

O/0853/23

TRADE MARKS ACT 1994

TRADE MARK APPLICATION 3749694 BY T D PLATT

AND

OPPOSITION 433657 BY LISTER'S BREWERY LTD

AND

TRADE MARK REGISTRATION 3594913

IN THE NAME OF LISTER'S BREWERY LTD

AND

APPLICATION 504941 BY T D PLATT

FOR THE INVALIDATION OF THIS REGISTRATION

BACKGROUND AND PLEADINGS

1. These are consolidated opposition and cancellation proceedings between Lister's Brewery Ltd ("The Brewery") and T D Platt ("Platt"). The Brewery opposes an application filed on 1st February 2022 by Platt to register **Listers** as a trade mark in relation to:

Class 29: Potato crisps; Crisps (Potato-); Low-fat potato crisps; Crisps; Potato crisps in the form of snack foods; Vegetable crisps; Potato chips; Chips (Potato-); Potato fries; Flakes (Potato-); Fried potatoes; Chipped potatoes; Potato snacks; Processed potatoes; Potato snack foods; Low-fat potato chips; Potato-based snack foods.

Class 31: Potatoes, fresh; Raw potatoes; Unprocessed potatoes; Fresh potatoes.

2. Platt denies the grounds of opposition to its own application and seeks to invalidate one of the earlier trade marks (No. 3594913) relied on by The Brewery. Trade mark 3594913 is registered in the name of The Brewery in relation to *potato crisps* and similar snacks in classes 29 and 30. The mark looks like this:



3. According to The Brewery, if Platt's mark is used in relation to the goods in classes 29 and 31 specified in the opposed application, there is a likelihood of confusion with trade mark 3594913.

4. Further, the Brewery claims that the use of Platt's mark in relation to the goods specified in class 29 above (only) would also create a likelihood of confusion with three other earlier registered marks. These are shown below.

<i>Trade Mark</i>	<i>Number</i>	<i>Goods relied on</i>	<i>Registered owner</i>
Lister's Brewery	3196257	Class 32: Beer and brewery products; Beer.	Alan Waite
Lister's	3159694	Class 33: Sloe gin.	The Brewery
Lister's	3496668	Class 31: Foodstuff for dogs.	The Brewery

5. The Brewery claims that these three earlier marks have been used and acquired a reputation. According to The Brewery, use of Platt's mark would, without due cause, take unfair advantage of the reputation or distinctive character of these earlier marks, and/or be detrimental to their distinctive character. According to The Brewery's pleadings, this objection is directed at Platt's goods in class 29 (only) so far as earlier trade marks 3196257 and 3496668 are concerned. Rather oddly, it extends to Platt's goods in class 31 too so far as earlier trade mark 3159694 is concerned.

6. The Brewery further pleads that it has acquired a valuable goodwill as a result of the use of **LISTER'S** and the composite mark shown in paragraph 2 above, since 2013 in relation to beer and gin, and since 2019 in relation to dog biscuits. According to The Brewery, use of Platt's mark in relation to potato crisps and similar goods in class 29 would constitute a misrepresentation to the public that those goods are an extension line to The Brewery's trade in beers, gins and dog biscuits. It is claimed that such a misrepresentation would damage The Brewery's goodwill. Accordingly, The Brewery claims that use of Platt's mark would be contrary to the law of passing off.

7. Consequently, The Brewery says that registration of Platt's mark would be contrary to sections 5(2), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"), which are as follows:

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

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

(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.”

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“(3) A trade mark which—

(a) is identical with or similar to an earlier trade mark,

(b) –

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

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“(4) A trademark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented—

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) –

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

8. Platt filed a counterstatement denying The Brewery's claims. I note, in particular, that Platt:

- (a) Requested proof of use of earlier trade marks 3159694 and 3196257;
- (b) Denied that the drinks for which either of these marks are registered in classes 32 and 33, or foodstuff for dogs for which earlier mark 3496668 is registered in class 31, are similar to *potato crisps* or any of the other goods specified in its application;
- (c) Claimed that Lister is a common name with limited distinctiveness;
- (d) Claimed to have senior rights to Lister's (and Listers) in relation to crisps as a result of the use of those marks since 2019;
- (e) Disputed that the opponent is entitled to rely on earlier trade mark 3196257 (Lister's Brewery) because that mark is registered in the name of Alan Waite, not The Brewery, and there is no evidence of a licence agreement between them.

9. Platt's application to invalidate The Brewery's trade mark 3594913 (per paragraph 2 above) is based on sections 47(2) and 5(4)(a) of the Act, the former of which is as follows:

"(2)the registration of a trade mark may be declared invalid on the ground—

(a) -

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration."

10. According to Platt's pleaded case, it has been using **Lister's** (with and without an apostrophe) and this mark:



- throughout the UK, in relation to crisps since February 2019. Consequently, by 12th February 2021, when The Brewery applied to register the mark shown in paragraph 2, Platt had already established a relevant goodwill and an earlier right to **Lister's**. Further, use of the applied-for mark by The Brewery would constitute a misrepresentation to the public that its products are connected with Platt, which would damage its goodwill. Consequently, use of trade mark 3594913 would be contrary to the law of passing off. Registration of the mark was, therefore, contrary to section 5(4)(a) of the Act.

11. The Brewery filed a counterstatement denying Platt's grounds for invalidation. I note The Brewery put Platt to proof that it had acquired sufficient goodwill under **Lister's** by 12th February 2021 to establish a passing off right against The Brewery.

REPRESENTATION

12. Platt was represented by 3volution Ltd. However, shortly before the hearing mentioned below, it changed representatives. It is now represented by Brabners LLP. The Brewery has been represented throughout by Murgitroyd & Company.

13. On 2nd April 2023 a hearing was appointed for 7th July. Platt was represented at the hearing by Sara Ludlam of Brabners LLP. The Brewery's representatives initially indicated that it would be represented by Emma Hodson of Murgitroyd. However, shortly before the hearing they advised that Ms Hodson was no longer available. Instead, written submissions were filed on behalf of The Brewery.

THE EVIDENCE

14. The Brewery's evidence consists of two witness statements by Emma Hodson (with 8 exhibits) and one by Philip Waite (with 7 exhibits). As noted above, Ms Hodson is a Trade Mark Attorney acting for The Brewery. The purpose of Ms Hodson's evidence is to show that beer is similar to, or associated with, potato crisps and the other goods in class 29 of Platt's application.

15. Mr Waite is a director, and along with his Father, Alan, co-founder of the business run by The Brewery since 2015. The purpose of his evidence is to show that his company, and the unincorporated partnership that preceded it, has used **LISTER'S** in relation to beers since October 2014 and, more recently, in relation to gin and dog treats.

16. Platt's evidence consists of witness statements by Thomas Platt (with 18 exhibits), two by Laura Platt (with 1 exhibit to the second), Chris Denning, Brain Morrissey (with 2 exhibits), Emma Brunyard (with 1 exhibit), Richard Wardle (with 2 exhibits), Russell D'Ambrosio (with 1 exhibit) and Paul Morton (also with 1 exhibit).

17. Mr Platt is a director of Platt. Laura Platt is his wife. She is also involved in running the business. The purpose of Mr Platt's evidence is to establish (1) why the name Lister's was chosen (as a tribute to his Grandfather, William Lister), (2) that preparations were made between 2016 – 2018 to launch Lister's Crisps, (3) the product was launched in January/February 2019, (4) Lister's Crisps have been marketed on a significant scale since then, (5) he had no knowledge of The Brewery when the mark was chosen, or when the trade began, (6) Lister is a surname used by various third party businesses trading in different market sectors, (7) that although beer and crisps are sold alongside each other in pubs, breweries do not supply crisps, and (8) that no evidence of brand confusion with The Brewery has come to light despite concurrent trading in crisps/beers.

18. Russell D'Ambrosio and Paul Morton are graphic designers. Their evidence is that they helped Platt develop (or further develop) the brand used for its crisps. Mr Morton says that Tom Waite first approached him about this work by in April 2016.

19. Chris Denning is the General Manager of the Lister's Arms pub in Malham, Yorkshire. His pub has sold Lister's Crisps since early 2022. According to Mr Denning, the use of the same name for the pub, which obviously sells beer (although not The Brewery's beer) and crisps, is an *"interesting talking point"* for customers, but does not *"confuse customers in a negative way."*

20. Ms Platt's evidence supports the evidence given by Mr Platt. She was also unaware of The Brewery until it contacted them in January 2021. Ms Platt's second statement additionally provides some evidence about the size of the UK markets for beer and dog biscuits. This is intended to show that The Brewery is a very small player in these markets.

21. Emma Brunyard worked for Platt and between December 2018 and March 2019. She was one of two employees dedicated to developing the crisps side of the business. She travelled locally in Yorkshire visiting potential customers and handing out price lists, flyers etc. trying to drum up custom for Lister's Crisps.

22. Brian Morrisey is a director of Snacks Brands Ltd, which is family-run business delivering snacks nationwide to customers in the licensed and food trades. His evidence is that his company has been buying Lister's Crisps from Platt on a wholesale basis and distributing them nationally to his customers since 2019.

23. Richard Wardle is a Senior Sales Lead at J L Brooks Ltd, which is a wholesale supplier of crisps, snacks, soft drinks, confectionery, pub and bar supplies to on-trade, sports clubs, schools, cafés etc. His evidence is that J L Brooks has been ordering Lister's Crisps from Platt on a wholesale basis since January 2020 and selling them on to its customers, mainly in the North and the Midlands.

PRELIMINARY PROCEDURAL ISSUE

24. As noted in paragraph 8(e) above, Platt contests The Brewery's entitlement to rely on earlier trade mark 3196257 (Lister's Brewery) because that mark is registered in the name of Alan Waite. In this connection, Platt points out that there is no evidence of a licence from Mr Waite in favour of The Brewery.

25. The Brewery representatives responded to Platt's challenge by asserting in written submissions that Alan Waite is the owner and a director of The Brewery. The closest the evidence comes to supporting this submission is the evidence of Philip Waite, who says that his father was co-founder of the business now run by The Brewery. If necessary, I would have been prepared to infer that The Brewery uses Alan Waite's trade mark with his consent. However, as I explained at the hearing, this is not sufficient to meet the requirements of article 2 of the Trade Marks (Relative Grounds) Order 2007,¹ which states that:

"2. The registrar shall not refuse to register a trade mark on a ground mentioned in section 5 of the Trade Marks Act 1994 (relative grounds for refusal) unless objection on that ground is raised in opposition proceedings by the proprietor of the earlier trade mark or other earlier right." (emphasis added)

26. This means that even a licensee of a registered trade mark is not entitled to bring opposition proceedings. Consequently, The Brewery is not entitled to rely on earlier trade mark 3196257 (Lister's Brewery) whether or not it uses that mark under an implied licence from Alan Waite. Further, section 38(2A) of the Act states that where an opponent relies on multiple earlier trade marks or other earlier rights "*the rights(if plural) must all belong to the same proprietor.*" This is potentially important because trade mark 3196257 is the only one of the earlier trade marks registered in relation to beers. It therefore forms a key part of the opponent's case, especially the case based on section 5(3) of the Act.

27. Non-compliance with the Trade Marks (Relative Grounds) Order and/or section 38 of the Act was not raised as an issue by Platt or (prior to the hearing) by the registrar. For the reasons given below, it is not necessary to resolve the matter at this stage.

¹ SI 1976/2007

OVERALL OUTCOME

28. The Brewery's opposition to Platt's trade mark application fails. This is essentially because:

- (i) The goods for which trade marks 3159694, 3496668 & 3196257 are registered are not similar, or sufficiently similar, to create a likelihood of confusion;
- (ii) The passing off right The Brewery claims based on its goodwill for beers fails for the same reason;
- (iii) The passing off right The Brewery claims based on its goodwill for gin and dog biscuits fails because it post-dates Platt's use of Lister's in relation to crisps;
- (iv) The reputation of Lister's Brewery for *beers*, *sloe gin* and *dog treats* at the date of Platt's application was insufficient to establish a qualifying reputation for section 5(3) purposes, and/or insufficient to justify a finding that use of Platt's mark would take unfair advantage of the reputation of the earlier mark, or be detrimental to its distinctive character;
- (v) Earlier trade mark No. 3594913 is invalid.

29. Platt's application to invalidate Brewery's trade mark 3594913 succeeds. This is essentially because:

- (i) Platt has succeeded in showing that it owned a more-than-trivial goodwill under LISTER'S in relation to crisps at the date trade mark application 3594913 was filed;
- (ii) Use of Listers by The Brewery would, at that date, have constituted a misrepresentation to the public that The Brewery's crisps/snacks were connected with Platt;
- (iii) This would have caused damage to Platt through diversion of sales and/or loss of control of the reputation attached to the name LISTER'S for crisps.

THE LONGHAND VERSION OF THE REASONS FOR THIS DECISION

Proof of use of earlier trade marks 3159694 and 3196257

30. Section 6A of the Act is as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(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), (aa) 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.”

31. Platt’s application was filed on 1st February 2022. The relevant period is therefore 2nd February 2017 to 1st February 2022. Although it was applied for in 2016, the registration procedure for trade mark 3196257 was not completed until 3rd February 2017 when the mark was entered in the register. This is less than 5 years prior to the date of Platt’s application (“the relevant date in the opposition”). Consequently, trade mark 3196297 is not subject to proof of use.

32. Trade mark 3159694 was registered on 12th August 2016. Therefore, reliance on this mark is subject to proof of use. In deciding whether **Lister’s** has been to genuine use in relation to gin, I have taken account of the guidance provided by Arnold J. (as he then was) in *Walton International Ltd & Anor v Verweij Fashion BV*,² and section 100 of the Act which states:

“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.”

33. Mr Waite’s evidence is that The Brewery has been selling Lister’s gin since May 2021. He says total sales of all goods in 2021 amounted to around £47k. This was lower than 2020 or 2022 because of COVID. Mr Waite says that 5% of these sales figures represents gin sales. According to an advertisement in exhibit PJW4, Lister’s ‘Tail Wagger’ gin retails for around £30. So the volume of gin sales is very small in absolute terms. It represents a tiny share of the UK gin market. However, there is nothing that calls into question whether the sales were made for any purpose other than the relevant one, i.e. to create a market for gin under the mark. On balance, I am satisfied that the evidence shows genuine use of Lister’s during the relevant period in relation to gin. Therefore, The Brewery is entitled to rely on the registration of trade mark 3159694 in relation to *sloe gin*.

² [2018] EWHC 1608 (Ch)

The Brewery's Section 5(1)/5(2) Grounds Of Opposition To Platt's Application

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

35. 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.

Average consumer and the selection process

36. It is contended on behalf of The Brewery that the relevant average consumer is “*an ordinary casual consumer somewhat in a hurry seeking to buy a snack to stave off hunger or have a treat*”, and therefore not a “*careful and diligent purchaser.*” I accept the relevant average consumer is a member of the general public. I also accept that snacks are not deeply considered purchases. The submission that the average

consumer should be regarded as lacking in care and diligence appears to me to conflict with the guidance in the case law that the average consumer is deemed to be “*reasonably well informed and reasonably circumspect and observant.*” However, I accept that the average consumer is likely to pay a below-average level of attention when selecting crisps and like products.

37. Such goods are likely to be selected mainly by eye from websites, point of sale displays, or directly from shelves. However, word-of-mouth orders may also play some part in the selection process.

Distinctive character of the earlier marks

38. The Brewery appears to take the position that the earlier marks have a ‘normal’ degree of distinctive character.³ The evidence indicates that trade mark 3594913 has not yet been used in relation to crisps and snacks in classes 29/30. There is no specific pleading that the distinctive character of the other earlier marks has, as a result of their use in relation to beers, gin and dog treats, been enhanced to ‘high’.

39. It is contended on behalf of Platt that the earlier marks have a low degree of distinctive character. It is submitted that the surnominal significance of Lister’s means that such marks are apt for use by different businesses named after someone called Lister. This is said to be borne out by the number of businesses that actually trade under that name.

40. The mere fact that a trade mark consists of, or includes, a surname does not mean that it is devoid of any distinctive character. However, as the CJEU held in *Harman International Industries, Inc v OHIM*:⁴

“Although it is possible that..... surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character.”

³ See, for example, paragraph 86 of the written submissions of The Brewery dated 4th July 2023.

⁴ Case C-51/09P

41. According to information Mr Platt found on the internet and included in his statement, 'Lister' is a common name, particularly in Yorkshire and other areas historically associated with the woollen industry. These include Lancashire, Lincolnshire and Norfolk. My own experience tells me that it is not a very common name in the context of the UK as a whole, like Smith or Roberts, but it is reasonably common. It is certainly common enough for the average UK consumer to recognise that it is a surname.

42. The use of surnames as trade marks for crisps and similar goods appears common, e.g. Walker's, Burt's. This confirms that surnames are capable of functioning as trade marks for such goods. However, the potential for other people of the same name, or businesses named after such people, to trade under the name inevitably introduces a degree of uncertainty in the consumer's minds when the same name is subsequently used in relation to different goods. It could indicate an extension of the line of products marketed by the first known user of that name, or a new trader who just happens to have the same name as the first user.

43. Mr Platt's evidence includes examples of a jewellery business and a couple of pubs in Yorkshire called Lister Horsfall and the Lister's Arms, respectively.⁵ This does no more than confirm the potential for businesses with names derived from Lister to peacefully co-exist in different market sectors.


44. I therefore accept that the degree of inherent distinctive character of the earlier marks (or, in the case of trade mark 3594913, the element comprising the word Lister's) is below average.

45. If The Brewery had pleaded that the earlier marks had acquired a high degree of distinctive character by the relevant date in the opposition proceedings, as a result of their use, I would have rejected that claim for the reasons given below in relation to the claimed reputation of earlier trade marks 3196257, 3159694 and 3496668.

⁵ See exhibit TP4

Comparison of the marks

46. The marks at issue are shown below.

Earlier trade marks	Contested trade mark
<p data-bbox="292 465 592 499">Trade mark 3594913</p>  <p data-bbox="300 864 600 898">Trade mark 3196257</p> <p data-bbox="336 954 632 999">Lister's Brewery</p> <p data-bbox="292 1149 770 1182">Trade marks 3159694 & 3496668</p> <p data-bbox="360 1238 496 1283">Lister's</p>	<p data-bbox="935 651 1058 685">Listers</p>

47. Marks are to be treated as identical where the later mark:

“.....reproduces, without any modification or addition, all the elements constituting the [earlier] trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”⁶

48. The presence or absence of an apostrophe is so insignificant that it may easily go unnoticed by average consumers. Therefore, I would have treated the contested mark as identical to earlier trade marks 3159694 & 3496668. However, The Brewery's

⁶ S.A. Société LTJ Diffusion v. Sadas Verbaudet SA, CJEU, Case C-291/00

pleaded case is that the contested marks are highly similar to the earlier marks. Consequently, that is how I have assessed the matter.

49. The word 'Brewery' in trade mark 3196257 is likely to be noticed by average consumers. However, having regard to the positioning of the word Lister's in this earlier mark (as the first element in the mark) and the obvious lack of distinctiveness of the second word, 'Brewery', in relation to beers, I have treated Lister's as the dominant and distinctive element of it. Consequently, the contested mark is also highly similar to earlier trade mark 3196257.

50. Earlier trade mark 3594913 includes a device of a dog's head. The device is not large in relation to the word Lister's, but it is not so insignificant that its presence (or absence) may go completely unnoticed by average consumers. However, as the word Lister's dominates the earlier mark due to its relative size, I have again treated Lister's as the dominant element of it. Consequently, the contested mark is also highly similar to earlier trade mark 3594913.

Comparison of the goods

51. The parties goods are set out in the table below.

Goods of the contested mark covered by the opposition under sections 5(1)/(2)	Goods relied on by opponent
Class 29: Potato crisps; Crisps (Potato-); Low-fat potato crisps; Crisps; Potato crisps in the form of snack foods; Vegetable crisps; Potato chips; Chips (Potato-); Potato fries; Flakes (Potato-); Fried potatoes; Chipped potatoes; Potato snacks; Processed potatoes; Potato snack foods; Low-fat potato chips; Potato-based snack foods.	<p><i>3594913</i></p> Class 29: Potato crisps; vegetable crisps; potato products and foodstuffs in the form of snacks; savoury snack foods; pork scratchings; mixtures of processed nuts with dried fruits; roasted, dried, salted, spiced, coated and processed nuts. Class 30: Snack biscuits, snack foods made from flour and from cereals; cereal

Class 31: Potatoes, fresh; Raw potatoes; Unprocessed potatoes; Fresh potatoes.	snacks; snack foods made from extruded potato/maize flour; extruded wheat snacks; extruded corn snacks; savoury snack foods; tortilla snacks; corn balls.
Class 29: Potato crisps; Crisps (Potato-); Low-fat potato crisps; Crisps; Potato crisps in the form of snack foods; Vegetable crisps; Potato chips; Chips (Potato-); Potato fries; Flakes (Potato-); Fried potatoes; Chipped potatoes; Potato snacks; Processed potatoes; Potato snack foods; Low-fat potato chips; Potato-based snack foods.	<p>3196257</p> <p>Class 32: Beer and brewery products; Beer.</p> <p>3159694</p> <p>Class 33: Sloe gin.</p> <p>3496668</p> <p>Class 31: Foodstuff for dogs.</p>

52. In *Canon*, the CJEU held 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.”

53. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case⁷ for assessing similarity are:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;

⁷ [1996] R.P.C. 281

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) 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;

(f) 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.

54. Platt's goods in class 29 and the goods in classes 29 and 30 for which earlier trade mark 3594913 is registered, are all snack foods. Therefore, they are (at the least) similar in purpose. They are also in competition with each other. They are plainly identical or similar goods. Platt's goods in class 31 are unprocessed potatoes. It is contended on behalf of The Brewery that these are similar or complementary to crisps because *"you need potatoes to make crisps."*

56. *Crisps* are a processed food used for a snack. Potatoes are raw vegetables. They are used for cooking, but not for snacking. The users of the respective goods are the same: the general public. The physical nature of the goods is plainly different. Platt's business is a farm growing potatoes. It has diversified into making crisps. There may, therefore, be some overlap in the production of potatoes and crisps, but there is no evidence that crisp producers generally grow their own potatoes, or that the public are aware of any such practice. So far as the public are concerned, potatoes come from farms, whereas crisps come from crisp/snack food producers. Admittedly, both types of goods would be stocked by the same sort of retailers, such as supermarkets and convenience stores. However, crisps would usually be found on different aisles to potatoes. The goods are obviously not in competition. Applying the usual criteria, these goods are not similar.

57. The Brewery's case really depends on the goods being 'complementary'. In *Kurt Hesse v OHIM*,⁸ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*,⁹ the General Court stated that "complementary" means:

"...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking."

58. In *Sanco SA v OHIM*,¹⁰ the General Court indicated that goods and services may be regarded as 'complementary' and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken against transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited*:¹¹

"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."

59. Potatoes are indispensable for the production of potato crisps, but they are not indispensable or important for the use of crisps. As I have already noted, there is no evidence that the public generally expect potato growers to produce crisps or vice versa. There is also no evidence that the goods are distributed by the same undertakings. The absence of such evidence is important because, as the General Court pointed out in *Compagnie des montres Longines, Francillon SA v OHIM*:¹²

⁸ Case C-50/15 P

⁹ Case T-325/06

¹⁰ Case T-249/11

¹¹ BL-0-255-13

¹² Case T-505/12

“60. consumers must consider it usual that the goods are sold under the same trade mark, which normally implies that a large number of the producers or distributors of the goods are the same.”

60. I therefore concluded that Platt’s goods in class 31 are not complementary, or otherwise similar, to the goods in classes 29 and 30 for which earlier trade mark 3594913 is registered.

61. Ms Hodson’s evidence is intended to show that Platt’s goods in class 29 (crisps) are complementary to the goods covered by earlier trade mark 3196257 (beer and brewery products). She says it is common practice for public house customers to purchase a beer and a packet of crisps. This is well known. I take judicial notice of this fact.

62. According to Ms Hodson, brewers have teamed up with crisp manufacturers to make a range of products under the same trade mark, or have made their own crisp product range. She provides the following evidence in support of this claim:¹³

<i>Producer & location</i>	<i>Source</i>	<i>What is shown</i>	<i>When</i>
Mikkeller Brewery, Denmark	Website The drinks business.com	Mikkeller joined up with a Danish crisp maker to produce organic beer crisps. These were available in Copenhagen, Aarhus, and online with sites in US, Japan, Singapore, Spain, and Germany.	January 2018
Guinness	Website Amazon.co.uk	Crisps co-branded with Guinness & Burts	26/10/22

¹³ See exhibits EH2 and EH3

		available. Date 'first available' indicated to be 2013/15.	
Black Sheep Brewery, Yorkshire	Website blacksheepbrewery.com	Black Sheep teamed up with crisp maker Seabrooks to create Steak and Ale crisps.	Article from August 2016
Burts Crisps, UK	Website burts.activationdevelopment.com	Burts marketed beer flavoured crisps co-branded with beer-brand Hobgoblin	26/10/22
Brightside Brewing, UK	Website Brightsidebrewing.co.uk	Brightside was selling third party Brown Bag crisps.	26/10/22
Fairfield Farm	Website Fairfieldfarmcrisps.co.uk	Crisp maker Fairfield Farm was advertising beer flavoured crisps co-branded with beer brand Adnams.	26/10/22

63. Ms Hodson's evidence also provides six examples of retailers of gift boxes and hampers marketing products consisting of, or including, beers and crisps or similar snacks.¹⁴ These are from webpages downloaded in November 2022 and mostly bearing copyright claims dated 2022 (i.e. they are from after the relevant date in the opposition). None of them show beers and crisps/snacks bearing the same trade mark.

64. Mr and Ms Platt's evidence is that whilst there may have been some limited co-branding between producers of beers and crisps, in their experience makers of beers do not make crisps, and makers of crisps do not make beers. This is because the production processes are very different. Mr Platt says his research revealed but a

¹⁴ See exhibit EH7

single example of beer and crisp makers co-branding a crisp-flavoured beer.¹⁵ Perhaps not surprisingly, the product does not appear to have been a success and is no longer available.

65. Mr and Ms Platt's evidence is supported by Platt's other witnesses. Mr Morrissey and Mr Wardle appear to be the most important of these because of their long experience in the wholesale trade. Although neither of their businesses supplies beer or gin, they say they have long experience of customers that do, and of customers who are pubs or bars. They give evidence to the effect that they are not aware of any supplier of beer/gin that also supplies crisps, or vice versa.

66. The Brewery's representatives point out that Mr Wardle's evidence shows that his own business supplies pubs/bars with crisps and another alcoholic product (wine). This is correct. Ms Hodson's second statement provides twelve further examples of wholesalers that supply (albeit in 2023) both beer/gin and snacks, including crisps. This does not appear to be controversial because in his evidence Mr Platt accepts that some wholesalers supply both crisps and beers. However, he disputes that such wholesalers would stock crisps alongside (by which I think he means 'in proximity to') beer (or gin or dog food). Ms Hodson second statement takes issue with this. She says that the webpages from two of the 12 wholesalers she found¹⁶ show crisps are advertised on the beer pages and vice versa. This is not evident to me from my perusal of the papers. However, I do not think it matters for the reasons given in paragraph 68 below.

67. As already noted, the test for complementarity between goods is whether the "*one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.*" As to the first requirement, I accept that beer and crisps are frequently consumed together, especially in a pub setting. However, that does not make the one important

¹⁵ See exhibit TP16 showing a collaboration between Seabrook and Northern Monk in 2021. It was no longer being produced in 2022. This collaboration is also referenced in exhibit EH4 to Ms Hodson's statement. It appears from this that crisp flavoured crisps was one of a number of innovative beers marketed by Northern Monk. In 2020, the company marketed a two-course roast dinner in beer form, using Aunt Bessie's Yorkshire Puddings and roast potatoes.

¹⁶ Bestway Wholesale and Imperial cash and Carry: see exhibit EH1 to Ms Hodson's second statement

(let alone indispensable) for the consumption of the other. The products are frequently consumed separately.

68. As to the second requirement, the relevant question is whether consumers consider it likely that the same undertaking would be responsible for quality of the crisps etc. and beers. This normally means that “*consumers must consider it usual that the goods are sold under the same trade mark.*” The mere fact that crisps and beers require different production processes and, therefore, tend to be made by different types of producers is not decisive. As I pointed out at the hearing, own-brand products are frequently marketed by undertakings who do not produce those products themselves. Similarly, the mere fact that the same retailer or wholesaler stocks both types of products is not decisive, if consumers believe responsibility for those products lies elsewhere, e.g. Walker’s crisps and Fuller’s beer. There is no evidence of retailers or wholesalers marketing own-branded beers and crisps and thereby taking responsibility for the quality of those goods.

69. The evidence of common or co-branding of beers and crisps is weak. Of the six examples of this practice relied on by the Brewery (see table at paragraph 62 above), only two are arguably prior to the relevant date in the opposition and in a place that is liable to have come to the attention of the relevant UK public (i.e. uses that may have affected the expectations of average UK consumers at the relevant date).

70. These are crisps co-branded as Guinness/Burts and Black Sheep/Seabrook. The first of these is actually shown in evidence gathered in October 2022, which is after the relevant date in the opposition. It arguably shows that such use started in 2013/2015. These are the dates from when the products are listed on Amazon’s UK website as having been made ‘first available’. It is not clear whether this means first available on Amazon (anywhere), or first available on Amazon’s UK website. There are no customer reviews included in the extracts which may have helped to answer this question. In any event, Guinness is plainly a big international business. The fact that it has teamed up with (and co-branded) crisps with a crisp maker does not establish that this is a common practice in the perception of average UK consumers of beers and crisps. The Black Sheep/Seabrook product is a relevant example of co-branding (albeit not one showing use of one mark for both products). However, there is no evidence as to the extent of the sales and promotion of this product, or of the UK

public's familiarity with it. In this connection, I note that the article in evidence states that the product was available from Black Sheep's bar in Masham, Yorkshire, which doesn't suggest there was extensive promotion in the UK.

71. This is why I conclude the evidence fails to establish that beer and crisps are complementary goods in the sense indicated in the case law. They are not similar on any other basis. Therefore, they are dissimilar goods.

72. The Brewery's case on gin and crisps being complementary goods is no stronger. In its final written submissions, The Brewery's representatives assert another connection between these goods; namely, (i) that crisps are made from potatoes, (ii) vodka is made from potatoes, and (iii) vodka is used to make gin. Point (i) is obvious and well-known. I believe point (ii) is correct, but I am not sure if it is well-known, i.e. a notorious fact. Point (iii) is not obvious or well-known. I therefore reject The Brewery's submissions on this point because (a) the opposition under section 5(2) is not directed at *potatoes* in class 31, only crisps and similar snacks in class 29, and (b) even if it is true that gin is made from vodka, the average UK consumer would not know this. Therefore, the suggested (but unproven) twice-removed connection between crisps and gin is irrelevant.

73. This is why the evidence fails to establish that gin and crisps are complementary goods in the sense indicated in the case law. They are not similar on any other basis. Therefore, they are dissimilar goods.

74. These findings are consistent with judgments of the EU's General Court. For example, in *Bodegas Montebello, SA v OHIM*,¹⁷ the Court made a comparison between wine and rum and decided they are dissimilar goods. In my view, there was more merit in the opponent's arguments in that case than there is in The Brewery's submissions that beer and gin are similar to crisps and similar snacks in class 29.

75. As regards crisps etc. compared to foodstuffs for dogs, I think it is obvious that (a) the nature and purpose of the goods is different, (b) they are sold through different

¹⁷ Case T-430/07

trade channels (or in different aisles in the case of supermarkets), (c) they are not in competition or complementary goods. They are plainly dissimilar goods.

76. This why all the goods for which trade marks 3159694, 3496668 & 3196257 are registered are dissimilar to Platt's goods in class 29.

77. These findings means that The Brewery's section 5(2) opposition to Platt's application in class 31 based on earlier trade mark 3594913 would have failed, even if the earlier trade mark was validly registered.¹⁸ Similarly, my findings that the goods for which earlier trade marks 3159694, 3496668 & 3196257 are registered are dissimilar to Platt's goods in class 29 based is sufficient, without more, to defeat The Brewery's section 5(2) grounds of opposition based on those marks.

Likelihood of confusion

78. There is a likelihood of confusion with earlier trade mark 3594913 if the contested mark is used in relation to the applied-for goods in class 29.

79. In case I am wrong to find that the goods for which earlier trade marks 3159694, 3496668 & 3196257 are registered are dissimilar to Platt's goods in class 29, I also considered whether there would be a likelihood of confusion with these marks. The Brewery's best case is founded on earlier trade mark 3196257 (Lister's Brewery), which is registered for beers in class 32.

80. The Brewery seeks to downplay the significance of Mr Denning's evidence on behalf of Platt, that the sale of Lister's crisps in the Lister's Arms does not cause confusion. It is pointed out that what he actually says is that it does not "*confuse customers in a negative way.*" The Brewery's representatives submit that this could mean there is some confusion. This is not a fair reading of Mr Denning's evidence. The gist of his evidence is that the concurrent use of Lister's/Lister's Arms is a talking point for customers, but does not deceive them into believing the users of the names are the same or economically connected. If The Brewery wanted to dig deeper into what Mr Denning meant by his chosen words the appropriate way to do this would

¹⁸ Some similarity of goods is essential to engage section 5(2) of the Act: See *Waterford Wedgwood plc v OHIM* – C-398/07 P (CJEU)

have been to ask for permission to cross examine him. It did not do so. In any event, I have not placed much weight on his evidence because it goes to the use of Lister's in relation to crisps/public house services rather than crisps/beers.

81. The Lister's Brewery mark is highly similar to the contested trade mark. However, it is of below-average distinctiveness, and even if the respective goods are similar, they are so to only a low degree. In these circumstances, I find that average consumers would regard the use of similar marks for beers and crisps etc. as no more than a coincidence. Such use may cause consumers to associate the marks in a similar way to that described by Mr Denning. However, this is mere association which does not constitute a likelihood of confusion.

82. Similarly, if I had accepted that gin and dog food are similar to some degree to crisps etc. I would have rejected The Brewery's section 5(2) case based on earlier trade marks 3159694, 3496668 for the same reasons.

The Brewery's Section 5(3) Grounds Of Opposition To Platt's Application

83. The Brewery's case is directed at Platt's goods in class 29 (only) so far as earlier trade marks 3196257 and 3496668 are concerned, but also to Platt's goods in class 31 so far as earlier trade mark 3159694 is concerned.

84. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oreal v Bellure* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

Reputation

85. Mr Waite's evidence is that The Brewery (or more likely the unincorporated partnership which preceded it) first produced beer in October 2014. He says the Brewery sold around:

£45k worth of goods in 2016;

£70k worth of goods in 2017;

£106k worth of goods in 2018;

£160K worth of goods in 2019;

£115k worth of goods in 2020;

£47k worth of goods in 2021;

£245k worth of goods in 2022;

£211 worth of goods "to date" in 2023.

86. Mr Waite's statement is dated 7th November 2022. Therefore, his reference to sales of goods in 2023 is plainly wrong. It is possible that all the years given in his statement are wrong: that 2015's sales are shown as 2016's, 2016's are shown as 2017's, and so on. However, if so, this points to a lack of care in the preparation of his evidence. This lack of care is also evident from the information he provides about the

date of first use of Lister's in relation to dog food. In paragraph 7 of his statement he says beer was first produced under 'Lister's' in October 2014, and that dog treats were sold under Lister's in March 2021. However, in paragraph 14 of his statement he says that Lister's dog biscuits were first made in 2019. It is not clear whether he is making a distinction between when dog biscuits were first made, as opposed to first sold. I have taken this lack of care and clarity into account in deciding how much weight to attach to Mr Waite's evidence.

87. Mr Waite claims that total sales since The Brewery started trading amount to over £1m. Only sales made before 1st February 2022 fall before the relevant date in the opposition. The sales figures for 2021 (which may be for 2020) are said to have been affected by the Covid pandemic. If the sales figures recorded for 2023 are actually for 2022, then about £20k of the sales recorded for 2023 are relevant. Assuming that the sales figures given for 2022 are actually for 2021, the annual sales figures provided by Mr Waite amount to just over £800k worth of sales prior to the relevant date in the opposition. Otherwise, taking the figures and dates at face value, the figure falls to around £565k worth of relevant sales.

88. Mr Waite says that 90% of the turnover relates to beer, 5% to gin and 5% to dog treats. Bearing in mind also that sales of gin and dog treats only started in 2021 (less than a year before the relevant date), The Brewery's best case is clearly based on earlier trade mark 3196257 (Lister's Brewery), which is registered for beers in class 32. The opponent's beers appear to have been sold to pubs etc. at around £1 – 1.25 per pint (without VAT) or £2 per half litre bottle.¹⁹ This suggests sales in the region of 650k pints of Lister's beer from the beginning of 2015 to 1st February 2022.

89. According to Mr Waite, LISTER'S appears on The Brewery's products, on packaging and labels, on beer clips in public houses where the beer is sold, and on the company's delivery van. It had over 1100 stockists throughout the UK at the date of Mr Waite's statement in 2022, and Lister's beer was at that date distributed to 31 counties. Given that total sales in 2022 appear to have been in the region of £20k per

¹⁹ See the invoices in exhibit PJW3

month, this indicates a large number of stockists taking small quantities of The Brewery's beers.

90. In *General Motors* the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation ‘in the Member State’. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation ‘throughout’ the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

91. According to an article published in *Drinks Business* in September 2020,²⁰ £2.2 billion worth of beer was sold through UK supermarkets during a four month period ending on 11th July 2020 as sales shifted from on-trade to off-trade during the lockdown associated with the Covid pandemic. This figure was up by £737m compared to the same period the year before. However, overall sales of alcohol fell from 2 billion litres to 1.3 billion litres during the same period. On any view, The Brewery's sale of (at most) 20k pints of beer per month in 2021 amounts to only a tiny proportion of the UK market for beers.

²⁰ See exhibit LP1 to Ms Platt's second statement

92. The relatively wide geographical scope of the sales is more helpful to The Brewery's case, although the impact of these sales on the market must have been diluted to some extent by the thin spread of them. The Lister's Brewery mark had been used for just over 7 years at the relevant date in the opposition. Thus, it was not a new mark, but neither was it a long established mark. Mr Waite's evidence is that The Brewery spent an average of £10k per annum on marketing and promotional activities. This includes maintaining a website, a Facebook page and word-of-mouth advertising through pub reviews. Between 2014 and the date of Mr Waite's statement in 2022, 16k visitors had used The Brewery's website. The Brewery has about 600 followers on Facebook and Instagram, and 1200 on Twitter. Lister's beers were referenced in an on-line article published on the website theargus.co.uk in March 2018, and on the website of local MP Nick Gibb in 2019. The Brewery also raised over £200k in crowd fundraising in 2020 and 2021, which it says further developed the reputation of the brand. However, it is not clear how many people saw these appeals and/or contributed.

93. None of this shows that Lister's Brewery received the kind of marketing and promotion that is likely to have reached a significant proportion of the beer-drinking public in the UK.

94. In *Spirit Energy Limited v Spirit Solar Limited*,²¹ Mr Phillip Johnson, as the Appointed Person, held that the opponent had not established a qualifying reputation for s.5(3) purposes. The opponent traded in solar energy equipment and installations and had used its mark in relation to such goods/services for 7 years prior to the relevant date in the proceedings. During the 5 years prior to the relevant date, it had installed solar energy generation equipment in over 1000 domestic homes and made over 700 installations for commercial customers. These sales had generated nearly £13m in income. However, there was limited evidence of advertising and promotion, and the amount spent promoting the mark had fallen in the years leading up to the relevant date. Additionally, the mark had only been used in South East England and the Midlands. Taking all the relevant factors into account, the Appointed Person

²¹ BL O/034/20

therefore decided that such use of the mark was not sufficient to establish a reputation for the purposes of s.5(3).

95. In *GNAT and Company Ltd & Anor v West Lake East Ltd & Anor*,²² HHJ Hacon held that the claimants had not established a qualifying reputation for the purposes of s. 10(3). The claimants had operated a restaurant at the Dorchester Hotel in Park Lane for around four years prior to the relevant date. Turnover was between £5m and £6m each year, which equated to approximately 70,000 customers served per year; advertising spend had varied significantly, from around £5,000 at its lowest to over £47,000. The claimants had provided dining vouchers worth about £17,000 to charities and there had been some press coverage and awards, but only 7 such articles appear to have been in evidence. The judge stated that, although it was likely that a spread of individuals across the UK would have read the articles or been made aware of the awards, the claimants' market share was tiny relative to the UK restaurant business as a whole. The advertising sums were also very small in that context and the business was in relation to a single restaurant. The judge concluded that the evidence satisfied the 'geographic' aspect of the test but not the 'economic' one, and that the use was not sufficient to establish that the claimants' mark had a qualifying reputation.

96. In my view, The Brewery's claim to a reputation for section 5(3) purposes is no stronger than the evidence advanced in those cases. It does not show that Lister's Brewery was known to a significant proportion of the beer-drinking public in the UK. This is why I decided it is insufficient for earlier trade mark 3196257 (Lister's Brewery) to qualify for protection in relation to beers under section 5(3) of the Act.

97. If I am wrong about this, and the earlier mark was known at the relevant date to a significant proportion of the beer-buying public, then I would have found that use of the contested mark would have caused a non-negligible proportion of the UK consumers of beers/crisps to make a link between the marks. This is consistent with the evidence of Mr Denning that the concurrent use of Lister's Arms/Lister's Crisps creates a talking point for his customers. I see no reason why the position would be

²² [2022] EWHC 319

any different in the case of Lister's Brewery for beers and the contested mark for crisps.

98. However, The Brewery's section 5(3) case based on unfair advantage would still have failed because:

(1) Even if the reputation established by Lister's Brewery at the relevant date in the opposition proceedings was sufficient to qualify for protection under section 5(3), the reputation was a modest one:

(2) Lister's Brewery is not a highly distinctive mark for the reasons given above;

(3) There is no likelihood of confusion for the reasons given above;

(4) There is no evidence that Platt intended to take advantage of the reputation of Lister's Brewery;

(5) In light of the above, and given the modest amounts spent marketing the earlier mark, I don't consider it realistic to say that use of the contested mark constitutes "*clear exploitation on the coat-tails of the mark with a reputation*" by exploiting "*the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image.*"

99. As regards Platt's intentions, The Brewery's representatives written submissions seek to cast doubt on the evidence of Mr and Ms Platt that, although they conducted searches, they were not aware of The Brewery when they selected Lister's for crisps, or when they first started trading under the contested mark. The Brewery did not request permission to cross examine them on the truth of their statements, and no evidence was filed to gainsay their evidence on this point. In these circumstances, I accept their evidence. It is common ground that they were aware of The Brewery's use of Lister's for beers when Platt's application was filed. However, they had been trading under Lister's in relation to crisps for more than two years by then. The motivation for Platt's application was plainly to protect the mark it used for the crisps side of its business, rather than by take advantage of any reputation The Brewery had established for beers.

100. The Brewery's section 5(3) case based on detriment to the distinctive character of the earlier mark would also have failed because:

(1) There is no likelihood of confusion;

(2) The earlier mark is not highly distinctive, let alone unique;

(3) There is no evidence of, or any logical basis for inferring, a change in the economic behaviour of average consumers of Lister's beers as a result of Platt's use of Lister's for crisps/snacks, or a serious risk that this will happen in future.

101. The Brewery makes no separate section 5(3) case based on detriment to the reputation of the earlier mark for beers.

102. The reasons given in paragraphs 91 – 101 above are why The Brewery's opposition under section 5(3) of the Act based on earlier trade mark 3196257 (Lister's Brewery) for beers would have failed, even if it had established that the earlier mark had a qualifying reputation.

103. The Brewery's section 5(3) case based on earlier trade marks 3159694 and 3496668 (both Lister's) for gin and dog food, respectively, is plainly weaker than the case based on Lister's Brewery for beers. Mr Waite's evidence is that The Brewery had sold five thousand packets of dog biscuits by the date of his statement in November 2022. He says that (by that time) they were available in 145 branches of the second largest pet shop chain in the UK. According to an article from the website petfoodpartners.co.uk,²³ the dog treat market is worth in the region of £693m per annum. The sale of five thousand packets of dog biscuits is clearly a drop in the ocean in this market. Bearing in mind also that this evidence goes to the position well after the relevant date in the opposition, The Brewery's case that Lister's was known as a trade mark for dog food by a significant part of the UK public is plainly hopeless.

104. The same applies to the section 5(3) case based on Lister's for gin. Sales of gin do not appear to have started until May 2021, just 8 months prior to the relevant date

²³ See exhibit LP1 to Ms Platt's second statement

in the opposition proceedings. It is not clear how much Lister's gin The Brewery sold during that period.²⁴ However, as The Brewery's total sales in 2021 amounted to £245k worth of goods (assuming again that the sales figure given for 2022 is actually for 2021), 5% of these sales could amount to no more than £12k. This is a miniscule proportion of the UK market for gin.

105. The reasons given in the previous two paragraphs are why The Brewery's opposition under section 5(3) of the Act based on the reputation of Lister's for gin and dog food, also failed.

The Brewery's Section 5(4)(a) Grounds Of Opposition To Platt's Application

106. As noted above, The Brewery relies on the use of **LISTER'S**, and the composite mark shown in paragraph 2 above, since 2013 in relation to beer and gin, and since 2019 in relation to dog biscuits. The opposition under this ground is directed at Platt's application in class 29 (only).

107. The evidence indicates that the public would regard The Brewery as responsible for the quality of the products marketed under the signs mentioned in the previous paragraph. This means that, subject to any agreement to the contrary (of which there is no evidence), The Brewery can claim to be the proprietor of any common law rights generated through the use of these signs. Consequently, unlike the position with The Brewery's section 5(2) and (3) grounds, there is nothing to prevent it relying on these signs for the purposes of its section 5(4)(a) grounds of opposition.

108. In *Discount Outlet v Feel Good UK*,²⁵ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

"55. The elements necessary to reach a finding of passing off are the 'classical trinity' of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of

²⁴ There is not a single invoice in evidence which shows sales of gin

²⁵ [2017] EWHC 1400 IPEC

deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

*56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”*

109. The threshold for acquiring protection under the law of passing off is lower than the threshold required to bring an opposition under section 5(3). As long as the level of trade in the UK is more than trivial, the law of passing off is available to a prospective claimant.²⁶

110. In *Sworders TM*,²⁷ I explained the relevant date in s.5(4)(a) proceedings as follows:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

111. Therefore, in order to succeed under section 5(4)(a), The Brewery has to show that Platt’s use of the contested mark, in relation to the goods covered by class 29 of its application, would have constituted passing off *both* at the date such use began *and* at the relevant date in the opposition.

²⁶ See, for example, *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590

²⁷ BL O-212-06. This summary was subsequently approved by Mr Daniel Alexander KC, as The Appointed Person, in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11

112. According to Mr Platt's evidence, Lister's crisps have been produced since January 2019. The first invoice for Lister's crisps in evidence is dated 30th March 2019. The Brewery has not yet marketed crisps or similar snacks under the signs it claims as earlier rights. According to Mr Waite, The Brewery's gin was first sold in May 2021. As explained above, his evidence as to when sales of Lister's dog treats/biscuits were first marketed appears contradictory. However, there is no evidence it was before March 2019. Consequently, the section 5(4)(a) grounds of opposition to Platt's application based on earlier rights to Lister's for gin and dog food must fail because The Brewery had no such rights at the date Platt first marketed Lister's crisps. Admittedly, the mark applied for is Listers not Lister's, but the difference is so slight that this is effectively the same mark.

113. Mr Waite's evidence is that The Brewery had sold goods to the following value prior to 2019:

£45k worth of goods in 2016;

£70k worth of goods in 2017;

£106k worth of goods in 2018.

114. Given that sales of other goods did not commence until 2019 at the earliest, these sales must all relate to Lister's beers. As explained above, sales figures for the years stated in Mr Waite's evidence must be wrong. If each year stated is one year after the year in which the associated sales actually occurred, this would mean the sales purporting to be for 2019 (£160k) are also relevant. Arguably, a small proportion of the £155k worth of sales claimed for 2020 (assuming these are actually 2019 figures) are also relevant.

115. Taking The Brewery's case at its highest, this would mean that it had sold around £400k worth of Lister's beer over 4 years before Platt started marketing Lister's crisps. That is enough to create a protectable goodwill. However, at the beginning of 2019 The Brewery was plainly still a small player in the UK beer market and using a name that was not especially distinctive.

116. In *Harrods Limited v Harrodian School Limited*,²⁸ Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

“There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff’s business. The expression “common field of activity” was coined by Wynn-Parry J. in McCulloch v. May (1948) 65 R.P.C. 58, when he dismissed the plaintiff’s claim for want of this factor. This was contrary to numerous previous authorities (see, for example, Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd. (1898) 15 R.P.C. 105 (cameras and bicycles); Walter v. Ashton [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the Advocaat case Lord Diplock expressly recognised that an action for passing off would lie although “the plaintiff and the defendant were not competing traders in the same line of business”. In the Lego case Falconer J. acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

²⁸ [1996] RPC 697 (CA)

[Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency) [1972] R.P.C. 838 at page 844 per Russell L.J.]

In the Lego case Falconer J. likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In Stringfellow v. McCain Foods (G.B.) Ltd. [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

'even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.'

117. In the same case Stephenson L.J. said at page 547:

'...in a case such as the present the burden of satisfying Lord Diplock's requirements in the Advocaat case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully

appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader’s name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents’ property in their goodwill, which must, as Lord Fraser said in the Advocaat case, be substantial.’ ”

118. There is no evidence of actual confusion as a result of the parties’ concurrent trade in beer and crisps. And I have found there is no likelihood of confusion, even if beer and crisps are similar to a low degree. This is why The Brewery’s opposition under section 5(4)(a) of the Act also failed.

Platt’s Application To Invalidate The Brewery’s Trade Mark Registration 3594913 Under Sections 47(2) and 5(4)(a) Of The Act

119. As The Brewery had not marketed crisps, or any of the other snacks in classes 29 and 30 covered by trade mark 3594913, prior to the date of the application to register the mark, the (only) relevant date in the invalidation proceedings is 12th February 2021.

120. As noted above, Mr Platt’s evidence is that Platt has been selling crisps under Lister’s since January/February 2019. In March 2019, Platt established Facebook and Instagram pages promoting these goods. The domain name listerscrisps.co.uk was established in June 2019. There is evidence that Lister’s crisps were promoted at the Great Yorkshire Show in July 2019.²⁹

121. A large proportion of Platt’s crisps business is conducted via wholesalers. Mr Wardle’s evidence is that J L Brooks has been placing weekly orders for Lister’s crisps since 2020.

122. In May 2020, Platt’s listerscrisps.co.uk website was made transactional so that the crisps could be bought online. Also in 2020, direct sales of Lister’s crisps

²⁹ See page 2 of exhibit TP8

commenced on Amazon. These developments further extended the reach of the brand.³⁰

123. The sign used on the packets for the crisps is the Lister's and stag's head logo shown in paragraph 10 above. However, product displays used just the words 'Lister's potato crisps'.³¹ The website and social media pages used 'listerscrisps'.

124. According to Mr Platt, sales of Lister's crisps in 2019 amounted to just over £29k. In 2020, sales rose to just over £40k. Sales rose again (to about £80k) in 2021, but most of these are after the relevant date in the invalidation proceedings. Therefore, it appears that sales prior to that date were in the region of £75k - £80k. The evidence indicates that the crisps are typically sold in packs of 25/40 individual units. The price for wholesalers appears to be around £8 per 25 pack. The price for retailers appears to be in the region of £15/20 per 25 pack.

125. The Brewery contests Platt's claim to have acquired a protectable goodwill under the signs in relies on in relation to crisps. Having regard to The Brewery's own use of Lister's since 2014/15, it also disputes that its use of trade mark 3594913 would amount to a misrepresentation, if it was used in relation to crisps and the other goods for which it is registered in classes 29 and 30. In this connection, The Brewery points out there is no evidence of confusion, and further disputes that any confusion would damage Platt's "*identifiable*" goodwill.

126. As stated earlier, provided it is more than trivial, the law of passing off protects the goodwill of a business from damage through misrepresentation.³² In *Lumos Skincare Limited v Sweet Squared Limited and others*,³³ the Court of Appeal in England and Wales held that the defendant had passed off its LUMOS nail care products as the claimant's goods. The claimant had been selling LUMOS anti-ageing products since 2007. The goods retailed at prices between £40 and £100 per bottle. The Claimant's sales were small; of the order of £2,000 per quarter from early 2008 to September 2009, rising to £10,000 per quarter by September 2010. The vast majority of these sales were to the trade, including salons, clinics and a market. As at the

³⁰ See the sales records at exhibit TP9

³¹ See the picture in exhibit TP11 from September 2019

³² See, for example, *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was)

³³ [2013] EWCA Civ 590

relevant date (October 2010) the Claimant had sold to 37 outlets and by that date it was still selling to 25 outlets. There was evidence of repeat purchases. Although the number of customers was small, or, as the judge at first instance put it, “*very limited*”, the claimant’s goodwill was found to be sufficient to entitle it to restrain the defendant’s trade under LUMOS.

127. In my view, Platt’s crisps business was sufficient in size and customer base by the relevant date in the invalidation proceedings to qualify for protection under the law of passing off. The customer base would have included not only Platt’s direct customers, but also the retailers who purchased Lister’s crisps from the wholesalers identified in the evidence, and members of the public who bought the crisps from retailers.

128. I am satisfied on the evidence that Lister’s (with or without an apostrophe) was distinctive of Platt’s crisps business at the relevant date to a substantial number of persons.

129. As to misrepresentation, it is true that there is no evidence of confusion with Lister’s Brewery. However, as The Brewery has not yet sold any crisps or snacks, this says nothing about the likelihood of confusion and deception if, or when, it starts doing so under trade mark 3594913.

130. Although trade mark 3594913 includes the device of a dog’s head (see paragraph 2 above), it is clear that **Lister’s** is the dominant element of that mark, and the name by which The Brewery’s crisps/snacks would be known. This is the same sign in which Platt has established goodwill for crisps. Therefore, despite the below average distinctiveness of Lister’s, it is obvious that The Brewery’s use of trade mark 3594913 in relation to the same goods (crisps) would deceive a significant number of Platt’s customers, or potential customers, into believing that The Brewery and Platt are the same or connected entities.

131. The Brewery’s mark is registered for other snacks in classes 29 and 30. However, they are all snacks and, therefore, natural extensions of a trade in crisps. Consequently, my findings on misrepresentation in relation to crisps extends to the other snacks for which trade mark 3594913 is registered.

132. As to The Brewery's prior use of Lister's in relation to beers, Platt was not passing off its crisps as being connected to The Brewery's business when such use commenced in 2019. The evidence indicates that the parties traded concurrently since 2019, without any evidence of confusion. It is The Brewery's prospective use of Lister's in relation to crisps/snacks which creates the likelihood of confusion and deception in the future. In these circumstances, The Brewery's first use of Lister's in relation to beers is no answer to Platt's claim to a passing off right.

133. The submission made on behalf of The Brewery, that any confusion would not cause serious damage to Platt's goodwill, is plainly wrong. Using such a similar mark has the obvious capacity to divert sales of crisps from Platt to The Brewery. Further, Platt would lose control of its reputation under Lister's. So if, for example, The Brewery marketed (say) Lister's corn snacks, and those products attracted negative publicity, a perceived connection with Lister's crisps would be bound to damage Platt's crisps business.

134. This is why Platt's application under section 47(2) of the Act is successful, and why I declare trade mark 3594913 invalid.

DIRECTION IF THERE IS AN APPEAL

135. In accordance with Rule 62 of the Trade Mark Rules 2008, I direct that if there is an appeal relating to the outcome of the opposition, and the appellant continues to seek to rely on earlier trade mark 3196257, the requirements of The Trade Marks (Relative Grounds) Order 2007 and section 38(2A) of the Act must be satisfied. This means that the trade mark must be transferred to the opponent/appellant, or all the earlier marks/rights that party still relies on brought into its name by other means.

COSTS

136. Platt has succeeded in both parts of the consolidated proceedings and is, therefore, entitled to a contribution towards its costs. I assess this as follows:

£400 for considering The Brewery's notice of opposition and filing a counterstatement;

£200 for the official fee for filing an application for invalidation of trade mark 3594913;

£200 for preparing that application;

£1800 for preparing evidence and considering The Brewery's evidence;

£1100 for considering The Brewery's written submissions, preparing a skeleton argument, and taking part in the hearing.

137. I therefore order Lister's Brewery Ltd to pay T D Platt the sum of £3700 within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated 8th September 2023

Allan James
For the Registrar