

O/536/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003350651
BY MARK JAMES MUNNOCH-WAHLBERG AND CRAIG MUNNOCH-
WAHLBERG

TO REGISTER THE TRADE MARK:

Saint or Sinner

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001100 BY
KELLY MARIE GILES

BACKGROUND AND PLEADINGS

1. On 3 November 2018, Mark James Munnoch-Wahlberg and Craig Munnoch-Wahlberg (“the applicants”) applied to register the trade mark **Saint or Sinner** in the UK. The application was published for opposition purposes on 18 January 2019. Registration is sought for the following goods:

Class 33 Gin.

2. The application was opposed by Kelly Marie Giles (“the opponent”) by way of the Fast Track opposition procedure commenced on 16 April 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3262236 for the following trade mark:



3. The earlier mark was filed on 9 October 2017 and registered on 5 January 2018. The opponent relies upon all goods for which the earlier mark is registered, namely:

Class 33 Alcoholic beverages, except beer; Beverages (Distilled -); Distilled spirits; Spirits.

4. The opponent submits that there is a likelihood of confusion because the goods are identical or similar and the marks are similar.

5. The applicants filed a counterstatement denying the claim made.

6. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies 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 the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

8. The applicants are unrepresented and the opponent is represented by MTJL Limited.

9. 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; both parties filed written submissions in lieu.

PRELIMINARY ISSUE

10. In their pleadings, both parties have made reference to the fact that they both use similar acronyms within their businesses (SDS v SOS). However, the assessment that I must undertake is in respect of the trade marks as applied for/registered. Similarities created by acronyms for those marks that may be used during the course of business are not relevant to that assessment.

11. The applicants have also made reference to the fact that the parties use different bottle shapes and different colours. Again, it is only the similarities or differences between the trade marks as applied for/registered that form part of my assessment. How those marks are presented in practice is not relevant to the decision I must make.

DECISION

12. Section 5(2)(b) of the Act states as follows:

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

(a)...

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

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

13. The trade mark upon which the opponent relies qualifies as an earlier trade mark because it was applied for at an earlier date than the applicant’s mark pursuant to section 6 of the Act. As the opponent’s trade mark had not completed its registration process more than 5 years before the date of the application in issue in these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods she has identified.

Section 5(2)(b) – case law

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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 to mind the earlier mark, 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

15. The competing goods are as follows:

Opponent's goods	Applicants' goods
<u>Class 33</u> Alcoholic beverages, except beer; Beverages (Distilled -); Distilled spirits; Spirits.	<u>Class 33</u> Gin.

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court stated that:

“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 for 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.”

17. “Gin” in the applicants’ specification falls within the broader categories of “Alcoholic beverages, except beer”, “beverages (distilled -)”, “distilled spirits” and “spirits” in the

opponent's specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

18. I note that the applicants have made submissions that their specification is limited to gin which is a point of difference from the opponent's specification (which covers a broader range of goods). However, the fact that the opponent's specification may also cover additional goods does not prevent the goods from being considered identical. In any event, the other goods covered by the opponent's specification would be highly similar to the applicants' goods because they would overlap in trade channels, users, uses, method of use and nature. There may also be a degree of competition between them.

The average consumer and the nature of the purchasing act

19. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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.”

20. The average consumer for the goods will be a member of the general public who is over the age of 18. The goods may also be purchased by businesses. There will be various factors taken into consideration during the purchasing process, such as flavour, age and alcohol content. However, the goods will not be excessively

expensive and are likely to be purchased reasonably frequently. I therefore consider that a medium degree of attention will be paid during the purchasing process.

21. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. I acknowledge that verbal advice may be sought from a sales assistant or representative. The goods may also be purchased from bars or restaurants. In these circumstances, the goods are likely to be purchased following perusal of a drinks or wine list or following perusal of the goods themselves on a shelf behind a bar¹. Consequently, visual considerations will dominate the selection process, although I do not discount that there will also be an aural component to the purchase of the goods.

Comparison of trade marks

22. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:


“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

23. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the marks

¹ *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*, Case T-187/17

and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

24. The respective trade marks are shown below:

Opponent's trade mark	Applicants' trade mark
	<p style="text-align: center;">Saint or Sinner</p>

25. The applicants' mark consists of the words 'Saint or Sinner'. There are no other elements to contribute to the overall impression which lies in the words themselves. The opponent's mark consists of the word 'SAINT', presented in blue with a halo device above the 'S' and the word 'SINNER', presented in red with a devil device presented above the 'R'. There is also a gold 'swirl' device which the opponent states is intended to appear as an ampersand. The eye is naturally drawn to the wording, which plays the greater role in the overall impression. Due to its size, the swirl device also plays a reasonable role in the overall impression. The halo and devil devices and use of colour play a lesser role.

26. Visually, the marks coincide in the presence of the words SAINT and SINNER. They differ in the presence of the word "OR" in the applicants' mark and the use of colour and devices in the opponent's mark. Notional use of the applicants' mark will cover use in different typefaces and colour, so differences created by these elements are not significant. I consider the marks to be visually similar to a medium degree.

27. Aurally, the words SAINT and SINNER will be pronounced identically in both marks. Whether or not the 'swirl' device is recognised as an ampersand, the marks

will differ in the pronunciation of the word OR in the applicants' mark which has no counterpart in the opponent's mark. I consider the marks to be aurally highly similar.

28. Conceptually, the words SAINT and SINNER will be given their ordinary dictionary meaning. The halo and devil devices reinforce these meanings. The word OR and the ampersand (if it is recognised) do not create a significant conceptual distinction between the marks. I consider the marks to be conceptually highly similar.

Distinctive character of the earlier trade mark

29. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

31. The opponent has not pleaded that her mark has acquired enhanced distinctive character through use and has filed no evidence to support such a finding. I can, therefore, only consider the inherent position. The words SAINT and SINNER are ordinary dictionary words. They are neither allusive nor descriptive. The use of colour and devices also contribute to the distinctiveness of the opponent's mark, however, as it is only the distinctiveness of the common elements which is relevant, I do not consider that this adds anything to the opponent's case². I consider the earlier mark to be inherently distinctive to a medium degree.

Likelihood of confusion

32. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to 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 that he has retained in his mind.

² *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

33. I have found the marks to be visually similar to a medium degree and aurally and conceptually highly similar. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who is over the age of 18 or a business user, who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium. I have found the parties' goods to be identical.

34. Bearing in mind the visual, aural and conceptual similarities between the marks, and the principle of imperfect recollection, I am satisfied that there is a likelihood of one mark being mistakenly recalled for the other. I consider there to be a likelihood of direct confusion.

35. In the event that I am wrong in this finding, I will now consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

36. Bearing in mind my conclusions set out above, I consider that even if the average consumer recalls the differences between the marks (for example, the use of devices in the opponent's mark), he or she is likely to perceive the applied for mark as an

alternative mark used by the same or economically linked undertaking. I consider there to be a likelihood of indirect confusion.

CONCLUSION

37. The opposition is successful, and the application is refused.

COSTS

38. The opponent has been successful and is entitled to a contribution towards her costs. The opponent did file a costs proforma outlining the number of hours spent on these proceedings. However, as the opponent is represented, costs will be governed by Tribunal Practice Notice 2/2015. In the circumstances, I award the opponent the sum of **£450** calculated as follows:

Filing a notice of opposition and considering the applicant's counterstatement	£150
Filing written submission in lieu	£200
Official fee	£100
Total	£450

39. I hereby order Mark James Munnoch-Wahlberg and Craig Munnoch-Wahlberg to pay Kelly Marie Giles the sum of £450 (in total) within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated this 12th day of September 2019

S WILSON

For the Registrar