

O-229-18

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION No. 3239393

BY SCOTT HASPINEALL

TO REGISTER THE TRADE MARK

STAFF BEER

IN CLASSES 25 & 32

AND

IN THE MATTER OF OPPOSITION

THERE TO UNDER No. 60000717 BY

ROBOT ENERGY LIMITED

BACKGROUND

1) On 24 June 2017, Scott Haspinell (hereinafter the applicant) applied to register the trade mark “staff beer” in respect of the following goods:

In Class 25: Adhesive bras; After ski boots; Aikido suits; uniforms; Albs; Aloha shirts; American football bibs; American football pants; American football shirts; American football shorts; American football socks; Anglers' shoes; Ankle boots; Ankle socks; Anklets [socks]; Anoraks; Anoraks [parkas]; Anti-perspirant socks; Anti-sweat underclothing; Anti-sweat underwear; Après-ski boots; Apres-ski shoes; Aprons; Aprons [clothing]; Aqua shoes; Arm warmers [clothing]; Army boots; Articles of clothing; Articles of clothing for theatrical use; Articles of clothing made of hides; Articles of clothing made of leather; Articles of outer clothing; Articles of sports clothing; Articles of underclothing; Ascots; Ascots (ties); Athletic clothing; Athletic footwear; Athletic shoes; Athletic tights; Athletic uniforms; Athletics footwear; Athletics hose; Athletics shoes; Athletics vests; Babies' clothing; Babies' outerclothing; Babies' pants [clothing]; Babies' pants [underwear]; Babies' undergarments; Babushkas; Baby bodysuits; Baby bottoms; Baby clothes; Baby doll pyjamas; Baby layettes for clothing; Baby pants; Baby tops; Balaclavas; Ball gowns; Ballet shoes; Ballet slippers; Ballet suits; Ballroom dancing shoes; Bandanas; Bandanas [neckerchiefs]; Bandeaux [clothing]; Barber smocks; Baseball caps; Baseball caps and hats; Baseball hats; Baseball shoes; Baseball uniforms; Baselayer bottoms; Baselayer tops; Basic upper garment of Korean traditional clothes [Jeogori]; Basketball shoes; Basketball sneakers; Bath robes; Bath sandals; Bath shoes; Bath slippers; Bathing caps; Bathing costumes; Bathing costumes for women; Bathing drawers; Bathing suit cover-ups; Bathing suits; Bathing suits for men; Bathing trunks; Bathrobes; Bathwraps; Beach clothes; Beach clothing; Beach cover-ups; Beach footwear; Beach hats; Beach robes; Beach shoes; Beach wraps.

In Class 32: Aerated fruit juices; Aerated juices; Aerated mineral waters; Aerated water; Aerated water (Preparations for making -); Aerated water [soda water]; Aerated waters; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Ale; Ales; Aloe juice beverages; Aloe vera drinks, non-alcoholic; Aloe vera juices; Aperitifs, non-alcoholic; Apple juice beverages; Apple juice drinks; Barley wine [Beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Beverages containing vitamins; Beverages (Non-alcoholic -);

Beverages (Preparations for making -); Beverages (Whey -);Bitter lemon; Black beer; Black beer [toasted-malt beer]; Blackcurrant cordial; Blackcurrant juice; Bottled drinking water; Bottled water; Brown rice beverages other than milk substitutes; Carbonated mineral water; Carbonated non-alcoholic drinks; Carbonated water; Carbonated waters; Cider, non-alcoholic; Cocktails, non-alcoholic; Coconut water; Coconut water as a beverage; Coconut-based beverages; Coffee-flavored ale; Coffee-flavored beer; Coffee-flavored soft drinks; Cola; Cola drinks; Colas [soft drinks];Concentrated fruit juice; Concentrated fruit juices; Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Cordials; Cordials [non-alcoholic];Cordials (non-alcoholic beverages);Craft beers; Cranberry juice; Cream soda; De-alcoholised beer; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Distilled drinking water; Douzhi (fermented bean drink);Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Dry ginger ale; Effervescing beverages (Pastilles for -);Effervescing beverages (Powders for -);Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes];Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils];Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils];Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Extracts of hops for making beer; Extracts of unfermented must; Flavor enhanced water; Flavored beer; Flavored beers; Flavored mineral water; Flavored waters; Flavoured carbonated beverages; Flavoured mineral water; Flavoured waters; Frozen carbonated beverages; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages Fruit beverages and fruit juices; Fruit beverages (non-alcoholic);Fruit drinks; Fruit extracts (Non-alcoholic -);Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -);Fruit juice concentrates; Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-based soft drinks flavored with tea; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Functional water-based beverages; Ginger ale; Ginger beer; Glacial water; Grape juice; Grape juice beverages; Grape must, unfermented; Grapefruit juice; Green vegetable juice beverages; Guarana drinks; Guava juice; Honey-based beverages (Non-alcoholic -);Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; Iced fruit

beverages; Imitation beer; India pale ales (IPAs); IPA (Indian Pale Ale); Isotonic beverages; Isotonic beverages [not for medical purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Juice (Fruit -); Juices; Kvass [non-alcoholic beverage]; Kvass [non-alcoholic beverages]; Lager; Lagers; Lemon barley water; Lemon juice for use in the preparation of beverages; Lemon squash Lemonade; Lemonades; Lime juice cordial; Lime juice for use in the preparation of beverages; Liqueurs (Preparations for making -); Lithia water; Low alcohol beer; Low calorie soft drinks; Low-alcohol beer; Low-calorie soft drinks; Malt beer; Malt syrup for beverages; Malt wort; Mango juice; Melon juice; Mineral enriched water [beverages]; Mineral water; Mineral water [beverages]; Mineral water (Non-medicated -); Mineral water (Preparations for making -); Mineral waters; Mineral waters [beverages]; Mixed fruit juice; Mixed fruit juices; Mixes for making sorbet beverages; Must; Nectars (Fruit -), non-alcoholic; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices ; Non-alcoholic beverages containing vegetable juices; Non-alcoholic beverages flavored with coffee; Non-alcoholic beverages flavored with tea; Non-alcoholic beverages flavoured with coffee; Non-alcoholic beverages flavoured with tea; Non-alcoholic beverages with tea flavor; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujonggwa) ; Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit extracts used in the preparation of beverages; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use]; Non-alcoholic punch; Non-alcoholic rice punch (sikhye); Non-alcoholic soda beverages flavoured with tea; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Nutritionally fortified beverages; Nutritionally fortified water; Orange barley water; Orange juice; Orange juice beverages; Orange juice drinks; Orange squash; Orgeat; Pale ale; Part frozen slush drinks; Pastilles for effervescing beverages; Pineapple juice beverages; Pomegranate juice; Porter; Powders for effervescing beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making liqueurs; Preparations for making

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

2) The application was examined and accepted, and subsequently published for opposition purposes on 7 July 2017 in Trade Marks Journal No.2017/027.

3) On 6 October 2017 Robot Energy Limited (hereinafter the opponent) filed a notice of opposition, subsequently amended. The opponent is the proprietor of the following trade mark:

Mark	Number	Dates of filing and registration	Class	Specification relied upon
STAFF	EU 015609191	05 July 2016 PENDING	32	Beer and brewery products; Non-alcoholic beverages; Fruit juice beverages; Waters;

		Priority date; 04.03.16 Priority country: Spain TM from which priority claimed M3602848		Energy drinks; Preparations for making beverages.
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a) The opponent contends that the marks of the two parties are highly similar and the respective goods in class 32 are identical. The opposition does not include the class 25 goods. As such it contends that the application offends against Section 5(2)(b) of the Act.

4) On 10 January 2018 the applicant filed a counterstatement, subsequently amended.

5) Both parties seek an award of costs in their favour. Neither side wished to be heard. Only the opponent provided written submissions which I shall refer to as and when necessary in my decision.

DECISION

6) The first ground of opposition is under section 5(2)(b) which reads:

“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.”

7) An “earlier trade mark” is defined in section 6, the relevant part of which states:

“6.-(1) In this Act an "earlier trade mark" means -

- (a) a registered trade mark, international trade mark (UK) or Community trade mark 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.”

8) The opponent is relying upon its trade mark listed in paragraph 3 above which is clearly an earlier filed trade mark. Given that the opponent’s mark is still pending the proof of use requirement does not bite.

9) When considering the issue under section 5(2)(b) I take into account the following principles which 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the nature of the purchasing process

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

11) The goods at issue in these proceedings are all beverages of one sort or another. The average consumer for such goods will be the public at large, albeit insofar as those goods which have an alcoholic content in excess of 0.5% are concerned, the average consumer will be over the age of 18.

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

“In that respect, as OHIM quite rightly observes, it must be noted that, even if bars and restaurants are not negligible distribution channels for the applicant’s goods, the bottles are generally displayed on shelves behind the counter in such a way that consumers are also able to inspect them visually. That is why, even if it is possible that the goods in question may also be sold by ordering them orally, that method cannot be regarded as their usual marketing channel. In addition, even though consumers can order a beverage without having examined those shelves in advance they are, in any event, in a position to make a visual inspection of the bottle which is served to them.”

13) Consequently, while the goods may be ordered orally in public houses, it is likely to be in the context of, for example, a visual inspection of the bottles containing the goods prior to the order being placed. Considered overall, the selection process is likely to be predominantly a visual one, although I accept that aural considerations will also play their part. Turning now to the level of attention the average consumer will display when selecting the goods, given that for the most part the cost of the goods is likely to be relatively low, but bearing in mind that the average consumer will wish to ensure they are selecting the correct type, flavour, strength etc. of beverage, they are, in my view, **likely to pay at least a reasonable level of attention to the selection of the goods at issue.**

Comparison of goods

14) When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*, the CJEU stated at paragraph 23 of its judgement:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

15) Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

16) In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved

a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

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

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 *Oberhauser v OHIM – Petit Liberto (Fifties)* [2002] ECR II-4359, paragraphs 32 and 33; Case T110/01 *Vedial V OHIM France Distribution (HUBERT)* [2002] ECR II-5275, paragraphs 43 and 44; and Case T- 10/03 *Koubi v OHIM – Flabesa (CONFORFLEX)* [2004] ECR II-719, paragraphs 41 and 42).”

18) Taking the above into account it is my opinion that the following goods of the two parties are identical as the detailed terms of the applicant’s specification are encompassed by the more general terms of the opponent’s specification.

Opponent’s goods	Applicant’s goods
Beer and brewery products	Ale; Ales; Barley wine [Beer]; Beer; Beer and brewery products; Beer wort; Beer-based beverages; Beer-based cocktails; Beers; Beers enriched with minerals; Black beer; Black beer [toasted-malt beer]; Coffee-flavored ale; Coffee-flavored beer; Craft beers; Douzhi (fermented bean drink); Flavored beer; Flavored beers; Imitation beer; India pale ales (IPAs); IPA (Indian Pale Ale); Lager; Lagers; Low alcohol beer; Malt beer; Pale ale; Porter; Stout; Stouts; Wheat beer;
Non-alcoholic beverages	Aerated juices; Alcohol free aperitifs; Alcohol free beverages; Alcohol free cider; Alcohol free wine; Alcohol-free beers; Aloe vera drinks, non-alcoholic; Aloe juice beverages; Aloe vera juices; Aperitifs, non-alcoholic; Beverages containing vitamins; Beverages (Non-alcoholic -); Bitter lemon; Brown rice beverages other than milk substitutes; Carbonated non-alcoholic drinks; Cider, non-alcoholic; Cocktails, non-

alcoholic; Coffee-flavored soft drinks; Cola; Cola drinks; Colas [soft drinks]; Cordials; Cordials [non-alcoholic];Cordials (non-alcoholic beverages); Cream soda; De-alcoholised beer; De-alcoholised wines; De-alcoholized beer; De-alcoholized drinks; De-alcoholized wines; Dry ginger ale; Flavoured carbonated beverages; Frozen carbonated beverages; Ginger ale; Ginger beer; Green vegetable juice beverages; Guarana drinks; Honey-based beverages (Non-alcoholic -); Juices; Kvass [non-alcoholic beverage];Kvass [non-alcoholic beverages]; Lemon barley water; Lemon squash Lemonade; Lemonades; Low calorie soft drinks; Non-alcoholic beer; Non-alcoholic beer flavored beverages; Non-alcoholic beverages; Non-alcoholic beverages containing fruit juices ; Non-alcoholic beverages containing vegetable juices; Non-alcoholic beverages flavored with coffee; Non-alcoholic beverages flavored with tea; Non-alcoholic beverages flavoured with coffee; Non-alcoholic beverages flavoured with tea; Non-alcoholic beverages with tea flavor; Non-alcoholic carbonated beverages; Non-alcoholic cinnamon punch with dried persimmon (sujeonggwa) ;Non-alcoholic cocktail bases; Non-alcoholic cocktail mixes; Non-alcoholic cocktails; Non-alcoholic cordials; Non-alcoholic drinks; Non-alcoholic flavored carbonated beverages; Non-alcoholic honey-based beverages; Non-alcoholic malt beverages; Non-alcoholic malt drinks; Non-alcoholic malt free beverages [other than for medical use];Non-alcoholic punch; Non-alcoholic rice punch (sikhye);Non-alcoholic soda beverages flavoured with tea; Non-alcoholic sparkling fruit juice drinks; Non-alcoholic vegetable juice drinks; Non-alcoholic wine; Non-alcoholic wines; Non-carbonated soft drinks; Nut and soy based beverages; Orange barley water; Orange squash; Orgeat; Part frozen slush drinks; Pastilles for effervescing beverages; Powders for effervescing beverages; Quinine water; Ramune (Japanese soda pops); Red ginseng juice beverages; Rice-based beverages, other than milk substitutes; Root beer; Root beers; Root beers, non-alcoholic beverages; Sarsaparilla [non-alcoholic beverage]; Seltzer water; Shandy; Sherbet beverages; Sherbets [beverages];Slush drinks; Smoothies; Smoothies containing grains and oats; Smoothies [fruit beverages, fruit predominating];Smoothies [non-alcoholic fruit beverages];Soda pops; Soda water; Soft drinks; Soft drinks flavored with tea; Sorbets [beverages];Sorbets in the nature of beverages; Soy beverage; Soya-based beverages, other than milk substitutes; Soy-based beverages, not being milk substitutes; Squashes [non-alcoholic beverages]; Tomato juice [beverage];Tomato juice beverages; Tonic water; Tonic

	<p>water [non-medicated beverages];Unfermented preserved must; Vegetable drinks; Vegetable juice; Vegetable juices [beverage];Vegetable juices [beverages];Vegetable smoothies; Vegetable-based beverages; Vitamin fortified non-alcoholic beverages;</p>
Fruit juice beverages	<p>Aerated fruit juices; Apple juice beverages; Apple juice drinks; Beverages consisting of a blend of fruit and vegetable juices; Beverages consisting principally of fruit juices; Blackcurrant cordial; Blackcurrant juice; Concentrated fruit juice; Concentrated fruit juices; Cranberry juice; Frozen fruit beverages; Frozen fruit drinks; Frozen fruit-based beverages; Frozen fruit-based drinks; Fruit beverages Fruit beverages and fruit juices; Fruit beverages (non-alcoholic); Fruit drinks; Fruit extracts (Non-alcoholic -); Fruit flavored drinks; Fruit flavored soft drinks; Fruit flavoured carbonated drinks; Fruit flavoured drinks Fruit juice; Fruit juice bases; Fruit juice beverages; Fruit juice beverages (Non-alcoholic -); Fruit juice concentrates; Fruit juice for use as a beverages; Fruit juices; Fruit nectars; Fruit nectars, non-alcoholic; Fruit smoothies; Fruit squashes; Fruit-based beverages; Fruit-based soft drinks flavored with tea; Fruit-flavored beverages; Fruit-flavored soft drinks; Fruit-flavoured beverages; Grape juice beverages; Grape must, unfermented; Grapefruit juice; Grape juice; Guava juice; Iced fruit beverages; Juice (Fruit -); Lime juice cordial; Mango juice; Melon juice; Mixed fruit juice; Mixed fruit juices; Nectars (Fruit -), Non-alcoholic fruit cocktails; Non-alcoholic fruit drinks; Non-alcoholic fruit extracts; Non-alcoholic fruit juice beverages; Non-alcoholic fruit punch; Non-alcoholic grape juice beverages; Orange juice; Orange juice beverages; Orange juice drinks; Pineapple juice beverages; Pomegranate juice; Smoked plum beverages; Smoked plum juice beverages; Watermelon juice;</p>
Waters	<p>Aerated mineral waters; Aerated water; Aerated water [soda water]; Aerated waters; Bottled drinking water; Bottled water; Carbonated mineral water; Carbonated water; Carbonated waters; Coconut water; Coconut water as a beverage; Coconut-based beverages; Distilled drinking water; Drinking mineral water; Drinking spring water; Drinking water; Drinking water with vitamins; Drinking waters; Flavor enhanced water; Flavored mineral water; Flavored waters; Flavoured mineral water; Flavoured waters; Functional water-based beverages; Glacial water; Lithia water; Mineral enriched water [beverages];Mineral water; Mineral water [beverages];Mineral water (Non-medicated -); Mineral waters; Mineral waters [beverages]; Nutritionally fortified</p>

	water; Sparkling water; Spring water; Spring waters; Still water; Still waters; Table water; Table waters; Vitamin enriched sparkling water [beverages]; Water; Water (Lithia -);Water (Seltzer -);Water-based beverages containing tea extracts; Waters; Waters [beverages];Waters (Table -);
Energy drinks	Beverages (Whey -); Energy drinks; Energy drinks containing caffeine; Energy drinks [not for medical purposes]; Isotonic beverages; Isotonic beverages [not for medical purposes]; Isotonic drinks; Isotonic non-alcoholic drinks; Nutritionally fortified beverages; Protein-enriched sports beverages; Soft drinks for energy supply; Sports drinks; Sports drinks containing electrolytes; Whey beverages.
Preparations for making beverages.	Aerated water (Preparations for making -); Beverages (Preparations for making -); Concentrates for making fruit drinks; Concentrates for making fruit juices; Concentrates for use in the preparation of soft drinks; Concentrates used in the preparation of soft drinks; Effervescing beverages (Pastilles for -);Effervescing beverages (Powders for -); Essences for making beverages; Essences for making flavoured mineral water [not in the nature of essential oils]; Essences for making non-alcoholic beverages; Essences for making non-alcoholic beverages [not in the nature of essential oils];Essences for making non-alcoholic drinks, not in the nature of essential oils; Extracts for making beverages; Extracts for making non-alcoholic beverages; Extracts of hops for making beer; Extracts of unfermented must; Hop extracts for manufacturing beer; Hop extracts for use in the preparation of beverages; Hops (Extracts of -) for making beer; Lemon juice for use in the preparation of beverages; Lime juice for use in the preparation of beverages; Liqueurs (Preparations for making -); Mineral water (Preparations for making -); Malt syrup for beverages; Malt wort; Mixes for making sorbet beverages; Must; Non-alcoholic fruit extracts used in the preparation of beverages; Powders for the preparation of beverages; Powders used in the preparation of coconut water drinks; Powders used in the preparation of fruit-based beverages; Powders used in the preparation of fruit-based drinks; Powders used in the preparation of soft drinks; Preparation for making non-alcoholic beverages; Preparations for making aerated water; Preparations for making beverages; Preparations for making liqueurs; Preparations for making mineral water; Syrup for making beverages; Syrup for making lemonade; Syrups for beverages; Syrups for lemonade; Syrups for making beverages; Syrups for making flavoured mineral waters; Syrups for making fruit-flavored drinks; Syrups for making non-alcoholic beverages; Syrups for making soft

	drinks; Syrups for making whey-based beverages; Syrups used in the preparation of soft drinks;
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19) The goods of the two parties are identical.

Comparison of trade marks

20) 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 them, bearing in mind their distinctive and dominant components. 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.”

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

Opponent’s trade mark	Applicant’s trade mark
STAFF	staff beer

22) The fact that the opponent’s mark is in upper case and the applicant’s in lower case would not be noticed by the average consumer. Both marks would be permitted to use both upper and lower case as part of their fair and normal use. Clearly, the whole of the opponent’s mark appears as the first word in the applicant’s mark. The applicant’s mark also has the word “beer”. There is obviously a degree of visual and aural similarity from the first word, but also some differences visually and aurally because of the presence of the second word in the applicant’s mark. The word “beer” is clearly

descriptive when used upon “beer” products, but when used upon goods such as “water” it would seem odd to the average consumer. I do not believe that the two words in the applicant’s mark form a unit, or that either affects the meaning of the other. Conceptually there is some similarity and also a degree of difference. **Overall I believe the marks to be similar to a medium degree.**

Distinctive character of the earlier trade mark

23) 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).”

24) The opponent’s mark consists of the single, well known dictionary word “STAFF”. This could be taken to mean the people working in an establishment, or to a wooden club/walking stick. **To my mind, the earlier mark is of average inherent distinctiveness but cannot benefit from enhanced distinctiveness through use as no evidence has been provided.**

Likelihood of confusion

25) 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 trade marks may be offset by a greater degree of similarity between the respective goods and vice versa. As I mentioned above, it is also necessary for me to keep in mind the distinctive character of the opponent's trade mark as the more distinctive this trade mark is, the greater the likelihood of confusion. 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 trade marks and must instead rely upon the imperfect picture of them he has retained in his mind. Earlier in this decision, I concluded that:

- the average consumer is a member of the general public (including businesses), who will select the goods by predominantly visual means, although not discounting aural considerations and that they will pay at least a reasonable degree of attention to the selection of such items.
- the opponent's marks have an average degree of inherent distinctiveness but cannot benefit from an enhanced distinctiveness through use.
- the goods of the two parties in class 32 are identical.
- the marks of the two parties are similar to a medium degree.

26) In view of the above, and allowing for the concept of imperfect recollection, there is a likelihood of consumers being confused into believing that the class 32 goods applied for under the mark in suit and provided by the applicant are those of the opponent or provided by some undertaking linked to it. **The opposition under Section 5(2) (b) in respect of the opponent's class 32 goods therefore succeeds in full.**

CONCLUSION

27) As the decision is conditional upon the opponent's mark gaining registration for the full specification sought, the issue of costs will be dealt with once the parties have informed the Registry of the outcome of the registration process in OHIM. The appeal period will similarly be determined once the final decision is issued.

Dated this 11th day of April 2018

**George W Salthouse
For the Registrar,
the Comptroller-General**