

**O-175-16**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3109363  
BY RUSSELL SHARP**

**TO REGISTER THE TRADE MARK:**

**CALEDONIAN**

**IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600000317  
BY C & C IP SÀRL**

## BACKGROUND AND PLEADINGS

1. On 19 May 2015, Russell Sharp applied to register the trade mark **CALEDONIAN** for the following goods in class 33:

Class 33      Gin, Scotch Whisky produced in Scotland.

The application was published for opposition purposes on 19 June 2015.

2. The application is opposed by C & C IP SÀRL (“the opponent”) under the fast-track opposition procedure.

3. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed against all of the goods in the application. The opponent relies upon its European Union Trade Mark (“EUTM”) registration no. 10904101 for the trade mark **CALEDONIA**, applied for on 22 May 2012 and for which the registration procedure was completed on 5 October 2012. The trade mark has a priority date of 18 January 2012. The opponent relies upon all of the goods in its trade mark registration, namely:

Class 32      Beers, lagers, ales, porters and beverages containing beer, lager, ale or porter.

4. On 11 November 2015, Mr Sharp filed a counterstatement in which he denies the basis of the opposition.

5. Rules 20(1)-(3) of the Trade Marks Rules (“TMR”) (the provisions which provide for the filing of evidence) do not apply to fast track oppositions but Rule 20(4) does. It reads:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit”.

6. The effect of the above is to require parties to seek leave in order to file evidence (other than the proof of use evidence which is filed with the notice of opposition) in fast track oppositions. No leave was sought in respect of these proceedings. I note that, attached to Mr Sharp’s counterstatement, are three appendices which contain evidence. No permission was sought or given for Mr Sharp to file evidence and the evidence will form no part of my decision. For the sake of completeness, I have reviewed the attachments to the counterstatement and am of the view that, even had they been admitted into proceedings, they would not have assisted Mr Sharp’s case.

7. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost. Otherwise, written arguments will be taken.

8. A hearing was neither requested nor considered necessary. Only the opponent filed written submissions, which I have read carefully and will refer to as necessary, below.

### **Preliminary issues**

9. Mr Sharp relies upon a number of factors which he states will avoid any likelihood of confusion. These are that:

- i) The parties' goods will be marketed in different retail premises. The opponent will sell its goods in pubs and golf clubhouses, while Mr Sharp will sell his products in specialist outlets and will target consumers who are knowledgeable about whisky and gin;
- ii) Mr Sharp is seeking to revive the name of a defunct Edinburgh distillery and will be providing details of the history of the distillery on his website;
- iii) there are a number of other marks on the register which feature the words "CALEDONIA" or "CALEDONIAN" and which are registered for goods in classes 32 and 33;
- iv) the opponent has a number of registrations for "CALEDONIA" in class 32 which, Mr Sharp asserts, were dormant until recently;
- v) the opponent has not filed evidence to demonstrate how confusion would occur in the marketplace.

10. Some of these are familiar arguments in trade mark oppositions. Before going further into the merits of this opposition, it is necessary to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

11. A trade mark registration is essentially a claim to a piece of legal property (the trade mark). Every registered mark is entitled to legal protection against the use, or registration, of the same or similar trade marks for the same or similar goods and/or services if there is a likelihood of confusion. Once a trade mark has been registered for five years, section 6A of the Act is engaged and the opponent can be required to provide evidence of use of its mark. Until that point, however, the mark is entitled to protection in respect of the full range of goods/services for which it is registered.

12. The trade mark relied on by the opponent had not been registered for five years at the date on which the application was published. Consequently, the opponent does not need to prove use for any of the goods for which its mark is registered. The earlier mark is entitled to protection against a likelihood of confusion with the applicant's mark based on the 'notional' use of the earlier mark for all the goods listed in the register. This concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd* ([2004] RPC 41) like this:

"22. ....It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place".

13. The assessment based on notional use also means that the opponent does not need to provide evidence of confusion in the marketplace. Indeed, the provisions for fast-track oppositions reproduced at paragraph 5, above, specifically prohibit the filing of evidence unless permission is given. Whether there is a likelihood of confusion is a matter for me to decide, having weighed all of the competing factors.

14. So far as the use of the applied-for mark is concerned, in *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited* (Case C-533/06), the Court of Justice of the European Union ("CJEU") stated at paragraph 66 of its judgment that, when assessing the likelihood of confusion in the context of registering a new trade mark, it is necessary to consider all the circumstances in which the mark applied for might be used if it were registered. As a result, my assessment must take into account only the applied-for mark (and its specification) and any potential conflict with the earlier trade mark. Any differences between the goods and services provided by the parties, or differences in their trading styles or marketing approach, are irrelevant unless those differences are apparent from the applied-for and registered marks.

15. As the comparison is made only between the applied-for and earlier marks, and their respective specifications, the existence of other trade marks on the register is not relevant to the judgment I must make (see the judgment of the General Court ("GC") in *Zero Industry Srl v OHIM*, Case T-400/06).

## **DECISION**

16. The opposition is based upon section 5(2)(b) of the Act which reads as follows:

"5. - (2) A trade mark shall not be registered if because -

(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”.

17. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“6. - (1) In this Act an “earlier trade mark” means -

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered”.

18. In these proceedings, the opponent is relying upon the trade mark shown in paragraph 3, which qualifies as an earlier trade mark under the above provisions. As I indicated at paragraph 12, it is not subject to proof of use, as per section 6A of the Act.

### **Section 5(2)(b) – case law**

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

The principles:

(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.

### **The average consumer and the nature of the purchasing act**

20. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. 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”.

21. Mr Sharp submits that:

“[T]he target consumer of the applicant will be knowledgeable and inquisitive about malt whiskies and innovative gin and, if they have heard of the opponent’s beer, be well aware of the differences between whisky, gin and beer and of the brand owners” (p. 2).

22. In its written submissions, the opponent states that:

“The goods covered by the respective Trade Marks are everyday consumer goods that are purchased and used generally by the average consumer on a regular basis or at social occasions. Consequently, the level of attention paid to the acquisition of the goods will not be high. The goods are not aimed at particular consumers but at the general consumers who are of legal age to consume such goods” (paragraph 6).

23. I have no reason to doubt that Mr Sharp may have a particular marketing strategy in mind but I have explained above why this is not relevant to the assessment I have to make. Both marks cover alcoholic beverages and, apart from the fact that the applicant’s goods are limited to goods produced in Scotland, are subject to no restrictions. I agree with the opponent that the average consumer of the goods at issue is a member of the adult general public.

24. In my experience, these goods are sold through a range of channels including restaurants, bars and public houses. They are also commonly sold in supermarkets, off-licences and their online equivalents. In restaurants, bars and public houses, the goods are likely to be on display, for example, in bottles or in optics behind the bar, or on drinks menus, where the trade mark will be visible. While I do not discount that there may be an aural component in the selection and ordering of the goods in bars, restaurants and public houses, this is likely to take place after a visual inspection of the bottles/drinks menu (see *Simonds Farsons Cisk plc v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04 (GC)). In retail premises, the goods at issue are likely to be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will most likely select the goods having viewed an image displayed on a web page. I am therefore of the view that the selection of the goods at issue will be primarily visual, although aural considerations will play a part.

25. In general, these goods are not terribly expensive. However, whether selecting the goods in retail or in licensed premises, the average consumer will choose a particular type, flavour or strength of beverage. Consequently, the average consumer will, in my view, pay an average degree of attention to the selection of the goods.

**Comparison of goods**

26. The competing goods are as follows:

<b>Opponent’s goods</b>	<b>Applicant’s goods</b>
<p><u>Class 32</u></p> <p>Beers, lagers, ales, porters and beverages containing beer, lager, ale or porter.</p>	<p><u>Class 33</u></p> <p>Gin, Scotch Whisky produced in Scotland.</p>

27. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“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”.

28. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;

- e) 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.

29. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

30. As for whether the goods are complementary, in *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

31. In relation to complementarity, I also bear in mind the guidance given by Mr Daniel Alexander QC, sitting as the Appointed Person, in case BL 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”.

32. This being a fast-track opposition, I have not had the benefit of evidence in relation to the similarity of the goods. In his counterstatement, Mr Sharp disputes whether the

goods are similar, although his comments are influenced by his intended use of the applied-for mark and by the opponent's actual use of the earlier mark which, as I have explained, is not the test I must apply. He states that:

"[The opponent's] beer is called CALEDONIA BEST and has an ABV (alcohol by volume) of 3.2%, it is sold on draught in pubs and golf clubhouses in pint measures or in cans and containing 440ml at the lower end of the price scale. It is the applicants [sic] intention to market CALEDONIAN Scotch Whisky at an ABV of 43% at a stated age of 5/12 years in 700 ml bottles. It will be sold in specialist whisky bars and shops, in duty free retail and in export markets. Similarly CALEDONIAN Gin will be sold at an ABV of 46% in 700 ml bottles and marketed predominantly in specialist outlets" (pp. 1-2).

33. For its part, the opponent refers me to two earlier Registry decisions in which a degree of similarity was found between goods in classes 32 and 33. These are noted but are neither binding upon me nor of strong persuasive value. The opponent submits that:

"[T]he respective users of the respective goods, the physical nature of the goods and the respective trade channels through which the goods reach the market are identical. The respective users will be the average consumer who partakes in the enjoyment of alcoholic beverages on social occasions. The physical nature of the respective goods is that they are all alcoholic and the respective goods would be sold through the same trade channels, such as pubs, off licences and supermarkets all being sold in close proximity to each other [...]" (paragraph 11).

34. In addition to the case law cited, above, two GC cases are particularly instructive on the factors to be considered when comparing alcoholic beverages. *The Coca-Cola Company v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-175/06, involved the comparison between wine on the one hand and beer on the other. In that case, the Court accepted (at paragraphs 63-70), that the goods constitute alcoholic beverages obtained by a fermentation process and that they are both consumed during a meal or drunk as an aperitif. However, it noted the different basic ingredients and methods of production (albeit ones which might include fermentation) and the differences in colour, aroma and taste of the end products. It concluded that, notwithstanding a certain similarity of purpose, i.e. enjoyment of a drink during a meal or as an aperitif, the consumer would perceive the end products as different and belonging to different families of alcoholic beverages. It acknowledged a certain degree of competition between the goods but found there to be no complementary relationship. Overall, it found little similarity between wine and beer.

35. In *Bodegas Montebello, SA v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-430/07, the GC found that rum and wine were "manifestly different" (its analysis is at paragraphs 29-37). This was again based on an assessment of the different ingredients and methods of production, which result in end

products different in taste, colour and aroma. In addition, it noted that wine is often drunk with a meal, while that is not generally the case for rum, and that the goods have a markedly different alcohol content. Although the Court accepted that rum and wine may share the same distribution channels, it considered that the goods would not generally be sold on the same shelves and that the goods were neither complementary nor in competition.

36. These decisions of the GC are weighted differently from the earlier decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in *Balmoral Trade Mark* [1999] RPC 297. *Balmoral* concerned the comparison of whisky with wine. It cautioned against placing too much emphasis on factors such as the methods of production and difference in colour and taste of the drinks, and focussed instead on the shared channels of trade. Shared distribution channels were considered in *Bodegas Montebello* but were not sufficient to outweigh the other factors. *Coca-Cola* did not refer to proximity of sale or distribution channels for wine and beer.

37. The *Collins English Dictionary* gives the following definitions of lager, ale and porter:

Lager: “a light-bodied effervescent beer, fermented in a closed vessel using yeasts that sink to the bottom of the brew”

Ale: “a beer fermented in an open vessel using yeasts that rise to the top of the brew”

Porter: “a dark sweet ale brewed from black malt”.<sup>1</sup>

For convenience, as lager, ale and porter are all types of beer, I shall refer to the opponent’s goods as “beers” and “beverages containing beers” but this should be taken to refer to the entire specification.

38. Beers and beverages containing beers are clearly alcoholic beverages, as are gin and whisky. The goods at issue are consumed for a pleasurable drinking experience, which may include the intoxicating effects of alcohol. The users, namely adults over 18, are identical. In addition, the goods are sold through the same channels, for example in retail premises such as supermarkets and off-licences, or in restaurants and bars.

39. Having said that, there is a notable difference in the alcoholic content of the goods at issue. In retail premises, spirits are usually sold in large bottles, while beers are sold in smaller bottles or cans. In restaurants and bars, gin would normally be dispensed into a tall glass and mixed with other spirits or a non-alcoholic beverage (such as tonic water) to make a long drink. The same may apply to whisky but whisky is also frequently sold for consumption by itself. Spirits are generally dispensed in small measures, often from optics displayed behind the bar. By contrast, beers would customarily be sold in half pint or pint measures dispensed from a tap, or be sold in bottles. While beverages containing beers are likely to consist of beers mixed with non-

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<sup>1</sup> <<http://www.collinsdictionary.com/dictionary/english>>, accessed 30 March 2016

alcoholic beverages (for example, with lemonade to make shandy), like beer they would be sold in half pint or pint measures and are likely to be perceived as beer-based beverages. In retail premises, the goods at issue are not normally sold on the same shelf and, while I accept that they may be sold in the same aisle, there is ordinarily a clear demarcation between the area for spirits and that for beers and beverages containing beers. Although the base ingredients for all the goods at issue may be the same (e.g. grain or malt), the production methods are different, gin and whisky being made by distillation and beers by fermentation. I do not consider that there is a complementary relationship between the goods of the earlier mark and those in the applied-for specification, neither being essential or important for the consumption of the other. It is possible that there may be a degree of competition between the goods at issue, though I do not consider that the competitive choice between drinking beers (or beverages containing beers) on the one hand and gin or whisky on the other will be commonly made. In my experience, producers of beers do not routinely also produce either gin or whisky, or vice versa. Bearing all of the above in mind, I find that the goods are similar but only to a low degree.

**Comparison of trade marks**

40. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgement in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

41. It would be wrong, therefore, artificially to dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

The trade marks to be compared are as follows:

<b>Opponent’s trade mark</b>	<b>Applicant’s trade mark</b>
CALEDONIA	CALEDONIAN

42. Mr Sharp has not commented specifically on the degree of similarity between the parties' marks. The opponent submits that the marks share a very high degree of visual similarity, that they are aurally "extremely similar" and that they are "conceptually the same. Both words convey a message to the effect that the Marks are, in some way, associated with or allude to Scotland" (paragraph 4).

43. The opponent's trade mark consists of the single nine-letter word "CALEDONIA", presented in capital letters. There are no other elements to contribute to the overall impression and distinctiveness, which is contained in the word itself.

44. The applicant's mark is the single ten-letter word "CALEDONIAN", also presented in capital letters. It has no other elements, its overall impression and distinctiveness lying in its totality.

45. Visually, the marks share the same first nine letters, the opponent's mark being completely contained within the applied-for mark. The difference between the marks is the final letter "N" of the applicant's mark. I consider there to be a very high degree of visual similarity between the marks.

46. The initial nine letters of both marks ("CALEDONIA") will be articulated in the same way. There is a difference in that the applicant's mark has a final letter "N", which will be pronounced. I am of the view that there is a very high degree of aural similarity.

47. The word "Caledonia" is defined by the *Collins English Dictionary* as "the Roman name for Scotland".<sup>2</sup> I do not consider that the average consumer would know the derivation of the opponent's mark "CALEDONIA" but the word is, in my view, a common one and would be perceived by the average consumer as evocative of Scotland. I also consider that the average consumer will identify "CALEDONIAN" as being an adjective meaning "relating to Scotland". As a result, I consider that there is a very high degree of conceptual similarity.

### **Distinctive character of the earlier trade mark**

48. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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<sup>2</sup>*Ibid.*, accessed 23 March 2016.

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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)”.

49. The opponent does not claim an enhanced level of distinctive character but submits that the earlier mark has a “normal” degree of inherent distinctiveness (paragraph 5). I have no submissions from Mr Sharp on this point.

50. Invented words usually have the highest degree of inherent distinctive character. The word “CALEDONIA” is an ordinary word with a known meaning. In relation to the goods for which it is registered, however, it is somewhat allusive, suggesting that they come from Scotland. I am of the view that the mark has no higher than an average degree of inherent distinctiveness.

### **Likelihood of confusion**

51. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, as the more distinctive this trade mark is, the greater the likelihood of confusion. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind.

52. I have found that the parties’ marks are visually, aurally and conceptually similar to a very high degree and that the earlier mark has no higher than an average degree of

inherent distinctive character. I have identified the average consumer to be a member of the adult general public, who will select the goods primarily by visual means (though I do not discount an aural component), and I have concluded that the degree of attention paid will be average. I have found the parties' goods to be similar only to a low degree.

53. Despite the fact that the marks are highly similar and that the goods will be purchased with an average degree of attention, I consider that there is no likelihood of confusion. This is because the similarity between "beers, lagers, ales, porters and beverages containing beer, lager, ale or porter" on the one hand and "gin, Scotch Whisky produced in Scotland" on the other is of the lowest degree. The goods will be separated from one another at the retail level and the average consumer will not mistakenly purchase gin in the belief that it is beer or a related product. In restaurants and pubs, the goods will generally be on display, often in different areas of the bar, and, even if they are requested orally, other indications will normally ensure that the bartender is aware of what the consumer requires (for example, whisky or gin will be requested in quantities such as single, double or large and may be requested with a mixer, whereas beer will be requested by the bottle or by the pint or half pint). Even if the consumer does become aware of both products, I do not consider that s/he would perceive them as coming from the same or economically linked undertakings. Rather, the low degree of similarity between the goods, coupled with the average distinctive character of the earlier mark, means that the average consumer will attribute the similarity between the trade marks to coincidence not economic connection. **The opposition fails under section 5(2)(b).**

## **Conclusion**

54. The opposition has been unsuccessful and the application will proceed to registration.

## **Costs**

55. As Mr Sharp has been successful, he is entitled to a contribution towards his costs. Neither party filed evidence; only the opponent filed written submissions. Awards of costs are governed by Annex A of Tribunal Practice Notice 4 of 2007. Using that TPN as a guide but bearing in mind that the applicant has not been professionally represented, I award costs to the applicant on the following basis:

Preparing a statement and  
considering the other side's statement: £100

Total: £100

56. I order C & C IP SÀRL to pay Russell Sharp the sum of **£100**. This sum is to 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 6th day of April 2016**

**Heather Harrison  
For the Registrar  
The Comptroller-General**