

O-003-14

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 2585906 IN THE NAME OF
BULLDOG ENERGY DRINK LTD

AND

OPPOSITION THERETO UNDER NO 102757 BY CK3 LLC

Background

1. Application No 2585906 has a filing date of 27 June 2011, stands in the name of Bulldog Energy Drink Ltd (“the applicant”) and seeks registration of the trade mark BULLDOG CIDER in respect of *cider*.

2. Following publication of the application in *Trade Marks Journal* 6909 on 14 October 2011, notice of opposition was filed by CK3 LLC (“the opponent”). The grounds of opposition were originally founded on sections 5(2)(a) and (b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) but the opponent confirmed at the hearing that the objection under 5(3) was withdrawn. In respect of the objection under section 5(2) the opponent relies on the following Community trade mark (“CTM”):

Mark	Dates	Specification of goods
CTM 5598421 BULLDOG	Filing date: 5 January 2007 Registration date: 7 February 2008	Gin

3. In respect of the objection under section 5(4)(a) of the Act, the opponent claims it has used the mark BULLDOG since “Quarter 4, 2007” throughout the UK in relation to “alcoholic beverages, in particular gin”.

4. The applicant filed a counterstatement wholly denying the grounds of opposition. Both parties filed evidence and the opponent also filed written submissions in lieu of filing evidence in reply. The evidence takes the form of witness statements by Raminder S Ranger who is Managing Director of the applicant and Anshuman Vohra who is founder and CEO of the opponent. Given the nature of the matters to be decided, I do not intend to summarise the evidence filed but I have reviewed it and will refer to it as appropriate in this decision. The matter came before me for a hearing on 11 December 2013. The applicant was represented by Mr Sanjay Raphael of Sun Mark Ltd. The opponent was represented by Ms Alaina Newnes of counsel instructed by Charles Russell LLP.

5. I pause at this point to explain that in a letter dated 23 October 2013, the applicant had indicated that it would be represented at the hearing by Mr Sanjay Raphael. On the day before the hearing, the applicant contacted the Trade Marks Registry by telephone and advised that Mr Ranger would be speaking on its behalf. At the start of the hearing, Mr Ranger was not in attendance though Mr Raphael was. Mr Raphael explained that Mr Ranger was “on his way” having been delayed due to transport difficulties caused by the weather but was expected to arrive within the next few minutes. After discussing the matter with both parties, I indicated that I would suspend the hearing for ten minutes. When the hearing reconvened, Mr Ranger had still not arrived. Mr Raphael had not contacted Mr Ranger nor did he have any knowledge of his current location. In response to my questions, Mr Raphael stated that he had full knowledge of the case and the issues involved, having been responsible for it for some time, was fully aware of the position of, and was able and content to represent, the applicant. Given the limited extent of the dispute between the parties, the fact that Mr Raphael had been closely involved throughout proceedings (he having signed and filed the Form TM8 in defence as well as much of the subsequent correspondence received from the applicant) and had indicated he

was fully prepared and content to proceed, I was satisfied that there would be no prejudice to the applicant. The hearing therefore commenced with Mr Raphael representing the applicant. In fact Mr Ranger arrived as Ms Newnes was making her submissions in response to those of the applicant. At the conclusion of the usual rounds of submissions, I afforded Mr Raphael and Mr Ranger the opportunity to confer then make any additional submissions considered necessary. The single submission made had already been made by Mr Raphael and Ms Newnes declined the opportunity to respond. I have considered all submissions made in reaching my decision.

The objection under section 5(2)(b) of the Act

6. I intend to consider first the ground of opposition based on section 5(2)(b) of the Act, the relevant parts of which read:

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

a) ...

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

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

7. An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.”

8. The opponent relies under this ground on its CTM 5598421 which, as can be seen from the dates set out in paragraph 2 above, is an earlier mark within the meaning of section 6 of the Act. Given the interplay between the date the earlier mark was entered in the register and the date of filing of the application, the earlier mark is not subject to the proof of use provisions set out in section 6A of the Act.

9. In considering this ground of objection and the likelihood of confusion between the respective marks, I take into account the guidance from the settled case law provided by the CJEU in *Sabel BV v Puma AG* [1998] RPC 199, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* [1999] RPC 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B. V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG & Adidas Benelux BV* [2000] E.T.M.R. 723, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH* C-120/04 and *Shaker di L. Laudato & C. Sas v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) C-334/05 P (LIMONCELLO)*. In the case of *La Chemise Lacoste SA v Baker Street Clothing Ltd*

[ALLIGATOR] O/333/10, Mr Hobbs Q.C., acting as the Appointed Person, set out the test shown below which was endorsed by Arnold J. in *Och-Ziff Management Europe Ltd and Oz Management Lp v Och Capital LLP; Union Investment Management Ltd & Ochocki*, [2010] EWCH 2599 (Ch).

- (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/ 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; nevertheless, the overall impression conveyed to the public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components;
- (e) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 in that mark;
- (f) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;
- (g) there is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character, either *per se* or because of the use that has been made of it;
- (h) mere association, in the sense that the later mark brings the earlier mark to mind, is not sufficient;
- (i) 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;
- (j) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of the respective goods

10. The goods to be compared are as follows:

Earlier mark	Application
Class 33 Gin	Class 33 Cider

11. In assessing the similarity of goods it is necessary to take into account, inter alia, their nature, their intended purpose, their method of use and whether they are in competition with each other or are complementary as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc Case C-39/97*.

12. In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281, Jacob J gave guidance as to how similarity should be assessed. He considered that the following should be taken into account when assessing the similarity of goods:

- “(a) The respective uses of the respective goods:
- (b) The respective users of the respective goods;
- (c) The physical nature of the goods;
- (d) The respective trade channels through which the goods 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 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 in the same or different sectors.”

He went on to say:

“in construing a word used in a trade mark specification, one is concerned with how the product is, as a practical matter, regarded for the purposes of trade”.

13. I also bear in mind the decision in *El Corte Inglés v OHIM Case T-420/03*, in which the court commented:

“96...goods or services which are complementary are those where 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 the production of those goods or provision of those services lies with the same undertaking (*Case T-169/03 Sergio Rossi v OHIM-Sissi Rossi* [2005] ECR II-685)”

14. Mr Raphael submitted that the respective goods are different. He submitted that gin and cider are made from different ingredients and through different production methods. He accepted that both are alcoholic drinks which may be used to quench a thirst but submitted that they do so in different ways as gin is mostly drunk with a mixer of some sort rather than neat whereas cider is drunk on its own. He submitted that cider and gin are distinct subcategories of alcoholic drinks which are categorised separately by the trade. In support of this claim he referred me to the following evidence:

Exhibit RR1: 9 pages (the last is blank) headed "Alcoholic Drinks Industry Guide". The cover page of the document indicates it was updated on 10 July 2012 i.e. after the relevant date in these proceedings. Mr Raphael submitted that as the guide includes separate entries for 'cider' and 'White Spirits and RTDs' this indicates the trade categorises gin and cider as separate products. In relation to the references to "cider" and "White Spirits and RTDs" referred to by Mr Raphael, these are listed under the heading "Market Research" and appear to indicate that Mintel reports were published under these titles in 2012. Under the heading "White Spirits and RTDs" is an explanation that the report covers "white spirits (gin, vodka, and white rum) and ready-to-drink mixed drinks and cocktails)".

The cover page of this document shows that it came from the British Library but there is no evidence to show how the document came to be compiled, by whom and for what purpose. It appears to me to be nothing more than a directory of resources, reports and publications which are available from a number of sources which, in some way, refer to various aspects of the various markets involving alcoholic drinks many of which have not been prepared by persons from the relevant trade. There are other headings in the document which link other drinks together, e.g. "Premium Lagers, Beers and Ciders", "Wine & Spirits Merchants" as well as others which refer to more general topics, e.g. "Alcohol in Restaurants", "Public Houses", "Alcoholic Drinks and an Aging Population". This document does not support the applicant's claim.

Exhibit RR3: 5 pages headed 'Eurocode 2 Core Classification version 99/2' and subtitled 'Main Group 11: Beverages (non-milk).' The pages indicate that they were downloaded from the ianunwin.demon.co.uk website on 17 January 2013, again after the relevant date. The evidence does not show, and Mr Raphael was unable to provide any information about the purpose or status of either the website itself or the information contained within the pages downloaded from it. Neither was he able to provide details of the source of or intended use or users of that information. Again, the document does not support the applicant's claim.

15. For her part, Ms Newnes submitted that the respective goods are highly similar. She accepted the applicant's view that gin and cider have different production methods and different ingredients but denied this meant they were not similar goods. Ms Newnes submitted that both gin and cider are alcoholic drinks, bought by adults and through the same trade channels such as in bars, restaurants, liquor stores and supermarkets as well as online. She went on to submit that both will be bought to

quench a thirst or for their alcoholic properties. Contrary to Mr Raphael's submissions, and referring to particular exhibits to Mr Vohra's evidence, she said that like cider, gin is also drunk neat (AV3 page 1 and AV15 page 34) and both may be served with a mixer of some sort, whether alcoholic or not, or as part of a cocktail (AV6 page 2) and that there are some cocktails which contain both gin and cider (AV15 page 5). As a consequence, she submitted, the goods are both in competition and complementary. Ms Newnes referred me to a number of published decisions of the UK and Irish trade mark registries as well as OHIM whereby cider has been found to be similar to other alcoholic drinks, including one involving the same parties, marks and goods as before me. Acknowledging that the decisions referred to are not binding on the registrar, she submitted that they are illustrative of the similarities of differing types of alcoholic beverages.

16. As the evidence from both parties makes clear, cider is made essentially by a fermentation process using fruit whilst gin is made by a distillation process using wheat and juniper. Despite the differences in ingredients and the production processes involved, there is no dispute that both gin and cider are alcoholic drinks albeit that the alcoholic content of cider is generally much lower than that of gin. As the evidence shows, both gin and cider may be used as a base for other drinks or together in the same drink. The natures of the respective goods coincide. Both drinks will be purchased by members of the general public who are legally entitled to do so. The respective goods share distribution channels as they are goods which are very widely available through the same specialist shops such as off licences or from a general store such as a supermarket, where they will be displayed in the same area of that store, as well as in bars, pubs and restaurants. Both gin and cider may be drunk as and of themselves and, whilst it is likely that some members of the public will have a preference for one over the other, it is equally likely that other members of the public will partake of either drink and so the respective goods are in competition. They are similar goods.

The average consumer and the nature of the purchasing process

17. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and then to determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. The competing goods are alcoholic drinks and, as indicated above, will be bought by members of the general public over the age of 18.

18. The selection of alcoholic drinks from retail outlets such as supermarkets, off-licences or from websites is likely to consist predominantly of self-selection. As a consequence, visual considerations are likely to dominate the selection process. When purchased in other venues, for example, in a bar or restaurant, the average consumer may have inspected the bottle, optic or dispenser containing the goods or selected the goods by reference to, for example, a drinks menu prior to placing their order, in which case visual considerations will also dominate the selection process. That is not to say that other aspects can be ignored: it may be that the average consumer may simply ask for the goods by reference to, for example, the brand and type of drink they require. In these latter circumstances, aural considerations will be of importance.

19. Whilst the cost of each of the respective goods may vary, they are both relatively low cost products. The level of attention paid to the purchase will vary depending on the nature of the purchase and the circumstances prevailing at the time of selection. For example, one would not expect the average consumer to pay as much attention to the selection of a four pack of cider chosen as part of a weekly supermarket shop as they would when selecting a bottle of spirits bought for a special occasion such as a birthday and when ordering drinks in a busy and noisy bar, the level of attention may not be particularly high. Overall, the average consumer, who is assumed to be reasonably well informed, circumspect and observant, will pay a reasonable level of attention to the selection of the goods at issue.

Comparison of marks

20. For ease of reference, the marks to be compared are as follows:

Earlier mark	Application
BULLDOG	BULLDOG CIDER

It is well established that the average consumer is considered to be reasonably well informed, circumspect and observant but perceives trade marks as wholes and does not pause to analyse their various details. In addition, he rarely has the chance to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has kept in his mind. In reaching a conclusion on similarity, I must compare the respective trade marks from the visual, aural and conceptual perspectives identifying, where appropriate, what I consider to be their distinctive and dominant elements. At the hearing and in its evidence (witness statement of Mr Ranger, paragraph 4), the applicant accepts that the respective marks “are the same”.

21. The earlier mark consists of a single word, no part of which is highlighted in any way. The distinctiveness of the mark therefore rests in its totality. The word BULLDOG is the name of a type of animal and has no meaning in relation to the goods for which it is registered. It is a mark with a reasonably high level of distinctive character.

22. The application seeks registration of the mark BULLDOG CIDER. The word CIDER is entirely descriptive and, given its position and the non-distinctive nature of the word CIDER, it is the word BULLDOG which is the dominant and distinctive element of this mark.

23. Appearing as the only or first element of each mark, the commonality of the distinctive word BULLDOG, coupled with the non-distinctive nature of the word CIDER in the application, leads to there being a high degree of visual, aural and conceptual similarity between the respective marks.

Distinctive character of the earlier mark

24. The distinctive character of a trade mark can be appraised only, first, by reference to the goods for which it is registered and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002]

ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585.

25. As I indicated above, BULLDOG has no meaning in relation to the goods for which it is registered. It is an ordinary dictionary word and is a mark with a reasonably high degree of inherent distinctive character. In his evidence for the opponent, Mr Vohra states that the mark was first used in the UK in 2007 in respect of gin. It is said to have been sold in “numerous retails settings”, including branches of “Nicolas”, Oddbins”, “Wine Rack”, “Fortnum & Mason”, “Selfridges & Co,” “Waitrose” and “Booths” as well as various cocktail bars around the UK. At AV8 are exhibited copies of ten invoices, five of which date from before the relevant date which show sales of gin under the mark Bulldog.

26. Figures of turnover in the UK are given in \$US as follows:

Jan-Dec 2007	Jan-Dec 2008	Jan-Dec 2009	Jan-Dec 2010	Jan-Jun 2011	Total
24,421.80	-	23,238.65	143,706.29	39,356.00	230,722.74

These figures are stated to relate to sales of some 35,772 bottles over this period. For the applicant, Mr Raphael submitted that this was “not a great volume given the size of the relevant market”, however, as I indicated at the hearing, nowhere in the evidence is it established what size the relevant market is and I am therefore unable to establish the market share the above turnover and sales might represent. In his evidence for the opponent, Mr Vohra states that gin under the mark Bulldog has been promoted by way of attendance at Trade Shows including “The Bar Show” in London in 2008 and 2009, through the distribution of e.g. t shirts, bar mats and dog tags and by way of various publications and the sponsorship of various activities such as the Guinness World Record arm-wrestling competition which took place in Potter’s Field in London in 2008 (AV15 page 43). Whilst it is clear that some promotion of the mark has been undertaken, the market for gin is likely to be of considerable size and the volume of sales shown (at today’s exchange rates, less that £150,000 in total over the four and a half year period) is not particularly high. I have no evidence from the public or the trade. Taking all of the evidence into consideration, it seems to me that the distinctiveness of the earlier mark has not been shown to have been enhanced to any material extent through its use.

Likelihood of confusion

27. In its evidence and through submissions at the hearing, the applicant seeks to rely on the argument that it has earlier trade mark registrations and had used its mark in respect of other goods being energy drinks. It claims that there had been no confusion with the opponent’s mark in respect of that use and submits that the position would be the same as regards its present application. As I pointed out at the hearing, the issue before me is to be decided on a notional basis taking into consideration the application for which registration is sought by the applicant and the

earlier right as registered and relied upon by the opponent. And as Millet LJ stated in *The European Limited v The Economist Newspaper Ltd* [1998] FSR 283:

“Absence of evidence of actual confusion is rarely significant, especially in a trade mark case where it may be due to difference extraneous to the plaintiff’s registered trade mark.”

The absence is even less significant where the goods covered by the application now sought, differ from those on which use is said to have been made in the past.

28. In determining whether there is a likelihood of confusion, a number of factors have to be borne in mind. The first is the interdependency principle whereby 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. I also have to factor in the distinctive character of the earlier mark, as the more distinctive it is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely on the imperfect picture of them he has retained in his mind.

29. Earlier in this decision I found:

- the respective marks have a high degree of visual, aural and conceptual similarities;
- the respective goods are similar;
- the earlier mark is of a reasonably high inherent distinctive character which has not been shown to have been enhanced to any material extent through its use.

30. Bearing all matters in mind, I find that there is a clear likelihood of confusion between the respective marks. Whilst I do not rule out the possibility that there could be direct confusion (i.e. someone ordering a BULLDOG (gin) in a bar but ending up with a BULLDOG CIDER), I think it more likely that indirect confusion will occur, with the consumer assuming that both products are made by the same or a related undertaking. The fact that the applicant itself intended to use effectively the same mark on products as different as cider and energy drinks underlines the possibility of the same undertaking using such similar marks to identify a single trade source for different types of drinks. The opposition founded on grounds under section 5(2)(b) of the Act succeeds.

31. In view of my finding under section 5(2)(b), I do not intend to go on to consider the other grounds of opposition.

Summary

32. The opposition succeeds.

Costs

33. As the opponent has been successful, it is entitled to an award of costs in its favour. In making the award, I note that both parties filed evidence and that a hearing took place with the opponent filing skeleton arguments. I make the award on the following basis:

For filing a statement and reviewing the other side's statement:	£300
Fee:	£200
For filing and considering evidence:	£300
For preparation for and attendance at the hearing:	£400
Total:	£1200

34. I order Bulldog Energy Drink Ltd to pay CK3 LLC the sum of £1200 as a contribution towards its costs. This sum is to be paid within seven days of the expiry of the period for appeal against this decision or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of January 2014

**Ann Corbett
For the Registrar
The Comptroller-General**