O-440-22

TRADE MARKS ACT 1994

IN THE MATTER OF

INTERNATIONAL TRADE MARK NO. WO1516056

DESIGNATING THE UNITED KINGDOM

IN THE NAME OF HANS-GERHARD FINK

TO REGISTER

finch

AS A TRADE MARK

IN CLASS 33

AND OPPOSITION THERETO (UNDER NO. 422358)

BY M&J GLEESON & CO.

Background & Pleadings

1. Hans-Gerhard Fink ("the holder") is the holder of International Registration ("IR") no. WO0000001516056 ("the designation") in respect of the trade mark set out on the title page. Protection in the UK was requested on 11 December 2019 in respect of *Alcoholic beverages (except beer)* in class 33.

2. The IR was published in the UK for opposition purposes on 4 September 2020. On 4 December 2020, M&J Gleeson & Co. ("the opponent") opposed the designation in full under section 5(2)(b) of the Trade Marks Act 1994 ("the Act") on the basis of two earlier registrations, one being a UK mark and the other an EU mark. The details of the marks being relied on are set out below:

UK TM No.1529126	EU TM No.237529
FINCHES	**FINCHES**
Class 32: Fruit juices, cordials, squashes; all being non-alcoholic beverages; all included in class 32; all for sale in Northern Ireland	*Class 32: Mineral and aerated waters and non-alcoholic drinks; fruit drinks and fruit juices, cordials and squashes; syrups and preparations including in class 32 for making beverages.*
Filing date: 4 March 1993 Registration date: 26 January 1996	Filing date: 12 April 1996 Registration date: 23 July 1998

3. The holder filed a defence and counterstatement denying the claims made and puts the opponent to proof of use of the earlier registrations.

4. Both sides have been represented throughout the proceedings. The holder has been represented by Stobbs and the opponent by FRKelly.

5. Both sides filed evidence and submissions. A hearing was requested and held before me, via video conference, on 7 April 2022. The holder was represented by Mr Jan-Casper Rebling of Stobbs and the opponent by Mr Paul Kelly of FRKelly.

Preliminary issues

6. It is convenient to set out at this stage the law that applies to the proceedings, and the impact of the end of the Brexit transitional period. The IR was designated for protection as a trade mark in the United Kingdom on 11 December 2019 so before IP Completion Day (being 11pm 31 December 2020). The opposition was also launched before IP Completion Day. The transitional provisions set out in the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 state that the proceedings should continue to be dealt with under the Act as it existed before IP Completion Day. The effect of this is that the opponent may rely on its EU TM as an earlier mark and the relevant territory for the EU TM subject to proof of use is the EU.

7. Section 6(3)(a) of the European (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.

Proof of use: Relevant statutory provision: Section 6A

8. The relevant statutory provisions for section 6A are set out below

> "(1) This section applies where
>
> > (a) an application for registration of a trade mark has been published,
> >
> > (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
> >
> > (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services."

9. Section 100 of the Act is also relevant. It states:

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

10. Both earlier marks are subject to proof of use having completed their respective registrations more than 5 years before the designation date of the IR.

11. The relevant period in which proof of use must be shown is the 5 years ending with the designation date of the IR, namely 12 December 2014 to 11 December 2019.

12. The case law on genuine use was summarised by Arnold J (as he then was) in *Walton International Limited v Verweij Fashion BV* [2018] EWHC 1608 (Ch):

"114. *The law with respect to genuine use.* The CJEU has considered what amounts to 'genuine use' of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundersvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816] [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm*

Clean Solutions GmbH & Co KG [EU:C:2013:592], [2014] ETMR, Case C-141/13 *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

> (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
>
> (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].
>
> (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
>
> (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the

proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis*

rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

Form of the mark

13. I shall first consider the form in which the marks have been used and decide if this constitutes an acceptable variant. In *Lactalis McLelland*[1], Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

> "13. […] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).
>
> 14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.
>
> 15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.
>
> 16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one

[1] *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word "MEDIA" would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still".

14. The earlier registrations both consist of a plain word only mark, namely FINCHES. In *LA Superquimica*[2], the General Court ("GC") held that such plain word marks protected the word or words contained in the mark in whatever form, colour or font.[3] Within the evidence there are examples of the word FINCHES being used in the following stylised formats:

[2] *LA Superquimica v European Union Intellectual Property Office (EUIPO)*, Case T-24/17
[3] Paragraph 39.

15. I consider these stylised variations do not alter the distinctive character of the earlier marks as registered and as such are acceptable variants.

Use of the mark

16. For use to be genuine, there must have been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the five-year period I have identified. In making my assessment, I am required to consider all relevant factors, including:

- the scale and frequency of the use shown;
- the nature of the use shown;
- the goods for which use has been shown;
- the nature of those goods and the market(s) for them; and
- the geographical extent of the use shown.

17. As one of the earlier marks is an EU TM, I bear in mind what the CJEU said in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11:

> "36. It should, however, be observed that … the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the

phrase 'in the Community' is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use."

And

"50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as 'genuine use', it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national mark."

And

"55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)."

18. The opponent, at the hearing, invited me to consider the evidential picture as a whole including the material which is undated or dated outside of the relevant period as being illustrative that the market for the goods is being maintained, whilst the holder

identified those specific shortcomings, i.e. undated material or where dated material was provided being outside of the relevant period, as being deficiencies which I should disregard entirely. In *New Yorker SHK Jeans GmbH*[4], the GC said:

> "In order to examine whether use of an earlier mark is genuine, an overall assessment must be carried out which takes account of all the relevant factors in the particular case. Genuine use of a trade mark, it is true, cannot be proved by means of probabilities or suppositions, but has to be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned (*COLORIS*, paragraph 24). However, it cannot be ruled out that an accumulation of items of evidence may allow the necessary facts to be established, even though each of these items of evidence, taken individually, would be insufficient to constitute proof of the accuracy of those facts (see, to that effect, judgment of the Court of Justice of 17 April 2008 in Case C-108/07, *Ferrero Deutschland v OHIM*, not published in the ECR, paragraph 36)."[5]

19. Bearing this in mind, I now turn to the evidence. The opponent provided two witness statements, the first in the name of Keith O'Haire, who is the "Head of Soft Drinks" for C&C Group (Ireland), dated 8 July 2021 with 3 appended exhibits and the second in the name of Brenda O'Regan of FRKelly, the opponent's legal representative, which is dated 14 January 2022.

20. In his witness statement, Mr O'Haire states that the opponent M&J Gleeson was acquired by C&C Group plc in 2012[6]. Another pertinent point to note is the date of first use which is stated as 1993 and was confirmed as being used throughout the island of Ireland. Mr O'Haire gives the turnover for the FINCHES brand in Northern Ireland as:

---

[4] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09,

[5] Ibid, Paragraph 53.

[6] It was confirmed in the witness statement of Brenda O'Regan dated 14 January 2022 that the opponent is a wholly owned subsidiary of C&C Group.

2020	2019	2018	2017	2016	Total
102,452	442,604	475,519	474,369	314,479	1,809,422

21. Although the pound sign is not present in the figures, it was confirmed at the hearing that the turnover is in sterling. In addition it is noted that figures for 2020 are provided, however these fall outside of the relevant period so will not be considered.

22. In exhibit KOH2, Mr O'Haire provides example of the marks in use on what is described as a "customer facing point of sale". The first two images[7] consist of two screenshots dated 7 August 2021 (which is outside of the relevant date) taken from the C&C Group website (www.candcgroupplc.com

[8].

[7] Pages 7 & 8

[8] Paragraph 3

23. Exhibit KOH3 comprises 19 invoices issued in the name of Tennent's NI. In her witness statement, Ms O'Regan states that Tennent's NI are another wholly owned subsidiary of C&C Group and are the authorised licensee of the opponent for the FINCHES marks in Northern Ireland. Ms O'Regan also states that the invoices provided are just a sample. Turning directly to these 19 invoices, I note that 8 are dated within the relevant period, namely those invoices going to Cuckoo Belfast[9], Kremlin Bar[10], Queens Student Union[11], Betty Blacks[12], Comber Rifle Club[13], Amici Ristorante[14], Village Inn[15] and Hoggs Bar[16] . Furthermore of the 8 invoices dated within the relevant period only the Comber Rifle Club, Amici Ristorante, Village Inn and Hoggs Bar invoices reference the FINCHES mark.

24. The holder criticises the evidence firstly for its lack of POSM, secondly for its few invoices which actually bear the trade marks and lastly for the invoicer being Tennents NI. Taking that last point first, I'm satisfied with Ms O'Regan's explanation that Tennents NI are an authorised licensee of the opponent and therefore I find the invoices to be valid for the purposes of considering the evidence provided. The holder's other concerns regarding the sufficiency of the evidence provided, such as the small number of invoices which actually exhibit the trade mark within the relevant date and the lack of dated POSM, need further examination.

25. The opponent correctly points out that there is no *de minimis* threshold which must be surpassed to find genuine use, however the assessment I must make is a multifactorial one. The evidence presented shows use in Northern Ireland only despite Mr O'Haire stating that the FINCHES has been used throughout the island of Ireland. Therefore the use presented falls within a relatively small geographical area of the EU. The turnover is stated to be between £314k in 2016 rising to £442k in 2019. The holder's evidence[17] contains industry figures from the British Soft Drinks

[9] Exhibit KOH3, p18
[10] Ibid. p19
[11] Ibid. p20
[12] Ibid. p21
[13] Ibid. p27
[14] Ibid. p28
[15] Ibid. p29
[16] Ibid. p30
[17] Exhibit JCR3

Association which states that the value of the UK soft drinks sector was worth £14bn and rose to £15.2bn over the same time period. The EU soft drinks sector will therefore clearly be worth considerably more. Therefore the opponent's EU market share of that soft drinks sector must be extremely small. The lack of POSM is also unfortunate but I take Ms O'Regan's point that sales made to the trade as opposed to general retail sales will not always generate much lasting or large scale marketing material.

26. At the hearing Mr Rebling for the holder directed me to the *Reber* decision[18] in which the CJEU found that although a German chocolate manufacturer had made genuine sales of its goods, the use was so small in the context of the EU chocolate market that it was deemed to be insufficient. I agree with the holder that *Reber* has an equivalence in this case. Therefore I find that genuine use has not been proved in the EU so the opponent cannot rely on its earlier EU TM No.237529 which leaves the question of the earlier UK TM No.1529126.

27. The considerations for use of a UK TM are again multifactorial. Northern Ireland makes up one quarter of the constituent parts of the UK so has a greater geographical significance than in my previous finding and the specification of goods for the earlier UK TM has a limitation for Northern Ireland only. Although no advertising expenditure or market share was shown, the opponent demonstrated a consistent turnover between 2016 and 2019 and use of the mark is shown on the goods despite the limited POSM. Therefore I find that the opponent has demonstrated genuine use of the mark in the UK.

Framing a Fair Specification

28. I have found use of the mark demonstrated on soft drinks. This term is relatively broad so I now consider whether it is a fair specification for the earlier marks. In *Euro Gida Sanayi ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, summed up the law as follows:

[18] *Reber Holding & Co KG v OHIM* Case C-141/13

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."[19]

29. In *Property Renaissance t/a Titanic Spa*[20], Carr J summed up the law relating to partial revocation as follows:

"iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (*Extreme Trade Mark)* [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot

[19] Pages 10-11.
[20] *Property Renaissance t/a Titanic Spa v Stanley Dock Hotel Ltd t/a Titanic Hotel Liverpool & Ors* [2016] EWHC 3103 (Ch)

reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

30. The bottled goods for which use has been demonstrated are flavoured beverages being orange, lemon, lemonade, ginger beer and shandy. Ms O’Regan stated the ‘splash’ mechanism was a beverage dispensing system, presumably dispensing the same flavoured beverages. As such I find the opponent can rely on its registered specification namely *Fruit juices, cordials, squashes; all being non-alcoholic beverages; all included in class 32; all for sale in Northern Ireland.*

Section 5(2)(b)

31. Section 5(2)(b) of the Act is as follows:

“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."

32. In considering the opposition under this section, I am guided by the following principles, gleaned from the decisions of the CJEU 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 BV* (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-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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. The average consumer is deemed to be reasonably well informed and reasonably circumspect and observant, but someone who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them they have kept in their 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 greater 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; and

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

Comparison of goods

33. With regard to the comparison of goods, in the judgment of the CJEU in *Canon*[21], the court stated at paragraph 23 that:

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

[21] Case C-39/97

34. Jacob J (as he then was) in the *Treat* case[22], identified the following factors as relevant for assessing similarity:

a) The respective users of the respective goods or services;
b) The physical nature of the goods or acts of services
c) The respective trade channels through which the goods or services reach the market
d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

35. In its skeleton argument, the holder put forward two fallback positions for its specification for my consideration. I have set out the current specification and the two fallback positions in the table below for clarification. I intend to address the current specification first and then return to the fallback positions later in my decision.

36. The goods to be compared are:

Goods for which the opponent has shown use in class 32:	**Holder's goods in class 33**
Fruit juices, cordials, squashes; all being non-alcoholic beverages; all included in class32; all for sale in Northern Ireland.	*Alcoholic beverages (except beer)* Fallback position 1: *Spirits* Fallback position 2: *Whiskey*

[22] [1996] R.P.C. 281

37. The holder's current specification *Alcoholic beverages (except beer)* is a broad term covering beverages which vary in their composition and alcoholic content and will also encompass alcoholic versions of non-alcoholic drinks. As such I find there is a likelihood of competition between the respective goods e.g. fruit-based drinks may be marketed as a non-alcoholic version of an alcoholic beverage such as mocktails in place of cocktails. In addition users may overlap and they also share some of the same distribution channels, i.e. pubs, bars and restaurants. Therefore I find the opponent's goods to be similar to the holder's goods to a low degree.

Average consumer and the purchasing act

38. I next consider who the average consumer is for the contested goods and the way in which those goods are purchased. 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.*

39. In *Hearst Holdings Inc*[23]*,* 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."

40. The average consumers of the contested goods are the general public, those over the age of 18 in the context of a pub or bar setting and businesses. The goods

[23] *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)

are likely to be available through several trade channels such as off licenses, pubs, bars, clubs and restaurants. The contested goods are inexpensive and reasonably frequent purchases. An average consumer would probably consider factors such as the flavour of the beverage or the suitability for mixing when making their selection. I find that a low to medium level of attention would be paid in this situation. The purchasing process will be a primarily visual experience although I do not rule out an aural element where the goods are ordered verbally in a pub, bar or restaurant setting.

Comparison of the marks

41. 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."

42. 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.

43. The marks to be compared are:

Opponent's registration	Holder's designation
FINCHES	*finch*

44. The opponent's mark consists of the word FINCHES in block capitals with no other aspect to it. As such the overall impression is derived solely from this word.

45. The holder's mark consists of a stylised word in a manuscript style of typeface. There are no other aspects to this mark and the overall impression is derived from this presentation.

46. In relation to the visual comparison, clearly both marks contain the same letters in the same order namely F-I-N-C-H. This is the entirety of the holder's mark and five of the seven letters in the opponent's mark. The points of difference are the additional letters ES in the opponent's mark and the stylisation of the holder's mark. However the stylisation *per se* does not have a particularly strong visual impact as it is not an unusual or uncommon typeface and it is clearly readable. Taking all this into account, I find there is a medium degree of visual similarity.

47. With regard to the aural comparison, the letters in common namely F-I-N-C-H will be pronounced identically with the only difference being the additional -IS sounded syllable in the opponent's mark. I find there is high degree of aural similarity.

48. Turning now to the conceptual comparison, it is settled case law that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer.[24] In my view the shared word FINCH will bring to mind the identical concept of the bird species and the opponent's mark will simply be seen as the plural form of that word. I do not find there is real conceptual difference between the singular and plural words, other than the numerical element, i.e. one finch versus

[24] 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.

two or more finches. However both marks have the bird species as their core meaning. Therefore I find the marks to be conceptually identical.

Distinctive character of the earlier mark

49. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion. In *Lloyd Schuhfabrik Meyer*[25] 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)."

50. Registered trade marks possess varying degrees of inherent distinctive character starting from the very low, because they are suggestive of, or allude to, a characteristic of the goods or services, scaling up to those with high inherent

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

distinctive character, such as invented words. The earlier mark consists of the ordinary dictionary word **FINCHES** and has no meaning in relation to the goods for which it is registered. As such I find that it is inherently distinctive to a medium degree.

51. I now turn my attention to the provision of evidence by the opponent to determine whether the distinctiveness of the earlier mark has been enhanced because of the use made of it. Following the criteria given in *Windsurfing above*, I find there are some particular deficiencies within the evidence provided and these were previously highlighted in paragraph 27. As such I do not find that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

52. 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.[26] I must also keep in mind the average consumer for 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.

53. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.

54. In *L.A. Sugar Limited*[27] Mr Iain Purvis Q.C., as the Appointed Person, explained that:

[26] *Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27
[27] *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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

55. So far in this decision I have found that:

- The goods are similar to a low degree.
- The average consumer will be paying a low to medium level of attention in primarily visual purchasing process although an aural dimension should also be factored in.
- The earlier mark is inherently distinctive to a medium degree.
- The marks are visually similar to a medium degree, aurally similar to a high degree and conceptually identical.

56. Taking into account the assessments I have made based on the comparison of the respective marks and their goods, I find that there is a likelihood of direct confusion. There is a two letter difference between the marks but these two letters simply constitute the difference between the singular and plural forms of the same dictionary word FINCH which I have already found have an identical concept. The singular and plural forms of the same word could easily be confused and lead to one mark being mistaken for the other. I reiterate the point about imperfect recollection that the consumer rarely has the chance to make direct comparisons between marks but instead relies on an imperfect recollection. I consider that to be the case here.

57. Having found a likelihood of confusion based on the current goods in the holder's class 33 specification, I turn now to the two fallback positions offered by the holder in its skeleton argument and reiterated at the hearing. The opponent acknowledged the holder's fallback positions at the hearing but made no specific comments in relation to them.

58. The first fallback position offered was *Spirits.* In making the comparison between *Spirits* and the opponent's goods, I am guided by the GC's comments in *Wesergold Getrankeindustrie*[28] in which it held that 'spirits, particularly whisky' was not similar to non-alcoholic beverages. Accepting that the respective goods were sometimes mixed together by consumers, the court nevertheless found that consumers would not expect the goods to originate from the same, or economically related, undertakings. Therefore the goods were not complementary within the meaning of the case law. Subsequently I find there is no similarity between the goods.

59. Having found there is no similarity between the holder's *spirits* and the opponent's goods, I do not need to consider the holders second fallback position.

60. Furthermore as I have found no similarity of goods then it follows that there is no likelihood of confusion. I am guided in this finding by Lady Justice Arden's comments in *eSure Insurance*[29], in which she stated that:

> "49........... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

[28] *Wesergold Getrankeindustrie GmbH & bCo KG v EUIPO,* case T-278/10
[29] *eSure Insurance v Direct Line Insurance,* [2008] ETMR 77 CA

Conclusion

61. The opposition fails. Subject to any appeal against this decision, the IR will be designated for protection in the UK for *Spirits* in class 33.

Costs

62. The holder has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice (TPN) 2/2016. At the hearing the holder drew my attention to its attendance at a CMC in this case held on 11 June 2021 and asked for that matter to be part of my consideration on costs. The purpose of the CMC was to address a request made by the opponent for an extension of time which was subsequently granted in its favour. Taking that into account, I award costs as follows:

£100	attendance at CMC
£300	reviewing notice of opposition and preparing counterstatement
£300	reviewing opponent’s evidence and preparing own evidence
£600	attendance at hearing
£1300	**Total**

63. I therefore order M&J Gleeson & Co to pay Hans-Gerhard Fink the sum of £1300, which 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 23rd day of May 2022

June Ralph
For the Registrar,
Comptroller-General