

**O/568/20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003398807**

**BY JEFFREY JOSHUA LAWRENCE**

**TO REGISTER:**

**Tiger Cider**

**AS A TRADE MARK IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 417796 BY**

**HEINEKEN ASIA PACIFIC PTE LTD**

## BACKGROUND AND PLEADINGS

1. On 13 May 2019, Jeffrey Joshua Lawrence (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 33: Alcoholic Beverages.

2. The applicant’s mark was published for opposition purposes on 2 August 2019. The applicant’s mark was opposed on 24 September 2019 by Heineken Asia Pacific PTE Ltd (“the opponent”). The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following marks:

TIGER

UK registration no. 2240911

Filing date 28 July 2000; registration date 23 November 2001

Relying on all goods namely:

Class 32: Lager and goods in the nature of lager.  
 (“the opponent’s first mark”);

# TIGER

International registration no. 880266

International registration date 5 December 2005

Date protection granted in UK 10 February 2008

Relying on all goods namely:

Class 21: Drinking glasses; mugs, not of precious metal; bottles; jugs, not of precious metal; jugs made of glass; glassware for household use; ice buckets (other than of precious metal); serving trays (other than of precious metal); menu card holders; coasters, not of paper and other than table linen; not including vacuum flasks, and thermally insulated containers for food; vacuum bottles and vacuum insulated containers.

Class 32: Lager and goods in the nature of lager.  
("the opponent's second mark"); and

# **TIGER**

International registration no. 839125

International registration date 16 November 2004

Date protection granted in EU 30 March 2006

Relying on all goods namely:

Class 32: Beer, ale and stout.

("the opponent's third mark")

3. The opponent submits that there is a likelihood of confusion between the parties' respective marks due to the similarity between them and the identity or similarity between the goods. The applicant filed a counterstatement denying the claims made.
  
4. The opponent is represented by Chiever B.V. and the applicant is represented by Angela Margaret Rose Woolford. Both parties have filed evidence in chief, with the opponent also filing submissions in response during the evidential rounds. No hearing was requested and only the applicant has filed written submissions in lieu of a hearing. I have taken these into consideration and will refer to them below where necessary. This decision is taken following a careful perusal of the papers.

## **EVIDENCE**

5. The opponent has submitted evidence in the form of a witness statement of Willem van den Wijngaart, dated 22 January 2020. The applicant filed evidence in the form of a witness statement of Angela Woolford, dated 12 March 2020. The opponent then filed evidence in reply in the form of a document titled "response to submissions as filed by the applicant on 12 March 2020" by Faith Lim Zhi Zhen dated 13 July 2020. I will summarise the most pertinent points of the evidence below.

## The opponent's evidence

### *The Witness Statement of Willem van den Wijngaart*

6. Mr van den Wijngaart is the Global Tiger Marketing Manager of the opponent, a position which he has held since 1 July 2019. He has been employed by the opponent since 2011.
7. Within his statement, Mr van den Wijngaart encloses a copy of the notice of opposition that was filed on 23 September 2019.<sup>1</sup> He also discusses the outcome of a comparison search on the 'Darts IP' website that shows a similarity of 95% between 'beers' in class 32 and 'cider' in class 33 in European cases and 100% in UK cases.<sup>2</sup> I note the content of these documents and comments from Mr van den Wijngaart, but the comparison of goods in this matter is not between 'beer' and 'cider'. While the applicant's mark contains the word 'cider', the goods for which he seeks to register are 'alcoholic beverages' in Class 33.
8. Mr van den Wijngaart then proceeds to state that the applicant has put the opponent to proof of use of its marks. However, this was not the case. Mr van den Wijngaart discusses the use the opponent has made of its marks since 2009 in the UK for 'beers'. However, since the evidence provided is significant and not strictly relevant to these proceedings, I will not go into detail regarding the evidence but will summarise the points made.
9. A number of print outs from online retailers are provided,<sup>3</sup> however, I note that they are all dated 17 January 2020 which is after the date of the application at issue and are, therefore, not relevant to these proceedings.
10. Various articles from websites such as foodbay.com, thedrinkbusiness.com, ccllabel.com, Heineken.co.uk, tigerbeer.com, campaignlive.com, popsop.com, telegraph.co.uk and talkingretail.com are also provided.<sup>4</sup> These articles all discuss the sales of beers with the opponent's marks specifically within the UK.

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<sup>1</sup> Exhibit 1

<sup>2</sup> Exhibit 2

<sup>3</sup> Exhibits 3 to 6

<sup>4</sup> Exhibits 7 to 16

The articles are dated between 21 October 2010 and 17 January 2020. Mr van den Wijngaart states that all of these websites are aimed at the UK market and that they reflect the opponent's current use of its mark on beers. I note that three of the articles provided<sup>5</sup> are dated after the date of application in issue and are, therefore, not relevant to these proceedings.

11. While some of the evidence provided by Mr van den Wijngaart falls after the date of the application in issue, some articles do not. To the extent that the opponent's evidence may relate to its marks having obtained an enhanced level of distinctive character through use, I will deal with this issue further below where appropriate.

### The applicant's evidence

#### *The Witness Statement of Angela Woolford*

12. Ms Woolford is the appointed representative of the applicant. Firstly, Ms Woolford provides a copy of the counterstatement filed by the applicant on 2 November 2019.<sup>6</sup> Ms Woolford discusses the previous Tribunal proceedings between the parties in which the opponent opposed the applicant's applied for mark, being 'Tiger Gin'. A copy of these proceedings, being opposition number O/286/15, is provided within Ms Woolford's evidence.<sup>7</sup> I note Ms Woolford's comments regarding the similarities between the marks and the goods that were being opposed during those proceedings. The previous proceedings dealt with a different mark and different goods than the ones at issue and they will, therefore, not be relevant to the global assessment that I must make within this decision.

13. Within the evidence, Ms Woolford refers to the 15 other trade marks owned by the applicant, that all include the word 'Tiger'. A list of these trade marks has been provided.<sup>8</sup> I note Ms Woolford's comments that these applications were not opposed, however, whether the applicant's other applications have been opposed or not, is not relevant to these proceedings.

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<sup>5</sup> Exhibits 7, 10 and 11

<sup>6</sup> Exhibit AW-1

<sup>7</sup> Exhibit AW-2

<sup>8</sup> Exhibit AW-3

14. Ms Woolford then proceeds to discuss the comparison of 'beer' and 'cider' and the evidence provided by the opponent, being the Darts IP printout. Ms Woolford has undertaken her own comparison search on the UK IPO's website<sup>9</sup> and has included a printout of a result that shows a previous decision of the Tribunal, being case O/003/14.<sup>10</sup>
15. Ms Woolford makes further points regarding the comparison of 'beer' and 'cider' and I refer to my comments at paragraph 7 above in that the goods comparison in these proceedings is not between 'beer' and 'cider'. Therefore, I will not set out the content of Ms Woolford's discussion on this point but, if required, I will refer to relevant points below when assessing the comparison of goods.
16. The evidence then turns to focus on the use of the word 'Tiger' on marks registered for goods in class 33 on the WIPO's trade mark register, of which there are 103 results, 75 being active with 3 pending.<sup>11</sup> Ms Woolford has also included a result of a trade mark search of the UK IPO's register for the word 'Tiger' in classes 32 and 33, of which there are 66 results.<sup>12</sup>
17. Finally, Ms Woolford discusses the applicant's brands and attempts at expanding his portfolio. Information regarding the applicant's brand and products is provided by way of an extract from his website, a list of awards obtained by the applicant, a press release regarding the success of the applicant's 'Tiger Gin' brand, social media print outs regarding 'Tiger Gin' being a sponsor of music awards and social media follower figures.<sup>13</sup> While these comments and exhibits are noted, they are not strictly relevant to these proceedings.

#### The opponent's evidence in reply

#### *Response to submissions as filed by the applicant on 12 March 2020*

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<sup>9</sup> Exhibit AW-4

<sup>10</sup> Exhibit AW-5

<sup>11</sup> Exhibit AW-20

<sup>12</sup> Exhibit AW-21 and AW-22

<sup>13</sup> Exhibits AW-23 to AW-27

18. While the response states that it is in reply to submissions filed by the applicant, I acknowledge that the document referred to is the witness statement of Ms Angela Woolford discussed at paragraphs 12 to 17 above.
19. This statement is given by Faith Lim Zhi Zhen and is dated 13 July 2020. Ms Zhen is employed by the opponent as legal counsel, a job she has held since April 2015.
20. Ms Zhen discusses the previous proceedings of O/286/15, that were raised by Ms Woolford in her statement. Ms Zhen seeks to differentiate it from these proceedings. Ms Zhen proceeds to set out the differences between 'cidars' and 'gin', being the goods for which the applicant's previous mark was filed. As I have set out above, the applicant's mark does not specify 'cidars' as a good, but 'alcoholic beverages'. Ms Zhen goes on to discuss, in detail, the goods comparison between the marks. I do not propose to reproduce these here but, if required, will refer to them when assessing the goods comparison.
21. The proof of use provisions are also mentioned and I have set out above that while the opponent's marks are older than 5 years, they have not been put to proof of use by the applicant.
22. Ms Zhen also addresses the marks owned by Everards Brewery that were highlighted by Ms Woolford in her evidence. I note Ms Zhen's comments regarding these marks; however, they do not form part of these proceedings.

## **PRELIMINARY ISSUE**

23. I note that in the applicant's evidence, the presence of trade marks in classes 32 and 33 containing the word 'TIGER' was discussed. This covered the applicant's own marks together with marks contained within both the UK IPO's register and the WIPO' register. For reasons that I will now explain, the applicant's point regarding the presence of multiple trade marks on the register under Classes 32 and 33 containing the word 'TIGER' has no bearing on the outcome of this opposition.

24. I note that in the case of *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).”

25. The fact that there is a multitude of trade marks that contain the word ‘TIGER’ with Class 32 or 33 protection is not a relevant factor to the distinctiveness of the opponent’s marks. While I note that some of the marks have an active status, the applicant has filed no evidence to demonstrate that any of these marks are actually in use in the marketplace. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

## **DECISION**

### **Section 5(2)(b): legislation and case law**

26. Section 5(2)(b) of the Act reads as follows:

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

(a) ...



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

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

27. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

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

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

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

29. The opponent’s marks qualify as earlier trade marks under the above provisions. As the opponent’s marks had completed their registration process more than 5 years before the application date of the mark in issue, it was open to the applicant to request that the opponent prove use of its marks pursuant to section 6A of the Act. However, the applicant confirmed in its counterstatement that it did not require the opponent to provide proof of use. Consequently, the opponent can rely upon all of the goods for which its marks are registered.

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

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;
- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a

composite mark, without necessarily constituting a dominant element of that mark;

- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

### Comparison of goods

31. The competing goods are set out as follows:

| The opponent's first mark's goods   | The applicant's goods                   |
|---|---|
| <u>Class 32</u><br>Lager and goods in the nature of lager.  | <u>Class 33</u><br>Alcoholic Beverages. |
| The opponent's second mark's goods  |   |
| <u>Class 21</u><br>Drinking glasses; mugs, not of precious metal; bottles; jugs, not of precious metal; jugs made of glass; |   |

|  |  |
|--|--|
| <p>glassware for household use; ice buckets (other than of precious metal); serving trays (other than of precious metal); menu card holders; coasters, not of paper and other than table linen; not including vacuum flasks, and thermally insulated containers for food; vacuum bottles and vacuum insulated containers.</p> <p><u>Class 32</u><br/>Lager and goods in the nature of lager.</p> |  |
| <p>The opponent's third mark's goods</p>   |  |
| <p><u>Class 32</u><br/>Beer, ale and stout.</p>  |  |

32. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 that:

“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”.

33. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

34. The General Court confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

35. Both parties have discussed the comparison of goods in significant detail throughout their evidence and submissions. I have set out above that the term ‘cider’ is not a term within the applicant’s specification, although I do note that cider does fall within the term of alcoholic beverages under class 33.

36. I note the previous proceedings between the parties in the Tribunal found a low degree of similarity between 'gin' for the applicant and 'lager and goods in the nature of lager'. This, together with the average degree of distinctive character was the main basis for the Hearing Officer not finding a likelihood of confusion between those marks. While the applicant's current term, being "alcoholic beverages" will include gin, I must make the current comparison against all goods for which the applicant's term can cover.
37. On the face of it, "lager and goods in the nature of lager" and "beer, ale and stout" in the opponent's specifications may be considered identical to "alcoholic beverages" in the applicant's specification based on the principle outlined in *Meric*. However, I note that the term "alcoholic beverages" falls within class 33 and that "beers" are expressly excluded. The opponent's class 32 goods all describe different types of beer and, therefore, I cannot find that these goods are identical. I will, however, proceed to assess the similarity (if any) between them.
38. I note that the applicant's goods cover a wide range of alcoholic beverages, which would include drinks with a high alcoholic content such as spirits and drinks with a lower alcoholic content such as cider. Although the means of production of alcoholic beverages will be different to lager, beer, ale and stout, I bear in mind the decision of Mr Geoffrey Hobbs QC, sitting as the Appointed Person, in the case of *Balmoral*.<sup>14</sup> While *Balmoral* concerned the comparison of whiskey and wine, it cautioned against placing too much emphasis on factors such as the methods of production and difference in colour and taste of the drinks, and focussed instead on the shared channels of trade.
39. It is common to find alcoholic beverages and lager, beer, ale and stout being sold by retailers whose customers expect them to stock and sell all kinds of alcoholic products. While the goods may be separated into different sections or shelves within those retailers, I am of the view that the average consumer would readily accept that a supplier of alcoholic beverages would also supply lagers, beers, ales and stouts. Therefore, there will be an overlap in trade channels between these goods.

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<sup>14</sup> *Balmoral Trade Mark* [1999] RPC 297

40. I will now move on to consider the other factors identified by Jacob J. in the *Treat* case (cited above). All goods at issue are beverages that contain alcohol (albeit at different contents) and they will, therefore, overlap in nature. There is also an overlap in purpose in that the goods offer pleasurable drinking experiences, which may include the intoxicating effects of alcohol. These goods will all be drunk by the consumer, meaning that the method of use will be identical. The users will also be identical, being those over 18 years old. Finally, given the broad range of goods included within the applicant's term, I find that there will be an element of competition between these goods. For example, a user could choose to drink an alcoholic beverage such as cider over lager or beer, and vice versa. However, I do acknowledge that the level of competition between other types of alcoholic beverages and lagers, beers, stouts and ales will be limited.

41. Overall, I find that "alcoholic beverages" in the applicant's specification is similar to the opponent's "lager and goods in the nature of lager" and "beer, ale and stout" to at least a medium degree.

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

42. 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 decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

43. I find that the average consumer of the goods at issue will be a member of the general public over the age of 18. The goods at issue are most likely to be sold through a range of retail outlets such as supermarkets, off-licences, specialist suppliers and their online equivalents. The goods will also be sold in restaurants, bars and public houses. In retail outlets, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as restaurants, bars and public houses, the goods are likely to be on display, for example, behind the counter at bars or on drinks menus. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

44. The goods are not everyday beverage products but are likely to be purchased on a semi-regular basis. The costs of the goods at issue will be fairly inexpensive. When selecting the goods, the average consumer is likely to consider such things as origin of the goods, the age of the goods, size, flavour, use by/best before dates and alcoholic content. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the goods.

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

45. 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).”

46. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

47. The opponent has not pleaded that its marks have acquired enhanced distinctiveness. However, for the sake of completeness, I note the following. The evidence provided by the opponent does not provide any information about the market share held by the opponent’s marks for the goods for which it is registered. While the opponent has included a number of print outs from various online retailers that show the products available for sale to UK consumers, it provides no information about sales figures to enable me to assess the extent of the use that has been made of the marks. While there are a number of articles included within the opponent’s evidence from UK websites that discuss sales within the UK, I do not consider this sufficient to enable me to assess the geographical spread of any use of the mark. No information is provided by the opponent about how much has been invested in promoting the mark relied upon or what steps have been taken to advertise under the mark. I, therefore, do not consider that the evidence filed is sufficient to show that the opponent’s mark has acquired an

enhanced level of distinctive character. Consequently, I have only the inherent position to consider.

48. The opponent's marks consist of one word only, being 'TIGER'. The opponent's first mark is a word only mark, whereas in the second and third marks, the word is displayed in different typefaces, albeit still standard. The word 'TIGER' is an ordinary word that will be attributed its dictionary meaning, being that of a large animal, belonging to the cat family. On the opponent's goods, it will have no descriptive or allusive qualities. I do not consider that the typefaces used in the opponent's second mark will affect the distinctive character of the mark meaning that it will have the same level of distinctive character as the opponent's first mark, which I find to be medium. However, the typeface used in the opponent's third mark appears to be a distorted version of a standard typeface. For this reason, I consider that the opponent's third mark's distinctiveness will be increased slightly. Therefore, I consider the opponent's third mark to have a higher than medium degree of inherent distinctive character.

### **Comparison of marks**

49. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

50. The CJEU stated at 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.”

51. It would be wrong, therefore, to artificially 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.

52. The respective trade marks are shown below:

| The opponent's marks  | The applicant's mark                               |
|---|--|
| <p data-bbox="341 846 735 936">TIGER<br/>("the opponent's first mark")</p> <p data-bbox="316 1016 762 1171"><b>TIGER</b><br/>("the opponent's second mark")</p> <p data-bbox="341 1256 743 1411"><b>TIGER</b><br/>("the opponent's third mark")</p> | <p data-bbox="1027 1077 1190 1111">Tiger Cider</p> |

53. The applicant submits that:

“the descriptive word ‘Cider’ enhances the distinctiveness of the Applicant’s trademark and serves as a clear differentiator between the marks both from visual and aural perspectives. Tiger Cider is also 2 words versus the single word Tiger and is therefore a longer mark thus differentiating between the marks. Also, ‘Cider’ has 2 syllables (Ci-der) which serves to enhance the difference in sound rhythms of the marks thus reducing further the aural

confusion. [...] Thus I believe that there can be no likelihood of confusion between the marks.”

### Overall impression

#### *The applicant’s mark*

54. The applicant’s mark is a word only mark that consists of the words ‘TIGER CIDER’. The word ‘CIDER’ is descriptive of a type of alcoholic beverage and will be seen as such by the average consumer. As a result, ‘CIDER’ will play a lesser role in the overall impression of the applicant’s mark, with ‘TIGER’ playing the greater role.

#### *The opponent’s marks*

55. The opponent’s first mark is a word only mark. While the opponent’s second mark is displayed in a different typeface, it is a standard typeface that carries no trade mark significance. There are no other elements that contribute to the overall impression of these marks, which lies in the word ‘TIGER’ itself.

56. However, the opponent’s third mark is the word ‘TIGER’ displayed in a distorted typeface that will be noticed. As a result, ‘TIGER’ will play the greater role in the overall impression of the mark, with the distorted typeface playing a lesser role.

### Visual Comparison

#### *The opponent’s first and second marks and the applicant’s mark*

57. Visually, the marks coincide in that they contain the word ‘TIGER’. The marks differ in that the applicant’s mark contains the word ‘CIDER’, which is not present in the opponent’s mark. The word ‘TIGER’ is the only element of the opponent’s first and second marks and sits at the beginning of the applicant’s mark, which is where average consumers tend to focus.<sup>15</sup> While I have found that the word ‘CIDER’ will play a lesser role in the overall impression of the mark, it still

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<sup>15</sup> *El Corte Inglés, SA v OHIM* Cases T-183/02 and T-184/02

constitutes a visual difference. Overall, I find that the opponent's first and second marks and the applicant's mark are visually similar to a high degree.

*The opponent's third mark and the applicant's mark*

58. These marks will share the same similarities and differences highlighted in paragraph 57 above. However, they will differ in the use of the distorted font in the opponent's third mark. I note that the applicant's mark is a word only mark and can be displayed in any standard typeface. Taking all of this into account, I find that these marks are visually similar to between a medium and high degree.

Aural Comparison

59. Aurally, the opponent's marks consist of two syllables that will be pronounced 'TAI-GUR'. The applicant's mark consists of four syllables that will be pronounced 'TAI-GUR-SAI-DUR'. The first two syllables of the marks are identical and form the entirety of the aural element of the opponent's marks. Given that the similarities fall at the beginning of the marks, I find that they will be aurally similar to a high degree.

Conceptual Comparison

60. Both parties' marks contain 'TIGER', which will be seen as conceptually identical by the average consumer. The word 'CIDER' in the applicant's mark is purely descriptive of a type of alcoholic beverage and, despite this, it will still act as a point of conceptual difference between the marks. Overall, I find that the marks are conceptually similar to a high degree.

**Likelihood of confusion**

61. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in

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

62. I have found the goods to be similar to at least a medium degree. I have found the average consumer to be a member of the general public over the age of 18. I have found that the visual component will dominate the selection process of the goods, however, I do not discount the aural component. I have concluded that the average consumer is likely to pay a medium degree of attention during the selection process of the goods. I have taken these factors into account in my assessment of likelihood confusion.

63. I have found the opponent's first and second marks to have a medium degree of inherent distinctive character and the opponent's third mark to have a higher than medium degree of inherent distinctive character. I have also found the opponent's first and second marks and the applicant's mark to be visually, aurally and conceptually similar to a high degree. I have found the opponent's third mark and the applicant's mark to be visually similar to between a medium and high degree and aurally and conceptually similar to a high degree.

#### Direct Confusion

64. I have found that the word 'TIGER' plays a greater role in both parties' marks. Due to its descriptive nature, I consider that the word 'CIDER' will be overlooked. Taking all of the above factors into account together with the principle of imperfect recollection, I consider that the average consumer is likely to mistake the applicant's mark and the opponent's marks for one another. This is particularly

the case where the applicant's mark is on goods such as cider. For example, due to the fact that beer, lager, ales, stouts and ciders are all commonly ordered or purchased by the bottle or pint, I find it likely that an average consumer will order a bottle or pint of cider on the mistaken belief that it is beer, and vice versa. Further, in the event that the goods are requested orally, it is likely that the average consumer will request a pint of/bottle of 'TIGER', which would prompt the response as to whether the consumer wanted a pint of/bottle of beer or cider. This is likely to give rise to confusion on the part of the consumer. Consequently, I consider that there is a likelihood of direct confusion between the marks on goods that I have found to be similar to at least a medium degree. However, if I am wrong on my finding of direct confusion, I will proceed to consider indirect confusion.

### Indirect Confusion

Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10.

"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 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.). BL O/375/10 Page 15 of 16

(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).”

65. I have borne in mind that the examples given by Mr Purvis QC are not exhaustive. Rather, they were intended to be illustrative of the general approach.<sup>16</sup>

66. If the average consumer notices the differences between the marks, I find that they are likely to believe that the goods provided under the respective marks originate from the same or economically linked undertaking. This is because the consumer, when encountering the mark ‘TIGER CIDER’ is likely to believe that it is a brand extension of the undertaking ‘TIGER’ that specifically focuses on cider. The reverse is also likely to be true in that a consumer encountering ‘TIGER’ on beer, lager, ale or stout is likely to believe that it originates from the same or economically linked undertaking as ‘TIGER CIDER’. Further, any differences in the presentation of the word elements of the marks will be seen as alternative marks used by the same or economically linked undertakings. Consequently, I find there to be a likelihood of indirect confusion between the marks on goods that are similar to at least a medium degree.

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<sup>16</sup> L.A. Sugar Limited v By Back Beat Inc, Case BL-O/375/10



## CONCLUSION

67. The opposition succeeds in its entirety and the application is refused.

## COSTS

68. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I award the opponent the sum of £300 as a contribution towards the costs of proceedings. The sum is calculated as follows, which includes no award in respect of the evidence filed; since the marks were not put to proof of use and the opponent did not claim (nor establish) enhanced distinctiveness of its marks through use, the evidence filed was irrelevant.

|   |             |
|---|-------------|
| Filing a notice of opposition and considering the applicant's counterstatement: | £200        |
| Official fee:   | £100        |
| <b>Total:</b>   | <b>£300</b> |

69. I therefore order Jeffrey Joshua Lawrence to pay Heineken Asia Pacific PTE Ltd the sum of £300. 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 16th day of November 2020**

**A COOPER  
For the Registrar**