

**O/336/19**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003281046**

**BY EVANS GROUP HOLDING COMPANY LIMITED**

**TO REGISTER THE TRADE MARK:**

**Lord Nelson**

**IN CLASSES 32 AND 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 412368 BY**

**LIDL STIFTUNG & CO. KG**

## BACKGROUND AND PLEADINGS

1. On 8 January 2018, Evans Group Holding Company Limited (“the applicant”) applied to register the trade mark **Lord Nelson** in the UK. The application was published for opposition purposes on 2 February 2018. Following an amendment to its specification, the applicant now seeks registration for the following goods:

Class 32      Aerated fruit juices; Aerated juices; Aerated mineral waters; Aerated water; Aerated water (Preparations for making -); Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Ale; Ales; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs, non-alcoholic; Apple juice beverages; Apple juice drinks; Barley wine [Beer]; Barley wine [beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages containing vitamins; Beverages (Non-alcoholic -); Beverages (Preparations for making -); Beverages (Whey -); Bitter lemon; Black beer; Black beer [toasted-malt beer]; Blackcurrant cordial; Blackcurrant juice; Bock beer; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut juice; Coconut water; Coconut water as a beverage; Coconut water as beverage; Coconut-based beverages; Cola; Cola drinks; Colas [soft drinks]; Concentrated fruit juice; Concentrated fruit juices; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Condensed smoked plum juice; Cordials; Cordials [non-alcoholic]; Cordials (non-alcoholic beverages); Craft beer; Craft beers; Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised drinks; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Dilutable preparations for

making beverages; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Dry ginger ale; Effervescing beverages (Pastilles for -); Effervescing beverages (Powders for -); Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes]; Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils]; Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Extracts of hops for making beer; Extracts of unfermented must; Flavor enhanced water; Flavored beer; Flavored beers; Flavored mineral water; Flavored waters; Flavoured beers; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit beverages (non-alcoholic); Fruit drinks; Fruit extracts (Non-alcoholic -); Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice concentrates; Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, nonalcoholic; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Ginger juice beverages; Glacial water; Grape juice; Grape juice beverages; Grape must, unfermented; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -); Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; Iced fruit beverages; Imitation beer; India pale ales (IPAs); IPA (Indian Pale Ale); Isotonic beverages; Isotonic beverages [not for medical

purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lager; Lagers; Lemon barley water; Lemon juice for use in the preparation of beverages; Lemon squash; Lemonade; Lemonades; Lime juice cordial; Lime juice for use in the preparation of beverages; Liqueurs (Preparations for making -); Lithia water; Low alcohol beer; Low calorie soft drinks; Low-alcohol beer; Low-calorie soft drinks; Malt beer; Malt syrup for beverages; Malt wort; Mango juice; Melon juice; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral water (Preparations for making -); Mineral waters; Mineral waters [beverages]; Mixed fruit juice; Mixed fruit juices; Mixes for making sorbet beverages; Mung bean beverages; Must; Nectars (Fruit -), non-alcoholic; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Non-alcoholic beers; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic punch; Non-alcoholic punches; Non-alcoholic rice punch (sikhye); Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Nutritionally fortified beverages; Nutritionally fortified water; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orange squash; Orgeat; Pale ale; Part frozen slush drinks; Pastilles for effervescing beverages; Pineapple juice beverages; Pomegranate juice; Porter; Powders for effervescing

beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making liqueurs; Preparations for making mineral water; Protein-enriched sports beverages; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Saison beer; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Shandy; Sherbet beverages; Sherbets [beverages]; Slush drinks; Smoked plum beverages; Smoked plum juice beverages; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating]; Smoothies [non-alcoholic fruit beverages]; Soda pops; Soda water; Soft drinks; Soft drinks for energy supply; Sorbets [beverages]; Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soy-based beverages, not being milk substitutes; Sparkling water; Sports drinks; Sports drinks containing electrolytes; Spring water; Spring waters; Squashes [non-alcoholic beverages]; Still water; Still waters; Stout; Stouts; Syrup for making beverages; Syrup for making lemonade; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks; Table water; Table waters; Tomato juice [beverage]; Tomato juice beverages; Tonic water; Tonic water [non-medicated beverages]; Unfermented preserved must; Vegetable drinks; Vegetable juice; Vegetable juices [beverage]; Vegetable juices [beverages]; Vegetable smoothies; Vegetable-based beverages; Vitamin enriched sparkling water [beverages]; Vitamin fortified non-alcoholic beverages; Water; Water (Lithia -); Water (Seltzer -);

Watermelon juice; Waters; Waters [beverages]; Waters (Table -); Wheat beer; Whey beverages.

Class 33 Absinthe; Acanthopanax wine (Ogapiju); Aguardiente [sugarcane spirits]; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs; Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches; Alcoholic tea-based beverage; Alcopops; Amontillado; Anise [liqueur]; Anisette; Anisette [liqueur]; Aperitif wines; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Arak; Arak [arrack]; Arrack; Arrack [arak]; Baijiu [Chinese distilled alcoholic beverage]; Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Beverages (Distilled -); Bitters; Black raspberry wine (Bokbunjaju); Blackcurrant liqueur; Blended whisky; Bourbon whiskey; Brandy; Cachaca; Calvados; Canadian whisky; Cherry brandy; Chinese brewed liquor (laojiou); Chinese mixed liquor (wujiapie-jiou); Chinese spirit of sorghum (gaolian-jiou); Chinese white liquor (baiganr); Chinese white liquor [baiganr]; Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy; Cooking wine; Cordials [alcoholic beverages]; Cream liqueurs; Curacao; Dessert wines; Digesters [liqueurs and spirits]; Distilled beverages; Distilled rice spirits [awamori]; Distilled spirits; Distilled spirits of rice (awamori); Dry cider; Extracts of spiritous liquors; Fermented spirit; Flavored tonic liquors; Fortified wines; Fruit (Alcoholic beverages containing -); Fruit extracts, alcoholic; Fruit wine; Gaolian-jiou [sorghum-based Chinese spirits]; Gin; Ginseng liquor; Grape wine; Grappa; Herb liqueurs; Hulless barley liquor; Hydromel [mead]; Japanese liquor

containing herb extracts; Japanese liquor containing mamushi-snake extracts; Japanese liquor flavored with Japanese plum extracts; Japanese liquor flavored with pine needle extracts; Japanese regenerated liquors (naoshi); Japanese sweet grape wine containing extracts of ginseng and cinchona bark; Japanese sweet rice-based mixed liquor (shiro-zake); Japanese sweet rice-based mixed liquor [shiro-zake]; Japanese white liquor (shochu); Japanese white liquor [shochu]; Kirsch; Korean distilled spirits (soju); Korean traditional rice wine (makgeoli); Liqueurs; Liqueurs containing cream; Liquor-based aperitifs; Low alcoholic drinks; Low-alcoholic wine; Malt whisky; Mead [hydromel]; Mulled wine; Mulled wines; Natural sparkling wines; Naturally sparkling wines; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Piquette; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Red wine; Red wines; Rice alcohol; Rose wines; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sake substitutes; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Shochu (spirits); Sorghum-based Chinese spirits; Sparkling fruit wine; Sparkling grape wine; Sparkling red wines; Sparkling white wines; Sparkling wine; Sparkling wines; Spirits; Spirits and liquors; Spirits [beverages]; Still wine; Strawberry wine; Sugar cane juice rum; Sweet cider; Sweet wine; Sweet wines; Table wines; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with Japanese plum extracts (umeshu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; White wine; White wines; Wine; Wine coolers [drinks]; Wine punch; Wine-based aperitifs; Wine-based drinks; Wines; Wines of protected appellation of origin; Wines of protected geographical indication; Yellow rice wine.

2. The application is opposed by Lidl Stiftung & Co. KG (“the opponent”). The opposition is directed against the applicant’s class 32 goods only. The opposition is based upon section 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following marks:

**LORD NELSON**

UKTM no. 2113010 (“the First Earlier Mark”)

Filing date 17 October 1996; registration date 30 January 1998

The opponent relies on all of the goods for which the mark is registered:

Class 30      Tea; tea products; tea substitutes.

**LORD NELSON**

UKTM no. 49736E (“the Second Earlier Mark”)

Filing date 18 December 1885; registration date 18 December 1885

The opponent relies on some of the goods for which the mark is registered:

Class 30      Tea

**LORD NELSON**

EUTM no. 4935623 (“the Third Earlier Mark”)

Filing date 28 February 2006; registration date 12 April 2007

The opponent relies on all of the goods for which the mark is registered:

Class 30      Tea from England.

3. The opponent claims that the respective goods are identical or similar and that the marks are identical. The opponent has confirmed that it is not prepared to withdraw its opposition notwithstanding the amendments to the applicant’s specification.

4. The applicant filed a counterstatement denying the claims made and requests that the opponent provide proof of use of the marks relied upon.



5. The applicant is represented by ip21 Limited and the opponent is represented by Urquhart-Dykes & Lord LLP. The opponent filed evidence in the form of the witness statement of Paul Gibson dated 4 December 2018. The applicant filed evidence in the form of the witness statement of Jacqueline Tolson dated 6 February 2019. The opponent filed evidence in reply in the form of the witness statement of Anna Teresa Szpek dated 5 April 2019. No hearing was requested, but both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

### **The Opponent's Evidence**

6. The opponent's evidence in chief consists of the witness statement of Paul Gibson, which is accompanied by 4 exhibits. Mr Gibson is the Buying Director for Lidl UK GmbH ("Lidl UK"), which is a wholly owned subsidiary of the opponent. He has worked for Lidl UK since 2003 and has held his current position since 1 November 2010.

7. Mr Gibson states that Lidl UK and the opponent started using the mark LORD NELSON in respect of tea in the UK in 1999 and in the EU in 1995. Mr Gibson states that the mark has been used in respect of a variety of tea types (including different flavours and different forms such as tea bags, granules etc.). Mr Gibson has provided copies of packaging for products sold under the opponent's marks<sup>1</sup>. The packaging includes boxes of Earl Grey, Green Tea with Jasmine, Vanilla, Green Tea with Vanilla and Green Tea with Lemon tea bags and Lemon, Mixed Berry and Peach flavoured instant tea. They are dated between 2010 and 2017 and all display the following mark:



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<sup>1</sup> Exhibit PXG1

8. Mr Gibson has also provided photographs of products as sold to the public which display the same variant mark<sup>2</sup>, although I note that these are undated and the locations in which these products have been sold is not provided.

9. Mr Gibson states that the opponent wants to keep turnover figures for the UK confidential and therefore has only provided a turnover figure for a small selection of tea products (8 products including various flavours of instant tea drinks, green tea bags and peppermint herbal infusions). The approximate minimum turnover figure provided for such products sold in the UK between 2013 and February 2018 is £2,800,500, with approximately 2,625,000 units sold.

10. Mr Gibson has provided a selection of invoices which are issued by the supplier of the products to the opponent<sup>3</sup>. These are dated between 2013 and 2018. The invoice amounts have been redacted but they show that over 120,000 units of LORD NELSON tea has been sold to the opponent by their supplier.

11. Mr Gibson states that the opponent has 620 stores across the UK and has a market share in the UK, as a grocer, of approximately 5.6%. Mr Gibson states that the opponent has over 10,000 stores across the rest of the EU with 3,200 stores in Germany and 1,500 stores in France. Mr Gibson has provided examples of offers targeted at customers in Poland and the Netherlands regarding tea products sold under the mark LORD NELSON<sup>4</sup>. One of these is dated 29 January 2013, but the other appears to be undated.

12. This concludes my summary of the opponent's evidence insofar as I consider it necessary.

### **The Applicant's Evidence**

13. The applicant's evidence consists of the witness statement of Jacqueline Tolson, the applicant's trade mark attorney, which is accompanied by 3 exhibits.

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<sup>2</sup> Exhibit PXG2

<sup>3</sup> Exhibit PXG3

<sup>4</sup> Exhibit PXG4

14. Ms Tolson has provided print outs showing the number of marks co-existing on the Register which contain the word NELSON and which are registered in classes 30, 32 and 33<sup>5</sup>. Ms Tolson has also provided a print out from the Registry's cross-search list and notes that this does not identify the goods in class 30 as being similar to those in classes 32 and 33<sup>6</sup>.

15. Ms Tolson has provided a print out from the Eastern Daily Press which discusses the closure of a public house in Norfolk, in which Nelson once drank. Ms Tolson states that the applicant's interest is connected with this public house and their desire to sell goods under its name.

16. This concludes my summary of the applicant's evidence insofar as I consider it necessary. Ms Tolson's evidence was accompanied by written submissions dated 6 February 2019. The applicant also filed written submissions in lieu of a hearing. Whilst I do not propose to summarise those submissions here, I have taken them into account and will refer to them below if necessary.

### **The Opponent's Evidence in Reply**

17. The opponent's evidence in reply consists of the witness statement of Anna Teresa Szpek, which is accompanied by 9 exhibits. Ms Szpek is the trade mark attorney acting on behalf of the opponent.

18. Ms Szpek states that on 2 April 2019, she conducted investigations on the internet and in person regarding the sale of tea-based drinks. She has provided a print outs from the websites of Sainsbury's, Tesco, Waitrose and Morrison, as well as photographs taken within the stores of these businesses located in Wimbledon, which show that iced tea products are commonly sold alongside other soft drinks including fruit juices, tonic water, sparkling water, carbonated drinks, cordials and energy drinks<sup>7</sup>.

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<sup>5</sup> Exhibit JT1

<sup>6</sup> Exhibit JT2

<sup>7</sup> Exhibits ATS1 to ATS8

19. This concludes my summary of the opponent's evidence in reply insofar as I consider it necessary. The opponent also filed written submissions in lieu of a hearing. Whilst I do not propose to summarise those here, I have taken them into account and will refer to them below where necessary.

## **PRELIMINARY ISSUES**

20. Ms Tolson referred, in her evidence, to other trade marks that are currently on the register which include the word NELSON. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71)."

21. In *British Sugar Plc v James Robertson & Sons Ltd* [1996], RPC 281, Mr Justice Jacob said:

"Both sides invite me to have regard to the state of the register. Some traders have registered marks consisting of or incorporating the word "treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the register does not tell you what is actually happening

out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the register. It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see eg *Madam Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.”

22. When assessing the likelihood of confusion under section 5(2), it is necessary for me to consider the potential for conflict between the applied for mark and the earlier trade marks in light of all the relevant circumstances. The existence of other trade marks on the register is not relevant to the decision I have to make.

23. I also note that Ms Tolson made reference to the applicant’s reason for being interested in registering the trade mark LORD NELSON. The assessment that I must undertake is whether there is a likelihood of confusion between the marks. The applicant’s intention or reason for seeking registration is not relevant to this assessment.

## **DECISION**

24. Section 5(2)(a) of the Act reads as follows:

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

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

(b) [...]

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

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

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

(a) a registered trade mark, international trade mark (UK) 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.”

26. The trade marks upon which the opponent relies qualify as earlier trade marks under the above provisions. As these trade marks completed their registration process more than 5 years before the publication date of the application in issue, they are subject to proof of use pursuant to section 6A of the Act and the applicant has, consequently, requested that the opponent prove use of its marks.

### **Proof of Use**

27. The first issue is whether, or to what extent, the opponent has shown genuine use of the earlier marks. The relevant statutory provisions are as follows:

“Raising of relative grounds in opposition proceedings in case of non-use

6A-(1) This section applies where –

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

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

(c) the registration procedure for the earlier trade mark was completed before the start of the period of five years ending with the date of publication.

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

(a) use of a trade mark includes use in a form differing in elements which do not alter the distinctive character of the mark in the form of which it was registered, and

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

(5) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

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

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

28. Section 100 of the Act is also relevant, which reads:

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

29. According to section 6(3)(a) of the Act, the relevant period in which genuine use must be established is the five-year period ending on the date of publication of the applied for mark. The relevant period is, therefore, 3 February 2013 to 2 February 2018.

30. What constitutes genuine use has been subject to a number of judgments. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. summarised the case law on genuine use of trade marks. He said:

“217. *The law with respect to genuine use* . In *Stichting BDO v BDO Unibank Inc* [2013] EWHC 418 (Ch), [2013] FSR 35 I set out at [51] a helpful summary by Anna Carboni sitting as the Appointed Person in *SANT AMBROEUS Trade Mark* [2010] RPC 28 at [42] of the jurisprudence of the CJEU in Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439 , Case C-259/02 *La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 and Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759 (to which I added references to Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237 ). I also referred at [52] to the judgment of the CJEU in Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16 on the question of the territorial extent of the use. Since then the CJEU has issued a reasoned Order in Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and that Order has been persuasively analysed by Professor



Ruth Annand sitting as the Appointed Person in *SdS InvestCorp AG v Memory Opticians Ltd* (O/528/15).

...

219. I would now summarise the principles for the assessment of whether there has been genuine use of a trade mark established by the case law of the Court of Justice, which also includes Case C-442/07 *Verein Radetzky-Orden v Bundesvereinigung Kameradschaft 'Feldmarschall Radetzky'* [2008] ECR I-9223 and Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR 7, as follows:

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

31. As one of the earlier marks is an EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Marken BV v Hagelkruis Beheer BV*, Case C-149/11, will also be relevant. The court noted that:

“36. It should, however, be observed that [...] the territorial scope of the use is not a separate condition for genuine use but one of the factors determining genuine use, which must be included in the overall analysis and examined at the same time as other such factors. In that regard, the phrase ‘in the Community’ is intended to define the geographical market serving as the reference point for all consideration of whether a Community trade mark has been put to genuine use.”

And:

“50. Whilst there is admittedly some justification for thinking that a Community trade mark should – because it enjoys more extensive territorial protection than a national trade mark – be used in a larger area than the territory of a single Member State in order for the use to be regarded as ‘genuine use’, it cannot be ruled out that, in certain circumstances, the market for the goods or services for which a Community trade mark has been registered is in fact restricted to the territory of a single Member State. In such a case, use of the Community trade mark on that territory might satisfy the conditions both for genuine use of a Community trade mark and for genuine use of a national trade mark.”

And:

“55. Since the assessment of whether the use of the trade mark is genuine is carried out by reference to all the facts and circumstances relevant to establishing whether the commercial exploitation of the mark serves to create or maintain market shares for the goods or services for which it was registered, it is impossible to determine a priori, and in the abstract, what territorial scope should be chosen in order to determine whether the use of the mark is genuine or not. A *de minimis* rule, which would not allow the national court to appraise all the circumstances of the dispute before it, cannot therefore be laid down (see, by analogy, the order in *La Mer Technology*, paragraphs 25 and 27, and the judgment in *Sunrider v OHIM*, paragraphs 72 and 77)”.

32. The court held that:

“Article 15(1) of Regulation No 207/2009 of 26 February 2009 on the Community trade mark must be interpreted as meaning that the territorial borders of the Member States should be disregarded in the assessment of whether a trade mark has been put to ‘genuine use in the Community’ within the meaning of that provision.

A Community trade mark is put to ‘genuine use’ within the meaning of Article 15(1) of Regulation No 207/2009 when it is used in accordance with its essential function and for the purpose of maintaining or creating market share within the European Community for the goods or services covered by it. It is for the referring court to assess whether the conditions are met in the main proceedings, taking account of all the relevant facts and circumstances, including the characteristics of the mark concerned, the nature of the goods or services protected by the trade mark and the territorial extent and the scale of the use as well as its frequency and regularity.”

33. In *The London Taxi Corporation Limited v Frazer-Nash Research Limited & Ecotive Limited*, [2016] EWHC 52, Arnold J. reviewed the case law since the *Leno* case and concluded as follows:

“228. Since the decision of the Court of Justice in *Leno* there have been a number of decisions of OHIM Boards of Appeal, the General Court and national courts with respect to the question of the geographical extent of the use required for genuine use in the Community. It does not seem to me that a clear picture has yet emerged as to how the broad principles laid down in *Leno* are to be applied. It is sufficient for present purposes to refer by way of illustration to two cases which I am aware have attracted comment.

229. In Case T-278/13 *Now Wireless Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs)* the General Court upheld at [47] the finding of the Board of Appeal that there had been genuine use of the contested mark in relation to the services in issue in London and the Thames

Valley. On that basis, the General Court dismissed the applicant's challenge to the Board of Appeal's conclusion that there had been genuine use of the mark in the Community. At first blush, this appears to be a decision to the effect that use in rather less than the whole of one Member State is sufficient to constitute genuine use in the Community. On closer examination, however, it appears that the applicant's argument was not that use within London and the Thames Valley was not sufficient to constitute genuine use in the Community, but rather that the Board of Appeal was wrong to find that the mark had been used in those areas, and that it should have found that the mark had only been used in parts of London: see [42] and [54]-[58]. This stance may have been due to the fact that the applicant was based in Guilford, and thus a finding which still left open the possibility of conversion of the community trade mark to a national trade mark may not have sufficed for its purposes.

230. In *The Sofa Workshop Ltd v Sofaworks Ltd* [2015] EWHC 1773 (IPEC), [2015] ETMR 37 at [25] His Honour Judge Hacon interpreted *Leno* as establishing that "genuine use in the Community will in general require use in more than one Member State" but "an exception to that general requirement arises where the market for the relevant goods or services is restricted to the territory of a single Member State." On this basis, he went on to hold at [33]-[40] that extensive use of the trade mark in the UK, and one sale in Denmark, was not sufficient to amount to genuine use in the Community. As I understand it, this decision is presently under appeal and it would therefore be inappropriate for me to comment on the merits of the decision. All I will say is that, while I find the thrust of Judge Hacon's analysis of *Leno* persuasive, I would not myself express the applicable principles in terms of a general rule and an exception to that general rule. Rather, I would prefer to say that the assessment is a multi-factorial one which includes the geographical extent of the use."

34. The GC restated its interpretation of *Leno* in Case T-398/13, *TVR Automotive Ltd v OHIM* (see paragraph 57 of the judgment). This case concerned national (rather than local) use of what was then known as a Community trade mark (now a European Union trade mark). Consequently, in trade mark opposition and cancellation proceedings the registrar continues to entertain the possibility that use of an EUTM in an area of the

Union corresponding to the territory of one Member State may be sufficient to constitute genuine use of an EUTM. This applies even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.

35. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the EUTM, in the course of trade, sufficient to create or maintain a market for the goods at issue in the Union during the relevant 5-year period. In making the assessment I am required to consider the relevant factors, including:

- a) The scale and frequency of the use shown;
- b) The nature of the use shown;
- c) The goods for which use has been shown;
- d) The nature of those goods and the market(s) for them; and
- e) The geographical extent of the use shown.

36. Proven use of a mark which fails to establish that “the commercial exploitation of the mark is real” because the use would not be “viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark” is, therefore, not genuine use.

### **Form of the mark**

37. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of

Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the 'use' of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

38. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:

“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub-questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

39. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

40. The opponent’s marks are used as registered in the evidence, which will clearly be use upon which the opponent may rely. Notional and fair use of the opponent’s marks will cover use in any standard typeface and so use of the marks in upper or lower case will be an acceptable variant. The opponent’s marks also appear in the following variant:





41. The words LORD NELSON are presented in white on a blue background with a device of a boat wheel above it and underlined in red. The background is outlined in a thin white line. It is clear from the case law cited above, that use in combination with additional matter is use upon which the opponent may rely (as per *Colloseum*). I consider this to be an acceptable variant of the opponent's marks. This is, therefore, use upon which the opponent may rely.

### **Sufficient Use**

42. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself<sup>8</sup>.

43. I note the applicant's submissions that the opponent has filed limited evidence given that it is claiming to have used its marks for over 20 years. However, the opponent is only required to demonstrate use during the relevant period in order to be able to rely on its earlier marks for the purposes of this opposition. Whilst I recognise that the opponent's evidence could have been more detailed, it is entirely reasonable and proportionate for the opponent to seek to target their evidence at this period rather than seeking to show use for the entire period of registration.

44. The opponent has shown its marks in use on a variety of tea products. Examples of packaging have been provided which are dated during the relevant period. The opponent has provided a minimum approximate turnover figure for a total of 8 products in the UK between 2013 and February 2018. This amounts to £2,800,500, with 2,625,000 units being sold. Whilst I accept that this is far from extensive over a 5-year period, I am satisfied that this is sufficient to show real commercial exploitation of the mark in the UK. I note that the opponent has provided its market share for its business as a grocer, but it does not necessarily follow that its market in tea and tea-based products is the same. Nonetheless, when taking the evidence as a whole, I am satisfied that the opponent has done enough to demonstrate genuine use of its marks in the UK. I note that one of its marks is an EUTM and therefore the opponent must

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<sup>8</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

demonstrate use in the EU. However, as explained in *Leno Marken* above, use in one member state can be sufficient to constitute genuine use of an EUTM. I consider that to be the case here.

### **Fair Specification**

45. I must now consider whether, or the extent to which, the evidence shows use of all the goods relied upon.

46. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

47. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

48. I have already found that the opponent's evidence shows use of its marks in relation to a range of tea products. I am satisfied that the opponent can rely on "tea" and "tea products". I note that the specification of the Third Earlier Mark is "tea from England". As this falls within the category of "tea" I am satisfied that the opponent can also rely upon this term.

49. I note that there are no examples of the opponent having used its marks in relation to "tea substitutes". To my mind "tea substitutes" might cover products such as herbal "teas" which do not actually contain tea leaves but use herbs as an alternative base for the beverage. Alternatively, it might include products of the instant variety which

are used to create a “tea” type product, but which, again, do not actually use tea leaves as their base. As explained in the case law cited above, it is important to consider the perception of the average consumer when determining a fair specification for the opponent’s mark. I consider that “tea substitutes” would be perceived by the average consumer to belong to the same category of goods as those for which the opponent has demonstrated genuine use. They are likely to be produced by the same manufacturers and sold through the same trade channels alongside more conventional tea products. In my view, to prevent the opponent from relying on this would be to construe its use of its mark too narrowly. I consider that the opponent can rely on its full specification for all of the earlier marks.

### **Section 5(2)(a)**

#### **Comparison of the marks**

50. It is a prerequisite of section 5(2)(a) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer”.

51. In its written submissions, the applicant states that it is “agreed that the earlier marks on which the opponent has based the opposition are identical to the opposed trade mark application”. I agree. The marks are self-evidently identical, differing only in their presentation in upper or lower case which, as noted above, is covered by notional and fair use in any event.

#### **Comparison of goods and services**

52. The competing goods are as follows:

The Opponent's Goods	The Applicant's Goods
<p><b>First Earlier Mark</b></p> <p><u>Class 30</u></p> <p>Tea; tea products; tea substitutes.</p> <p><b>Second Earlier Mark</b></p> <p><u>Class 30</u></p> <p>Tea.</p> <p><b>Third Earlier Mark</b></p> <p><u>Class 30</u></p> <p>Tea from England.</p>	<p><u>Class 32</u></p> <p>Aerated fruit juices; Aerated juices; Aerated mineral waters; Aerated water; Aerated water (Preparations for making - ); Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Ale; Ales; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs, non-alcoholic; Apple juice beverages; Apple juice drinks; Barley wine [Beer]; Barley wine [beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages containing vitamins; Beverages (Non-alcoholic -); Beverages (Preparations for making -); Beverages (Whey -); Bitter lemon; Black beer; Black beer [toasted-malt beer]; Blackcurrant cordial; Blackcurrant juice; Bock beer; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut juice; Coconut water;</p>

	<p>Coconut water as a beverage; Coconut water as beverage; Coconut-based beverages; Cola; Cola drinks; Colas [soft drinks]; Concentrated fruit juice; Concentrated fruit juices; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Condensed smoked plum juice; Cordials; Cordials [non-alcoholic]; Cordials (non-alcoholic beverages); Craft beer; Craft beers; Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised drinks; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Dilutable preparations for making beverages; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Dry ginger ale; Effervescing beverages (Pastilles for -); Effervescing beverages (Powders for -); Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes]; Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in</p>
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	<p>the nature of essential oils]; Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Extracts of hops for making beer; Extracts of unfermented must; Flavor enhanced water; Flavored beer; Flavored beers; Flavored mineral water; Flavored waters; Flavoured beers; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit beverages (non-alcoholic); Fruit drinks; Fruit extracts (Non-alcoholic -); Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice concentrates; Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, nonalcoholic; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Ginger juice</p>
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	<p> beverages; Glacial water; Grape juice; Grape juice beverages; Grape must, unfermented; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -); Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; Iced fruit beverages; Imitation beer; India pale ales (IPAs); IPA (Indian Pale Ale); Isotonic beverages; Isotonic beverages [not for medical purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lager; Lagers; Lemon barley water; Lemon juice for use in the preparation of beverages; Lemon squash; Lemonade; Lemonades; Lime juice cordial; Lime juice for use in the preparation of beverages; Liqueurs (Preparations for making -); Lithia water; Low alcohol beer; Low calorie soft drinks; Low-alcohol beer; Low-calorie soft drinks; Malt beer; Malt syrup for beverages; Malt wort; Mango juice; Melon juice; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral water (Preparations for making -); Mineral waters; Mineral waters </p>
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	<p>[beverages]; Mixed fruit juice; Mixed fruit juices; Mixes for making sorbet beverages; Mung bean beverages; Must; Nectars (Fruit -), non-alcoholic; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Non-alcoholic beers; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sueonggwa); Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic punch; Non-alcoholic punches; Non-alcoholic rice punch (sikhye); Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-</p>
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	<p>alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Nutritionally fortified beverages; Nutritionally fortified water; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orange squash; Orgeat; Pale ale; Part frozen slush drinks; Pastilles for effervescing beverages; Pineapple juice beverages; Pomegranate juice; Porter; Powders for effervescing beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making liqueurs; Preparations for making mineral water; Protein-enriched sports beverages; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Saison beer; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Shandy; Sherbet beverages; Sherbets [beverages]; Slush drinks; Smoked plum beverages;</p>
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	<p>Smoked plum juice beverages; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating]; Smoothies [non-alcoholic fruit beverages]; Soda pops; Soda water; Soft drinks; Soft drinks for energy supply; Sorbets [beverages]; Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soy-based beverages, not being milk substitutes; Sparkling water; Sports drinks; Sports drinks containing electrolytes; Spring water; Spring waters; Squashes [non-alcoholic beverages]; Still water; Still waters; Stout; Stouts; Syrup for making beverages; Syrup for making lemonade; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks; Table water; Table waters; Tomato juice [beverage]; Tomato juice beverages; Tonic water; Tonic water [non-medicated beverages]; Unfermented preserved must; Vegetable drinks; Vegetable juice; Vegetable juices [beverage]; Vegetable juices [beverages]; Vegetable smoothies;</p>
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	Vegetable-based beverages; Vitamin enriched sparkling water [beverages]; Vitamin fortified non-alcoholic beverages; Water; Water (Lithia -); Water (Seltzer -); Watermelon juice; Waters; Waters [beverages]; Waters (Table -); Wheat beer; Whey beverages.
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53. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the CJEU in *Canon*, C-39/97, the court stated at paragraph 23 of its judgment that:

“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.”

54. 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 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.

55. 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.”

56. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

57. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category,

designated by trade mark application (Case T-388/00 Institut for Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

58. In its written submissions, the applicant states:

“4. Applying the British Sugar test, tea is generally a warm beverage, whereas beverages in classes 32 and 33 are generally served cold. The uses of the respective goods are therefore different. The users of the goods are different, and the physical nature of the goods are certainly different as tea is presented either as a powder or primarily as a leaf (encased or otherwise) whereas the applicant’s goods are generally sold in liquid form. Looking at the trade channels through which they are sold, tea is generally sold either through grocers, supermarkets or through specialist tea retailers, whereas the applicant’s products maybe sold either through supermarkets or through licensed premises. If in a supermarket, the goods are found in entirely separate areas of the supermarket, and certainly on different shelves. Lastly the goods are not completive.

Therefore, the goods of interest to the respective parties are dissimilar.”

59. In its written submissions in lieu, the opponent states:

“The Opponent’s evidence in reply by way of a witness statement from Anna Teresa Szpek seeks to assist in the comparison of goods. Tea in Class 30 is necessarily similar to tea based beverages in Class 32 because of the common ingredient, tea. [...] tea is similar to all beverages in class 32. By the Applicant’s own reasoning with reference to the UKIPO cross search list, goods in the same class are similar or identical. Therefore, tea based beverages in Class 32 must be similar to other beverages in Class 32. Given that there is similarity between tea based beverages and beverages in Class 32 and that there is similarity between tea in Class 30 and tea based beverages in Class 32, there must be similarity between tea in Class 30 and beverages in general in Class 32.”

60. For the avoidance of doubt, the cross-search list used by the Registry to notify third parties of potential conflict between an application and their registered marks is for reference purposes only and is not exhaustive.

61. “Tea”, “tea products”, “tea substitutes” and “Tea from England” in the opponent’s specifications all fall within the broader categories of “Alcohol free beverages”, “Beverages (Non-alcoholic -)”, “Non-alcoholic beverages” and “Non-alcoholic drinks” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

62. The following goods in the applicant’s specification are all soft drinks:

Aerated fruit juices; Aerated juices; Aerated mineral waters; Aerated water; Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs, non-alcoholic; Apple juice beverages; Apple juice drinks; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Bitter lemon; Blackcurrant juice; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut juice; Coconut water; Coconut water as a beverage; Coconut water as beverage; Coconut-based beverages; Cola; Cola drinks; Colas [soft drinks]; Concentrated fruit juice; Concentrated fruit juices; Condensed smoked plum juice; Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised drinks; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking waters; Dry ginger ale; Flavor enhanced water; Flavored mineral water; Flavored waters; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages; Fruit beverages and fruit juices; Fruit beverages

(non-alcoholic); Fruit drinks; Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, nonalcoholic; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit-based beverages; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Ginger juice beverages; Glacial water; Grape juice; Grape juice beverages; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -); Iced fruit beverages; Imitation beer; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lemon barley water; Lemonade; Lemonades; Lithia water; Low calorie soft drinks; Low-calorie soft drinks; Mango juice; Melon juice; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral waters; Mineral waters [beverages]; Mixed fruit juice; Mixed fruit juices; Mung bean beverages; Nectars (Fruit -), non-alcoholic; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Non-alcoholic beers; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); Non-alcoholic cocktails; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic punch; Non-alcoholic punches; Non-alcoholic rice punch (sikhye); Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orgeat; Part frozen slush drinks; Pineapple juice beverages; Pomegranate juice; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Sherbet



beverages; Sherbets [beverages]; Slush drinks; Smoked plum beverages; Smoked plum juice beverages; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating]; Smoothies [non-alcoholic fruit beverages]; Soda pops; Soda water; Soft drinks; Sorbets [beverages]; Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soy-based beverages, not being milk substitutes; Sparkling water; Spring water; Spring waters; Still water; Still waters; Table water; Table waters; Tomato juice [beverage]; Tomato juice beverages; Tonic water; Tonic water [non-medicated beverages]; Vegetable drinks; Vegetable juice; Vegetable juices [beverage]; Vegetable juices [beverages]; Vegetable smoothies; Vegetable-based beverages; Water; Water (Lithia -); Water (Seltzer -); Watermelon juice; Waters; Waters [beverages]; Waters (Table -).

63. They will overlap in user and uses with the “tea” in the opponent’s specification as the goods will all be consumed by members of the general public and are all intended for the purpose of quenching thirst. This is particularly the case bearing in mind that the opponent’s “tea” is broad enough to cover iced tea products. Both iced tea and the drinks listed in the applicant’s specification will be served in liquid form, often in the ready to drink variety. As noted in the opponent’s evidence, these are often sold alongside each other in the same retail outlets. The goods are likely to be available through the same trade channels. There will be an element of competition between the goods as someone looking to purchase a beverage may choose either the applicant’s goods or the opponent’s. I consider the goods to be similar to a high degree.

64. “Beverages containing vitamins”, “Beverages (Whey -)”, “Drinking water with vitamins”, “Energy drinks”, “Energy drinks containing caffeine”, “Energy drinks [not for medical purposes]”, “Isotonic beverages”, “Isotonic beverages [not for medical purposes]”, “Isotonic drinks”, “Isotonic non-alcoholic drinks”, “Nutritionally fortified beverages”, “Nutritionally fortified water”, “Protein-enriched sports beverages”, “Soft drinks for energy supply”, “Sports drinks”, “Sports drinks containing electrolytes”, “Vitamin enriched sparkling water [beverages]”, “Vitamin fortified non-alcoholic beverages” and “Whey beverages” in the applicant’s specification are also soft drinks,

but they have an added purpose such as to give the user an energy or nutritional boost. This will be a point of difference with the opponent's tea-based goods, although the fundamental use of all of the goods will remain the same – to quench thirst. The users will overlap. The method of use and nature will overlap. The goods will be sold through the same trade channels. I consider the goods to be similar to at least a medium degree.

65. The following goods in the applicant's specification are all preparations used to make soft drinks:

Aerated water (Preparations for making -); Beverages (Preparations for making -); Blackcurrant cordial; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Cordials; Cordials [non-alcoholic]; Cordials (non-alcoholic beverages); Dilutable preparations for making beverages; Effervescing beverages (Pastilles for -); Effervescing beverages (Powders for -); Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils]; Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Fruit extracts (Non-alcoholic -); Fruit juice bases; Fruit juice concentrates; Fruit squashes; Lemon juice for use in the preparation of beverages; Lemon squash; Lime juice cordial; Lime juice for use in the preparation of beverages; Malt syrup for beverages; Mineral water (Preparations for making -); Mixes for making sorbet beverages; Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cordials; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Orange squash; Pastilles for effervescing beverages; Powders for effervescing beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water;

Preparations for making beverages; Preparations for making mineral water; Squashes [non-alcoholic beverages]; Syrup for making beverages; Syrup for making lemonade; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks.

66. The applicant's goods will be used in the preparation of making beverages. They will require the addition of something else to make them into their drinkable form (such as water). The nature of the goods is different. There may be some overlap in trade channels, in that they may all be available from retail outlets such as supermarkets. However, the trade channels will also differ with the applicant's goods not being purchasable through food and drink outlets such as restaurants and bars, whereas the opponent's goods will be. I consider the goods to be similar to a low degree.

67. "Ale", "Ales", "Barley wine [Beer]", "Barley wine [beer]", "Beer", "Beer and brewery products", "Beer wort", "Beer-based beverages", "Beer-based cocktails", "Beers", "Beers enriched with minerals", "Black beer", "Black beer [toasted-malt beer]", "Bock beer", "Craft beer", "Craft beers", "Flavored beer", "Flavored beers", "Flavoured beers", "India pale ales (IPAs)", "IPA (Indian Pale Ale)", "Lager", "Lagers", "Low alcohol beer", "Low-alcohol beer", "Malt beer", "Pale ale", "Porter", "Saison beer", "Shandy", "Stout", "Stouts" and "Wheat beer" in the applicant's specification are all alcoholic beverages. They overlap, broadly, in purpose and method of use with the opponent's "tea" in that they are all beverages for consumption. However, in *Wesergold Getrankeindustrie GmbH & bCo KG v EUIPO*, case T-278/10, the GC held that "spirits, particularly whisky" were not similar to non-alcoholic beverages. In that case, the court found that the very nature of the goods was different due to the presence (or lack) of alcohol in the goods. The court found that this was perceived by consumers to be a significant difference in the nature of the goods and, given the very different methods of production, consumers would not expect the goods to originate from the same or economically linked undertakings. In my view, the same applies to the goods in the present case. I consider these goods to be dissimilar.

68. “Extracts of hops for making beer”, “Extracts of unfermented must”, “Grape must, unfermented”, “Hop extracts for manufacturing beer”, “Hop extracts for use in the preparation of beverages”, “Hops (Extracts of -) for making beer”, “Liqueurs (Preparations for making -)”, “Malt wort”, “Must”, “Preparations for making liqueurs” and “Unfermented preserved must” in the applicant’s specification are all goods used in the process of producing alcoholic beverages. The user may overlap on a superficial level in that home brewers of alcoholic beverages may purchase these goods as well as the opponent’s “tea”. However, there is also a significant difference in user in that the applicant’s goods will predominantly be used by businesses in the field of alcoholic beverage production, whereas the opponent’s goods will be used by members of the general public. The uses of the goods are different, with the opponent’s goods being used to quench thirst and the applicant’s goods being used to produce secondary products. The method of use, trade channels and nature of the goods are different. They are not in competition with each other. I consider these goods to be dissimilar.

69. As some degree of similarity is required for there to be a likelihood of confusion, the opposition must fail in respect of the goods that I have found to be dissimilar with the opponent’s goods<sup>9</sup>.

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

70. 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 the goods are likely to be selected by the average consumer. 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

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<sup>9</sup> *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA

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.”

71. The average consumer for the goods will be a member of the general public. The goods are all likely to be relatively low in cost, although the average consumer will still take into account varying factors during the purchasing process such as flavour, nutritional properties and sugar content. Purchases of the goods are likely to be fairly frequent. The level of attention during the purchasing process is likely to be average.

72. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or an online equivalent. I also recognise that they may be purchased from food and beverage outlets, at which the consumer is likely to view the products on a shelf behind the bar or on a drinks menu. However, I do not discount that there may be an aural component to the purchase of the goods given that advice may be sought from a sales assistant or orders may be placed in person at a bar.

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

73. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

74. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

75. The opponent has filed evidence to demonstrate that it has used its marks. In my view, whilst the evidence is sufficient to demonstrate use of the marks, it is not sufficient to establish that the opponent’s marks have acquired enhanced distinctive character through use. The market share information provided by the opponent relates to its position in the market as a grocer. However, no market share figures have been provided in relation to the opponent’s position within the tea market specifically. I therefore have only the inherent position to consider. The opponent’s marks are all the words LORD NELSON, which is a famous name. It is neither allusive nor descriptive for the goods in issue. I consider the opponent’s marks to have a medium degree of inherent distinctive character.

### **Likelihood of confusion**

76. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency

principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

77. I have found the marks to be identical. I have found the earlier marks to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public and I consider that the goods will be selected primarily by visual means, although I do not discount an aural component. I have concluded that an average degree of attention will be paid during the purchasing process. I have found the parties' goods to range from similar to a low degree to identical (except for those which I have found to be dissimilar).

78. In accordance with the interdependency principle, a low degree of similarity between the goods can be offset by a greater degree of similarity between the marks. Bearing in mind the fact that the marks are identical and the opponent's marks have a medium degree of inherent distinctive character, I consider that there is a likelihood of direct confusion in respect of all goods for which I have found there to be similarity (including those goods which are only similar to a low degree).

## **CONCLUSION**

79. The opposition has been successful in respect of the following goods for which the application is refused:

Class 32      Aerated fruit juices ;Aerated juices; Aerated mineral waters; Aerated water; Aerated water (Preparations for making -); Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs,

non-alcoholic; Apple juice beverages; Apple juice drinks; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages containing vitamins; Beverages (Non-alcoholic -); Beverages (Preparations for making -); Beverages (Whey -); Bitter lemon; Blackcurrant cordial; Blackcurrant juice; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut juice; Coconut water; Coconut water as a beverage; Coconut water as beverage; Coconut-based beverages; Cola; Cola drinks; Colas [soft drinks]; Concentrated fruit juice; Concentrated fruit juices; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Condensed smoked plum juice; Cordials; Cordials [non-alcoholic]; Cordials (non-alcoholic beverages); Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised drinks; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Dilutable preparations for making beverages; Distilled drinking water; Douzhi (fermented bean drink); Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Dry ginger ale; Effervescing beverages (Pastilles for -); Effervescing beverages (Powders for -); Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes]; Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils]; Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Flavor enhanced water; Flavored mineral water; Flavored waters; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages; Fruit



beverages and fruit juices; Fruit beverages (non-alcoholic); Fruit drinks; Fruit extracts (Non-alcoholic -); Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks; Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice concentrates; Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, nonalcoholic; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Ginger juice beverages; Glacial water; Grape juice; Grape juice beverages; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -); Iced fruit beverages; Imitation beer; Isotonic beverages; Isotonic beverages [not for medical purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lemon barley water; Lemon juice for use in the preparation of beverages; Lemon squash; Lemonade; Lemonades; Lime juice cordial; Lime juice for use in the preparation of beverages; Lithia water; Low calorie soft drinks; Low-calorie soft drinks; Malt syrup for beverages; Mango juice; Melon juice; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral water (Preparations for making -); Mineral waters; Mineral waters [beverages]; Mixed fruit juice; Mixed fruit juices; Mixes for making sorbet beverages; Mung bean beverages; Nectars (Fruit -), non-alcoholic; Non-alcoholic beer; Non-alcoholic beer flavored beverages ;Non-alcoholic beers; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujeonggwa); Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Non-

alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic punch; Non-alcoholic punches; Non-alcoholic rice punch (sikhye); Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Nutritionally fortified beverages; Nutritionally fortified water; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orange squash; Orgeat; Part frozen slush drinks; Pastilles for effervescing beverages; Pineapple juice beverages; Pomegranate juice; Powders for effervescing beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making mineral water; Protein-enriched sports beverages; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Sherbet beverages; Sherbets [beverages]; Slush drinks; Smoked plum beverages; Smoked plum juice beverages; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating]; Smoothies [non-alcoholic fruit beverages]; Soda pops; Soda water; Soft drinks; Soft drinks for energy supply; Sorbets [beverages]; Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soya-based beverages, not being milk substitutes; Sparkling water; Sports drinks; Sports drinks containing electrolytes; Spring water; Spring waters; Squashes [non-alcoholic beverages]; Still water; Still waters; Syrup for making beverages; Syrup for making lemonade; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups

for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks; Table water; Table waters; Tomato juice [beverage]; Tomato juice beverages; Tonic water; Tonic water [non-medicated beverages]; Vegetable drinks; Vegetable juice; Vegetable juices [beverage]; Vegetable juices [beverages]; Vegetable smoothies; Vegetable-based beverages; Vitamin enriched sparkling water [beverages]; Vitamin fortified non-alcoholic beverages; Water; Water (Lithia -); Water (Seltzer -); Watermelon juice; Waters; Waters [beverages]; Waters (Table -); Whey beverages.

80. The opposition has been unsuccessful in respect of the following goods for which the application will proceed to registration:

Class 32 Ale; Ales; Barley wine [Beer]; Barley wine [beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Black beer; Black beer [toasted-malt beer]; Bock beer; Craft beer; Craft beers; Extracts of hops for making beer; Extracts of unfermented must; Flavored beer; Flavored beers; Flavoured beers; Grape must, unfermented; Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; India pale ales (IPAs); IPA (Indian Pale Ale); Lager; Lagers; Liqueurs (Preparations for making -); Low alcohol beer; Low-alcohol beer; Malt beer; Malt wort; Must; Pale ale; Porter; Preparations for making liqueurs; Saison beer; Shandy; Stout; Stouts; Unfermented preserved must; Wheat beer.

81. The application will also proceed to registration for the following goods, which were unopposed:

Class 33 Absinthe; Acanthopanax wine (Ogapiju); Aguardiente [sugarcane spirits]; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs; Alcoholic beverages containing fruit; Alcoholic beverages, except beer;

Alcoholic beverages (except beer); Alcoholic beverages except beers;  
Alcoholic beverages (except beers); Alcoholic beverages [except beers];  
Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated  
beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails;  
Alcoholic cocktails containing milk; Alcoholic cocktails in the form of  
chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials;  
Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences;  
Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail  
drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches;  
Alcoholic tea-based beverage; Alcopops; Amontillado; Anise [liqueur];  
Anisette; Anisette [liqueur]; Aperitif wines; Aperitifs; Aperitifs with a  
distilled alcoholic liquor base; Arak; Arak [arrack]; Arrack; Arrack [arak];  
Baijiu [Chinese distilled alcoholic beverage]; Beverages (Alcoholic -),  
except beer; Beverages containing wine [spritzers]; Beverages (Distilled  
-); Bitters; Black raspberry wine (Bokbunjaju); Blackcurrant liqueur;  
Blended whisky; Bourbon whiskey; Brandy; Cachaca; Calvados;  
Canadian whisky; Cherry brandy; Chinese brewed liquor (laojiou);  
Chinese mixed liquor (wujiapie-jiou); Chinese spirit of sorghum (gaolian-  
jiou); Chinese white liquor (baiganr); Chinese white liquor [baiganr];  
Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy;  
Cooking wine; Cordials [alcoholic beverages]; Cream liqueurs; Curacao;  
Dessert wines; Digesters [liqueurs and spirits]; Distilled beverages;  
Distilled rice spirits [awamori]; Distilled spirits; Distilled spirits of rice  
(awamori); Dry cider; Extracts of spiritous liquors; Fermented spirit;  
Flavored tonic liquors; Fortified wines; Fruit (Alcoholic beverages  
containing -); Fruit extracts, alcoholic; Fruit wine; Gaolian-jiou [sorghum-  
based Chinese spirits]; Gin; Ginseng liquor; Grape wine; Grappa; Herb  
liqueurs; Hulless barley liquor; Hydromel [mead]; Japanese liquor  
containing herb extracts; Japanese liquor containing mamushi-snake  
extracts; Japanese liquor flavored with Japanese plum extracts;  
Japanese liquor flavored with pine needle extracts; Japanese  
regenerated liquors (naoshi); Japanese sweet grape wine containing  
extracts of ginseng and cinchona bark; Japanese sweet rice-based  
mixed liquor (shiro-zake); Japanese sweet rice-based mixed liquor

[shiro-zake]; Japanese white liquor (shochu); Japanese white liquor [shochu]; Kirsch; Korean distilled spirits (soju); Korean traditional rice wine (makgeoli); Liqueurs; Liqueurs containing cream; Liquor-based aperitifs; Low alcoholic drinks; Low-alcoholic wine; Malt whisky; Mead [hydromel]; Mulled wine; Mulled wines; Natural sparkling wines; Naturally sparkling wines; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Piquette; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Red wine; Red wines; Rice alcohol; Rose wines; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sake substitutes; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Shochu (spirits); Sorghum-based Chinese spirits; Sparkling fruit wine; Sparkling grape wine; Sparkling red wines; Sparkling white wines; Sparkling wine; Sparkling wines; Spirits; Spirits and liquors; Spirits [beverages]; Still wine; Strawberry wine; Sugar cane juice rum; Sweet cider; Sweet wine; Sweet wines; Table wines; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; White wine; White wines; Wine; Wine coolers [drinks]; Wine punch; Wine-based aperitifs; Wine-based drinks; Wines; Wines of protected appellation of origin; Wines of protected geographical indication; Yellow rice wine.

## **COSTS**

82. The opponent has enjoyed the greater degree of success and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the opponent the sum of **£1,100** as a contribution towards its costs. In calculating this sum, I have taken into account the

fact that the opponent has only been partially successful. The sum is calculated as follows:

Preparing a statement and considering the applicant's statement	£200
Preparing evidence and evidence in reply and considering the applicant's evidence	£550
Preparing written submissions in lieu	£250
Official fee	£100
<b>Total</b>	<b>£1,100</b>

83. I therefore order Evans Group Holding Company Limited to pay Lidl Stiftung & Co. KG the sum of £1,100. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of June 2019**

**S WILSON**

**For the Registrar**