

**O-629-20**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3388507  
IN THE NAME OF BREWDOG PLC FOR THE TRADE MARK**

**ROGUE WAVE**

**IN CLASS 33**

**AND**

**APPLICATION NO. 3419747 IN THE NAME OF BREWDOG PLC  
FOR THE TRADE MARK**

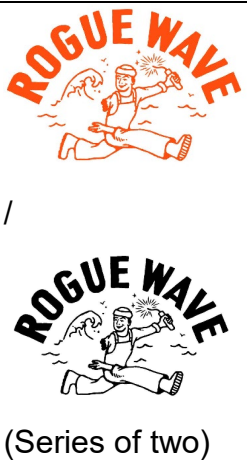


(Series of two)

**THE CONSOLIDATED OPPOSITIONS THERETO UNDER NUMBERS 416942 &  
418723  
BY OREGON BREWING COMPANY**

## Background and pleadings

1. **BrewDog plc** (the applicant) applied to register two trade mark applications in the UK for the trade marks set out in the table below. The trade marks were accepted and published in the Trade Marks Journal on the dates shown, in respect of the goods and services outlined below:

Application number	Trade Mark	Application Date	Publication date	Goods
3388507	ROGUE WAVE	01/04/2019	12/04/2019	Class 33: Alcoholic beverages (except beers); cider; flavoured ciders; beer-flavoured cider; spirits; liqueurs; distilled beverages; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; rum; pre-mixed alcoholic beverages, other than beer-based; pre-mixed alcoholic cocktails.
3419747	 (Series of two)	07/08/2019	13/09/2019	Class 33: Alcoholic beverages (except beers); cider; flavoured ciders; beer-flavoured cider; spirits; liqueurs; distilled beverages; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; rum; pre-

				mixed alcoholic beverages, other than beer-based; pre-mixed alcoholic cocktails.
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2. **Oregon Brewing Company** (the opponent) opposes both trade marks on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (the Act). In both instances, this is on the basis of its three earlier trade marks as set out in the table below:

Registration number	Territory of registration	Trade Mark	Application /priority date	Registration date	Goods
2126640	UK	ROGUE	13/03/1997	22/05/1998	Class 32: Beer, ale, stout, porter, lager.
824813	EU	ROGUE	19/11/1997	25/08/1999	Class 32: Malted beverages, namely lagers, ales and barleywine; and ciders.
10716157	EU	ROGUE	12/03/2012	24/07/2012	Class 33: Distilled spirits.

3. The opponent argues that the respective goods are identical or similar and that the marks are similar. The opponent argues that the earlier mark is contained in the applicant's mark in full, and that there is a likelihood of confusion between the same.
4. The applicant filed a counterstatement in each opposition, denying the claims made and denying that the opponent has a valid basis for the oppositions under Section 5(2)(b) of the Act, and requesting that the opponent provides proof of use of its earlier trade marks relied upon.

5. By way of a letter dated 28 April 2020, the Tribunal wrote to the parties directing the consolidation of proceedings under Rule 62(1)(g) of the Trade Marks Rules 2008, following a request received by the opponent dated 27 April 2020.
6. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered necessary.
7. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful perusal of the papers.
8. The opponent is represented in these proceedings by Potter Clarkson LLP. The applicant is represented by Lawrie IP Limited.

## **Evidence**

### Evidence filed by the opponent

9. The opponent filed evidence in these proceedings firstly by way of an Affidavit in the name of Brett Joyce as current company director and former president of the opponent, and Exhibits A – R.
10. Within the Affidavit, Mr Joyce explains he became the president of the opponent in 2007 and held the position until 31 December 2018. Mr Joyce explains he has been on the Board of Directors for the opponent since 2008. Mr Joyce explains that all beer products produced by the opponent are sold under the ROGUE trade mark, which he describes as a “house mark”. Mr Joyce explains that between 1 April 2014 – 31 March 2019 (the “Time Period”) the opponent sold beers in the UK in both bottles and kegs, and occasionally in cans. He explains that all types of packaging for the opponent’s bottled beer products prominently display the ROGUE house

mark, and lists the UK product range during the “Time Period” as below, but noting there were also others:

- ROGUE Dead Guy Ale
- ROGUE Juniper Pale Ale
- ROGUE Mocha Porter
- ROGUE Hazelnut Brown Nectar
- ROGUE Brutal IPA
- ROGUE American Amber Ale
- ROGUE Yellow Snow IPA
- ROGUE Shakespeare Oatmeal Stout
- ROGUE 7 Hop IPA
- ROGUE Honey Kolsch
- ROGUE 4 Hop IPA
- ROGUE Santa’s Private Reserve
- ROGUE Fresh Roast
- ROGUE Outta Line

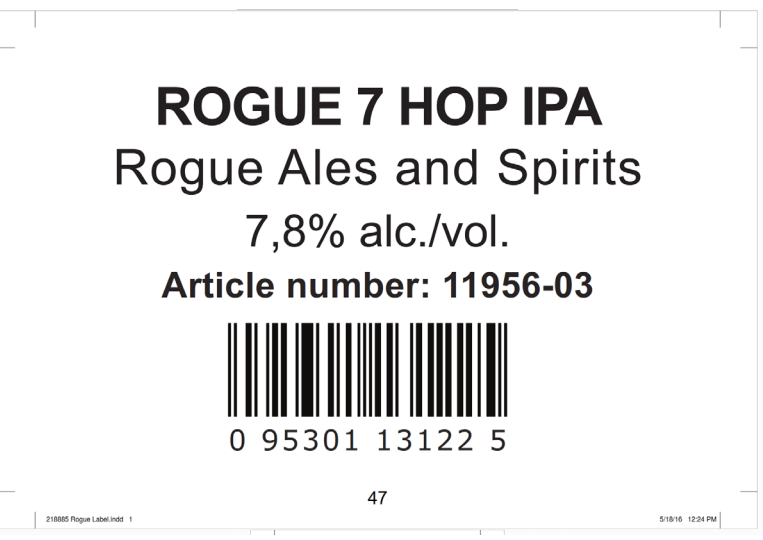
11. Exhibit A includes examples of labels of the goods described above, and I have set out some examples of those provided below:





216088 Rogue\_EURO\_7HopIPA.indd 1

21916 8:07 AM



218885 Rogue Label.indd 1

5/18/16 12:24 PM



12. Several more examples of packaging are included within Exhibit A.

13. Mr Joyce explains that **Exhibit B** consists of a selected sample of “Tap Badges” and “Tap Handles” used with kegs in the UK market during the “Time Period”. Examples of the images included in Exhibit B are below:



14. Several further images have been shown using various illustrations and

varieties of the mark **ROGUE** under this exhibit.

15. **Exhibit C** includes images of the opponent’s beer products, and Mr Joyce explains this illustrates how the packaging on products sold to the UK changed between 2014 & January 2019. Mr Joyce explains that “ROGUE Dead Guy Ale” changed its packaging during this time, but that the artwork on other beer products remained the same. It is not clear which images are from which timeframe mentioned from the exhibit.

16. Mr Joyce has provided sales figures for ROGUE beers sold in the EU during the “Time Period” as shown in the table below. Mr Joyce explains that the figures have been rounded to the closest thousand USD and represent sales to importers/distributors.

Country	Beer
Italy	\$843,000
United Kingdom	\$766,000
Netherlands	\$1,061,000
France	\$734,000
Portugal	\$4,000
Ireland	\$14,000

Germany	\$441,000
Spain	\$90,000
Finland	\$67,000

Total (appx): \$4,020,000

17. **Exhibit D** consists of a selection of invoices showing sales to customers named as follows:

- Cremin & Radley Drinklink, Cork, Ireland (Invoice date 31 March 2014)
- Euroboozer Limited, UK (Invoice date 9 May 2014, 22 June 2015, 31 March 2015, 4 January 2016, 26 January 2016, 25 March 2016, 14 July 2017)
- Bacchanalia Wine Merchant, Cambridge UK (Invoice date 30 May 14, 16 December 2014, 27 February 2015, 26 June 2015, 22 September 2015, 3 March 2016)
- Cerveteca Lisboa, Portugal (Invoice date 21 October 2014)
- Brewdog Bars Limited, UK (Invoice date 14 October 2014) – total invoice 0.00
- International Beers & Beverages, France (Invoice date 30 October 2015)
- James Clay & Sons, UK (Invoice date 29 August 2018, 31 October 2018, 7 November 2018, 5 February 2019)
- Condal Chef, S.L., Spain (Invoice date 28 April 2017)


18. Whilst the shipping address on most of the invoices above matches the billing address, the shipping address on a selection of the invoices shown is in the US. Mr Joyce explains that even where a US address shows in the “SHIP TO” section of these invoices, these were ultimately shipped to the location shown in the “BILL TO” section, as follows:


“A few of the invoices in **Exhibit D** have a “P/U Rogue Brewery, NEWPORT, OR 97365 United States” (or similar language) address in the “SHIP TO” portion. This is an internal recordkeeping item to reflect the fact that OBC’s international shipping terms for its beers are typically *ex works* Newport or Portland, OR, USA (meaning that risk of



loss for the products shifts to the importer at those locations). Beers on any invoice in **Exhibit D** with an OR, USA address in the “SHIP TO” section were shipped to the importer listed in the country indicated in the “BILL TO” section.”

19. The invoices provided all show sales of goods including various beers shown in images provided amongst other exhibits, and Mr Joyce points out in particular the reference to “DEAD GUY ALE” and “NUT BROWN”, the labels for which, Mr Joyce confirms, are shown in Exhibit A, and have been reproduced within the Affidavit. In addition, I note some of the invoices also reference goods including “DEAD GUY WHISKEY”, “SPRUCE GIN”, “PINK GIN”, “OR SINGLE MALT WHISKEY” and “VOODO VODKA”. All of the

invoices provided clearly display the mark  at the top of the page.

20. **Exhibit E** consists of images that Mr Joyce confirms are “examples bottles of beers from the range of ROGUE spirits that were sold in the UK in 2014”. The images provided under this exhibit are from the opponent’s website [www.rogue.com](http://www.rogue.com) and are provided via web archiving site the Wayback Machine. The images show various beers using the  mark and are labelled October 27, 2014.

21. **Exhibit G** provides images from the opponent’s social media, documenting promotional activity that Mr Joyce confirms took place “in Spain on November 5, 2015; the Netherlands on March 4, 2016; the UK on May 12, 2017; and Italy on June 6, 2018”.

22. **Exhibit F** contains a number of promotional articles. The first is on the webpage entitled “We Brought Beer” discussing the opponent’s ROGUE beer. The article is followed by a London address and shows a date of April 16<sup>th</sup>, 2015, and the web address has been provided by Mr Joyce, as shown in the list below. There is a second article dated 24 February 2015 on

[www.dailymail.co.uk](http://www.dailymail.co.uk) discussing the opponent's products primarily in relation to its Sriracha Hot Stout Beer under the **ROGUE** trade mark, and stating "The independent brewery prides itself on handcrafted ales, porters, stouts, lagers and spirits." The third article provided is dated March 14, 2016 and discusses the UK launch of Rogue IPAs on a site named 'bar'. An Article from the Independent naming the "10 best American beers" dated 30 June 2016 has been provided, referencing "Rogue Ales, Dead Guy Ale" at number 10. An event page for "American Beer Tasting with Rogue Ales" at a bar in Leeds on 9 February 2017 has been provided, including specific reference to pale ales and barley wine. Finally, an online article from the Metro has been provided, dated 2 December 2014. There is reference to ROGUE ales and spirits, and comment that the Rogue Sriracha hot stout beer is available to pre-order, with the price converted from US dollars into GBP. The web addresses have not been shown on the Exhibits themselves, but have been provided by Mr Joyce as follows:

- (<https://www.webroughtbeer.co.uk/a-bunch-of-rogues/>)
- (<https://www.dailymail.co.uk/femail/food/article-2966932/American-brewers-create-fierybeer-chilli-sauce-say-mouth-burning-brew-goes-SPICY-food.html>)
- (<https://barmagazine.co.uk/uk-launch-for-ipas-from-oregon-rogue-ales-using-eight-hopvarieties-euroboozer/>)
- (<https://www.independent.co.uk/extras/indybest/food-drink/best-americanbeer-july-4th-independence-day-2016-list-brands-ranked-a7111086.html>)
- (<https://www.leedsinspired.co.uk/events/american-beer-tasting-rogue-ales>)
- (<https://metro.co.uk/2014/12/02/rogue-sriracha-hot-stout-beer-is-here-yep-chilli-sauce-stout-is-now-a-thing-4971277/>)

23. **Exhibit G** consists of an article that appears to be in Italian, which makes

reference to ROGUE, **ROGUE** and . At the top of the article, images of beers using the two stylised marks are shown. The article doesn't appear to be dated. Mr Joyce explains this an advertisement placed by the opponent's

Italian importer, Ales & Co, in a May 2018 issue of *Il Mondo Della Birra*, a beer-focused magazine.

24. **Exhibit H** includes 4 photographs, including one undated image of a drinks list including 4 ROGUE beers written in English, and one undated image of ROGUE boxes in a warehouse. A third photograph provided shows ROGUE beers in a shop, displaying items in GBP and with the date 15 September 2017 stamped on the boxes shown in the image. The fourth is an undated image of ROGUE beers in a shop. The currency used is unclear. Mr Joyce elaborates on the images provided in his affidavit as follows:

“These examples include a December 2017 menu for a Barcelona restaurant, Napar BCN, showing ROGUE beer (the labels for the beer listed can be found in Exhibit A); cases of ROGUE beer bottles on hand at Condal Chef, a Barcelona distributor, in December 2017; ROGUE beer for sale on January 2, 2018 at a Whole Foods in London, UK; ROGUE beer for sale on January 4, 2018 at a beer retail location in Paris, FR.”

25. **Exhibit I** consists of a letter dated 3 July 2019 letter from one of the opponent’s importers in Italy, Ales & Co srl, Castello d/Argile (BO) Italy. The letter states that Ales & Co. has imported and distributed “Rogue Ales & Spirits” since 2013 in Italy. **Exhibit J** is a similar letter from the opponent’s Denmark importer One Pint Brand A/S, stating they are selling Rogue Ales & Spirits into the following territories:

Country	start date	status	channels
Austria	Aug-18	regular sales	local distributor selling to on- and off-trade
Croatia	Aug-18	regular sales	local distributor selling to on- and off-trade
Czech Republic	Aug-17	regular sales	local distributor selling to on- and off-trade
Slovakia	Aug-17	regular sales	local distributor selling to on- and off-trade
Denmark	Apr-16	regular sales	own sales organisation selling to on- and off-trade
Faroe Islands	Apr-16	regular sales	local distributor selling to on- and off-trade
Georgia	Jun-19	new customer	local distributor selling to on- and off-trade
Germany	Apr-16	regular sales	own sales organisation selling to on- and off-trade
Netherlands	May-18	no order since March 2019	local distributor selling to on- and off-trade
Norway	Jun-19	new customer	local distributor selling to off-trade
Portugal	Jun-17	regular sales	local distributor selling to on- and off-trade
Slovenia	Dec-18	regular sales	own sales organisation selling to on- and off-trade

26. **Exhibit K** lists awards won by the opponent's Rogue Beers. Mr Joyce explains these were all won in EU competitions during the "Time Period". The table provided names awards issued from 2014 – 2018 from the following:

- European Beer Star;
- World Beer awards;
- Brussels Beer Challenge;
- Meininger's International Craft Beer Awards;
- World Beverage Competition

27. There are 27 awards listed in 2014, 4 from 2015, 3 from 2016, 5 from 2017 and 8 from 2018 for ROGUE beers.




28. Mr Joyce goes on to discuss ROGUE spirits in his affidavit, stating these are all "sold under the ROGUE trademark as a "house mark."". Mr Joyce confirms:

"The product range of ROGUE spirits sold in the UK in the Time Period included the following:

- ROGUE Dead Guy Whiskey
- ROGUE Hazelnut Spice Rum
- ROGUE Oregon Single Malt Whiskey
- ROGUE Oregon Single Malt Vodka
- ROGUE Spruce Gin
- ROGUE VooDoo Vodka
- ROGUE Pink Gin
- ROGUE Dark Rum"

29. Mr Joyce explains "Exhibit L are images showing how the ROGUE mark was displayed on its distilled spirits products sold in the UK for each year during the Time Period". **Exhibit L** displays marketing material (or "sell sheets") showing images of the following:

- Rye whiskey with dates of “2014” & “9/8/16”, dated 2015 & “9/8/16” 2016 & “9/8/16”, “2017” & “9/8/16”, “2018”, “2019”;
- Single malt vodka with dates of “5.15.13” & “2014” & “5.15.13” & “2015”, “5.15.13” & “2016”;
- Hazelnut spiced rum with dates of “6.13.12” & “2014” and “6.13.12” & “2015”, “6.13.12” & “2016”, “6.13.12” & “2017”;
- Spruce Gin dated “2014”, “2015”, “2016”, “2017”, “2018”, “2019”;
- Single malt whiskey with dates of “2014” & “6.14.12” and “2015” & “6.14.12”, “2017” & “7/27/15”, “2018”, “2019”;
- ‘Oak barrel’ whiskey dated “12-4-2009” & “2014” and 2015 & “12-4-2009”, “2016”, “2017”, “2018”, ”2019”,
- Stouted whiskey dated “2019”

30. All of the images shown in this exhibit use the marks ,  or  on the bottles and marketing material, and refer to Rogue or Rogue Spirits in word format within the text. Mr Joyce explains that in the years when product packaging did not change, the opponent typically used the same “sell sheet” as in previous years.

31. Mr Joyce provides the following sales figures for spirits “bearing the ROGUE mark” in the EU as follows:

Location of Importer	Spirits	Volume (in liters)
Italy	\$3,000	108
United Kingdom	\$10,000	340
Netherlands	\$13,000	540
France	\$1,000	27
Germany	\$38,000	1,620

Total: \$65,000  
2,635 liters

32. Mr Joyce confirms the figures are rounded to the closest thousand US dollars.

33. **Exhibit M** consists of a selection of invoices to customers in the following locations:

- Bierevolution SARL, France (Invoice date 8 April 2014)
- Bacchanalia Wine Merchant, UK (Invoice date 30 May 2014, 16 December 2014, 7 November 2014, 19 May 15, 22 September 2015, 23 June 2016)
- Euroboozer Limited, UK (Invoice date 13 August 2014, 31 March 15, 7 October 2015, 18 August 2016, 31 October 2016)
- Ales & Co. Italy (Invoice dated 27 February 2015)
- Bier & Co Amsterdam, Netherlands (Invoice dated 27 July 15)
- One Pint A/S, Denmark (Invoice date 29 February 2016, 15 August 2015, 17 October 2016, 28 December 2018)
- Diamond Beer, Finland (Invoice dated 31 January 2018, 19 March 2018, 8 June 2018)

34. The invoices provided list a range of spirits being sold to the parties above on the dates above, including whiskey, gin, vodka and rum. Again, on occasion the shipping address does not match the invoicing address, but Mr Joyce confirms all products were shipped to the addresses featured in the invoice addresses. In addition, I note there are some invoices which show a 0.00 balance, which appear to relate to samples provided, and it looks likely both from the invoice and the sales figures provided that the spirits appearing on the invoices relating to Finland were for sampling and were not charged.

35. Mr Joyce also explains as follows:

“Some of OBC’s [the opponent’s] importers to whom ROGUE spirits were shipped operated in markets beyond their receiving location. For example, ROGUE spirits shipped to One Pint A/S headquarters in Denmark may have been subsequently sold not only in Denmark but also in other EU countries such as Belgium, Germany, or Sweden”

36. **Exhibit N** consists of screenshots from the opponent's website [www.rogue.com](http://www.rogue.com) from internet archiving site Wayback Machine. The sites shown on the Wayback Machine date from 10 April 2014, and use the marks

ROGUE / ROGUE &  .

37. **Exhibit O** provides screenshots of twitter posts sharing a “@MetroUK” article promoting “@Rogueales” Spruce Gin, as well as a post showing “@rogueales spirits” from “@euroboozer”.

38. Mr Joyce describes **Exhibit P** as “photographs of ROGUE spirits being sold at retail in the EU during the Time Period”. Images showing the spirits are shown in the photographs, but no date or location can be identified from the Exhibit itself.

39. **Exhibit Q** shows promotional articles referring to Rogue gin, on “Metro” online dated 19 January 2016, and ROGUE whiskey on [whiskys.co.uk](http://whiskys.co.uk) which appears to be undated. Mr Joyce confirms the web addresses as “<https://metro.co.uk/2016/01/19/the-10-best-american-gins-you-should-bedrinking-5617825/>” and “<http://www.whiskymerchants.co.uk/rogue-spirits/4536549052>” in his affidavit.

40. Finally, **Exhibit R** lists what Mr Joyce describes as “awards for ROGUE spirits from competitions in the EU”. This list details 16 awards for 2014, 16 awards for 2015, 5 awards for 2016, 3 awards in 2017 and 3 awards in 2018. The awards are spread across vodka, whiskey, gin and rum from the following:

- International Spirits Challenge;
- International Wine & Spirits Competition;
- World Rum Awards;
- World Whiskies and Spirits Conference;
- Gin Masters;
- American Whiskey Masters;
- Luxury Masters;

- World Beverage Competition;

41. Also filed by the opponent is a witness statement in the name of Sarah Janella Barr of Potter Clarkson LLP, the opponent's representative in these proceedings. The witness statement attaches two exhibits, namely Exhibit SJB/1 and Exhibit SJB/2.

42. **Exhibit SJB/1** contains an extract from the Cambridge English Dictionary giving several definitions of the word ROGUE. I have condensed the pages provided to give the main definitions provided below:

**behaving in ways that are not expected or not normal, often in a way that causes damage:**

- a *rogue state*
- *rogue cells*

**A rogue animal is a dangerous wild animal that lives apart from the rest of its group.**

▶ go rogue

informal

**to start behaving in a way that is not normal or expected, especially by leaving your group and doing something dangerous:**

old-fashioned humorous

**a person who behaves badly but who you still like:**

- *"Come here, you little rogue!" chuckled my uncle.*
- *The women all think he's a **lovable** old rogue.*

**a person, organization, or country that does not behave in the usual or acceptable way:**

- *Buzzy's a fun-loving teenage rogue.*

**behaving in ways that are not expected or not normal, often in a harmful way:**

- *There have been rogue firms in the past which have ripped customers off.*
- a *rogue state*



## rogue

He complained that they sheltered 'idle rogues and vagabonds' and complained of their promiscuity and filthy practices.

From [Cambridge English Corpus](#)



In these cases, the nonhuman comes in the form of a *rogue* comet or asteroid, shattering the stability of the human world.

From [Cambridge English Corpus](#)



43. **Exhibit SJB/2** includes articles from various online news and information outlets described in the witness statement as:

Huffington Post – January 2020

Oregon News – January 2020

San Francisco Chronicle – January 2016

Oregon Live – March 2019

Wikipedia entry for Sneaker waves

44. The articles and information pages provided describe incidences and dangers of “ROGUE WAVES” and “SNEAKER WAVES” in the US. The information provided from Wikipedia explains that an “American oceanographer distinguishes “rogue waves” as occurring on the ocean and sneaker waves as occurring at the shore”.

Evidence filed by the applicant

45. The evidence filed by the applicant consists of a witness statement in the name of Sharon Mackinson and Exhibits SM1-SM3, and a second witness statement in the name of Rachel Denholm and Exhibits RD01 – RD03.

46. Within her witness statement, Ms Mackinson states she is of Lawrie IP Limited, the representative for the applicant.


47. **Exhibit SM1** provided consists of an extract from Collins dictionary, defining the words *rogue* and *rogue wave* in the following terms:

# rogue

Word Frequency ○○○○○



(rɒg )

Word forms: plural rogues 

## 1. COUNTABLE NOUN

A **rogue** is a man who behaves in a dishonest or criminal way.

*Mr Ward wasn't a rogue at all.*

Synonyms: scoundrel [*old-fashioned*], crook [*informal*], villain, fraudster [More Synonyms of rogue](#)

## 2. COUNTABLE NOUN [oft. adjective NOUN]

If a man behaves in a way that you do not approve of but you still like him, you can refer to him as a **rogue**.

[*feelings*]

*...Falstaff, the loveable rogue.*

## 3. ADJECTIVE [ADJECTIVE noun]

A **rogue** element is someone or something that behaves differently from others of its kind, often causing damage.

*Computer systems were affected by a series of rogue viruses.*

*The rogue male is not a twentieth-century phenomenon.*

## Definition of 'rogue wave'

# rogue wave



## in British English

(rəʊg weɪv)

## NOUN


a sudden huge wave

*A huge rogue wave hit the ship in the Indian Ocean.*

*Collins English Dictionary. Copyright © HarperCollins Publishers*

## Examples of 'rogue wave' in a sentence

# rogue wave

 These examples have been automatically selected and may contain sensitive content. [Read more...](#)

*It caught him like a rogue wave, a big sea surging up from the depths, unexpected, overwhelming.*

*MARK MILLS AMAGANSETT (2004)*

*A rogue wave caught Rollo broadside, slapping the wind from his lungs, sending him sprawling.*

*MARK MILLS AMAGANSETT (2004)*

48. **Exhibit SM2** consists of an article from bbc.com discussing “rogue waves”, as well as the “Wikipedia” page discussing rogue waves.

49. **Exhibit SM3** describes the applicant’s reasoning for choosing the mark ROGUE WAVE, the meaning behind the name and the applicant’s associations with the North Sea.

50. Ms Denholm’s Witness statement also states she is of Lawrie IP, the representative for the applicant. The content of Exhibits RD01 – RD03 is the same as the content provided under SM1-SM3, and so I will not provide further detail.

## Proof of use

### 51. Relevant statutory provision: Section 6A:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period .

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

52. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co*

*KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other

goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

53. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

54. The burden is on the opponent to show genuine use of the earlier marks as requested, in respect of the goods as registered and within the relevant territory and the relevant timeframes.

### **Form of the mark**

55. Prior to conducting an analysis of the evidence filed in order to determine if there has been genuine use of the registered marks, it is necessary to review the instances where the proprietor has used the mark in conjunction with additional elements, or in a varying form to the mark as shown on the register, in order to determine if these instances should be classed as use ‘of the mark’ for the purpose of the assessment. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”.

56. In *Nirvana Trade Mark*, BL O/262/06, Mr Richard Arnold Q.C. (as he then was), sitting as the Appointed Person, summarised the test under section 46(2) of the Act as follows:



“33. ...The first question [in a case of this kind] is what sign was presented as the trade mark on the goods and in the marketing materials during the relevant period...

34. The second question is whether that sign differs from the registered trade mark in elements which do not alter the latter’s distinctive character. As can be seen from the discussion above, this second question breaks down in the sub questions, (a) what is the distinctive character of the registered trade mark, (b) what are the differences between the mark used and the registered trade mark and (c) do the differences identified in (b) alter the distinctive character identified in (a)? An affirmative answer to the second question does not depend upon the average consumer not registering the differences at all.”

57. Although this case was decided before the judgment of the CJEU in *Colloseum*, it remains sound law so far as the question is whether the use of a mark in a different form constitutes genuine use of the mark as registered. The later judgment of the CJEU must also be taken into account where the mark is used as registered, but as part of a composite mark.

58. In the the judgment of the Court of Appeal in *Specsavers* [2014] EWCA Civ 1294, it was confirmed that the use of a registered mark with another element, be it use in conjunction with, or as a part of the mark, may be considered as use of the mark as registered even where part of the original mark is covered, for instance by an element that has been superimposed over the registered mark, provided that the distinctive character of the mark as registered is not altered, and that registered element it is perceived by the consumer as indicating the commercial origin of the goods.<sup>1</sup>

59. Where ROGUE is used as a trade mark on its own in word format within the opponent’s evidence, it is clear this will be acceptable use of the marks as registered. However, the opponent also shows use of the mark in various

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<sup>1</sup> See paragraphs 24 & 34

stylisations and combinations in respect of the above goods. I have considered the relevant variants as used by the opponent below:

#### Variant 1



**ROGUE**<sup>®</sup>

60. This variant of the opponent's mark is used on the majority of the products, advertising material and invoices provided in evidence. The colours used in the above mark vary, sometimes with the star being used in the same colour as the text, and sometimes in an alternative colour, such as is shown above. I find this to be use of the trade mark as registered, namely ROGUE, used in conjunction with a star mark (with at best a very low level of distinctiveness) placed within the O. In my view, the use of the word ROGUE maintains an independent role within the combination of the ROGUE mark and star mark and will still be used separately from the star by consumers to designate the commercial origin of the goods, meaning the mark is an acceptable variant in line with *Colloseum*. However, should it be the case that due to the overlap of the star with the element ROGUE this is not to be classed as use of the mark ROGUE independently, I find that the distinctive character of the registered mark, which is held in ROGUE, is not altered by the use of the star in this way, and the registered mark will be perceived by the consumer as indicative of the origin of the goods, and I would therefore find this to be an acceptable variant of the registered mark in line with *Nirvana* and *Specsavers*.

#### Variant 2



61. In my view the above mark is use of the trade mark as registered, namely ROGUE, in conjunction with other elements, and it should therefore be assessed in line with Colloseum. In my view, although the element ROGUE is used within a stylised X and S, and within the sentence HAVE A ROGUE XSPERIENCE, I find that due to the placement of ROGUE, as well as the use within the expression (which indicates that the experience originates from the goods under the trade mark ROGUE), ROGUE will still act in its own right as an indicator of the commercial origin of the goods in this instance. I therefore find this to be an acceptable variant of the mark.

### Variant 3



62. I find this to be use of variant 1 above, alongside the word SPIRITS which descriptive of the goods on which it is used. For this reason, and the reasons set out under variant 1 above, I find this to be an acceptable variant of the mark.

### Variant 4



63. Again, I find this to be use of variant 1 above, in addition to the elements FARMS and the wording GROW THE REVOLUTION. I find the ROGUE element maintains its ability to be viewed by the consumer as the indicator of the commercial origin of the products, and that the elements FARMS will be seen as a having little distinctiveness, namely indicating the FARMS run under the ROGUE trade mark, which grow the produce used in the production of the goods, and GROW THE REVOLUTION as a slogan used in conjunction

with the trade mark. I find this use to be acceptable variant use of the trade mark as registered, in line with *Colloseum*.

## **GENUINE USE**

64. Before I begin to analyse the proof of use filed in respect of the earlier marks, I note the applicant has made the following submissions:

“In summary, it is not accepted that the information and evidence provided by the Opponent is sufficient to demonstrate that the ROGUE mark has been used in the UK and the EU within the relevant period. Specifically, it is not accepted that the mark has been used on barleywine and ciders as covered by EU trade mark registration no. 824813 or in connection with distilled spirits as covered by EU trade mark registration no. 010716157.”

65. I note these are repeated within the applicant’s final written submissions as follows:

““For the reasons already specified in the Applicant’s earlier submissions, it is the Applicant’s position that the Opponent has failed to demonstrate use of its marks for all goods, in the relevant time periods and within the relevant territory. In particular, it is submitted that the Opponent has not demonstrated use in respect of barleywine and ciders covered by EU Trade Mark Registration No. 824813, or in connection with distilled spirits covered by EU Trade Mark Registration No. 010716157.”

66. Although I note the applicant makes reference to the evidence (or lack thereof) in relation to specific goods, I do not find these comments to be an express admission that the mark has been used in respect of the goods not specified, and so I will not take this as such. I must therefore assess whether the opponent has shown genuine use for the mark as specified, in respect of the goods as registered. As the three earlier marks are identical and all

subject to proof of use, there is no need to distinguish between these other than in terms of territory when assessing the goods. The goods for which the opponent must prove use may therefore be categorised as follows:

**ROGUE in the EU**

*Class 32: Malted beverages, namely lagers, ales and barleywine; and ciders.*

*Class 33: Distilled spirits.*

**ROGUE in the UK**

*Class 32: Beer, ale, stout, porter, lager.*

67. I also note at this stage that the applicant has made submissions on each piece of evidence provided by the opponent, often stating why each item filed is not relevant or does not show use. The comments made focus on the inability of each document to show use in the timeframe, or within the territory, or of the mark, or in respect of one or more of the goods for which the use is claimed. Within its final submissions, the opponent has responded on this point, stating that the applicant appears to have based its arguments on an individual assessment of each item of the evidence, rather than on the evidence in its entirety. Whilst I have considered each point that the applicant has put forward in its submissions, I agree with the opponent that I must assess the evidence based on the picture of use that has been established by the sum of the same. Whilst I will therefore consider the applicant's criticisms of each item of evidence filed, I note at this stage that this will only confirm a lack of genuine use if I find that the sum of the evidence as a whole does not satisfy me that genuine use of the mark, or an acceptable variant, has been made within the relevant territory, within the relevant timeframe, and in respect of the goods as registered by the opponent.

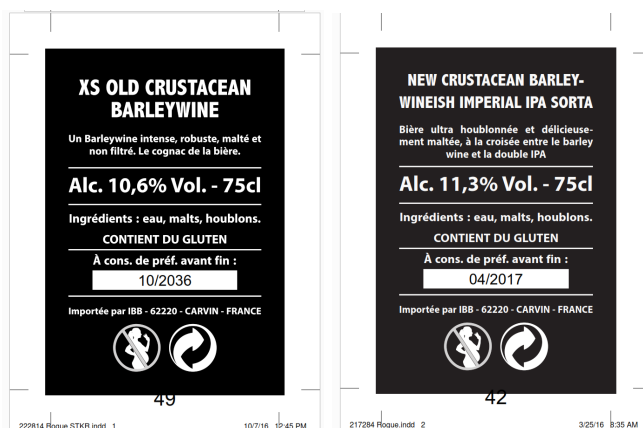
68. As mentioned above, all three earlier marks relied upon by the opponent are subject to proving use in this opposition, and the relevant date under Section 6A of the Act is five years prior to the date of application of each contested mark. The relevant period for proving use in this opposition is therefore between 2 April 2014 – 1 April 2019 in respect of the applicant’s word mark and the 8 August 2014 – 7 August 2019 in respect of the applicant’s logo mark.

### Ciders

69. None of the evidence provided by the opponent relates to the promotion or sale of ciders by the opponent. I therefore find no genuine use in respect of these goods.

### Barley wine (EU)

70. Within its evidence, the opponent has provided labels<sup>2</sup> mentioning Barley Wine and Barley “wineish” as shown below:



71. Although these images do not make use of the mark ROGUE, the following images have also been provided in the evidence showing packaging for the barley wine and barley “wineish” (as described above) as well as a description of the products<sup>3</sup>, as below:

<sup>2</sup> Exhibit A

<sup>3</sup> Exhibit C



## OLD CRUSTACEAN BARLEYWINE STYLE ALE

DECEMBER–JANUARY

An unfiltered and unfinned Barleywine. Intense, robust, malty and dark.  
The cognac of beers.

750 ml Ceramic Bottle & Draft • 9 Ingredients • 24° P • 105 IBU • 78 AA • 50° L • 10.6% ABV



## New Crustacean

Year Round

John Maier, our Brewmaster, wanted to create a beer that defied traditional style definitions, resulting in a remarkably hoppy yet balanced and malty ale. It was not quite a Barleywine and not quite a Double or Imperial IPA. But who really cares about putting beers into narrow categories? Great beer is great beer.

Painted 750 ml bottle • 8 Ingredients  
24° PLATO • 88 IBU • 83 AA • 13° L • 11.6% ABV

72. As the “New Crustacean” beverage is described as “not quite a Barleywine” by the opponent itself, it is my view that it cannot be found to be evidence towards use of the mark for barley wine. The evidence relating to the “New Crustacean” will therefore not be considered towards use of barley wine.

73. Although I note that the product “Old Crustacean” is also described as “Barleywine Style Ale”, it is clearly referred to on the packaging as XS OLD CRUSTACEAN BARLEYWINE”, and in its description as “An unfiltered and unfinned Barleywine”. I am therefore satisfied that this evidence relates to barley wine.

74. Within the opponent’s evidence, there is reference to the opponent’s barley wine in the context of a tasting event taking place in Leeds on 9 February 2017<sup>4</sup>. This also includes an image of the product XS OLD CRUSTACEAN BARLEYWINE displaying an acceptable variant mark. This Exhibit indicates that the opponent’s barley wine was available for tasting within the UK (at least within Leeds), within the relevant time period.

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<sup>4</sup> Exhibit F

75. I also note that the image used on the ‘taps’ for the sale of barley wine also uses ROGUE in variants I have found to be acceptable. Whilst the image itself appears to be undated and without reference to territory, Mr Joyce has explained in the affidavit that the “tap badges and tap handles” shown were for the UK market during the “Time Period”, which he has set out earlier as being between 1 April 2014 – 31 March 2019. I note at this stage that Mr Joyce sets out at the beginning of his affidavit that where he references the UK it includes the EU and vice versa, but as the UK is in the EU it is not clear if this reference is intended to cover territories outside of the UK.

76. In addition to the above, I note that sales of the opponent’s barley wine, which has been shown to use an acceptable variant of the mark, have been made in the UK and Portugal. These sales are evidenced on the invoices provided<sup>5</sup>, where “XS Old Crustacean” is referred to on the following occasions throughout the invoices in respect of the two relevant time periods:

- On 21 October 2014 Cerveteca in Portugal was invoiced for one case (6 x 750ml per case);
- On 16 December 2014 Bacchanalia Wine Merchants in the UK were invoiced for 2 cases (6 x 750ml per case);
- On 27 February 15, Bacchanalia Wine Merchants in the UK were invoiced for 3 cases (6 x 750ml per case);
- On 31 March 2015, Euroboozer in the UK were invoiced for 11 cases (6 x 750ml per case);
- On 22 June 2015, Euroboozer in the UK were invoices for 10 cases (6 x 750ml per case).

77. In addition to the use of the mark on the packaging of the barley wine products themselves, I note also that the invoices provided display an acceptable variant of the ROGUE trade mark on the same.

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<sup>5</sup> Exhibit D



78. I note that Mr Joyce has explained that the invoices provided are exemplary only, which appears to suggest that there may be sales of barley wine in addition to those listed above, within the relevant time period. However, I also note that no sales figures have been provided in relation to barley wine only. It is unclear whether the sales of barley wine make up a significant portion of the figures mentioned under beers, and if this applies in each territory for which sales of beers have been shown.

79. From the sum of the evidence, I find it is clear there has been some sales of barley wine under an acceptable variant of the mark, within the relevant territory, within the relevant timeframe. However, outside of the above, there has been only limited reference to the sale of barley wine by the opponent in the affidavit or the exhibits provided. Further, I note that none of the awards mentioned reference the barley wine product, and that no marketing spend has been provided in respect of the same.

Beer, ale, stout, porter, lager (UK)

80. The opponent has registered protection for the above goods within the UK, in addition to protection for lager and ales within the EU. As the two earlier marks are identical, should the opponent establish genuine use of lager and ale in the UK I will not go on to consider the proof of use provided in the context of the EU, as this will add nothing to the strength of the opponent's case. Should this not be established in the UK, I will go on to consider if alternatively, genuine use has been established for these goods in the context of the EU.

81. In respect of the UK, the opponent has provided 16 invoices relating to the sale of various types of beers including various ales, IPAs, stouts and porters and lager to the UK. The invoices all show the mark **ROGUE**<sup>®</sup>, which I have found to be an acceptable variant of the mark as registered, and clearly link to products shown to bear the same mark. Of these invoices to the UK, all 16 fall within the relevant time period for proving use in respect of the applicant's

word mark, and 14 of these fall within the relevant date for proving use for the logo mark. I note that not all of the invoices are as useful, for example, the invoice issued to Euroboozer Limited in the UK dated 9 May 2014 does not include the second page showing the invoice total, and the invoice issued to Brewdog Bars Limited on 14 October 2014 shows the total as 0.00, indicating the items shipped were likely promotional samples. However, several of the invoices issued to the UK during this time appear to be for thousands of USD, to three different UK customers. Whilst I note some reference to spirits has been made on the invoices in Exhibit D, it is clear from the references that the vast majority of the sales under the invoices provided within Exhibit D are for the ales, IPAs, stouts and porters. References to the sale of lager on the invoices are more limited, but the sale of ROGUE Hot Tub Lager features on an invoice to Euroboozer in the UK 14 July 2017. The invoices provided are spread across the relevant period between 2014 - 2018.

82. As mentioned, the sales shown during the relevant timeframes on the invoices to the UK can be linked to products showing the opponent's mark in an acceptable variant in the rest of the evidence. Images of the packaging relating to ale, porter, stout and lager are provided, all of which Mr Joyce has confirmed in his affidavit were sold in the UK during the time period.

83. I note that Mr Joyce has not differentiated between the types of beer within the sales figures provided, and has instead grouped these in one. Further, I note that these have simply been provided in respect of sales "during the Time Period", which as I mentioned, Mr Joyce has referenced as between the 1 April 2014 – 31 March 2014, the relevant time period in respect of the opposition against the word mark only. However, whilst this includes a period that is outside of the relevant timeframe for the logo mark, it is my view that on balance, and with reference to the invoices falling within both timeframes, it is clear a large portion of the figures provided will fall into the relevant time periods for both marks. The figures provided for sales of 'beer' to the UK during this time period are as below:

United Kingdom	\$766,000
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84. In addition to the above, the articles provided by the opponent shown on various '.co.uk' websites helps to establish that the opponent's beers had a presence within the UK during the relevant time frame. I note one promotional article dated 16 April 2015 (within both relevant timeframes) from "webroughtbeer.co.uk" states:

"We currently have a huge range of Rogue Ales in store, including pales, ambers, IPAs & stouts.."

85. The article shows images of various ales as well as the "Double Chocolate Stout" and the "Mocha Porter" on display within the shop. In addition, the launch of the new "Sriracha HOT Stout" is discussed on the dailymail.co.uk in an article dated 24 February 2015, again within both relevant timeframes. The article appears to be directed at a UK audience, converting the USD price into GBP, and explaining the beer can be purchased from rogue.com.

86. In my view, considering the sum of the evidence provided, it is clear there has been use of acceptable variant of the mark by the opponent in respect of beer, ale, stout, porter and lager within the UK within the relevant timeframe.

#### Distilled spirits - EU

87. Mr Joyce dedicated the second half of his affidavit, as well as Exhibits L onwards to the use of its mark in respect of spirits. There are many references are made to 'spirits' only, and I note at this stage that I am aware that the goods as filed are 'distilled spirits'. I have considered that there may be occasions where spirits are not 'distilled', but I am unaware of when or if this may occur. However, it is not only is it my understanding that distilling is part of the process, at least in respect of the majority of spirits available, but I also note that the evidence provided by the opponent at Exhibit L describes the spirits to which the evidence relates as 'distilled', made at the 'distillery', or

made by ‘distillers’ on many occasions. It is my view that I made attribute the use described and shown in relation to spirits, as use in relation to distilled spirits in this instance.

88. As a reminder, within the affidavit, Mr Joyce has provided the sales figures in respect of spirits sold under the ROGUE mark in the EU within the “Time Period” (which, as mentioned, Mr Joyce has specified only as 1 April 2014 – 31 March 2019), as follows:

Location of Importer	Spirits	Volume (in liters)
Italy	\$3,000	108
United Kingdom	\$10,000	340
Netherlands	\$13,000	540
France	\$1,000	27
Germany	\$38,000	1,620

Total: \$65,000  
2,635 liters

89. Examples of invoices showing the sales of the spirits are provided at Exhibit M. In this exhibit, 21 invoices have been provided, all of which fall within the relevant time frame in respect of the word mark, and 19 of which fall within the relevant time frame for the logo mark. The only invoice relating to sales in France is in the relevant time frame for the logo mark only. I note also that invoices relating to sales in Finland have been provided, but the invoices for this territory appear to be totalling \$0.00 and no total sales figures have been provided. Again, the invoices show discrepancies between the invoicing address and the shipping address on occasion, but Mr Joyce has again explained that the shipping destination of all of the products shown are the “invoice address”.

90. In general, the invoices provided are spread out fairly across the majority of the relevant period, however, I note that the invoices provided for some territories are more concentrated. For example, the invoices provided in Finland are all from 2018, whereas the UK invoices are concentrated between 2014 – 2016.

91. The invoices list the sales of a variety of spirits including gin, whisky, rum and vodka. The products listed on the invoices provided match with the packaging shown within Exhibit N, all of which show acceptable variants of the earlier mark. Within his affidavit, Mr Joyce has confirmed the photographs show how the packaging was in the EU in 2014, and are an "...example only and are merely meant to illustrate the manner in which OBC's ROGUE spirits that are sold in the EU is packaged and to indicate the identity of between the bottles as they were sold in the EU and the invoices for those sales, as indicated ...". Exhibit L also shows the packaging used for the spirits through the relevant time frames, dated up to 2019 in relation to gin and whisky, 2017 for rum and up to 2016 in relation to vodka, all showing acceptable variants of the mark. Mr Joyce explains in his affidavit that the packaging shown at Exhibit L is as used in the UK during each year of the "Time period". The sum of the Exhibits N, L and M clearly show sales of the goods under the relevant marks, both on the packaging and invoices, within the relevant territory and in both relevant time periods.

92. In addition to the above, an article dated 19 January 2016 talks favourably about the opponent's ROGUE Spruce Gin, showing the product clearly using an acceptable mark, as well as mentioning the opponent's Voodoo Maple Vodka which uses an acceptable variant of the mark. Mr Joyce gives the web address of the article in his affidavit as a .co.uk address, and there are references to the UK both in the text of the article and through the use of '£' when referring to prices. This evidence helps to furnish the picture of use in both time frames created by the evidence.

93. Now that I have established the goods for which use has been made of the mark (or an acceptable variant) by the opponent, within the relevant territory, within the relevant time period, I will consider if I find this to be sufficient to qualify as genuine use in respect of the goods as registered.

94. Whilst I note there is no de minimums rule for finding genuine use in the UK or the EU, use must not be solely for the purpose of preserving the opponent's rights (namely token use) and must instead be for the real commercial

exploitation of the mark in the relevant market. I must also remember that not every instance of commercial use may be found to be genuine use.<sup>6</sup> In making my assessment I am required to consider all relevant factors to establish if the use is genuine, including:

- i) The scale and frequency of the use shown
- ii) The nature of the use shown
- iii) The goods and services for which use has been shown
- iv) The nature of those goods/services and the market(s) for them
- iv) The geographical extent of the use shown

95. In respect of the opponent's barley wine, from the sum of the evidence, I have found there has certainly been some use of an acceptable variant in respect of these goods in the EU within the two relevant timeframes.

96. However, I do find there is information that I require for my assessment of genuine use that is missing from the sum of the evidence, namely information on the scale and frequency of the use, as well as the geographical extent of the same. I cannot find with any certainty that the use of the mark in respect of barley wine extends across the EU. Whilst it has been shown there is a small amount of use at least in the UK, and a very small amount of use in Portugal, the sales that I can confidently pin to the goods, particularly in Portugal are so small they add little to the picture. Further, there is nothing to back up there has been any additional commercial exploitation in this territory. Whilst I accept that in the right circumstances, the use of a mark even in only one territory may be accepted as genuine use across the EU, I note that in this case the amount of the goods sold is also unclear. As Mr Joyce has made reference to the invoices being exemplary, it may well be that more sales of barley wine have taken place across the EU than the 27 cases shown on the

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<sup>6</sup> See decision in *Jumpman* BL O/222/16, Mr Daniel Alexander QC, as the Appointed Person, upheld the registrar's decision to reject the sale of 55k pairs of training shoes through one shop in Bulgaria over 16 months as insufficient to show genuine use of the EU trade mark in the European Union within the relevant 5 year period.

invoices, but as I have mentioned it is impossible to tell the extent to which the sales figures for beer provided relate to barley wine.

97. It is not my view that the use appears token, purely for the purpose of maintaining the registration. The sale of barley wine by the opponent appears entirely consistent with its broader business and seems to me more likely that these goods simply occupy a very small amount of the opponent's business in the territory. However, it is my view that I cannot attribute enough commercial activity for these goods within the territory of the EU throughout the relevant periods to establish genuine use in this instance.
98. Considering the question of genuine use in respect of ale, stout, porter, and lager in the UK, I find that some of the criticisms I have made in respect of the evidence for barley wine also apply here. I have again found that the evidence shows at least some use of the mark (or an acceptable variant), in respect of the goods, in respect of the relevant territory and timeframes, but as I have mentioned above, the sales figures given by Mr Joyce have not been broken down beyond 'beers', and it is unclear exactly which proportion of these relate to stout, ales, porters or lager.
99. However, in this case there are a number of UK invoices clearly displaying the sale of many more of these goods within the UK within both the relevant time periods, particularly in relation to ales, stouts and porters. I also note that in the case of ales, stouts and porter, there are many references to these throughout Mr Joyce's affidavit. It appears clear from the picture of the evidence that stouts, ales and porters form a significant part of the opponent's business and in turn sales figures under 'beers' in the UK. This evidence is furnished with articles such as those at Exhibit D showing stouts, ales and porters as available for purchase within the UK within the relevant timeframe, under the mark. This is in addition to the images of the packaging showing the use of the mark itself on these goods, and images of the goods on sale in the market. I note that the market is undoubtedly large for these goods in the UK, but I find that the picture created by the sum of the evidence is that the opponent has made real commercial exploitation of the mark in the UK market

for these goods, and as such has made genuine use of its mark in respect of the same.

100. There is more doubt in my mind as to the extent of the commercial exploitation for lager in the UK within the relevant time periods. In my view, the lack of certainty on the sale of lager into the UK means from the evidence provided I am unable to find genuine use in respect of the same when it is considered alone. With reference to genuine use for lager in the EU, whilst I find a fraction more evidence by way of limited sales of Dirtoir Lager in Portugal under the mark, I do not find this sufficient to show genuine use in the EU for lager.

101. However, as I have found that genuine use has been made in respect of porter, ale and stout, which I find are all types of beer, I find genuine use has also been shown, and is indeed more substantial, in respect of beer as a wider category in the UK.

102. Moving on to the use found in respect of spirits, I note that once again I must assess if the use I have found constitutes genuine use in the context of the EU, with consideration to the factors set out in paragraph 94 above. One element that I find assists me in this respect is that the sales figures have been defined in respect of spirits and the territories in which they have been sold. As these figures are defined by the goods and in respect of the territories, the extent and the breadth of the use in relation to spirits is fairly clear. Although the sales figures relate only to the relevant time period for the word mark, I note the sales figures provided have been backed up with the evidence provided by way of invoices falling within (as well as outside) the timeframe for the logo mark.

103. On the question of genuine use, the applicant has submitted that the sales volume and turnover figures shown in this period in respect of the goods are "very low". I agree with the applicant to an extent, and I find a total of \$65,000 USD will be only a fraction of the market for spirits in the EU. I note also that there has been more use made in some EU territories than others. In



my view the sales into France cannot be counted towards genuine use in respect of the logo mark, as it is very possible that all of the sales to this territory fell outside of the relevant period for this mark. In respect of the remaining territories, on balance I find it likely that the sales fall within both relevant time periods.

104. As mentioned, the volume of sales made is only one of the factors I must consider when assessing if the use may be considered as genuine. With this in mind, it is my view that even with consideration of the undoubtedly large market for the goods, the sale of tens of thousands of US dollars of spirits under the mark, spread across a minimum of four territories in the EU in each relevant time frame, coupled with the (albeit limited) promotional materials provided, and the evidence of the various awards won for spirits within the EU in the time frame, amounts to a picture of genuine use. It appears to me that the use made by the opponent for spirits has been with the genuine intention of creating and maintaining a market for the goods in the EU, despite it not being particularly extensive.

105. I have already found there has been no use and as such no genuine use in respect of *Malted beverages, namely ciders* in the EU.

### **Fair specification**

106. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting

specification should accord with the perceptions of the average consumer of the goods or services concerned.”

107. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows:

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 (“Asos”) at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46.”

108. I have considered that, in terms of the broader wording of ‘beer’ the opponent may not have shown use in respect of every single variety of the same. However, on the basis of the case law as set out above, it is my view that in respect of beers, it would be inappropriate to narrow the opponent’s protection only to the particular and specific categories for which use has been evidenced. It is my view that the average consumer would fairly describe the goods offered by the opponent as beers, and I therefore find they may enforce the protection of the goods ‘beers’ within the opposition. I note also that lager falls within the meaning of beers. It is my view that the average consumer would perceive protection including that for lager in the UK would be fair considering the opponent’s use of the mark in relation to beer as a broader category.

109. In respect of ‘distilled spirits’, it is my view that this is more easily and frequently broken down by the consumer into various subcategories. However, in this instance I find that the range of spirits shown would fairly be described by the consumer as ‘spirits’. As I find this may be slightly broader than the wording ‘distilled spirits’, I find it appropriate to allow the opponent to enforce the protection for ‘distilled spirits’ within its registration.

110. In respect of the remaining goods for which genuine use has been shown, I find these are all fairly narrow terms and may be enforced as registered.

111. In summary, I find the goods which may be enforced by the opponent within the opposition under its fair specification are as follows:

Under UK registration no. 2126640 Class 32: <i>Beer, ale, stout, porter, lager.</i>	Class 33: Alcoholic beverages (except beers); cider; flavoured ciders; beer-flavoured cider; spirits; liqueurs; distilled beverages; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; rum; pre-mixed alcoholic beverages, other than beer-based; pre-mixed alcoholic cocktails.
Under EU registration no. 10716157 Class 33: <i>Distilled spirits</i>	
<b>Opponent's goods</b>	<b>Applicant's goods (both applications)</b>

### Preliminary issues

112. Before I proceed with the decision, I have noted some submissions from the applicant that I feel are best addressed at this stage. One line of argument against the likelihood of confusion between the applications and the earlier marks is articulated by the applicant as follows:

*"It is also submitted that the well-established reputation of the Applicant to the average consumer is to act as a leader and trail blazer.*

*Therefore, it is submitted that the average consumer would not be led to believe that the Applicant's goods bearing the ROGUE WAVE mark are linked in any way with the Opponent. Such a suggestion would be entirely against the grain of the Applicant's business methods and ethos which are well known by the average consumer. It is clear that*

*there is no risk of confusion with the Opponent's goods, including no likelihood of association."*

113. I find there to be several aspects of this argument that prevent me from considering it further. The first is that the submission of the applicant's alleged reputation is entirely unsupported by evidence, and it is not a fact upon which I am willing to take judicial notice.

114. The second issue I find with this statement is that it assumes several pieces of information will be known by the consumer when purchasing the goods, as follows:

- That the goods marketed under the ROGUE mark derive from Oregon Brewing Company, or at least a party that is not the applicant;
- That the goods marketed under ROGUE WAVE derive from BrewDog plc (I note the unsupported submissions on the reputation of the applicant on this point);
- That the goods on offer under the ROGUE WAVE reached the UK market after the goods ROGUE, and as such, due to the applicant's business method as a "trail blazer" there must be no connection between them.

115. Even if I were to rely on the submissions of a reputation of the applicant, which I find I cannot, the argument proposed makes no allowances for the possibility of confusion on the basis that when seeing the earlier mark, the consumer will assume this is an earlier or later mark owned by the applicant. A likelihood of confusion does not rely on a the consumer making a connection between the opponent and the applicant's companies, but rather on mistaking the marks for another, or alternatively on making the connection between the marks themselves, and assuming on that basis alone that the economic undertaking responsible for the goods must be linked. I therefore find that even if the consumer were aware in this instance, of the applicant having a reputation as a "trail blazer", this would not be determinative of no likelihood of confusion.

116. For the reasons set out above, I find this line of argument put forward by the applicant to be irrelevant in this instance, and I will not consider this further within this decision.

## **DECISION**

### **Section 5(2)(b)**

117. Section 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”.

### **Section 5A**

118. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### **The Principles**

119. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) 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 and services**

120. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.



(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the "Nice Classification" means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1975."

121. Similarity between goods and services is to be considered based on the criteria set out by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, as well as the factors in *Canon*<sup>7</sup>. These cases references factors including the nature, intended purpose, method of use, and whether they are comple mentary or in competition, alongside other factors namely the trade channels, users, and in the case of self-serve consumer goods, where these are likely to be found. In respect of identity of goods, in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court 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 fur Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark".

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

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<sup>7</sup> *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97

"... 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."

123. In *Sky v Skykick* [2020] EWHC 990 (Ch), Lord Justice Arnold considered the validity of trade marks registered for, amongst many other things, the general term 'computer software'. In the course of his judgment he set out the following summary of the correct approach to interpreting broad and/or vague terms:

*"...the applicable principles of interpretation are as follows:*

*(1) General terms are to be interpreted as covering the goods or services clearly covered by the literal meaning of the terms, and not other goods or services.*

*(2) In the case of services, the terms used should not be interpreted widely, but confined to the core of the possible meanings attributable to the terms.*

*(3) An unclear or imprecise term should be narrowly interpreted as extending only to such goods or services as it clearly covers.*

*(4) A term which cannot be interpreted is to be disregarded."*

124. With the above factors in mind, and following the assessment of the proof of use, the goods for comparison are as follows:

Under UK registration no. 2126640 Class 32: <i>Beer, ale, stout, porter, lager.</i>	Class 33: Alcoholic beverages (except beers); cider; flavoured ciders; beer-flavoured cider; spirits; liqueurs; distilled beverages; distilled spirits; whisky, blended whisky; liqueurs; gin; vodka; rum; pre-mixed alcoholic beverages, other than beer-based; pre-mixed alcoholic cocktails.
Under EU registration no. 10716157 Class 33: <i>Distilled spirits</i>	
<b>Opponent's goods</b>	<b>Applicant's goods (both applications)</b>

125. Within its submissions, the applicant appears to concede that all of the opponent's goods are similar to its goods to a low degree, marking this in its table of goods within its written submissions. The applicant submits:

“In supporting the position that the goods listed in class 33 of the present application are of low similarity to the ‘beer’ and similar goods in class 32 of the ROGUE registrations, we wish to draw attention to the decision in the UKIPO decision in the case Jeffrey Joshua Lawrence v Heineken Asia Pacific Pte. Ltd (O-286-15) where the Hearing Officer referred to an earlier case against the same party where it was found by Hearing Office, Mrs Judi Pick there is ‘*no similarity between ale and gin*’, or in the alternative that the ‘*similarity must be of a very low level*’ (paragraph 18, sub para 14). In the later case referred to it was found that the goods (gin and beer) were “*similar, but to only a low degree.*”

126. I find this to be a concession by the applicant that the opponent's goods found in class 32 are similar to its class 33 goods to at least a low degree. The opponent submits that the goods are at least similar to a high degree. I find on this basis that the opponent's goods in class 32 are similar to the applicant's goods to a minimum of a low degree. However, should I have misinterpreted this concession by the applicant, I note that it is nonetheless my opinion that the opponent's class 32 goods are similar to the applicant's goods to at least a low degree. I find this reasoning to be supported in part by the decision in *James Duncan Abbott v Alpes Marques* [BL no. O/693/19] in which the appointed person Miss Emma Himsworth QC overturned a finding that beers and whisky were not similar, stating:

*"72. In my view, had the Hearing Officer: (1) gone through a proper analysis of the factors relevant to his assessment of the similarity of the goods in the particular case that was before him; and (2) specifically considered the position by reference to perception of the average consumer in the UK in accordance with the approach set out in in BALMORAL TM and CALEDONIAN TM he could and would have found that beer and whisky were similar but only to a low degree."*

127. However, as there are in my view, other more similar goods to compare to some of the applicant's class 33 goods, I will not conduct a full comparison of the opponent's class 32 goods against the applicant's goods in class 33. Instead, I have set out below my reasoning in respect of the most relevant comparison between the goods below.

*Cider; flavoured ciders; beer-flavoured cider*

128. I note that at a deeper level, the nature of cider differs to that of beer, in the sense that the drinks are made from different things. Cider is made from apples, whereas beer is generally made from hops and yeast. However, both are beverages, usually containing a similar percentage of alcohol, and both often have a similar appearance and consistency. The intended purpose of both drinks is the same, namely for quenching thirst, consuming with a meal

or in and of itself for enjoyment of the taste or the alcohol. Both drinks will be both sold in cans, bottles or from taps, and in the same quantities, such as in pints or half pints from a tap or pump. The goods will also be sold in the same areas of supermarkets as well as in a hospitality setting. Both drinks are often served in the same type of receptacle. As the goods serve the same purpose, there is a level of competition between them, as consumers may enter a supermarket or bar, pub or restaurant undecided on which drink they will choose, and opt for one over the other to enjoy or quench their thirst. This level of competition is exacerbated in respect of ciders that are intentionally beer flavoured, as they are clearly intended to be purchased by those who enjoy the taste of beer. Overall, I find the applicant's above goods similar to the opponent's to a high degree.

*Alcoholic beverages (except beers); spirits; distilled beverages; distilled spirits; whisky, blended whisky; gin; vodka; rum;*

129. I find the above goods filed by the applicant all to either fall within the meaning of the opponent's distilled spirits, or to encompass distilled spirits within their meaning, or to be distilled spirits. For this reason, I find the above goods to either be self-evidently identical to the opponent's, or to be identical within the meaning of *Meric*.

*pre-mixed alcoholic beverages, other than beer-based; pre-mixed alcoholic cocktails*

130. A key component of the above goods filed by the applicant will be a type of distilled spirit, as included in the opponent's goods, and whilst it may not always be the case (I note the possibility of wine spritzers falling into these categories for example), I find this to be the case more often than not. On this basis, there will be some competition between the pre-mixed beverages and distilled spirits, as consumers may opt to purchase the spirits separately, or alternatively in the pre-mixed form, considering factors such as price and convenience when making their choice, but often with the anticipation the end result will be the same. I find the trade channels for these goods will often overlap. The goods will be placed in the same section of retail shops, but

perhaps not side by side on the same shelves. In terms of nature and intended purpose, there is a certain amount of overlap in the sense that they are all alcoholic beverages which will be consumed generally for the enjoyment of the taste and/or the effects of the alcohol. Pre-mixed beverages will include a much lower content of alcohol than the spirits themselves, however, spirits will often be purchased with a mixture, or with the intention of adding one to dilute the percentage. Overall, I find the above goods to be similar to the opponent's earlier goods *distilled spirits* to a high degree.

### *Liqueurs*

131. The primary ingredient of a liqueur will be distilled spirits, as covered by the opponent's goods, and I find it is very possible that these goods may be deemed identical to distilled spirits covered by the opponent. However, even if they are not identical, I find again that the nature of these goods will be broadly the same, in that they will both be alcoholic beverages (containing at least in part distilled spirits), and the purpose of both will generally be for drinking to enjoy the taste or the effects of the alcohol. Both liqueurs and distilled spirits will often be served with a mixer or within another drink such as a cocktail and can also be served alone or on ice. Liqueurs are likely to have a lower level of alcoholic content and be a sweeter, but there will still be some competition between the two, and consumers may be choosing between, for example, a gin or a gin liqueur. The goods will be sold within hospitality establishments but also within the same section of supermarkets, and as mentioned will be served in a similar manner. If liqueurs are not found to be identical to distilled spirits, I find at least that the applicant's liqueurs are similar to the opponent's distilled spirits to a high degree.

### **Comparison of marks**


132. 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.”

133. 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.

134. In this instance, all three earlier marks are identical. For this reason, I will refer simply to the “earlier mark” in singular format for the purpose of the marks comparison. With that in mind, the respective trade marks are shown below:

<p>ROGUE</p>	<p>ROGUE WAVE</p> <p>(“The applicant’s word mark”)</p>
	<div style="text-align: center;">  </div> <p>Series of two</p>

	("The applicant's logo mark")
Earlier trade mark	The contested trade marks

135. The dominant and distinctive element, and only element of the earlier trade mark is the word ROGUE. The overall impression is held in the mark in its entirety.

136. In respect of the applicant's word mark, I find both the words ROGUE and WAVE to be dominant and distinctive elements. I find the overall impression of the mark is held in the mark as a whole.

137. I find the most dominant and distinctive element of the applicant's logo mark to be the wording ROGUE WAVE. I find this to be roughly 50% of the mark as a whole, and to be the element that consumers will immediately be drawn to and remember. However, I find the image of the sailor to also add to the overall impression of the same.

#### Visual comparison

138. Visually, the earlier mark is incorporated into the both of the contested marks in its entirety. The opponent argues that this, along with the fact that ROGUE features as the first element of the applicant's mark, means the marks should be considered as visually (and phonetically) similar to a high degree. The applicant argues on the contrary, that the marks are visually dissimilar.

139. I have considered that the applicant's word mark shares the first word identically with the opponent's mark, but that it differs in length with the introduction of a second four letter word that is not present in the opponent's mark. Overall, with consideration to the similarities and the differences between the marks, I find the marks to be visually similar to a medium degree.



140. In respect of the applicant's logo mark, again I find the first visual element that the consumer will notice in the applicant's mark is near identical to the opponent's mark, which as a word mark may be used in a stylised or colour form. However, again the first word element is followed by the second 4 letter word WAVE in the applicant's mark, which I find will also be noticed by the consumer, and underneath this element is a large image of a sailor that will not be ignored. With consideration of the identity of the first element, but also the differences between the marks, I find the applicant's logo mark visually similar to the opponent's earlier mark to between a low and medium degree.

#### Aural comparison

141. The applicant argues the marks are aurally dissimilar, and the opponent submits they are phonetically similar to a high degree, for the reasons previously outlined.

142. The aural elements in both the applicant's logo mark and word mark are identical, both consisting of two syllables, namely ROGUE WAVE. The opponent's mark consists of a single syllable, which is aurally identical to the first syllable in both of the applicant's mark. With consideration of the aural similarities, and the differences in length and ending of the marks, I find both marks to be aurally similar to the earlier mark to a medium degree.

#### Conceptual comparison

143. The applicant has made detailed submissions as to why it believes that the marks are conceptually dissimilar. I note the applicant has also submitted evidence on the meaning of ROGUE and ROGUE WAVE in the form of dictionary definitions, and various news articles discussing the concept of 'rogue waves'. I gather from the evidence filed that a 'ROGUE WAVE' is an abnormally large wave that appears unexpectedly and without warning, which may have the potential to be dangerous and cause destruction. The evidence

filed by the opponent under Exhibit SJB-2 also appears to confirm this meaning of rogue wave, although I note it appears intended for a US audience.

144. On the conceptual comparison, the applicant argues:

“The addition of the word WAVE creates an overall term with a meaning of its own that is different to ROGUE. A ‘rogue’ as a noun is a person that is dishonest or unprincipled or possesses other typically negative personal qualities. However, when combined with another word such as WAVE, the term ROGUE becomes an adjective, meaning ‘problem’ or ‘wayward’.

As discussed in the earlier submissions, the difference in syntactical structure of the two marks creates conceptual differences when the marks are compared as a whole. The Opponent’s mark is the standalone term ROGUE, the dictionary definition of which includes the meaning “*a man who behaves in a dishonest or criminal way*”. By contrast, the phrase ROGUE WAVE is defined as “*a sudden huge wave*”. Describing an open water phenomenon, the phrase ROGUE WAVE hangs together as a known term with a meaning which is readily understood by the consumer and which differs significantly from the term ROGUE as a standalone term. These assertions are supported by the evidence previously enclosed with the Witness Statement and Exhibits of Rachel Denholm, dated 30 July 2020.”

Notwithstanding the clear conceptual meaning of the Opponent’s marks, even if the phenomenon of a ROGUE WAVE is not known to the relevant consumer, it is submitted that the mark ROGUE WAVE would not inevitably evoke the same conceptual meaning as ROGUE on its own.”

145. On the contrary, the opponent argues the marks are conceptually similar. The opponent states:

56. <https://www.merriam-webster.com/dictionary/rogue> defines a “rogue” as a “vagrant,” “tramp,” “mischievous person”, etc. What all definitions have in common is that they describe a person (or object) that has specific personality traits and behaviours, or characteristics, something that is unique and out of the ordinary. That is why the word “rogue” is used to describe and characterise so many different objects (e.g., rogue waves, rogue stallions, rogue barons) and organisations (e.g., rogue nations, rogue societies, rogue states). The word “rogue” is aptly used with all of these to tell inform about the characteristics of that particular “rogue” -- rugged individualism, a desire to go against the grain, a person or object that stands out compared to the others.

57. So, it is with a “rogue wave” (also known as freak waves, monster waves, episodic waves, killer waves, extreme waves, sneaker waves, and abnormal waves), which are unusually large, unexpected and suddenly appearing surface waves that can be extremely dangerous. Simply, a “rogue wave” is one type of wave that exhibits “roguish” characteristics. As such, the mark ROGUE WAVE immediately conveys to consumers the same basic message as the Opponent’s mark ROGUE: this is a product that stands apart from the others. This holds even if a consumer has no idea what a rogue wave is.

146. The evidence filed by both parties defines ROGUE in several ways. ‘Rogue’ is used to depict a person or animal that behaves in an unruly or unexpected way (‘the man was a rogue’ ‘she was a rogue’), and is also used to describe the behaviour itself (‘the man was acting rogue’, ‘she went rogue’).

147. In my view, the word ROGUE may be understood within the earlier mark in either or both of the ways above by the consumer. I believe that there will be some consumers for who the noun is clearly brought to mind to who the opponent’s mark conjures the image of ‘a rogue’ namely an unruly person. However, I find there will likely be an equivalent portion of the consumer who see ROGUE as descriptive of a behaviour or characteristic, perhaps alluding that there may be something about the goods themselves that is particularly

maverick, or unexpected, or that this is a comment on the behaviour of the person consuming them.

148. In respect of the applicant's goods, to some consumers I find the mark will conjure the image of a wave that is unexpected or abnormal. I find the way in which this will be conjured in the mind of the different consumers to be nuanced, depending on their previous knowledge. On the one hand, I agree with the applicant that there will be some UK consumers with knowledge of the meaning of rogue wave, for whom the words will hang together to create a slightly different meaning, namely the phenomenon of a wave that displays a very particular set of characteristics, albeit characteristics that are typically 'rogue'. However, I find also that there will be a further set of consumers for whom the phenomenon of a 'rogue wave' is not known. I find that for these consumers, a similar concept may be conjured, one of a wave behaving in an unexpected and perhaps dangerous way. However, for these consumers, the meaning of the mark will be split into two elements, namely ROGUE describing a behaviour in the same way that this does in the opponent's mark, and WAVE describing a wave. I also find there will be a further set of consumers who will view the mark as simply meaning 'ROGUE' (in either of the meanings described) on the one hand, and 'WAVE' simply as a wave, likely from the sea but possibly in the case of the word mark, as a greeting.

149. For the reasons above, I therefore find that for a significant portion of consumers the word ROGUE will be attributed the same meaning in both the applicant's and the opponent's mark. Where this is the case, I find the marks to be conceptually similar to a medium degree. Whilst I note the introduction of a sailor and sea device in the logo mark will reinforce to the consumer the meaning of 'wave', I do not find this will detract from the similarities in the concept, which will remain at a medium degree for both marks. However, where the consumer will view the meaning of the earlier mark as an unruly person, or even a 'loveable rogue', and the meaning of the applicant's mark as a large wave that appears from nowhere to cause destruction, I find the marks to be conceptually dissimilar.

## Average consumer and the purchasing act

150. 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.

151. 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.”

152. The relevant consumer of all of the goods in this matter will primarily consist of the general public over the age of 18. There may also be a portion of professional consumers purchasing the goods on behalf of a business, or for the purpose of running a business themselves. It is my view that a significant portion of members of the general public over the age of 18 will purchase the goods fairly frequently, either in a retail or hospitality environment, whereas the professional public is more likely to purchase these in a wholesale environment. I note the price point of the goods may range from relatively inexpensive to very expensive, but this will not be determinative of a high level of care for the goods in general, and I find the purchase will not be one undertaken by the public with a particularly heightened level of care. The general public will likely consider various factors

when purchasing the goods, including the type, taste and alcoholic content of the goods, and so I find an average level of attention will be paid. In respect of professionals, it is my view their attention will be enhanced due to the increased responsibility of purchasing these goods on behalf of a business, and the increased liability that will come with serving or selling the goods to consumers. I find the professional consumer will likely pay between an above average degree of attention when making a purchase.

153. Where these goods are purchased in a retail environment, the consumer will rely predominantly on the visual inspection of the goods on shelves. Where the goods are purchased in a café, bar, restaurant, pub or nightclub, again this will be predominantly visual with marks most likely being displayed on and chosen from a drinks menu<sup>8</sup> or displayed on the bottles or boards visible behind the bar. However, as verbal orders will often be placed in these scenarios, aural considerations cannot be completely discounted.<sup>9</sup> I find that professionals will also make predominantly visual purchases, although on occasion orders may be placed verbally and so I also cannot completely disregard the aural comparison in respect of professionals.

### **Distinctive character of the earlier trade mark**

154. 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

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<sup>8</sup> See the decision of the General Court in case T-187/17, *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*

<sup>9</sup> See the decision of the General Court in *Stock Polska sp. z o.o. v EUIPO*, case T-701/15, in which it was found verbal ordering should be considered.

*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).”

155. The earlier mark ROGUE is a known English word. Although, as I have mentioned, the mark may allude to something about the goods being unusual or maverick, I do not find that the mark alludes to a characteristic of the goods in a way that detracts from its ability to be used to identify the commercial origin of the same, nor do I find the mark descriptive of the goods. I find the mark to be inherently distinctive to an average degree. In my view, the evidence is not sufficient to show that the distinctiveness of the earlier mark has been enhanced through use of the same. Although there is evidence of reasonable sales in respect of beer in the UK, where I find the opponent’s best prospect of raising the distinctive character through use lies, there is no evidence of how these sales interact with the beer market in the UK, which I expect is very large. I note there is evidence of awards won at an EU level, but there is little to show how this has impacted the distinctiveness of the mark in the UK, and the evidence of press and social media provided is fairly modest.

## **GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.**

156. Prior to reaching a decision on this matter, I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 119 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that a likelihood of confusion may be increased where the earlier mark holds a high degree of distinctive character, either inherently, or due to the use made of the same, and that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks. I must also consider that both the degree of attention paid by the consumer and how the goods or services are obtained will have a bearing on how likely the consumer is to be confused.

157. I consider at this point that there are two types of confusion that I may find. The first type of confusion is direct confusion. Direct occurs where the consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings<sup>10</sup>.

158. I have found the earlier mark to be inherently distinctive to an average degree. I have found that it shares a medium level of visual and aural similarity with the applicant's word mark, and that to some the marks will be conceptually similar to a medium degree, and to others, they will be conceptually dissimilar. I have found between a low and medium level of visual similarity with the applicant's logo mark, and the same findings in the

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<sup>10</sup> *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10,



aural and conceptual comparison as I did in respect of the applicant's word mark. I found the opponent may rely on beer, ale, stout, porter and lager, as well as distilled spirits in the opposition. I found the average consumer will pay a medium level of attention to the purchase of the goods, which are all either identical or highly similar, and that the purchasing process will be primarily visual.

159. It is clear to me that even where the goods are identical, the consumer will notice the differences between the marks both visually and aurally. It is my view that the introduction of an additional word in the applicant's word mark, and the word and device in the logo mark will not be misremembered to the extent that the differences go unnoticed, even considering the consumers imperfect recollection. For this reason, I find there will be no likelihood of direct confusion between the marks.

160. In respect of the likelihood of indirect confusion, Mr Ian Purvis Q.C. in *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, set out some of the scenarios in which a likelihood of indirect confusion may apply. He stated:

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).”

161. I note that the categories set out above are not exhaustive, and there is no requirement for the marks to fit neatly within one of these for indirect confusion to occur. In addition, I also keep in mind the comments of Mr James Mellor Q.C., as the Appointed Person in *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, in which he stressed that indirect confusion should not be found merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark simply calls to mind another mark. This is mere association not indirect confusion.

162. It is my view that the earlier and contested marks do not fall into one of the categories identified by *L.A. Sugar* as above, but that I should not write off the possibility of indirect confusion on this basis. The earlier mark is clearly contained in both later marks. Further, I find that the earlier mark is a dominant and distinctive element in both later marks, and it will clearly be noticed by the consumer. I found this element that connects the two marks to be inherently distinctive to an average degree, and in my view it is often the case that word ROGUE will, in all three marks, convey the exact same meaning to the consumer. However, I note that the addition of the word ‘wave’ does create a point of conceptual difference between the marks that helps to counteract some of the visual and aural similarities to some consumers. I find this particularly in respect of those consumers with a clear understanding of the phenomenon of a ‘rogue wave’ to whom the two words will hang together to form this meaning, and to whom the opponent’s mark brings to mind an unruly person. To this group of consumers, it is my view that it will be unlikely for indirect confusion to occur.

163. However, in respect of those consumers who will view the marks simply as meaning ROGUE as a set of behaviours, and ROGUE WAVE as

the same set of behaviours attributed to a wave, or alternatively as a set of behaviours, and separately a wave in the sea (or a greeting), I find that ROGUE will create a clear concept that runs consistently through both marks, helping to connect the marks in the mind of the consumer. I note this common element must do more than simply bring the other mark to mind, and I have considered if this will be the effect in this case and in this market. In my view, the market for alcohol is one in which it is common for a house brand to be used in conjunction with various sub brands. I find that the consumer, viewing and acknowledging ROGUE as a common element in the marks, may easily view ROGUE WAVE as a sub brand for different varieties of identical goods. Further, in my view, the applicant's marks may also be viewed as a sub brand or a brand extension in respect of different types of similar goods, for example, where ROGUE is used for beer, ROGUE WAVE may be used for beer flavoured cider, or where ROGUE is used for spirits, ROGUE WAVE may be used in relation to a brand extension into liqueurs or cocktails derived from those spirits. It is my view the element ROGUE, holding an average level of distinctiveness, will link the two marks in the mind of the consumer to the extent that this group of consumers, which I believe will be significant, is likely to reach the conclusion that ROGUE WAVE is a sub brand of ROGUE in respect of all of the applicant's goods. In respect of the logo mark, although I note the visual similarities are lower than in respect of the word mark, I still find that it is the wording ROGUE WAVE that will be used first and foremost by the consumer to identify the commercial origin of the goods, and I find that the link made through the word ROGUE will mean a likelihood of indirect confusion also applies in respect of the same.

164. In summary, for the reasons set out above, I find there is a likelihood of indirect confusion in respect all goods in both applications.

### **Final Remarks**

165. In the event that the opposition was successful, the applicant has asked that I consider a fallback specification. This has been provided as follows:

*“The present Applications should be permitted to proceed to registration for all goods listed, or in respect of the Applicant’s fall-back position of vodka only, and an award of costs made in favour of the Applicant.”*

166. As a likelihood of confusion has been found in respect of all of the applicant’s goods, including ‘vodka’, the applicant’s fall back specification makes no difference to the matter in hand. I therefore find that the applicant’s fallback position of ‘vodka’ may not be allowed to proceed to registration.

167. The opposition has been successful, and the applications nos. 3388507 & 3419747 will be refused for all goods filed.

## **COSTS**

168. The opponent has been successful and is entitled to a contribution towards its costs in respect of both oppositions filed. In the circumstances I award the opponent the sum of £2500 as a contribution towards the cost of the two proceedings. The sum is calculated as follows:

Official fee	£100 (x 2)
Preparing the TM7 and considering the counterstatement	£200 (x 2)
Preparing and filing the evidence and considering the applicant’s evidence	£1500
Preparing and filing written submissions	£400
Total	£2500

169. I therefore order BrewDog plc to pay Oregon Brewing Company the sum of £2500. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 15<sup>th</sup> day of December 2020**

**Rosie Le Breton  
For the Registrar,  
The Comptroller-General**