

O-101-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3148666
BY BLACK TOR BREWERY LTD
TO REGISTER THE TRADE MARK:**



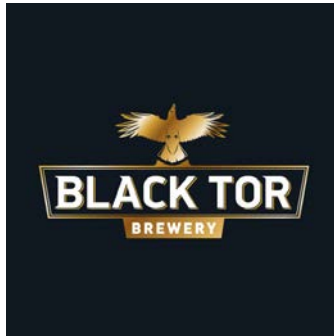
IN CLASS 32

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 406701 BY ZELOOF LLP**

Background and pleadings

1. On 9 February 2016, Black Tor Brewery Ltd (“the applicant”) applied to register the following trade mark for “beer” in class 32:



2. The application was published for opposition purposes on 26 February 2016. It is opposed by Zeloof LLP (“the opponent”). The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon its UK trade mark registration no. 2550334 for the trade mark **BLACK EAGLE BREWERY**, which has a filing date of 15 June 2010 and for which the registration procedure was completed on 27 January 2012. The earlier mark is registered for a range of goods and services; for the purposes of this opposition, the opponent relies upon the following:

Class 32 Non-alcoholic drinks.

Class 33 Alcoholic beverages; none of the aforementioned being whiskey or being primarily made from or primarily containing whiskey.¹

3. In its Notice of Opposition, the opponent claims that there is a likelihood of confusion, including a likelihood of association, because the application is “highly similar to the

¹ Although the limitation is not referred to either in the notice of opposition or in the opponent’s submissions, it is in the specification and applies to all of the opponent’s goods in class 33.

Opponent's mark and the goods and services opposed are either identical or highly similar to those registered in the trade mark".

4. The applicant filed a counterstatement, in which it admits that the goods are similar, though it does not specify to what degree. However, it argues that the marks "differ visually, aurally and conceptually to the extent that there is no likelihood of confusion, including a likelihood of association, on the part of the relevant buying public".

5 The opponent has been represented throughout by Dolleymores; the applicant is not professionally represented. Neither party filed evidence but the applicant filed written submissions during the evidence rounds. While neither party asked to be heard, the opponent filed submissions in lieu of a hearing. I have read all of the papers carefully and will bear both parties' comments in mind, referring to them, as necessary, below.

DECISION

6. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

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

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

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

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

"6. - (1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of 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,

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

8. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 2, which qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date of the application in suit, it is not subject to proof of use, as per section 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

9. 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

10. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“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”.

11. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

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

12. The General Court (“GC”) confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods/services are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut fur Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

13. The goods to be compared are:

Applicant's goods	Opponent's goods
<u>Class 32</u> Beer	<u>Class 32</u> Non-alcoholic drinks. <u>Class 33</u> Alcoholic beverages; none of the aforementioned being whiskey or being primarily made from or primarily containing whiskey.

14. In its submissions, the applicant has conceded that the goods are highly similar. The opponent argues that “non-alcoholic drinks’ includes non-alcoholic beer which is identical to the goods in the application”.² I agree. Beer can be alcoholic or non-alcoholic and the applicant’s term encompasses both types. The opponent’s “non-alcoholic drinks” includes non-alcoholic beer. The goods must be considered to be identical.

15. Given that I have found the parties’ goods in class 32 to be identical, the opponent’s position would not be improved were I to consider the remaining goods in the opponent’s specification and I do not intend to do so.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited*,

² Submissions, paragraph 4.

The Partnership (Trading) Limited, U Wear Limited, J Fox Limited, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median”.

17. The applicant has made no submissions regarding the average consumer. The opponent submits that:

“The average consumer in this opposition must be determined as the general public of all ages. The goods in Class 32 of both applications cover non-alcoholic beers which includes ginger beer, root beer etc. and is available to consumers of all ages. As such, the average consumer is not limited to the population over 18 as would be the case if the goods were limited to alcoholic beverages”.

18. The specifications for both marks cover beverages, alcoholic and non-alcoholic. I consider that the average consumer of the goods at issue is a member of the general public, though in the case of alcoholic beers, that will be an adult over 18.

19. In my experience, the goods at issue are sold through a range of channels including restaurants, bars and public houses. They are also commonly sold in supermarkets, off-licences and their online equivalents. In restaurants, bars and public houses, the goods are likely to be on display, for example, on taps or in bottles in fridges behind the bar. They may also be shown on drinks menus, where the trade mark will be visible. While I do not discount that there may be an aural component in the selection and ordering of

the goods in bars, restaurants and public houses, this is likely to take place after a visual inspection of the bottles or drinks menu (see *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04 (GC)). In retail premises, the goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will most likely select the goods having viewed an image displayed on a web page. I am, therefore, of the view that the selection of the goods at issue will be primarily visual, although aural considerations will play a part.

20. The level of attention paid to the purchase of the goods at issue is likely to vary across the category. In general, the goods are not terribly expensive. However, whether selecting the identical goods at issue in retail premises or in bars and restaurants, the average consumer will choose a particular type or flavour of beverage. I consider that an average level of attention will be paid to the selection process.

Comparison of trade marks

21. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.


22. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the

light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

23. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

24. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicant’s trade mark
BLACK EAGLE BREWERY	

25. Regarding the application, the opponent submits that “the device of the bird featured in the application is a dominant and distinctive element of the mark” and points out that there is no limitation as to colour.³ It claims that “[w]hen considered represented in gold it is apparent that the average consumer, having some knowledge of birds but not an in-depth or ornithological knowledge, will consider the bird to represent a golden eagle”.⁴ It also submits that:

³ Paragraph 9.
⁴ Paragraph 10.

“When considered represented in black, the average consumer will consider the device in the application to be of a black eagle. This will be exacerbated by an Imperfect recollection made of the Opponent’s trade mark. As such, the device when represented in black is identical to the initial elements of the Opponent’s trade mark, namely, BLACK EAGLE”.⁵

26. Overall, it argues that the marks are visually similar “to a moderate to high degree”. It claims a moderate level of aural similarity. The opponent also argues that, if the bird is considered represented in black, “[t]his representation would create a device of a black eagle which is conceptually identical to the BLACK EAGLE element of the Opponent’s trade mark”.⁶ From the opponent’s perspective, the marks are conceptually similar to a moderate degree.⁷

27. The applicant argues in its submissions that “[t]he Applicant’s counterstatement clarified that their mark contains the silhouette of a RAVEN, golden in colour, neither BLACK in colour nor an EAGLE”. It makes no specific submissions on the level of visual or aural similarity between the marks but states that the marks are conceptually dissimilar.

28. The earlier mark consists of the dictionary words “BLACK EAGLE BREWERY”. I consider that the words “BLACK EAGLE” form a unit describing a particular bird of prey. However, as “BLACK” qualifies the word “EAGLE”, it is the word “EAGLE” which has the greater impact in the overall impression. A brewery is defined in the *Oxford Dictionary of English* as “a place where beer is made commercially”.⁸ In the context of goods which are closely associated with brewers and the brewing industry, the word “BREWERY” is likely to be perceived as descriptive or non-distinctive.

⁵ Paragraph 11.

⁶ Paragraph 16.

⁷ Paragraph 17.

⁸http://www.oxfordreference.com/view/10.1093/acref/9780199571123.001.0001/m_en_gb0101260?rskey=RigLAo&result=1 [accessed 23 February 2017]

29. The application has a number of elements. There is an image of a bird, in silhouette with its wings outstretched. The bird is coloured gold. Underneath the image are the words “BLACK TOR”, in capital letters in white. The font is slightly stylised and has a gold shaded effect. The words are surrounded by a double line border, in gold. The bottom edge of the border forms a quadrilateral, in gold, which contains the word “BREWER”, in smaller, white capital letters. All of these elements are presented on a black background. Although the bird device is at the top of the mark, I consider that the words “BLACK TOR” are the most striking element in the overall impression, due to their size and the natural tendency to focus on words within a mark. As with the opponent’s mark, the word “BLACK” is likely to be seen as qualifying the word “TOR” and will have slightly less impact. The device plays a marginally less important role than the words “BLACK TOR”. The border and background play weak roles while the word “BREWER” is, for the reasons given above, likely to be given no trade mark significance.

30. From the visual perspective, both marks share the words “BLACK” and “BREWER”. However, the second word in each mark (“EAGLE” and “TOR”) bears no resemblance to the other. There are other significant visual differences between the marks, in particular the presence of a bird device in the application. Having regard to all the similarities and differences between the marks, and bearing in mind my assessment of the overall impression, I find that there is a low degree of visual similarity between the marks.

31. As far as aural similarity is concerned, the device in the application will not be articulated. The words in the respective marks are dictionary words which will be afforded their usual pronunciation. Although the word “TOR” may not be one with which the average consumer is familiar, it will be pronounced as it is written, as the phonetic equivalent of the word “tore”. As the marks share the same first and last words, there is a degree of aural similarity. However, taking into account the strikingly different second words and my assessment of the overall impression, I consider that the marks are aurally similar to a medium degree.

32. At the highest conceptual level, both marks refer to a brewery. However, in the context of the goods at issue, the average consumer is more likely to focus on the meanings generated by the other elements of the marks, namely “BLACK EAGLE” and “BLACK TOR”. Thus, the opponent’s mark is likely to convey to the average consumer the image of a bird of prey. As far as the applicant’s mark is concerned, some average consumers may know that “Black Tor” is a real geographical location. Some will know that a “tor” is a hill and will assume that “BLACK TOR” is a reference to a particular hill, whether real or imagined. For these average consumers, the concept elicited by the words will be one of a hill. However, whilst the word “TOR” is a dictionary word, it is not, in my view, one in common parlance. As a consequence, for many average consumers, the word will not convey a particular meaning.

33. The parties have made a number of submissions regarding the bird device in the application. My view is that the average consumer will simply perceive it as a bird, without troubling themselves to identify the particular species. I acknowledge that the device is presented in gold and that there is a bird called a golden eagle. However, as there is nothing else in the application to suggest that the bird is intended to be an eagle, I see no reason why the average consumer would attach that meaning to the image. I find that overall there is a low degree of conceptual similarity.

34. I have not overlooked the opponent’s submissions regarding the colour(s) in which the marks might be presented and, in particular, the colour of the bird device in the application. However, I do not think that those submissions assist the opponent. If the bird device were presented in black with no other changes to the application, the device would not be visible against the black background and would make no impression on the average consumer. If the device were presented in black against, for example, a white background, it would not increase the likelihood of the bird being perceived as an eagle. On the contrary, absent any other indication that the device should be seen as an eagle, it is more likely that if the bird were presented in black it would be perceived as a crow or, as the applicant apparently intended, a raven.

Distinctive character of the earlier trade mark

35. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought 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. In *Lloyd Schuhfabrik*, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and

statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51)”.

36. I have no submissions from either party regarding the distinctiveness of the earlier trade mark and the opponent has filed no evidence in support of a claim of enhanced distinctiveness. Invented words usually have the highest degree of inherent distinctive character; words which are descriptive of the goods relied upon normally have the lowest. The earlier mark consists of dictionary words, the first two of which are not descriptive of the goods at issue. I consider that the mark has an average degree of inherent distinctive character.

Likelihood of confusion

37. Determining whether there is a likelihood of confusion is not scientific; rather, it involves a global assessment of a number of factors, bearing in mind the interdependence between them (*Canon* at [17]). It is a matter of considering all of the relevant factors from the point of view of the average consumer and deciding whether he is likely to be confused. In doing so, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

38. Confusion can be direct (where the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion was explained by Iain Purvis, Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc.*, Case BL-O/375/10, where he stated that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes

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

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example”).

39. In terms of direct confusion, although both marks contain the words “BLACK” and “BREWERY”, I consider that the other elements in the application, especially the device and presentational elements, will be recalled or remembered by the consumer. These

differences will prevent the average consumer from mistaking it for the word-only mark of the opponent, even when the effects of imperfect recollection are taken into account. As I have indicated, the selection of the goods is likely to be predominantly visual, so the low degree of visual similarity between the marks is of particular weight. There is no likelihood of direct confusion.

40. As far as indirect confusion is concerned, neither “BLACK” nor “BREWERY” plays an independent distinctive role in either mark and will not be relied upon as an indication of trade origin by the average consumer. Although both marks reference a brewery, I do not consider that there will be an expectation on the part of the average consumer that the identical goods at issue come from the same or economically linked undertakings. On the contrary, the conceptual differences are more likely to suggest to the average consumer that the goods are produced by discrete undertakings, even in circumstances where the meaning of “TOR” is not understood and the difference is therefore non-distinctive. There is no likelihood of indirect confusion.

Conclusion

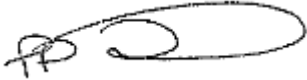
41. The opposition has failed. Subject to appeal, the application will proceed to registration.

Costs

42. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 4 of 2007. The applicant has been successful and would normally be entitled to a contribution towards its costs. However, as the applicant is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the applicant and invited it to indicate whether it intended to make a request for the award of costs. The applicant was informed that, if so, it should complete a pro-forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. It was advised that “no costs will be awarded” if the pro-

forma was not completed. The applicant did not file a completed pro-forma. That being the case, I direct that the parties bear their own costs.

Dated this 6th day of March 2017

A handwritten signature in black ink, appearing to be 'H. Harrison', written over a horizontal line.

Heather Harrison

For the Registrar

The Comptroller-General