

O-119-21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3396474

BY SOUL SPIRITS LTD

TO REGISTER



AS A TRADE MARK

IN CLASSES 33 & 35

AND

THE OPPOSITION THERETO UNDER NUMBER OP000417378

BY

HAECKY HOLDING AG

Background and pleadings

1. Soul Spirits Ltd (“the applicant”) applied to register the trade mark, as shown on the cover page of this decision, on 2 May 2019. The application, which relates to goods and services in classes 33 and 35,¹ was subsequently published in the Trade Marks Journal for opposition purposes on 17 May 2019.
2. The application was opposed by Haecky Holding AG (“the opponent”). The opposition was filed on 19 August 2019; and was initially based upon sections 5(2)(b), 3(3)(b) and 3(6) Trade Marks Act 1994 (“the Act”). However, the second and third grounds were discontinued by reason of the opponent’s decision not to file evidence in support of its opposition. It is a partial opposition, directed against the following goods and services in the application:

Class 33 Alcoholic beverages (except beer); spirits; rum; whisky; vodka; gin.

Class 35 Mail order retail services related to alcoholic beverages (except beer); Retail services in relation to alcoholic beverages (except beer); Retail services in relation to preparations for making alcoholic beverages; Retail services relating to alcoholic beverages; Retail services via catalogues related to alcoholic beverages (except beer); Retail services via global computer networks related to alcoholic beverages (except beer); Wholesale services In relation to alcoholic beverages (except beer); Wholesale services in relation to preparations for making alcoholic beverages; Wholesale services in relation to preparations for making beverages; Alcoholic beverage procurement services for others [purchasing goods for other businesses]; Retail services In relation to preparations for making

¹ The specifications are lengthy; and are therefore not reproduced in this decision. Please refer to The Register: <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003396474> for the full specifications.

beverages; Providing consumer product information relating to food or drink products; Unmanned retail store services relating to drink; Providing consumer product information relating to food or drink products; Commercial information services relating to wine; Mail order retail services related to beer; Retail services connected with the sale of subscription boxes containing beers; Retail services In relation to beer; Retail services via catalogues related to beer; Retail services via global computer networks related to beer; Wholesale services in relation to beer.

3. The opponent relies upon its International Registration **01107083**, filed on 16 January 2012; for which the registration procedure was completed on 4 January 2013.² This trade mark is registered for goods in classes 30, 32 and 33. However, the opponent relies upon only some of the goods under said registration, namely all of the goods of class 33, as follows:

CORUBA

Class 33 Alcoholic beverages, except beer.

Procedural Points

4. In these proceedings the opponent is represented by the firm Dehns; and the applicant is unrepresented.
5. The opponent filed a notice of opposition and statement of grounds. The applicant filed a notice of defence and counterstatement. Neither party filed written submissions beyond those contained in the notice of opposition/counterstatement. Neither side filed evidence. A hearing was neither

² Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.”

requested nor considered necessary. I therefore give this decision after careful review of all the papers before me.

Preliminary Points

6. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

7. The applicant has purportedly filed evidence with its notice of defence and counterstatement. By letter dated 26 February 2020 the Tribunal advised the applicant as follows:

It is noted that you have provided several documents along with the form TM8, which are considered evidential content. As the proceedings are currently at the pleadings stage evidence is not yet required.

If you wish for the documents to be filed as evidence it must be in the required format i.e. cross referenced in a witness statement, containing a declaration of truth. You will have the opportunity to file the evidence in the 'evidence rounds' at a later stage in the proceedings.

The evidential content you have filed will not be considered in proceedings in their current format.

Guidance on filing evidence and examples can be found on our website
....

8. This advice was reiterated in further correspondence from the Tribunal including letters dated: 1 September 2020; 28 November 2020 and 1 December 2020; with additional guidance on requesting a retrospective extension of time to file

their evidence. However, the applicant has chosen not to formalise its evidence or seek additional time to do so.

9. For these reasons the said evidential content has not been considered in this decision; and in any event, I consider that it would have had no material impact on my decision.

DECISION

Section 5(2)(b)

10. Section 5(2)(b) of the Act provides 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.”

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

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

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

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

12. The opponent’s trade mark registration, having been registered on 4 January 2013, qualifies as an earlier trade mark under section 6 of the Act. Although registered for more than five years (from the date the contested application was filed), the applicant has not put the opponent to proof of use of the earlier word mark. The opponent is, as a consequence, entitled to rely upon its earlier mark in relation to all of the goods indicated without having to prove genuine use. Therefore, I must make the assessment based upon the full width of the goods relied upon by the opponent, regardless of whether or not the mark has actually been used in relation to those goods.

Section 5(2)(b) – case law

13. 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 the goods and services

14. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon*, the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective users of the respective goods or services;
- (b) The physical nature of the goods or acts of services;

- (c) The respective trade channels through which the goods or services reach the market;
- (d) In the case of self-serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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”.

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

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

20. 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.

Similarity of goods and services – Nice Classification

21. Section 60A of the Act provides:

22. “(1) For the purpose of this Act goods and services-

are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975.”

The Opponent’s Class 33 Goods

23. The term “Alcoholic beverages, except beer” appear in both (the opponent’s and applicant’s) specifications; therefore, these goods are self-evidently identical.

24. Although the terms “spirits; rum; whisky; vodka; gin” do not have a direct counterpart in the opponent’s specification, they are all types of alcoholic drinks, which fall within its broad term “alcoholic beverages”. These goods are therefore identical on the principle outlined in *Meric*.

The Applicant's Class 35 Services

25. Mail order retail services related to alcoholic beverages (except beer); Retail services in relation to alcoholic beverages (except beer); Retail services relating to alcoholic beverages; Retail services via catalogues related to alcoholic beverages (except beer); Retail services via global computer networks related to alcoholic beverages (except beer); and Unmanned retail store services relating to drink. I consider these to be sufficiently comparable to be grouped as retail services in relation to alcoholic beverages (except beer).

26. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court 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, and therefore similar to a degree.

27. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘similar’ to goods are not clear cut.”

28. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*³, and *Assembled Investments (Proprietary) Ltd v. OHIM*⁴, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁵, 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).

29. The nature, purpose and method of use of retail services in relation to alcoholic beverages (except beer) are not the same as the earlier specification "alcoholic beverages, except beer". Nevertheless, I consider, in line with reasoning in the *Oakley* case, that they are complementary; in the sense that alcoholic beverages are indispensable to the provision of the retail services. These services are specifically provided for the ultimate purpose of selling alcoholic

³ Case C-411/13P.

⁴ Case T-105/05.

⁵ Case C-398/07P.

beverages; and would make no sense without those goods. They are the same as, or fall under the natural and usual meaning of the term alcoholic beverages, except beer. Moreover, the services are generally offered in the same places where the goods are offered for sale; and likewise target the same public. I therefore find that the applicant's retail services in relation to alcoholic beverages (except beer) are similar to the earlier specification (alcoholic beverages, except beer) to an average degree.

Wholesale services In relation to alcoholic beverages (except beer)

30. It is clear that users of wholesale services are different from final customers, being business customers, such as distributors and/or retailers. Nevertheless, I find that there remains a degree of similarity between these wholesale services and the opponent's goods; because the goods that are the subject of the contested wholesale services are exactly the same goods as the opponent's goods. It is plain to see that the services in this category would not exist without the goods at issue. Therefore, they are complementary. They are generally offered in the same places where the goods are offered for sale; and target the same consumer group. I find that these services are similar to an average degree to the opponent's alcoholic beverages, except beer.

Alcoholic beverage procurement services for others [purchasing goods for other businesses]

31. When the opponent's goods (alcoholic beverages, except beer) are compared with the contested alcoholic beverage procurement services, I consider that this does not relate to the opponent trading its own goods, which in any event is not a service envisaged by the term procurement services in class 35. I take procurement services here to mean a commercial function, for business customers, which is different in nature, purpose and method of use. These services are neither complementary, nor in competition with the opponent's goods. Furthermore, they are offered through different distribution channels and

target a different relevant public. Therefore, these services are dissimilar to the opponent's goods.

Wholesale services in relation to preparations for making alcoholic beverages;

Retail services in relation to preparations for making alcoholic beverages

32. According to settled caselaw, for a finding of similarity between goods and retail/wholesale services, it is not necessary for the goods of those services to be exactly the same as the opposing goods. Similarity can be established even where the goods “resemble each other to a certain degree”.⁶ This is mainly on account of their complementarity; in the sense that one is indispensable or important for the use of the other, with the result that consumers may think that the same undertaking is responsible for manufacturing those goods and for providing those services. I find that the goods relating to these contested services are closely connected to the goods of the earlier mark. The average consumer (whether a business user or a member of the relevant public) may either buy ready-made alcoholic drinks, or purchase products to enable them to make their own; and in the latter case, access the relevant wholesale or retail services. Therefore, I find that these services are similar to the opponent's goods to an average degree.

Wholesale services in relation to preparations for making beverages;

Retail services In relation to preparations for making beverages

33. The contested “preparations for making beverages” (ingredients used to prepare drinks) is even broader than the specification “preparations for making alcoholic beverages”; as this includes all types of beverages, alcoholic and non-alcoholic. I find that the applied-for specification is not too vague to permit a comparison; and it clearly encompasses the earlier goods specification; as these services may also be used in relation to the preparation of alcoholic beverages. I consider that they can be widely distributed to stores, publicans and bar owners, for

⁶ T-365/14, *Trecolore*, EU:T:2015:763, § 34-35; T-390/16, *Dontoro*, EU:T:2018:156, § 32-33; T-729/18, *Lloyd*, EU:T:2019:889, § 36; T-116/06, *O Store*, EU:T:2008:399, § 42-58; and the case of T-116/06, *Oakley, Inc v OHIM*, EU:T:2008:399, § 56.

example (to make their own alcoholic beverages, instead of purchasing the finished articles). Therefore, these services retain a sufficient link to the goods under the earlier mark, to the extent that they must be regarded as similar. For all of the above reasons, I conclude that these services are also similar to an average degree.

Providing consumer product information relating to food or drink products;
Commercial information services relating to wine

34. I find that these services are fundamentally different in nature and purpose from the opponent's goods. They principally exist to provide information to support or supplement other services. I accept that some of the opponent's goods may appear in these information services; and conclude that that would be insufficient for finding similarity. These services target customer groups with different needs and are offered through different distribution channels. For example, commercial information services may target business entities; and could relate to the provision of information ranging from business contacts, to investment opportunities, in respect of wine. Moreover, these are not complementary, in the sense that one is indispensable for the other, nor in competition. Therefore, these information services are dissimilar to the goods of the opponent's specification.

Mail order retail services related to beer; Retail services connected with the sale of subscription boxes containing beers; Retail services in relation to beer; Retail services via catalogues related to beer; Retail services via global computer networks related to beer; Wholesale services in relation to beer

35. Beer, the goods that are the subject of these contested services, can be distinguished to some extent by subcategory; given, for example, that their production processes are different and that some beers are non-alcoholic in nature. Nevertheless, these goods (so far as the relevant Alcohol By Volume applies), belong to the same category of alcoholic drinks intended for the adult general public. Therefore, the contested services have the similar aim of

supplying alcoholic beverages for consumption. The average consumer will expect to find them in the same commercial outlets, including mail order services and catalogues, as alcoholic beverages. Additionally, they can originate from the same undertakings. Therefore, I find that these contested services (relating to beer) are similar to the opponent's goods to an average degree.

36. In conclusion, of the contested goods and services, I have found that the following are identical or at least similar to an average degree to the opponent's goods ("alcoholic beverages, except beer"):

Alcoholic beverages (except beer); spirits; rum; whisky; vodka; gin; Mail order retail services related to alcoholic beverages (except beer); Retail services in relation to alcoholic beverages (except beer); Retail services in relation to preparations for making alcoholic beverages; Retail services relating to alcoholic beverages; Retail services via catalogues related to alcoholic beverages (except beer); Retail services via global computer networks related to alcoholic beverages (except beer); Wholesale services In relation to alcoholic beverages (except beer); Wholesale services in relation to preparations for making alcoholic beverages; Wholesale services in relation to preparations for making beverages; Retail services In relation to preparations for making beverages; Unmanned retail store services relating to drink; Mail order retail services related to beer; Retail services connected with the sale of subscription boxes containing beers; Retail services In relation to beer; Retail services via catalogues related to beer; Retail services via global computer networks related to beer; Wholesale services in relation to beer.

Therefore these terms will form the basis of my later analysis on the likelihood of confusion.

Average consumer and the purchasing act

37. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the

likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. 47.

38. 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.”

39. The goods at issue in these proceedings are alcoholic beverages or related to them. The average consumer of the goods is a member of the adult general public (including businesses). The goods may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where they are normally displayed on shelves) and online; in such circumstances, the goods will be obtained by self-selection. The goods at issue are also sold in, for example, public houses, bars and restaurants; where they will be displayed on, for example, bottles; and where the trade mark will appear on drinks lists or menus). When the goods at issue are sold in, for example, public houses, bars and restaurants there will be an oral component to the selection process; though not to the exclusion of visual considerations. In *Simonds Farsons Cisk plc v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for

the applicant's goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

40. Consequently, while the goods may be ordered orally in bars and restaurants, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one. Having said that, I also accept that alcoholic beverages may be ordered orally in a noisy environment, such as bars, clubs or restaurants, and without having previously visually examined the products and the brands associated with them.⁷ Consideration must therefore be given to consumers who address and recognise alcoholic beverages according to the aural element which serves to identify them.

41. I turn now to consider the level of attention the average consumer will display when selecting the goods. I accept that some of the goods at issue can be very expensive and rare; and some consumers select those carefully (according to origin, type or grapes and so on). For the most part, however, the cost of the goods is likely to be relatively low. Bearing in mind that the average consumer will wish to ensure they are selecting the correct (type, flavour, strength, et cetera) beverage; they are, in my view, likely to pay at least a reasonable level of attention to the selection of the goods at issue.

42. In relation to the applicant's retail services, the average consumer is once again the public at large. The selection (whether conducted in the physical or virtual

⁷ *Società agricola Giusti Dal Col v EUIPO - DMC (GIUSTI WINE)*, Case T-678/18; § 54-55; and *Aroa Bodegas v OHIM - Bodegas Muga (aroa)*, Case T-536/12; § 55.

worlds) will, in my view, consist primarily of a visual act. However, I do not discount the potential for aural reference, such as word-of-mouth recommendations, or arranging to meet at a particular establishment. The average consumer may also direct his/her mind to matters such as the opening hours, size and location of the retail premises (if the selection takes place in the real world); together with, for example, the range of goods stocked, the quality of the goods stocked and other costs considerations. The level of care taken over the selection of the relevant services will depend to a degree upon the type of occasion, from everyday purchases or social drinking to special or one-off events. On balance, there will be an average degree of attention paid to the selection of these services.

43. The average consumer for the wholesale services I found to be similar, is likely to be a business seeking a supplier of alcoholic beverages or relevant related goods. Such an entity will take an above average degree of attention in selecting the service provider owing to the importance of ensuring that the service meets the business requirements, taking into account, for example, cost and characteristics of the product (for example, aroma, taste). The purchasing process will primarily be visual with the services being selected from brochures or online equivalents, or from specific tender submissions. There may also be word-of-mouth recommendations and bookings by telephone where aural considerations will play a part.


Comparison of the marks

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

45. 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.

46. The respective trade marks are shown below:

CORUBA	
Earlier trade mark	Contested trade mark

Overall Impression

47. The opponent’s earlier mark consists of the single word CORUBA. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself.

48. The applicant’s is a figurative mark consisting of the word elements COYABA and RUM. The COYABA element is presented in a stylised uppercase black font, with a yellow-gold double shadow, inscribed in the form of a gentle curve or wave, with an upward flow towards the right, against a black background. The RUM element appears in a smaller standard black font, under the first three letters of COYABA, within the yellow-gold double shadow. The mark’s overall

impression lies predominantly in the word elements, with COYABA being more dominant; and the mark's stylisation playing a lesser role.

Visual Comparison

49. Visually, the marks coincide in that they share four letters or two syllables, placed in exactly the same order; namely "CO**BA". Since consumers generally pay more attention to the beginning of words, the fact that they differ in the middle letters ("RU", in relation to the opponent's mark and "YA" in the applicant's mark), has limited impact. The decorative stylisation and the smaller word element RUM of the contested mark play secondary roles. The signs are therefore visually similar to a medium degree.

Aural Comparison

50. Aurally, the pronunciation of the marks is the same in the sound of the common letters or syllables "CO**BA" and differ in the sound of the middle letters/syllables "RU" and "YA". They have the same rhythm and intonation and will be pronounced into three syllables each, namely "CO-RU-BA" versus "CO-YA-BA". I also believe, in the case of the applicant's mark, that a significant proportion of the average consumer will place more attention on the word "COYABA", as the more dominant element; and omit to articulate the "RUM" element. In such a case, the marks would be aurally similar to a high degree. In the (less likely) case where the "RUM" element is articulated in addition to "COYABA", the marks can be said to be aurally similar to a medium degree.

Conceptual Comparison

51. The word "CORUBA" does not convey a concept. I consider that the relevant average UK consumer will ascribe no meaning to the word; and instead conclude that "CORUBA" is an invented word.

52. In its notice of defence and counterstatement the applicant claims that: “We chose the word Coyaba as it means paradise in Barbadian terms and as we are importing rums from the Caribbean, including Barbados, we chose the name to give it integrity”. However, I could not take this into consideration as it has not been formalised into evidence (at the evidence rounds). Furthermore, even if I were prepared to take judicial notice of this evidence, I do not consider that the applicant’s suggested meaning will be obvious to the average UK consumer. In my view, the average consumer would not instinctively or immediately attach a concept to the word element “COYABA”. This word will be seen as invented or borrowed from another language. To this extent, the marks will be conceptually neutral. The word element “RUM” (appearing in the applicant’s mark only) will be perceived as an alcoholic beverage by the average UK consumer. The presence of this element, therefore, acts as a point of conceptual difference between the marks. When taken into consideration, the average consumer will perceive the mark as a whole as something to do with rum or alcoholic beverages. Therefore, for all of the above reasons, I find that the marks are not similar from a conceptual point of view.

Distinctive character of the earlier trade mark

53. The degree of distinctiveness of the earlier mark is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark the greater the likelihood of confusion⁸. 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.

54. “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

⁸ *Sabel BV v Puma AG*, Case C-251/95 [para. 24]

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.

55. Trade marks possess various 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. Further, the distinctiveness of a mark can be enhanced by virtue of the use made of it. In this case, however, the opponent has not pleaded that its mark has acquired enhanced distinctiveness through use and has not filed any evidence to support such a claim. Consequently, I have only the inherent position to consider.

56. The earlier mark consists solely of the word “CORUBA”, with no stylisation or additional elements. In line with my conclusion on its concept, the average consumer is unlikely to attribute a meaning to this ostensibly invented word. It also follows that the word does not describe or allude to the goods for which it is registered. Therefore, as an invented word with no apparent meaning, the mark is of a high degree of inherent distinctive character.

Conclusions on Likelihood of Confusion

57. 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; that is, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective 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, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also bear in mind the average consumer of the goods and 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 they have retained in their mind.

58. Confusion can be direct (where the average consumer mistakes one mark for the other), or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks and the services down to the responsible undertakings being the same or related).

59. The distinction between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

“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.

60. I earlier found that the competing goods are identical; that the relevant retail services are similar to an average degree (to the opponent’s goods). The average consumer is an adult member of the general public, who will select those goods and services by both visual and oral means (albeit the visual considerations are likely to dominate); and who will pay a reasonable level of attention in selecting those goods and services. In relation to the wholesale services I found to be similar to an average degree, I concluded that the average consumer is most likely to be a business user, who will select the services predominately by visual means; and exhibit an above-average degree of attention in the selection process.

61. The overall impression of the opponent's mark is of a single word. I also concluded that the word element "COYABA" in the contested figurative mark is more dominant than the word element "RUM" and the overall stylisation of that mark. The competing marks are visually similar to an average degree; aurally similar to a high degree (where only the more dominant word element in the applicant's mark is articulated) or to an average degree (in rarer cases where both word elements are articulated). The marks are conceptually neutral to the extent that the words "CORUBA" and "COYABA" have no particular meaning; but the presence of the word element "RUM" acts as a point of conceptual difference between them. I have found the earlier mark to have a high degree of inherent distinctiveness.

62. I consider that the degree of visual and aural similarity between the relevant elements of the competing marks, which contribute to the overall impressions they convey is, in the absence of a conceptual hook to assist the average consumer in distinguishing between them, sufficient to result in a likelihood of direct confusion through imperfect recollection. This applies to all of the contested goods and services I have found to be identical or similar; even taking into account a higher degree of attention of the relevant average consumer.

Conclusion

63. The opposition is successful in relation to the following goods and services, for which the application is refused (subject to appeal):

Class 33 Alcoholic beverages (except beer); spirits; rum; whisky; vodka; gin.

Class 35 Mail order retail services related to alcoholic beverages (except beer); Retail services in relation to alcoholic beverages (except beer); Retail services in relation to preparations for making alcoholic beverages; Retail services relating to alcoholic beverages; Retail services via catalogues related to alcoholic

beverages (except beer); Retail services via global computer networks related to alcoholic beverages (except beer); Wholesale services In relation to alcoholic beverages (except beer); Wholesale services in relation to preparations for making alcoholic beverages; Wholesale services in relation to preparations for making beverages; Retail services In relation to preparations for making beverages; Unmanned retail store services relating to drink; Mail order retail services related to beer; Retail services connected with the sale of subscription boxes containing beers; Retail services In relation to beer; Retail services via catalogues related to beer; Retail services via global computer networks related to beer; Wholesale services in relation to beer.

64. The application may proceed to registration for the remaining class 35 services, including those that were not opposed.

COSTS

65. As the opponent has been largely successful, it is entitled to a contribution towards its costs. However, I consider it appropriate to discount the contribution by reason of the fact that the opposition did not succeed in relation to three (3) of the contested services. Awards of costs in proceedings are governed by Annex A of Tribunal Practice Notice (“TPN”) 2 of 2016. Applying said TPN as a guide, I award costs to the opponent on the following basis:

Official fee:	£100
Filing the Notice of opposition and reviewing the counterstatement :	£200
Total:	£300

66. I order Soul Spirits Ltd to pay to Haecky Holding AG the sum of **£300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of February 2021

**Denzil Johnson,
For the Registrar**