

O/381/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3415587

BY ELLIOT HORNER

TO REGISTER THE TRADE MARK:



IN CLASS 32

AND

OPPOSITION THERETO UNDER NO. 419018

BY

WINSTON R. CUTHBERT

Background and pleadings

1. Elliot Horner (“the applicant”) applied to register the trade mark below in the UK on 22 July 2019.



2. It was accepted and published in the Trade Marks Journal on 11 October 2019 in respect of the following goods:

Class 32 Ale; Ales; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Beverages (Non-alcoholic -); Flavored beer; Flavored beers; Flavoured beers; India pale ales (IPAs); IPA (Indian Pale Ale); Lager; Lagers; Low-alcohol beer; Malt beer; Non-alcoholic beer; Non-alcoholic beers; Non-alcoholic beverages; Stout; Stouts.

3. Winston R. Cuthbert (“the opponent”) opposes the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the trade mark UK00003274647, which is registered as a series of three itemized below (and which I will mainly refer to in its single word form). The mark was filed on 2 December 2017 and registered on 23 March 2018.

Can A Beer

Canabeer

CanABeer

4. The Opponent's mark is registered for the following goods which are relied upon in this opposition:

Class 32 Beer; Beer-based beverages; Beers; Beers enriched with minerals.

5. In their TM7, the opponent argues that the respective goods are identical or similar and that the marks are similar.
6. The applicant filed a TM8. In their counterstatement, they deny any likelihood of confusion between the marks, indicating that the marks are different visually and conceptually. They further assert that ““Can A Beer” is not a trading company” – and therefore the consumer would not be put in the position of mixing the two brands up – whereas the applicant's mark is linked to its trading company and therefore they have more to lose. These latter points are not relevant. The opponent's mark had not been registered for five years or more on the date on which the opposed application was filed and therefore there is no requirement to prove use of the earlier mark as per section 6A of the Act. My assessment will be a notional one of the marks and goods as registered/applied for.
7. Both parties filed documents which they classed as evidence supported by witness statements.
8. The applicant provided a written submission, whereas the opponent did not.
9. The applicant is represented by Wilson Gunn, whereas the opponent is unrepresented.

Evidence

10. The opponent, Winston R. Cuthbert, filed a signed witness statement along with four exhibits, WRC1-4. The witness statement is undated, but all the exhibits refer to it as having been dated 13 August 2020.

11. In the witness statement, the opponent sets out some arguments as to likelihood of confusion which I refer to later in this decision, and states that “both trademarks exist within the small and nascent cannabidiol (CBD)-infused beer market.”
12. The remainder of the witness statement relates to what is described as an attempt to reach a settlement. This is not relevant to the matter at hand i.e. my assessment of the marks and goods as registered/applied for, so I say no more about it.
13. The applicant’s witness statement is from Elliot Horner, signed and dated 24 February 2021, with exhibits numbered as References 1A-1C.
14. Exhibit 1A shows examples of beer names that are the same or similar to the opponent’s trade mark.
15. Exhibit 1B contains examples of similarly-named brands operating in various sectors that the applicant contends are distinguishable due to differences in “type face” and design.
16. Exhibit 1C contains a list of “CBD drinks companies in the UK” that the opponent can immediately think of. This exhibit attempts to counter the opponent’s claim in its TM7 and witness statement that the cannabidiol (CBD)-infused beer market is “small and nascent”. However, the size of the market for which the goods are registered/applied for does not have any bearing on my deliberations in relation to the marks and the goods before me.

DECISION

17. Section 5(2)(b) of the Act reads 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.”

18. 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, international trade mark (UK) a European Union 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.”

19. Given their respective filing dates, the trade mark upon which the opponent relies qualify as an earlier trade mark as defined above.

Section 5(2)(b) – case law

20. Although the UK has left the EU, section 6(3)(a) of the European Union (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.

21. 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

22. The goods in question are as follows:

Opponent's goods	Applicant's goods
<u>Class 32</u> Beer; Beer-based beverages; Beers; Beers enriched with minerals.	<u>Class 32</u> Ale; Ales; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals;

	Beverages (Non-alcoholic -); Flavored beer; Flavored beers; Flavoured beers; India pale ales (IPAs); IPA (Indian Pale Ale); Lager; Lagers; Low-alcohol beer; Malt beer; Non-alcoholic beer; Non-alcoholic beers; Non-alcoholic beverages; Stout; Stouts.
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23. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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.”

24. 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 uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

- (e) 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;
- (f) 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.

25. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, the General Court (“GC”) 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.”

26. 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 the responsibility for those goods lies with the same undertaking.”

27. I will now make my comparison with reference to the applicant’s goods.

28. “Beer”, “Beer-based beverages” and “Beers” are identical to the opponent’s “Beer”, “Beer-based beverages” and “Beers”.

29. “Ale”, “Ales”, “Beers enriched with minerals”, “Flavored beer”, “Flavored beers”, “Flavoured beers”, “India pale ales (IPAs)”, “IPA (Indian Pale Ale)”, “Lager”, “Lagers”, “Low-alcohol beer”, “Malt beer”, “Non-alcoholic beer”, “Non-alcoholic beers”, “Stout” and “Stouts” are types of beer and are therefore *Merici* identical to the opponent’s “Beer” in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
30. “Beverages (Non-alcoholic -)” and “Non-alcoholic beverages”, include and cover “Non-alcoholic beer” and “Non-alcoholic beers” as assessed above. In the absence of any fall-back specification, the same outcome applies.
31. “Beer and brewery products” are *Merici* identical to the opponent’s “Beer” in that goods designated by the earlier mark are included in a more general category designated by the trade mark application.
32. “Beer-based cocktails” are *Merici* identical to the opponent’s “Beer-based beverages” in that the goods designated by the trade mark application are included in a more general category designated by the earlier mark.
33. “Beer wort” is the liquid produced during the beer brewing process which is then fermented to make beer. While being potentially similar to the opponent’s “Beer”, it differs from beer in that it is part of the brewing process, whereas beer is the finished product. Its purpose is to form an essential part of the beer brewing process, while beer’s purpose is to be drunk. The users differ – brewers and drinkers of beer. The trade channels also differ to the extent that beer is an end product sold through pubs, off licences and supermarkets, while beer wort, as a brewing ingredient, might be sold to home brewers through off licences and supermarkets, but stocked separately from beer, or it could be sold to professional brewers through wholesalers. There is a limited degree of competition where a member of the public makes a choice between purchasing the end product or brewing their own beer. While it does not always follow that an ingredient for a product and the product itself are complementary, in this

case, beer wort is indispensable to beer and is not used in any other context. It is also likely that the average consumers may think the responsibility for those goods lies with the same undertaking in that both are produced by breweries. Overall, I find these goods to be of medium similarity.

The average consumer and the nature of the purchasing act

34. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services 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.”

35. In respect of beer, even the non-alcoholic variety, the average consumer will be an adult member of the public. The average transaction will not be one where high cost is a dominant factor during the purchasing process, but the average consumer may give due consideration to other factors such as the type of beer being purchased. Overall, I consider that a medium degree of attention will be paid when the goods are being purchased.

36. The goods may be obtained as a self-serve consumer item on the shelves of a supermarket or off licence, or their online equivalent, or they may be acquired in pubs, bars or restaurants. In a primarily self-service retail

environment, although there may be the occasional verbal enquiry regarding the goods, visual considerations will be overwhelmingly to the fore. Even where the customer is served their beverages, visual considerations will predominate in the form of use of a drinks menu, looking at a beer pump, or directly scrutinising the goods on shelves or in glass-fronted cabinets. Consequently, while an aural component in the purchasing process is not ruled out, visual factors are more important.

37. In respect of beer wort, the average consumer will be a professional or amateur brewer. While they will give consideration to the type, flavour and other attributes that will result in the brewed beer, the goods are not in a very high price bracket except where a professional brewer is placing a very large order. Overall, the level of attention paid by the average consumer during the purchasing process will be medium.

38. Whether purchasing directly from physical premises or via a website, the purchasing process will be dominated by visual considerations. In either case, advertising material could be reviewed. Only in a minority of cases will an aural component - word-of-mouth - be a factor, although I will not rule out the significance of the aural aspects completely.

Comparison of the trade marks


39. 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 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.”

40. 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.

41. The respective trade marks are shown below.

Opponent’s trade mark	Applicant’s trade mark
Can A Beer	
Canabeer	
CanABeer	

42. In its witness statement, the opponent contends that, “There is a likelihood of confusion between *Canabeer*® and *Cannabrew* because both words are used to identify the same product, a cannabidiol (CBD)-infused beer. In the UK, beer and brew are often used interchangeably to refer to beer and as such, *Canabeer*® and *Cannabrew* are likely to be confused by customers and the market alike.” They also state that the words “Cana” and “Canna” are phonetically identical and are the most important parts of the words that they form part of “due to its reference to the product’s core ingredient and its commercial market.”

43. The opponent also points out in their witness statement, that the opponent’s uncle misspells the word “Cannabrew” as “Canabrew” in Exhibit WR4 as a

way of trying to show that there is potential for confusion between the marks. However, the relevant tests are whether the marks as registered/applied for are visually, aurally, or conceptually similar, not whether or not one might mistype them.

44. The applicant contends that the marks are visually dissimilar. They further argue that the marks are phonetically dissimilar: “There is no possibility that the -BEER / -BREW endings of the respective marks will not be clearly pronounced or lost within the marks as a whole ... the clear phonetic difference between BREW and BEER will be pronounced and noticed.”
45. The applicant also considers the marks to differ conceptually: “It is clear that Can A Beer and CanABeer are more likely to be perceived as referring to a can of beer than the cannabis content of the beer and so Canabeer must be interpreted as providing the same perception. Therefore, the Later Mark is conceptually different from the Earlier Mark, with the perception of the CANNA- element of the Later Mark as a reference to cannabis, being reinforced by the Device element of the Later Mark.”
46. I note the applicant’s Exhibit 1B with its examples of similarly-named brands that they contend operate in the same sectors and are distinguishable due to differences in “type face” and design. However, I must make my own assessment based on the established criteria and the particular marks before me, which I do below.
47. The applicant’s mark is a figurative mark containing the word “CANNABREW” in bold block capitals. To the left of the word is a round device with a black background containing a vertical black and white stripe which is crossed over near the bottom by a horizontal black and white stripe, with two separate diagonal stripes going through the same crossover point. The device is taller than the word, but the word is significantly wider. The word carries more weight than the device in forming the overall impression given that it is bigger than the device and one’s eye is drawn to the word

element in that it can be read. To the right of the word are the letters “TM” in very small text which, given their size and likely perception as shorthand for “trade mark”, are to be considered negligible.

48. The opponent’s plain word mark, in a series of three formats, “Can A Beer”, “Canabeer” and “CanABeer”, has no other visual elements that contribute to the overall impression of the mark.
49. Visually, the opponent’s mark, being a word mark, can notionally be presented in any case, so could be presented as “CANABEER”. This is undoubtedly the case with the “Canabeer” earlier mark which I focus upon. It shares the same first three letters with “CANNABREW”. The remaining letters of “CANABEER”, “A”, “B”, “E” and “R” are all present in the remainder of “CANNABREW”, albeit the opponent’s mark has a single “N”, while the applicant’s mark has a double “N”. The applicant’s mark contains a reasonably sized device, while there is no device in the applicant’s mark. Overall, I find the marks to be of medium visual similarity.
50. Aurally, the opponent’s mark would be pronounced as “Cannah-beer”. The applicant’s mark would be pronounced “CANNAH-BREW”. While at least the first parts are phonetically identical, the endings are different. The endings do, though, have a “B” sound at the start of the final syllable. Overall, I find the marks to be higher than a medium degree of similarity, but not of the highest degree.
51. Conceptually, the earlier mark conveys the single suggestive concept of canned beer as in a can of beer.
52. The applicant’s mark could convey more than one concept. First and foremost is the notion of a “brew” in a can. I note the applicant’s statement in its submission that “The strongest argument of the Opponent is that brew is another word for beer. The Opponent has not produced any evidence to support the assertion that in colloquial English the words are interchangeable

and are used interchangeably. In fact, there is an argument that the word brew is equally likely, if not more likely, to be used in reference to tea.” I would agree that a common usage of the word “brew” as a noun is as in “a cup of tea”, but in the context of the goods that are being assessed, I consider that “brew” will be taken to mean a brewery’s particular beer. In that sense, the two marks share the same concept which would be seen by a significant proportion of the relevant public. A much smaller group of people would note the double “N” spelling in “CANNABREW” and that it shares the same first six letters as the word “cannabis”, thus seeing the concept of a cannabis beer for that mark. The consumer may also derive the added, but less conceptually significant, message of Britishness from the applicant’s device due to the Union Jack-style format of the stripes.

53. Where the relevant public simply see the primary concept of the two marks as a can of beer, I find the marks to be highly similar conceptually, even for those consumers that pick up on the minor concept of Britishness in the applicant’s device. Where a proportion of the relevant public would detect the concept of cannabis in the applicant’s mark, there is a conceptual difference.

Distinctive character of the earlier mark

54. 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-0000, paragraph 49).

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

55. 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.

56. I must make an assessment of the inherent distinctive character of the earlier mark.

57. The mark, in its series of three, “Can A Beer”, “Canabeer” and “CanABeer”, would be understood by the average consumer so as to interpret it as a play on the words “a can of beer”. As such, while it would be seen as suggestive or allusive of the relied upon goods for which the opponent’s mark is registered, the play on words gives it some distinctive character, one which in my view is not the lowest of degrees. However, the word configurations in the mark are not so novel as to warrant a finding of a medium or high degree of distinctive character. I find that the mark is inherently distinctive to slightly lower than a medium degree.

Likelihood of confusion

58. 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 or 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 services 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 they have retained in their mind.

59. 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 recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is

different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

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

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

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

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

of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

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

61. I note the applicant’s Exhibit 1A which is cross-referenced in its submission as “evidence of the state of the cannabis beer marketplace and the existence of beers under the branding of CANABEER, CANNABEER, CANNA BEER, and CANNABIA, none of the which are the Opponent’s product.” While this evidence might indicate that other traders have happened upon the type of mark construction that uses the prefix “can(n)a”, there is no evidence about the use or significance of these traders in the marketplace. Thus, there is nothing to show what significance or impact this will have had on the average consumer and whether they are able to distinguish, or have become accustomed to distinguishing between, such forms of use. Such evidence is not in my view material.

62. I consider that a significant proportion of the average consumers would see the two marks straightforwardly as denoting canned beer, with a much smaller group of consumers picking up on the allusions to cannabis in the applicant’s mark.

63. The respective endings of the marks are different – “-beer” and “-BREW” and the applicant’s mark contains a device, while the applicant’s mark does not. The average consumer will notice these differences and there is therefore no likelihood of direct confusion in this case.

64. While noticing the differences between the marks, a significant proportion of the average consumers could still consider them to be brand variations.

Taking the configuration of the opponent's mark which is the closest to that of the applicant - "Canabeer" - it is entirely possible that the average consumer would mis-recall one or other of the marks as having a single or double "n" whereby they would consider the marks' prefixes to be identical visually and phonetically. It is also possible that those who see the concept of cannabis by virtue of the double "n" will also impute that to the earlier mark, mis-recalling it as also having a double "n". Alternatively, even if that smaller group of people who pick up on the concept of cannabis were to see that as point of difference and therefore a reason not to be confused, it does not matter. This is because a significant proportion of the relevant public will be confused¹.

65. That significant proportion of the relevant public referred to previously as simply seeing two marks that denote a can of beer, will, through imperfect recollection, see the marks as having the identical prefix and would regard the "-beer" and "-brew" brands as emanating from the same or linked undertakings. I therefore conclude that there is a likelihood of indirect confusion in this case, even for those goods that I have classed as of medium similarity. The presence of a device in one of the marks, which some may see as denoting Britishness, is not a bar to my finding of indirect confusion. I consider that the average consumer, while noting its inclusion, will still see the commonality that does exist between the marks as indicating the same or shared economic origin.

CONCLUSION

66. The opposition has succeeded in full. Subject to appeal, the application will be refused.

COSTS

67. The opponent has been successful in its opposition. The opponent is unrepresented and no Cost Pro Forma has been received, so they are entitled

¹ *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch)

only to the official fee for filing the opposition. I award the opponent the following:

Official fees:	£100
Total:	£100

68. I order Elliot Horner to pay Winston R. Cuthbert the sum of £100. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of May 2021

JOHN WILLIAMS
For the Registrar