

O-286-15

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3035040
BY JEFFREY JOSHUA LAWRENCE
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33:**

Tiger Gin

AND

**AN OPPOSITION THERETO (NO. 401974) BY
HEINEKEN ASIA PACIFIC PTE. LTD**

Background and pleadings

1. This dispute concerns whether the trade mark **Tiger Gin** should be registered for gin in class 33. The mark was filed by Mr Jeffrey Joshua Lawrence on 16 December 2013 and was published for opposition purposes on 24 January 2014.

2. Registration is opposed by Heineken Asia Pacific Pte. Ltd (“the opponent”). Its grounds are under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following two trade mark registrations:

i) UK registration 2240911 for the mark **TIGER** which was filed on 26 July 2000 and which completed its registration process on 23 November 2001. The mark is registered in respect of “lager and goods in the nature of lager” in class 32.

ii) International registration 839125 which designated the EU for protection on 16 November 2004 with protection being conferred on 30 March 2006. The mark is protected in respect of “beer, ale and stout” in class 32.

3. The opponent states that its marks have been used, and have a reputation, for all their registered/protected goods. In relation to the claim under section 5(4)(a), the opponent relies on the use of the sign **TIGER** since January 1970 in respect of lager beer. The opponent’s main claims are:

a) The respective marks are “very closely similar”.

b) The goods are similar on account of there being the same users, that they are all alcoholic beverages, that various producers produce gin (and other spirits) and the earlier mark(s)’ goods.

c) There is a “very real” likelihood of confusion; it adds that Tiger Gin could be seen as an extension of the opponent’s TIGER branded alcoholic beverages.

d) The applicant would take unfair advantage of the opponent’s reputation because consumers would assume that there is an economic connection.

e) There is unfair advantage because sales made by the applicant would be the result of the opponent’s reputation.

f) The offering of less adequate goods could impact on the opponent.

g) The use of the applicant’s mark would result in a loss of exclusivity.

h) The opponent has goodwill in the UK in relation to lager beers and the use of the applied for mark would be preventable under the law of passing-off.

4. Mr Lawrence filed a counterstatement. He put the opponent to proof of use of its earlier marks but added that he would waive this request if the applicant accepted that the only goods for which the marks had been used were “lager beers”. Mr Lawrence does not consider the goods to be similar. He accepts, though, that the marks are similar and that the “trade mark aspect” of his mark is the word Tiger. He believes that the goods are sufficiently different so that there would be no confusion and that there would be no unfair advantage, detriment or dilution of the earlier mark’s reputation/distinctive character. He denies that the use of his mark would constitute a misrepresentation.

5. Both sides are professionally represented. The opponent is represented by D Young & Co LLP, the applicant by Nucleus IP Limited. Both sides filed evidence. A hearing took place before me on 28 May 2015. The applicant was represented by Mr Malcolm Chapple, of counsel, instructed by Nucleus IP Limited. The opponent was represented by Mr Richard Burton of D Young & Co.

6. It is worth noting the following two points that were accepted at the hearing:

- i) The applicant accepted that genuine use had been made of the opponent's **TIGER** mark in the UK in the relevant period in respect of lager beer. The opponent agreed that it was sufficient to rely purely on these goods for the purposes of its opposition. Consequently, I do not need to consider the proof of use provisions, the position having been accepted and agreed. Nor do I need to differentiate between the two earlier marks; I will refer to them in the singular from this point forward.
- ii) The applicant accepted that the respective marks were highly similar. No case was put forward by the opponent that the marks were identical (it argued for near identity) so the respective positions are not materially different, nor do they differ from mine which is that there is a very high degree of visual, aural and conceptual similarity between the marks, particularly when one bears in mind that the only difference between them is the addition of the name of the goods (gin) in the applied for mark.

The evidence

7. I will return to the evidence when it becomes relevant to the issues that need to be determined. For the record, those who have given evidence are:

Opponent's evidence

8. Two witness statements were provided by Mr Cyril Charzat, the opponent's group marketing and sales Director. His evidence is primarily about the use that has been made of the opponent's mark. At the hearing, Mr Chapple submitted that Mr Charzat's evidence should be treated as "unreliable" because the statement of truth he made does not match the wording outlined in the Civil Procedure Rules ("CPR") and, furthermore, that he has only worked for the opponent since 2013 and therefore his knowledge of previous facts must be hearsay. I do not accept these submissions. The wording of Mr Charzat's statement of truth is essentially the same as the CPR and, furthermore, he has confirmed that this evidence comes from his own knowledge or from the records of the company. I do not agree that the reliability of this evidence should be called into question, especially bearing in mind that these concerns were not put to the opponent earlier in the proceedings. However, I still need to determine what can be taken from the evidence and what the evidence establishes; this will be discussed later.

Applicant's evidence

9. A witness statement was provided by Mr Nicholas Preedy, the applicant's trade mark attorney. His evidence relates primarily to exchanges of communication that took place between the parties and is also used to introduce into the proceedings a decision in a previous case, *OLD TOM*, which involved a similar dispute. Mr Preedy also comments upon the opponent's evidence.

Opponent's reply evidence

10. A witness statement was provided by Mr Burton, the opponent's trade mark attorney, who gives evidence about goods similarity.

Section 5(2)(b)

11. Section 5(2)(b) of the Act states that:

“5.(2) A trade mark shall not be registered if because –

(a) ...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.”

12. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of marks

13. Given what I have said in paragraph 6, there is no need to make a detailed assessment. The marks have a very high degree of visual, aural and conceptual similarity.

Comparison of goods

14. The comparison of goods is one of the key factors in this case. Put simply, the question is whether gin is similar to lager beer and, if so, to what degree? When making this determination, all relevant factors relating to the goods should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer* the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their

intended purpose and their method of use and whether they are in competition with each other or are complementary.”

15. Guidance on this issue has also come from Jacob J In *British Sugar Plc v James Robertson & Sons Limited* [1996] RPC 281 where the following factors were highlighted as being relevant when making the comparison:

- “(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.”

16. In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), this relates to close connections or relationships that are important or indispensable for the use of the other. In *Boston Scientific Ltd v OHIM* Case T- 325/06 the General Court (“GC”) stated:

“It is true that goods are complementary if 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 (see, to that effect, Case T-169/03 Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI) [2005] ECR II-685, paragraph 60, upheld on appeal in Case C-214/05 P Rossi v OHIM [2006] ECR I-7057; Case T-364/05 Saint-Gobain Pam v OHIM – Propamsa (PAM PLUVIAL) [2007] ECR II-757, paragraph 94; and Case T-443/05 El Corte Inglés v OHIM – Bolaños Sabri (PiraÑAM diseño original Juan Bolaños) [2007] ECR I-0000, paragraph 48).”

17. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case B/L O/255/13 *LOVE* where he warned against applying too rigid a test:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is

neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston.”

18. It should be noted that these proceedings constitute a second opposition against Mr Lawrence’s trade mark application. The first opposition has already been determined in Mr Lawrence’s favour, a dispute which involved a very similar conflict to that here. In the first opposition the Hearing Officer, Mrs Judi Pike, said this in relation to the conflict between the goods, a conflict which included beer on the one hand and gin on the other:

“13. The opponent has been entirely silent as to why it considers the goods and services to be similar. Its only reference to the goods and services is in its notice of opposition where it merely states that they are similar. The applicant, via Mr Preedy’s evidence, relies upon my *Old Tom* decision, in which I said (the references to liqueurs and cocktails are not relevant to this decision):

“15. The Collins English Dictionary (2000 edition) primary definition of ‘ale’ is “a beer fermented in an open vessel using yeasts that rise to the top of the brew.” Collins Dictionary gives the following definitions of liqueurs and cocktails:

gin: “an alcoholic drink obtained by distillation and rectification of the grain of malted barley, rye, or maize, flavoured with juniper berries”;

liqueur: “any of several highly flavoured sweetened spirits such as kirsch or cointreau, intended to be drunk after a meal”;

cocktail: “any mixed drink with a spirit base, usually drunk before meals.”

16. Ale is sold in bottles, cans, crates or by the pint/half pint in the UK. Gin, liqueurs and cocktails are sold in much smaller measures in bars, commensurate with their much higher potency. They are sold in varying sizes of bottles in shops, but would not be drunk in the same quantity as is the case for ale. Mr Maslyukov states in his counterstatement that:

“The comparative approach may also be done by the volume of consumption. The filling method for the ale and for the gin is radically different. The gin is basically filled into the small cup of 50ml – the ale is filled into the big cup of 500-1000ml. It is enough to look on a famous art work “Gin Lane” and “Beer Street” issued by English artist William Hogarth in 1751 to understand the dramatic difference in the effect of the goods when consumed on a daily basis. Also the approach may be done by comparing the method of production which is radically different for the gin and for the ale. The smell of the two goods is

radically different too, because the one is made by distillation and another - by fermentation.”

Mr Maslyukov’s comments are reminiscent of the findings of the GC in two cases. In *The Coca-Cola Company v OHIM*, Case T-175/06, the GC considered beer, ale and porter as opposed to wine, noting the difference in colour, taste, smell, ingredients and production methods. It considered that the relevant consumer would consider beer and wine as two distinct products, not belonging to the same family of alcoholic beverages. It found that they were not complementary but that they competed, to a certain extent, because they were both capable of meeting identical needs (consumption during a meal or as an aperitif). However, the Court said that it must be accepted that the average consumer would consider it normal for the two types of product to come from different undertakings, since the perceived differences between them would also make it unlikely that there would be an expectation that the same undertaking would produce and market the two types of beverage. The Court noted that, in Austria, there is a tradition of producing both beer and wine and that this is done by different undertakings. Its conclusion was that there was little similarity between wines and beers (that there was any was purely on account of the possible competition between them, as mentioned above). In *Bodegas Montebello, SA v OHIM*, Case T-430/07, the Court made a comparison in that case between wine and rum. It found that wine and rum are not composed of the same ingredients, their method of production is also different, and the end products are different as regards their taste, colour and smell. Consequently, the public perceives wine and rum as different in nature. It also found that wines are normally consumed as an accompaniment to a meal but that rum is not served at a meal, so that the two types of product are consumed on different occasions. The Court observed that the alcoholic content of the two products is very different and that even though the wine and rum might share distribution channels, they will not generally be sold on the same shelves. The Court considered there was no competing or complementary consideration and concluded that wine and rum are clearly distinguished by their nature, method of production, provenance, use and alcoholic content, with the overall result that there was no similarity between them.

17. The findings of the GC are helpful in making a comparison between ale, on the one hand, and gin and gin-based drinks on the other. Although, for example, lemonade can be added to ale to make a shandy, I bear in mind that ale is generally drunk without modification whereas gin is usually drunk in combination with another component, such as tonic water or a fruit juice as a mixer. Even though they both contain alcohol, the nature of the goods is quite different: they do not belong to the same family of alcoholic beverages. As in the first of the two GC cases, it is my perception that, in the UK, the two types of product would come from different undertakings. There has been no evidence to suggest otherwise. I bear in mind that the GC said that

beer and wine compete to a certain extent because they are both capable of meeting identical needs: consumption during a meal or as an aperitif. In the case before me, I think there is a further distance in that ale is not traditionally regarded as an aperitif and gin, liqueurs and cocktails are not commonly drunk during a meal. The goods are very different in relation to taste, colour, smell, alcoholic content and the measures in which they are sold. The goods are sold in different areas of shops and bars and there is no evidence of common producers of ale and gin, or of common ingredients.

18. For all these reasons, I conclude that there is no similarity between *ale* and *gin*...”

14. I went on to say that there was no similarity between ale and gin, but that if I was wrong, the similarity must be of a very low level. Having looked again at the *Coca-Cola v OHIM* judgment, it is useful to set out what the Court said. It concluded that there was little similarity between beer (and ale and porter) and wine:

“Comparison between wine and beer

63 So far as concerns, first, the nature, end users and method of use of wines and beers, ale and porter, it is correct, as argued by the applicant, that those goods constitute alcoholic beverages obtained by a fermentation process and consumed during a meal or drunk as an aperitif.

64 However, it must be stated – as did the Board of Appeal – that the basic ingredients of those beverages do not have anything in common. Alcohol is not an ingredient used in the production of those beverages, but is one of the constituents generated by that production. Moreover, although the production of each of those beverages requires a fermentation process, their respective methods of production are not limited to fermentation and are fundamentally different. Thus, crushing grapes and pouring the must into barrels cannot be assimilated to the brewing processes of beer.

65 Moreover, the fact that beer is obtained through the fermentation of malt, whereas wine is produced through the fermentation of the must of grapes, means that the end products generated differ in colour, aroma and taste. That difference in colour, aroma and taste leads the relevant consumer to perceive those two products as being different.

66 In addition, despite the fact that wine and beer may, to a certain extent, satisfy the same need – enjoyment of a drink during a meal or as an aperitif – the Court considers that the relevant consumer perceives them as two distinct products. The Board of Appeal was therefore correct to consider that wines and beers do not belong to the same family of alcoholic beverages.

67 As regards, next, the complementary nature of wine and beer as referred to in the case-law cited in paragraph 61 above, it should be borne in mind that complementary goods are goods which are closely connected in the sense that one is indispensable or important for the use of the other (see Case T-169/03 *Sergio Rossi v OHIM – Sissi Rossi (SISSI ROSSI)* [2005] ECR II-685, paragraph 60). In the present case, the Court considers that wine is neither indispensable nor important for the use of beer and vice versa. There is indeed nothing to support the conclusion that a purchaser of one of those products would be led to purchase the other.

68 As to whether wine and beer are in competition with each other, it has previously been held, in a different context, that there is a degree of competition between those goods. The Court of Justice thus considered that wine and beer are, to a certain extent, capable of meeting identical needs, which means that a certain measure of mutual substitutability must be acknowledged. Nevertheless, the Court of Justice pointed out that, in view of the significant differences in quality – and, accordingly, in price – between wines, the decisive competitive relationship between wine and beer, a popular and widely consumed beverage, must be established by reference to those wines which are the most accessible to the public at large, that is to say, generally speaking, the lightest and least expensive varieties (see, by analogy, Case 356/85 *Commission v Belgium* [1987] ECR 3299, paragraph 10; see also, Case 170/78 *Commission v United Kingdom* [1983] ECR 2265, paragraph 8, and Case C-166/98 *Socridis* [1999] ECR I-3791, paragraph 18). There appears to be nothing to indicate that that assessment does not also apply in the present case. Accordingly, it must be acknowledged, as the applicant indicates, that wine and beer are, to a certain extent, competing goods.

69 Finally, in accordance with the Board of Appeal's assessment, it must be accepted that the average Austrian consumer will consider it normal for wines, on the one hand, and beers, ale and porter, on the other, to come from different undertakings – and will therefore expect this – and that those beverages do not belong to the same family of alcoholic beverages. There is nothing to suggest that the Austrian public is not aware, and does not notice the characteristics distinguishing beer and wine as regards their composition and method of production. On the contrary, the Court considers that those differences are perceived as making it unlikely that the same undertaking would produce and market the two types of beverage at the same time. For the sake of completeness, it should be noted that it is well known that, in Austria, there is a tradition of producing both beer and wine, and that this is done by different undertakings. Consequently, the average Austrian consumer expects beers, ale and porter, on the one hand, and wines on the other, to come from different undertakings.

70 In the light of all of the preceding factors, the Court considers that, for average Austrian consumers, there is little similarity between wines and beers.”

15. I remain of the view that the element of competition between beer and gin is less than that between beer and wine. From my own experience, I think that a choice is more likely to be made between drinking wine and beer, e.g. when dining out, than between drinking beer and gin.

16. Paragraph 69 of the GC’s decision refers to the fact that the average Austrian consumer would consider beer and wine to come from different undertakings. I do not see that there is any difference between an Austrian and a UK consumer as far as expectations of beer producers also producing wine is concerned: it is as unlikely in the UK as it is in Austria “that the same undertaking would produce and market the two types of beverage at the same time”. This is equally true of beer and gin. The processing of beer and spirits is very different, just as the processing of beer and wine is different. The GC did not, in *Coca-Cola*, refer to proximity of sale, although it did in *Bodegas Montebello, SA v OHIM*, finding that the alcoholic content of wine and rum is very different and that even though they might share distribution channels, they will not generally be sold on the same shelves. In that case, despite the finding about shared distribution channels, the GC found that wine and rum were “manifestly different”. Shared distribution channels was a factor considered by Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Balmoral Trade Mark* [1999] RPC 297, a case earlier than the GC cases, in which he compared whisky to wine (for identical marks):

“At the heart of the argument addressed to me on behalf of the application is the proposition that whisky and wines are materially different products which emanate (and are known to emanate) from producers specialising in different and distinct fields of commercial activity. This was said to render it unlikely that a producer of whisky would become (or be expected to become) a wine producer and unlikely that a producer of whisky who did become a wine producer would market (or be expected to market) his whisky and wines under the same trade mark. I was urged to accept that this made it possible for one producer to use a mark for whisky and another producer to use the same mark concurrently for wines without any real likelihood of confusion ensuing.

I am willing to accept that wine production and the production of whisky are activities which call for the exercise of perceptibly different skills directed to the production of qualitatively different alcoholic drinks. It may be the case that few undertakings produce both whisky and wines and it may be the case that the same trade mark is seldom used to signify that whisky and wines emanate from one and the same producer. However, I am not able to say on the basis of the materials before me whether there is any substance in either of those points. Beyond that, I consider that the arguments advanced on behalf of the applicant over-emphasise the part played by producers and under-

emphasise the part played by other traders in the business of buying and selling whisky and wines.

It is common to find whisky and wines bought and sold by merchants whose customers expect them to stock and sell both kinds of products. Many such merchants like to be known for the range and quality of the products they sell. The goodwill they enjoy is affected by the judgment they exercise when deciding what to offer their customers. In some cases the exercise of judgment is backed by the use of “own brand” or “merchant-specific” labelling. Those who supply retail customers may be licensed to do so under an “off-licence” or a licence for “on and off sales” in appropriate circumstances. It is not unusual for resellers of whisky and wines to be suppliers of bar services as well.

When the overall pattern of trade is considered in terms of the factors identified by Jacob J. in the *British Sugar* case (uses, users and physical nature of the relevant goods and services; channels of distribution, positioning in retail outlets, competitive leanings and market segmentation) it seems clear to me that suppliers of wines should be regarded as trading in close proximity to suppliers of whisky and suppliers of bar services. In my view the degree of proximity is such that people in the market for those goods or services would readily accept a suggestion to the effect that a supplier of whisky or bar services was also engaged in the business of supplying wines.”

17. The comparison of goods factors in the two GC decisions and in *Balmoral* are weighted differently. On the one hand, the GC emphasises the different methods of production, different aroma, colour and taste of the drinks; whilst, on the other hand, *Balmoral* cautioned against placing too much emphasis on these factors and looked, instead, at who will be selling the goods. The GC, in *Coca-Cola*, did not refer to whether there is proximity of sale or distribution channels for wine and beer. And, in *Bodegas Montebello*, although it was acknowledged that that wine and rum might share distribution channels, they will not generally be sold on the same shelves. In that decision, the weight given to the alcoholic content, methods of production, taste, smell etc of wine and rum outweighed the distribution channel similarity and so the goods were “manifestly different”. In *Coca-Cola v OHIM*, the GC considered that wine and beer were not complementary, but that there was a certain amount of competition. The conclusion was that there was “little similarity” between wine and beer. Competition does not feature in the *Balmoral* comparison.

18. Attempting to cut a path through the three authorities, the factors I have in mind in relation to the present case are:

- The different processing/manufacture of beer and gin,
- The different taste, colour and smell,
- The very different alcoholic content. Beer is a long drink and gin is a spirit, drunk in short measures
- They are not in the same ‘family’ of alcoholic beverages
- They are not complementary

- There is less competition between beer and gin than between beer and wine
- But it is common to find the sale of various alcoholic drinks in the same outlet

19. Weighing them all, including what I said in *Old Tom*, I conclude that there is a very low degree of similarity between, on the one hand, beer, ale and porter, and on the other hand, gin, based upon a very low degree of competition and the potential for shared distribution channels (and then, as in the wine v. rum GC case, they are not sold on the same shelves).”

19. Mrs Pike’s decision is not binding upon me. Neither does a fellow Hearing Officer’s decision have a strong degree of persuasive value. However, I have included the above extract as it nevertheless provides a thorough analysis of some of the more important cases relating to conflicts between alcoholic drinks. I also bear in mind that Mrs Pike did not have the benefit of hearing the legal argument I have had (or even written submissions in lieu) nor seeing any evidence in relation to goods similarity. At the hearing, Mr Burton highlighted a number of other cases involving similar types of conflicts where goods similarity was held. Again, these are noted, but Mr Burton accepted that whilst there may be some persuasive value, it was for me to determine whether the goods are similar, and, if so, to what degree.

20. In terms of the evidence addressed to goods similarity, Mr Burton provided a witness statement and supporting documents attempting to show that some producers produce both beer and gin. The exhibits in support of this are:

- i) Prints from the website of The Cotswold Brewing Company showing that it produces a wheat beer and a gin.
- ii) Prints from adnams.co.uk showing that it produces various beers and a gin.
- iii) Prints from the website edenbrewerystandrews.com which produces ale and a gin.
- iv) Prints from the website of Diageo showing that they produce a product called Tanqueray (which I assume is a gin) and Guinness (a stout beer). Mr Burton also states that Diageo’s website refers to gin being an important contributor to its stable of products and that beer makes up 20% of its net sales.
- v) Two prints from the website of The Chiltern Brewery, the first shows its range of beers, the second shows a range of gins. However, the gin is not only sold under a separate name, but it appears to be produced by a separate entity (Foxdenton Farm) so, Chiltern Brewery are simply retailing it.

21. Mr Burton submitted that the evidence demonstrates that it is common for producers to make both beer and gin and that such goods could be co-branded (as per points i)-iii)). Whilst I accept that the evidence shows that some producers of beer have also produced gin, the evidence does not establish that this is common. It is not possible to ascertain from the evidence how significant these producers are. If one is attempting to demonstrate a common practice of shared production/branding, three examples in what must be a fairly large market is not persuasive. I also note

the Diageo example; however, whilst this demonstrates that a drinks company produces both spirits and beer, the fact that they are sold under completely different brand names is not in my view particularly helpful. The fifth example is not helpful given that it does not show what Mr Burton is attempting to show.

22. Mr Burton also relied on an email that Mr Lawrence sent to the opponent before this dispute arose whereby he asked whether there would be “any objections for me to use the name Tiger Gin on a new Gin I am looking at producing” and in which he asks whether the opponent would be interested in an “equity stake in this new company?”. It was submitted that this shows that Mr Lawrence considered the goods in question to be similar enough to cause concern and that the offer of an equity share shows an awareness that producers of beer often have an active interest in the production of gin. I do not consider this evidence to be particularly telling as not only does it fail to objectively show why the goods are similar, but the words of Mr Lawrence, as Mr Chapple submitted, do not expressly say what Mr Burton says and the ability to infer what Mr Burton states is stretching matters.

23. Mr Chapple made a submission on the basis that the respective goods have different consumers. However, much of his submission appeared based on the actual target market of the opponent’s product. This is not the correct test for the assessment to be made which must, instead, be based on the inherent characteristics of the goods and the notional market for them. However, even if Mr Chapple was correct in his submission, I do not agree that there is a difference in consumer/user as there is no reason why the type of person he identified as being the actual consumer of the opponent’s goods could not also be a drinker of gin. This applies also to what I consider the correct, notional test should be - all sorts of members of the public drink lager beer and all sorts drink gin – there is a large overlap.

24. Based on the totality of the authorities, evidence and submissions before me, I consider it difficult to say that there is no similarity at all between lager beer and gin. They are both alcoholic drinks consumed for social purposes and/or the intoxicating effects of the alcoholic content. They are both sold in similar outlets such as off-licences and the drinks area of a supermarket; they are both also sold in restaurants and bars. There is no complementary relationship that I can see, although, it is possible that a competitive choice between drinking lager beer or gin may occasionally be made, although this would not represent a commonly made competitive choice. However, the alcoholic content of lager beer and gin differs greatly. The goods will not ordinarily be sold on the same shelf, although I accept that they could potentially be sold in the same aisle. There is, though, normally a clear demarcation between the spirits area and the beer area. The goods are sold in different types of packaging: gin is sold in large bottles, lager beer in cans or smaller bottles. In a bar or restaurant gin will normally be dispensed from optics into a tall glass and then mixed with something (such as tonic) whereas beer will be sold in bottles or via a pump and then placed into pint or half pint glasses. There is no evidence showing that the production methods are similar. The core ingredient that gives the drink its particular characteristics differ, gin being a berry (juniper) based drink, lager beer being made from barley/wheat etc. There is nothing to show that producers of beer commonly diversify into the production of beer or *vice versa*. Overall, I conclude that the goods are similar, but to only a low degree.

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

26. The average consumer is the adult general public. Alcoholic drinks may be bought in supermarkets, off-licences etc. The online equivalents of such businesses are also relevant. This all suggests a more visual selection process. Whilst the goods may also be purchased in bars and similar establishments, where they may be requested orally, the goods will still, ordinarily, be on display so that they can be seen (see *Simonds Farsons Cisk plc v OHIM* Case T-3/04). Therefore, overall, I consider the purchase to be a primarily visual one, but I will not completely ignore the aural impact of the marks in the assessment. The level of attention in buying the goods themselves will not, generally speaking, be of a high level – a medium level of care will be used.

Distinctiveness character of the earlier marks

27. The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, based either on inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v Puma AG*, paragraph 24). 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 *WindsurfingChiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

28. From an inherent perspective, the word TIGER is not an usual one. However, it is a word which makes no real suggestive or allusive nod to the goods for which it is registered. I consider it to be of a normal or average level of inherent distinctive character.

29. The opponent has filed evidence of the use made of its mark. One purpose of the evidence is to attempt to show that the level of distinctive character of the earlier mark has been enhanced through use. The evidence comes from Mr Charzat. Before coming to his evidence it is important to stress one point. The assessment is to be made from the perspective of the UK average consumer, as it is only they who are relevant in the determination. The following evidence is noted:

- The opponent is part of the Heineken group of companies.
- TIGER beer was launched in 1932 in Asia and is now sold in over 70 countries.
- TIGER beer has been sold in the UK. It is not clear from Mr Charzat’s evidence from when it was first used, but Mr Chapple accepted that the mark had been used from the 1970s.
- In excess of 100,000 hectolitres are sold of the beer in the EU per year.
- TIGER beer has won a number of awards, including some in the UK.
- Between 2004-2006 TIGER beer was named as “one of the coolest brands” in the UK by SuperBrands UK Limited.
- Examples of promotional activities include sponsorship of music related events (6 examples spanning 2011-2012 are illustrated). Examples of on-street billboard advertising are provided. Six are depicted, one of which appears to be in a tube tunnel. A full page advertisement in a magazine is provided, but what the publication is is not clear; examples of invoices for promotional activities are provided, some of which relate to the UK.
- A PowerPoint presentation is provided from 2012 about an advertising campaign run in 2012. Mr Charzat states that advertisements “appeared” on various websites including Metro, Drowned in Sound, The Standard, The Independent, NME and Spotify.
- TIGER beer has featured in magazines including some UK publications including the Daily Mirror. A total of 12 are referred to (spanning 2007-2013), but these are not just the ones from the UK.
- The opponent promotes its beer on its websites at tigerbeer.co.uk and tigerbeer.com.

- The opponent runs (since 2005) an initiative called TIGER TRANSLATE which “showcase[s] global creativity with the fusion and collaboration of music, design, art, fashion dance and photography....”. The initiative involves running certain events, some (but not many) have taken place in London. The initiative has its own website.
- The opponent runs an initiative called TIGER STREET FOOTBALL which is a series of street football tournaments. Mr Charzat states that people from the UK have participated, but there is no evidence that any of the tournaments have taken place in the UK.
- Worldwide net annual turnover has ranged between SG\$ 1,783 (000,000) and SG \$3,350 (000,000) per annum between 2007 and 2012. (I assume SG\$ to be Singapore Dollars).
- Various annual reports of the opponent are provided in the evidence. Mr Burton did not take me to any of them at the hearing, so, whilst noted, I do not consider it necessary to summarise them further
- Tiger beer has (since 2011) its own YouTube channel which has over 470 subscribers and which holds 119 videos. Collectively, the videos have received over 1.2 million views. There is also a Facebook page which has had over 1 million “likes” since 2007.

30. Mr Chapple was highly critical of the evidence. His criticisms included the lack of evidence focused on the position in the UK, that much of the evidence was from overseas, that the awards won were not given context (such as award categories etc) and that the promotional events were fairly small scale. I also find it notable that the opponent has failed to provide evidence showing what level of sales it has achieved in the UK, let alone what its market share is in the UK. I asked Mr Burton if any of the evidence provided by Mr Charzat could shed any light on this. The best he could identify were some invoices in Exhibit T06 to the opponent’s UK distributor, the totals for these invoices in the years 2007, 2008 and 2009 amount to just over £500,000 per annum. The only evidence that could potentially assist to add to this picture is an article in Exhibit T01 from the Publican’s Morning Advertiser which discusses the impact of world beers on the UK market. The extract states:

“Consider Tiger Beer, which has benefited from its Hidden Depths Marketing Campaign, promoting its Far Eastern (Singapore) provenance but is brewed in the UK. It sits in eighth place on the CGA table having enjoyed the highest growth by value among the biggest selling brands, with a 36.3% uplift that has taken sales to £30.2m”

I additionally note from this article that other world beers are mentioned with much greater sales (e.g. Peroni beer selling £441.7m).

31. I consider Mr Chapple to be right on a number of his criticisms. For example, the promotional activity that has taken place does not appear on the face of it to have a particularly high profile such as a national television or newspaper advertising campaign would have. The Hidden Depths campaign (which, despite Mr Chapple’s suggestion to the contrary, I accept took place) may have had a higher profile and led to greater public awareness, but even then it is difficult to quantify this without

knowing more about it. The YouTube channel does not seem highly popular; the number of subscribers is low, and even though the combined number of video views is over one million, this may not be particularly significant bearing in mind that it is not known how many of these views are attributable to persons in the UK; the same problem applies to the Facebook page. The Tiger Translate initiative does not seem to have a high profile (there is nothing to suggest that it is well known), and there is no evidence to show that the street football tournaments take place in the UK. The on-street advertising is not quantified or contextualised, so one does not know what type of foot-fall there was in those areas or how long the advertisements were there for. The sponsorship/promotion of music events is also difficult to contextualise. On the face of it some of those referred to in the evidence seem to be fairly small affairs. The largest appears to be the Tiger Beer Chilli Crab Festival which was held in 2007 and the relevant articles states that over 16,000 people attended (unaudited). Whilst not insignificant, there is nothing to show how widely known this event was beyond the people that attended. There are further gaps in the evidence. There is no evidence, for example, of how many retail establishments sell the goods in the UK or how many bars stock the product. There is no evidence of geographical spread.

32. It is, of course, easy to pick holes in individual pieces of evidence. I must, though, consider the evidence in totality. Even doing this it is clear that the evidence is not well-marshalled. However, the amount of lager beer being sold (and the money spent on promotional activity) is not insignificant. One must bear in mind that the market for beer in the UK is a huge one and even if I were to accept the £30 million figure referred to above (although some caution must be exercised in accepting this figure as it is not even provided by the opponent), the market share is unlikely to be up there with the most popular brands in the UK. The other evidence is, of course, borne in mind, evidence which suggests that some degree of public awareness has been achieved, but the lack of context and detail makes it difficult to assess its full impact. The evidence as whole paints a picture that there is likely to have been some enhancement of distinctive character from the perspective of the UK average consumer, but I can only pitch such enhancement at a fairly small degree. The uplift I have described is not enough for the mark to be regarded as a highly distinctive one. Therefore, whilst the earlier mark may have a slightly above average level of distinctiveness on account of the use made, I cannot put it any higher than that.

Likelihood of confusion

33. The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

34. Mr Burton stressed to me the importance of the interdependency principle in that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I agree that this is an important point because, as Mr Burton submitted, the marks have a very high degree of similarity. Mr Chapple, on the other hand, submitted that the goods were simply not close enough for confusion

to arise. Mr Burton also stressed the enhanced distinctive character of the opponent's mark. Whilst I do not ignore this, I have of course only found a small uplift in distinctiveness due to the use made of the mark. Mr Burton also submitted that in bars etc both products could be requested simply by reference to the word TIGER and the consumer provided with a gin when he really wanted a beer, and that the average consumer would then assume an economic connection.

35. In my view there will be no likelihood of confusion. The goods will be separated from one another at the retail level and the average consumer, despite the near identity between the marks, will not pick up a beer in the mistaken belief that it is gin, or vice versa. Even if the average consumer became aware of both products, I do not consider that the use of the word TIGER by both will be put down to a same stable product. The low degree of goods similarity coupled with the fact that the mark has an average level of inherent distinctiveness, distinctiveness which has only been enhanced to a small degree through use means, in my view, that the average consumer will simply assume that the undertakings responsible for the goods have happened upon the same name. Thus, the use of the word TIGER will be put down to co-incidence not economic connection. In terms of the marks being encountered in bars etc, there are a number of factors which assist to avoid the type of confusion Mr Burton relied upon. Even if the goods are requested orally, they would still, ordinarily, be on display and seen by the average consumer. Furthermore, the average consumer would normally specify what is being requested not just by the use of the product name, but also other indications which would alert the barperson to what is being requested (e.g. "bottle/pint of" would indicate that the lager is being requested, whereas "glass of", "...and tonic" would indicate that gin is being asked for). Furthermore, many consumers would simply ask for a gin (most likely with tonic) and may only request the brand of gin if prompted to do so). Even if the barperson were asked for TIGER then he or she would no doubt enquire as to whether the person wishes to receive a gin or a beer – the fact that a choice of two products is given does not mean that a likelihood of confusion will arise. **The opposition fails under section 5(2)(b).**

Section 5(4)(a)

36. Section 5(4)(a) of the Act reads:

"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of "an earlier right" in relation to the trade mark."

37. Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing-off. The analysis is based

on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

38. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

39. Whether there has been passing-off must be judged at a particular point (or points) in time. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Lord Justice Kitchen summarised the position thus:

“165. There is a further complication, however. Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

The above related to a community trade mark, however, the same applies, *mutatis mutandis*, to a UK national trade mark. The filing date of the subject trade mark is 16 December 2013. There is no evidence of any pre-filing use by Mr Lawrence so the matter need only be assessed as of that date.

40. Mr Chapple submitted that the opponent has failed to show any goodwill. I reject this submission. Although I have stated earlier in this decision that the opponent’s use has not provided it with a high level of enhanced distinctive character, it easily

clears the hurdle of having a more than trivial level of goodwill. However, where the opponent does fail is on the test for misrepresentation. The relevant test was outlined by Morritt L.J. in *Neutrogena Corporation and Another v Golden Limited and Another*, [1996] RPC 473:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 *Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

41. In comparison to section 5(2)(b) of the Act, the test still requires consumers to believe that the goods are of the same (or related) stables. Albeit, the test is now one-directional in that those consumers must believe, applied to this case, that Tiger Gin is the responsibility of the producer of Tiger lager beer. I accept that there is a difference in the test in that under section 5(2)(b) one is making the assessment from the perspective of the average consumer whereas under passing-off one is concerned with a “substantial number of members of the public”. However, without debating how different these tests actually are, I consider that whichever way one looks at it, the opponent has not established that a substantial number of persons would be deceived. For similar reasons to that already expressed, I consider that the commonality of the word TIGER will be put down to co-incidence and consumers will not be deceived. I do not consider that a substantial number of members of the public will believe that the goods sold under the applied for mark are those of the opponent. **The opposition fails under section 5(4)(a).**

Section 5(3)

42. Section 5(3)¹ of the Act reads:

“5-(3) A trade mark which-

(a) 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 Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

Reputation

43. The earlier mark(s) must have a reputation. In *General Motors Corp v Yplon SA (Chevy)* [1999] ETMR 122 and [2000] RPC 572 the CJEU stated:

“The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.”

44. There was a discussion at the hearing as to whether something stated in the applicant’s counterstatement meant that the existence of a reputation had been conceded. At the hearing, Mr Chapple submitted that what was said was not a concession but, in any event, he accepted that the opponent’s may have a reputation but of a fairly small level focused on a certain subset of consumers (lager enthusiasts, predominantly young male club-goers). I held earlier that the mark had been used to a sufficient degree to provide some (but not much) enhancement of distinctive character. Taking this forward to a reputation for the purposes of section 5(3) of the Act, I consider that the earlier mark does have a reputation but, due to the failings of the evidence, not one that should be assessed as being strong. I do not consider it necessary to limit the reputation to the precise categorisation that Mr Chapple has put forward.

The required link

45. In addition to having a reputation, a link must be made between the subject trade mark and the earlier mark. In *Adidas-Salomon*, the CJEU stated:

“The infringements referred to in Article 5(2) of the Directive, where they occur, are the consequence of a certain degree of similarity between the mark and the sign, by virtue of which the relevant section of the public makes a connection between the sign and the mark, that is to say, establishes a link between them even though it does not confuse them (see, to that effect, Case C-375/97 *General Motors* [1999] ECR I-5421, paragraph 23). The existence of such a link must, just like a likelihood of confusion in the context of Article 5(1)(b) of the Directive, be appreciated globally, taking into account all factors

¹ Section 5(3) was amended by The Trade Marks (Proof of Use, etc) Regulations 2004 (SI 2004 No. 946) giving effect to the judgments of the CJEU in *Davidoff & Cie SA and Zino Davidoff SA v Gofkid Ltd* (C- 292/00) and *Adidas-Salomon AG and Adidas Benelux BV v Fitnessworld Trading Ltd* (“*Addidas-Salomon*”) (C-408/01)).

relevant to the circumstances of the case (see, in respect of the likelihood of confusion, SABEL, paragraph 22, and Marca Mode, paragraph 40).”

46. In *Intel Corporation Inc v CPM (UK) Ltd (C-252-07)* (“Intel”) the CJEU provided further guidance on the factors to consider when assessing whether a link has been established. It stated:

“41 The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case...

42 Those factors include:

- the degree of similarity between the conflicting marks;
- the nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public;
- the strength of the earlier mark’s reputation;
- the degree of the earlier mark’s distinctive character, whether inherent or acquired through use;
- the existence of the likelihood of confusion on the part of the public”.

Similarity of marks

47. The marks are similar to a very high degree.

The goods

48. The goods are similar to only a low degree. The relevant section of the public does, however, overlap.

Reputation and distinctive character

49. The earlier mark has an average level of inherent distinctness, uplifted slightly through use. The reputation is not a strong one.

Likelihood of confusion

50. There is no likelihood of confusion

Link or not?

51. In my view there will be no link. Clearly, for those who are unaware of the earlier mark then a link will never be made. Given that the strength of the reputation is not great then this applies to a good many number of consumers. For those who may know the Tiger lager beer product, I do not believe that their minds will turn to Tiger lager when the Tiger Gin product is encountered. It is the sort of word that could be adopted by more than one trader, and neither the goods involved or the reputation of the earlier mark (which I have assessed as not strong) would result in the relevant public bringing the earlier mark to mind when encountering the applied for mark. Put

simply, they will not even think about it. **There is no link and, so, the ground of opposition under section 5(3) must fail.**

The heads of damage

52. In case of appeal I will, nevertheless, give my views on the heads of damage. On the assumption, against my above finding, that a link will be made, there are three potential heads of damage under section 5(3) to consider. They are often referred to as: i) free-riding, ii) dilution, and iii) tarnishing. The three kinds of damage were conveniently summarised by the CJEU in Case C-487/07), *L'Oréal v Bellure*, as follows:

“39. As regards detriment to the distinctive character of the mark, also referred to as ‘dilution’, ‘whittling away’ or ‘blurring’, such detriment is caused when that mark’s ability to identify the goods or services for which it is registered is weakened, since use of an identical or similar sign by a third party leads to dispersion of the identity and hold upon the public mind of the earlier mark. That is particularly the case when the mark, which at one time aroused immediate association with the goods or services for which it is registered, is no longer capable of doing so (see, to that effect, *Intel Corporation*, paragraph 29).

40. As regards detriment to the repute of the mark, also referred to as ‘tarnishment’ or ‘degradation’, such detriment is caused when the goods or services for which the identical or similar sign is used by the third party may be perceived by the public in such a way that the trade mark’s power of attraction is reduced. The likelihood of such detriment may arise in particular from the fact that the goods or services offered by the third party possess a characteristic or a quality which is liable to have a negative impact on the image of the mark.

41. As regards the concept of ‘taking unfair advantage of the distinctive character or the repute of the trade mark’, also referred to as ‘parasitism’ or ‘free-riding’, that concept relates not to the detriment caused to the mark but to the advantage taken by the third party as a result of the use of the identical or similar sign. It 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.”

Tarnishing

53. Mr Burton withdrew his claim to the tarnishing head of damage at the hearing. There is no need to say any more about this.

Free-riding

54. Mr Burton submitted that the link made would result in unfair advantage because consumers would believe that the respective undertakings are related and the applicant would, therefore, benefit from the opponent’s marketing and reputation. Having already held that there is no likelihood of confusion then any argument on this basis is bound to fail. Mr Burton additionally argued that there could be some

form of image transfer with the applicant benefitting from an association with an award winning product and the prestige of the product. I reject this submission. Even if a link were made, I come to the view that it would be so fleeting that it should be regarded as inconsequential. The relevant public will draw no parallels. I struggle to see why there would be any image transfer and I do not consider the job of marketing the product to be any easier. Therefore, without even coming to the unfair aspect of the head of damage, I reject this claim on the basis that no advantage would be derived.

Dilution

55. The following is taken from Mr Burton's skeleton argument. The submission was not built upon to any great degree at the hearing:

"24) . Further, if the Applicant uses the mark, their use would also have the effect of reducing the distinctiveness of the Opponent's trade mark, as well as reducing its ability to clearly identify their trade mark and products in the marketplace."

56. I do not see how the use of the applied for mark will make the opponent's mark any less capable of distinguishing the goods for which it has a reputation or making it any less distinctive. I reject this claim for want of any evidence or clear reasoning as to why this form of damage would arise.

Conclusion

57. All the grounds of opposition have failed. The opposition is rejected.

Costs

58. The applicant has succeeded and is entitled to a contribution towards his costs. Both representatives indicated that they were content to proceed on the basis of the published scale. My assessment is as follows:

Preparing a statement and considering the other side's statement - £400

Filing and considering evidence - £600

Preparing for and attending the hearing - £600

Total - £1600

59. I therefore order Heineken Asia Pacific Pte. Ltd to pay Jeffrey Joshua Lawrence the sum of £1600. This should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18TH day of June 2015

**Oliver Morris
For the Registrar,
The Comptroller-General**