

O/437/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003337630
BY HALEWOOD INTERNATIONAL BRANDS LIMITED
TO REGISTER THE TRADE MARK:**

WILLOW

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001065 BY
THE WILLOW TREE DISTILLING COMPANY LIMITED**

BACKGROUND AND PLEADINGS

1. On 11 September 2018, Halewood International Brands Limited (“the applicant”) applied to register the trade mark **WILLOW** in the UK. The application was published for opposition purposes on 16 November 2018. Registration is sought for the following goods:

Class 33 Alcoholic beverages (except beer); spirits.

2. The application is opposed by The Willow Tree Distilling Company Limited (“the opponent”) by way of the Fast Track opposition procedure commenced on 15 February 2019. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on UK registration no. 3229160 for the trade mark **Willow Tree Gin**. The earlier mark was filed on 5 May 2017 and registered on 11 August 2017. The opponent relies upon all goods for which the mark is registered, namely:

Class 33 Gin.

3. The opponent submits that the respective goods are identical or similar and that the marks are similar.

4. The applicant filed a counterstatement denying the claim made.

5. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008, but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

6. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. In its counterstatement, the applicant requested permission to file evidence and stated as follows:

“The applicant further contends that there are numerous marks on the register in Classes 32 & 33 which contain the word WILLOW, and the table attached details these. Whilst we know that the state of the register is no reflection on the marketplace, the fact that these marks coexist without incident shows that the word WILLOW is one which is commonly adopted by drinks companies. The applicant requests permission to file evidence of the products on the market in the UK which include the word WILLOW in their names.”

7. On 17 May 2019, the Registry wrote to the parties as follows:

“I acknowledge receipt of the Form TM8 received on 7th May 2019 which contained a request to file further evidence in this case.

The Registry’s preliminary view is that the request should be refused. Having carefully considered the reasons for the request, the Registry’s view is that these reasons are not sufficient to justify the filing of further evidence in this case. The existence of multiple products using variations of the name WILLOW on the market does not demonstrate an awareness on the part of consumers that these products originate from different undertakings. It is not, therefore, clear how this evidence will assist the applicant.

In accordance with paragraph 10 of Tribunal Practice Notice 2/2011, if you disagree with the preliminary view you should request a hearing within fourteen days from the date of this letter, that is, on or before 31 May 2019.

If no response is received within the time allowed, the preliminary view will automatically be confirmed.”

8. No hearing was requested and so the Registry’s preliminary view stands.

9. Both parties are unrepresented.

10. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings

requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary; both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

PRELIMINARY ISSUE

11. Notwithstanding the Registry's decision to refuse the applicant's request to file evidence of other marks on the register which contain the word WILLOW and the applicant's decision not to challenge that refusal the applicant has made reference to this in its written submissions in lieu.

12. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court ("GC") 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)."

13. For the avoidance of doubt, when assessing the likelihood of confusion under section 5(2)(b), it is necessary to consider the potential for conflict between the applied for mark and the earlier mark in light of all the relevant circumstances. It is clear from the case law, that the existence of other trade marks on the register is not relevant to the decision I must make.

DECISION

14. Section 5(2)(b) of the Act states 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.”

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

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

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

(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.”

16. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provision. As the opponent's trade mark had not completed its registration process more than 5 years before the date of the application in issue in these proceedings, it is 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

17. 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 greater degree of similarity between the marks, and vice versa;

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

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

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

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

Comparison of goods

18. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 33</u> Gin.	<u>Class 33</u>

	Alcoholic beverages (except beer); spirits.
--	--

19. I note that in its written submissions, the applicant states as follows:

“The specification of the application does of course cover gin, however it also covers all other alcoholic drinks. The applicant submits that only gin is identical, and that the other alcoholic drinks cannot be confusingly similar with the goods of the opponent’s mark, as the opponent’s mark cannot cover anything but gin, given that gin is included within the mark. The Applicant therefore submits that the other alcoholic drinks within the specification cannot be held similar with the goods of the opponent’s mark.”

20. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the 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.”

21. “Gin” in the opponent’s specification falls within the broader categories of “Alcoholic beverages (except beer)” and “spirits” in the applicant’s specification. These goods can, therefore, be considered identical on the principle outlined in *Merica*. The fact that the applicant’s specification may also cover additional goods does not prevent the goods from being considered identical. In any event, the other goods covered by the applicant’s specification would be highly similar to the opponent’s goods because they would overlap in trade channels, users, uses, method of use and nature. There may also be a degree of competition between them.

The average consumer and the nature of the purchasing act

22. 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.”

23. I have no submissions from either party on the identity of the average consumer or the nature of the purchasing process for the goods in issue. In my view, the average consumer for the goods will be a member of the general public who is over the age of 18. The goods may also be purchased by businesses. There will be various factors taken into consideration in deciding which goods to purchase such as flavour, age and alcohol content. However, the goods will not be excessively expensive and are likely to be purchased reasonably frequently. I therefore consider that a medium degree of attention will be paid during the purchasing process.

24. The goods are most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. I acknowledge that verbal advice may be sought from a sales assistant or representative. Alternatively, the goods may be purchased from bars or restaurants. In these circumstances, the goods are likely to be purchased following perusal of a drinks or wine list or following perusal of the goods themselves on a shelf behind a bar¹. Consequently, visual considerations will

¹ *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*, Case T-187/17

dominate the selection process, although I do not discount that there will also be an aural component to the purchase of the goods.

Comparison of trade marks

25. 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 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.”

26. 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.

27. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
Willow Tree Gin	WILLOW

28. I have no substantive submissions from the opponent on the similarity of the marks, other than that they are confusingly similar. In its counterstatement, the applicant states:

“It is denied that the mark of the application, WILLOW, is similar with the earlier mark, WILLOW TREE GIN. The earlier mark comprises three words, totalling four syllables and thirteen letters. The mark of the application is a single word of six letters. The marks differ visually and phonetically to a great extent. Furthermore, conceptually, the opponent’s mark has a meaning of a type of tree, and of gin. The applicant’s mark is only Willow, and this has several meanings, a tree, a wood, a slender thing, a type of blossom. There is no reference to gin in the applicant’s mark. Although it is admitted that the marks share the element WILLOW, the other elements contained in the earlier mark give it a very different concept and render it different visually and phonetically also.”

29. The applicant’s mark consists of the word WILLOW. There are no other elements to contribute to the overall impression which lies in the word itself. The opponent’s mark consists of the words WILLOW TREE GIN. The word GIN will be viewed by the consumer as descriptive of the goods for which the mark is registered and will, therefore, play a lesser role in the overall impression. The words WILLOW TREE will play a greater role.

30. Visually, the marks coincide in the presence of the word WILLOW. They differ in the presence of the words TREE and GIN in the opponent’s mark which have no counterpart in the applicant’s mark (although, as noted above, the word GIN will be viewed as descriptive). I consider the marks to be visually similar to a medium degree.

31. Aurally, the word WILLOW will be given its ordinary English pronunciation and will be pronounced identically in both marks. The words TREE and GIN in the opponent’s mark will also be given their ordinary English pronunciation, but have no counterpart in the applicant’s mark. It may be the case that the word GIN would not be articulated at all by some consumers due to its descriptive nature which would increase the aural

similarity between the marks. Consequently, I consider the marks to be aurally similar to at least a medium degree.

32. Conceptually, the words WILLOW TREE in the opponent's mark will be seen as a reference to a particular type of tree. The word GIN will be viewed as a descriptive reference to the goods in respect of which the mark is used. The Cambridge English Dictionary provides only one definition for the word WILLOW:

“A tree that grows near water and has long, thin branches than hang down, or wood from this tree.²”

33. I consider that it is this meaning that will be identified by the average consumer when viewing the applicant's mark. The marks will, therefore, be conceptually highly similar or identical. The applicant suggest that it may also be viewed as “a slender thing” or “a type of blossom”. The applicant's reference to “a slender thing” is, in my view, a reference to the word “willowy³” rather than the word “willow”. I consider it unlikely that it will be viewed as a reference to a type of blossom and the applicant has provided no further explanation or evidence as to why this might be the case.

Distinctive character of the earlier trade mark

34. 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-

² <https://dictionary.cambridge.org/dictionary/english/willow>

³ <https://dictionary.cambridge.org/dictionary/english/willowy>

108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 1-2779, 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 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).”

35. 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.

36. I have no submissions from the parties on the distinctive character of the earlier mark. The opponent has not pleaded that it's mark has acquired enhanced distinctiveness through use and has filed no evidence to support such a finding. I can, therefore, only consider the mark's inherent distinctiveness. The words WILLOW TREE are ordinary dictionary words which are neither descriptive nor allusive for the goods in issue. The word GIN, as noted above, is descriptive. I consider the mark to be inherently distinctive to at least a medium degree.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods 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 needs 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 necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

38. I have found the marks to be visually and aurally similar to a medium degree and conceptually highly similar or identical. I have found the opponent's mark to have at least a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who is over the age of 18 or a business user, who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be medium. I have found the parties' goods to be identical.

39. Bearing in mind the visual, aural and conceptual similarities between the marks, I consider that they will be mistakenly recalled as each other. This is particularly the case given that the opponent's mark is inherently distinctive to at least a medium degree and, as a general rule, the beginnings of marks tend to make more impact than the ends⁴. The concept of the willow tree is likely to act as a hook in the minds of the consumer in respect of both marks. Even if there are some consumers who identify a different meaning in the word WILLOW in the applicant's mark, in my view, a significant proportion of average consumers will identify it as a reference to a type of tree. If there is a likelihood of confusion amongst a significant proportion of the public displaying the characteristics attributed to an average consumer for the goods, then this is sufficient for a finding of confusion⁵. I consider there to be a likelihood of direct confusion.

⁴ *El Corte Ingles, SA v OHIM*, Cases T-183/02 and T-184/02

⁵ See *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation* [2016] EWCA Civ 41 and *Soulcycle Inc v Matalan Ltd* [2017] EWHC 496 (Ch)

CONCLUSION

40. The opposition is successful, and the application is refused in its entirety.

COSTS

41. Awards of costs are governed by Tribunal Practice Notice 2/2015. The opponent has been successful and would normally be entitled to a contribution towards its costs. However, as the opponent is unrepresented, at the conclusion of the evidence rounds the tribunal wrote to the opponent and invited it to indicate whether it intended to make a request for an award of costs. The opponent was informed that, if so, it should complete a pro-forma, providing details of its actual costs and accurate estimates of the amount of time spent on various activities in the prosecution of the opposition. The opponent was informed that “if the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded”. The opponent did not file a completed pro-forma and, in its written submissions in lieu, stated “I will not be pursuing costs”. That being the case, I award the opponent the sum of £100 in respect of the opposition fee only.

42. I therefore order Halewood International Brands Limited to pay The Willow Tree Distilling Company Limited the sum of **£100**. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

Dated 26 July 2019

S WILSON

For the Registrar