

O/0505/26

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00004011107
BY SOHO WHISKY CO LTD
TO REGISTER:



AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 447731
BY DONATEL FRERES LIMITED

BACKGROUND AND PLEADINGS

1. On 05 February 2024, Soho Whisky Co LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision, in the UK. The application was accepted and published in the Trade Marks Journal on 23 February 2024 in respect of the following goods:

Class 33: *Whisky.*

2. On 23 May 2024, the application was opposed by Donatel Freres Limited (“the opponent”) based upon Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).

3. Under both Section 5(2)(b) and Section 5(3), the opponent relies on the following trade mark:

UK00003994045

SOHO WHISKY CLUB

Filing date: 16 January 2024

Registration date: 17 May 2024

The opponent relies on the goods and services for which the mark is registered, namely:

Class 33: *Whisky; Whiskey.*

Class 34: *Tobacco and tobacco substitutes; cigarettes and cigars; electronic cigarettes and oral vaporisers for smokers; smokers' articles; matches.*

Class 35: *Advertising; business management; business administration; office functions.*

Class 43: Services for providing food and drink; temporary accommodation.

4. By virtue of its earlier filing date, the trade mark relied upon by the opponent is an “earlier mark” in accordance with Section 6 of the Act. The opponent’s earlier mark had not been registered for more than five years at the filing date of the contested mark, and, as such, it is not subject to the use conditions under Section 6A of the Act.

5. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the marks are similar and the goods and services are identical or similar.

6. Under Section 5(3) the opponent claims that its business has been operating for 13 years and that the earlier mark benefits from a reputation in relation to whisky, tobacco products and the services of providing food and drink in a club setting. The opponent also claims that use of the applied-for mark will take unfair advantage of, or be detrimental to, the distinctive character and reputation of the earlier mark. It also claims that the similarity between the marks is such that the relevant public will believe that there is an economic connection between them.

7. Lastly, under Section 5(4)(a), the opponent relies on the sign ‘SOHO WHISKY CLUB’ which it claims to have used throughout the UK since 2012 in relation to the sale and distribution of whisky and other alcoholic beverages and associated retail services, as well as hospitality services such as providing food and drink in a club setting.

8. The applicant filed a defence and counterstatement denying the claims made. In particular, the applicant contends that the figurative elements of the applied-for mark and the difference between the verbal elements ‘CO’ and ‘CLUB’ in the respective marks are sufficient to avoid confusion. In this connection, the applicant states that consumers are generally aware of the differences between product-based and membership-based entities, reducing the chance of mistaking one for the other. Further, the applicant contends that the parties operate in different segments of the market because the applicant is a producer of whiskey whilst the opponent is a membership club that acts as a whiskey broker. Lastly, the applicant relies upon the following arguments: (a) that there has been concurrent use without objection, (b) that

“Soho Whisky” is a descriptive term that refers to both a location and a product type and cannot be monopolised by the opponent, (c) that the applicant has adopted and used its name in good faith and with no intention to mislead or trade off the goodwill of Soho Whisky Club.

9. The opponent is represented by Jane McGill. The applicant is not professionally represented, acting as a private litigant.

10. Only the opponent filed evidence during these proceedings. Neither party requested a hearing, nor did they file submissions in lieu of a hearing. I make this decision having taken full account of all the papers, referring to them as necessary.

Relevance of EU Law

11. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, Section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

EVIDENCE

12. The opponent’s evidence came in the form of three witness statements from the following individuals: Malcolm George Mullin, Nicholas Morgan, and Tony McGeever.

13. Mr Mullin is the director of the opponent’s company; his witness statement is dated 13 February 2025 and is accompanied by 8 exhibits (MM1 – MM8).

14. Mr Morgan is the founder member of the opponent’s business; his witness statement is dated 17 February 2025 and is accompanied by one exhibit (NM1).

15. Mr McGeever is a former employer of the club run by the opponent; his witness statement is dated 17 February 2025 and is accompanied by one exhibit (TM1).

16. Part of the evidence filed by the opponent talks about how the applicant's brand was launched by a competing business that had previously attempted to purchase the opponent's business; this evidence is provided in support of the claim that the adoption of the applied-for mark is an attempt to misappropriate the reputation and goodwill of the opponent. Whilst this evidence is noted, it is wholly irrelevant in the context of the grounds pleaded, which do not include bad faith. Likewise, other parts of the opponent's evidence relate to pre-action correspondence exchanged between the parties – this, also, is irrelevant in the context of the grounds pleaded which seek to establish likelihood of confusion, damage to reputation and passing off. Accordingly, I will say no more about this evidence.

17. The rest of the evidence consists of insufficiently detailed claims about the opponent's reputation or relates to instances of confusion. I will return to this evidence below insofar as it is necessary to resolve these proceedings.

DECISION

Section 5(2)(b)

18. 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.”

19. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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; and

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

Comparison of goods

20. The competing goods are as follows:

The applicant's goods	The opponent's goods
Class 33: <i>Whisky.</i>	Class 33: <i>Whisky; Whiskey.</i>

21. Both parties' goods consist of whisky. The goods are self-evidently identical.

22. For the sake of completeness I should say that whilst I bear in mind the applicant's submission that the parties operate in different segments of the market, namely the applicant in the business of bottling and retailing whisky, and the opponent in that of a private members' club and whisky brokerage, the particular segment of the market in which the parties have so far chosen to trade is irrelevant for the purpose of the

notional assessment I need to make,¹ which is based on the goods as they are registered and applied for, which in this case are self-evidently identical.

Average consumer

23. 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 goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

24. In *Iconix Luxembourg Holdings* (cited above), the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion,

¹ See *Roger Maier v ASOS* [2015] EWCA Civ 220 at paragraphs 78 and 84 and *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06

by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

25. The average consumer of the parties' whiskey will be a member of the general public of drinking age or a business user.

26. The goods at issue will typically be sold through a range of retail outlets, such as supermarkets and off licences, and their online equivalents, where the goods will be displayed on shelves, from which they will be self-selected by consumers. A similar process will apply to websites, where consumers will select the goods after viewing images and information displayed on a webpage. Accordingly, visual considerations would dominate. Goods such as these are also sold in hospitality settings such as in restaurants, bars, nightclubs and public houses. In these environments, there may be an aural component to the selection process, such as requests to bar and waiting staff. However, even where the goods are ordered in this way, the selection process would still be in the context of a visual inspection of the goods on drinks menus, for example, prior to the order being placed. Therefore, in general, the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.

27. The goods may also be purchased by the owners of businesses such as, for example, bars, public houses, restaurants and nightclubs. For these consumers, the goods are likely to be frequent purchases for the ongoing operation of the business. Businesses are likely to purchase the goods from distributors and wholesalers, as well as through online channels. In these circumstances, the goods are likely to be purchased after a visual inspection of the product, or after viewing information in

brochures or on the Internet. As such, the purchasing process will be largely visual in nature. However, businesses may also engage in discussions with salespersons about the products. Therefore, I do not discount aural considerations entirely.

28. As regards the level of attention deployed by the consumer during the selection of the goods, for the most part, the goods will be moderately priced and are likely to be purchased reasonably regularly. Members of the public will consider factors such as price, alcoholic content and taste, paying a medium degree of attention. Business users will be acutely aware that the goods they are selecting will be consumed by their customers, and will also consider the negative impact of choosing the wrong goods for their business, all of which will attract an above medium degree of attention. Having said that, when different groups of consumers are targeted (i.e. the general public and businesses), the likelihood of confusion will be assessed in relation to the perception of the part of the public displaying the lower degree of attentiveness, as it will be more prone to confusion.²

Comparison of marks

29. 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.”

² *Ergo Versicherungsgruppe v OHIM — Société de développement et de recherche industrielle (ERGO)*, T-220/09

30. 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. The respective marks are shown below:

The applied-for mark	The earlier mark
	<p>SOHO WHISKY CLUB</p>

31. The earlier mark consists of the words 'SOHO WHISKY CLUB'. The words 'WHISKY CLUB' are plainly non-distinctive because the word 'CLUB' will be perceived as referring to the type of business that offer the goods whereas the word 'WHISKY' will clearly indicate the type of goods that the club offers. Consequently, the word 'SOHO' will play the greater role in the overall impression. In this connection, I accept that 'SOHO' is a district in London, however, (1) there is no evidence that a significant proportion of the average consumer of the goods will recognise 'SOHO' as a geographical location and (2) even if the average consumer was to be aware that 'SOHO' is a geographical location, there is no evidence of any link between 'SOHO' and whisky goods³, which means that 'SOHO' is, at least, moderately distinctive for these goods.

32. The applied-for mark consists of the words 'SOHO WHISKY CO' written in a handwritten font, with the word 'SOHO' presented above the word 'WHISKY' and the

³ Newport Creek, BL-O-223/16

latter presented above the word 'CO'. The words 'SOHO WHISKY CO' are presented against a yellow rectangular background and next to a figurative element made up of three shapes consisting of two vertical rectangles and a semicircle. Whilst the figurative element and the stylisation of the letters have a visual impact, I consider that the rule of thumb that words speak louder than devices applies in this case as the stylisation is minimal and the figurative element will be perceived as ornamental. Accordingly, whilst the figurative element and the stylisation contribute to the overall impression, the distinctive and dominant component of the application is the verbal element 'SOHO WHISKY CO'.

Visual similarity

33. Visually, the verbal elements 'SOHO WHISKY CLUB' in the earlier mark and 'SOHO WHISKY CO' in the application coincide in the first two words 'SOHO WHISKY' and the first letter 'C' of the third word which are identically presented at the beginning of both marks. The marks differ in the letters 'LUB' in the earlier mark and 'O' in the application, as well as in the presence in the application of the figurative element, the background and colour as well as the stylisation of the letters, none of which has any counterpart in the earlier mark. Bearing in mind that (a) the differentiating elements of the marks are of a weakly distinctive character, because the figurative elements are ornamental, whereas the verbal elements 'CO' and 'CLUB' will be perceived as referring to the type of business which uses the marks, and (b) the coinciding verbal elements of the marks are the most distinctive elements, I consider that the level of similarity between the marks is medium to high.

Aural similarity

34. Aurally, 'SOHO WHISKY CLUB' and 'SOHO WHISKY CO' will be articulated in the usual way. The first two words of the marks and the first letter of the third word are aurally identical. The letters 'LUB' in the earlier mark and 'O' in the application will be a point of aural difference. I bear in mind that the beginning of marks tend to make

more of an impact than the ends.⁴ In my view, the marks are aurally similar to a high degree.

Conceptual similarity

35. Conceptually, although I have mentioned that there is no evidence of 'SOHO' being a famous location which will be known by the average consumer of the goods at issue, for the sake of completeness I will proceed on the basis that there are two groups of consumers. For a significant group of consumers who will understand 'SOHO' as a geographical location, the marks will convey the same identical concept. Conversely, for another significant group of consumers who are not aware of that location, 'SOHO' will be perceived as invented and will convey no concept.

36. Although the marks contain the additional words 'CLUB' and 'CO' as I have already said, they will be perceived as descriptive on the basis that they refer to the type of business that uses the signs, namely a club and a company, 'CO' being a well-known abbreviation for 'company'. Consequently, whilst these elements of the marks convey different concepts, first they are non-distinctive concepts and secondly, even if they refer to different type of business, they are similar at a high level, insofar as they both refer to the concept of a business structure. Accordingly, for the first group of consumers the marks are conceptually identical insofar as the only distinctive concept the marks convey is that of the same geographical location; for the second group of consumers the marks are conceptually neutral insofar as 'SOHO' will be perceived as invented.

Distinctive character of the earlier mark

37. 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

⁴ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

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).”

38. Registered 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. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

39. The word ‘SOHO WHISKY CLUB’ in the earlier mark will be perceived as referring to a whisky club located in ‘SOHO’ (for those who are aware that Soho is a geographical location) or called Soho (for those who will perceive ‘Soho’ as invented). Either way, having found that there is no evidence of any link between ‘SOHO’ and whisky goods, even in relation to those consumers who are aware that Soho is a geographical location, the mark is distinctive to a medium degree, the other elements of the mark ‘WHISKY CLUB’ being descriptive and not materially increasing that level of distinctiveness. Indeed, for those consumers who will perceive ‘Soho’ as invented, the mark will be distinctive to a high degree.

40. As I have anticipated, whilst the opponent has filed some evidence, it is not helpful. I say this because first, most of the evidence does not relate to the opponent's use of the earlier mark, but rather to the applicant's intention when filing the application, as well as to pre-action correspondence exchanged between the parties and to instances of confusion. Secondly, even when the evidence touches upon the issue of reputation, it is wholly insufficient to establish the requirement for use, reputation or enhanced distinctiveness, because it lacks fundamental details, including turnover figures, marketing and promotional investment, intensity and geographical extent of use as well as market share. In this connection, the only evidence which relate to reputation is contained in the witness statement of Malcolm G. Mullin at paragraph 2 which states as follows:

"I established the Club approximately 13 years ago and have since built a strong reputation within the whisky industry. We are known for our expertise in single malt, single cask whisky, and we go to great lengths to select high-quality casks, offering tastings and arranging purchases for our members. See exhibit MM1 supporting our establishment and reputation"

41. MM1 consists of an undated screenshot from what appears to be a customer review which is as follows:



Qype User (mrfris...)

London, United Kingdom

@ 46 ★ 84 📷 49

★★★★★ Apr 30, 2012

📷 1 photo

Scotch whisky enthusiasts look no further! Situated above Old Compton Street stalwart The Vintage House, the Soho Whisky Club (opened Dec 2011) boasts a whisky list of over 300 bottles, including a full range of Glenfarclas Family Casks!

The light, airy clubroom (with what can only be described as a whisky feature wall) seats about 15 people, and makes a great little bolthole to escape the craziness of Soho and relax with a couple of choice malts.

As a non-smoker I wasn't particularly turned on by the humidior, but cigar enthusiasts might also note that the club offers a decent range of cigars, and has a roomy and heated cigar terrace out the back to smoke them.

It is a private members' club, so you'll need to join up before you're allowed to buy drinks there however once you've become a member you get access to the exceptionally priced selection (starting at £3.95 a dram a far cry from some of the more prominent whisky establishments), as well as monthly members' tastings. You can sign in up to 3 guests, and if whisky isn't to their taste you can also bring up bottles of wine or champagne from the shop downstairs (subject to a modest corkage fee).

The esoteric world of single malts can be fairly daunting to a newcomer, however this would be a perfect place to dip your toe in and get started.



42. Leaving aside the fact that the review appears to have been written 14 years prior to the relevant date of 05 February 2024, as I have said, this evidence comes nowhere near establishing enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use.⁵ It follows that the evidence failing to establish enhanced distinctiveness, I will proceed on the basis of the inherent position, i.e. that the earlier mark is inherently distinctive to a medium or high degree.

⁵ T-807/16, N & NF TRADING / NF ENVIRONNEMENT

Likelihood of confusion

43. 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, including that a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

44. Confusion can be direct or indirect. In *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This

may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)."

45. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

46. It is not sufficient that a mark merely calls to mind another mark: *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17. This is mere association not indirect confusion.

47. Earlier in this decision I found that:

- The applicant's mark and the opponent's earlier mark are visually similar to a medium to high degree, and aurally similar to a high degree. Conceptually, for a group of consumers the marks are conceptually identical insofar as the only distinctive concept the marks convey is that of the same geographical location;

for another group of consumers, the marks are conceptually neutral insofar as 'SOHO' will be perceived as invented.

- The parties' goods are identical.
- The average consumer is a member of the general public or a business user who will select the services mainly visually, with a medium or higher than medium (but not high) degree of attention.
- The earlier mark is inherently distinctive to a medium or high degree depending on whether Soho is perceived as a geographical location or an invented word. The evidence filed by the opponent is insufficient to establish that the distinctiveness of the earlier mark has been enhanced to any material extent.

48. In my view, given the similarity between the verbal elements 'SOHO WHISKY CLUB' and 'SOHO WHISKY CO' in the respective marks, but bearing in mind the visual impact created by the figurative elements in the application, it would be easily foreseeable for the consumer to indirectly confuse the marks when used in relation to identical goods paying a medium (or even above medium) degree of attention. In my view, in those circumstances confusion will arise from consumers misremembering or mis-recalling the elements 'SOHO WHISKY CLUB' and 'SOHO WHISKY CO' and perceiving the differences between the marks as indicating a logo version of the earlier mark rather than having independent trade mark significance, giving rise to indirect confusion. For the sake of completeness, I should say that even if both marks were perceived as a Whisky business in Soho, it would not be considered coincidental because there is no obvious link between SOHO and whisky.

49. There is a likelihood of indirect confusion.

50. As it will be recalled, one of the arguments put forward by the applicant is that it applied for the mark in good faith. For the sake of completeness, I should say that I have disregarded such argument because the applicant's intentions are extraneous to the perception of the average consumer and, as such, cannot be taken into account

when assessing the likelihood of confusion. Likewise, whilst I note the applicant's argument about honest concurrent use, since the applicant has not filed any evidence of use, the argument falls away simply because no concurrent use has been established.

Section 5(4)(a) and 5(3)

51. I can deal with those grounds very briefly. I have already commented on the evidence filed by the opponent and I found that it comes nowhere near establishing enhanced distinctiveness, which refers to an increased recognition and capacity of a trade mark to identify the goods or services for which it is registered as coming from a particular undertaking as a result of extensive use. Further, whilst there is evidence of a customer review, it is dated 14 years prior to the relevant date and there is nothing further which shed some light on the extent of the opponent's use; in addition, the opponent's use appears to relate to the running of a club, rather than to the marketing of the registered goods under the earlier mark, i.e. whisky. It follows that since the evidence does not even establish use of the earlier mark in relation to the registered goods, it cannot establish reputation or goodwill in the same mark/sign which are concepts based on use.

OUTCOME

52. The opponent's claims succeeds under Section 5(2)(b) and the application will be refused registration.

COSTS

53. The opponent has been successful and is, therefore, entitled to a contribution towards its cost based upon the scale published in Tribunal Practice Notice 1/2023. In the circumstances, I award the opponent the sum of £1,200, calculated as follows:

Preparing the notice of opposition and considering the counterstatements: £500

Filing evidence and considering the evidence: £500
Official Fees: 200
Total: £1,200

54. I therefore order Soho Whisky Co LTD pay Donatel Freres Limited the sum of £1,200. This sum is to 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 15th day of June 2026

TERESA PINTO
For the Registrar