

O/718/21

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001377499

BY SOUTHERN WILD DISTILLERY PTY LTD

TO REGISTER THE TRADE MARK:

DASHER + FISHER

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 422082

BY FISHERS GIN LTD

BACKGROUND AND PLEADINGS

1. International trade mark 1377499 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Southern Wild Distillery Pty Ltd. The IR is registered with effect from 26 October 2017. With effect from 30 January 2020, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the following goods:

Class 33 Alcoholic beverages (except beer); whiskey; gin; spirits (beverages); rum; vodka; brandy.

2. The request to protect the IR was published on 14 August 2020. On 16 November 2020, Fishers Gin Ltd (“the opponent”) opposed the protection of the IR in the UK based upon sections 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) the opponent relies on the following trade marks:

FISHERS

European Union trade mark no.14522767¹

Filing date 1 September 2015; registration date 14 January 2016.

Relying upon all goods for which the earlier mark is registered, namely:

Class 33 Alcoholic beverages.

(“the First Earlier Mark”)

¹ Although the UK has left the EU and the transition period has now expired, EUTMs, and International Marks which have designated the EU for protection, are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.



UK registration no.00003156611

Filing date 24 March 2016; registration date 9 February 2018.

Relying upon all goods for which the earlier mark is registered, namely:

Class 33 Gin.

(“the Second Earlier Mark”)

3. Under section 5(2)(b), the opponent relies upon all of the goods for which its marks are registered. The opponent claims that there is a likelihood of confusion because the marks are similar from a visual and aural point of view and the goods are either identical or highly similar.

4. Under section 5(4)(a) the opponent relies upon the sign **FISHERS** which it claims to have used throughout the UK since at least 2015 for alcoholic beverages, namely, gin.

5. The holder filed a counterstatement denying the claims made.

6. The opponent is represented by Potter Clarkson LLP and the holder is represented by McCarthy Denning Limited. Only the opponent filed evidence in chief. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

7. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in

these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the witness statement of Mr Andrew Michael Hilliard Heald, which is dated 10 May 2021. Mr Heald is the Founder and Director of the opponent. Mr Heald's statement was accompanied by 9 exhibits.

9. The opponent also filed evidence in the form of the witness statement of Mr Christopher Andrew Baume, which is dated 15 July 2021. Mr Baume is the Chartered Trade Mark Attorney and Associate at Potter Clarkson LLP who are the representatives for the opponent. Mr Baume's statement was accompanied by 2 exhibits. The exhibits filed under Mr Baume's witness statement are screenshots of the links which were provided in exhibit AMHH1 in Mr Heald's witness statement, which the holder was notified that the Hearing Officer would not view the content of on 24 May 2021.

10. Whilst I do not propose to summarise the submissions and evidence here, I have taken them into consideration and will refer to them below where necessary.

DECISION

Section 5(2)(b)

11. Section 5(2)(b) reads as follows:

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

(a)...

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

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

12. 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 IR for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks

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

13. The trade marks upon which the opponent relies qualify as earlier trade marks because they were applied for at an earlier date than the holder’s IR pursuant to section 6 of the Act. As the opponent’s marks had not completed their registration process more than 5 years before the filing date of the IR in issue, they are not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) case law

14. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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

15. The competing goods are as follows:

| Opponent's goods | Holder's goods |
|--|---|
| <p>The First Earlier Mark <u>Class 33</u> Alcoholic beverages.</p> <p>The Second Earlier Mark <u>Class 33</u> Gin.</p> | <p><u>Class 33</u> Alcoholic beverages (except beer); whiskey; gin; spirits (beverages); rum; vodka; brandy.</p> |

16. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

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

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

17. “Gin” appears identically in both the opponent’s Second Earlier Mark’s specification and the holder’s specification.

18. “Alcoholic beverages” in the opponent’s First Earlier Mark’s specification is self-evidently identical to “alcoholic beverages (except beer)” in the holder’s specification.

19. I consider that “whiskey”, “gin”, “sprints (beverages)”, “rum”, “vodka” and “brandy” in the holder’s specification will fall within the broader category of “alcoholic beverages” in the opponent’s First Earlier Mark’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

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

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

21. The average consumer of the goods will be adult members of the general public. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the cost, flavour, ingredients and alcohol percentage. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

22. The goods are likely to be purchased by self-selection from the shelves of a retail outlet such as supermarkets or off-licences, or an online equivalent. Such goods are also sold in public houses and bars, where they will be publicly displayed behind the counter or on a drinks menu. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be verbally ordered at a bar, or if stocked behind a counter, the average consumer must ask the sales assistant for them.


Comparison of the trade marks

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

24. 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.

25. The respective trade marks are shown below:

| Opponent's trade marks | Holder's IR |
|---|---|
| <p data-bbox="379 786 611 837" style="text-align: center;">FISHERS</p> <p data-bbox="320 875 671 909" style="text-align: center;">(The First Earlier Mark)</p> <div data-bbox="411 1016 603 1496" style="text-align: center;">  </div> <p data-bbox="296 1534 695 1568" style="text-align: center;">(The Second Earlier Mark)</p> | <p data-bbox="874 1010 1334 1055" style="text-align: center;">DASHER + FISHER</p> |

Overall Impression

26. The First Earlier mark consists of the word FISHERS. There are no other elements to contribute to the overall impression which lies in the word itself.

27. In exhibit AMHH9, and in their written submissions, the opponent attaches and references decision number BL O/647/17 where a previous Hearing Officer describes the Second Earlier mark as the following:

“17. The applicant’s mark consists of the outline of a capped bottle on which appears a label made up of a background pattern with a top and bottom border and on which is a central feature in the shape of a square. Placed centrally within that square is the word FISHERS above which is a device of an anchor, the whole surrounded by what Mr Kinsey referred to at the hearing as a lifebelt device. I think it more likely that, if noticed at all, it will simply be seen as a circle bordering the word and anchor device however I will use Mr Kinsey’s descriptor for convenience. Above and below these elements, and partially overlapping the lifebelt, are curved blank ribands. The central square has a continuous decorative border to the left and right hand sides and a similar border to the top and bottom which is split in the middle. Each external corner of the square contains a heart device and each internal corner has what appears to be a flower device and scrolls. The background pattern is made up of a series of squares interlocked with diamond shapes with circles at each intersection. The mark is not limited as to colour. The outline of a bottle is not distinctive for gin. The background pattern, the word Fishers and the anchor device are distinctive elements of the mark. If it is noticed at all, the lifebelt element is of little distinctiveness as are the ribands. The background pattern is a busy one whereas the word FISHERS is presented on a white background and is placed between the curved ribands above and below it which adds focus to it and this, coupled with its central location and size, leads me to find that it is the word FISHERS which is the dominant distinctive element of the applicant’s mark.”

28. I am not bound by the decisions of previous Hearing Officers, and it is important to note that I cannot take into consideration the submissions of Mr Kinsey at the hearing which is referenced. However, I echo the description of the opponent’s Second Earlier Mark in the above paragraph for comparison purposes and would reach the same conclusion as to the most dominant and distinctive element of the mark.

29. The Holder's IR consists of the words DASHER and FISHER, with a plus symbol in between. The overall impression of the mark lies in the combination of these elements.

Visual Comparison

The First Earlier Mark and the Holder's Mark

30. Visually, the marks coincide in the presence of the letters F, I, S, H, E and R. These all act as visual points of similarity. However, the First Earlier Mark contains the additional letter S at the end of FISHER, and the holder's IR contains the additional elements DASHER and the plus symbol. These all act as visual points of difference. As a general rule, the beginning of the marks tend to make more impact than the ends, especially as words are read from left to right.² Consequently, I consider the marks to be visually similar to between a low and medium degree.

The Second Earlier Mark and the Holder's Mark

31. The same comparison applies as set out above. However, the Second Earlier Mark contains all of the additional intricate elements such as the anchor device, the central square, decorative boarder and background. Taking the above into account, I consider the marks to be visually similar to a low degree.

Aural Comparison

The First Earlier Mark and the Holder's Mark

32. Aurally, the First Earlier Mark will be given its ordinary English pronunciation, FISH-ERS. The plus in the holder's mark will be articulated as AND. Therefore, I consider that the holder's IR will be pronounced as DASH-ER AND FISH-ER. Consequently, I consider the marks to be aurally similar to between a low and medium degree.

² *El Corte Ingles, SA v OHIM, Cases T-183/02 and T-184/02*

The Second Earlier Mark and the Holder's Mark

33. The Second Earlier Mark is a composite mark. The design elements cannot be articulated, and therefore, aurally the same comparison applies as above. I consider the marks to be aurally similar to between a low and medium degree.

Conceptual Comparison

The First Earlier Mark and the Holder's Mark

34. Conceptually, the word FISHER, is present in both marks, albeit the First Earlier Mark is the plural version (FISHERS). The holder in its counterstatement lists various concepts which could be assigned to the word FISHER including:

- a) A large brown marten
- b) A person who fishes, the archaic of fisherman, fisherfolk etc. as defined by the Oxford English Dictionary
- c) A shipping forecast area in the North Sea
- d) A common surname
- e) A river in Tasmania

35. I accept that these are all concepts which could be assigned to the word FISHERS. However, I consider it most likely that the average consumer would recognise the opponent's mark, FISHERS, to be a relatively common surname (FISHER) in the possessive form (albeit without the apostrophe) or a slight variation of the same name i.e. with the addition of an 'S'.

36. The holder's IR is composed of two words, DASHER and FISHER. Again, FISHER could be assigned the above list of concepts. DASHER is also defined as someone or

something that dashes.³ The fact that DASHER and FISHER are connected by the plus sign and that both words share the commonality of being surnames, allows me to conclude that the average consumer will assign this concept to the holder's IR. The other concepts which could be assigned to FISHER would not make sense when combined with the dictionary definition of the word DASHER.

37. Consequently, the marks share some conceptual similarity to the extent that they are both likely to be seen as referring to the same family name (or a variant thereof), FISHER and FISHERS. However, the First Earlier Mark refers to only one name (or person) whereas the holder's IR refers to two, giving the impression of two distinct people. Taking the above into account, I consider that the marks are conceptually similar to between a low and medium degree.

The Second Earlier Mark and the Holder's Mark

38. The same comparison applies as above, although, I recognise that the anchor device may reinforce the meaning of FISHER in the Second Earlier Mark to mean someone who fishes. However, as both marks being recognised as surnames represents the opponent's best case (due to the resulting conceptual overlap), I will proceed on that basis. Consequently, for the same reasons set out above, I consider the marks are conceptually similar to between a low and medium degree.

Distinctive character of the earlier trade mark

39. 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

³ <https://www.collinsdictionary.com/dictionary/english/dasher>

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promotion of 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).”

40. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

41. Mr Heald has provided FGL’s approximate income from sales of FISHERS gin products in the UK to enable me to assess the extent of the use that has been made of the marks:

| | |
|--------------|----------|
| January 2020 | £250,000 |
| 2019 | £120,000 |
| 2018 | £80,000 |
| 2017 | £50,000 |
| 2016 | £50,000 |

42. The opponent is relying upon two earlier rights for the purposes of this opposition, the FISHERS word mark, and the FISHERS bottle label composite mark. Although Mr Heald has not specified what earlier marks the above figures relate to, the

distinctiveness of both marks lies in the word FISHERS. Therefore, I consider that use of one of them would be acceptable use of the other. Consequently, this will not impact my overall finding.

43. I also note that in exhibit AMHH4, Mr Heald provided three invoices for the sale of “Fishers Gin 6x70cl” dated September, October and November 2018 which amount to £14,748.46. Only two of the invoices are addressed to customers which are based in the UK. In annex CAB1 and CAB2 of exhibit AMHH1, Mr Baume provides a series of screenshots to demonstrate that FISHERS gin is sold through various retailers in the UK. However, these are all undated. Consequently, I have limited information as to the geographical spread of use in the UK prior to the relevant date.

44. I note that no market share figures have been provided and that the above turnover figures do not appear to represent a particularly significant market share in what must be a fairly extensive market in the UK. The opponent has also not provided any information or figures in relation to advertising. I note that in exhibit AMHH7 Mr Heald does provide screenshot evidence of the FISHERS gin website, Twitter and Instagram. However, these are all undated. The exhibit also includes screenshots of the FISHERS gin Facebook page which does contain two dated posts which fall before the relevant date. The first post which is dated 28 January 2020 shows two FISHERS gin bottles and announces that their “new online store is open for UK business”. However, I note that the bottles do not use the opponent’s Second Earlier Mark. The second post which is dated 25 February 2016 only shows use of part of the Second Earlier Mark’s design.

45. Mr Heald also provides the following articles in exhibit AMHH3:

- FISHERS gin being featured in The Times article “25 most stylish gifts for men” dated 6 December 2016.
- An article on Cambridge Club Festival website about FISHERS gin dated 16 March 2021, however, this falls after the relevant date.
- An article in the East Anglian Daily Times about FISHERS distillery opening on the Suffolk coast. This exhibit was difficult to read and therefore I was unable to determine the exact date of the article.

- A screenshot from The Gin Guild about FISHERS gin which is undated.

46. Mr Heald also submits that FISHERS gin has been acknowledged in Olive Magazine for Best British Gins dated 2 September 2019. It has also been acknowledged in Make it British making the Top 25 British Gin Brands and it won the IWSC 2020 Silver Award.⁴ However, these acknowledgements and awards are undated.

47. Taking the above into account, I do not consider that the opponent has demonstrated that the distinctive character of both of its earlier marks have been enhanced through use.

48. I will now consider the inherent distinctiveness of the opponent's marks.

The First Earlier Mark

49. In *Harman International Industries, Inc v OHIM*, Case C-51/09P, the Court of Justice of the European Union found that:

“Although it is possible that, in a part of the European Union, surnames have, as a general rule, a more distinctive character than forenames, it is appropriate, however, to take account of factors specific to the case and, in particular, the fact that the surname concerned is unusual or, on the contrary, very common, which is likely to have an effect on that distinctive character. That is true of the surname ‘Becker’ which the Board of Appeal noted is common”.

50. In *El Corte Inglés, SA v OHIM*, Case T-39/10, the General Court found that:

“54. As the applicant asserted in its pleadings, according to the case-law, the Italian consumer will generally attribute greater distinctiveness to the surname than to the forename in the marks at issue (Case T-185/03 Fusco v OHIM – Fusco International (ENZO FUSCO) [2005] ECR II-715, paragraph 54). The

⁴ Exhibit AMHH2

General Court applied a similar conclusion concerning Spanish consumers, having established that the first name that appeared in the mark in question was relatively common and, therefore, not very distinctive (Case T-40/03 Murúa Entrena v OHIM – Bodegas Murúa (Julián Murúa Entrena) [2005] ECR II-2831, paragraphs 66 to 68).

55. Nevertheless, it is also clear from the case-law that that rule, drawn from experience, cannot be applied automatically without taking account of the specific features of each case (judgment of 12 July 2006 in Case T-97/05 Rossi v OHIM – Marcorossi (MARCOROSI), not published in the ECR, paragraph 45). In that regard, the Court of Justice has held that account had to be taken, in particular, of the fact that the surname concerned was unusual or, on the contrary, very common, which is likely to have an effect on its distinctive character. Account also had to be taken of whether the person who requests that his first name and surname, taken together, be registered as a trade mark is well known (Case C-51/09 P Becker v Harman International Industries [2010] ECR I-5805, paragraphs 36 and 37). Likewise, according to the case-law cited in the previous paragraph, the distinctive character of the first name is a fact that should play a role in the implementation of that rule based on experience.”

51. I consider that FISHER/S is a relatively common name. Therefore, taking the above case law into account, if the average consumer perceived the mark as a surname (whether it be the name FISHER in possessive form or a slight variant of the name with the addition of an ‘S’), it will be inherently distinctive to a medium degree.

The Second Earlier Mark

52. I note that the devices and background of the Second Earlier Mark do add moderately to the distinctiveness. Therefore, I consider the Second Earlier Mark to be inherently distinctive to a slightly higher than medium degree.

Likelihood of confusion

53. 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 goods 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

54. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the First Earlier Mark and the holder's IR to be visually similar to between a low and medium degree.
- I have found the Second Earlier Mark and the holder's IR to be visually similar to a low degree.
- I have found all of the marks to be aurally similar to between a low and medium degree.
- I have found all of the marks to be conceptually similar to between a low and medium degree.
- I have found the earlier marks to be inherently distinctive to a medium degree or slightly higher than a medium degree.
- I have identified the average consumer as adult members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.

- I have found the parties goods to be identical.

55. Taking all of the factors listed in paragraph 54 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. I do not consider that the additional elements DASHER, the plus element and the S at the end of FISHERS in the IR will be mistakenly recalled or misremembered. I also do not consider that the decorative devices and background of the Second Earlier Mark will be overlooked by the average consumer. Consequently, I do not consider there to be a likelihood of direct confusion.

56. It now falls to me to consider the likelihood of 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.”

57. Having noticed that the competing trade marks and IR are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the IR was connected with the opponent. They are not natural variants or brand extensions of each other. There is also no evidence that it is common practice for alcoholic beverage brands which use a name as their trade mark to extend their brand

by adding an additional person's name. The average consumer is far more likely to view these marks as simply referring to two different people, who have similar last (and relatively common) names (FISHER and FISHERS). A finding of confusion should not be made merely because two marks share a common element; it is not sufficient that one mark merely calls to mind the other.⁵ Consequently, I do not consider there to be a likelihood of indirect confusion.

58. The opposition based upon section 5(2)(b) is unsuccessful.

Section 5(4)(a)

59. Section 5(4)(a) of the Act states as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

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

60. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of

⁵ *Duebros Limited v Heirler Cenovis GmbH, BL O/547/17*

application for registration of the trade mark or date of the priority claimed for that application.”

61. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the *Jif Lemon* case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

62. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM O-212-06* Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then

to assess whether the position would have been any different at the later date when the application was made.”

63. As the holder has filed no evidence of use, I have only the prima facie relevant date to consider i.e. 30 January 2020.

Goodwill

64. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

65. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing off claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark* [1969] R.P.C. 472). Thus the evidence will include evidence from the trade as to reputation; 54 evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

66. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

67. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark* [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small.

That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

68. Goodwill arises as a result of trading activities. It is clear from the figures provided by Mr Heald that FISHERS gin has been trading under the FISHERS sign since 2016, although the opponent has claimed it has been used since at least 2015 for alcoholic beverages, namely, gin. The revenue figures from 2016 to January 2020 for FISHERS gin total £550,000. I consider this evidence to be sufficient to demonstrate a level of goodwill. On balance, I am prepared to accept that the opponent has a modest, though not trivial, degree of goodwill in the UK in relation to gin. I am also satisfied that the sign relied upon was distinctive of that goodwill at the relevant date.

Misrepresentation and damage

69. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

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

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

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

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

70. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

71. I consider that the differences between the marks and IR would be sufficient to avoid misrepresentation occurring. I consider that these differences are sufficient to avoid a substantial number of members of the relevant public purchasing the holder's goods in the mistaken belief that they are provided by the opponent's business. As there is no misrepresentation, there can be no damage.

72. The opposition under section 5(4)(a) is unsuccessful.

CONCLUSION

73. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

74. The holder has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the

circumstances, I award the applicant the sum of **£1,150** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

| | |
|---|---------------|
| Considering the Notice of opposition and preparing a Counterstatement | £300 |
| Considering the opponent's evidence | £500 |
| Preparing and filling written submissions in lieu | £350 |
| Total | £1,150 |

75. I therefore order Fishers Gin Ltd to pay Southern Wild Distillery Pty Ltd the sum of £1,150. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 29th day of September 2021

L FAYTER
For the Registrar