

**O-426-19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3304219 BY  
W.M. WHISKEY CO. LIMITED  
TO REGISTER:**

**PURE**

**AS A TRADE MARK IN CLASSES 32, 33, 35 & 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 60000993 BY  
MBG HOLDING GMBH**

## Background & pleadings

1. On 16 April 2018, W.M. Whiskey Co. Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision for goods in classes 32, 33, 35 and 43. The application was published for opposition purposes on 17 August 2018.

2. On 19 November 2018, the application was partially opposed under the fast track opposition procedure by MBG Holding GmbH (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) with the opponent relying upon European Union Trade Mark (“EUTM”) registration no. 017157934 for the trade mark effect PURE, which has an application date of 30 August 2017 and registration date of 14 December 2017. The opponent relies upon all the goods for which its trade mark is registered:

*Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages.*

*Class 33: Alcoholic beverages (except beers).*

3. The opponent claims the goods and services of the application are identical or similar to the goods for which its earlier mark is registered, and the marks are similar, visually, phonetically and conceptually. It claims, as a result, that there is a likelihood of confusion between the marks.

4. The applicant filed a counterstatement in which the basis of the opposition is denied.

5. The opponent is represented by Urquhart-Dykes & Lord LLP; the applicant is represented by Trade Mark Wizards Limited.

6. Rule 6 of the Trade Marks (Fast Track Opposition)(Amendment) Rules 2013, S.I. 2013 2235, disappplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(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 net effect of these changes is to require parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

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. The opponent filed written submissions. The applicant did not file written submissions, but I will treat the contents of its counterstatement as its written submissions.

## **Decision**

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

“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.”

10. The registration upon which the opponent relies qualifies as an earlier trade mark. As it had been registered for less than five years on the date on which the

contested application was published, it is not subject to proof of use. Consequently, the opponent is entitled to rely upon it for all of the goods for which it stands registered.

11. The following principles are gleaned from the decisions of the courts of the European Union in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

**The principles:**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### **Comparison of goods and services**

12. In comparing the respective specifications, all relevant factors should be considered, as per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* where 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.”

13. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-325/06, the General Courts (“GC”) stated that “complementary” means:

“82 ... there is a close connection between [the goods], 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...”.

14. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] R.P.C. 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services.

15. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. stated:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

16. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch) at [12] Floyd J said:

“... 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."

17. The opponent opposes all the applicant's goods in classes 32 and 33; some of the applicant's services in class 35, and all of the applicant's services in class 43. The applicant restricted its specifications following the filing of the opposition, although this does not appear to have been reflected in the opponent's submissions. The competing goods and services, as they now stand, are as follows:

<b>The opponent's goods</b>	<b>The opposed goods and services</b>
<p><i>Class 32: Beers; Mineral and aerated waters and other non-alcoholic beverages; Fruit beverages and fruit juices; Syrups and other preparations for making beverages.</i></p>	<p><i>Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; Syrups and other preparations for making beverages; ginger ale; ginger beer; dry ginger ale; ale; ales; pale ale; coffee flavoured ale; smoothies; smoothies [non-alcoholic fruit beverages]; smoothies [fruit beverages, fruit predominating]; fruit-based beverages; frozen fruit beverages; powders used in the preparation of fruit-based beverages; fruit squashes; fruit nectars; fruit nectars, non-alcoholic; non-alcoholic fruit extracts; frozen fruit drinks; mixed fruit juice; non-alcoholic fruit drinks; fruit flavoured soft drinks; syrups for making fruit-flavoured drinks; concentrates for making fruit juices; ice</i></p>

<p>Class 33: <i>Alcoholic beverages (except beers).</i></p>	<p><i>fruit beverages; soft drinks; vegetable drinks; cola drinks; isotonic drinks; de-alcoholised drinks; low-calorie soft drinks; carbonated non-alcoholic drinks; part frozen slush drinks; fruit flavoured carbonated drinks; sports drinks containing electrolytes; isotonic non-alcoholic drinks; aloe vera drinks, non-alcoholic; syrups for making soft drinks; squashes [non-alcoholic beverages]; sorbets [beverages]; sherbets [beverages]; beverages containing vitamins; alcohol free beverages; effervescing beverages (powders for -); powders for effervescing beverages; preparations for making beverages; beverages (whey -); tonic water [non-medicated beverages]; mineral water [beverages]; honey-based beverages (non-alcoholic -); non-alcoholic beverages with tea flavour; malt syrup for beverages; soya-based beverages, other than milk substitutes; beer-based cocktails; non-alcoholic cocktails.</i></p> <p>Class 33: <i>Alcoholic beverages; whisky; whisky based drinks; whisky cocktails; malt whisky; blended whisky; scotch whisky; canadian whisky; whisky punch; scotch whisky based liqueurs; bourbon whiskey; alcoholic cordials; alcoholic extracts; alcoholic bitters; alcoholic gin; alcoholic extracts for gin; low-alcoholic</i></p>
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	<p><i>extracts for gin; prepared gin cocktails; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; rum; malt whisky; schnapps; cocktails; alcoholic cocktails in the form of chilled gelatines; raspberry cocktails; grapefruit cocktails; preparations for making alcoholic beverages; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit; absinthe; alcoholic beverages containing fruit; alcoholic bitters; alcoholic cocktail mixes; alcoholic cordials; alcoholic coffee based beverage; alcoholic jellies; alcoholic punches; blackcurrant liqueur; ciders; cherry brandy; distilled spirits; dry cider; fermented spirits; flavoured tonic liqueurs; fruit extracts, alcoholic; herb liqueurs; hullless barley liquor; pre-mixed alcoholic beverages; pre-mixed alcoholic beverages, containing vodka; peppermint liqueurs; rum punch; sugar cane juice rum.</i></p> <p><i>Class 35: Retail and online retail services in relation to the sale of beers, mineral</i></p>
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	<p><i>and aerated waters and other non-alcoholic beverages, fruit beverages and fruit juices, Syrups and other preparations for making beverages, ginger ale, ginger beer, dry ginger ale, ale, ales, pale ale, coffee flavoured ale, smoothies, smoothies [non-alcoholic fruit beverages], smoothies [fruit beverages, fruit predominating], fruit-based beverages, frozen fruit beverages, powders used in the preparation of fruit-based beverages, fruit squashes, fruit nectars, fruit nectars, non-alcoholic, non-alcoholic fruit extracts, frozen fruit drinks, mixed fruit juice, non-alcoholic fruit drinks, fruit flavoured soft drinks, syrups for making fruit-flavoured drinks, concentrates for making fruit juices, ice fruit beverages, soft drinks, vegetable drinks, energy drinks, cola drinks, isotonic drinks, de-alcoholised drinks, energy drinks containing caffeine, low-calorie soft drinks, carbonated non-alcoholic drinks, part frozen slush drinks, fruit flavoured carbonated drinks, sports drinks containing electrolytes, isotonic non-alcoholic drinks, aloe vera drinks, non-alcoholic, syrups for making soft drinks, squashes [non-alcoholic beverages], sorbets [beverages], sherbets [beverages], beverages containing vitamins, alcohol free beverages, effervescing beverages</i></p>
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	<p><i>(powders for -), powders for effervescing beverages, preparations for making beverages, beverages (whey -), tonic water [non-medicated beverages], mineral water [beverages], honey-based beverages (non-alcoholic -), non-alcoholic beverages with tea flavour, malt syrup for beverages, soya-based beverages, other than milk substitutes, beer-based cocktails, non-alcoholic cocktails, alcoholic beverages, whisky, whisky based drinks, whisky cocktails, malt whisky, blended whisky, scotch whisky, Canadian whisky, whisky punch, scotch whisky based liqueurs, bourbon whiskey, alcoholic cordials, alcoholic extracts, alcoholic bitters, alcoholic gin, alcoholic extracts for gin, low-alcoholic extracts for gin, prepared gin cocktails, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, alcoholic extracts containing vodka, alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails,</i></p>
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*preparations for making alcoholic beverages, alcoholic energy drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit, absinthe, alcoholic beverages containing fruit, alcoholic bitters, alcoholic cocktail mixes, alcoholic cordials, alcoholic coffee based beverage, alcoholic jellies, alcoholic punches, aperitif wines, blackcurrant liqueur, ciders, cherry brand, desert wines, distilled spirits, dry cider, fermented spirits, flavoured tonic liqueurs, fruit extracts, alcoholic, herb liqueurs, hullless barley liquor, low alcoholic wine, mulled wine, portable spirits, pre-mixed alcoholic beverages, preparations for making alcoholic wine, peppermint liqueurs, natural sparkling wines, prepared wine cocktails, rose wines, rum punch, sherry, sparkling grape wine, sparkling fruit wine, sparkling red wine, sparkling white wines, table wines, strawberry wine, sugar cane juice rum, wine-based drinks, wine punch.*

*Class 43: Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; hotels; pubs; bars; lounges; café; drink stands; catering for the provision of food and beverages; preparation of food and drink; services for the preparation of food and drink;*

	<p><i>provision of information relating to the preparation of food and drink; temporary accommodation; restaurant services; restaurant information services; restaurant reservation services; carvery restaurant services; mobile restaurant services; fast food restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; takeaway services; take-out restaurant services.</i></p>
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18. The law requires that goods/services be considered identical where one party's description of its goods/services encompasses the specific goods/services covered by the other party's description (and vice versa): see *Gérard Meric v OHIM*, Case T-33/05, GC. The applicant's goods in classes 32 and 33 are covered by the identical and wider terms in the specification of the earlier mark. The parties' goods are identical.

19. The opposed services in class 35 are retail services in relation to beverages, both alcoholic and non-alcoholic, and preparations for making beverages. In *Oakley, Inc v OHIM*, Case T-116/06, the GC held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, making them similar to a degree.

20. In *Tony Van Gulck v Wasabi Frog Ltd* ("Miss Boo"), BL O/391/14, Mr Geoffrey Hobbs, sitting as the Appointed Person, cautioned that "selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35". The objective of retail services, as set out in *Oakley*, "includes, in addition to the legal sales transaction, all activity carried out by the trader for the purpose of encouraging the conclusion of such a transaction" and "those services play, from the point of view of the relevant consumer, an important role when he comes to buy the goods offered

for sale.” On the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>1</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>2</sup>, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>3</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer’s point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent’s goods and then to compare the opponent’s goods with the retail services covered by the applicant’s trade mark;
- iii) It is not permissible to treat a mark registered for ‘retail services for goods X’ as though the mark was registered for goods X;
- iv) The General Court’s findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party’s trade mark was registered (or proposed to be registered).

21. I take from these authorities that, in comparing retail services against goods, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and, that the level of similarity may be weak depending on the presence or absence of the other *Canon* factors.

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<sup>1</sup> Case C-411/13P

<sup>2</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

<sup>3</sup> Case C-398/07P

22. The opponents' goods are self-evidently different in nature to retail services. The intended purpose of the goods is for drinking or creating drinks. The intended purpose of retail services is to encourage the sale of various goods, which means that the purpose of the goods/services is different. The goods are not in competition with the services and their method of use also differs.

23. As said above, the intended purpose of the applicant's retail services is to encourage the sale of various goods, including the goods for which the opponent has cover. I find that the applicant's retail services are complementary to the opponent's goods because the opponent's goods are (amongst others) specified as the subject of the retail services, either individually or as part of a larger group. The goods are indispensable to the retail services relating to them. In addition to the complementary relationship between the goods and the retailing thereof, there is an overlap in the trade channels through which the goods and services reach the average consumer. I find that there is a medium degree of similarity between the opponent's goods and the applicant's class 35 services which have been opposed.

24. In *Group Lottuss Corp., SL v OHIM*, Case T-161/07, the GC held there to be a low degree of similarity between beer, cocktail bars, entertainment and discotheques on account of the complementarity, target audience and overlapping points of sale. In *Yoo Holdings v OHIM*, T-562/14 the GC held that restaurant services were similar to beverages. In addition, it is common to find house wines and house branded cocktails in bars, restaurants and cocktail lounges. Consequently, I find that the opponent's goods are similar to a low degree with the following of the applicant's services in class 43:

*Services for providing food and drink; provision of food and drink in restaurants; catering for the provision of food and drink; hotels; pubs; bars; lounges; café; drink stands; catering for the provision of food and beverages; preparation of food and drink; services for the preparation of food and drink; restaurant services; carvery restaurant services; mobile restaurant services; fast food restaurant services; self-service restaurant services; restaurant services incorporating licensed bar facilities; restaurant services for the provision of fast food; takeaway services; take-out restaurant services.*

25. This leaves *provision of information relating to the preparation of food and drink; temporary accommodation; restaurant information services; restaurant reservation services*. The opponent's submissions do not address these services. It is not obvious to me why they are similar to the opponent's goods. They do not share nature, purpose, method of use and are not in competition. Hotel reservation services and information services, such as booking.com, are not complementary to nor do they share trade channels with beverages. The purpose of temporary accommodation is to provide the user with somewhere to sleep. Although this may include a restaurant or bar, that is not the core meaning of the term. To find similarity with temporary accommodation because there may be a restaurant or bar attached or on site is introducing too many steps in the comparison, leading to a creeping logic. There appears also to be no similarity with *provision of information relating to the preparation of food and drink*. This appears to me to be a service integral to the running of bars and restaurants, rather than a service supplied to the general public. If I am wrong about that, in the absence of any submissions on the point, the similarity between the opponent's goods and the applicant's *provision of information relating to the preparation of food and drink* will be very low, at best.

### **The average consumer and the nature of the purchasing process**

26. As the case law above indicates, it is necessary for me to determine who the average consumer is for those goods I have found to be either identical or similar; I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, 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.”

27. The average consumer of the goods and services at issue in these proceedings is an adult member of the public where the purchase of alcoholic goods (either via a retail or a bar service) is concerned, and any member of the public where non-alcoholic goods are concerned. Drinks may be bought in shops, at a bar or in a restaurant. The purchase of the goods and services will be a primarily visual purchase; even if drinks are asked for, they are usually on display<sup>4</sup>. Whilst certain drinks and restaurants will be thought about more carefully before a choice is made (in terms of them being more expensive), this does not equate to a heightened level of care. Buying drink or choosing a restaurant is a decision that an average consumer makes with a medium level of attention<sup>5</sup> to the provenance of the services or goods.

### **Comparison of trade marks**

28. 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 them, 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*:


“.....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.”

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<sup>4</sup> *Simonds Farsons Cisk plc v OHIM* Case T-3/04 and *Rani Refreshments FZCO v OHIM*, Case T-523/12, both GC.

<sup>5</sup> See the decision of Professor Phillip Johnson, sitting as the Appointed Person, in *Monster Energy Company v Chis Dominey and Christopher Lapham* BL O/061/19.

29. 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 they create. The trade marks to be compared are as follows:

The opponent's trade mark	The applicant's trade mark
effect PURE	

30. The opponent's mark comprises two words, the second of which is presented in capitals. This gives it a degree of dominance in the overall impression, but it is marginal (also bearing in mind notional use of the mark covers use in lower case and upper case). The overall impression of the applicant's mark lies in the particular stylised way in which the word PURE is presented.

31. The marks visually and aurally coincide in the word PURE. The applicant's mark is highly stylised; hence the level of visual similarity, taking into account the additional difference created by the word 'effect' at the front of the earlier mark, is low. The stylisation will not feature in pronunciation of the marks. Allowing for the articulation of 'effect' as the first word in the earlier mark, the aural similarity is medium.

32. Pure is an ordinary dictionary word which means uncontaminated/unadulterated. Both marks contain this word. The opponent's mark contains an additional word, effect. If it was the second word, so that the mark read PURE effect, the mark would have the concept of something creating or having a pure effect. However, it is at the front of the mark, so is grammatically incorrect. This lessens the impact of the two words combining to create a concept which makes sense. Owing to the common element PURE, the marks have a medium level of conceptual similarity.

### **Distinctive character of the earlier trade mark**

33. 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.

34. As the opponent has filed no evidence of any use it may have made of the trade mark upon which it relies, I have only its inherent characteristics to consider. The earlier mark is comprised of two elements. There is only one point of similarity between the marks: PURE. The applicant submits that the word PURE in the opponent's mark describes the quality of the goods for which the mark is registered, possessing little, if any, distinctive character. I agree.

35. The opponent submits that its mark “does not follow the usual grammatical rules of the English language. This bestows a normal level of inherent distinctive character on the Earlier Trade Mark. In the context of the Earlier Trade Mark this must extend to all elements of it.” I disagree. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C., sitting as the Appointed Person, pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

36. It is the fact that the mark as a whole is grammatically incorrect which gives the mark its distinctive character as a whole. It does not mean that each element of it has distinctive character *per se*. Although the mark as a whole has a normal level of distinctive character, the distinctiveness of PURE is very low, if it is distinctive at all for the goods.

### **Likelihood of confusion**

37. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of considering all the factors, weighing them and looking at their combined effect, in accordance with the authorities set out earlier in this decision. One of those principles states that a lesser degree of similarity between goods and services may be offset by a greater degree of similarity between the trade marks, and vice versa. I have found that there is no similarity between the opponent’s goods and the applicant’s *temporary accommodation; restaurant information services; restaurant reservation services*. As per *Canon* at [22], there is no likelihood of confusion where the goods or services are dissimilar. The opposition fails against these services.

38. The later mark is heavily stylised. Normal and fair use of the earlier mark would not extend to such stylisation. The predominant way in which the marks will be encountered is visually. Whether drinks may be sold in noisy bars where requests may be misheard, as submitted by the opponent, does not override the normal marketing conditions which are visual<sup>6</sup>, also bearing in mind aural requests are made when the goods are usually displayed. The marks will not be confused for one another (directly confused). That leaves me to consider whether there is a likelihood

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<sup>6</sup> See the cases cited at footnote 4 of this decision.

of confusion in the indirect sense; i.e. that the average consumer believes that there is an economic connection between the two undertakings, or that they are variant marks from the same undertaking, because of the common element in relation to identical goods. However, the existence of a common element does not automatically lead to a finding of confusion. One of the considerations is the distinctiveness of the common element.

39. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. He stated:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate

components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

40. Arnold J. went on to point out that “if the only similarity between the respective marks is a common element which has low distinctiveness, that points against there being a likelihood of confusion.” I have said above that the distinctiveness of the earlier mark lies in the incorrect grammatical juxtaposition of ‘effect PURE’. PURE is descriptive or very low in distinctive character for the goods. The later mark is highly stylised. Average consumers, who are reasonably circumspect, would consider the common element to be no more than a coincidence brought about by two parties who wish to convey the concept of pure drinks. That is, if they brought the earlier (or later) mark to mind at all: in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association, not indirect confusion. I find that there is no likelihood of confusion, whether direct or indirect.

## **Outcome**

41. The opposition fails. The application may proceed to registration.

## **Costs**

42. Awards of costs in fast track opposition proceedings are governed by Tribunal Practice Notice (“TPN”) 2 of 2015. Using that TPN as a guide, I award costs to the opponent on the following basis:

Considering the opposition and preparing  
the applicant's statement:

£300

43. I order MBG Holding GmbH to pay to W.M. Whiskey Co. Limited the sum of £300. 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 23 July 2019

**Judi Pike**  
**For the Registrar,**  
**the Comptroller-General**