

O-244-17

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NOS 3182242 AND 3182246
BY MICHAEL ROBINSON AND GARRY ROBINSON
TO REGISTER THE FOLLOWING TRADE MARKS:**

IKOYI CHAPMANS

&

CHAPMANS

IN CLASSES 32 AND 33

**AND IN THE MATTER OF OPPOSITION THERETO
UNDER NOS 600000539 AND 600000540
BY DAJJ LTD**

Background and pleadings

1. These consolidated proceedings concern two trade mark applications filed by Michael Robinson and Garry Robinson (“the applicants”) on 25 August 2016. Application number 3182242 is for the trade mark **Ikoyi Chapmans**, for the following goods:

Class 32 Aperitifs, non-alcoholic;Beverages (non-alcoholic-);Beverages (Non-alcoholic -);Carbonated non-alcoholic drinks;Fruit juice beverages (Non-alcoholic -);Fruit juice for use as a beverages;Fruit juices;Non-alcoholic beer flavored beverages;Non-alcoholic cocktail mixes;Non-alcoholic cocktails;Non-alcoholic drinks;Non-alcoholic fruit drinks;Non-alcoholic honey-based beverages.

Class 33 Alcoholic beverages (except beers);Alcoholic bitters;Alcoholic cocktails;Beverages (Alcoholic -), except beer;Pre-mixed alcoholic beverages, other than beer-based.

2. Application number 3182246 is for the trade mark **Chapmans**. Registration is sought for the following goods:

Class 32 Alcohol free beverages;Aperitifs, non-alcoholic;Beverages (non-alcoholic-);Beverages (Non-alcoholic -);Carbonated non-alcoholic drinks;Fruit juice beverages (Non-alcoholic -);Fruit juice for use as a beverages;Fruit juices;Non-alcoholic beverages;Non-alcoholic cocktail mixes;Non-alcoholic cocktails;Non-alcoholic drinks;Non-alcoholic fruit drinks;Non-alcoholic fruit juice beverages.

Class 33 Alcoholic beverages (except beers);Alcoholic bitters;Alcoholic cocktails;Beverages (Alcoholic -), except beer;Pre-mixed alcoholic beverages, other than beer-based.

3. Both applications were published for opposition purposes on 16 September 2016. They are opposed by Dajj Ltd (“the opponent”) under the fast-track opposition procedure. The opposition against application number 3182242 is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods in the application. The opposition against application number 3182246 is based upon sections 5(1), 5(2)(a) and 5(2)(b) of the Act. It is also directed against all of the goods in the application.

4. The opponent relies upon three UK trade mark registrations in both of its oppositions and upon all of the goods for which the marks are registered. The details of the trade marks are:

(i) Chapman

UK trade mark number 2626111

Filing date 15 June 2012; date of entry in register 18 January 2013

Class 32 Non-alcoholic soft drinks.

(ii) Chapman Flavoured Fruit Juice Soft Drink

UK trade mark number 2628125

Filing date 12 July 2012; date of entry in register 18 January 2013

Class 32 Non-alcoholic soft drinks.

(iii) N.G. Chapman

UK trade mark number 3016060

Filing date 31 July 2013; date of entry in register 8 November 2013

Class 32 Non-alcoholic beverages.

5. The applicants filed counterstatements denying the grounds of opposition.

6. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

7. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings. I note that, attached to the opponent’s submissions of 10 April 2017, is an annex containing evidence. The tribunal’s letter dated 10 March 2017 advised the parties that, this being a fast-track procedure, if the parties wished to file evidence a request for leave to do so should be filed. Bearing in mind that the opponent elected to use a procedure in which the routine filing of evidence is not permitted, and as no permission has been sought or given for the opponent to file evidence, the evidence filed will form no part of my decision.

8. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Neither party filed written submissions.

9. The opponent has been professionally represented throughout by Boulton Wade Tennant. The applicants are litigants in person.

Sections 5(1), 5(2)(a) and 5(2)(b)

10. The oppositions are based upon ss. 5(1), 5(2)(a) and 5(2)(b) of the Act, which read as follows:

“5.—(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.

(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 of the part of the public, which includes the likelihood of association with the earlier trade mark”.

11. An earlier trade mark is defined in s. 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”.

12. The trade marks upon which the opponent relies, shown at paragraph 4, qualify as earlier trade marks under the above provisions. As these trade marks had not completed their registration process more than 5 years before the publication date of the applications in suit, they are not subject to proof of use, as per s. 6A of the Act. The opponent can, as a consequence, rely upon all of the goods it has identified.

Sections 5(1) and 5(2)(a)

13. In order to get an objection under the above sections off the ground, the competing trade marks must be identical. In *S.A. Société LTJ Diffusion v Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held, that:

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

14. The opponent argues in its statement of grounds that “[it] is common to use the possessive and plural of trade marks and so it is submitted that CHAPMANS and CHAPMAN are identical as the presence of the letter “S” in CHAPMANS is so insignificant that it will go unnoticed by the average consumer”. I disagree. The words are not identical. As far as the average consumer’s perception is concerned, “Chapmans” is neither a correct plural nor a possessive and I consider that the average consumer would notice the “s” at the end of the application. The marks are not identical and the opposition under ss. 5(1) and 5(2)(a) is dismissed accordingly.

Section 5(2)(b)

15. 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:

(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.

The average consumer and the nature of the purchasing act

16. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd*. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

17. The opponent has not commented on the average consumer. It does, however, submit that the goods at issue will be “purchased on the basis of visual selection”.¹ The applicants have not made any submissions regarding the average consumer or the purchasing process.

18. The specifications cover beverages, both 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 the alcoholic beverages, 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 (General Court (“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

¹ Submissions, paragraph 12.

goods having viewed an image displayed on a web page. The selection of the goods at issue will, therefore, 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 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. 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”.

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

23. I will begin with the opponent’s trade mark number 2626111, which seems to me to represent the opponent’s best case. I will return to the other marks, if necessary. The trade marks to be compared are as follows:

Opponent’s trade mark	Applicants’ trade marks
Chapman	Ikoyi Chapmans Chapmans

24. The applicants argue, regarding the first of their marks, that “[t]he first word, ‘Ikoyi’, is dominant and highly unusual”. They also state in their written submissions that “IKOYI is indeed a location in Lagos, Nigeria. The word IKOYI [...] is used because our product originated from the Ikoyi Club in Nigeria”.² I have no specific submissions regarding their other mark.

25. In respect of the applied-for “Chapmans”, the opponent submits that the marks are “very similar as the applied for sign is wholly contained within the marks the subject of the Earlier Rights and plays an independent, distinctive role within all three marks”.³

26. It makes identical submissions regarding the trade mark “Ikoyi Chapmans” but adds that:

“the Mark, IKOYI CHAPMANS, is very similar to the marks the subject of the Earlier Rights. IKOYI is a well known location in Lagos, Nigeria. As such, the dominant and distinctive elements of the applied for sign is CHAPMANS”.⁴

² Counterstatement (opp. 600000539).

³ Statement of grounds (Opp. 600000540), paragraph 4.

⁴ Statement of grounds (Opp. 600000539), paragraph 4.

27. The opponent's mark consists of the word "Chapman", presented in title case. There are no other elements to contribute to the overall impression, which is contained in the word itself. I consider that the average consumer would recognise "Chapman" as a fairly common surname.

28. The applicants' "Chapmans" mark is also a single-word mark, presented in title case, whose overall impression is contained in the word itself. I consider that the "s" at the end of the mark applied for will be noticed by the average consumer. Although it is neither a plural nor a correct possessive form, I take the view that the average consumer would call to mind the surname "Chapman".

29. The only difference between the applied-for "Chapmans" and the opponent's "Chapman" lies in the "s" at the end of the eight-letter mark. The earlier mark is a reasonably common surname; the applicants' mark calls that same surname to mind. The marks are highly similar visually, aurally and conceptually.

30. Matters are more complex for the mark "Ikoyi Chapmans". The applicants accept that "Ikoyi" is an area of Lagos, Nigeria. However, given that they also claim that "Ikoyi" is "most definitely the dominant word", and that they are not professionally represented, I do not consider that the applicants' statement can properly be understood as a concession regarding the descriptiveness or non-distinctiveness of the word "Ikoyi". The opponent submits that the word is descriptive of the goods' geographical origin but has not sought leave to file evidence. The result is that there is no evidence before me that the average consumer would either know that "Ikoyi" is an area of Lagos or make any association between the word "Ikoyi" and the goods at issue. I think either scenario is unlikely. I consider that the average consumer would perceive the word "Ikoyi" as an invented word and its unusualness leads me to the view that the mark "Ikoyi Chapmans" would not be perceived as a forename/surname combination. The words do not form a unit, with each making a contribution to the distinctiveness of the mark. However, I find that "Ikoyi", an invented word at the beginning of the mark, has a greater impact in the overall impression than the word "Chapmans".

31. Although the marks contain the words “Chapman”/“Chapmans”, there is a significant difference because of the word “Ikoyi” in the applicants’ mark. Taking into account my assessment of the dominance of “Ikoyi” in the overall impression, I consider that the marks are visually similar to a medium degree.

32. Aurally, the first word of the applied-for mark will be pronounced either “I-KOY-EE” or “EYE-KOY-EE”. It is the first word in the mark applied for and has no counterpart in the earlier mark. “Chapmans” and “Chapman” will be given their conventional pronunciation. I consider that there is a medium degree of aural similarity.

33. I indicated, above, that the word “Ikoyi” will have no meaning for the average consumer and that both marks will call to mind a surname. As the concept of a surname is present in both marks, they are conceptually similar to that extent.

Comparison of goods

34. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the 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”.

35. 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.

36. I also remind myself of the guidance given by the courts on the correct approach to the interpretation of specifications. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question".

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

“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”.

38. In *Kurt Hesse v OHIM*, Case C-50/15 P, 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC 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”.

39. In *Sanco SA v OHIM*, Case T-249/11, the GC 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* BL-0-255-13:

“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”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

40. I also bear in mind the guidance in the same case, where Mr Alexander warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

41. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* BL O/399/10 and *BVBA Management, Training en Consultancy v Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs [30] to [38]).

42. The applicants submit that:

“This product will be marketed as a West African based drink originating from Ikoyi and using [...] natural bitters and herbs for a unique flavour. Dajj Ltd have not indicated what their product is, but it is obviously not this West African drink from Ikoyi as otherwise they would have mentioned this similarity in their opposition. [...] These goods are not identical or even similar as suggested by Dajj Ltd, they originate from a particular area of Nigeria (Ikoyi) and the applicant can see no likelihood of public confusion or association”.

43. Although the actual goods offered by the parties may differ, the comparison must be made on the basis of notional use of the marks across the full width of the specifications. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22.It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place”.

44. This approach has recently been endorsed by the Court of Appeal in *Roger Maier v ASOS* ([2015] EWCA Civ 220 at paragraphs 78 and 84). As a consequence, any

differences between the goods offered by the parties, or differences in their trading or marketing styles, are irrelevant unless those differences are apparent from the specifications of the applied-for and registered marks.

45. The opponent argues that “non-alcoholic soft drinks” encompasses all of the goods in class 32 of the applications and that they are, therefore, identical.⁵ It also argues that the applicants’ goods in class 33 “are similar to the non-alcoholic drinks covered by the Opponent’s earlier registrations”.⁶

46. The *Collins English Dictionary* definition of “soft drink” is “a nonalcoholic drink, usually cold”.⁷ However, in my experience as an average consumer of these goods, the ordinary and natural meaning of “soft drink” does not include non-alcoholic beers and wines; the term tends to mean drinks such as cordials and squashes, sweetened carbonated drinks and fruit juices. In the absence of evidence or submissions on the matter, I proceed on that basis.

Alcohol free beverages; Aperitifs, non-alcoholic; Beverages (non-alcoholic-); Beverages (Non-alcoholic -); Carbonated non-alcoholic drinks; Fruit juice beverages (Non-alcoholic -); Fruit juice for use as a beverages; Fruit juices; Non-alcoholic beer flavored beverages; Non-alcoholic beverages; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic drinks; Non-alcoholic fruit drinks; Non-alcoholic fruit juice beverages; Non-alcoholic honey-based beverages

47. All of the applicants’ goods in class 32 are encompassed by the opponent’s “non-alcoholic soft drinks”, or vice versa. These goods are, on the principle outlined in *Meric*, identical. If that is not right and drinks such as non-alcoholic aperitifs and cocktails are not identical to “soft drinks”, they must still be highly similar, sharing nature, purpose, users, method of use and channels of trade, as well as having a competitive relationship.

⁵ Submissions, paragraph 10.

⁶ *Ibid.*

⁷ <https://www.collinsdictionary.com/dictionary/english/soft-drink> [accessed 10 May 2017].

Alcoholic beverages (except beers); Alcoholic cocktails; Beverages (Alcoholic -), except beer; Pre-mixed alcoholic beverages, other than beer-based

48. “Alcoholic beverages (except beers); alcoholic cocktails; beverages (alcoholic-), except beer; pre-mixed alcoholic beverages, other than beer-based” are similar in nature to “non-alcoholic soft drinks” to the extent that they are all drinks. However, there is a difference in intended purpose, the applicants’ goods being intended for relaxation or, potentially, intoxication, and the opponent’s goods being primarily for slaking the thirst. The users will all be members of the public, though the applicants’ goods are restricted to adults. The channels of trade may coincide, insofar as the goods may be sold in the same premises or on the same websites. However, in retail outlets such as supermarkets and off-licences, the goods would typically be located in separate aisles. There may be an element of competition, to the extent that soft drinks may be an alternative to an alcoholic drink. Although the goods may be used together, they are not complementary in the sense that the average consumer would expect responsibility for them to lie with the same or an economically connected undertaking. I find that the goods are similar to a low degree.

Alcoholic bitters

49. Alcoholic bitters are, to my understanding, bitter-tasting spirits made from plant extracts. They may be used to flavour cocktails or may be consumed alone. They therefore share a degree of similarity of nature and purpose with soft drinks, particularly drinks such as cordials. While they may share users, they are unlikely to be located in the same section of retail premises as soft drinks, they are not in direct competition and are not complementary in the sense that the average consumer would expect responsibility for them to lie with the same or an economically connected undertaking. The goods are similar to a low degree.

Distinctive character of the earlier trade mark

50. 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*, 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)".

51. The opponent has not claimed that its mark has an enhanced level of distinctive character nor, this being a fast-track opposition, is there any evidence on the point. I therefore have only the inherent position to consider. 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 is a reasonably common surname. I consider that it has an average degree of inherent distinctive character.

Likelihood of confusion

52. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear 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 but relies instead upon the imperfect picture of them he has retained in his mind.

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

Application 3182246 “Chapmans”

54. The marks at issue have a high degree of visual, aural and conceptual similarity, and the earlier mark is possessed of an average degree of inherent distinctive character. The goods vary from identical to similar only to a low degree. Even when considering those goods which have only a low degree of similarity and which will be purchased with an average degree of attention, the minor difference between the marks is, in my view, insufficient to avoid confusion, particularly when the concept of imperfect recollection is borne in mind. There is a likelihood of direct confusion.

Application 3182242 “Ikoyi Chapmans”

55. In terms of direct confusion, although the marks contain the highly similar elements “Chapman” and “Chapmans”, this element plays a secondary role in the overall impression of the applicant’s mark, where it is the word “Ikoyi” that dominates. The earlier mark is averagely distinctive but will be recognised by the consumer as a fairly ordinary surname. Whilst the goods are identical (taking the position most favourable to the opponent) and will be purchased with an average degree of attention, the word “Ikoyi” is so striking that it is likely to be remembered or recalled by the average consumer. Even taking into account the concept of imperfect recollection, the visual and aural differences created by the first word in the application are sufficiently marked that there is no likelihood of confusion, either direct or indirect. Any similarity between the trade marks is likely to be attributed to coincidence, not economic connection. The opposition fails under s. 5(2)(b).

Conclusion

56. Although the opposition against application 3182246 failed under ss. 5(1) and 5(2)(a), it has succeeded in full under s. 5(2)(b). Application number 3182246 will be refused.

57. The opposition against application 3182242 has failed and, subject to appeal, the application will proceed to registration.

Final remarks

58. I have not judged it necessary to consider the opponent's remaining trade marks, as neither would materially improve the opponent's position in either opposition. Both earlier marks are less similar than trade mark 2626111 to the marks applied for. I note that the specification of trade mark number 3016060 has potentially broader coverage than that of the mark upon which this decision has been made. However, as my finding in respect of 3182242 has been made on the presumption of identical goods, the opponent's case would not be materially improved were I to consider the opposition under a less similar mark. I decline to do so.

Costs

59. Both parties having enjoyed a measure of success, I direct that they bear their own costs.

Dated this 19TH day of May 2017

**Heather Harrison
For the Registrar
The Comptroller-General**