

O/592/19

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003302733

BY THE SOHO SOCIETY

TO REGISTER THE TRADE MARK



IN CLASS 32

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 413866 BY

SOHO BREWING LTD

BACKGROUND AND PLEADINGS

1. On 10 April 2018, The Soho Society (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 29 June 2018. The applicant seeks to register its trade mark for the following goods:

Class 32 Beer.

2. The application is opposed by Soho Brewing Ltd (“the opponent”) under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following trade marks:



UK registration no. 3138488 (series of 4)

Filing date 30 November 2015; registration date 1 April 2016

Relying on all goods for which the marks are registered, namely:

Class 32 Beer; lager; pilsner; ale; and porter, and preparations for making these different beers.

(“the First Registration”)



(UK registration no. 3025125)

Filing date 7 October 2013; registration date 13 November 2015

Relying on all goods for which the mark is registered, namely:

Class 32 Beers including low and non alcoholic beers; Non-alcoholic beer;
Low alcohol beer; Beer.

(“the Second Registration”)



(EUTM no. 13869896)

Filing date 24 March 2015; registration date 5 April 2018

Relying on all goods for which the mark is registered, namely:

Class 32 Beer, lager, ale, porter and stout, and preparations for making
these different beers.

(“the Third Registration”)

3. The opponent claims that there is a likelihood of confusion because the respective goods are identical or similar, and the marks are similar.

4. The applicant filed a counterstatement denying the claim made.

5. The applicant is unrepresented and the opponent is represented by Dolleymores. The applicant filed evidence in the form of the witness statement of Robert Timothy Lord dated 2 April 2019. No evidence in chief or evidence in reply was filed by the opponent. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE AND PRELIMINARY ISSUE

6. As noted above, the applicant's evidence consists of the witness statement of Robert Timothy Lord dated 2 April 2019, which was accompanied by 8 exhibits. Mr Lord is the Chair of the applicant; a role he has held since September 2017.

7. The majority of Mr Lord's evidence focuses upon the applicant's prior use of the applied for mark. For the avoidance of doubt, the fact that the applicant claims to have used its mark prior to the opponent's mark being applied for/registered, is not a defence in law to an opposition under section 5(2)(b). Tribunal Practice Notice 4/2009 explains this as follows:

"The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.

4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in *Ion Associates Ltd v Philip Stainton and Another*, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.

5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes

to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

8. The applicant has not sought to invalidate the opponent's mark based on its claim to an earlier unregistered right. Section 72 of the Act provides that registration shall be taken as prima facie evidence of the validity of a registered trade mark. The opponent's mark must, therefore, be regarded as validly registered and, in these circumstances, the law requires priority to be determined according to the filing dates of the applications for registration. This means that the opponent's mark has priority.

9. Mr Lord has also set out in his evidence that "Soho" is the name of an area in London. In particular, he refers to an extract from the website Wikipedia, which states as follows:

"Soho is an area of the City of Westminster, part of the West End of London. Originally a fashionable district for the aristocracy, it has been one of the main entertainment districts in the capital since the 19th century."¹

10. As noted above, both parties have filed written submissions. I do not propose to summarise those submissions here, but have taken them into consideration, and will refer to them below where necessary.

DECISION

11. Section 5(2)(b) of the Act reads as follows:

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

(a)...

¹ Exhibit TL8

(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.”

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

“6(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, an international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

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

13. Given their filing dates, the trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As the earlier marks had not completed their registration process more than 5 years before the publication date of the application in issue in these proceedings, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it 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	Applicant's goods
First Earlier Registration <u>Class 32</u> Beer; lager; pilsner; ale; and porter, and preparations for making these different beers.	<u>Class 32</u> Beer.
Second Earlier Registration <u>Class 32</u> Beers including low and non alcoholic beers; Non-alcoholic beer; Low alcohol beer; Beer.	

<p>Third Earlier Registration</p>	
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Class 32

Beer, lager, ale, porter and stout, and preparations for making these different beers.

16. “Beer” appears in the specifications of both the applicant’s mark and the opponent’s marks. The goods are, clearly, identical.

The average consumer and the nature of the purchasing act

17. 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.”

18. The average consumer will be a member of the general public, who is over the age of 18. There will be various factors taken into consideration in deciding which goods to purchase such as flavour 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.

19. 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. Alternatively, the goods may 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 behind a bar². However, orders will be placed verbally. 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


20. 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:

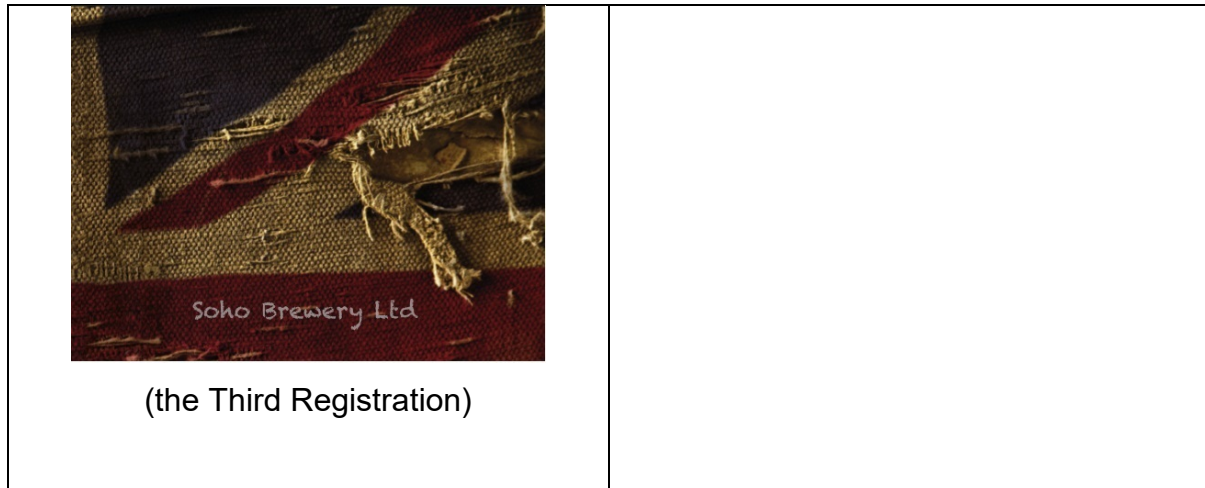
“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in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

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

² *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*, Case T-187/17

22. The respective trade marks are shown below:

Opponent's trade marks	Applicant's trade mark
 <p>Soho Lager</p>  <p>Soho Pilsner</p>  <p>Soho Pale Ale</p>  <p>Soho Porter</p>	
<p>(the First Registration)</p>  <p>Soho Brewery Ltd</p> <p>(the Second Registration)</p>	



23. The applicant's mark consists of the words THE SOHO SOCIETY, presented in white on a blue circular background. Around the outside of the circular background are the words OUR NEIGHBOURHOOD IS YOUR BUSINESS. There are also some additional white device elements surrounding the text. The words THE SOHO SOCIETY play the greater role in the overall impression due to their size and central positioning, with the words OUR NEIGHBOURHOOD IS YOUR BUSINESS paying a lesser role due to being in smaller font and positioned around the top and bottom of the circular background. The stylisation, background and devices also contribute to the overall impression, but play a lesser role.

24. The opponent's marks consist of the words SOHO LAGER, SOHO PILSNER, SOHO PALE ALE, SOHO PORTER or Soho Brewery Ltd in white font presented on a partial Union Jack background. The overall impression of the marks lie in the combination of these elements.

25. Visually, the only overlap in the marks is the word SOHO. The additional wording, devices and background elements used in each mark differ entirely, as do the colours used. I consider there to be only a low degree of visual similarity.

26. Aurally, the only overlap in the marks is the pronunciation of the word SOHO, which will be identical. The words LAGER, PILSNER, PALE ALE and PORTER in the First Registration may not be pronounced because they are descriptive of the goods. Similarly, the words OUR NEIGHBOURHOOD IS YOUR BUSINESS in the applicant's mark may also not be pronounced as they are smaller and may be seen as a slogan.

However, the words THE and SOCIETY in the applicant's mark will be pronounced and have no counterpart in the opponent's marks. The words BREWERY LTD in the Second and Third Earlier Registrations will also have no counterpart in the applicant's mark. At best, I consider there to be between a low and medium degree of aural similarity between the marks.

27. Conceptually, the marks overlap in that they all make reference to SOHO. I agree with the applicant that this will be viewed as a reference to a particular area of London. The First Earlier Registration gives the impression of different types of beer which are produced in the Soho area. The Second and Third Earlier Registrations give the impression of a brewery which is located in the Soho area. The applicant's mark gives the impression of a society which is located in Soho.

28. In its written submissions in lieu, the opponent states:

"21. The blue rondel device [in the applicant's mark], and the presentation of the wording within that rondel is synonymous with the London blue plaques used and run by the English Heritage. The London blue plaque scheme was started in 1866 and celebrates the links between notable figures of the past and the buildings in which they lived and worked. The blue plaques attached to buildings honour the notable men and women who had lived or worked in that property. The scheme and blue plaques are recognised as part of the UK's history."

29. The opponent goes on to state that, as the Union Jack flag use in its own marks is also synonymous with the United Kingdom, this is a conceptual link between the marks. I note that the opponent has filed no evidence to support its claim regarding the use of the blue roundel or to demonstrate that the average consumer will be aware of its significance. In the absence of any evidence to the contrary, I do not consider that the average consumer will attribute any particular meaning to the use of the blue background in the applicant's mark. The connection with Soho is, therefore, the only link between them. I consider there to be a low degree of conceptual similarity.

Distinctive character of the earlier trade mark

30. 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).”

31. 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 or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

32. The opponent has not pleaded that the distinctiveness of its marks has been enhanced through use and has filed no evidence to support such a claim. I have, therefore, only the inherent position to consider. The words SOHO LAGER, SOHO

PILSNER, SOHO PALE ALE, SOHO PORTER and Soho Brewery Ltd in the opponent's marks are descriptive of the goods provided by the opponent and the geographical location from which they originate. The opponent points to the fact that there has not been a brewery in Soho for a number of years to suggest that this makes the use of these words in its marks unusual and, therefore, distinctive. However, the average consumer cannot be expected to have detailed knowledge about how common breweries are in the Soho district of London and, in any event, the fact that this is not a common location for breweries does not prevent the words SOHO BREWERY from being descriptive of a brewery located in that area. The addition of the Union Jack background does add some additional distinctiveness to the marks. However, even with this, I consider the inherent distinctive character of the opponent's marks to be no more than somewhere between a low and medium degree.

Likelihood of confusion

33. 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 and services 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 services 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.

34. I have found the marks to be a low degree of visual and conceptual similarity between the marks. At best, I consider the marks to be aurally similar to between a low and medium degree. I have found the earlier marks to have between a low and

medium degree of inherent distinctiveness. I have identified the average consumer to be a member of the general public who is over the age of 18. I consider that they will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that a medium degree of attention will be paid during the purchasing process. I have found the goods to be identical.

35. Taking all of these factors into account, I do not consider that the marks will be mistakenly recalled or misremembered as each other. The visual, aural and conceptual differences between the marks will not go unnoticed by the average consumer. I do not consider there to be a likelihood of direct confusion.

36. I will now consider whether there is a 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.”

37. Having identified the differences between the marks, I can see no reason why the average consumer would consider them to have originated from the same or economically linked undertakings. The common element – SOHO – in the marks is far more likely to be seen by the average consumer as indicating businesses or products linked in some way to that area of London, rather than indicating linked businesses. I do not, therefore, consider there to be a likelihood of indirect confusion.

CONCLUSION

38. The opposition under section 5(2)(b) fails in its entirety.

COSTS

39. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. As noted above, although the applicant filed evidence, the majority of this addressed prior use of the applied for mark which is not relevant to the issue before me. I have, therefore, reduced the amount awarded in respect of the applicant's evidence to reflect this. In the circumstances, I award the applicant the sum of £650 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the opponent's statement	£200
Preparing evidence	£150
Preparing written submissions in lieu	£300
Total	£650

40. I therefore order Soho Brewing Ltd to pay The Soho Society the sum of £650. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 03rd day of October 2019

S WILSON

For the Registrar