O-484-22

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3525565
BY SIMON CADISCH
TO REGISTER THE FOLLOWING TRADE MARK:

Bitch Diesel

IN CLASS 33

AND

OPPOSITION THERETO UNDER NUMBER 423431
BY DIESEL FARM SOCIETÀ AGRICOLA S.R.L.

BACKGROUND AND PLEADINGS

1. On 22 August 2020, Simon Cadisch ("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 4 December 2020 and registration is sought for the following goods:

Class 33 *Alcoholic beverages*

2. On 4 March 2021, DIESEL FARM SOCIETÀ AGRICOLA S.R.L. ("the opponent") opposed the application based upon section 5(2)(b) of the Trade Marks Act 1994 ("the Act"). The opponent relies upon the following trade mark ("the earlier mark"):

DIESEL FARM
European Union Trade Mark ("EUTM") number 3801859.[1]
Filing date 29 April 2004; registration date 19 August 2005.

3. The opponent relies upon *alcoholic beverages (other than beers)* in class 33.

4. The opponent claims that the marks are similar, and the goods are identical, resulting in a likelihood of confusion.

5. The registration procedure for the earlier mark was completed more than five years prior to the filing date of the contested application. Therefore, it is subject to proof of use pursuant to section 6A of the Act. The opponent made a statement of use for the goods relied upon.

6. The applicant filed a defence and counterstatement denying a likelihood of confusion on the basis of a lack of similarity between the marks. The applicant requested proof of use of the opponent's earlier mark.

[1] Although the UK has left the EU and the transition period has now expired, EUTMs are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019. Tribunal Practice Notice 2/2020 refers.

7. Both parties filed evidence and submissions during the evidence rounds. Neither party requested an oral hearing and only the applicant filed written submissions in lieu. The applicant is represented by Ellis IP Ltd and the opponent by Murgitroyd & Company.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in the form of the witness statement of Alessi Arianna Roberta dated 13 August 2021 and its corresponding nine exhibits (DF1 – DF9). Ms Roberta is a Legal Representative within the opponent company. The opponent also filed written submissions dated 17 August 2021.

9. The applicant filed evidence in the form of the witness statement of Michael Ellis dated 22 November 2021 and its corresponding three exhibits (SC1 – SC3). Mr Ellis is Director of Ellis IP, representing the applicant. The applicant also filed written submissions dated 22 November 2021.

10. The opponent filed evidence in reply in the form of the witness statement of Christian Finn dated 24 January 2022 and its corresponding two exhibits (CF1 – CF2). Mr Finn is Director of Murgitroyd & Company, representing the opponent. The opponent filed further written submissions dated 24 January 2022.

11. The applicant filed written submissions in lieu of a hearing dated 15 March 2022.

12. I have considered the evidence and submissions of the parties and will refer to them, where necessary, during this decision.

DECISION

Relevance of EU law

13. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of use

14. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

> "6A (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)-(5A) [Repealed]

(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."

15. Section 100 of the Act is also relevant, which reads:

"100. 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."

16. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

"114. […] 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 P *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*

Bundervsvereinigung 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 P *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]."

17. As the earlier mark is an EUTM, the comments of the Court of Justice of the European Union ("CJEU") in *Leno Merken BV v Hagelkruis Beheer BV*, Case C-149/11, are relevant. The court noted that:

"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 trade 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)."

The court held that:

> "Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to 'genuine use in the Community' within the meaning of that provision.
>
> A Community trade mark is put to 'genuine use' within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the market concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity."

18. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited,* [2016] EWHC 52, Arnold J. (as he then was) reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issues in London and the Thames Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guildford, and thus a finding which still left open the possibility of conversion of the Community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State". On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand

> it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

19. The General Court ("GC") restated its interpretation of *Leno Merken* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now an EUTM). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods being limited to that area of the Union.

20. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the earlier mark is 23 August 2015 to 22 August 2020.

21. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:

i) The scale and frequency of the use shown;
ii) The nature of the use shown;
iii) The goods for which use has been shown;
iv) The nature of those goods and the market(s) for them; and
v) The geographical extent of the use shown.

22. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[2]

23. Ms Roberta gives evidence that DIESEL FARM was first used in the UK on a red wine named Rosso di Rosso in 2001 and has been used on similar goods since. From 2017, DIESEL FARM wines could be purchased online from third party e-commerce websites, such as those of Drinks & Co and Wine Searcher, and from 2020, directly from the DIESEL FARM website.[3] This is corroborated by copies of webpages taken from https://shop.dieselfarm.com.[4] DIESEL FARM is visible on the bottles of wine themselves and in the descriptions of the products. The prices of the wines are in euro. The webpages are dated 14 September 2021, presumably the date on which they were accessed. I bear in mind that this shows the picture more than one year after the end of relevant period.

24. Wines and sparkling wines either bearing the DIESEL FARM mark or named DIESEL FARM in the product descriptions are shown on the websites of Drinks & Co and Tannico; prices are in pound sterling. Further red and rosé wines (as well as olive oil) referred to as DIESEL FARM in the product descriptions are available from the DIESEL FARM website referred to in the previous paragraph; prices are in euro.[5] I note, however, that the wines displayed on the UK websites are out of stock, with no indication of when they will be available to purchase. The webpages in the relevant exhibit are either undated or dated 12 August 2021, again, presumably the date on which they were accessed.

25. Turnover for the DIESEL FARM brand between 2016 and 2020 is as follows:

Year	**Turnover (£)**
2020	4,677.02
2019	3,561.44

[2] *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09
[3] Paragraph 2 of the witness statement of Alessi Arianna Roberta.
[4] Exhibit DF1
[5] Exhibit DF2

2018	7,191.04
2017	8,499.35
2016	920.81

26. The turnover figures are supported by 11 invoices, seven of which fall within the relevant period.[6]

27. DIESEL FARM wines have been rated on the website www.vivino.com, and for the six wines available, they have an average rating of 3.9 out of 5, based on 953 ratings.[7] These pages were accessed on 13 August 2021 and so I bear in mind that a proportion of these ratings are likely to fall outside of the relevant period. Two articles featuring DIESEL FARM wines are also in evidence, one of which is dated March 2017 and the other 13 August 2021, the date on which the page was accessed.

28. Ms Roberta explains that goods bearing the DIESEL FARM mark have received numerous awards.[8] This is corroborated by the pages contained within exhibit DF5. It is not clear, for all of the awards, in what years they were received. However, there appear to have been several within the relevant period, including:

- International Wine & Spirit Competition ("IWSC") 2020 Bronze Award;
- IWSC 2019 Bronze Award;
- London Wine Competition Best in Show by Variety 2019;
- Veronelli Guide 2020 Three Gold Stars (for Rosso di Rosso 2015);
- IWSC 2020 Silver Award;
- Veronelli Guide 2020 Three Gold Stars (for Nero di Rosso 2015); and
- Veronelli Guide 2020 Three Gold Stars (for Bianco di Rosso 2015).

[6] Exhibit DF3
[7] Exhibit DF4
[8] Paragraph 6 of the witness statement of Alessi Arianna Roberta.

29. Ms Roberto gives evidence that the opponent regularly participates in wine competitions and festivals throughout the United Kingdom and Europe[9] and has provided invoices to demonstrate proof of entry.[10]

30. Ms Roberto has provided copies of press articles featuring DIESEL FARM and states that they are accessible to persons living in the UK.[11] The articles appear to be written in Italian and I have not been provided with translated copies; I do not intend to attempt to decipher their contents.

31. Exhibits DF8 and DF9 relate to the opponent's marketing and advertising activities. I have not been provided with the amount spent on marketing annually or in total, but there are seven invoices dated within the relevant period, six of which appear to be for marketing material such as business cards, prints, brochures and catalogues and total approximately 6,000 euros.

32. Whilst some of the opponent's evidence is undated or dated outside the relevant period, it is apparent that DIESEL FARM has been used on wines and sparkling wines during the relevant period that have been available to purchase at least in the UK and Italy. The turnover is not overwhelming, but I remind myself that use does not have to be quantitively significant to be genuine. Further, I consider the use in the UK and Italy to have constituted a substantial part of the EU at the relevant date. Taking all of the evidence into account, I am satisfied that the opponent has demonstrated genuine use of the earlier mark in the EU.

33. I must now consider whether, or the extent to which, the evidence shows use of the earlier mark in relation to the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs QC as the Appointed Person summed up the law as being:

> "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

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[9] Paragraph 7 of the witness statement of Alessi Arianna Roberta.
[10] Exhibit DF6
[11] Paragraph 8 of the witness statement of Alessi Arianna Roberta and exhibit DF7.

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."

34. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)*,* Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

> "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 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 Pl*c [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."

35. The opponent relies upon *alcoholic beverages (other than beers)*. The use shown by the opponent overwhelmingly relates to red, white and rosé wine and, to a lesser extent, sparkling wine. There is no evidence of use in relation to any other alcoholic beverages. The goods would be fairly described by the average consumer as wines and sparkling wines, which would be perceived as identifiable sub-categories of the broader term *alcoholic beverages*. Accordingly, a fair specification for the earlier mark is:

Class 33 *Wines; Sparkling Wines*.

Section 5(2)(b)

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

"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."

Relevant law

37. 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.

The principles

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

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

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

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

38. In light of my findings above, the competing goods are the opponent's *wines; sparkling wines* and the applicant's *alcoholic beverages*.

39. In *Gérard Meric v OHIM*, the GC confirmed that even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):[12]

[12] Case T-133/05

> "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."

40. The opponent's goods fall within the scope of the applicant's and so, in line with *Meric*, the parties' goods are identical.

The average consumer and the nature of the purchasing act

41. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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."

42. The average consumer of alcoholic beverages is an adult member of the general public. The purchase is primarily visual; the consumer either visually peruses a menu at a bar or scans the shelves behind a bar and then orders, or visually scans shelves in a shop or pages on a website and makes a self-selection. However, the goods may be ordered orally and so I cannot discount an aural component to the purchase.

43. The level of attention in buying the goods will not be of the highest level but consumers will consider the flavour and alcohol content of the goods, as well as any dietary requirements. Allowing for those who purchase inexpensive alcoholic beverages such as alcopops and those who purchase expensive champagne, for example, the attention level of the consumer is no higher than medium.

Comparison of marks

44. It is clear from *Sabel* that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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 relevant 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 artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade 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 trade marks to be compared are as follows:

Earlier mark	**Contested mark**
DIESEL FARM	Bitch Diesel

47. Both parties have filed evidence and submissions relating to the meaning of the word DIESEL in relation to the goods at issue. The applicant contends that DIESEL is descriptive of alcoholic beverages since it is the name of a drink made with lager, cider and blackcurrant cordial. The applicant has filed evidence in support of this assertion from the websites of Wikipedia, The Student Room and Drinks Mixer.[13] The opponent filed evidence in support of its submission that the drink referred to by the applicant is known by different names regionally.[14] The applicant's evidence does not satisfy me that DIESEL is descriptive of alcoholic beverages: the pages of all three websites indicate that different names are used regionally and so the evidence does not support a finding that DIESEL will be considered descriptive of the goods to the average consumer.

48. The contested mark consists of the two words BITCH and DIESEL, where the first letter of each word is capitalised. There are no other elements that contribute to the overall impression of the mark, which rests in the two words, with neither word dominating.

49. The earlier mark consists of the two words DIESEL and FARM in upper case. Again, there are no other elements that contribute to the overall impression of the mark, which rests in the two words. I do not agree with the opponent that the word FARM is descriptive and non-distinctive. Whilst I accept that a farm is often used to produce ingredients for alcoholic beverages, the link for consumers between the word FARM and the goods is a tenuous one and not one that results in DIESEL being the distinctive element of the mark. I am of the view that both words in the mark are equally dominant.

Visual comparison

50. The marks coincide in the word DIESEL, though the fact that it appears at the beginning of the earlier mark and the end of the contested mark creates a visual

[13] Exhibit SC1 to the witness statement of Michael Ellis.
[14] Exhibit CF1 to the witness statement of Christian Finn.

difference. Both marks contain an additional word that does not appear in the other mark. Overall, I find a low degree of visual similarity between the marks.

Aural comparison

51. There is nothing to suggest the marks will not be articulated in their entirety. Both marks consist of three syllables; the first and second syllables in the earlier mark are identical to the second and third syllables in the contested mark. The remaining syllable in the marks (FARM and BITCH) are aurally very different. Overall, I find a low to medium degree of aural similarity between the marks.

Conceptual comparison

52. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM*.[15] The assessment must be made from the point of view of the average consumer.

53. Both the earlier mark and the contested mark are an unusual combination of words, with no clear meaning other than the ordinary definitions of the words making up the marks. Consumers will see the marks and think of the meaning of the two words individually, since they have no obvious meaning combined: DIESEL and FARM for the earlier mark and BITCH and DIESEL for the contested mark. There is a conceptual overlap due to the shared word DIESEL, but this only creates a low degree of similarity given the ambiguity of the marks.

Distinctive character of the earlier mark

54. In *Lloyd Schuhfabrik Meyer* 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

[15] [2006] e.c.r.-I-643; [2006] E.T.M.R. 29

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)."

55. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

56. I will begin by assessing the inherent distinctive character of the earlier mark. The earlier mark consists of two ordinary dictionary words, though their combination is unusual and has no meaning in relation to the goods. Consequently, I consider the mark to be inherently distinctive to a medium degree.

57. Turning now to consider whether the distinctiveness of the earlier mark has been enhanced through use, I refer to the opponent's evidence of use, summarised above. I bear in mind that evidence of use outside the UK does not assist here given that it is the UK consumers who are relevant to the assessment. Though there is evidence of catalogues and brochures having been produced, it is not clear exactly how many

were circulated and to whom. As stated at paragraph 31, above, I have not been provided with the amount spent on marketing, annually or in total. The only figures before me for the amount invested in promoting the mark originate from invoices for marketing material, totalling approximately 6,000 euros. I also bear in mind an annual turnover of no more than £8,500 (in 2017), which, for the wine market in the UK, is quite insignificant, despite the opponent claiming a 2% share of the UK wine market, something that is not corroborated by the evidence before me. Taking everything into account, the evidence does not persuade me that the distinctiveness of the earlier mark has been enhanced through use.

Likelihood of confusion

58. 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 down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

59. I have found the marks to be aurally similar to a low to medium degree and visually and conceptually similar to a low degree. I have found the earlier mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be an adult member of the general public who will purchase the goods predominantly by visual means, though I do not discount an aural element to the purchase. I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods at issue to be identical.

60. Notwithstanding the principle of imperfect recollection, I consider that there are sufficient differences between the marks to avoid them being mistakenly recalled as each other. Whilst both marks contain the word DIESEL, each mark contains an additional word not present in the other, which will not go unnoticed. Despite the identical goods, I do not consider there to be a likelihood of direct confusion.

61. I go on now to consider whether the average consumer, having recognised that the marks are different, considers the common element of both marks (the word DIESEL) and determines, through a mental process, that the marks are related and originate from the same, or an economically linked undertaking.

62. Indirect confusion was described in the following terms by Iain Purvis QC, sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc:*[16]

> "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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: 'The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark'.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

[16] BL O/375/10

(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)."

63. That the three categories in that case are non-exhaustive was confirmed by the Court of Appeal in *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*.[17] Arnold LJ said, of the explanation given in *LA Sugar* about how indirect confusion arises:

"12. This is a helpful explanation of the concept of indirect confusion, which has frequently been cited subsequently, but as Mr Purvis made clear it was not intended to be an exhaustive definition. For example, one category of indirect confusion which is not mentioned is where the sign complained of incorporated the trade mark (or a similar sign) in such a way as to lead consumers to believe that the goods or services have been co-branded and thus that there is an economic link between the proprietor of the sign and the proprietor of the trade mark (such as through merger, acquisition or licencing)."

64. Arnold LJ pointed out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

[17] [2021] EWCA Civ 1207

65. As pointed out by Mr James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Ashish Sutaria*, “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”, before observing that the differences between marks which are the reason why there is no likelihood of direct confusion might also be the reason why there is no indirect confusion.[18] In a subsequent case, *Duebros Limited v Heirler Cenovis GmbH*, Mr Mellor QC, again sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element.[19] This is mere association not indirect confusion.

66. For the average consumer to reach a conclusion that the undertakings responsible for the marks are linked, they would need to decide that the presence of DIESEL in both marks indicates a shared origin. Whilst I disagree with the applicant that DIESEL is descriptive for the goods, neither is it so distinctive for the goods at issue that no one else other than the opponent would use it in a trade mark. The removal of the word FARM - which I have found not to be descriptive - at the end of one mark and the addition of the word BITCH at the start of another does not seem like a logical re-branding, co-branding or brand extension. Rather than consumers analysing the marks and coming to the conclusion that both marks are DIESEL marks and are linked, it is far more likely that the common element will be perceived as a coincidence. I do not consider there to be a reasonable basis for a finding of indirect confusion.

CONCLUSION

67. The opposition has been unsuccessful and the application will proceed to registration.

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[18] BL O/219/16

[19] BL O/547/17

COSTS

68. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances I award the applicant the sum of £1,250, calculated as follows:

Considering the other side's statement and preparing a counterstatement	£200
Preparing evidence and considering the other side's evidence	£750
Preparing submissions in lieu of a hearing	£300
Total	**£1,250**

69. I therefore order DIESEL FARM SOCIETÀ AGRICOLA S.R.L. to pay Simon Cadisch the sum of £1,250. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 6th day of June 2022

E VENABLES
For the Registrar