

O-438-20

TRADE MARKS ACT 1994
IN THE MATTER OF
TRADE MARK APPLICATION NO. 3383915
BY GOAT DRINKS LTD
TO REGISTER

I N Y T H

AS A TRADE MARK IN CLASS 32

AND

OPPOSITION THERETO
UNDER NO. 416758
BY VIGNERONS DE LA MEDITERRANEE

Background and pleadings

1. On 16 March 2019, Goat Drinks Ltd (“the applicant”) applied to register the trade mark shown below under number 3383915:

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2. The application was published for opposition purposes on 29 March 2019.

3. Vignerons de la Mediterranee (“the opponent”) filed a notice of opposition on 27 June 2019. The opposition, which is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), is directed only against the following goods in the application:

Class 32 Alcohol free beverages; Beverages (Non-alcoholic); Non-alcoholic aperitifs; Non-alcoholic cider; De-alcoholised wines; De-alcoholised drinks; Non-alcoholic beverages; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic drinks; Non-alcoholic fruit cocktails; Non-alcoholic drinks; Non-alcoholic wines; Non-alcoholic liquors.

4. The opponent relies upon the following trade mark registrations:

Mark 1:

MYTHIQUE (word mark)

International Registration (“IR”) no.: 983716

International registration and designation date: 17 September 2008

Date of protection granted in European Union (EU): 19 October 2009

Goods relied upon:

Class 33 Wine

(The opponent claims genuine use of the mark only in relation to wine)

Mark 2:



(figurative mark)

European Union (EU) registration no.: 13334461

Filing date: 6 October 2014

Date of entry in register: 27 February 2015

Goods:

Class 33 Wines and other alcoholic beverages (except for beers)

5. The opponent argues that there is a likelihood of confusion, including the likelihood of association, because the respective marks and the goods are similar. The applicant filed a counterstatement denying the grounds of opposition.

6. Given their dates of filing, the trade marks upon which the opponent relies qualify as earlier trade marks in accordance with section 6 of the Act.

7. The opponent is represented by Urquhart-Dykes & Lord LLP and the applicant is represented by ip4all. Both parties filed evidence which I will mention to the extent I consider appropriate. Both parties filed written submissions in lieu of a hearing. I make this decision after a careful reading of all the papers filed by the parties.

Evidence

Opponent's evidence

8. This consists of two witness statements.

The first statement is from Agnès Jaubert and is accompanied by four exhibits. Ms Jaubert states that she is the Secretary- General of Vinadeis, the parent company of the opponent company.

9. According to Ms Jaubert the opponent and entities acting under the opponent's authority have been selling wines under the marks MYTHIQUE, LA CUVÉE

MYTHIQUE and DUO MYTHIQUE to more than 130 countries worldwide including several EU countries.¹

10. Vinadeis' catalogues from the *website www.vinadeis.com* for the years 2016, 2017 and 2018 are provided as Exhibit AJ1. The following excerpt are from the first pages of the catalogues:

“The range of wines available from the Vinadeis winemakers represents the finest possible showcase from the south of France and includes real finds from the Languedoc-Roussillon region”. (2016)

“The range of wines available from the Vinadeis winemakers represents the finest possible showcase of French wines.” (2017/2018)

11. Several images of bottles of wine bearing the signs

The logo for 'Duo MYTHIQUE' features the word 'Duo' in a gold, cursive script font, with 'MYTHIQUE' in a bold, black, sans-serif font below it.The logo for 'MYTHIQUE LANGUEDOC' features the word 'MYTHIQUE' in a bold, black, serif font, with 'LANGUEDOC' in a smaller, orange, sans-serif font below it.

are seen throughout the catalogues.

12. According to Ms Jaubert, the terms “La cuvee”, “Languedoc” and “duo” appearing on the signs mean “wine which is the product of a vine”, “region or terroir from where the grapes for wine have been grown” and “blend of two grape varieties, respectively.

13. Ms Jaubert states that Exhibit AJ2 consists of “selected invoices” issued to the EU countries during the relevant period. Twenty-one invoices dated between March 2014 to August 2018 are provided in evidence. The invoices were issued under the names of U.C.C.O.A.R S.A.S and Vignerons de la Mediterranee S.A.S. (the opponent). The invoices identify the opponent’s goods by references to MYTHIQUE. Some of the invoices also contain references to LA CUVÉE MYTHIQUE.² The recipients have addresses in the UK (Bristol), France, Ireland, Austria and Belgium.

¹ See para 3.

² Ms Jaubert claims that “Rge Cuvee Mythique” referred in the invoice dated 15 June 2015 is for La Cuvee Mythique.

14. According to Ms Jaubert, MYTHIQUE products have won numerous awards as listed below:

- International Wine Challenge 2014 (awarded to La Cuvee Mythique rouge, 2012)
- International Wine Challenge 2014 (awarded to La Cuvee Mythique blanc, 2013)



- International Weinprämierung Zurich 2014 (awarded to)
- International Bronze Wine Winner Challenge 2016 awarded to Cuvee Mythique blanc, 2015)
- International Commended Wine Winner Challenge 2016 (awarded to Cuvee Mythique rouge, 2014)
- An award issued in 2016 certifying that La Cuvee Mythique Blanc has been chosen by the Top 100 Languedoc-Roussillon Sud de France judging panel.

15. Ms Jaubert claims that U.C.C.O.A.R S.A.S and Vignerons de la Mediterranee S.A.S are the subsidiaries of the parent company Vinadeis. Two documents are provided as Exhibit AJ4. The first one is an excerpt of the main entry in the Trade and Companies Register dated 21 December 2018. It identifies the opponent as a joint-stock company. However, it is not entirely clear to me from this document the relationship between the opponent and Vinadeis. The second document is an extract from the Main Register of Commerce and Societies. It identifies Vinadeis as the “president” of U.C.C.O.A.R.

16. The second witness statement is from Sharon Kirby. Ms Kirby claims that she is a UK and European qualified Trade Mark Attorney at Urquhart-Dykes & Lord LLP. The witness statement is accompanied by 9 Exhibits.

17. Exhibit SK1 consists of an extract from the UKIPO cross search general guidance on similarity of goods in class 32 and class 33.

18. Exhibit SK2 consists of several images of bottles of non-alcoholic and de-alcoholic wines bearing the signs ARIEL, OPIA, PIERRE. The images are from the websites www.arielvineyards.com, www.pierre-chavin.com and amazon.co.uk. There are also images of bottles of wines labelled as no alcohol/alcohol-free under the marks ARTIS and BONNE NOUVELLE, which Ms Kirby claims are produced by the opponent or their related company. The Exhibit is undated.

19. Exhibit SK3 consists of a print of an article titled "*There's money in moderation: the rise of alcohol-free drinks*" from the Financial Times. The article is dated 23 March 2018. Ms Kirby highlights the following excerpts from the article:

"On page 5 of 15, as printed, there is mention of a growing market for no and low-alcohol beers. Examples of recent product launches here include "Heineken 0.0, Budweiser Prohibition and Guinness Open Gate Pure Brew Lager". There is a quote from their (award-winning Dandelyan Cocktail Bar at the Mondrian Hotel in London) drinks menu's creator which reads "we don't segregate our non-alcoholic cocktails because we want people to feel like they're still ordering something adult, that they are taking part in that collective feeling of celebration"."

20. Exhibit SK4 consists of prints from Waitrose & Partners website showing both the alcohol and the alcohol-free version of Heineken beer for sale. The Exhibit also contains prints from the website www.birramoretti.com and www.oldmoutcider.co.uk showing both the alcohol and alcohol-free versions of BIRRA MORETTI beer and OLD MOUT CIDER, respectively.

21. Print of an article from the website www.thedrinksbusiness.com is provided as Exhibit SK5. It is dated 29 July 2019 and contains a list of "10 low and non-alcohol spirits brands to watch in 2019".

22. Exhibit SK6 consists of a print of an article titled "10 best alcohol-free and low alcohol wines for Dry January" from the online newspaper, The Independent. The article is dated 3 January 2019.

23. Exhibit SK7 consists of prints from the websites *echofallswine.co.uk* and *www.lindermans.com* showing alcoholic and non-alcoholic versions of Echo Falls and Lindermans wines.

24. A print of another article from the website *www.thedrinksbusiness.com* titled “Speedlip rolls out new non-alcoholic aperitifs” is provided as Exhibit SK9. It is dated 1 May 2019 and contains information about a range of aperitifs from Seedlip.

25. Exhibit SK9 is a print of an article from the website *www.livescience.com*. The article is titled “Breaking the Code: Why your Brain Can Read This”. It is dated February 2012 and provides an insight into how the brain reads words.

Applicant's evidence

26. This consists of a witness statement from Dr Roger Lowe. Mr Lowe states that he makes the statement on behalf of the applicant. I understand that Dr Lowe is the applicant's legal representative (t/a ip4all) as per the counterstatement and other correspondence on file. The witness statement contains a number of submissions.

27. Exhibit RDL1 consists of a trade mark search report issued by the UKIPO for the applied-for mark.

28. Several regulations applicable in the UK and the EU relating to wine trade are provided as Exhibit RDL2.

29. A copy of “Low Alcohol Descriptors Guidance” published on 13 December 2018 is provided as Exhibit RDL3. It contains the UK Government's definition of certain descriptors in relation to drinks. Mr Lowe has highlighted the definitions of the terms low alcohol, non-alcoholic, alcohol-free and de-alcoholised.

30. Exhibit RDL4 contains a copy of The Soft Drinks Industry Levy Regulations 2018. According to Mr Lowe all of the opposed goods in the application are deemed to be “soft drinks” under the terms of the regulation.

31. An article titled “Harmful Interactions – mixing alcohol with medicines” published by the National Institute on Alcohol Abuse and Alcoholism is provided as Exhibit RDL5. The revised version of the article was published in 2014 and contains a list of commonly used medicines that interact with alcohol.

32. Another article highlighting the increasing popularity and sales of low and non-alcoholic drinks in the UK is provided as Exhibit RDL6. It is titled “Rising trend: Low alcohol and alcohol free wine” and is dated 8 January 2020.

33. A copy of the Licensing (Conditions for Mixed Trading) Regulations (Northern Ireland) 1997 is provided as Exhibit RDL8. Mr Lowe highlights that the Schedule to these Regulations ensures separation of alcoholic beverages from other goods.

34. Exhibits RDL9 and RDL10 contain lists of several trade marks that contain either the word MYTHIQUE or stylised representation of an owl.

Proof of Use

35. The applicant submits:

“The only use of the Prior Rights has been in relation to wine, and nothing more, it is denied that any such use is sufficient in any event.”

36. Although the opponent has relied on two earlier marks, only its word mark had completed its protection process more than 5 years before the date of application of the contested mark. Therefore, pursuant to section 6A of the Act, only the word mark is subject to proof of use in relation to wine. The opponent can validly rely on all the goods it has identified under its figurative mark as that mark is not subject to the proof of use provisions.

37. The relevant statutory provisions are as follows:

“6A. Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) 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 relevant period.

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

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

(3) The use conditions are met if –

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

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

(4) For these purposes –

- (a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form of which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and
- (b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European 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 Union.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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.”

38. 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.”

39. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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 Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* 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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the

control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

- (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] and [22]. 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]; *Reber* at [29].
- (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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].
- (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] and [76]-[77]; *Leno* at [55].

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

40. As the earlier mark is an IR protected in the EUTM, the comments of the Court of Justice of the European Union (“CJEU”) in *Leno Merken BV v Hagelkruis Beheer BV*, Case C149/11, that applies to trade marks subject to proof of use in the EU are 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 13 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)”.

At paragraphs 57 and 58, 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.”

41. 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 multifactorial one which includes the geographical extent of the use."

42. The General Court ("GC") restated its interpretation of *Leno Marken* in Case T398/13, *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.

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

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

44. In *Awareness Limited v Plymouth City Council*,⁷ Mr Daniel Alexander Q.C. as the Appointed Person stated that:

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

Relevant period

45. Pursuant to section 6A of the Act, the relevant period for assessing whether there had been genuine use of the earlier mark is the 5-year period ending with the date of application of the contested mark, i.e. 17 March 2014 to 16 March 2019.

Form of the Mark

46. 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).

47. 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.”

48. 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.

49. Only Ms Jaubert’s witness statement and the accompanying Exhibits concerns evidence of use of the opponent’s mark MYTHIQUE. The evidence shows the use of the word MYTHIQUE in a slightly stylised form on bottles of wine. However, the stylisation is minor, and it does not alter the distinctive character of the word “MYTHIQUE”. The evidence also shows the use of the word “MYTHIQUE” in conjunction with other elements such as a stylised image of an owl and the words “LA CUVÉE, Duo and LANGUEDOC. Notwithstanding the presence of those elements, due to its size and presentation, the average consumer is likely to perceive MYTHIQUE as indicative of the origin of the product. As the use in conjunction with another sign falls within the ambit of genuine use, the opponent can also rely on the use of the mark as demonstrated.

Sufficient Use

50. The opponent has claimed use of its mark only in relation to wine. 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.³ Out of twenty-one invoices the opponent filed, four were issued in the name U.C.C.O.A.R S.A.S. and the rest in the name of the opponent company. Nineteen invoices also bear the name Vinadeis. The opponent also confirms that both U.C.C.O.A.R and the opponent are the subsidiaries of Vinadeis.

51. The opponent claims that MYTHIQUE branded products are currently exported to more than eleven EU countries. The invoices, however, demonstrate sales to only six EU countries, including the UK. Ms Jaubert's reference to the invoices as "selected invoices" indicates to me that those filed in evidence do not constitute the complete list of invoices issued during the relevant. In that regard, I bear in mind Ms Jaubert's following statement:

"Not only has there been use, but our sales are growing. For example, in 2016 our sales of the MYTHIQUE branded products in the EU were in excess of 4,200,000 Euros (approximately £3,444,000 at the average 2016 Euro Sterling exchange rate); whereas in 2018 they were in excess of 5,800,000 Euros (approximately £5,104,000 at the average 2018 Euro Sterling exchange rate).⁴

52. Although no supporting invoices or turnover figures were filed in evidence to substantiate this statement, in the absence of cross-examination, I accept Ms Jaubert's statement on the point. The volume of sales made during the relevant period shows a consistent increase, and it appears to be considerable. Invoices show the sales of products under the mark MYTHIQUE. The evidence also indicates a geographical spread of the use across the EU. Considering the evidence as a whole, I am satisfied that the use of the opponent's earlier mark is sufficient to create and maintain a market for wine in the EU over the relevant five-year period.

³ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

⁴ See witness statement, para 4.

Section 5(2)(b)

53. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Case law

54. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) The matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) The average consumer normally perceives the mark as a whole and does not

proceed to analyse its various details;

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings to mind the earlier mark, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing act

55. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which these goods are likely to be selected by the average consumer.

56. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

57. The goods at issue are alcoholic and non-alcoholic beverages. The average consumer of such goods will be the public at large, albeit insofar as alcoholic beverages are concerned, the average consumer will be over the age of 18. All of the goods may be sold through a range of channels, including retail premises such as supermarkets and off-licences (where the goods are normally displayed on shelves and are obtained by self-selection) and in public houses (where the goods are displayed on, for example, shelves behind the bar and where the trade marks will appear on dispensers at the bar etc.). When the goods are sold in, for example, public houses the selection process is likely to be an oral one. However, there is nothing to suggest that the goods are sold in such a manner as to preclude a visual inspection. In *Simonds Farsons Cisk pic v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-3/04, the Court of First Instance (now the General Court) said:

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant's

goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

58. While the goods may be ordered orally in public houses, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. The selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Although for the most part, the cost of the goods is likely to be relatively low. During the selection process, the average consumer is likely to ensure that they select the correct type, flavour, strength, etc., of beverage.

59. In its counterstatement, the applicant submits that the average consumer pays an average degree of attention during the selection process.⁵ However, in its final submissions, the applicant argues that the average consumer will pay a high degree of care and attention.⁶ Having already made such concession that the average consumer pays an average degree of attention, the applicant cannot resile from its position. Considering the various factors discussed in the foregoing paragraphs, the average consumer, in my view, is likely to pay a medium level (average degree) of attention to the selection of the goods at issue and not a high degree of care and attention.

Comparison of goods

60. When making the comparison, all relevant factors relating to the goods in the specification should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

⁵ Counter Statement dated 2 August 2019, page 17.

⁶ The Applicant’s Final Submissions dated 17 June 2020, page 10.

“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”.

61. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (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.

62. 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”.

63. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market* (Trade Marks and Designs) (OHIM), Case T-325/06, the General Court (“GC”) stated that ‘complementary’ means:

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

64. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

65. In *Gérard Meric v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* case T-133/05, the General Court (“GC”) stated:

“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 the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 *Vedial v OHIM – France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

66. I also bear in mind the comments of Daniel Alexander Q.C., sitting as the Appointed Person, in *Sandra Amelia Mary Elliot v LRC Holdings Limited*, BL O/255/13, where he warned against applying too rigid a test when considering complementarity:

“20. In my judgment, the reference to “legal definition” suggests almost that the guidance in Boston is providing an alternative quasi-statutory approach to evaluating similarity, which I do not consider to be warranted. It is undoubtedly right to stress the importance of the fact that customers may think that responsibility for the goods lies with the same undertaking. However, it is neither necessary nor sufficient for a finding of similarity that the goods in

question must be used together or that they are sold together. I therefore think that in this respect, the Hearing Officer was taking too rigid an approach to Boston”.

67. Although the opponent has cited the UKIPO and the EUIPO decisions⁷ concerning the comparison of goods in classes 32 and 33, they are neither binding nor persuasive. The opponent also relies on the UKIPO cross search list⁸ to argue on the point of similarity. As the cross-search list is merely a guide to be used during the examinations process, the search results are not determinative on the issue of similarity between the competing goods.⁹

68. The applicant has raised various concerns about the wording of the opponent’s figurative mark’s specification. I will address those concerns to the extent I consider is necessary. The applicant submits:

“The Nice Classification includes Explanatory Notes to all Classes of goods and services, and the Notes to Class 33 states as follows:

Class 33 includes mainly alcoholic beverages, essences and extracts. The inclusion of the word “mainly” indicates that not all of the beverages found in Class 33 are of an alcoholic nature. The wording used by the opponent is rather strange, and the applicant would invite the tribunal to determine that the effect of the wording “and other alcoholic beverages is so as to limit the Goods covered by Prior Right 2 to alcoholic beverages.”¹⁰

69. The General Court in *The Coca-Cola Company v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, (Mezzopane) T-175/06, considered whether the goods covered under class 33 include both alcoholic and non-alcoholic beverages. The court stated:

⁷ See the opponent’s further submissions dated 7 October 2019, page 7.

⁸ See Exhibit SK1

⁹ See *Proctor & Gamble Company v Simon Grogan*, O-176-08, paras 32 – 34.

¹⁰ See the applicant’s submissions dated 17 June 2020 paras 24,25.

“74. However, according to the clear and unambiguous wording of Class 33, that class includes all alcoholic beverages with the sole exception of beers. Consequently, the mere fact that, in Class 32, the words ‘non-alcoholic’ do not refer expressly to ‘fruit drinks and fruit juices’ and ‘syrops and other preparations for making beverages’ has no bearing on the question whether or not that class could contain alcoholic products other than beer. Not only does the wording of Class 33 leave no scope for interpreting it other than as including all alcoholic beverages except for beers but, in addition, the explanatory notes to Classes 32 and 33 support the interpretation that Class 33 includes all alcoholic beverages except beers. According to the explanatory note to Class 33, as soon as an alcoholic beverage is ‘de-alcoholised’, it is taken out of Class 33 and is included in Class 32. The explanatory note to Class 32 confirms that by stating that it includes ‘de-alcoholised’ drinks.”

70. It is clear from the GC’s decision that class 33 includes only alcoholic beverages except beers. I, therefore, proceed on that basis.

71. I will first compare the term ‘wine’ covered by the opponent’s word mark with all of the contested goods.

Dealcoholized wines; Non-alcoholic wines

72. The applicant states:

“As ‘wine’ is normally not served accompanied with ‘non-alcoholic beverages’, these goods are not complementary.

Furthermore, alcoholic beverages such as ‘wine’ and ‘non-alcoholic beverages’ are not in competition with each other. Their differences in taste and the preference or absence of alcohol have the result, in general, that, an average consumer seeking to buy alcoholic beverages covered by the mark applied for, but will buy the beverages of his or her own choosing.

As indicated by the Court in the ‘Mezzopane’ judgment (18/06/2008. T-175/06, Mezzopane, EU: T:2008:212), non-alcoholic beverages are not beverages that are interchangeable with the alcoholic beverages covered by the earlier mark. s. Finally, in both the ‘Mezzopane’ and ‘Lindenhof’ (15/02/2005; T-296/02, Lindenhof, EU: T:2005:49) judgments it has been stated that the average consumer consider it normal and, therefore, will expect wines, on the one hand, and non-alcoholic drinks on the other, to come from different companies. They will not consider those drinks as items in a general range of drinks likely to have a common commercial origin and will not expect those drinks to have the same commercial origin.”¹¹

73. In respect of end-users and method of use, the applicant contends:

“The consumption of wine does not rule out the consumption of non-alcoholic beverages and vice versa, but the consumption of one of those beverages does not necessarily lead to the consumption of the other. Moreover, wine is generally intended to be savoured and is not designed to quench thirst, whereas the non-alcoholic beverages covered by the contested mark are generally intended to quench thirst.”¹²

74. For its part, the opponent submits:

“The opponent also believes that there have been many changes in the drinks market most notably in recent years following the trends for healthy living and “clean” eating and drinking, the Veganism movement and similar. The opponent contends that in keeping with current lifestyle choices, now more than ever that link between certain types of goods in Classes 32 and 33 is increasingly close.”¹³

75. The opponent further submits:

¹¹ See Counter Statement, page 8.

¹² See Counter Statement, page 6.

¹³ See the opponent’s Further Submissions, page 4.

“In going on to consider certain authorities cited in the TM8 and accompanying statement, the Opponent notes that the Mezzopane case (T175/06) is not over 10 years old. Many commentators at the time were not in agreement with the findings of that case, and there are numerous cases which find alcoholic beverages under Class 33, and non-alcoholic beverages under Class 32 to be at minimum of low similarity, and depending on the nature and circumstances, in certain scenarios to find a moderate to higher similarity.

...

The opponent believes that the goods opposed are similar to those protected in their combined prior rights and so should be refused. Further, they believe it is obvious any de-alcoholised equivalent of an alcoholic drink protected in their prior rights should be found to be similar. They object to several broad terms which attempt to allow protection for this subset of “dealcoholized wines” and “non-alcoholic wines”, and “non-alcoholic aperitifs” (They ask that consideration be given throughout also to low-alcohol wines, which may fall under the remit of class 32). They also object to the inclusion of broad terms which may include as components of dealcoholized wines or non-alcoholic equivalent (which could then, for example be presented in a can of pre-mixed cocktail).¹⁴

76. The applicant largely relies on the judgement in Mezzopane to support its arguments on dissimilarity between its goods and the opponent’s wine. The applicant also cites in support of its position the judgements in FLÜGEL¹⁵ and “Lindenhof”¹⁶. I remind myself that class 32 goods that were in conflict with wine in Mezzopanne were mineral, aerated waters and other non-alcoholic drinks, syrups and other preparations for making beverages and mixed lemonade-based drinks. As the GC’s findings were made in relation to a separate category of goods in class 32, those findings cannot be transposed to the goods at issue in the current proceedings, namely, non-alcoholic and de-alcoholised wine, on the one hand and wines, on the other. For similar reasons, I also do not consider that FLÜGEL and Lindenhof findings should be applied *mutatis mutandis*.

¹⁴ See the opponent’s Further Submissions, page 6-8.

¹⁵ T-150/17

¹⁶ T-296/02

77. The applicant submits that the nature of the competing goods is different, at least in terms of ingredients as the opposed goods are produced by the addition of flavoured plant extracts to water.¹⁷ In the ordinary and natural meaning, de-alcoholised and non-alcoholic wines covered by the applicant's specification are wines that have had the alcohol removed through a process. In my view, the applicant's goods share a degree of similarity in nature with the opponent's wine. This is because they are both wines, even though one has an absence of alcohol. They share the method of use. Even while taking account of the applicant's submission that the competing goods are placed in different shelves and are clearly separated, I am aware from my own experience that non-alcoholic wines are likely to be sold alongside or in shelves in close proximity with wines in supermarkets or other outlets selling drinks.

78. I also bear in mind that it is not uncommon for the same producer to produce both alcohol and non-alcoholic/de-alcoholised wines. An overlap in the manufacturing process of the competing goods is another factor that is likely to lead the average consumer to think that both the wines and its non-alcoholic equivalents are produced by the same undertaking. I also think that the competing goods will be consumed for its taste and pleasure. To that extent, I find that the goods share the intended purpose. The goods may be in competition as the average consumer may prefer non-alcoholic/de-alcoholised equivalents instead of wine or vice versa for various reasons, for example, lifestyle choices. I agree with the applicant that the goods are not complementary. However, taking account of all the other factors, this distinction is insufficient to lessen the extent of the degree of similarity between the competing goods. I find that the competing goods are similar to a high degree.

Alcohol free beverages; Beverages (Non-alcoholic); Non-alcoholic beverages; De-alcoholised drinks; non-alcoholic drinks

79. The applicant submits:

“At paragraph 12 of the Statement of Grounds, the Opponent attempts to further particularise their position, but the Applicant is unable to understand what if any

¹⁷ See witness statement of Dr Roger Lowe.

the assistance paragraph 12 provides. In any event, any sub-set of De-alcoholised drinks; non-alcoholic beverages; and alcohol-free beverages, would all be without alcohol, they would only be listed in class 32, and therefore be dissimilar.”¹⁸

80. Merely because the competing goods appear in different classes does not automatically result in a finding of dissimilarity. In this regard, I also bear in mind the decision of the GC in *Sofia Golam v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*¹⁹ which refers to *P.P. TV - Publicidade de Portugal e Televisão, SA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*²⁰, and states:

"35. That finding is not altered by the fact that the latter services appear on the alphabetical list for Class 41. The likelihood of confusion between services covered by different marks does not depend on the classification of those services under the Nice Agreement, but rather on the similarity between those services. In that regard, Rule 2(4) of Commission Regulation (EC) No 2868/95 of 13 December 1995 implementing Regulation No 40/94 (OJ 1995 L 303, p. 1) provides, moreover, that the classification of goods or services is to serve exclusively administrative purposes, so that goods or services may not be regarded as similar on the ground that they appear in the same class under the Nice Classification, and goods or services may not be regarded as dissimilar on the ground that they appear in different classes."

81. The applicant further contends that all of the opposed goods are deemed to be “soft drinks”.²¹ It does not appear to me that the applicant’s terms designate only a particular category of products, namely, soft drinks.²² The notional and fair use of the terms in the specification allows the applicant to use the mark across a range of goods that can be encompassed within those broad terms, and the terms are apt to cover

¹⁸ See Counter Statement, page 8.

¹⁹ T-486/12

²⁰ T-118/07

²¹ The applicant refers to The Soft Drinks Industry Levy Regulations 2018 (Exhibit RDL4).

²² According to Collins English Dictionary, A soft drink is a cold, non-alcoholic drink such as lemonade or fruit juice, or a fizzy drink. See <https://www.collinsdictionary.com/dictionary/english/soft-drink> [accessed 1 September 2020]

alcohol-free wines, non-alcoholic wines, de-alcoholised wines. I, therefore, consider that the same reasoning addressed at paragraphs 77 and 78 apply to these goods. Although I have not considered the similarity between alcohol-free wine and wine in the preceding paragraphs, I find no reason why similar considerations should not apply to alcohol-free wines as well. The applicant's goods are similar to the opponent's goods to a high degree.

Non-alcoholic aperitif

82. The opponent submits:

“Aperitifs have been found on some definitions to include wines, but otherwise to be similar to wines, and at least to include a sub-set, wine spritzers.”²³

83. *Collins English Dictionary* defines aperitif as an alcoholic drink, especially a wine, drunk before a meal to whet the appetite.²⁴ That bears out my understanding that wines are also served as aperitifs. As I understand it, the term “non-alcoholic aperitif” refers to beverages that do not contain alcohol and are taken before a meal to stimulate the appetite. I see no reason why the term would not include non-alcoholic wines. Certainly, there is no evidence before me that this would not be the case. Therefore, similar considerations addressed at paragraphs 77 and 78 apply. The applicant's goods are similar to the opponent's wine to a high degree.

Non-alcoholic cocktails, non-alcoholic fruit cocktails; non-alcoholic cocktail mixes

84. The opponent submits:

“The reasoning here is these remaining terms, such as “non-alcoholic cocktail mixes; non-alcoholic cocktails; non-alcoholic fruit cocktails” may well include de-alcoholised or non-alcoholic wines, low alcohol wines, or otherwise have a

²³ See Further Submissions page 4.

²⁴ See <https://www.collinsdictionary.com/dictionary/english/aperitif> [accessed 1 September 2020].

close association with the same given the association which would likely to be found in respect of their alcoholic equivalents.”²⁵

85. The applicant’s goods are mixed drinks often made with various ingredients such as juice and/or herbs but do not contain any alcohol while the opponent’s goods are wines. Even where non-alcoholic or de-alcoholised wines are used as ingredients in preparing non-alcoholic cocktails, the end-products are sold to the customers in a pre-mixed form. The average consumer is unlikely to think that neither the ingredients used in preparing the applicant’s goods nor the alcoholic versions of those ingredients come from the same undertaking. Of course, there is no evidence before me to the contrary. The nature of the opponent’s wine is different to the applicant’s goods due to the presence and absence of alcohol. The users and method of use will overlap. The competing goods will share channels of trade. The competing goods are not complementary, nor do they compete. Considering these factors, I find that the applicant’s goods are similar to the opponent’s goods to a low degree.

Non-alcoholic cider

86. Although both are drinks, the applicant’s goods are made from apple while the opponent’s goods are made from grapes. They also differ in the presence or absence of alcohol. The nature of the competing goods is, therefore, different. The users and method of use will overlap. The goods will share channels of trade. However, the goods are neither complementary nor in competition. Considering these factors, I find that the applicant’s goods are similar to the opponent’s goods to a low degree.

Non-alcoholic liquors

87. The applicant’s goods are non-alcoholic versions of liquors²⁶ such as whisky, vodka or gin. They differ from wine in terms of the ingredients and the presence or absence of alcohol. The nature and purpose of the competing goods are different. The

²⁵ See Further Submissions page 4.

²⁶ According to Collins English Dictionary liquors²⁶ are strong alcoholic drinks such as whisky, vodka or gin. See <https://www.collinsdictionary.com/dictionary/english/liquor> [accessed 1 September 2020].

users and the method of use will overlap. The goods will share channels of trade. The goods, however, do not compete, nor they are complementary in the sense described by the case-law. Considering these factors, I find that the applicant's goods are similar to the opponent's goods to a low degree.

Goods covered by the opponent's figurative mark

88. The opponent's figurative mark has a broader specification than its word mark and also contains the identical term wine. I have already concluded that the applicant's dealcoholized wines; non-alcoholic wines; alcohol free beverages; beverages (non-alcoholic); non-alcoholic beverages; de-alcoholised drinks; non-alcoholic drinks and non-alcoholic aperitif are similar to the opponent's wine to a high degree. Although I have found that the applicant's remaining goods are similar to the opponent's wine to a low degree, those goods are similar to the term "other alcoholic beverages" covered by the figurative mark to a high degree due to the following reasons:

Non-alcoholic cocktails, non-alcoholic fruit cocktails; non-alcoholic cocktail mixes; Non-alcoholic cider; Non-alcoholic liquors; Non-alcoholic aperitif

89. The phrase "other alcoholic beverages" in the opponent's specification is broad enough to encompass cocktails, cider, liquors and aperitif. The applicant's goods are therefore non-alcoholic equivalents of the opponent's goods. There is an overlap in the users and the method of use. The competing goods share the intended purpose as both goods may be consumed for their taste. The goods are sold in close proximity in supermarkets and other selling outlets. Given that the applicant's goods are non-alcoholic versions of the opponent's goods, the average consumer may choose, for example, for health reasons or lifestyle choices, the applicant's goods instead of the opponent's goods or vice versa. Although goods are not complementary, taking into account all other factors, I find that the respective goods are similar to a high degree.

Distinctiveness of the earlier marks

90. The distinctive character of the earlier mark must be considered. The more distinctive the mark is, either inherently or through use, the greater the likelihood of

confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

91. Invented words usually have the highest degree of distinctive character, while words which are allusive of the goods have the lowest. Distinctiveness can also be enhanced through the use of the mark.

92. The applicant submits:

“In the absence of any evidence to the contrary (the Applicant reserves the right to make further submissions following the evidence round), there are only the inherent characteristics of the two Prior Marks to consider, and in the Applicant’s submission, the dominant component of both of which is the word MYTHIQUE.

The word MYTHIQUE has no known meaning in the English language, and in the Applicant's submissions it is neither descriptive of nor nondistinctive for wine, i.e. the goods upon which the Opponent relies. As a consequence, in the Applicant's submission, they are trade marks possesses of only low to average degree of inherent distinctive character."²⁷

93. The applicant also submits:

"As Exhibit RDL9 indicates the word MYTHIQUE has been incorporated into a large number of trade marks registered in a variety of classes, with different owners. The use of a stylised representation of an owl, is not distinctive of the Opponent either, as Exhibit RDL10 shows its use in 68 marks in Class 33 which cover the UK."²⁸

94. In *Zero Industry Srl v OHIM*, Case T-400/06, the General Court 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)."

²⁷ See counter statement, paras. 37, 38.

²⁸ See witness statement of Dr. Roger Lowe, page 11.

95. The evidence the applicant has filed does not show that any of those marks are currently being used in the market place. Therefore, what impact they have made on the distinctiveness of the earlier marks is not known. As the evidence does not establish that the distinctiveness of the earlier marks has been weakened by its frequent use, I will base my assessment on the inherent characteristics of the earlier marks.

96. I will first consider the position in relation to the opponent's word mark. In my view, a potentially significant portion of the average consumers is likely to recognise the word "MYTH" in the opponent's mark and may think that the mark is a made-up word created from that word. However, neither the word "MYTH", nor the word "MYTHIQUE" as a whole is allusive or suggestive of the goods at issue. The mark, therefore, possesses a high degree of distinctive character and not a low to average degree of inherent distinctive character as argued by the Applicant. Although the evidence filed by the opponent demonstrates the use of the mark, the opponent has not claimed enhanced distinctiveness of its mark. In any event, the evidence is insufficient to establish the acquired distinctiveness of the mark in relation to wines. Moreover, there is no information regarding the market share held, the intensity of use or third-party evidence of recognition. Taking the evidence into account, I am unable to conclude that the distinctiveness of the earlier mark has been enhanced through its use.

97. In addition to the word "MYTHIQUE", the opponent's figurative mark consists of other elements such as the word "LA CUVEE" and a figurative representation of an owl. It is a general rule that where a mark consists of word and figurative elements, the word element of the mark is, in principle, more distinctive than the figurative element, because the average consumer will more readily refer to the goods in question by citing their name than by describing the figurative element.²⁹ It follows from my findings noted at paragraph 96, "MYTHIQUE" is highly distinctive. Although "LA CUVEE" is also likely to be seen as an invented word, it is presented above the word "MYTHIQUE" in a much smaller font. Given its size and presentation, in my view, it is the word "MYTHIQUE" that gives the earlier mark its high degree of distinctiveness overall.

²⁹ ²⁹ See *Massive Bionics, SL v EUIPO*, Case T223/16, paragraph 62.

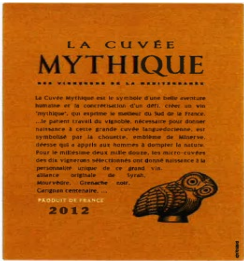
Comparison of marks

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

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

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

100. The trade marks to be compared are as follows:

Opponent's trade marks	Applicant's trade mark
<p style="text-align: center;">MYTHIQUE</p> 	<p style="text-align: center;">IAYTH</p>

101. The opponent's word mark is comprised of the word " MYTHIQUE" presented in capital letters without any stylisation. I have already concluded that the word "MYTHIQUE" possesses a high degree of distinctive character. The overall impression of the mark also lies in the word "MYTHIQUE".

102. The applicant submits:

"The Applicant's Mark comprises of a four-character combination in which those characters stylistically represents the letters "M" "Y" "T" and "H" or a sufficient part of those letters as understood in English which together identify the word "MYTH", in a style which seeks to convey a misrepresentation or partial representation of the true form of the letters. Due to the stylistic representation of the true form of the Applicant's Mark, it is in the submission of the Applicant highly distinctive, as the partial expression of the letters will cause the consumer to pay and maintain its attention for a longer period of time than the letters in the plain script i.e. without the stylisation."³⁰

103. For its part, the opponent submits:

"Whilst the word MYTH is stylised here, characters comprising the word can be clearly seen; the characters would be understood as M-Y-T-H and so would be viewed as "MYTH" albeit in a particular "minimalist" sans serif typeface. Hence, whilst the stylisation of the letters is in a typeface with omitted parts, the omitted elements would be filled-in in understanding of the consumer, and the word is clearly seen, hence the combination would be pronounced as the word "MYTH".³¹

104. The applicant's mark is comprised of a stylised representation of the letters "M,Y,T,H". The presentation of the letters with omitted parts, in my view, is not a negligible feature of the mark, and it makes a contribution to the overall impression of the mark. The average consumer will readily identify the word "MYTH" in the

³⁰ See Counter Statement page 12.

³¹ Statement of Grounds, page 2

applicant's mark and is likely to attach more weight to the impact of the verbal element than its stylisation. Therefore, the overall impression of the mark is dominated by the word "MYTH". The stylization plays a lesser role.

105. Concerning the visual comparison, the applicant submits:

"The only point of possible visual similarity between the competing trade marks is in respect of the letters "MYTH", which comprise the first four letters of the opponent's Prior Mark 1 and whole of the applicant's mark albeit the applicant's mark is in a very stylised form".³²

106. The competing marks coincide in the presence of the word "MYTH" which is the only element in the applicant's mark and constitutes the first four letters in the opponent's mark. The words are presented in capital letters in both marks, although the applicant's mark is presented in a stylised form. It is a general rule that the average consumer fixes their attention more readily on the first part of the mark. Bearing in mind my assessment of the overall impression of the marks, the average consumer is likely to notice the presence of the word "MYTH" common to two marks. In terms of differences, there are additional letters in the opponent's mark, and the applicant's mark is presented in a stylised form. Considering these factors, I find that the competing marks are visually similar to a medium degree.

107. On aural similarity, the applicant submits:

"It may be that consumers who are more familiar with French may pronounce MYTHIQUE as MYTH-EEK. In the Applicant's submission it is likely, that the UK consumer will pronounce MYTHIQUE as MYTHIK."³³

108. The opponent's mark will be pronounced as a two-syllable word. The competing marks coincide in the pronunciation of the word "MYTH" (the applicant concedes that its mark will be perceived and pronounced as that word³⁴) which is the only syllable in

³² See Counter Statement page 12.

³³ Final Submissions page 12.

³⁴ See Counterstatement, paragraphs 24 -25.

the applicant's mark. I agree with the applicant that some consumers who are familiar with the French word "MYTHIQUE" will pronounce the second syllable as "EEK". However, it does not appear to me, nor there is evidence before me that "MYTHIQUE" is a French word commonly known among the average UK consumer. In my view, the average UK consumer is likely to pronounce the second syllable as "IK". In any event, this second syllable, irrespective of the way it is pronounced, does not have a counterpart in the applicant's mark. Considering the similarities and differences, I find that the marks are aurally similar to a medium degree.

109. Turning to the conceptual similarity, "MYTH" in the applicant's mark can have more than one meaning; some of those are:

"A myth is a well-known story which was made up in the past to explain natural events or to justify religious beliefs or social customs, or a person or thing whose existence is fictional or unproven".³⁵

110. The opponent submits:

"Basic French is reasonably well-known in the UK. Whilst an average consumer may not understand the exact meaning of "MYTHIQUE", it would be expected that a consumer would most likely understand MYTHIQUE to be French form of the word "myth", "mythical" or similar. Otherwise, they may consider that MYTHIQUE is simply an extension and form of the word derived from the word "MYTH" itself. Or, seen from the other view, MYTH is simply an abbreviation or root of the word "mythique", "mythic" or "mythical"."³⁶

111. I bear in mind that for a conceptual meaning to be relevant, it must be one capable of immediate grasp.³⁷ While I accept that UK consumers are likely to have an appreciation for some of the common words in French, as I mentioned earlier, it does not seem to me that the average consumer is likely to know that "MYTHIQUE" is the French form of the word myth. Certainly, there is no evidence before me to that effect.

³⁵ See <https://www.collinsdictionary.com/dictionary/english/myth> [accessed 11 August 2020].

³⁶ Statement of Grounds, page 3.

³⁷ See Case C-361/04 P *Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

In my view, the average consumers are more likely to see the word “MYTHIQUE” as an invented word. That is not to say, however, that it is devoid of any conceptual meaning. Although a mark will be perceived as a whole, the average consumer may break it down into verbal elements which suggest a concrete meaning to them.³⁸ When faced with the opponent’s mark, I would expect a significant portion of average consumers to recognise the word “MYTH” in it, both visually and aurally. The second element “IQUE” is meaningless. Given that “MYTH” is the only word in its own right that is present in the opponent’s mark, the average consumer is likely to, when viewing the mark as a whole, see it an invented word created from the word “MYTH” and construe it accordingly. Noting that “MYTH” is the only concept present in the applicant’s mark, whatever meaning is attributable to it is likely to be the same in both the marks. I find that the marks are conceptually similar to a reasonably high degree.

The opponent’s Figurative Mark

112. The opponent's Figurative Mark consists of a number of elements. The mark has the appearance of a label. The words "LA CUVÉE" appears at the top of the mark and beneath it, in a much bigger font, appears the word "MYTHIQUE". The words are presented in a slightly stylised font in capital letters. A dotted line separates "LA CUVÉE" and "MYTHIQUE" from rest of the elements in the mark. Text placed at the centre of the mark is barely legible. The date "2012" appears beneath the text. The mark also contains a stylised image of an owl at the right-hand side bottom corner. A rectangle in portrait orientation in orange forms the background for all the elements described above. The opponent has disclaimed the word elements "LES VIGNERONS DE LA MEDITERRANEE" and the text placed in the centre of the trademark.

113. I have already concluded that the word “MYTHIQUE” possesses a high degree of distinctive character. Given its size and position, I consider that it is the word “MYTHIQUE” that dominates the overall impression of the mark. I note the applicant also accepts that the dominant component of the mark is the word “MYTHIQUE”.³⁹ The figurative representation of an owl does contribute to the overall impression of the mark, but a lesser role. A weaker role is played by the word “LA CUVÉE” which

³⁸ See *Usinor SA v OHIM*, Case T-189/05, paragraphs 62 – 68.

³⁹ See the applicant’s final submissions dated 17 June 2020, para 69.

appears above the word “MYTHIQUE” in a much smaller font. The remaining elements including the coloured rectangle background will make only a limited contribution to the overall impression conveyed.

114. Visually both marks coincide in the presence of the word “MYTH” which is the only element in the applicant’s mark. In terms of differences, the opponent’s mark contains a number of additional elements including the letters “I,Q,U,E” that appear at the end of the word “MYTH”, “LA CUVÉE”, an image of an owl none of which have counterparts in the applicant’s mark. The applicant’s mark is presented in a stylized font; however, the stylizations of the word elements are negligible in the opponent’s mark. The opponent’s mark also has background elements which are absent in the applicant’s mark. Considering the similarities and differences, and my assessment of the overall impression of the marks, I find that the visual similarity between the competing marks is between low and medium.

115. The device element in the opponent’s mark will not be expressed aurally. The elements that the average consumer is likely to pronounce in the opponent’s mark are “LA CUVÉE and MYTHIQUE” or merely “MYTHIQUE”. Due to its size and positioning, in my view, the significant portion of the average consumers are likely to refer to the opponent’s mark as “MYTHIQUE”. In those circumstances, my finding in paragraph 108 applies and the marks are aurally similar to a medium degree. Where the average consumer pronounces “LA CUVÉE”, I find that the marks are aurally similar to a fairly low degree.

116. Turning to the conceptual similarity, “LA CUVÉE” in the opponent’s mark is unlikely to convey any meaning for the average consumer. With regard to the word “MYTHIQUE” similar considerations discussed at paragraph 111 applies. The device element of an owl introduces a second conceptual impression in the opponent’s mark which does not have a counterpart in the applicant’s mark. As mentioned earlier, the word “MYTH” has more than one meaning and whatever meaning is attributable to it is likely to be the same in both the marks. Considering these factors, I find that the competing marks are conceptually similar to a medium degree.

Likelihood of confusion

117. Although the applicant argues that the highly regulated wine trade and labelling restrictions cannot lead to a likelihood of confusion between wine and the applicant's goods,⁴⁰ the likelihood of confusion must be assessed from the perspective of the average consumer who is unlikely to be aware of the various trade and labelling legislation/restrictions referred to in the applicant's evidence. I need to bear in mind several factors in determining whether there is a likelihood of confusion. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (Canon at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade marks, as the more distinctive those trade marks are, the greater the likelihood of confusion (Sabel at [24]). I must also keep in mind the average consumer for the goods at issue, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them he has retained in his mind (Lloyd Schuhfabrik at [26]).

86. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods/services down to the responsible undertaking being the same or related).

118. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained that:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the

⁴⁰ See witness statement of Dr Lowe. The applicant highlights various provisions of EU regulation No.1308/2013, The Licensing Act 2003 and the Licensing Regulation 1997.

later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark".

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

119. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

120. I will first consider the position in relation to the opponent's word mark. In my view, the additional letters in the opponent's mark and the stylisation of the word

element in the applicant's mark are sufficient to avoid direct confusion. That leaves only indirect confusion to be considered.

121. The applicant submits:

"In this case the Applicant struggles to see how the Applicant's Mark and the Prior Mark 1/Mark 2 are capable of falling within any of the 3 classes identified by Mr Purvis QC as the stylisation of the Applicant's Mark would prevent the average consumer of the Goods in the UK to conclude that they belong to the same or economically linked undertakings."⁴¹

122. I have found that the opponent's goods (wines) are similar to the applicant's goods to varying degrees. I have also found that the goods will be selected with a medium degree of attention. The marks are visually and aurally similar to a medium degree and conceptually similar to a high degree.

123. Applying the conclusions, I am satisfied that the degree of similarity between the marks as wholes, that results from the presence of the common element "MYTH" which is at the beginning of the opponent's mark and is the only element of the applied-for mark will result in a likelihood of indirect confusion. Bearing in mind, in particular, the high degree of conceptual similarity between the marks and the high degree of distinctiveness of the earlier mark, the average consumer is likely to think that the competing marks are used by the same or economically linked undertakings to offer alcoholic beverages and its non-alcoholic/de-alcoholised equivalents, respectively. Confusion is still likely even where the competing goods are similar only to a low degree. Accordingly, I find that there is a likelihood of indirect confusion with respect to all the goods covered by the application.

124. Concerning the opponent's figurative mark, the non-coinciding elements in the competing marks are sufficiently prominent to avoid direct confusion.

⁴¹ See Final Submissions page 17 and 23.

125. I have found that the goods in the applied-for mark are similar to the opponent's goods (either wines or other alcoholic beverages) to a high degree. The goods will be selected with a medium degree of attention. I also found that the visual similarity between the marks is between low and medium, the marks are aurally similar to a fairly low or medium degree depending on how the average consumer articulates the opponent's mark and the marks are conceptually similar to a medium degree.

126. In *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*,⁴² Kitchin L.J. considered the relationship between the average consumer and the likelihood of confusion. He concluded that:

“if, having regard to the perceptions and expectations of the average consumer, the court concludes that a significant portion of the relevant public is likely to be confused such as to warrant the intervention of the court, then it may properly find infringement.”

Although this was in the context of infringement, the same approach is appropriate under s.5(2).⁴³

127. I have found that a significant portion of consumers will only articulate the word “MYHIQUE” in the opponent's mark and that this word plays a dominant role in that mark. Accordingly, the points of differences between the competing marks, in my view, are insufficient to dispel the impact of visual, aural and conceptual similarity between the marks as wholes, that results from the presence of the common element “MYTH”. Given the high degree of distinctiveness of ‘MYTHIQUE’ as a whole, the average consumer, when faced with highly similar goods, are likely to think that the goods come from the same or economically linked undertakings. There is a likelihood of indirect confusion.

⁴² [2016] EWCA Civ 41, at paragraph 349(v)

⁴³ See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 498 (Ch), Mann J.

Conclusion

128. The opposition has succeeded in full. The application will be refused for the opposed goods, namely:

Alcohol free beverages; Beverages (Non-alcoholic); Non-alcoholic aperitifs; Non-alcoholic cider; De-alcoholised wines; De-alcoholised drinks; Non-alcoholic beverages; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic drinks; Non-alcoholic fruit cocktails; Non-alcoholic drinks; Non-alcoholic wines; Non-alcoholic liquors.

129. As this is a partial opposition, the application will proceed to registration for the remaining goods, namely:

Milk of Almonds beverage; Aloe juice beverages; non-alcoholic aloe vera drinks; Aloe vera juices; Apple juice beverages; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages enriched with added minerals [not for medical purposes]; Beverages enriched with added trace elements [not for medical purposes]; Beverages enriched with added vitamins [not for medical purposes]; Preparations for making beverages; Carbonated non-alcoholic drinks; Coconut water as beverage; Coffee-flavoured soft drinks; Energy drinks [not for medical purposes]; Extracts for making beverages; Fruit beverages and fruit juices; non-alcoholic fruit extracts; Glacial water; Guarana drinks; Guava juice; Non-alcoholic beverages containing fruit juices; Non-alcoholic beverages containing vegetable juices; Non-alcoholic beverages with tea flavour; Non-alcoholic flavoured carbonated beverages; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts used in the preparation of beverages; Pomegranate juice; Powders for the preparation of beverages; Quinine water; Vegetable juice; Vegetable juices [beverage]; non-alcoholic beers; mineral and aerated waters; syrups and other preparations for making beverages; shandy; Non-alcoholic beverages containing seaweed; Non-alcoholic beverages containing fungi; Non-alcoholic beverages containing herbs; Non-alcoholic beverages containing honey; Non-alcoholic beverages containing nuts; Non-alcoholic beverages containing chocolate; Non-alcoholic beverages containing flavouring.

Costs

130. The opponent has been successful and is entitled to an award of costs. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I note the opponent filed evidence in these proceedings as well as written submissions in lieu of a hearing. I award costs to the opponent on the following basis:

Official fee:	£100
Preparing the notice of opposition and considering the counterstatement:	£200
Preparing and filing evidence:	£500
Preparing written submissions:	£300
Total:	£1,100

131. I order Goat Drinks Ltd to pay Vignerons de la Mediterranee the sum of **£1,100**. This sum is to be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 10th day of September 2020

Karol Thomas
For the Registrar
The Comptroller-General