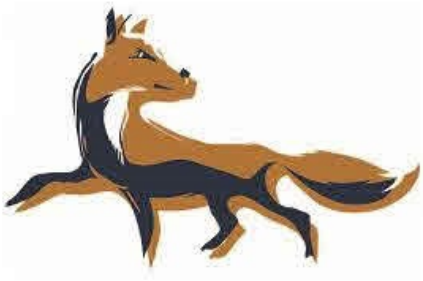
o/436/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK3546910
BY THATCHERS CIDER COMPANY LIMITED
TO REGISTER THE TRADE MARK:



IN CLASSES 32 & 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 423551
BY HEINEKEN BROUWERIJEN B.V.

Background and pleadings

1. On 22 October 2020, Thatchers Cider Company Limited ("the applicant") applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 11 December 2020. The applicant seeks registration for the following goods:

> **Class 32:** Alcohol free beverages; Alcohol free cider; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Ale; Beer; Beer and brewery products; Beer-based beverages; Beverages (Non-alcoholic -); Carbonated non-alcoholic drinks; Carbonated soft drinks; Cider, non-alcoholic; De-alcoholised drinks; De-alcoholized drinks; Flavoured carbonated beverages; Fruit beverages; Fruit beverages (non-alcoholic); Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Fruit flavoured carbonated drinks; IPA (Indian Pale Ale); India pale ales (IPAs); Lager; Low alcohol beer; Non-alcoholic carbonated beverages; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit drinks; Soft drinks; Craft beers; Flavoured beers; Apple juice beverages; Juices; Pale ale; Preparations for making beverages; Stout.
>
> **Class 33:** Cider; Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

2. The application was opposed by Heineken Brouwerijen B.V. ("the opponent") on 11 March 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent filed on the following International Registration designating the EU:

International Registration no. 1258714A designating the EU[1]
International Registration date: 19 February 2015, Date protection granted in the EU: 3 July 2018
Priority date claimed: 26 November 2014

Relying upon all of the goods, namely:

> **Class 32:** Beers, ales and beverages made from malt; porter; stout; lager; non-alcoholic beverages including energy drinks, mineral and aerated waters, non-alcoholic cider, fruit drinks and fruit juices; syrups, essences and other preparations for making beverages; combinations of any of the foregoing.
>
> **Class 33:** Alcoholic beverages (except beers); cider; cider blends; fruit wine; mixed alcoholic drinks; alcoholic energy drinks; wines; spirits (other than dark spirits) and liqueurs; alcoholic preparations for making beverages; combinations of any of the foregoing.

3. The opponent claims that the parties' marks are similar and that their goods are identical or similar. It states that the relevant public is likely to believe the goods originate from the same undertaking and therefore there is a likelihood of confusion.

4. The applicant filed a counterstatement which, for the most part, denied the claims made and provided detailed reasons as to why. However, I note that the applicant accepted that its goods in class 33 are identical or highly similar to the opponent's class 33 goods.

[1] Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.

5. The applicant is represented by Stephens Scown LLP and the opponent is represented by Osborne Clarke LLP.

6. When filing its counterstatement, the applicant also filed evidence. This issue was not noted until the matter was passed for a decision. At this point, the evidence was accepted into the proceedings under Rule 20 of the Trade Mark Rules 2008, as per the Registry's letter of 8 February 2022. The opponent was given the opportunity to provide evidence in reply but did not do so. Neither party requested a hearing and the opponent submitted submissions in lieu. This decision is therefore taken following careful perusal of the papers.

7. 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 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.

Evidence

8. The applicant's evidence consists of a witness statement by Christopher Milton, who is the Off-Trade & Export Sales Director of the applicant, a position they have held since October 2008. The main purpose of the evidence is to show that their own mark has been in use since 2018 and the sales figures related to the product that the applicant mark is currently used on.

9. I have read and considered all of the evidence and will refer to the relevant parts at the appropriate points in the decision.

Preliminary Issue

10. The applicant has filed some evidence showing use of foxes or fox like creatures on the bottles of alcoholic beverages. Some examples of this evidence are as follows:

11. While it has not been expressly pleaded, it appears that this evidence has been filed to show that the distinctiveness of the opponent's mark has been weakened due to the frequent use of foxes or fox like creatures on alcoholic drinks in the marketplace. However, for reasons I will now explain, this has no bearing on the outcome of this opposition.

12. In *Zero Industry Srl v OHIM,* Case T-400/06, the General Court stated that:

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

13. In considering the evidence of foxes/fox like creatures used on alcohol packaging, I note that the applicant has provided examples of 10 brands covering various alcoholic beverages including cider, gin and whiskey. While there may be a multitude

of entities that use a fox or fox like creatures as part of their companies' logos, this is not a relevant factor to the distinctiveness of the opponent's mark. There is no evidence of these marks being present on the register. Further, all of these marks have additional elements aside from depictions of fox like creatures and no evidence has been provided as to sales figures or marketplace availability. The outcome of this opposition will be determined by making a global assessment whilst taking into account all relevant factors and the submissions put forward by the applicant are not relevant to that assessment.

Decision

Section 5(2)(b)

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

> "5(2) A trade mark shall not be registered if because –
>
> > (a)…
> > (b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark."

15. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6(1) In this Act an "earlier trade mark" means –
>
> > (a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

> (2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b) subject to its being so registered."

16. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the contested mark pursuant to section 6 of the Act. The earlier mark is not subject to the proof of use requirements pursuant to section 6A of the Act. This is because it had not completed its registration process more than 5 years before the filing date of the application in issue. The opponent can, therefore, rely upon all of the goods for which its mark is registered.

Section 5(2)(b) case law

17. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG,* Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc,* Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV,* Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH,* Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM,* Case C-334/05P and *Bimbo SA v OHIM,* Case C-591/12P:

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of Goods

18. As noted above from the Form TM8 and counterstatement, the applicant accepts that the class 33 goods in their specification are 'identical or highly similar' to the opponent's class 33 goods. The applicant did not specify which goods it considers to be identical and which are highly similar, therefore, I must still undertake a comparison in order to identify the degree of similarity between them. Further, no similar concession in respect of identity/similarity was made for the class 32 goods, which I must also consider.

19. Section 60A of the Act provides:

> "(1) For the purpose of this Act goods and services-
>
> > (a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.
> >
> > (b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.
>
> (2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

20. In *Gérard Meric v Office for Harmonisation in the Internal Market* ('Meric'), CaseT-133/05, the General Court ("the GC") stated that:

> "29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur 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".

21. For the purposes of considering the issue of similarity of goods and services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

22. The competing goods are as follows:

The opponent's goods	**The applicant's goods**
Class 32: Beers, ales and beverages made from malt; porter; stout; lager; non-alcoholic beverages including energy drinks, mineral and aerated waters, non-alcoholic cider, fruit drinks and fruit juices; syrups, essences and other preparations for making beverages; combinations of any of the foregoing.	Class 32: Alcohol free beverages; Alcohol free cider; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Ale; Beer; Beer and brewery products; Beer-based beverages; Beverages (Non-alcoholic -); Carbonated non-alcoholic drinks; Carbonated soft drinks; Cider, non-alcoholic; De-alcoholised drinks; De-alcoholized drinks; Flavoured carbonated beverages; Fruit beverages; Fruit beverages (non-alcoholic); Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Fruit flavoured carbonated drinks; IPA (Indian Pale Ale); India pale ales (IPAs); Lager; Low alcohol beer; Non-alcoholic carbonated beverages; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit drinks; Soft drinks; Craft beers;

	Flavoured beers; Apple juice beverages; Juices; Pale ale; Preparations for making beverages; Stout.
Class 33: Alcoholic beverages (except beers); cider; cider blends; fruit wine; mixed alcoholic drinks; alcoholic energy drinks; wines; spirits (other than dark spirits) and liqueurs; alcoholic preparations for making beverages; combinations of any of the foregoing.	Class 33: Cider; Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

23. The following goods are found identically within both the applicant's and the opponent's specifications: Ale; Beer; Alcohol free cider; Non-alcoholic beverages; Beverages (Non-alcoholic); Cider (non-alcoholic); Lager; Non-alcoholic drinks; Preparations for making beverages; Stout; Cider; Ciders; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer).

24. *Beer and brewery products; Beer-based beverages; IPA (Indian Pale Ale); India pale ales (IPAs); Low alcohol beer; Craft beers; Flavoured beers; Pale ale.* I find that the above goods from the applicant's specification would be identical under the *Meric* principles to the opponent's 'Beers, ales and beverages made from malt'.

25. *Alcohol free beverages; De-alcoholised drinks; De-alcoholized drinks; Non-alcoholic beverages containing fruit juices; Carbonated non-alcoholic drinks; Carbonated soft drinks; Flavoured carbonated beverages; Fruit beverages; Fruit beverages (non-alcoholic); Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Fruit flavoured carbonated drinks; Non-alcoholic flavored*

carbonated beverages; Non-alcoholic fruit drinks; Soft drinks; Apple juice beverages; Juices. I find that the above goods from the applicant's specification would be identical under the *Meric* principles to the opponent's 'non-alcoholic beverages including energy drinks, mineral and aerated waters, non-alcoholic cider, fruit drinks and fruit juices'. The opponent's goods are not limited to the goods listed after the word 'including' but rather this is used to simply provide examples of non-alcoholic beverages.

26. *Dry cider; Sweet cider; Low alcohol cider.* I consider that the above goods are all types of 'cider' which is found in the opponent's class 33 specification therefore, these goods are identical under the *Meric* principles.

27. I find that as 'Perry' in the applicant's specification is a type of alcoholic beverage, it is identical under the *Meric* principles to the opponent's 'Alcoholic beverages (except beers)'.

Average consumer and the purchasing act

28. 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.

29. 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."

30. I think that the relevant consumer of both the applicant's and the opponent's alcoholic goods will be primarily the general public over the age of 18. For the non-alcoholic goods, it would also include those under the age of 18. There may also be a portion of professional consumers purchasing the goods on behalf of a business, or for the purpose of running a business themselves, this would be most likely in the purchase of 'preparations for making beverages'.

31. It is my view that a significant portion of members of the general public will purchase the goods fairly frequently, either in a retail or hospitality environment. The professional public will likely purchase these in a retail or wholesale environment, or via distributors. The price point of beers and non alcoholic drinks is usually relatively low. In relation to alcoholic beverages, I consider that there is a possibility of much more expensive products, particularly wines and whiskeys.

32. The method of purchase will likely be in a retail setting and the consumer – both public and professional- will largely rely on a visual inspection of the goods. Where the goods are purchased in a hospitality setting, this will be predominantly visual with marks most likely being displayed on and chosen from a drinks menu or displayed on the bottles or boards visible behind the bar. However, as verbal orders will often be placed, aural considerations cannot be completely discounted. Professional consumers may also place aural orders however, they are likely to have viewed the products prior to this.

33. When purchasing beverages, the public may consider matters such as quality, origin and taste. For the most part, the goods will attract a medium degree of attention, particularly in relation to alcoholic beverages, this is the case even for goods which are on the more expensive end of the case as they factors considered are likely to be the same. The level might be slightly lower when it comes to everyday soft drinks and fruit juices alcoholic beverages.

34. For professional consumers, I find the level of attention paid will be enhanced due to the increased responsibility of purchasing these goods on behalf of a business, and the increased liability that will come with serving or selling the goods to consumers. It

is my view that the professional consumer will pay at least a medium level (although not to a high degree) of attention in respect of the goods.

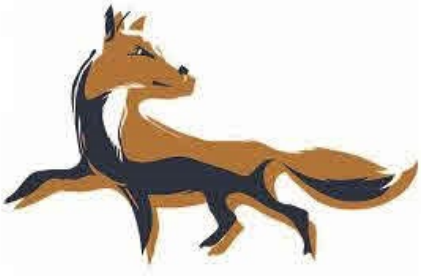
Comparison of the marks

35. 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."

36. 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.

37. The respective trade marks are shown below:

The earlier mark	**The contested mark**
	

38. The opponent claims that the contested mark's overall impression is of a 'stylised drawing of a fox with one front leg raised and three legs on the ground, body facing left with head to the right, with a long bushy white-tipped tail held horizontally black and white shading with simple blocks of brown colour suggest light, shadow and fur' and that their own mark's overall impression is 'a stylised drawing of a fox with one front leg raised and three legs on the ground, facing to the right with a long bushy white-tipped tail held horizontally. Black and white shading suggest light, shadow and fur'.

39. The applicant claims that the dominant and distinctive component of the earlier mark is a generic one-dimensional black animal presumed canine facing the right whereas their own mark is a colourful caricature of a fox in brown and white with shadowing.

40. In relation to the earlier mark I find the overall impression lies in the depiction of a black and white fox in a focus pose, facing right.

41. In relation to the contested mark, I find the overall impression lies in the depiction of a painted/brush stroke style four-legged creature in colour stood facing the left but looking back to the right. I believe that the average consumer might consider the creature to be 'fox-like' or may not be able to immediately recognise it as a fox due to the heavy stylisation of the mark.

42. I will now look at the visual comparison between the marks. While both marks will be seen as containing a graphical depiction of a four-legged fox like creature, they are stylistically very different and I note that just because two marks may share representations of the same thing, it does not automatically result in a finding of visual similarity between them.[2] As the earlier mark is registered in black and white, it is not restricted to particular colours.[3] However, it is not appropriate to notionally apply complex colour arrangements to any mark registered in black and white as it is

[2] *The Royal Academy Of Arts v Errea Sport S.P.A.* BL O/010/16
[3] *Specsavers International Healthcare Limited & Others v Asda Stores Limited,* Case C-252/12

necessary to evaluate the likelihood of confusion on the basis of normal and fair use of the marks. Any application of complex colour arrangements would not be normal and fair use.

43. I bear in mind the submissions of the opponent that the average consumer will not do a deep analysis into the aspects of both marks and whilst I agree with this, I believe that the average consumer will notice the significant stylistic differences between the marks. The earlier mark is a more realistic, hand drawn style of mark compared to the applied for is a more stylised representation made to look like it has been painted and these are the overall visual impressions left on the average consumer. Due to this, I find that the marks are visually similar to a low degree.

44. Next, I turn to the aural comparison. The applicant contested that as there are no aural elements to the marks, the focus will be on the visual comparisons. The opponent however, states that when the marks are referred to aurally they will be pronounced as 'fox' or 'the fox'. In *Dosenbach-Ochsner AG Schuhe und Sport v OHIM,* Case T-424/10 the GC stated:

> "45. …contrary to what the applicant submits, a phonetic comparison is not relevant in the examination of the similarity of a figurative mark without word elements with another mark (see, to that effect, Joined Cases T-5/08 to T-7/08 *Nestle v OHIM – Master Beverage Industries (Golden Eagle and Gold Eagle Deluxe)* [2010] ECR II-1177, paragraph 67).
>
> 46. A figurative mark without word elements cannot, by definition, be pronounced. At very most, its visual or conceptual content can be described orally. Such a description, however, necessarily coincides with either the visual perception or the conceptual perception of the mark in question. Consequently, it is not necessary to examine separately the phonetic perception of a figurative mark lacking word elements and to compare it with the phonetic perception of other marks."

45. I therefore consider that it would be inappropriate for me to consider the aural similarities or differences between the marks.

46. With regard to the conceptual similarities between the marks, they are both artistic representations of a fox or fox like creature. One mark appears to be more 'realistic' and the other seems to be more highly stylised and abstract. Bearing in mind the impression given by both marks will likely be that of a fox or fox like creature, I find that the marks are conceptually identical.

Distinctive Character of the Earlier Mark

47. 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).
>
> 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)."

48. The opponent did not file any evidence and has made no claim of an enhanced level of distinctiveness in its earlier marks nor have they provided evidence to support

such a claim so I will base my decision on the inherent distinctiveness of the earlier mark.

49. I consider that the use of a fox logo is not suggestive or allusive of the goods covered in the specification. I consider that the hand-drawn, more realistic nature of the fox in the earlier mark makes it less fanciful. I consider further that the use of animals in trademarks is not an uncommon one and even in a stylised fashion, the use of a fox is not particularly remarkable. I therefore consider the level of inherent distinctive character to be a medium degree.

Likelihood of Confusion

50. There are two types of confusion that I must consider. Firstly, direct confusion i.e. where one mark is mistaken for the other. The second is indirect confusion which is where the consumer appreciates that the marks are different, but the similarities between the marks lead the consumer to believe that the respective goods or services originate from the same or a related source.

51. In *L.A. Sugar Limited v Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

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

52. I have come to the above conclusions that the goods are identical, the marks are visually similar to a low degree, conceptually identical and that an aural comparison is not appropriate based on the marks having no elements capable of being articulated. The earlier mark is inherently distinctive to a medium degree.

53. I accept that both marks are showing creatures that could be seen as foxes however, the stylisation of the animals is very different and they are indeed shown in different poses and directions. I believe that the average consumer, even paying a lower degree of attention as they might in relation to the purchase of some of the goods in question, will notice the differences between the marks.

54. The fact that both marks could be described as foxes is not sufficient to create a likelihood of confusion. In *Chemise Lacoste*, Case BL O/333/10, Mr Geoffrey Hobbs Q.C., sitting as the Appointed Person found that i) a concept is not a sign capable of being a trade mark, ii) that the rights conferred by registration are centred on the graphic representation of the registered mark, iii) the concept of a mark cannot be protected without regard to the specific form in which it is registered. Accordingly, he held that there was no likelihood of confusion between the word ALLIGATOR and the well known device of the Lacoste crocodile. In reaching this finding, Mr Hobbs Q.C. accepted that the position might be different if the word(s) had the capacity to spontaneously trigger a recollection of a very specific image corresponding to an earlier pictorial mark, such as MONA LISA, EIFFEL TOWER or STARS AND STRIPES.

55. In *Sabel v Puma* the CJEU said that:

> "24. In that perspective, the more distinctive the earlier mark, the greater will be the likelihood of confusion. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public.

> 25. However, in circumstances such as those in point in the main proceedings, where the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion."

56. I have found that the distinctive character of the earlier mark is medium and therefore, I do not consider that the mark will fall into the category of marks mentioned in paragraph 24 of the above judgement. The common element of the marks- a fox or fox-like creature- cannot be said to have a high level of imaginative content.

57. Considering all the above, I believe that there is no likelihood of direct confusion between the marks, even on goods that are identical or in circumstances where the consumer pays a lesser degree of attention. I find that the average consumer will notice the difference between the marks and although the other mark might be called to mind, they will recognise that the marks are not one and the same.

58. I will now go on to consider the possibility of indirect confusion. Again, I take guidance from Mr Purvis in *L.A. Sugar Limited* where he stated:

> "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)".

59. These examples are not exhaustive but provide helpful focus.

60. Turning to the above categories; firstly, the shared elements between the marks are fox devices which I do not find to be strikingly distinctive. There is no additional element added to either of the marks, they exist soley as fox devices and so the second category cannot apply. The differences in the stylisation of the marks would not be an obvious or logical brand extension in my opinion. I do not consider that the average consumer would find it logical that the opponent, for example, would redesign their mark so significantly that it might no longer be recognisable as a clear representation of the earlier mark. In this case that would be to redesign a fairly realistic representation of a fox to a highly stylised depiction of a creature that might not be as easily recognised as a fox. Whilst the categories set out above by Mr Purvis are not exhaustive, I see no obvious rationale for the differences between the marks that would lead the average consumer to consider that, when confronted with both marks, the common element of a fox would be an indicator of a brand-extension or sub-brand, particularly given the significant differences between those elements. It is also not sufficient that a mark merely calls to mind another mark.[4] This is mere association not indirect confusion. Due to the this, I do not believe that there is any reason to expect an economic connection between the two. I therefore find that there would be no indirect confusion between the marks, even on goods that are identical or in circumstances where the consumer pays a lesser degree of attention.

Conclusion

61. The opposition under section 5(2)(b) fails in its entirety and so the contested mark will proceed to registration.

[4] *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17

Costs

62. The applicant has been successful and is entitled to a contribution towards its costs. Award of costs are based upon the scale as set out in Tribunal Practice Notice 2 of 2016. The award of costs in this matter has been calculated as follows:

Considering the Notice of Opposition and preparing Counter Statement	£350
Preparing evidence	£250
Total	**£600**

63. I therefore order Heineken Brouwerijen B.V. to pay Thatchers Cider Company Limited the sum of £600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 18th day of May 2022

L Nicholas
For the Registrar