BL O/0992/25

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION No. 3886482
BY ENERGY SERUM GLOBAL (PTY) LTD
TO REGISTER THE FOLLOWING TRADE MARK:

SERUM

IN CLASS 32

-AND-

THE OPPOSITION THERETO UNDER No. 441925
BY KRATOCHVÍLOVCI SPOL. S R.O.

Background and pleadings

1. On 8 March 2023 ENERGY SERUM GLOBAL (PTY) LTD (**"the Applicant"**) applied to register the word-only trade mark 'SERUM' in the UK, claiming a priority date of 21 December 2022 from its South African trade mark number 2022/38826. The application was accepted and published in the Trade Marks Journal on 14 April 2023. Registration is sought for the following goods:[1]

> Class 32: Energy drinks, energy drinks enhanced with nootropics, nootropics drinks, energy drinks enhanced with vitamins and minerals, sugar free energy drinks, carbonated energy drinks; syrups and other non-alcoholic preparations for making beverages namely concentrates, syrups or powders used in the preparation of energy drinks.

2. On 13 July 2023 Kratochvílovci spol. s r.o. (**"the Opponent"**) opposed the application under section 5(2)(a) of the Trade Marks Act 1994 (**"the Act"**).[2] The opposition is directed at all the applied-for goods.

3. The Opponent relies on its UK comparable trade mark (EU)[3] for the word-only trade mark 'SERUM', trade mark registration number 916203762, which was filed on 27 December 2016 and became registered on 19 April 2017. It is registered in respect of goods in Class 33 which are set out below. For the purposes of the opposition the opponent relies on all the goods for which its mark is registered:

> Class 33: Alcoholic beverages (except beer); Spirits and liquors.

---

[1] As amended by the Applicant in accordance with the filing of the Applicant's Form TM21B dated 30 October 2023.

[2] 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.

[3] On 1 January 2021, the UK left the EU after the expiry of the transition period – which came to an end on 'IP Completion Day' i.e. 31 December 2020 at 11:00 pm. Under Article 54 of the Withdrawal Agreement, the UK Registry created comparable UK trade marks for all holders with an existing EU trade mark ("EUTM") registered before 'IP Completion Day'. These comparable trade marks were recorded in the UK trade mark register and as a consequence, have the same legal status as if they had been applied for and registered under UK law. A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

4. By virtue of its earlier filing date, the trade mark upon which the Opponent relies qualifies as an earlier trade mark pursuant to section 6 of the Act.

5. The Opponent argues that the respective goods are similar and that the respective marks are identical, giving rise to a likelihood of confusion.

6. As the earlier mark had been registered for more than five years at the priority date of the contested application, it is subject to the use conditions pursuant to section 6A of the Act, and as it is a comparable trade mark (EU) it is additionally subject to the provisions set out in Schedule 2A, Part 1, paragraph 7 of the Act. Accordingly, the Opponent made a statement that it has used its mark in relation to all the goods for which the mark is registered.

7. The Applicant filed a counterstatement in which it requests that the Opponent provides proof of use of its earlier trade mark relied upon. In its counterstatement the Applicant denies that the respective goods are similar. With regard to the respective marks, the Applicant "accepts that the Opponent's Mark is aurally and visually the same",[4] however, it denies that they are conceptually identical.[5]

8. Neither party elected to file submissions during the evidence rounds, but both parties filed evidence. After the filing of the Opponent's evidence in chief, the Applicant filed its evidence, to which the Opponent responded with evidence in reply. Neither party requested a hearing and neither elected to file submissions in lieu of a hearing. I therefore make this decision following a careful consideration of the papers before me.

9. The Opponent is represented by Keltie LLP and the Applicant is represented by Tidman Legal Limited.

---

[4] See the Applicant's Form TM8 'Notice of Defence and Counterstatement', paragraph 5 of the counterstatement.

[5] Ibid., paragraphs 6 and 7.

EVIDENCE FILED

Opponents' evidence in chief

10. The Opponent's evidence in chief is provided in the witness statement of Michal Kratochvíl dated 13 February 2024 and has six accompanying exhibits labelled MK1 to MK6. Mr Kratochvíl is the Chief Executive Officer of Kratochvílovci spol. s r.o., a position he has held since 1999. The purpose of his witness statement is to provide proof of use evidence of the earlier mark.

Applicant's evidence

11. The Applicant's evidence is provided in the witness statement of James Emile Van der Linde dated 12 April 2024 and has five accompanying exhibits labelled JEV1 to JEV5. Mr Van der Linde is a director and shareholder of Energy Serum Global (Pty) Ltd. The main purpose of his evidence is to support his assertion that energy drinks are not similar to alcoholic beverages.

Opponents' evidence in reply

12. The Opponent's evidence in reply is provided in the witness statement of Benjamin Britter dated 5 June 2025 and is accompanied by one exhibit labelled BNB1. Mr Britter is a Chartered Trade Mark Attorney and Partner at the Opponent's representative firm, Keltie LLP. Mr Britter stated that the purpose of his evidence is to "demonstrat[e] that alcoholic beverages are commonly sold with soft drinks, including 'energy drinks', as ready-to-drink products."

13. I shall refer to the parties' evidence where appropriate in my decision.

DECISION

PROOF OF USE

14. In opposition proceedings, the registrar shall not refuse to register a trade mark by reason of an earlier trade mark unless the use conditions of the earlier trade mark are met. I will therefore begin by assessing whether the earlier mark has been put to genuine use.

Proof of use legislation

15. The relevant parts of the Act are as follows:

Section 6A

(1) This section applies where—

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section "the relevant period" means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if—

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non-use.

(4) For these purposes—

(a) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

[...]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for

the purposes of this section as if it were registered only in respect of those goods or services.

Schedule 2A, Part 1, paragraph 7

(1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where IP completion day falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union.

Section 100[6]

"If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it."

Proof of use case law

16. The law relating to genuine use of a registered trade mark was summarised by Arnold LJ in *easyGroup Ltd v Nuclei Ltd & Ors*[7] as follows:

"105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU [Court of Justice of the European Union] in a considerable number of cases, the principal decisions being

---

[6] Section 100 of the Act makes it clear that the trade mark proprietor bears the burden of proving genuine use of its trade mark. In this regard see *Ferrari SpA v DU*, C–721/18, at paragraphs 73 to 83.

[7] [2023] EWCA Civ 1247.

Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky'* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

"106. […] the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not

suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

107. […] The General Court ['GC'] of the European Union has repeatedly held that genuine use of a trade mark cannot be proved by means of probabilities or suppositions, but must be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned: see e.g. Case T-78/19 *Lidl Stiftung & Co KG v European Union Intellectual Property Office [EU:C:2020:166*] at [25]. It has also repeatedly held that the smaller the commercial volume of the exploitation of the mark, the more necessary it is for the proprietor to produce additional evidence to dispel any doubts as to the genuineness of its use: see e.g. *Lidl* at [33]. In *Awareness Ltd v Plymouth City Council [2013] RPC 24* Daniel Alexander QC sitting as the Appointed Person said:

19. For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. …

22. … it is not strictly necessary to exhibit any particular kind of documentation but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal … comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaking, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

17. In *Awareness Ltd,* the Appointed Person goes on to say that:

> "28. […] Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered […]."

18. I also note Mr Alexander's comments in *Guccio Gucci SPA v Gerry Weber International AG*.[8] He stated:

> "The Registrar says that it is important that a party puts its best case up front – with the emphasis both on "best case" (properly backed up with credible exhibits, invoices, advertisements and so on) and "up front" (that is to say in the first round of evidence). […] The rule is not just "use it or lose it" but (the less catchy, if more reliable) "use it – and file the best evidence first time round – or lose it"."

19. The genuine use provision is not there to assess economic success or large-scale commercial use.[9] An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.[10]

20. As regards the territorial scope of the use of an EUTM, in *Walton International,*[11] Arnold J (as he then was), after setting out the eight applicable principles when assessing genuine use (which are the same as the eight principles he subsequently set out in *easyGroup Ltd*),[12] added the further three principles when assessing genuine use in the EU:

> "118. *The law with respect to genuine use in the Union*. Whereas a national mark needs only to have been used in the Member State in question, in the case of a EU trade mark there must be genuine use of the mark "in the Union". In this regard,

[8] Case BL O/424/14.

[9] *MFE Marienfelde GmbH v OHIM*, Case T-334/01.

[10] *New Yorker SHK Jeans GmbH & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-415/09, paragraph 53.

[11] *Walton International Ltd & Anor v Verweij Fashion BV,* [2018] EWHC 1608 (Ch), (which is also a decision by Arnold LJ, or Arnold J as he then was, that predates his decision in *easyGroup Ltd*).

[12] Ibid., paragraphs 114 and 115.

the Court of Justice has laid down additional principles to those summarised above which I would summarise as follows:

(9) The territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to genuine use in the Union: *Leno* at [44], [57].

(10) While it is reasonable to expect that a EU trade mark should be used in a larger area than a national trade mark, it is not necessary that the mark should be used in an extensive geographical area for the use to be deemed genuine, since this depends on the characteristics of the goods or services and the market for them: *Leno* at [50], [54]–[55].

(11) It cannot be ruled out that, in certain circumstances, the market for the goods or services in question is in fact restricted to the territory of a single Member State, and in such a case use of the EU trade mark in that territory might satisfy the conditions for genuine use of a EU trade mark: *Leno* at [50].”

21. Therefore, the Opponent can rely on its earlier trade mark only to the extent that the evidence filed establishes that the earlier trade mark had been put to genuine use in respect of the goods for which it is registered during the relevant period. The relevant period for assessing genuine use is the five-year period ending with the priority date claimed for the application in issue i.e. **22 December 2017 to 21 December 2022**.

22. Since the earlier mark is a comparable mark (EU), use in the EU remains relevant because a part of the relevant five-year period falls prior to IP Completion Day (i.e. before 31 December 2020). Therefore the Opponent can rely upon genuine use of the corresponding EUTM in the EU, including the UK, prior to IP Completion Day. However, any genuine use after IP Completion Day (i.e. 1 January 2021) must relate solely to use in the UK.

Proof of use evidence

23. Mr Kratochvíl gives evidence that the Opponent (a company based in the Czech Republic) creates, distributes and sells alcoholic beverages in the UK and overseas and that one of its “core brands is SERUM, which acts as a trade mark for an alcoholic

rum beverage". He states the "SERUM rum brand" was first used in the EU in 2018 and its use in the UK began in 2020.

24. The Opponent's rums are distilled and aged in Panama and have been sold and marketed by the Opponent under the SERUM brand since 2018. The core range extends to three varieties of rum each having differing flavour profiles, named 'Elixir' (a rum aged up to 8 years),[13] 'Gorgas' (a rum aged for 5 years),[14] and 'Ancon' (a rum aged for 10 years). In addition, in 2020 'SERUM Puente Centenario' was added to the range – a 2004 vintage rum released in a limited edition of only 3000 bottles.[15]

25. Pre-2020, 'SERUM' was displayed on the rum bottle labels and bottle neck foils in the following form:[16]

26. An example of the pre-2020 packaging of the 'Elixir', 'Gorgas' and 'Ancon' SERUM rums is shown below on the brand's website 'www.rumserum.com' in August 2019:[17]

[13] Exhibit MK2 page 11.

[14] Exhibit MK5 page 30.

[15] Exhibit MK2 page 12.

[16] Exhibit MK3, page 16.

[17] Exhibit MK2 page 10, dated 29 August 2019. Also see images of the bottles posted on the 'Rum Serum' Facebook and Instagram social media pages taken at events in Paris, France and Berlin, Germany both in 2018 – Exhibit MK3.

27. Following the announcement of a new packaging design in 2020,[18] SERUM appeared on the rum bottle labels and bottle tops in the following form:

28. Images of the new packaging design, which won gold at the 2020 spirits industry 'Design & Packaging Masters' awards held in London,[19] are shown below.[20] The award was promoted in December 2020 on the 'Rum Serum' Facebook page.[21]

[18] Exhibit MK6.

[19] Exhibit MK3, page 23 and Exhibit MK5.

[20] Exhibit MK3 and MK5.

[21] Exhibit MK3, page 23.

29. As can be seen from the two images above, SERUM appears in a stylised form on the label and bottle stopper; it also appears embossed on the glass bottle itself, written vertically in plain text on either side of the printed label.

30. The following "approximate sales in the UK and EU" of the Opponent's "rum beverages sold under the trade mark SERUM" have been provided:[22]

	Sales
2018	€64,253
2019	€109714
2020	€122975
2021*	€5,358
2022*	€5,316

* UK only

31. The following "approximate volume of rum beverages sold in the UK and EU under the trade mark SERUM" have been provided:[23]

	Volume in Bottles
2018	7559
2019	12968
2020	13817
2021*	462
2022*	504

* UK only

32. Three invoices dated November 2020, April 2021, and November 2022 show sales of 'SERUM ELIXIR', 'SERUM GORGAS', 'SERUM ANCON', and 'PUENTE CENTENARIO' to UK-based customers – Craft Rum Box Limited and Thirsty Brands Limited – both at 105 Oyster Lane, West Byfleet, Surrey.[24] A Facebook post confirms

[22] Witness statement of Mr Kratochvíl, paragraph 8.

[23] Witness statement of Mr Kratochvíl, paragraph 9.

[24] Exhibit MK1.

'Serum Gorgas' is available via craftrumbox.co.uk.[25] The 2022 invoice (in English) matches the figures in the tables above (504 bottles sold for €5,316), indicating the values reflect wholesale, not retail, volumes and prices. The 2020 and 2021 invoices are untranslated.

33. The following "estimated marketing and promotional spend in the EU and the UK in relation to the SERUM rum products" have been provided:[26]

	Advertising and Promotional Spend
2018	€38,551
2019	€9,792
2020	n/a
2021*	€9,715
2022*	€14,890

* UK only

34. Mr Kratochvíl states that the Opponent's promotional activities include attendance at trade fairs such as one held in London in 2022 – images from this event show the exhibition of two product ranges, one being the 'SERUM' rum range and the other a range of gins named 'Mintis Gin';[27] and promotion via social media platforms, namely via the 'Rum Serum' accounts on Facebook and Instagram.[28]

35. Mr Kratochvíl states that "the SERUM rum product has also been bestowed a number of awards since its inception, including by industry-leading bodies such as the 'Spirits Design Masters' and 'International Wine and Spirits Competition' ["IWSC"]. Examples of these awards are attached at Exhibit MK5."[29] I note that 'Serum Gorgas'

[25] Exhibit MK3, page 24.

[26] Witness statement of Mr Kratochvíl, paragraph 11.

[27] Witness statement of Mr Kratochvíl, paragraph 14 and supporting Exhibit MK4.

[28] Exhibit MK3.

[29] Witness statement of Mr Kratochvíl, paragraph 15.

won the bronze medal in 2018 at the IWSC held in London;[30] 'Serum Puente Centenario' and 'Serum Ancon' each won a bronze medal at the 2021 IWSC.[31]

Conclusions on the proof of use evidence

36. The 2022 sales figures (at least) appear to reflect wholesale rather than retail sales. Even so, I am mindful of Neuberger LJ's comments in *Laboratoire de la Mer Trade Mark*,[32] namely that:

> "49. A wholesale purchaser of goods bearing a particular trade mark will, at least on the face of it, be relying upon the mark as a badge of origin just as much as a consumer who purchases such goods from a wholesaler. The fact that the wholesaler may be attracted by the mark because he believes that the consumer will be attracted by the mark does not call into question the fact that the mark is performing its essential function as between the producer and the wholesaler."

37. Furthermore, although it appears that the goods were not sold directly to the UK public in 2022, but rather to UK-based wholesale customers, the Opponent still promoted the brand to the public via Facebook.[33] In *Fruit of the Loom v EUIPO*, a clothing-related case (but nonetheless relevant here), the General Court said:

> "50. It must be stated that, in a market such as that of the European Union, in order to create or preserve an outlet for goods such as those at issue in the present case, it is common (and even necessary where a manufacturer of such goods does not have its own distribution channels) to direct commercial acts at professionals in the sector concerned and particularly at resellers. […]
>
> 51. It must therefore be held that the Board of Appeal was not entitled to rule out the genuineness of the use relied upon by the applicant solely because the commercial acts invoked by the applicant were not directed at end consumers."

[30] Exhibit MK3, page 16.

[31] Exhibit MK3, page 25.

[32] [2006] FSR 5

[33] Exhibit MK3, page 24.

38. As wholesale prices are typically lower than retail prices, the number of bottles sold by the Opponent provides a clearer picture of sales volume. Although sales from 2018 to 2022 were relatively low, I do not consider the apparent low sales volumes to be a bar to making a finding that the use shown is genuine.

39. In *Laboratoire de la Mer Trade Mark,*[34] Neuberger L.J. also addressed the question of "minimal" use, concluding that the case law makes it clear that "minimal" use will not of itself disqualify the use from being "genuine",[35] and that when addressing the question as to whether use is sufficient to preserve or create market share, one should not adopt the approach that *"in order to be genuine, the use of the mark must be such as to achieve a significant market share",*[36] and that *"once the mark is communicated to a third party in such a way as can be said to be 'consistent with the essential function of a trade mark' as explained in [36] and [37] of the judgment in Ansul, it appears to me that genuine use for the purpose of the directive will be established."*[37]

40. Although no promotional spend was reported in 2020, this is not detrimental. That year saw the launch of a new product, a packaging redesign promoted on Facebook, and the highest sales volume in the 2018–2022 period.

41. While no data has been provided on the size of the alcoholic beverages or rum markets in the EU and UK, both are likely substantial. SERUM appears to hold only a small share based on reported sales. However, despite being a relatively new entrant (launched in 2018), the brand has gained recognition in the spirits industry through awards, suggesting it has not gone unnoticed.

42. Taking all the foregoing into account, I consider genuine use of the earlier mark has been established.

<u>Form of the mark</u>

43. The mark has been used in plain text embossed on the 2020 bottle design - this is clearly use on which the Opponent can rely. The 'SERUM' mark has also been used

[34] [2006] FSR 5

[35] Ibid. paragraph 43.

[36] Ibid. paragraph 44.

[37] Ibid. paragraph 48.

in two stylised variants throughout the period (see my paragraphs 25 and 27). Section 6(A)(4)(a) of the Act envisages that the obligation to use the trade mark registered may be fulfilled by furnishing proof of use of the sign which constitutes the form in which it is used in trade.[38] The purpose of this provision is to avoid imposing strict conformity between the used form of the trade mark and the form in which the mark was registered, and therefore to allow its proprietor, on the occasion of its commercial exploitation, to make variations in the sign, which, without altering its distinctive character, enable it to be better adapted to the marketing and promotion requirements of the goods or services concerned.[39] The identified stylised variants can be regarded as broadly equivalent to the registered mark, differing only in negligible elements which do not alter its distinctive character, and such use therefore still qualifies as genuine.[40]

Fair specification

44. The Opponent's registration is not limited to any specific alcoholic beverage, spirit or liquor. I have therefore considered whether reliance on the broad terms of the registration is justified based on the use shown, or whether a narrower, fair specification should be applied.

45. In making this consideration I have regard to the approach set out by the Court of Appeal in *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834,[41] wherein Kitchin LJ (as he then was) summarised the relevant principles as follows:

> "245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.
>
> 246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in

[38] See the General Court ruling in T-194/03 *Il Ponte Finanziaria* [2006] ECR II-445 at paragraph 50 (not overturned by the Court of Justice C-234/06 *Il Ponte Finanziaria* [2007] ECR I-7333).

[39] Ibid.

[40] See *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22.

[41] Paragraphs 245 to 249 of that decision. Also see related case law in relation to 'fair specification': *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10; *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch).

relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. […] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered."

46. In *Sky Ltd v SkyKick UK Ltd* [2024] UKSC 36, Lord Kitchin (as he had by then become) explained at [261] that the above approach he had set out in *Merck* (my emphasis):

"… must now be seen in light of the more recent guidance given by the CJEU in, for example: *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paras 36-53. There the CJEU explained, at para 40, that the essential criterion to apply for the purposes of identifying a

coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use."

47. In *easyGroup Limited v Easy Live (Services) Limited & Ors* [2025] EWCA Civ 946, Arnold LJ addressed the law relating to independent subcategories in cases of genuine use and referred with approval to Kitchin's approach, noting that the earlier decision of the CJEU in Case C-714/18 P *ACTC GmbH v European Union Intellectual Property Office* [EU:C:2020:573] at [44] established the same proposition Lord Kitchin had extracted from *Ferrari.* Arnold LJ reviewed the facts of the two decisions of the CJEU in detail (both of which are assimilated law), noting that in *ACTC*, the CJEU said at [50], "the aim of the criterion of the purpose and intended use of the goods in question is not to provide an abstract or artificial definition of independent subcategories of goods; it must be applied coherently and specifically."

48. Turning to the evidence before me I note that it shows that the only ranges of products sold and marketed under the SERUM brand during the relevant period are rums; indeed, this aligns with Mr Kratochvíl's statement that SERUM "acts as a trade mark for an alcoholic rum beverage". There is no evidence before me that the Opponent's product offering under the SERUM brand extends to anything other than rum.

49. The earlier mark is registered in respect of the broad category alcoholic beverages; as well as spirits and liquors (liquors being flavoured spirits which are typically sweetened). On a superficial level, all alcoholic beverages share the same purpose and intended use, as do all spirits i.e. they are consumed for enjoyment, typically in celebratory and social contexts, and can enhance dining experiences i.e. they are not generally consumed for hydration or nutrition. However, the terms 'alcoholic beverages' and 'spirits' are sufficiently broad that it is possible to identify within them a number of coherent subcategories capable of being viewed independently – rum being a distinct and independent subcategory of the registered terms. Taking the foregoing into account, I conclude that the genuine use shown does not warrant a reliance on the broad terms for which the mark is registered. Accordingly, a fair specification on which the Opponent can rely is therefore "rum" and I shall proceed on this basis.

Comparison of goods

50. The goods to be compared are shown in the table below.

Opponents' fair specification	Applicant's specification
Class 33: Rum	Class 32: Energy drinks, energy drinks enhanced with nootropics, nootropics drinks, energy drinks enhanced with vitamins and minerals, sugar free energy drinks, carbonated energy drinks; syrups and other non-alcoholic preparations for making beverages namely concentrates, syrups or powders used in the preparation of energy drinks.

51. When considering whether goods are similar, all the relevant factors relating to the goods should be taken into account. Those factors include, inter alia:[42]

(1) the physical nature of the goods;
(2) their intended purpose;
(3) their method of use / uses;
(4) who the users of the goods are;
(5) the trade channels through which the goods reach the market;
(6) in the case of self-serve consumer items, where in practice they are found or likely to be found in shops and in particular whether they are, or are likely to be, found on the same or different shelves; and
(7) whether they are in competition with each other (taking into account how those in trade classify goods, for instance whether market research companies put them in the same or different sectors);
or
(8) whether they are complementary to each other.

[42] See *Canon*, Case C-39/97, paragraph 23; and *British Sugar PLC v James Robertson & Sons Ltd.,* [1996] R.P.C. 281 – the *"Treat"* case

52. 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"*.[43] Complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity,[44] and it can be clearly distinguished from 'use in combination' – the latter being where goods/services are merely used together, whether by choice or convenience (e.g. bread and butter; or wine and wine glasses[45]), this means that they are not essential for each other.

53. Section 60A(1)(a) of the Act provides that goods are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification, nor dissimilar to each other on the ground that they appear in different classes under the Nice Classification.

54. In *Absolut Company Aktiebolag v Dongguan Topson Electronic Technology Co Ltd*, BL O/0488/25 (ELUX), the issue on appeal before Professor Philip Johnson sitting as the Appointed Person concerned the assessment of similarity between alcoholic products and other beverages. Prof. Johnson first addressed a number of cases before the General Court dealing with such an assessment, setting them out at [9] as follows, noting that two in the list are not assimilated case law (my underlining at (viii) as emphasis):

(i) T-296/02 *Lidl Stiftung & Co v OHIM* [2005] ECR II-563 (sparkling wine and non-alcoholic drinks were found to be more dissimilar than similar)
(ii) T-175/06 *Coca Cola v OHIM* [2008] ECR II-1055 (MEZZOPANE) (there was found to be little similarity between beer and wine)
(iii) T-430/07 *Bodegas Montebello*, EU: T:2009:127 (rum and wine were found to be dissimilar);

---

[43] *Boston Scientific Ltd v OHIM,* Case T-325/06, paragraph 82

[44] *Kurt Hesse v OHIM*, Case C-50/15 P

[45] As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amalia Mary Elliot v LRC Products Limited,* BL O/255/13 - *"It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes."*

(iv) T-421/10 *Cooperativa Vitivinícola Arousana* v OHMI (ROSALIA DE CASTRO) [2011] ECR II-347 (a low degree of similarity was found between alcoholic and non-alcoholic beverages)

(v) T-278/10 *Wesergold Getrankeindustrie v EUIPO*, EU:T:2012:459 (a low degree of similarity was found between spirits and non-alcoholic beverages)

(vi) T-584/10 *Yilmaz v OHIM*, EU:T:2012:518 (tequila and beer were said to be dissimilar)

(vii) T-150/17 *Asolo Ltd v EUIPO*, EU:T:2018:641 (FLÜGEL) (<u>alcoholic and energy drinks were found to be dissimilar</u>)

(viii) T-378/17 *La Zaragozana v EUIPO*, EU:T:2018:888 (CERVISIA) (beer and non-alcoholic beer were said to be highly similar; whereas beer and non-alcoholic drinks were held to be averagely similar)

(ix) T-195/20 *Sociedade da Água de Monchique, SA v EUIPO*, EU:T:2021:601 (CHIC) (water and alcoholic beverages (except beer) were said to be dissimilar)

(x) T-437/22 Vanhove v EUIPO, EU:T:2023:246 (brandy and wine were found to have a low degree of similarity).

55. Further considering the goods in issue, Prof. Johnson referred to the following cases:

(i) *ZORAYA* (R 964/2020-G, 13 April 2022) – in which the Grand Board of Appeal examined the evolving market for alcohol-free (0% ABV) drinks.

(ii) *ICEBERG* (R 1720/2017-G, 21 January 2019) – the Grand Board found vodka and non-alcoholic beverages to be dissimilar.

(iii) *BALMORAL TM* [1999] RPC 297 – it was held that whisky and wine might be perceived as originating from the same undertaking, particularly in the context of store-branded products.

(iv) *CALEDONIAN* (O/382/16) – the Appointed Person upheld the finding that whisky and beer were only similar to a low degree, (but it was also accepted that a finding the products were dissimilar would not have been open to challenge).

56. Prof. Johnson noted that it is important to remember that the outcomes of the cases he cited are fact-dependent and that they are not binding in the strictest sense. However, he noted relevant considerations set out in all these decisions that may be applied to other cases, namely:

> “13. First, the fact that spirits are mixed with soft-drinks (mixers) does not make the products complementary (*Yilmaz*, [55]; *Wesergold*, [40]; *CHIC*, [53 to 55]), but it does mean there is a partial (but not significant) overlap between spirits and soft drinks (*Wesergold*, [32 and 33]).
>
> 14. Second, soft-drinks, water and (possibly) beer are drunk to quench the thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]; *ROSALIA DE CASTRO*, [31]; the *CHIC* case takes a different view that low alcoholic drinks are not consumed to quench thirst, CHIC, [44]), but in any event spirits are not consumed to quench thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]).
>
> 15. Thirdly, the methods of production for alcoholic drinks (and between alcoholic drinks and non-alcoholic drinks) differ and this is relevant to the similarity between them: *Mezzopane*, [64 and 69]; *Bodegas*, [29]; *Yilmaz*, [54]. Likewise, products which are processed versions of each other might be more similar (e.g. wine and Brandy): *Vanhove*, [87].
>
> 16. Fourthly, the differences between the colour, aroma and taste of two alcoholic drinks suggests to consumers that they are different: *Mezzopane*, [65]; *Yilmaz*, [54].
>
> 17. Finally, the alcoholic content of the goods is a very relevant factor in determining the similarity of the goods: *Bodegas*, [32]; *Wesergold*, [31]; *CHIC*, [40 and 41]; *FLÜGEL*, [84]. However, a non-alcoholic version of an equivalent alcoholic drink is likely to be highly similar to it: *CERVISIA*, [20]. Nevertheless, the Grand Board highlighted that a drink’s alcoholic content is only a factor in the assessment of similarity and is not determinative: *ZORAYA*, [68].

57. The Applicant denies any similarity between alcoholic beverages and its energy drinks. Mr Van der Linde cites the *Encyclopaedia Britannica* (see Exhibit JEV5),

describing energy drinks as beverages containing stimulants like caffeine, sugar, and supplements, capable at enhancing alertness and physical performance. He also references the '*drinkaware.co.uk'* website (see Exhibit JEV5), I note that this states that many alcoholic drinks, particularly spirits like gin, vodka and whisky, are mixed with fizzy drinks.

58. Mr Van der Linde asserts that the Applicant's energy drinks contain no alcohol and there is no intention to use the mark for alcoholic or low-alcohol beverages. He states that if sold in UK bars or supermarkets, the product would likely be placed in the non-alcoholic section, not near alcoholic drinks. He also notes the lack of evidence that the Opponent sells non-alcoholic drinks under the SERUM mark or that spirit producers commonly diversify into energy drinks.

59. He further distinguishes the parties' products by packaging and composition i.e.: the Applicant's energy drink is sold in cans, not glass bottles; it contains no sugar whereas alcohol contains sugar; it is carbonated, undistilled, and bright green in colour – features that he submits visually and functionally differentiate the Applicant's energy drink from the Opponent's rum.

60. Mr Britter provides the Opponent's evidence in reply stating that it consists of *"extracts from UK-facing websites demonstrating that alcoholic beverages are commonly sold with soft drinks, including 'energy drinks', as ready-to-drink products"*.

61. The evidence comes from the websites of the following retailers: 'Drink Supermarket', 'Tesco' and 'Asda' and show images of products for sale in cans which consist of spirits mixed with fizzy drinks – namely 'gin & tonic'; 'rum & cola'; 'whiskey & cola'; 'vodka & energy drink'. With regard to the latter, the evidence shows a product called 'Dragon Soop' – the information about the product is as follows: "cocktails combining vodka with caffeinated energy drinks have long been popular in clubs, pubs and bars. Dragon Soop takes this informal, self-mixed innovation and turns it into a caffeinated alcoholic cocktail in a chillable can; a ready mixed and ready to drink response to the demand for those types of drinks."[46]

[46] Exhibit BNB1, pages 3 to 6.

62. I now turn to the comparison of the goods before me, grouping them together where the same reasoning applies.

Energy drinks, energy drinks enhanced with nootropics, […] energy drinks enhanced with vitamins and minerals, sugar free energy drinks, carbonated energy drinks.

63. Broadly speaking, the above goods can be characterised as 'energy drinks', therefore the comparison fundamentally is between 'rum' and 'energy drinks'.

64. Rum is a distilled alcoholic spirit, while energy drinks are non-alcoholic, typically carbonated, and contain stimulants like caffeine. Their only shared characteristic is that they are both beverages, which is too general to establish similarity in nature. Comparing them based on this alone would be akin to making a likely unsupportable finding that beef steak is similar in nature with lettuce because both are foods.

65. Alcoholic spirits like rum are consumed for enjoyment in social or celebratory contexts, not for hydration. In contrast, energy drinks are consumed for stimulation and refreshment. Thus, they differ in purpose, and method of use.

66. Rum is regulated differently from energy drinks, as only those aged 18 and over can legally purchase alcohol in the UK. While some over-18s may consume both rum and energy drinks, this overlap in user is on too general a level to establish a meaningful similarity between the goods.

67. There is no competition between the goods. A consumer choosing a non-alcoholic drink over rum does not imply substitutability; rum does not offer the energy or stimulation that energy drinks do.

68. While energy drinks may be stocked in close proximity to rum in some settings, such as pubs, they are generally sold in different sections (even in smaller settings such as pubs) – rum with spirits, energy drinks with soft drinks. Shared retail outlets do not equate to shared trade channels.

69. Rum may be mixed with certain soft drinks – for example, rum and cola – but this does not make the goods complementary; this is simply a case of use in combination, which is distinct from complementarity. Likewise, the existence of RTD (ready-to-drink) products containing vodka and energy drinks does not alter this conclusion. RTDs are

pre-mixed for convenience and do not imply that the individual components are similar. They occupy a separate segment of the alcoholic beverages market, distinct from spirits like rum.

70. In *Wesergold* at [33], the General Court confirmed that the fact that spirits can be mixed with non-alcoholic drinks in a pre-packaged form does not alter the fact that spirits are also sold and consumed unmixed. I agree – evidence of a pre-mixed vodka and energy drink does not demonstrate that rum (or spirits) are essential to energy drink consumption – both can be consumed and purchased independently. At [35], the General Court further held that even if some producers manufacture both spirits and non-alcoholic drinks, this does not alter the general consumer perception that they come from different undertakings, especially given their distinct production methods; and that the Board of Appeal was justified in concluding that the public does not typically associate alcoholic and non-alcoholic beverages with the same source. I also agree with these findings.

71. As Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person noted in *Tony Van Gulck v Wasabi Frog Ltd*,[47] a finding of complementarity does not automatically equate to similarity if the complementarity is not sufficiently pronounced to suggest, from the consumer's perspective, the goods are similar within the terms of section 5(2)(b) of the Act.[48]

72. Even if some complementarity could be said to exist due to consumers mixing rum with energy drinks – which I do not accept – any resulting degree of complementarity would in my opinion be insufficient to establish similarity. The goods differ significantly in production methods, and consumers are likely to perceive them as originating from separate undertakings, which undermines and points away from a finding of complementarity in any event.

73. Finally, there is no evidence nor case law before me which suggests that treating spirits (including rum) as dissimilar to energy drinks would be insupportable. I find no similarity between the above applied-for goods and rum.

[47] BL O/391/14, see paragraphs 19 and 22.

[48] Ibid., paragraph 22.

Syrups and other non-alcoholic preparations for making beverages namely concentrates, syrups or powders used in the preparation of energy drinks.

74. These products are one step removed from ready-to-consume energy drinks, but in line with my earlier conclusions regarding energy drinks, these syrups and preparatory goods are dissimilar to *"rum"*.

Nootropics drinks

75. Nootropics are compounds that enhance cognitive performance – caffeine being a common example. Nootropic drinks offer sustained energy release and, while their ingredient blends may differ from typical energy drinks, they are similarly intended to boost energy and alertness. For the purposes of this assessment, they share the same essential characteristics as energy drinks and are dissimilar to *"rum"* based on the reasoning I set out above.

76. Taking all the above into consideration, I find that the Opponent's *"rum"* is dissimilar to all the goods contained in the applied-for specification.

77. Although the competing marks are identical, a likelihood of confusion under section 5(2)(b) of the Act requires at least some similarity between the goods.[49] As no such similarity exists, there can be no likelihood of confusion, and the opposition therefore fails.

OUTCOME

78. The opposition under section 5(2)(b) of the Act fails. Subject to appeal, trade mark application number 3886482 shall proceed to registration for all the goods applied for.

COSTS

79. The Applicant has been successful and is entitled to a contribution towards its costs, assessed in line with the scale set out in Tribunal Practice Notice (1/2023). In determining the amount, I have considered that the Applicant's evidence was largely

[49] *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, paragraph 49

unnecessary. In the circumstances, I award the Applicant £550, apportioned as follows:

Preparation of the Notice of Defence and Counterstatement	£250
Preparing evidence	£300
TOTAL	**£550**

80. I therefore order Kratochvílovci spol. s r.o. to pay ENERGY SERUM GLOBAL (PTY) LTD the sum of **£550**. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 24th day of October 2025

Daniela Ferrari

For the Registrar