

O/0888/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003815842
BY BEAK FRIED CHICKEN LTD TO REGISTER:

BEAK

AS A TRADE MARK IN CLASSES 35 & 43

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 438638 BY DANIEL TAPPER

AND

IN THE MATTER OF APPLICATION NO. UK00003849951
BY DANIEL TAPPER TO REGISTER:



AS A TRADE MARK IN CLASSES 32 & 35

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 439467 BY BEAK FRIED CHICKEN LTD

BACKGROUND AND PLEADINGS

1. These proceedings involve cross-oppositions wherein Beak Fried Chicken Ltd (“BFC”) and Daniel Tapper (“DT”) brought actions against one another. I will summarise the relevant proceedings below, beginning with DT’s opposition on the basis that it was brought first.

DT’s opposition

2. On 2 August 2022, BFC applied to register the trade mark ‘BEAK’ in the UK (“BFC’s mark”) for the following services:

Class 35: Retail services relating to clothing, headwear, stationery and footwear, namely T-shirts, sportswear, hats, stickers and socks.

Class 43: Preparation of food, namely Fried chicken burgers, fried chicken wings and fried chicken strips.

3. BFC’s mark was published for opposition purposes on 14 October 2022 and, on 16 January 2023, it was opposed by DT. The opposition is brought under both sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (“the Act”) and is reliant upon the following marks:

The Beak Brewery

UK registration no. 3380292

Filing date 4 March 2019; registration date 24 May 2019

Relying on some goods and services only, namely:

Class 25: Articles of clothing; beanie hats; beanies; caps; caps [headwear]; casual clothing; casual shirts; clothing; hats; hooded sweatshirts; hooded tops; jackets; jackets [clothing]; knit tops; padded jackets; rain jackets; rugby tops; shirts; socks for men; sweatshirts; tee-shirts; trousers; t-shirts; windproof jackets.

Class 43: Bar and restaurant services; bar information services; bar services; bars; beer bar services; beer garden services; cafés; canteens; consultancy services relating to food; contract food services; food and drink catering; preparation of food and drink; providing food and drink; providing restaurant services; provision of food and drink; provision of food and drink in restaurants; pubs; restaurant and bar services; restaurant services; restaurants; services for providing drink; serving food and drink in restaurants and bars; wine bar services; wine bars.

("DT's first earlier mark"); and

The Beak Brewery

UK registration no. 3120818

Filing date 4 August 2015; registration date 30 October 2015

Relying on all services, namely:

Class 40: Brewing of beer.

("DT's second earlier mark").

4. In respect of both grounds of the opposition, DT seeks to oppose all of BFC's class 43 services and only some of its class 35 services, namely "retail services relating to clothing, headwear, and footwear, namely T-shirts, sportswear, hats, and socks".
5. Under the section 5(2)(b) ground of his opposition, DT claims that BFC's class 35 services are similar to his class 25 goods and BFC's class 43 services are identical/similar to his services in classes 40 and 43. Further, DT claims that neither 'THE' nor 'BREWER' in his own marks are distinctive meaning that the marks at issue consist of the same dominant and distinctive element. As such, DT argues that there exists a likelihood of confusion between the marks.
6. Under his section 5(3) ground, DT claims to enjoy a significant degree of reputation in both of his marks for those goods and services listed above. Given the close

similarity of the marks and the goods and services at issue, DT claims that the marks would be viewed as being connected. As a result, consumers would perceive a link between the parties' marks. Lastly, use of BFC's mark would take unfair advantage of, or be detrimental to the distinctive character or reputation of, DT's earlier marks.

7. BFC filed a counterstatement wherein it denied the claims made against it.

BFC's opposition

8. On 16 November 2022, DT applied to register the following trade mark in the UK:



("DT's opposed mark")

9. DT seeks registration of the above mark for the following goods and services:

Class 32: Beer; Beers; flavored beer; black beer; imitation beer; malt beer; beer wort; wheat beer; bock beer; saison beer; craft beer; flavored beers; craft beers; black beer [toasted-malt beer]; coffee-flavored beer; de-alcoholized beer; non-alcoholic beer; de-alcoholised beer; low-alcohol beer; beer-based beverages; barley wine [beer]; beer-based cocktails; barley wine [beer]; alcohol-free beers; extracts of hops for making beer.

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, books on brewing beer, beer mats, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets, sausages with ale, meat and ale pies, beer batters for frying, pickles, sauces, preserves, relishes, marinades, beer, beers, flavored beer, black beer, imitation beer, malt beer, beer wort, wheat beer, bock beer, saison beer, craft beer, coffee-flavored beer, de-alcoholized beer, non-alcoholic beer, de-alcoholised beer, low-alcohol beer, beer-based beverages, barley wine [beer], beer-based cocktails, extracts of hops for making beer, beer brewing ingredient kits consisting primarily of malt wort, hop concentrates and hopped wort, wines, spirits, cocktails.

10. DT's opposed mark was published for opposition purposes on 2 December 2022 and, on 1 March 2023, it was partially opposed by BFC. BFC's opposition is brought under section 5(2)(b) of the Act and is targeted at only those services underlined above. In bringing its opposition, BFC relies upon its own opposed mark, being that described at paragraph two above. BFC relies only upon the following services of its own mark:

Class 35: Retail services relating to clothing, headwear, stationery and footwear, namely T-shirts, sportswear, hats, stickers and socks.

11. BFC claims that the marks at issue are similar and cover similar services,¹ meaning that there would be a likelihood of confusion on the part of the public.

¹ It is noted that BFC's notice of opposition actually makes reference to similar goods. However, given that only services are at issue, I consider it reasonable to infer that this is a typographical error and is meant to be read as 'services'.

12. DT filed a counterstatement wherein he accepts that the word elements of the marks are identical (though he claimed that his own mark has a strong and distinctive visual identity) and that the services in class 35 are identical. However, DT sets out that he has opposed BFC's relied upon mark and while it is not expressly stated in the counterstatement, DT's position can be taken as an argument that BFC's mark should not proceed to registration. Therefore, BFC is not entitled to rely on its mark for the purposes of its opposition. Given the nature of his own opposition, this does not reflect the correct position, a point I will address further below.
13. Under the power given to the Tribunal under Rule 62(1)(g) of the Trade Mark Rules 2008, these proceedings were consolidated upon the filing of the counterstatement in BFC's opposition. This was communicated to the parties by way of written correspondence dated 23 May 2023.
14. DT is represented by Abion UK Limited (formerly Lane IP) and BFC is represented by Agile IP LLP. DT filed evidence in chief and also evidence in reply. While it did not file evidence, BFC elected to file written submissions during each of the evidence rounds.² No hearing was requested and only DT filed written submissions in lieu. This decision is taken after careful consideration of the papers.
15. 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.

² It is noted that the document filed in reply is headed with a reference to it being 'evidence in reply'. Despite this, the document is not evidence in reply. Firstly, the content of this document does not constitute evidence and, secondly, it is not accompanied with a sworn statement of truth (being a requirement for evidence).

EVIDENCE

16. DT's evidence came in the form of two witness statement in his own name. The statements are dated 24 July and 12 December 2023. The first statement was that filed in chief whereas the latter is that which was filed in reply. DT's first statement was accompanied by 11 exhibits, being those labelled Annex 1 to 11. His second statement was accompanied by a further 10 exhibits, being those labelled Annex A to J.

17. As above, BFC did not file evidence but did file written submissions during both rounds of evidence.

18. I do not intend to summarise the parties' evidence or submissions in full here. However, I confirm that I have taken all evidence and filed documents into account and will summarise them to the extent that I deem necessary below.

PRELIMINARY ISSUE

19. Before proceeding with the substance of my decision, I will discuss one point briefly. This has to do with DT's pleaded case in both oppositions and I raise it here because in his written submissions in lieu of a hearing, DT refers to the retail of stationery and stickers as applying to the section 5(3) ground. While noted, this is not reflected in the pleadings, which confirm the opposition is aimed at only some services in class 35. This is evidenced by his answers at question four of section A and question two of section B of his notice of opposition,³ which refer to details provided in the continuation sheet. The continuation sheet referred to confirms the following in relation to the section 5(2)(b) and 5(3) grounds, respectively:⁴

³ Being questions in relation to the goods and/or services against which the grounds are aimed. See pages 6, 8, 13 and 15 of DT's notice of opposition.

⁴ These images are taken from the continuation sheet dated 1 March 2023 and do not show the full tables provided. I have omitted the remainder of both tables as they relate to the other classes in DT's opposition which are not relevant to the point I make here. Further, it is noted that the reliance upon DT's second earlier mark is aimed only at BFC's class 43 services so I refrain from reproducing that information here.

1. This Opposition relates to the Applicants goods / services in Classes 35 & 43 shown below on the basis of the Opponents goods and services in Classes 25 & 43:-

The Beak Brewery	BEAK
Class 25 Articles of clothing; Beanie hats; Beanies; Caps; Caps [headwear];Casual clothing; Casual shirts; Clothing; Hats; Hooded sweatshirts ;Hooded tops; Jackets; Jackets [clothing];Knit tops; Padded jackets; Rain jackets; Rugby tops; Shirts; Socks for men; Sweatshirts; Tee-shirts; Trousers; T-shirts; Windproof jackets.	Class 35 Retail services relating to clothing, headwear, stationery and footwear, namely T-shirts, sportswear, hats, stickers and socks.

Section B Opposition based on S5(3)

The Beak Brewery	BEAK
Class 25 Articles of clothing; Beanie hats; Beanies; Caps; Caps [headwear];Casual clothing; Casual shirts; Clothing; Hats; Hooded sweatshirts ;Hooded tops; Jackets; Jackets [clothing];Knit tops; Padded jackets; Rain jackets; Rugby tops; Shirts; Socks for men; Sweatshirts; Tee-shirts; Trousers; T-shirts; Windproof jackets.	Class 35 Retail services relating to clothing, headwear, stationery and footwear, namely T-shirts, sportswear, hats, stickers and socks.

20. Clearly, the pleaded case of DT is that he has brought a partial opposition and I will proceed as such. This issue flows over to the opposition brought by BFC also. This is because, as set out above, DT appears to claim that BFC's mark should not proceed to registration so cannot, therefore, be relied upon. In the event that DT's opposition succeeds, a number of terms in BFC's specification will be struck out and BFC will not be permitted to rely on them. However, the nature of DT's partial opposition means that BFC's mark will survive for at least some services. This means that BFC will be able to rely on its mark regardless of the level of success achieved by DT in its opposition.

21. In addition to the above, I wish to also clarify that despite what DT states in his written submissions in lieu of a hearing, his second mark is not subject to a proof of use assessment. While it was open to BFC to make a request that DT prove use of the same, it did not do so.

MY APPROACH

22. As above, DT's opposition will have some impact upon BFC's opposition in that the level of success (if any) will determine what services BFC can rely on in its own opposition. Therefore, I will consider DT's opposition first. Even if that opposition succeeds in full, BFC's opposition will continue. I will discuss this point further upon the conclusion of my assessment of DT's opposition.

DECISION

DT's opposition

Section 5(2)(b): legislation and case law

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

“(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 or association with the earlier trade mark.”

24. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

25. 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), 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.”

26. Given their filing dates, DT’s earlier marks qualify as earlier trade marks under the above provisions. DT’s first earlier mark had not completed its registration process more than five years prior to the filing date for the BFC’s mark, meaning that it is not subject to proof of use pursuant to section 6A of the Act. While DT’s second earlier mark did complete its registration process more than five years prior to the filing date of BFC’s mark, BFC did not elect to put DT to proof of use for the same. This means that DT can rely upon all of the goods and services of both marks that he has highlighted in his notice of opposition.

27. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) (“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 great 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 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 and services

28. In its first filed written submissions, BFC made reference to the class 32 goods in DT’s specification. The pleaded case of DT is that he relies on only his goods in class 25 and services in classes 40 and 43. Therefore, such comments in respect of the class 32 goods are not relevant here and I will discuss them no further.

29. The competing goods and services are as follows:

DT’s goods and services	BFC’s services
<u>Class 25</u> Articles of clothing; beanie hats; beanies; caps; caps [headwear]; casual clothing; casual shirts; clothing; hats; hooded sweatshirts; hooded tops; jackets; jackets [clothing]; knit tops; padded jackets; rain jackets; rugby tops; shirts; socks for men; sweatshirts;	<u>Class 35</u> Retail services relating to clothing, headwear, and footwear, namely T-shirts, sportswear, hats, and socks. <u>Class 43</u> Preparation of food, namely Fried chicken burgers, fried chicken wings and fried chicken strips.

tee-shirts; trousers; t-shirts; windproof jackets.

Class 40

Brewing of beer.⁵

Class 43

Bar and restaurant services; bar information services; bar services; bars; beer bar services; beer garden services; cafés; canteens; consultancy services relating to food; contract food services; food and drink catering; preparation of food and drink; providing food and drink; providing restaurant services; provision of food and drink; provision of food and drink in restaurants; pubs; restaurant and bar services; restaurant services; restaurants; services for providing drink; serving food and drink in restaurants and bars; wine bar services; wine bars.

30. When making the comparison, all relevant factors relating to the goods and services 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 that:

⁵ DT’s submissions refer to these services being relevant only to the section 5(3) ground. As was the case with the preliminary issue discussed above, this is not reflective of the pleaded case as such services are, in fact, relied upon by DT.

“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”.

31. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

32. 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 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.”

33. 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.”

34. I have submissions from both parties in respect of the goods and services comparison. I can confirm that I have taken these into account and while I will not reproduce them in full here, I will, where necessary, discuss them further below.

Class 35

Retail services relating to clothing, headwear, and footwear, namely T-shirts, sportswear, hats, and socks.

35. Firstly, I wish to discuss the framing of the above term. While the term appears to suggest that the retail services cover clothing, headwear and footwear at large, this is not the case. I say this because the inclusion of the word ‘namely’ restricts the services to the retail of the goods that follow, being t-shirts, sportswear, hats and socks.

36. While DT’s specifications do not include retail services, his first earlier mark does include “articles of clothing”, “clothing” (both sufficiently broad to cover t-shirts and sportswear), “caps [headwear]”, “hats” and “socks for men” (technically being a type of footwear, especially when you consider that socks are specifically referred

to in BFC's term). Such terms can be said to cover the same goods that BFC's term covers the retail of. On this point, I refer to the case of *Oakley, Inc v OHIM*, Case T-116/06 wherein, at paragraphs 46-57, the GC 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. I also refer to the case of *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, wherein Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services vs. 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."

37. However, on the basis of the European courts' judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05, at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P, 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).

38. In light of the case law and principles outlined above, I am of the view that DT's retail services overlap in user and trade channels with BFC's goods. Clearly, a user looking to buy clothing goods will seek the retail of the same and, further, it is common in the trade for the producer of clothing goods to also offer its goods via its own retail services, be that online or via their own branded stores. The goods and services are plainly important to one another in the eyes of the consumers and they are likely to believe that the responsibility for the goods and the retail of the same lies with the same undertaking. The goods and services are, therefore, complementary in the way described by the case law (see *Boston*, cited above). While the goods and services differ in nature, method of use and purpose, the above overlaps are sufficient to give rise to a finding that they are similar to a medium degree.

Class 43

Preparation of food, namely Fried chicken burgers, fried chicken wings and fried chicken strips.

39. BFC submits that its class 43 services are precise and specifically relate to the preparation of chicken and the consumer would, therefore, recognise the difference between the services. BFC also makes the argument that just because beers can be used as an ingredient in fried chicken, they are not similar. While noted, such an argument has no real assistance to BFC's position. I say this because DT's first earlier mark's specification includes the term "preparation of food and drink". This service is sufficiently broad to cover the preparation of any type of food, including fried chicken burgers, wings and strips. As a result, I am of the view that BFC's above service falls within DT's service meaning that they can be said to be identical under the principle outlined in *Meric*.

40. Before proceeding, I wish to discuss DT's reliance upon his second mark, which stands registered for "brewing of beers". I see no reason why such a service would share any obvious degree of similarity with BFC's class 43 services (being those services against which this mark is targeted). Firstly, the services plainly differ in nature, method of use and purpose. Secondly, I appreciate that there is an association between beers and the provision of food and drink, DT's term is for the actual brewing of beers and not the retail or provision of beers to end consumers. On this point, I am of the view that the services differ in user (DT's term will be provided to business or professional users looking to have beers brewed on their behalf whereas BFC's term will be targeted at members of the general public). While there may be some overlap in trade channels (a large brewing company may operate its own pubs that offer food and drink), this is not sufficient to warrant a finding of similarity. Lastly, I do not consider that the services are complementary to one another and neither are they competitive in nature.

41. In order for there to be a likelihood of confusion under section 5(2)(b) grounds, there needs to be at least some degree of similarity between goods and services.

Given that there is no similarity between the services in DT's second earlier mark and the services of BFC, there can be no likelihood of confusion under the present ground. As a result, DT's reliance upon his second earlier mark under this ground must fail at this stage. Therefore, I will say no more about it.

The average consumer and the nature of the purchasing act

42. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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. (as he then was) 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.”

43. The goods and services at issue are ordinary consumer goods and services that will be selected by members of the general public at large. The class 25 goods will be available via general retailers, be that through their physical or online stores. The goods will either be displayed on shelves or selected after having viewed images of them on a webpage. The class 35 and 43 services are likely to be selected having considered, for example, promotional material (in hard copy or online) or signage appearing on the high street. For the goods and services, visual considerations will be an important part of the selection process. That being said, I do not discount aural considerations playing a part as a result of word-of-mouth recommendations or advice from sales assistants.

44. The goods and services will, for the most part, be selected on a frequent basis and will be relatively inexpensive selections. Having said that, some goods and services are likely to be towards the more expensive end of the scale (expensive designer clothes or high-end restaurants, for example). Such goods/services are also likely to be selected on a much less frequent basis. Regardless of the costs of the goods, the factors that the consumer will consider when selecting the goods will be relatively ordinary and will involve considerations as to fit, style and materials used. As for the services, these will be selected after the consumer gives consideration to factors such as stock, delivery methods and price of goods (for the class 35 services) and type of food sold, available reviews (be that online or via newspapers, for example) and hygiene ratings (for the class 43 services). Taking all of this into account, I am of the view that the selection process for the goods and services is likely to attract a medium degree of attention.

Comparison of the marks

45. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

46. 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.”

47. 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.

48. The respective trade marks are shown below:

DT's earlier mark	BFC's mark
The Beak Brewery	BEAK

49. I have submissions from both parties in respect of the comparison of the marks at issue. I do not intend to discuss these in full here but there is one point in respect of DT's submissions that I do wish to mention briefly. In his submissions, DT makes reference to, and reproduces, a number of different uses of his mark (I note that reference is made to where such use can be found in his evidence). These different uses include the word 'BEAK', solus, 'BEAK BREWERY', 'BEAK BREWING CO.' and the word 'BEAK' in conjunction with device elements, one of which being in line with the device used in his opposed mark. The submissions go on to assert that it is DT's case that use of 'BEAK' and 'BEAK BREWERY' that he has reproduced in his submissions must be held to be use of the 'THE BEAK BREWERY' which, as above, is DT's earlier mark as registered. It is not clear to me what exactly DT is arguing by making reference to these points.⁶ If it was the case that, in respect of the present comparison, DT introduced these submissions to argue that the marks can be compared as being 'BEAK' against 'BEAK'. This is not the case. While notional and fair use of DT's earlier mark may include use of

⁶ Arguments to variant use may assist when considering the issue of form of the mark under proof of use considerations but those are not relevant here. On this point, I note that the submissions are made in conjunction with reference to the case law *NIRVANA* (BL O/262/06) which is a case often cited in respect of the variant mark point.

'The Beak Brewery' in different colours and in different standard typefaces, it does not cover dissected use of the mark, i.e. use of 'BEAK' solus. Any such submissions on this point are, therefore, of no assistance here and I will say no more about this point.

50. In respect of the remaining submissions, I will discuss them further below, if necessary. For now, however, I will simply confirm that I have given due consideration to all submissions filed.

Overall Impression

51. BFC's mark is a word only mark that consists solely of the word 'BEAK'. There are no other elements that contribute to the overall impression of the mark, which lies in the word itself. As for DT's mark, this is also a word only mark consisting of three words, being 'The Beak Brewery'. For reason I will come to discuss below, the overall impression of the mark will be dominated by the word 'Beak', with 'Brewery' playing a lesser role and 'The' playing a negligible role.

Visual Comparison

52. Both marks are word only marks meaning that they can be used in either upper case, lower case or any customary combination of the two. Therefore, the different use of case in the marks is of no relevance to the visual comparison. Visually, the marks share use of the word 'BEAK'. This is accepted by BFC as the only identical aspect of the mark in its submissions. The marks differ in the presence of 'The' and 'Brewery' in DT's mark, which sit at the beginning and end of the mark respectively. While they play lesser roles in the overall impression of DT's marks, they still have a visual presence and, therefore, act as points of visual difference. Taking all of this into account but also bearing in mind the overall impression of the marks, I am of the view that the marks are visually similar to a medium degree.

Aural Comparison

53. In considering DT's mark, I am of the view that it will be pronounced in full and in the ordinary way. While 'The' is likely to have very little impact from a trade mark perspective, consumers will still pronounce it. Further, while 'Brewery' may indicate the nature of DT's business, it will still be pronounced. On this point, 'Brewery' is not descriptive of DT's goods or services and, even if it were, I remind myself of the case of *Purity Hemp Company Improving Life as Nature Intended* (Case BL O/115/22) wherein Mr Philip Harris, sitting as the Appointed Person, set out that just because a word was descriptive, it does not render it aurally invisible. As for BFC's mark, this will simply be pronounced as 'BEAK'.

54. BFC's position is that because DT's earlier mark consists of an additional three syllables in the presence of the words 'The' and 'Brewery', the marks are not aurally similar. While these additional words (which have no counterpart in BFC's mark) act as points of difference, they do not render the marks aurally dissimilar. Regardless of the presence of different words, the marks share the word 'BEAK' that will be pronounced identically in both marks. Taking into account the different length of the marks and the position of the point of identity (in the middle of DT's mark), I find that the marks are aurally similar to between a low and medium degree.

Conceptual Comparison

55. BFC's mark is the word 'BEAK'. When the mark is viewed on services that relate to the preparation of chicken food then consumers will readily identify this as the hard part of a chicken's mouth. However, in respect of the retail services for clothing, the beak referenced may be that which belongs to any type of bird. As for DT's mark, 'The' will have no conceptual meaning outside of being a determiner of the words that follow it. The concept associated with the word 'Beak' will be the

same as it is in BFC's mark.⁷ 'Brewery' will be understood as a reference to the place where beer is brewed. This will be viewed as an indicator of the type of business that DT operates and is the reason why I have found 'Brewery' to play a lesser role in DT's mark.⁸ When the mark is viewed as a whole, the reference to a brewery and the beak of a bird is likely to be considered a somewhat unusual combination of words. That being said, I consider that 'Beak' will be viewed as the primary indicator of origin and 'Brewery' referring to a business operation. All this being said, 'Brewery' still contributes as a point of conceptual difference, although I consider that it is only capable of offsetting the identical (and dominant) concept associated with the shared use of 'BEAK' to a minor degree. Overall, I find that these marks are conceptually similar to a high degree.

Distinctive character of DT's earlier mark

56. 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

⁷ I note that the evidence sets out that DT chose the word 'Beak' as a reference to the cuckoo bird, being a nod to the fact that he previously operated as what he refers to as 'a cuckoo brewer'. While that may have been DT's intention, this will not be understood by the average consumer and I have nothing before me by way of evidence to suggest otherwise.

⁸ While the goods and services relied upon do not directly relate to brewery services (so 'Brewery' cannot be said to be descriptive), I have reached this finding because, regardless of what goods/services are actually offered, 'Brewery' remains an indicator of a type of business in the eyes of the consumer therefore rendering it unremarkable from a trade mark perspective.

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).”

57. Registered trade marks possess varying degrees of inherent distinctive character, perhaps lower where a mark may be suggestive or allusive of a characteristic of the goods or services for which it is registered, ranging up 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. DT submits that his earlier mark is highly distinctive, both from an inherent position and due to the use made of the mark since 2013. Before proceeding to consider whether the use shown in evidence is capable of proving that DT’s earlier mark enjoys an enhanced degree of distinctive character, I will first consider the inherent position.

58. DT’s earlier mark is a word only mark made up of three words, being ‘The Beak Brewery’. Firstly, ‘The’ will have no impact on the distinctiveness of DT’s earlier mark. Secondly, the word ‘Beak’ has no descriptive or allusive qualities in respect of any of the services relied upon. That being said, it is an ordinary dictionary word with a known meaning. Lastly, I have set out above that ‘Brewery’ is unremarkable from a trade mark perspective and is somewhat allusive to the overall nature of DT’s business. It, will, therefore, contribute less to the distinctiveness of the mark. In considering the mark as a whole, I find that the distinctiveness of the mark will be dominated by the word ‘Beak’ with ‘Brewery’ contributing to a very little degree and ‘The’ not contributing at all. I remind myself that DT’s position is that his earlier mark is inherently distinctive to a high degree but I disagree. None of the words in the mark are made-up or novel words that would warrant such a finding. Instead,

bearing all of the above in mind, I am of the view that DT's earlier mark enjoys a medium degree of inherent distinctive character.

59. In considering the evidence insofar as it can be said to enhance the distinctiveness of the mark, I note that the majority of the evidence before me relates to DT's beer brewing operation and the sale of his beers. Such goods and services are not at issue here so the evidence on this point is not relevant to the present ground. While there is evidence in respect of clothing and the provision of food, it is not particularly extensive and I can deal with it briefly.

60. In respect of the goods at issue, the evidence explains that since April 2020, DT has created branded clothing goods including 920 caps, 56 work wear jackets and 1,500 t-shirts.⁹ A range of invoices are provided in respect of DT's purchase of these goods from the manufacturer.¹⁰ I note that a number of the invoices cover activity from April 2020 onwards but also include activity from after the relevant date for the present proceedings, being 2 August 2022. In respect of the sale of these goods to consumers, I note that the only evidence before me is a reference in DT's narrative evidence to the fact that these goods were sold across UK and Europe and cumulatively generated tens of thousands of pounds for the business. Firstly, this is an imprecise statement and given that the evidence references activity from after the relevant date, it is likely that this statement covers goods sold after it.¹¹ Secondly, the relevant territory for these proceedings is the UK so any claimed sales in Europe are of no relevance. On this point, there is no breakdown of how the sales relate to goods sold in the UK so it is not possible for me to make any sort of accurate determination.

61. I note that evidence in relation to the preparation of food and drink is also provided. The evidence sets out that DT acquired a 2,500 square foot premises in April 2020 for the operation of his business. His evidence states that half of this space is taken up by his brewery but the other half is a street food canteen. DT claims to regularly

⁹ There is reference to drinking glasses but these are not at issue here.

¹⁰ Annex 8

¹¹ Being use that would not be relevant here.

attract between 200 and 300 people each weekend and that the canteen alone has generated almost £800,000 in revenue in the first three years of its operation. Given that the premises was obtained in April 2020, this claim in respect of 'the first three years' of its operation is likely to cover a period of time after the relevant date. A number of TripAdvisor, Google and OpenTable reviews are provided in evidence.¹² The reviews are noted but some of which are from after the relevant date so are of no assistance here. By my count, the OpenTable printout shows just four reviews from prior to the relevant date, the TripAdvisor printout shows just nine and the Google printout shows 24.

62. The evidence regarding the provision of food seems to indicate that DT does not offer the food himself but, rather, offers a space for third parties to offer 'pop-up' food services. This is not something that DT has shied away from as he not only filed evidence to this effect (an interview with DT himself sets out that the food element of his premises involves a different chef or restaurant setting up there on a weekly basis),¹³ he mentions it his submissions that this is the case. On this point, he argues that such circumstances still mean that this use should be considered use of his mark. He argues that the premises from which the food is provided from are heavily branded with his own branding and that the third-party providers enter into contracts with DT because he remains responsible for the matter of health and safety. Further, he argues that the social media reviews confirm that the vast majority of reviewers do not mention the food partner. While noted, I do not consider that this means that the provision of food from DT's premises is sufficient to demonstrate that consumers would not be aware of the fact that the food is provided for by a third-party. There is nothing in the evidence to suggest that the food is shown as being provided under the 'Beak Brewery' branding. On this point, I will say that it is my understanding that 'pop-up' catering/restaurant services such as this are becoming increasingly common in the trade and consumers are likely to be aware of situations where a third-party 'pop-up' is being offered.¹⁴ Further, I do not consider that the lack of mention of these third-party providers in reviews

¹² Annex 3

¹³ See pages 9 to 18 of Annex 4

¹⁴ It is somewhat unfeasible to suggest that the food providers would not have any of their own branding featured as such pop-up events.

indicates that the consumers believe the food consumed was provided under the 'Beak Brewery' brand. In my view, this is not necessarily something that all reviews would seek to clarify and, further, I note that where food is mentioned, some reviews do mention the fact that the food was provided for by different companies. For example, I note reference to a company called 'Pig & Jacket' and another reference to a 'pizza company' in reviews. As a result, I am not satisfied that consumers would consider food from third-party providers to be provided for under DT's brand. As a result, DT is unable to rely on such evidence.

63. My issue with the evidence regarding the provision of food is fatal to any claim to enjoy enhanced distinctive in respect of such a service. However, this does not take away from the provision of drink by way of the different beers DT offers at his premises. On this point, I note that the evidence discusses Beak Brewery's presence on a website called UNTAPPD which is described as the world's most popular beer platform. An entry taken from UNTAPPD's website is provided and I note that DT's business (being referred to as 'BEAK') shows that it offers 158 beers and has obtained 118,413 ratings for an average score of 3.964.¹⁵ In BFC's submissions and in DT's evidence in reply, there was some back and forth in respect of DT's initial claim that the 9 million users of UNTAPPD would be aware of DT's brand as 'BEAK'. While the wording of DT's initial claim is somewhat unfortunate (clearly not all users of UNTAPPD would be aware of 'BEAK' just because it appears on the site), it is clear to me that, in his evidence in reply, DT is not actually claiming that all 9 million users would know of his brand. On the point of this website, the presence of over 100,000 reviews is noted but the print-out provided is dated 5 July 2023, being some 10 months after the relevant date. It is, therefore, possible that a number of the reviews came from after that date meaning that they would be of no assistance. Clearly a proportion of reviews and ratings would have come prior to the relevant date, however, there is nothing sufficiently solid to demonstrate the precise position as at the relevant date.

¹⁵ See page 4 of Annex 4

64. The evidence goes on to discuss coverage from UK food critics such as those who report for The Guardian and The Daily Mail. The volume of any press coverage in the evidence is limited but I note that one of the critics, in a Daily Mail article, lists Beak Brewery in his top places to eat and drink outside in England. While present in a well-known UK-wide publication, there is no figures as to any readership associated with this article or any indication as to whether it led to any level of sales. In my view, this is a particular issue for DT as the overall volume of the press coverage is limited.

65. Social media evidence is then discussed and I note that DT confirms that his business has almost 30,000 social media followers across various platforms, including Instagram, and that he has 8,000 newsletter subscribers. This is not supported by any evidence so it is not possible for me to determine whether this claim reflects the position as at the relevant date or, more likely (given the nature of the evidence as a whole), the position as at the date of the witness statement, being in July 2023.

66. Taking all of the evidence that relates to the goods and services at issue into account, I am satisfied that it demonstrates that DT, at the relevant date, offered for sale a number of clothing goods and that he operated a premises from which he offered the provision of drinks to consumers. However, the supporting evidence as to the level of use in relation to the provision of such goods and services is insufficiently solid. There is no evidence as to marketing spend and nor is there anything I can rely on to demonstrate the precise level of turnover/sales as at the relevant date. I accept that there is a level of press coverage by way of reviews from UK-wide publications, however, this is limited and there is nothing to suggest the level of readership of the same and neither is there anything to demonstrate any effect these articles had on DT's business. Lastly, there are a number of reviews from customers provided but the total amount of reviews from prior to the relevant date is at a very low level (by my count, the reviews cover just 37 reviews in total). Overall, I am of the view that the evidence provided fails to support a finding that DT's earlier mark enjoys an enhanced degree of distinctive character for any of the goods and services relied upon under the present ground. As a result,

the inherent position applies, namely that the mark is inherently distinctive to a medium degree.

Likelihood of confusion

67. 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 services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the DT's 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 he or she has retained in his or her mind.

68. I have found the parties' goods and services to be either identical or similar to a medium degree. I have found the average consumer for the services to be members of the general public at large who will select the goods and services on a primarily visual basis whilst paying a medium degree of attention. In respect of the similarity of the marks at issue, I have found them to be visually similar to a medium degree, aurally similar to between a low and medium degree and conceptually similar to a high degree. I have found DT's mark to be inherently distinctive to a medium degree.

69. While DT has made no submissions as to direct confusion, it is still necessary for me to consider the same. Taking all of the above into account and even bearing in mind the principle of imperfect recollection, I am of the view that consumers would

not mistake the parties' marks for one another. I say this because while I have found 'Brewery' to play a lesser role in DT's mark, it is not directly descriptive of the goods and services at issue and, therefore, does not lack distinctiveness to the point that it would be overlooked by consumers. In my view, upon being confronted by the parties' marks, the consumer would (1) notice the differences between them and (2) be able to accurately recall or remember which mark was which. Consequently, I do not consider that there exists a likelihood of direct confusion between the parties' marks, even on identical services.

70. I turn now to consider indirect confusion. In doing so, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, BL O/375/10, wherein 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)".

71. While the above examples in *L.A. Sugar* are noted, they are not intended to be treated as an exhaustive list of the only instances wherein indirect confusion occurs.

72. Further, I note the case of *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, wherein Arnold LJ referred to the comments of James Mellor Q.C. (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at paragraph 16 that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

73. DT's submissions set out that category (a) of *L.A. Sugar* (cited above) is the most appropriate in the present circumstances. This is because 'Beak' is strikingly distinctive for a brewery. In making this argument, DT relies on his use of the mark since 2013. Firstly, DT's use of his mark on the sale of beers is not relevant to the present ground. Secondly, as discussed above, DT's brewery services are not relevant to the present ground as they share no similarity with BFC's goods. Further, DT's actual use of the relevant goods or services is far from sufficient to demonstrate that his mark enjoys an enhanced distinctive character. While

category (a) may apply in circumstances where the distinctiveness is inherent, I have found above that DT's mark enjoys a medium degree of distinctiveness. As such, it follows that use of 'Beak' in a trade mark is not so strikingly distinctive that consumers would believe that only one undertaking would use it. As a result, I do not consider that category (a) of *L.A. Sugar* is applicable in the present case. That being said, DT's submissions do not mean that I cannot consider categories (b) or (c) (or any other type of indirect confusion on the basis that the categories set out in *L.A. Sugar* are not exhaustive).

74. Before considering these points, I wish to briefly set out that even though I have found no direct confusion, parts of marks are still capable of being overlooked when considering the issue of indirect confusion. I say this because I consider it likely that consumers will overlook the presence of the word 'The' in DT's mark. Therefore, the only difference that I consider relevant to the assessment of indirect confusion is the word 'Brewery' in DT's mark.

75. I have found throughout this decision that the parties' marks are dominated by the word 'BEAK'. As for the point of difference, I appreciate that 'Brewery' plays a lesser role in DT's earlier mark, it does not describe the goods or services at issue. That being said, I do consider that it will be viewed as an indicator of a type of business, being the brewing of beers. As such, consumers are likely to incorrectly view it as an indication of a type of service offered by 'Beak' or, alternatively, will consider that the goods/services upon which the marks are viewed (clothing or services for the provision of food and drink) are simply ancillary goods/services to that undertaking's main mode of business, namely that it operates primarily as a brewing company but also offers merchandising goods and services for the provision of food and drink. As a result, regardless of how the consumer perceives 'Brewery', the indicator of origin for DT's mark will be seen as the word 'Beak'. While this is not strikingly distinctive in DT's mark, it does enjoy a medium degree of distinctive character. As a result, I do not consider it to be the case that the shared use of such a word would be considered coincidental by consumers. As a result, I find that consumers will consider that 'Beak Brewery' is either a brand extension or sub-brand of 'BEAK' and will, therefore, believe the marks to originate

from the same or economically linked undertakings. Alternatively, consumers may also consider 'BEAK' to be a sub-brand or brand extension of 'Beak Brewery' if they were to view the clothing goods or class 43 services as other goods/services provided by the brewery. On this point, I remind myself that whether the consumer is confused as to believe that an applicant's mark is a brand extension or sub-brand of the opponent's mark or vice versa is not relevant to the present assessment.¹⁶ Taking all of this into account and even bearing in mind the comments of Mr Mellor Q.C. and Arnold LJ referred to at paragraph 72 above, I consider that there is a likelihood of indirect confusion between the marks.

76. The success of the present ground means that DT's opposition succeeds in full. For the sake of completeness, however, I will proceed to consider the section 5(3) ground.

Section 5(3)

77. Section 5(3) of the Act states:

“5(3) A trade mark which –

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.”

¹⁶ See paragraph 75 to 84 of *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 wherein Kitchin LJ (as he then was) explained that “right way round” or “wrong way round” confusion may be a consequence of nothing more meaningful than the order in which the consumer happened to come across the mark and the sign. He explains further that in both instances the consumer thinks that the goods or services in issue come from the same undertaking or economically linked undertakings, and they may be equally damaging to the distinctiveness and functions of the mark.

78. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, Case 252/07, *Intel*, Case C-408/01, *Adidas-Salomon*, Case C-487/07, *L'Oréal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*, Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel*, paragraph 42

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the

goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oréal v Bellure NV*, paragraph 40.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

79. Under the present ground, DT relies on the same marks and same goods and services as it did under its section 5(2)(b) ground.

80. The conditions of section 5(3) are cumulative. Firstly, DT must show that the marks are similar. Secondly, DT must show that his marks have achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must be

established that the level of reputation and the similarities between the parties' marks will cause the public to make a link between them, in the sense of the earlier mark being brought to mind by BFC's mark. Finally, assuming the first three conditions have been met, section 5(3) requires that one or more of the types of damage will occur. It is unnecessary for the purposes of section 5(3) that the goods or services at issue be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

Reputation

81. I consider that I can deal with the present ground relatively briefly. I remind myself that I have summarised the evidence in respect of DT's class 25 goods and the class 43 services under his first earlier mark at paragraphs 59 to 66 above. While the test for reputation is not the same as for enhanced distinctive character, I consider that the same outcome under the distinctive character assessment applies here. I hereby echo my findings under my distinctive character assessment above in that the evidence provided lacks clarity and is imprecise in nature. As a result, I am of the view that the evidence filed falls far short of proving that DT enjoyed a reputation in respect of his class 25 goods and class 43 services. As a result, DT is unable to rely on his first earlier mark in support of the present ground.

82. As for the class 40 services under DT's second mark, I consider that the evidence fails to prove that a reputation exists for these also. I say this because the service that DT's second mark is registered for is "brewing of beer". While the evidence speaks to the sales of beer and it is clear that DT's business brews its own beer at DT's premises, there is nothing to suggest that DT actually offers brewing services to customers. The use of such services would include third parties obtaining services from DT wherein he brews beer on their behalf. No such evidence is before me and, as such, DT's reliance upon his second earlier mark must fail at this stage.

83. As DT has failed to prove that his earlier marks enjoy a reputation, his reliance upon the section 5(3) ground falls at the first hurdle.

Conclusion of DT's opposition

84. While the section 5(3) ground has failed in its entirety, DT has succeeded opposing BFC's mark under the section 5(2)(b) ground. As a result, subject to any successful appeal against my decision, BFC's mark is refused registration for all of the services subject to DT's opposition, being the following:

Class 35: Retail services relating to clothing, headwear and footwear, namely T-shirts, sportswear, hats and socks.

Class 43: Preparation of food, namely Fried chicken burgers, fried chicken wings and fried chicken strips.

85. BFC's mark may, however, proceed to registration for the following services, being those that were not opposed:

Class 35: Retail services relating to stationery, namely stickers.

BFC's opposition

86. Given that BFC's mark proceeds to registration for those unopposed services, BFC's opposition may proceed in reliance upon the following services only:

Class 35: Retail services relating to stationery, namely stickers.

87. The relevant legislation, case law and principles in relation to section 5(2)(b) grounds have been set out in full above when considering DT's opposition. As such, I do not consider it necessary to repeat them again here. Instead, I simply refer back to the relevant parts of DT's opposition wherein I considered his section

5(2)(b) ground and repeat my reliance upon that legislation, case law and principles here.

Comparison of services

88. BFC's services are set out at paragraph 86 above. DT's opposed services are as follows:

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, books on brewing beer, beer mats, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.

89. At question eight of his counterstatement, DT accepted that the services in class 35 are identical. At that point, DT did not seek to clarify which services it accepted as identical. I note that in his written submissions, DT sought to alter his position by arguing that the services were dissimilar and did so by relying on a decision of this Office (under case number O/555/20) wherein advertising services were found to be dissimilar to retail services. While the change in position is noted, this cannot alter the pleaded position, namely that the services are identical. On this point, I appreciate that at the time of making his counterstatement, it was not clear which of BFC's services would survive DT's opposition. That being said, the nature of DT's notice of opposition against BFC's mark was partial and was not aimed at "retail services relating to stationery, namely stickers". Therefore, I consider it reasonable to suggest that, at that time, DT should have been aware that BFC's opposition would proceed in reliance upon those services at the very least. As a result, the issue in respect of identity/similarity between DT's advertising, marketing and promotion services and at least some retail services of BFC would have been live at the time of filing the counterstatement and identified as something that would have been relevant regardless. This is something that DT was (or at least should

have been) aware of at the time. Therefore, I am of the view that DT's concession can be taken to be a blanket concession as to identity between all of the services at issue.

90. Given DT's pleaded case, I am bound to proceed on the basis that DT concedes that the services at issue are identical.

The average consumer and the nature of the purchasing act


91. For the same reasons as discussed at paragraphs 43 and 44 above, I find that the average consumer for the retail services will be members of the general public at large who will select the services on a primarily visual basis (though I do not discount an aural consideration) after paying a medium degree of attention. As for the advertising, promotional and marketing services, these will, for the most part, be selected by business users. Having said that, I consider that members of the general public at large may also select these services by way of local newspaper or online advertising services. The services will be available from the provider directly where they will be shown to the consumer on lists, placards or on leaflets. Alternatively, the services may be listed online via the provider's website. While members of the public are likely to have primarily visual considerations, business users are likely to select the services after discussions with sales assistants as well as considering the visual component. As such, I consider that business users will pay attention to the visual and aural components equally.

92. Business users will select the services on a relatively frequent basis whereas members of the general public are likely to select them on a more infrequent basis. The costs of the services will range somewhat from inexpensive adverts in newspapers, for example, to large scale advertising campaigns which will be considerably more expensive. In respect of the level of attention paid, members of the general public will consider the reach of the advertising and the duration that the advert will be shown. I consider that these consumers will pay a medium degree of attention. As for business users, this will be a more involved selection as the advertising or promotion of the business is likely to be an important factor in the

success of the business. Such consumers will consider ordinary factors such as those discussed above but will also look to consider previous advertising campaigns run by the provider, testimonials from previous customers and details/information as to projected returns on/success of said advertising campaigns. As a result, I consider that business users are likely to pay a relatively high degree of attention.

Comparison of the marks

93. The competing marks are as follows:

BFC's mark	DT's opposed mark
<p>BEAK</p>	

Overall Impression

94. BFC's mark is a word only mark that consists solely of the word 'BEAK'. There are no other elements in BFC's mark that contribute to its overall impression, which lies in the word itself. DT's opposed mark is a figurative mark that consists of the word 'BEAK' in a bold standard typeface. This sits below a device element which appears to be a cartoon drawing of a man carrying an oversized bottle whilst reading a magazine or newspaper. I appreciate that the eye of the consumer is naturally drawn to elements of marks that can be read, however, I cannot ignore

the size and placement of the device element. In my view, the word and device element contribute equally to the overall impression of DT's opposed mark.

Visual Comparison

95. In his counterstatement, DT accepted that the word element in the marks is identical. Clearly, this is the case. As for the visual impression of the mark, DT's counterstatement sets out that his own mark has a strong and distinctive visual identity. I agree with this point as the device element is large and has no counterpart in BFC's mark. While the presence of the device element cannot counteract the identity of the word elements entirely, it is a significant point of visual difference. Taking all of this into account, I find that the marks are visually similar to a medium degree.

Aural Comparison

96. The only aural element in DT's opposed mark is the word 'BEAK'. The aural element of BFC's mark is also the word 'BEAK'. Clearly, these marks are aurally identical.

Conceptual Comparison

97. When considering DT's opposition, I found that BFC's mark would be understood as a reference to the beak of a bird. This applies here. Further, the same finding applies to the word element of DT's opposed mark. The device element of DT's opposed mark is a cartoon drawing of a man carrying an oversized bottle reading a magazine or newspaper. While this will be identified by the consumer, it is unlikely to have much impact on the concept of the mark overall as it conveys no obvious message from a trade mark perspective and neither can it be said to be associated with the word element of the mark (so as to give it further meaning or qualify said meaning). As a result, the concept of DT's opposed mark will be dominated by the word 'BEAK'. That being said, it does act as a slight point of conceptual difference. Overall, I consider that the marks are conceptually similar to a high degree.

Distinctive character of BFC's mark

98. BFC did not file any evidence and, therefore, I only have the inherent position to consider. As above, BFC's mark consists solely of the word 'BEAK'. While this is not descriptive or allusive to the services relied upon by BFC under the present opposition, it is an ordinary dictionary word with a clear meaning. As such, its use from a trade mark perspective is not particularly remarkable. Overall, I consider that BFC's mark enjoys a medium degree of inherent distinctive character.

Likelihood of confusion

99. Because of DT's concession in his counterstatement, I have proceeded with this opposition on the basis that the parties' services are identical. I have found the average consumer for the services to be members of the general public at large and business users. Members of the general public are likely to have primarily visual considerations (though I do not discount aural considerations) and will pay a medium degree of attention during the selection process. Business users, on the other hand, will select the goods whilst paying attention to the visual and aural components equally and will pay a relatively high degree of attention. I have found the marks to be visually similar to a medium degree, aurally identical and conceptually similar to a high degree. I have found BFC's mark to be inherently distinctive to a medium degree.

100. Taking all of the above into account and bearing in mind the principle of imperfect recollection, I am of the view that consumers will inaccurately recall or misremember the marks at issue. While I appreciate that the device element in DT's opposed mark will be noticed, consumers will look to pin their recollection of the marks on the word element, which is identical in both. As a result, I consider it likely that consumers will forget which mark consisted of the device element and which did not. Consequently, I consider that there exists a likelihood of direct confusion between the marks and given the identity of the word element, I find that this applies regardless of the level of attention paid by the consumer.

101. For the sake of completeness, I will proceed to consider indirect confusion. In the present case, if consumers are able to recall the marks due to the device element in DT's opposed mark, then I consider that they will still believe them to be the responsibility of the same undertaking. While I appreciate that the device element has no obvious connection to the services at issue, I consider that consumers will believe the marks to be alternate marks used by the same undertaking in different contexts. For example, the consumer may believe that the word only mark is one that is used on promotional materials whereas the device mark is one that used on product packaging. Consequently, I consider that there exists a likelihood of indirect confusion between the marks and given the identity of the word element, I find that this applies regardless of the level of attention paid by the consumer.

102. As an alternative approach to confusion, I remind myself that when considering the conceptual impact of DT's mark, I said that the device element will carry no obvious meaning. If I am wrong on this point and it does carry some message to the consumer that is unconnected to the 'BEAK' element, confusion will still occur. I say this because in this scenario, when considering DT's opposed mark as a whole, consumers will also perceive it as being made up of two signs (the device element and the word 'BEAK') which have their own distinctive significance, independent of the significance of the whole. As a result, consumers will also be confused as a result of the identity of the sign 'BEAK' within DT's opposed mark and BFC's mark, which is also the word 'BEAK'.¹⁷

Conclusion of BFC's opposition

103. BFC's opposition succeeds in full meaning that, subject to any successful appeal of my decision, DT's opposed mark is refused registration for the following services:

¹⁷ This finding is based on the *Medion v Thomson* (Case C-120/04) principle, the correct approach to which is set out by Arnold LJ (as he then was) in the case of *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of key rings, pens, books on brewing beer, beer mats, luggage, shoulder bags, tote bags, wallets, purses, glasses, drinking vessels, beer pitchers, beer glasses, bottle openers, cups, mugs, insulated mugs, drinks coasters, tea towels, flags, pennants, headwear, scarves, gloves, caps, t shirts, sweat shirts, clothing, jackets.

104. It may, however, proceed to registration for the following goods and services, being those that were unopposed:

Class 32: Beer; Beers; flavored beer; black beer; imitation beer; malt beer; beer wort; wheat beer; bock beer; saison beer; craft beer; flavored beers; craft beers; black beer [toasted-malt beer]; coffee-flavored beer; de-alcoholized beer; non-alcoholic beer; de-alcoholised beer; low-alcohol beer; beer-based beverages; barley wine [beer]; beer-based cocktails; barley wine [beer]; alcohol-free beers; extracts of hops for making beer.

Class 35: Advertising, marketing, promotion and / or retail (whether in store, by mail order, telephone, or via the internet) of sausages with ale, meat and ale pies, beer batters for frying, pickles, sauces, preserves, relishes, marinades, beer, beers, flavored beer, black beer, imitation beer, malt beer, beer wort, wheat beer, bock beer, saison beer, craft beer, coffee-flavored beer, de-alcoholized beer, non-alcoholic beer, de-alcoholised beer, low-alcohol beer, beer-based beverages, barley wine [beer], beer-based cocktails, extracts of hops for making beer, beer brewing ingredient kits consisting primarily of malt wort, hop concentrates and hopped wort, wines, spirits, cocktails.

CONCLUSION

105. The outcome of these consolidated proceedings is that both parties' oppositions succeeded in full. That being said, both parties' oppositions were partial oppositions so both parties' marks may proceed to registration for some goods and services. I do not intend to repeat these here but remind myself that the levels of success have been set out at paragraphs 84 and 85 (for DT's opposition) and 103 and 104 (for BFC's opposition). To reconfirm what I have already set out above, the outcomes of both oppositions are subject to appeal.

COSTS

106. As both parties have succeeded in bringing their respective oppositions, I am of the view that the appropriate outcome in respect of costs is to make no costs award and hereby order both parties to bear their own costs.

Dated this 12th day of September 2024

A COOPER
For the Registrar