

O-272-16

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION 3055299
BY JEFFREY JOSHUA LAWRENCE
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33**

King of GIN

**AND
OPPOSITION 403255 THERETO BY
WEST END DRINKS LIMITED**

Background and pleadings

1. Jeffrey Joshua Lawrence (the Applicant) applied to register the trade mark King of GIN in the UK on 13 May 2014. It was accepted and published in the Trade Marks Journal on 15 August 2014 in respect of *Spirits* in class 33.
2. West End Drinks Limited (the Opponent) oppose the trade mark on the basis of Sections 5(2)(b) and 5(3) of the Trade Marks Act 1994 (the Act). This is on the basis of its earlier UK Trade Mark and earlier European Union (formerly Community) Trade Marks. Both EU Trade Marks are themselves currently under opposition. I therefore focus on the UK Trade Mark, although, for the record, the details of all three earlier marks are as follows:

Mark	Number	Filing date	Status
The King of Soho	UK0002607768A	23/01/2012	Registered 27/04/2012
THE KING OF SOHO	EU010770634	29/03/2012 Claiming priority from the mark above	Opposed
	EU011539103	01/02/2013	Opposed

3. The Opponent's earlier UK Mark is registered in respect of the following goods:

Class 32 Beers and non-alcoholic drinks

Class 33 Alcoholic drinks & cocktails

4. The Opponent argues that the respective goods are identical or similar, and that the marks are similar. The Opponent further argues that its mark has a reputation, and that the Applicant's mark, if registered, will weaken the ability of the Earlier Mark to identify the goods for which it is registered and for which it has a reputation, and that this will lead to lost sales because use of the later mark would dilute the distinctive character and reputation of its mark. It further argues

that the use of the Applicant's mark if registered will ride on its (the Opponent's) coattails and benefit from the power of attraction, reputation and prestige of the earlier mark. Finally, the Opponent claims that there is no due cause for adoption of the Applicant's mark.

5. The applicant filed a counterstatement:

- Denying that the Opponent's goods in class 32 are similar to the Applicant's goods;
- Admitting that the Opponent's goods in class 33 are identical to the Applicant's goods;
- Denying that the marks are similar enough to cause confusion;
- Denying the claim under section 5(3) and putting the Opponent to proof.

6. The earlier mark was registered within five years of the date of publication of the opposed mark, therefore, the proof of use requirements do not apply with the consequence that the earlier mark may be relied upon for its specification as registered. The relevant date for the claims under both section 5(2)(b) and 5(3) is the date of filing, being 13 May 2014.

7. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary.

8. Both sides filed written submissions, which will not be summarised but will be referred to as and where appropriate. No hearing was requested and so this decision is taken on the basis of the papers before me.

Evidence

Opponent's evidence

9. The Opponent's evidence comprises the witness statement of Alex Robson, director of West End Drinks Limited, plus exhibits, and the witness statement of Clare Sugden of Stobbs IP, plus exhibits, both dated 8/06/2015. Some evidence was the subject of a confidentiality order as it relates to sensitive commercial information, and whilst I take it into account it is redacted below.

10. The following points arise from Ms Robson's evidence:

- West End Drinks Limited was incorporated as a private limited company on 31 May 2012, by Directors Howard Raymond and Ms Robson.

- The Mark 'The King of Soho' was taken from the nickname attributed to Mr Raymond's late father, Paul Raymond, a businessman operating in and associated with the nightlife of the West End of London from the 1950s onwards.
- Exhibit AR-5 shows the appearance of the Opponent's goods, being bottles of gin. The primary mark used on the bottle is that of Application EU011539103, though the words 'THE KING OF SOHO' in plain text appear on the reverse, as well as in the web address KINGOFSOHODRINKS.COM.
- AR-5 also includes printouts from the Opponent's social media profiles. Both are dated 20/05/2015, though the twitter records go back as far as 10/5/2015. It cannot be seen when the facebook page was established. The twitter page was established in May 2012, but twitter usernames can be changed so this is not probative. Again, the primary mark used is that of Application EU011539103, though the words 'The King of Soho' appear elsewhere in plain text, including as the username of the facebook account, and the twitter address @TheKingofSoho. The facebook account has 3452 'likes' and the twitter account has 2110 followers.



- Ms Robson's evidence is that the mark has been prominently displayed on "Oyster card holders, posters, t-shirts, postcards, brand factsheets/presentations". Examples of these appear in exhibits AR-12 and AR-13.
- The goods are said to have been exhibited at various trade shows and events "including IMBIBE LIVE which was held from 1 July 2014 to 2 July 2014". This is after the relevant date, and the evidence supplied does not show that the Opponent's product was involved in the event.
- The goods are also said to have been exhibited at the trade fair Packaging Innovations in 2013, but again this is not shown by the evidence provided. A video of a presentation given in part by Ms Robson is supplied, dating to October 2013, but it is not clear to whom the presentation was given.
- Ms Robson offers hearsay evidence that one pub, (the French Horn, Sonning), when making a Gin and Tonic with the Opponent's goods, refers to

it as a 'King and Tonic'. Further, she exhibits at AR-9 an audio recording of what is said to be the head bartender at Kettners, Soho, using the words 'the King's gin'. This recording is said to date to December 2014, after the relevant date.

- At exhibit AR-10 are presented a press release dating to after the relevant date, and undated marketing materials said to date to around September/Early October 2013. The only dated example is from after the relevant date.
- Exhibit AR-11 comprises several published articles, some of which fall before the relevant date, including inter alia:

London Evening Standard, 16 April 2013, announcing the launch of the brand, linking it to Paul Raymond and noting that the goods, when available, will be "high quality London Dry Gin";

London Evening Standard 27 September 2013 giving further details including price information. This article notes that at the time of the article the goods are stocked in "a handful of central London venues".

London Gin Club, 20 September 2013, reviewing the goods. The bottle is shown bearing the stylised mark, and the title and text of the article use the word mark 'The King of Soho';

Daily Mail, 3 October 2013, no mention is made of the opponent's goods but a bottle of the Gin is pictured in the hands of Mr Raymond and his brother;

The Grocer, 23 November 2013, discussing the launch of the product and the business strategy;

Pub & Bar, 31 March 2014, mentioning the goods in passing. There is also a picture of the goods.

- Exhibit AR-12 shows a variety of examples of the stylised mark in use, including shop frontage and t-shirts. The shop window display at AMATHUS DRINKS, which is said to be famous, is said to have been in place on 28 June 2014, after the relevant date.
- Exhibit AR-13 shows an advert on the Opponent's website for a promotional event held after the relevant date at which the word mark is said to have been featured.

- AR-14 – AR-18 are examples of hits from the first five pages of search results returned by Google for the terms ‘King of Soho gin review’, which Ms Robson says demonstrate the volume of positive reviews for the goods sold under the marks.
- AR-19 is the first page of a Google search for the words ‘king gin london’, eight of the nine results, as well as all of the image results, are hits for the Opponent’s goods.
- AR-20 shows the hits for the phrase ‘king gin’, one of which relates to the party with whom the Opponent is engaged in opposition proceedings at what is now called the EUIPO. Of the remainder, all but three relate to the Opponent.
- AR-21 shows similar, this time for the search ‘king gin UK’.
- AR-22 shows a blog relating to the branding exercise by which the stylised mark was derived.
- Finally, exhibit AR-23 shows the IMDb page of the Michael Winterbottom film about the life of Paul Raymond.

11. Ms Sugden’s witness statement supplements Exhibit AR-11 of Ms Ramond’s evidence, by presenting the circulation figures for each of the articles listed therein. These range from almost 1 million per publication in the case of the London Evening Standard, to around 20,000 for smaller publications such as ‘Pub & Bar’.

Applicant’s evidence

12. The Applicant’s evidence comprises the witness statement of Miss Angela Woolford dated 15 October 2015, plus exhibits, and is a mixture of evidence, and submissions, some of which may be conveniently dealt with at this juncture in respect of the following issues:

- a) The meaning of reputation in trade mark cases
- b) The trading status of companies linked to the Opponent
- c) The link between the Raymond family, the Opponent and the trade mark
- d) Other brands using the word ‘King’
- e) Requests to strike out evidence as not relevant
- f) Requests to strike out evidence as offensive

13. a) The Applicant appears to conflate ‘reputation’ in a trade mark sense with the idea of a ‘good reputation’ from a moral standpoint. The test for reputation in this case is simply whether the earlier mark is known by a significant part of the relevant public (see *General Motors Corp v Yplon SA* [2000] RPC 572 (CJEU)).
14. b) The Applicant has gone to some trouble to research and depict graphically the taxonomy of the various companies linked to Howard Raymond, Ms Robson and the Opponent, based on the misconception that the claim to ‘reputation’ relates to the Opponent, rather than to the trade mark. Section 5(3) of the Act, to which the reputation claims relate, states:

A trade mark which –

- a) is identical with or similar to an earlier mark, and
- b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, *the earlier trade mark has a reputation in the United Kingdom* [...]

Evidence relating to the directorships of members of the Opponent, or the liquidity of companies of which they are shareholders, are therefore not relevant to these proceedings, as the reputation in question is that of the earlier trade mark. If the Opponent is the registered proprietor of an earlier mark then that is sufficient grounds to bring the action.

15. c) The Applicant has also taken the trouble to research and depict graphically the family tree of Howard Raymond. The Applicant also supplies a copy of Paul Raymond’s last will and testament (‘the Will’), as well as articles describing schisms in the Raymond family. The apparent intent is to show that, contrary to the Opponent’s claims, Howard Raymond is not the ‘heir’ to Paul Raymond’s title ‘The King of Soho’ because his nieces were chosen as successors. This is not pertinent. The question is about the mark registered by the opponent, a mark which must be taken as valid, no proceedings having been launched against it by the applicant or any of the alleged “heirs”. I use the word “heirs” loosely because the name is not a title of nobility.
16. I note that there is a request for confidentiality in respect of the Will, which it is unnecessary to grant as the document is open to public inspection. In any case I need say no more about it.
17. d) Evidence of similar or identical marks in the marketplace other than those involved in the present case is not decisive for the reasons given in *Henkel KGaA*

v Deutsches Patent- und Markenamt, Case C-218/01, where the Court of Justice of the European Union found that:

“65... The fact that an identical trade mark has been registered in one Member State as a mark for identical goods or services may be taken into consideration by the competent authority of another Member State among all the circumstances which that authority must take into account in assessing the distinctive character of a trade mark, but it is not decisive regarding the latter's decision to grant or refuse registration of a trade mark.

On the other hand, the fact that a trade mark has been registered in one Member State for certain goods or services can have no bearing on the examination by the competent trade mark registration authority of another Member State of the distinctive character of a similar trade mark for goods or services similar to those for which the first trade mark was registered.”

18. Further, 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).”

19. e) It is said by the Applicant that the marketing expenditure of the Opponent, and evidence relating to the resulting exposure of the earlier mark, including that of the Opponent's second witness statement to which are exhibited readership statistics of publications in which articles and advertising relating to the earlier mark appears, should be struck out as irrelevant, as “reputation cannot be bought”. On the contrary, where ‘reputation’ in a trade mark sense means that the relevant public are aware of the mark, this may be entirely relevant evidence. There is also an assertion that only evidence of advertising relating to wholesale traders should be admitted because the Opponent trades as a wholesaler. This

distinction is not relevant as the relevant public for the goods 'Spirits' includes the end user irrespective of the business structure of the Opponent.

20.f) Finally, there is a request for page 14 of the Opponent's exhibit AR-11 to be struck out as offensive. This is a page from the website 'paulraymond.com' comprising pornographic images (albeit somewhat censored), and text. Whilst it is acknowledged that this may be offensive to some, that fact does not render it irrelevant evidence for these proceedings, and I allow it.

21. These issues having been dealt with, the following further point arises from the Applicant's evidence: it is the Applicant's belief that the Opponent's mark should be taken in its entirety as 'The King of Soho', but that if a single word can be said to be the dominant element then that word is 'Soho' and not 'King'.

The Opponent's evidence in reply

22. This comprises the further witness statement of Claire Sugden, plus exhibits, in which the Opponent explains further the distinction between wholesale and retail, and the nature of the relevant consumer of alcoholic drinks. It is not necessary to summarise this evidence any further.

DECISION

Section 5(2)(b)

Sections 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.

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

L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

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

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

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

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

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

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

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

(k) if the association between the marks creates a risk that the public 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

24. The Applicant admits that the Opponent's goods in Class 33 are identical to its own. Whether the other goods of the earlier mark are also similar will not, therefore, improve the opponent's position.

Average consumer and the purchasing act

25. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

26. 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.

27. The average consumer of spirits, including gin, is a member of the general public, albeit over the age of 18. The goods will be sold either in supermarkets and off-licences where the mode of selection will be primarily visual, or in licensed premises such as pubs and restaurants where they will be ordered verbally, but may be visible on optics or otherwise displayed behind the bar.

28. In *Simonds Farsons Cisk plc v OHIM* Case T-3/04 it was stated:

58. 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.

59. Moreover, and above all, it is not disputed that bars and restaurants are not the only sales channels for the goods concerned. They are also sold in supermarkets or other retail outlets (see paragraph 14 of the contested decision), and clearly when purchases are made there consumers can perceive the marks visually since the drinks are presented on shelves [...]

29. In terms of the degree of care and attention paid in the selection process, this will vary slightly between the more careful purchaser who is interested in the variety, geographic origin, ABV etc., and the less careful purchaser who makes a snap decision at the bar. Generally speaking, given the cost and frequency of purchase, I consider the degree of care and attention to be normal.

Comparison of marks

30. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 Court of Justice of the European Union 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.

31. 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.

The respective trade marks are shown below:

Earlier Mark	Contested Mark
The King of Soho	King of GIN

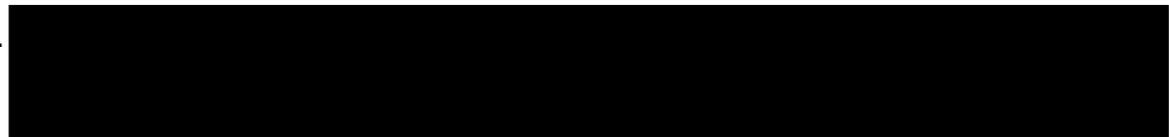
32. It is clear from *Ravensburger AG v OHIM*, Case T-243/08 that the reputation of the earlier mark is not relevant to the assessment of the similarity of the marks, though it is to be taken into account later in the decision, in the global assessment on likelihood of confusion.
33. The earlier mark consists of the phrase 'The King of Soho', in a normal typeface with the capitalisation as shown. No one element is dominant over the other; the phrase hangs together as a unit and the overall impression it conveys is of a pseudo title of nobility relating to Soho.
34. The contested mark consists of the phrase 'King of GIN' in a normal typeface with the capitalisation as shown. Though the element 'GIN' by itself would be weak in relation to spirits, the phrase hangs together and the overall impression it conveys is of a phrase with laudatory connotations, i.e. the best or most important of a particular product, in this case Gin.
35. Visually both marks contain the phrase 'King of' with the same capitalisation, though the earlier mark is preceded by the definite article and the contested mark is not, (though this will not play a hugely significant role). The marks differ in both the number of words (4 versus 3) and the terminal word of each mark. Overall they are visually similar to a medium degree.
36. Aurally the marks would be given their ordinary English pronunciations, being aurally identical in terms of the shared words 'King of', but aurally dissimilar in terms of the terminal words 'Soho' and 'GIN', and I note that the different numbers of syllables will play a not insignificant role here. The definite article will have lesser significance, as it may be dropped altogether when articulating the mark. Overall the marks are aurally similar to a medium degree.
37. Conceptually the marks do both refer to a king, however there are strong conceptual differences both in the identity of that realm, being Soho and Gin, and in that 'The King of Soho' is clearly a person (being *the* King of a geographical region in the traditional sense of the word 'King'), whereas in the mark 'King of GIN' the word 'king' takes on a more laudatory significance, i.e. the best among

the gins. This point is made by the Applicant, who contends that their mark refers to an object whilst the Opponent's mark refers to a person. As a whole therefore, they are conceptually similar to a low degree, if at all.

Distinctive character of the earlier trade mark

38. The Applicant suggests that there can be no rights in the use of the word 'King' as there are too many other marks using that word, and that the word 'Soho' in the Opponent's mark is to be regarded as descriptive as it relates to an area of London. Whilst King does have laudatory connotations and whilst Soho has some geographic connotations, as a whole the mark has at least normal inherent distinctiveness in relation to spirits.

39.



I have no clear view of the market share enjoyed by the product, newly launched as it is. I am unable to say on the basis of the evidence before me that the mark enjoys an enhanced distinctive character.

Conclusions on Likelihood of Confusion.

40. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and vice versa. I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has retained in his mind.

41. The Opponent cited a number of cases. Decisions of the Boards of Appeal are not authoritative, though they may be persuasive. One of the cases cited was *Medion*, referred to above. The present case however, involves an earlier trade mark and a later trade mark which contain a shared element, rather than a mark which contains an element which is identical or similar to an earlier mark. Nevertheless, I note the following. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an

earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.

42. However, *Medion* is not decisive. In *Ancco, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the 'ann taylor' element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.

49 Moreover, even if it were accepted that the 'loft' element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50 Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, prima facie, the existence of a likelihood of confusion between the signs at issue.

43. Bearing in mind the above case law, earlier in the decision I have found that:

- The goods are identical;
- The average consumer is a member of the general public aged over 18 who generally pays a normal level of care and attention during the selection process.
- The marks are visually and aurally similar to a medium degree, and conceptually similar to a low degree, if at all.
- The earlier mark is possessed of a normal degree of inherent distinctive character

44. In the above circumstances, even bearing in mind the consumer's imperfect recollection and the fact that they do not directly compare marks, I nevertheless consider it highly unlikely, despite the commonality of the words 'King of' (which have laudatory connotations), that the marks will be misremembered as one another, particularly as one refers to the King of a place (Soho) and the other refers to the goods. There is no likelihood of direct confusion.

45. In relation to indirect confusion, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10, Mr Iain Purvis Q.C. as the Appointed Person noted 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 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).

46. In terms of indirect confusion, the shared element 'King of' is not so strikingly distinctive of the Opponent that the use of the words in the context of the applied for mark would lead the average consumer to consider 'King of GIN' to be a sub-brand or extension of the Opponent's goods. It is certainly not a natural/logical extension.

Outcome under Section 5(2)(b)

47. The opposition under Section 5(2)(b) fails, and I go on to consider the claim under Section 5(3).

Section 5(3)

48. Section 5(3) of the Act reads:

5(3) A trade mark which

(a) is identical with or similar to an earlier trade mark,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of Community trade mark, in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.

Reputation

49. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and Case C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel*, paragraph 42

e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel*, paragraph 79.

f) Detriment to the distinctive character of the earlier mark occurs when the mark’s ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel*, paragraphs 76 and 77.

g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel*, paragraph 74.

h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV*, paragraph 40.

i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

50. For the opponent to succeed in its claim under Section 5(3) the evidence must show a reputation as at the relevant date (13 May 2014). I set out my findings on the opponent's evidence above. As I noted above, readership and reach of a marketing campaign may be relevant evidence in a case such as this, however



I have no clear view of the market share enjoyed by the product, newly launched as it is. I am unable to say on the basis of the evidence before me that a significant part of the relevant public would have been aware of the mark at the relevant date.

51. In case I am wrong regarding the reputation, I go on to consider whether the relevant public would make a link between the two marks:

52. In my consideration of the same marks under the provisions of section 5(2)(b) of the Act, I found that there is no likelihood of confusion between them. However the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion. In *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in Ferrero v OHMI, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).

53. The respective marks consist of four and three words respectively, with two of those words being shared; 'King of'. I have found the marks to be visually and aurally similar, and conceptually similar to a low degree, if at all. I have found the respective goods to be identical, as are the relevant public and channels of trade. I also found that the earlier mark has only a normal degree of inherent distinctiveness which has not been enhanced through use. Taking these matters into account, I consider the relevant public would not make the necessary link.
54. The second hurdle the opponent has to overcome is therefore not met and the claim under Section 5(3) fails.

Conclusion

55. Though I have focussed on the UK Trade Mark, the Opponent's EU Trade Marks would put them in no better position. The opposition has failed in its entirety, and the application may proceed to registration.

COSTS

56. The Applicant has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Applicant the sum of £1000 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing a statement and considering the other side's statement:	£200
Preparing evidence and considering the other side's evidence:	£500
Preparing submissions in lieu of a hearing:	£300
Total:	£1000

57. I therefore order West End Drinks Limited to pay Jeffrey Joshua Lawrence the sum of £1000. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 27th day of May 2016

Andrew Wall

For the Registrar