

O-552-18

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3238208
BY YASMIN ANSAH, OLIVIA ANSAH AND KIERON CAMPBELL
TO REGISTER THE FOLLOWING TRADE MARK
IN CLASSES 33, 35 AND 43



AND

OPPOSITION THERETO UNDER NO. 410371
BY SAM PAGET-STEAVENSON

Background and pleadings

1. On 19 June 2017, Yasmin Ansah, Olivia Ansah and Kieron Campbell (jointly “the applicant”) filed trade mark application number 3238208, for the mark above, for the following goods and services:

Class 33: Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cordials; Alcoholic fruit cocktail drinks; Alcoholic punches; Alcopops; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Blackcurrant liqueur; Low alcoholic drinks; Preparations for making alcoholic beverages; Rum; Rum [alcoholic beverage]; Rum punch; Spirits and liquors.

Class 35: Advertising; Advertising and marketing; Advertising and marketing services provided by means of social media; Advertising and publicity; Advertising flyer distribution.

Class 43: Bars; Serving of alcoholic beverages.

2. The application was accepted and published for opposition purposes on 30 June 2017. Sam Paget-Steavenson (“the opponent”) opposes the application under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), relying upon the UK Trade mark (“UKTM”) registration 2605584, the pertinent details of which are as follows:

Mark: THE RUM RUNNER

Filing date: 30 January 2015

Date of registration: 28 July 2015

Services: Class 43: *Catering services; provision of food and drink.*

3. The opponent claims that the marks are similar and that the class 33 goods and class 43 services of the application are identical or similar to the services covered by the earlier mark, leading to a likelihood of confusion under section 5(2)(b) of the Act.

4. The applicant filed a counterstatement in which it denies a likelihood of confusion. The counterstatement consists of submissions relating to the marks and the goods and services, which I bear in mind in making this decision.

5. The opponent's trade mark is an earlier mark, in accordance with section 6 of the Act. As it completed its registration procedure more than five years prior to the publication date of the applicant's mark, it is subject to the proof of use conditions, as per section 6A of the Act. The applicant, in its counterstatement, requested the opponent provide proof of use of the earlier registered mark upon which it relies. The relevant period in the current case is 01 July 2012 to 30 June 2017.

6. The opponent is represented by National Business Register LLP, whilst the applicant represents itself. Aside from their respective statement of grounds and counterstatement, neither party filed written submissions. The opponent filed evidence. Neither party chose to be heard, nor did they file written submissions in lieu of a hearing.

Evidence summary

7. The opponent's evidence takes the form of a witness statement and four corresponding exhibits from Mitchell Willmott of National Business Register LLP, representing the opponent.

8. Mr Willmott's witness statement is dated 16 February 2018. Mr Willmott states that the opponent began using the term 'The Rum Runner' in December 2012 and uses the term to promote its catering services and the provision of food and drink at events. Mr Willmott provides figures for the opponent's annual turnover as follows:

March 2013 - £7,195
March 2014 - £79,031
March 2015 - £99,128
March 2016 - £168,854
March 2017 - £192,417

9. Mr Willmott describes Exhibit MW1 as a brochure containing further information in relation to the opponent's services. Throughout the brochure, which is undated, the services are referred to as being provided by 'The Rum Runner'. It is explained that the services provided include the design and development of cocktails, and the design and styling of bars used to service the aforementioned cocktails. The brochure goes on to provide, over the subsequent six pages, a more detailed breakdown of the services, illustrated with photographs of cocktails and bars. On the front page of the brochure, and in the bottom right hand corner of all subsequent pages, the following logo is used:



10. Exhibit MW2 contains printouts from social media accounts, namely Twitter and Instagram. Mr Willmott refers to these accounts as belonging to the opponent.

11. The profile picture on the opponent's Twitter account is the logo shown at paragraph 9, above, whereas the account name is 'The Rum Runner' and the page is accessed via '@the_rum_runner'. From the three pages of printouts from the Twitter account, I have identified the following:

- The account was created in January 2012
- It has 339 followers
- It follows 152 other Twitter users
- It has 'tweeted' 118 times
- It has posted 26 photos and videos
- Its posts have been 'liked' 31 times
- The account provides a link to the website 'therumrunner.co.uk'

12. From the printouts, there are four posts visible to me: one retweet on 3 April 2016, two retweets on 6 April 2016, and one tweet on 10 March 2017. These posts fall within the proof of use period identified in paragraph 5, above.

13. The printout from the Instagram account consists of one page, from which I have identified the following:

- The account has shared 68 posts
- It has 1,111 followers
- It follows 466 other Instagram users
- The account provides a link to the website 'www.therumrunner.co.uk'

14. Similarly to the Twitter account, the logo at paragraph 9, above, is used as the profile picture, the account name is 'The Rum Runner' and the account is accessed via 'the_rum_runner'. However, there are no visible dates in relation to the account itself or any of its posts.

15. Exhibit MW3 consists of 58 pages of accounts paperwork for the opponent's company in support of the annual turnover figures detailed in paragraph 8, above. The paperwork consists of director's statements, profit and loss accounts, balance sheets and expenses schedules dated between 31 March 2013 and 31 March 2017. The opponent's company is referred to as 'THE RUM RUNNER LIMITED' and 'Rum Runner Ltd'.

16. Exhibit MW4 contains 49 invoices (numbered between 507 and 793, and dated from 03 June 2012 to 05 April 2017), the majority of which are addressed to addresses in London, with the remainder being sent to Leicester, Winchester, Oxfordshire, Hampshire, Norwich, Buckinghamshire and Bath. The invoices total £104,576.29. The recipients vary between individuals and businesses. The majority of items listed on the invoices relate to the provision of bar staff and cocktail ingredients. There is, however, also evidence of the provision of other drinks including beer, fruit juices, non-alcoholic cocktails, bottled water and wine. In the top left hand corner of each invoice is the logo shown at paragraph 9, above. In the top right hand corner of each invoice are the

words 'The Rum Runner', followed by a correspondence address, presumably for the opponent's company. The description of items charged for on invoice number 562 includes the words 'Rum Runner Bar'. Similar wording is used on invoice number 564: 'The Rum Runner' and on invoice number 696: 'Rum Runner'. Each invoice states that cheques should be made payable to 'The Rum Runner Limited'.

17. Mr Willmott's witness statement also addresses section 5(2)(b) of the Act, encompassing a comparison of the marks and of the goods and services. It is submitted at paragraph 4(1) that the marks in question are "phonetically similar to a high degree" and, at paragraph 4(2), that they are "visually similar". The following is submitted, at paragraphs 4(11) and (12), in relation to the goods and services:

- The beverage products covered by the class 33 specification of the opposed mark are similar and complementary to the class 43 services covered by the opponent's earlier mark;
- The class 43 services covered by the opposed mark are identical to the class 43 services covered by the opponent's earlier mark.

I will bear these submissions in mind, where necessary, later in my decision.

18. As the applicant filed no evidence, that concludes my summary of the evidence, insofar as I consider it necessary.

Decision

Proof of use

19. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier mark. The relevant statutory provisions are as follows:

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

(1) This section applies where-

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier mark unless the use conditions are met.

(3) The use conditions are met if-

(a) within the period of five years ending with the date of publication of the application the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been used, but there are proper reasons for non-use.

(4) For these purposes-

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Union.

(6) Where an earlier trade mark satisfies the use condition in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

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

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

21. The relevant period, as identified in paragraph 5 above, is 01 July 2012 to 30 June 2017.

22. When considering whether genuine use has been shown, I must apply the same factors as if I were determining an application for revocation based on grounds of non-use. In *London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*¹, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use.* In *In Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-

¹ [2016] EWCH 52

4237). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

218. An important preliminary point to which Prof Annand draws attention in her decision is that, whereas the English versions of Articles 10(1) and 12(1) of the Directive and Articles 15(1) and 51(1)(a) of the Regulation use the word “genuine”, other language versions use words which convey a somewhat different connotation: for example, “ernsthaft” (German), “efectivo” (Spanish), “sérieux” (French), “effettivo” (Italian), “normaal” (Dutch) and “sério/séria” (Portuguese). As the Court of Justice noted in *Ansul* at [35], there is a similar difference in language in what is now recital (9) of the Directive.

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kameradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer

or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or

preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

Variant use

23. It is clear at the outset that the earlier mark relied upon by the opponent is a plain word mark and, in accordance with section 6A(4)(a) (which corresponds to section 46(2)) of the Act, use of the mark in a form differing in elements which alter the distinctive character of the mark in the form in which it is registered will not qualify as illustrating use of this plain word mark.

24. As per my evidence summary, above, the opponent has filed evidence containing a number of variants of the mark, including:

- (i) The Rum Runner
- (ii) the rum runner
- (iii) the_rum_runner
- (iv) Rum Runner
- (v) THE RUM RUNNER LIMITED
- (vi) The Rum Runner Limited
- (vii) Rum Runner Ltd



25. In relation to variants (i) and (ii), I refer to Professor Ruth Annand's comments, sitting as the Appointed Person in *Bentley Motors Limited v Bentley 1962 Limited*²:

“16. A word trade mark registration protects the word itself (here BENTLEY) written in any normal font and irrespective of capitalisation and, or highlighting in bold (see e.g. Case T-66/11, *Present-Service Ullrich GmbH & Co. KG v. OHIM*, EU:T:2013:48, para. 57 and the cases referred to therein, BL O/281/14,).”

26. Accordingly, I consider variants (i) and (ii) to be acceptable variants of the registered mark.

27. Variants (v), (vi) and (vii) all contain the word 'limited' or the abbreviation 'ltd', which constitutes use of a company name. Use of a company name in relation to goods and services was explained in *Aegon UK Property Fund Limited v The Light Aparthotel LLP*³. Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“17. unless it is obvious, the proprietor must prove that the use was in relation to the particular goods or services for which the registration is sought to be maintained.

18. In *Céline SARL v. Céline SA*, Case C-17/06 (*Céline*), the Court of Justice gave guidance as to the meaning of “use in relation to” goods for the purpose of the infringement provisions in Article 5(1) of the Directive. Considering a situation where the mark is not physically affixed to the goods, the court said at [23]:

“...even where the sign is not affixed, there is use “in relation to goods or services” within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign

² BL O/158/17

³ BL O/472/11

which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party.”

19. The General Court has, on more than one occasion, proceeded on the basis that a similar approach applies to the non-use provisions in what is now Article 42 of the European Union Trade Mark Regulation. For example, in *Strategi Group*, Case T-92/091, the General Court said:

“23. In that regard, the Court of Justice has stated, with regard to Article 5(1) of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989, L 40, p. 1), that the purpose of a company, trade or shop name is not, of itself, to distinguish goods or services. The purpose of a company name is to identify a company, whereas the purpose of a trade name or a shop name is to designate a business which is being carried on. Accordingly, where the use of a company name, trade name or shop name is limited to identifying a company or designating a business which is being carried on, such use cannot be considered as being ‘in relation to goods or services’ (*Céline*, paragraph 21).

24. Conversely, there is use ‘in relation to goods’ where a third party affixes the sign constituting his company name, trade name or shop name to the goods which he markets. In addition, even where the sign is not affixed, there is use ‘in relation to goods or services’ within the meaning of that provision where the third party uses that sign in such a way that a link is established between the sign which constitutes the company, trade or shop name of the third party and the goods marketed or the services provided by the third party (see *Céline*, paragraphs 22 and 23).

20. Those passages must be read together with the general requirements of proof of use in *Ansul* at [43] that there is genuine use of a trade mark where the mark is used in accordance with its essential function namely to guarantee

the identity of the origin of the goods or services for which it is registered, in order to create or preserve an outlet for those goods or services.”

28. That is the case here. The opponent uses the company name, which is almost identical to the trade mark as registered, in such a way that a link is established between the company and the services provided. It is not used solely to identify the company and, therefore, variants (v) to (vii) are acceptable variants of the registered mark.

29. The word marks (i), (ii), (v), (vi) and (vii) are acceptable variants of the mark as it was registered. However, whether enough use of those word marks has been shown in the evidence filed to qualify as genuine use will be determined later in my decision.

30. I now turn my attention to variants (iii), (iv) and (viii). In *Nirvana Trade Mark*⁴, Mr Richard Arnold Q.C. (as he then was) as the Appointed Person summarised the test under section 46(2) as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”


31. The distinctiveness of the word-only mark THE RUM RUNNER lies in the words themselves as there is no element of stylisation or device which affects its inherent

⁴ BL O/262/06

distinctiveness. The words 'Rum Runner' are by far the most distinctive part of the mark. 'The' signifies the definite article. Its omission in variant (iv) does not alter the distinctive character of the mark in its registered form.

32. With regard to variant (iii), the_rum_runner, the only difference (lower case not being an issue) between the mark as registered and the variant is the underscoring between the words. Underscoring is a standard component in a Twitter or an Instagram address, which is the context in which this variant appears in the evidence. To the average social media user, it is common knowledge that use of an underscore simply replaces a space between words, as spaces cannot be used in social media account names following the '@' symbol. The words remain as they are in the registered form of the mark and the average consumer, encountering the underscoring in the context of Twitter and Instagram, would appreciate their significance as simply part of a social media address. The distinctive character of THE RUM RUNNER is not affected by the underscoring.

33. The final variant to consider is (viii), the stylised form, as set out in the table below:

Registered mark	Form in which mark has been used
THE RUM RUNNER	

34. There are a number of differences between the marks. The first word 'THE' is the same in each mark, but the second and third words are visually quite different between the two. The differences in the form as used are that the word RUM is not configured using the plain letters R, U and M and the word RUNNER does not begin with the plain letters R and U. Instead a 'curled' device has been used in order to give the

appearance of the letters R and U, and to connect those 'letters' so as to portray the words RUM RUNNER.

35. Having established (i) the way in which the mark has been used; (ii) the distinctive character of the registered mark; and (iii) what the differences are between the registered mark and the mark used, the final analysis is to decide whether those differences alter the distinctive character of the mark in its registered form. Visually, the mark, as used in its stylised form, has substantial differences to the word-only form of THE RUM RUNNER. The differences are so substantial that, in my view, it may not be obvious that the device is indeed in use to replace the letters R and U. My conclusion is that the visual differences have altered the distinctive character of the mark in its registered word-only form.

36. It follows that the use of the stylised variant of the mark falls outside the parameters of section 6A(4)(a) of the Act. As such, I will now consider whether the remaining evidence as filed by the opponent is sufficient to constitute genuine use of the mark.

37. The words 'The Rum Runner' are used on page 2 of the brochure, where it is explained that the services provided include the design and development of cocktails, and the design and styling of the bars used to serve the aforementioned cocktails. The brochure goes on to provide, over the subsequent six pages, a more detailed breakdown of the services, illustrated with photographs of cocktails and bars. Whilst the brochure is undated, it must be noted that the correct approach to assessing the evidence is to view the picture as a whole, including whether individual exhibits corroborate each other⁵. I bear in mind that the evidence does show that there have been 118 tweets about the opponent's The Rum Runner services. Seeing as the account was created just 5 months before the start of the relevant period, it can reasonably be assumed that the majority of this activity occurred within the relevant period, accounting for any posts between January 2012 and June 2012. Similarly, although the Instagram printout, individually, as a separate element, would be insufficient to make a finding of actual use, the social media printouts corroborate each

⁵ See the comments of Mr Geoffrey Hobbs QC, sitting as the Appointed Person in *Brandconcern BV v Scooters India Limited* [2014] WL 517611

other in terms of actual use of the mark as registered, which is more than merely token, identifies the origin of the services (being the services for which the mark is registered), and creates or preserves an outlet for these services. The picture presented by the social media evidence, as a whole, is that of regular use. These support, and are supported by, the use shown on the invoices which indicate a small but growing business, with regular income (as evidenced in the company accounts) and a fairly wide geographical spread across England.

38. Putting all the evidence together provides me with a picture which is sufficient to establish that the opponent has used its mark in the relevant period.

Fair specification

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*⁶, Mr Justice Carr summed up the law relating to partial revocation as follows.

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme

⁶ [2016] EWHC 3103 (Ch)

Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

40. The average consumer, when considering catering services, is, in my view, likely to expect the provision of both food and drink, but especially food. No evidence has been filed to show that the opponent provides food as part of its 'The Rum Runner' service: it is not mentioned in the brochure at exhibit MW1 or on the social media pages at exhibit MW2, nor is food itemised on any of the invoices contained in exhibit MW4. I can only conclude that the provision of food has not been offered as a service during the relevant period and, as such, use has not been shown for class 43 *catering services* or class 43 *provision of food*. Taking this into account, the only service within the opponent's specification for which use has been shown is the *provision of drink*. This term covers bar services. However, I consider *provision of drink* too wide a category as the provision of drink may include cafes, restaurants and smoothie bars, for example. The opponent appears to provide drinks, mainly cocktails, via a bar service. The *provision of cocktails* would be too narrow a category, taking into account

the alternative drinks provided, as per paragraph 16 of this decision. I find that *bar services* under class 43 is a fair specification for the services evidenced by the opponent.

41. The opponent may rely upon *bar services* only for the purposes of this opposition.

Section 5(2)(b)

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

“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.”

43. The following principles are gleaned from the judgment 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 C3/03, *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 the 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.

Preliminary issue

44. The applicant, in its counterstatement, made submissions which include analysis of the parties' marks and their respective goods and services as follows:

“[...] There are other businesses out there which do have the exact same spelling as [the] opposing trade mark and do phonetically sound the same, however our spelling is completely different. Just like Coca Cola and Pepsi, they both have a very similar product which people can argue tastes the same. However they have two different names just like us, we as a brand are offering a different product altogether and not a catering service.

[...]

Our company 'Rum Runna' provides unique rum cocktails to the members of the public, we in-house make and prepare the cocktails as well as sell. I can see that the opposing company are an actual company that can cater for events and offer a chance for people to create their own, even provide workshops for people. However we are not like this since all our products will be prepackaged.”

45. Before I continue with this decision, it is necessary to address the issues brought up by the applicant. Firstly, any reference to any other trade mark or business is not relevant to the matter before me. It is the applicant's mark that the opponent is opposing and so it is in relation to those marks and their respective goods and services that I write this decision.

46. Secondly, the applicant requested that the opponent provided evidence to show that it is using their mark. The opponent did so and, upon review of this, I found use in relation to *bar services* as per paragraphs 40 and 41, above. The finer details of, for example, how exactly the beverages are sold to consumers and whether the cocktails are made by the bar staff or by consumers themselves, are not relevant to this decision. Under section 5(2)(b) of the Act, I am only required to make a comparison of

the goods/services in the specification of the applied for mark and the services in the earlier mark for which I found genuine use. In *Roger Maier and Another v ASOS*⁷, Kitchen L.J. stated that:

“78. ...the court must...consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods is the use is such as to give rise to a likelihood of confusion.”

However, I will take the applicant’s submissions into consideration, where relevant, throughout the remainder of this decision.

Comparison of goods and services

47. In comparing the respective specifications, all relevant factors should be considered. In *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer* 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.”

⁷ [2015] EWCA Civ 220

48. ‘Complementary’ was defined by the General Court (“GC”) in *Boston Scientific Ltd. v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*⁸:

“82 It is true that goods are complementary if 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...”

49. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited*⁹ (the *Treat* case) for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

50. In *YouView TV Ltd v Total Ltd*¹⁰, 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 *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.”

51. In *Sanco SA v OHIM*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.

⁸ Case T-325/06

⁹ [1996] R. P. C. 281

¹⁰ [2012] EWCH 3158 (Ch)

¹¹ Case T-249/11

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., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*¹²:

“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”.

52. The opponent has not opposed the registration of the applied for mark in respect of its class 35 services. Therefore, the competing specifications are shown in the table below.

Earlier mark	Applied for mark
Class 43: <i>Bar services</i>	Class 33: <i>Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cordials; Alcoholic fruit cocktail drinks; Alcoholic punches; Alcopops; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Blackcurrant liqueur; Low alcoholic drinks; Preparations for making alcoholic</i>

¹² BL O/255/13

	<p><i>beverages; Rum; Rum [alcoholic beverage]; Rum punch; Spirits and liquors.</i></p> <p><i>Class 43: Bars; Serving of alcoholic beverages.</i></p>
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Class 43

53. In this case, ‘Bars’ are identical to ‘bar services’. The law also requires that goods be considered identical where one party’s description of its goods encompasses the specific goods covered by the other party’s description (and vice versa): see *Gérard Meric v OHIM*¹³, in which the GC stated:

“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 für 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.”

On this principle, “Serving of alcoholic beverages” in the applicant’s specification is identical to “Bar Services” in the opponent’s specification. The parties’ class 43 services are identical.

Class 33

54. The nature of goods and services differ, as do their methods of use and their purpose. However, the goods and services in question have shared channels of trade and are in competition with each other, at least to a certain extent: consumers have the choice between buying the goods from a shop and drinking them at home or

¹³ Case T-133/05

visiting a bar and buying and drinking them there. In that sense, the consumer is choosing between the goods themselves or the service.

55. In terms of their complementarity, although drinks can be consumed without the need for a bar service, there would be no use for bar services without drinks to serve from them, i.e. the applicant's goods would be provided via the opponent's services. The goods and services at issue are complementary. I come to the view that there is a medium degree of similarity between the goods and services in question.

The average consumer and the nature of the purchasing act

56. As principle (b) in paragraph 43 above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. 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*¹⁴, 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.”

57. 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 or services in question: *Lloyd Schuhfabrik Meyer*¹⁵.

58. The average consumer is a member of the adult general public. In the case of the applicant's class 33 goods, it is primarily a visual purchase; the purchaser either

¹⁴ [2014] EWHC 439 (Ch)

¹⁵ Case C-342/97

visually peruses a menu at a bar or scans the shelves behind the bar and then orders, or visually scans shelves in a shop or pages on a website and makes a self-selection. However, although the goods may be selected by visual means, they are ordered by word of mouth and, therefore, there is an aural element to the purchase. In relation to the class 43 services, these are predominantly selected by eye. One sees the establishment's name either displayed at the venue itself, on social media, or on advertising material. However, I do not discount the potential for aural reference, such as making a recommendation or arranging to meet at the place in question.

59. The level of attention in buying the class 33 goods themselves will not be of the highest level. Allowing for those who are purchasing inexpensive alcopops and those who are purchasing more expensive champagne, for example, the attention level of the consumer in the category of alcoholic beverages is no higher than average. The measure of care taken over the selection of the class 43 services will depend, to a degree, upon the type of occasion, i.e. a quick drink after work compared to a celebratory evening out. Overall, there will be an average degree of attention paid to the purchase of both the goods and the services.

Comparison of marks

60. It is clear from *Sabel BV v Puma AG* 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 their overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in *Bimbo SA v OHIM*¹⁶, 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

¹⁶ Case C-591/12P

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

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

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

Earlier mark	Applied for mark
THE RUM RUNNER	 The logo for 'RUM RUNNA' is a circular emblem. At the top, a white straw with a black outline projects from a yellow and orange gradient bowl, which is shaped like a coconut. The bowl is flanked by two green palm trees. The words 'RUM' and 'RUNNA' are written in large, bold, black capital letters across the center of the bowl. The background of the bowl features a red and orange sunset over a horizon line.

Overall impression

63. The opponent’s mark consists solely of the words “THE RUM RUNNER”. No part of the mark is stylised or emphasised in any way. There are no other elements to contribute to the overall impression, which rests in the mark in its totality. The words RUM RUNNER are the most distinctive part of the mark. ‘The’ signifies the definite article and therefore plays a lesser role.

64. The applicant’s mark consists of a number of elements. The words “RUM RUNNA” are presented in black capital letters in a slightly stylised font. Encompassing the words RUM RUNNA is a device in the shape of a coconut bowl, designed in red, orange and yellow, with a black border and a white straw projecting from it. In the

background are two palm tree devices with bright green leaves, brown trunks and, presumably, two patches of sand at the bottom of each. Despite the number of elements, it is, in my view, the words RUM RUNNA which have, by virtue of their size and central positioning, the greatest impact in the overall impression. The coconut bowl and palm trees are decorative and play a lesser role in the mark, though will not be ignored by the average consumer.

Visual comparison

65. Visually, the words RUM RUNNA within the applicant's mark are positioned prominently and centrally within the mark and are therefore the visually dominant component. The same can be said for the opponent's mark in that the dominant component is the words RUM RUNNER. The similarity lies in the word RUM and the majority of the last word: 'RUNN', which are identical in both marks.

66. The differences between the opponent's mark and the words within the applicant's mark are the addition of the word THE in the earlier mark, and the different ending of the last word, i.e. '-A' v '-ER'.

67. There exists further differences in that the applicant's mark also contains stylisation in the form of a red, orange and yellow coconut device with a black border, which encases the words RUM RUNNA, and the palm tree devices behind it. In contrast, the opponent's mark consists solely of the words THE RUM RUNNER with no stylisation.

68. Taking all of these factors into account, I consider the two marks in question to be visually similar to a medium degree.

Aural comparison

69. In terms of aural similarity, the dominant component of the applicant's mark, RUM RUNNA, and the dominant component of the opponent's mark, RUM RUNNER, are aurally identical. Taking into account that the earlier mark starts with THE, I consider the marks to be aurally similar to a high degree.

Conceptual comparison

70. The applicant's spelling of RUNNA will simply be seen as a misspelling of the English word 'runner'. The word RUM in both marks clearly relates to the alcoholic beverage, considering their respective specifications. I understand 'runner', in the context of both parties' marks, to mean someone who is carrying or delivering goods, in this case, rum. I cannot see how the concept in either mark would differ from the other. The addition of the coconut bowl and palm trees in the applicant's mark is suggestive of a 'Caribbean' or tropical theme and reminiscent of a drink, owing to the straw in a cup-like device. The average consumer will perceive both marks as the delivery or provision of rum, and the devices in the applicant's mark only reinforce this concept. Consequently, I find these marks to have a high degree of conceptual similarity.

Distinctive character of the earlier trade mark

71. The degree of distinctiveness of the earlier must be assessed. This is because the more distinctive the earlier mark, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*¹⁷, 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not

¹⁷ Case C-342/97

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).”

72. Having considered the evidence filed by the opponent, I find that the turnover figures, in the context of the market for bars, are very low. Whilst enough use was evidenced to demonstrate genuine use, use of the mark is not at a sufficient level to have enhanced its distinctive character. Consequently, I have only the inherent distinctiveness of the mark to consider. The earlier mark consists solely of the words THE RUM RUNNER with no stylisation or additional elements. As per my findings in paragraph 70 above, the concept of the mark, as seen by the average consumer, is likely to be that of the delivery or provision of rum. Whilst I find that the earlier mark is not descriptive of the services for which it is registered, it does suggest that the consumer is going to be provided with rum and, as such, may allude to *bar services*. Accordingly, I find the earlier mark to possess a slightly lower than average degree of inherent distinctive character.

Likelihood of confusion

73. 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 services and vice versa. As I mentioned above, it is also 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 keep in mind the average consumer for the goods and the services, 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 upon the imperfect picture of them he has retained in his mind.

74. There are two types of confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods/services come from the same, or related, trade source). I bear in mind the decision in *L.A. Sugar Limited v By Back Beat Inc*¹⁸, where Mr Iain Purvis, sitting as the Appointed Person, noted that:

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

75. Earlier in this decision I found that:

- The average consumer is a member of the adult general public, who will select the goods and services primarily by visual means (though there is an aural element to the selection) and who will pay, in the main, an average degree of attention to their selection;
- The goods in class 33 of the applicant’s specification and the services in class 43 of the opponent’s specification are similar to a medium degree;
- The class 43 services are identical;
- The marks are visually similar to a medium degree, aurally similar to a high degree and conceptually highly similar;

¹⁸ Case BL-O/375/10

- The opponent's mark is inherently distinctive to a slightly lower than average degree.

76. In my view, the visual differences between the marks will avoid the consumer simply mistaking one mark for the other. The consumer is likely to recognise that the later mark is different from the earlier mark. However, these will both be seen as 'rum runner' marks. Taking account of the similarity (or identity in the case of the class 43 services) between the goods and services, the consumer is likely to believe that the marks are variants of each other and that the respective goods/services come from the same, or related, trade source.

Conclusion

77. There is a likelihood of indirect confusion.

78. The opposition to the application was directed only at some of the goods and services for which registration is sought. With that in mind, the opposition succeeds in relation to the following goods and services:

Class 33: Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cordials; Alcoholic fruit cocktail drinks; Alcoholic punches; Alcopops; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Blackcurrant liqueur; Low alcoholic drinks; Preparations for making alcoholic beverages; Rum; Rum [alcoholic beverage]; Rum punch; Spirits and liquors.

Class 43: Bars; Serving of alcoholic beverages.

79. The application will proceed to registration for:

Class 35: Advertising; Advertising and marketing; Advertising and marketing services provided by means of social media; Advertising and publicity; Advertising flyer distribution.

Costs

80. As the opponent has been successful it is entitled to a contribution towards its costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (“TPN”) 2/2016. Using that TPN as a guide I award costs to the opponent on the following basis:

Official fee:	£100
Preparing a statement and considering the other side’s statement:	£200
Preparing evidence:	£500
Total:	£800

81. I order Yasmin Ansah, Olivia Ansah and Kieron Campbell to pay Sam Paget-Steavenson the sum of **£800**. This sum is to be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 5th day of September 2018

Emily Venables
For the Registrar,
The Comptroller-General