

**O/574/21**

**TRADE MARKS ACT 1994**

**CONSOLIDATED PROCEEDINGS**

**IN THE MATTER OF APPLICATIONS FOR  
TRADE MARKS NOS. UK00003436609, UK00003443582 AND UK00003462432  
IN THE NAME OF NICK ROBINSON FOR THE TRADE MARKS**

**Incognito,**

**Incognito Cocktail Company**

**AND**



**IN CLASSES 43, 33 AND 33, RESPECTIVELY**

**AND THE OPPOSITIONS THERETO UNDER NUMBERS 419224, 419548 AND  
420851**

**BY**

**AZUMI LIMITED**

## **Background and Pleadings**

1. Nick Robinson ('the Applicant') filed applications to register the trade marks shown on the cover page of this Decision:

i) **UK00003436609**

**Incognito**

Filed 15 October 2019

Published for opposition purposes in the *Trade Marks Journal* on 25 October 2019

For the following services:

*Class 43: Bar and restaurant services; Bar services; Bars; Beer bar services; Beer garden services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food preparation; Hookah bar services; Hookah lounge services; Hotel accommodation reservation services; Hotel accommodation services; Hotel catering services; Hotel services; Hotels; Hotels and motels; Hotels, hostels and boarding houses, holiday and tourist accommodation; Restaurant and bar services; Restaurant information services; Restaurant services; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Services for the preparation of food and drink; Services for the provision of food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Serving of alcoholic beverages; Sommelier services; Wine bar services; Wine bars; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to bars; Provision of information relating to restaurants; Provision of information relating to the preparation of food and drink; Public house services; Pubs; Rental of bar equipment; Lounge services (Cocktail -); Night club services [provision of food]; Private members dining club services; Private members drinking club services; Providing drink services; Providing food*

*and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink in bistros; Providing information about bar services; Providing information about bartending; Providing information about restaurant services; Providing of food and drink; Providing restaurant services; Providing reviews of restaurants and bars; Cafe services; Café services; Cafés; Cafeterias; Carry-out restaurants; Cocktail lounge buffets; Cocktail lounge services; Cocktail lounges; Coffee bar services; Coffee shop services; Coffee shops.*

ii) **UK00003443582**

**Incognito Cocktail Company**

Filed 12 November 2019

Published for opposition purposes in the *Trade Marks Journal* on 22 November 2019

For the following goods:

*Class 33: Absinthe; Aguardiente [sugarcane spirits]; Akvavit; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs; Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic preparations for making beverages; Alcoholic punches; Alcoholic tea-based beverage; Alcopops; Amontillado; Anise [liqueur]; Anisette; Anisette [liqueur]; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Aquavit; Arak; Arak [arrack]; Arrack; Arrack [arak]; Baijiu [Chinese distilled alcoholic beverage];*

*Beverages (Alcoholic -), except beer; Beverages containing wine [spritzers]; Beverages (Distilled -); Bitters; Black raspberry wine (Bokbunjaju); Blackcurrant liqueur; Blended whisky; Bourbon whiskey; Brandy; Cachaca; Calvados; Canadian whisky; Cherry brandy; Chinese brewed liquor (laojiou); Chinese mixed liquor (wujiapie-jiou); Chinese spirit of sorghum (gaolian-jiou); Chinese white liquor (baiganr); Chinese white liquor [baiganr]; Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy; Cordials [alcoholic beverages]; Cream liqueurs; Curacao; Digesters [liqueurs and spirits]; Distilled beverages; Distilled rice spirits [awamori]; Distilled spirits; Distilled spirits of rice (awamori); Dry cider; Extracts of spiritous liquors; Fermented spirit; Flavored tonic liquors; Fortified wines; Fruit (Alcoholic beverages containing -); Fruit extracts, alcoholic; Gaolian-jiou [sorghum-based Chinese spirits]; Gin; Ginseng liquor; Grain-based distilled alcoholic beverages; Grappa; Herb liqueurs; Hulless barley liquor; Hydromel [mead]; Japanese liquor containing herb extracts; Japanese liquor containing mamushi-snake extracts; Japanese liquor flavored with Japanese plum extracts; Japanese liquor flavored with pine needle extracts; Japanese regenerated liquors (naoshi); Japanese sweet grape wine containing extracts of ginseng and cinchona bark; Japanese sweet rice-based mixed liquor (shiro-zake); Japanese sweet rice-based mixed liquor [shiro-zake]; Japanese white liquor (shochu); Japanese white liquor [shochu]; Kirsch; Korean distilled spirits (soju); Liqueurs; Liqueurs containing cream; Liquor-based aperitifs; Low alcoholic drinks; Malt whisky; Mead [hydromel]; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Piquette; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Rice alcohol; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sake substitutes; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Shochu (spirits); Sorghum-based Chinese spirits; Spirits; Spirits and liquors; Spirits [beverages]; Sugar cane juice rum; Sugarcane-based alcoholic beverages; Sweet cider; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Tonic liquor flavored with pine needle*

*extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; Wine coolers [drinks]; Wine-based aperitifs.*

iii) **UK00003462432**



Filed 30 January 2020

Published for opposition purposes in the *Trade Marks Journal* on 10 April 2020

For the following goods:

*Class 33: Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic bitters; Alcoholic cocktail mixes; Alcoholic cocktails; Cocktails; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Rum punch; Spirits; Vermouth; Vodka.*

2. Azumi Limited ('the Opponent') filed respective oppositions to the applications on 27 January 2020 (Opposition no. 419224), 24 February 2020 (Opposition no. 419548) and 29 July 2020 (Opposition no. 420851). All three oppositions are based on section 5(2)(b) of the Trade Marks Act 1994 ("the Act"); all are directed against all of the goods/services in the respective applications.

3. The Opponent relies on the following earlier trade mark registration for its section 5(2)(b) ground:

UK00003180080<sup>1</sup>

INKO NITO

Filing date: 12 August 2016; Date registration completed: 11 November 2016

Relying on the following registered goods and services:

Class 33: *Alcoholic beverages (except beers).*

Class 43: *Restaurant services; bar services; café services; catering services; provision of food and drink.*

4. The Opponent claims that:

- Opposition 419224 – the respective marks are visually, aurally and conceptually highly similar; the respective class 43 services are identical and similar; and that the Applicant's class 43 services are similar to the Opponent's goods.
- Opposition 419548 – the first word of the Applicant's mark is highly similar to the earlier marks visually, aurally and conceptually; the respective class 33 goods are identical; and that the Applicant's goods are similar to the Opponent's services.
- Opposition 420851 – the respective marks are highly aurally similar; the respective class 33 goods are identical; and that the Applicant's goods are similar to the Opponent's services.

Consequently, that is a likelihood of confusion in each case.

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<sup>1</sup> The Opponent also relies on an earlier registration EUTM 015702772 (comparable mark UK00915702772), but this is for an identical mark for identical goods and services.

5. The Applicant filed a defence and counterstatement for each opposition, denying the grounds in each case.
6. Both parties filed evidence and written submissions in the evidence rounds. Written submissions in lieu of a hearing have been filed by both parties.
7. The Opponent is represented by Boulton Wade Tennant LLP; the Applicant is represented by Paris Smith LLP.

### **Relevant dates**

8. Section 6A of the Act provides that where the registration date of the earlier mark is more than 5 years prior to the application date of the applied-for mark, the opponent may be required to prove use of the earlier mark. In the instant case, Section 6A is not engaged because the registration date of the earlier mark, i.e. 11 November 2016, is less than 5 years prior to each of the application dates of the applied-for marks, i.e. 15 October 2019; 12 November 2019 and 30 January 2020. Consequently, the Opponent is entitled to rely upon its mark in respect of all of the goods upon which it relies.
9. The Applicant has submitted the following at 'section' 2 of its written submissions dated 15 March 2021:

Trade marks do not grant a monopoly over goods and services, they grant a monopoly over the brand using those goods and services, ONLY where the marks are identical or confusingly similar and we suggest, only then within the smaller interpretation of market sector in which the mark is recognised and can establish goodwill. For the reasons set out above and below, it is our strong assertion that none of the Applicant's marks are similar to INKO NITO.

This submission is wrong in law. There is no requirement for an Opponent to establish a goodwill in an opposition under s5(2)(b) of the Act.<sup>2</sup> Furthermore,

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<sup>2</sup> The Applicant's later submission that 'the Opponent has yet to demonstrate any evidence of reputation' is also irrelevant, because the Opponent has not pleaded a reputation in respect of its mark.

section 6A of the Act is not engaged in the instant case; there is therefore no obligation for the Opponent to demonstrate use of the mark.

## **Preliminary issues**

### **10. Applicant's reference to goodwill**

The Applicant has submitted the following at 'section' 2 of its written submissions dated 15 March 2021:

Trade marks do not grant a monopoly over goods and services, they grant a monopoly over the brand using those goods and services, ONLY where the marks are identical or confusingly similar and we suggest, only then within the smaller interpretation of market sector in which the mark is recognised and can establish goodwill. For the reasons set out above and below, it is our strong assertion that none of the Applicant's marks are similar to INKO NITO.

This submission is wrong in law. There is no requirement for an Opponent to establish a goodwill in an opposition under s5(2)(b) of the Act.<sup>3</sup> Furthermore, section 6A of the Act is not engaged in the instant case; there is therefore no obligation for the Opponent to demonstrate use of the mark.

### **11. Notional use**

The Applicant has included in its evidence screenshots of the parties' respective website 'home' pages. It has also argued in its written submissions that 'the Opponent trades only in the Japanese market'<sup>4</sup>.

12. How the Applicant uses its mark is not a relevant factor in the assessment of whether there is a likelihood of confusion. As noted above, at [8], there is no requirement for the Opponent to prove use of its mark. I must only consider the 'notional' use of the marks in relation to the goods and services in their respective specifications. In my assessment, I must therefore consider all of the possible circumstances in which the mark applied for *might* be used if it were registered. Any *actual* differences between the parties' goods or services are irrelevant unless they are apparent from the applied-for and registered marks.

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<sup>3</sup> The Applicant's later submission that 'the Opponent has yet to demonstrate any evidence of reputation' is also irrelevant because the Opponent has not pleaded a reputation in respect of its mark.

<sup>4</sup> Point 2 of the Applicant's written submissions dated 15 March 2021.



13. The Court of Justice of the European Union (“CJEU”)<sup>5</sup> has stated the following on the matter of notional use<sup>6</sup>:

“Once a mark has been registered its proprietor has the right to use it as he sees fit so that, for the purposes of assessing whether the application for registration falls within the ground for refusal laid down in that provision, it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier mark in all the circumstances in which the mark applied for might be used if it were to be registered.”

#### 14. Evidence of actual confusion

The Applicant has submitted, section 3 of its written submissions, that “it is imperative that, for the Oppositions to succeed, the Opponent evidences a likelihood of confusion’. This is wrong in law. There is no obligation, in the instant proceedings, for either party to file evidence.<sup>7</sup> It is not correct that there must be ‘actual confusion as to the source’ because there will be cases in which an applied-for mark has not yet been used.<sup>8</sup> Whether or not there is a likelihood of confusion is the substantive matter to be determined by this Tribunal, having compared the respective marks and their specifications and applying the established legal principles set out below at [38].

### **Opponent’s evidence**

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<sup>5</sup> Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Trade Marks Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

<sup>6</sup> *O2 Holdings Limited, O2 (UK) Limited v Hutchison 3G UK Limited*, Case C-533/06.

<sup>7</sup> Although, if a point is pleaded for which evidence is required, it is expected that the party will adduce evidence in support of that point.

<sup>8</sup> *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, per Kitchen L.J.

15. The Opponent's evidence comes from Daniela Paull, a Trade Mark Attorney of Boulton Wade Tennant LLP, and Rainer Bernd Leo Becker, Director of the Opponent company. Ms Paull's Witness Statement is dated 7 October 2020 and refers to 3 exhibits; Mr Becker's Witness Statement is dated 27 May 2021 (no exhibits).

16. Witness Statement of Daniela Paull

Ms Paull states that she has carried out online searches of the terms 'cocktail', 'company' and 'inko nito' via dictionary.cambridge.org and collinsdictionary.com. Screenshots of the definitions of 'cocktail' (Exhibit DP1) and 'company' (Exhibit DP2) have been adduced to support the Opponent's assertion that those elements of the Applicants' marks are 'devoid of any distinctive character in the relation to the goods applied for'.

17. A screenshot of the search result for 'Inko Nito' (Exhibit DP3) has been adduced to support the Opponent's argument that 'Inko Nito' will be perceived as a misspelling of 'Incognito'. The online Collins Dictionary has generated the search result 'Sorry, no results for "inko nito" in the English Dictionary. Did you mean: incognito, incognitos'.

18. However, the search results given by a website have been generated by an algorithm and do not necessarily mirror the way in which words are perceived by the average consumer.

19. Witness Statement of Rainer Becker

Mr Becker's Witness Statement can be summarised as an explanation of the rationale behind his choice of mark.

20. The reasoning behind a party's choice of mark is irrelevant to the Tribunal's assessment of whether there is a likelihood of confusion under s5(2)(b) of the Act

in this case. I must consider the respective marks 'at face value'; I am unable to take into account the rationale behind a mark's creation or design.<sup>9</sup>

### **Applicant's evidence**

21. The Applicant's evidence comes from Laura Kay Trapnell, a partner at Paris Smith LLP, representing the Applicant. Her Witness Statement is dated 9 February 2021 and refers to 12 exhibits.
22. Exhibit LKT1 – comprises a screenshot of the Applicant's website showing its figurative mark. As explained above under 'Notional use', how the Applicant is currently using its mark is irrelevant to the Tribunal's assessment of whether or not there is a likelihood of confusion between the respective marks.
23. Exhibit LKT2 – comprising screenshots of the parties' respective home pages is also irrelevant for the reason provided above.
24. Exhibit LKT3 - comprises a screenshot of the Opponent's online menu which features the phrase 'Unconventional Japanese Robatayaki'. The Applicant has adduced this evidence to show that the Opponent's restaurant is Japanese and 'prides itself with having an unconventional and modern vibe'.
25. As noted above, section s6A of the Act is not engaged and the Opponent is not, therefore, required to prove use of its mark. How it uses its mark and in respect of what type of cuisine, for example, are irrelevant to the assessment of likelihood of confusion between the parties' respective marks.<sup>10</sup>
26. Exhibit LKT4 – comprises two screenshots: one from 'Google Translate' which shows that 'inko nito' is a Japanese word which translates into English as

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<sup>9</sup> The Applicant's submissions on the intended meaning behind a mark (at 1.1. of its written submissions dated 1 March 2021) are therefore also irrelevant. The issue at stake is how the mark is perceived by the average consumer.

<sup>10</sup> See above paragraph on 'Notional use'. The Applicant's submission that 'the Opponent trades only in the Japanese market' is therefore also irrelevant.

'parakeet'. The other, from a website 'jisho.org', shows that a search for 'INKO NITO' has yielded no result; whereas 'INKO' is shown as meaning 'parrot'.

27. Exhibit LKT5 - Comprises screenshots of search results for 'inko nito' from the Cambridge and Collins online dictionaries showing that the term 'inko nito' has not been recognised but suggesting various other words or terms which contain similar letters or sounds including 'incognito'.
28. Exhibit LKT6 - Comprises printouts of Google search results of the terms 'INKO NITO' and 'incognito'. The search results for 'INKO NITO' have yielded pages related to the Opponent's restaurant; the results for 'incognito' have yielded pages related to browsing the web in 'incognito', i.e. private mode, plus a Wikipedia entry for the term.
29. Exhibit LKT7 - Comprises online search results for the term 'cocktail company' in the online Collins dictionary. Ms Trapnell suggests in her Witness Statement that this has been adduced to demonstrate that none of the definitions generated has any association with a Japanese restaurant. It is presumed that this has also been adduced in an effort to demonstrate conceptual distance between the respective marks.
30. Exhibit LKT8 - comprises the details of the Applicant's existing registrations for marks: UK00003284107 Incognito Bar; and UK00003329140 Incognito (figurative mark).
31. The presence, or otherwise, of other marks on the Register containing 'incognito' has no bearing on the instant proceedings. My assessment is concerned only with the marks pertinent to this particular opposition.
32. Exhibit LKT9 – has been adduced to support the Applicant's claim that its trade mark 'has acquired a reputation'. It comprises details of media coverage including: industry magazine articles; TV; award wins; Trip Advisor profile; social media presence and a Youtube promo video (on a USB stick).

- A screenshot of a social media post showing that the Applicant participated in Channel 4 television programme 'Extreme Chocolate Makers', dated 24 April 2019.
- A photograph of a feature from 'Class magazine' on cocktails. This is, unfortunately, illegible.
- A photograph of a feature from 'Henley Bridge Magazine' dedicated to the Applicant's Incognito venue in Winchester.
- A list of awards won – no evidence of these awards by way of, e.g. correspondence from the awarding organisations/bodies or copies of the awards themselves, have been included though.
- Screenshots from Tripadvisor showing reviews of the Applicant's Incognito venue in Winchester. The Applicant indicates that there are 768 reviews in total as at 26 February 2021. The reviews included in the exhibit are very favourable and give '5/5' ratings, but they are dated December 2020 i.e. after the filing dates of the Applicant's marks with which these proceedings are concerned. Consequently, they do not have as much probative value as evidence related to the period before the filing dates.
- A screenshot of the Applicant's Instagram account for 'Incognito Cocktail Bars' shows 9,686 followers as at 26 Feb 2021. The number of followers as at the dates of the filing of the applications cannot be discerned.
- A promotional video for the Applicant's Incognito venue in Winchester. Ms Trapnell has stated that the video has had nearly 600 views, however I am unable to ascertain how many views there had been as at the filing dates of applications.

33. Exhibit LKT10 - comprises the details of the three applications with which these proceedings are concerned, obtained from the IPO website. This does not constitute evidence.

34. Exhibit LKT11 - comprises a copy of one of the pages from the Opponent's website which Ms Trapnell states 'shows the name INKO NITO presented as separate words. The Tribunal's assessment of the likelihood of confusion between the marks is based on the marks as registered. This exhibit is therefore superfluous.

35. Exhibit LKT12 - comprises a video clip on YouTube (<https://www.youtube.com/watch?v=SyWZZBvupk8>) which Ms Trapnell states 'demonstrates an independent pronunciation of the words INKO NITO at approximately 3 minutes 30 seconds into the video clip'.

36. The following Decision has been made after careful consideration of the papers before me.

## **Decision**

### **Section 5(2)(b) of the Act and related case law**

37. Section 5(2)(b) of the Act states:

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

(a) ...

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

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

38. The following principles are derived from the decisions of the 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 C120/04; *Shake di L. Laudato & C. Sas v OHIM*, Case C-334/05P; and *Bimbo SA v OHIM*, Case C-591/12P

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

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

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

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

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

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

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

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

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

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

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

## **Comparison of goods and services**

### **39. Similarity of goods and services – Nice Classification**

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.”

40. I must therefore be mindful of the fact that the appearance of respective goods in the same class is not a sufficient condition for similarity between those goods or services.

41. The General Court in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05 held that:

“29. ... 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 für 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”.

42. The Tribunal may group goods (or services) together for the purposes of assessment:

*Separode Trade Mark* BL O-399-10 (AP):

“The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision.”

43. The CJEU in *Canon*, Case C-39/97, stipulates that all relevant factors relating to the parties’ goods and services must be taken into account:

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

44. Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281<sup>11</sup>, identified the following factors for assessing similarity of the respective goods and services:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found, or likely to be found, in supermarkets and, in particular, whether they are, or are likely to be, found on the same or different shelves;

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<sup>11</sup> *British Sugar Plc v James Robertson & Sons Ltd* [1996] R. P. C. 281, pp 296-297.

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

45. Goods or services will be found to be in a competitive relationship only where one is substitutable for the other.<sup>12</sup>

46. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods [or services]. In *Boston Scientific Ltd v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

47. The goods and services to be compared are as follows:

Opponent’s mark:	Applied-for marks:
<p><b>Class 33:</b> <i>Alcoholic beverages (except beers).</i></p> <p><b>Class 43:</b> <i>Restaurant services; bar services; café services; catering services; provision of food and drink.</i></p>	<p>i) UK00003436609</p> <p>Incognito</p> <p><b>Class 43:</b> <i>Bar and restaurant services; Bar services; Bars; Beer bar services; Beer garden services; Food and drink catering; Food and drink catering for banquets; Food and drink catering for</i></p>

<sup>12</sup> *Lidl Stiftung & Co KG v EUIPO*, Case T-549/14.

	<p><i>cocktail parties; Food and drink catering for institutions; Food preparation; Hookah bar services; Hookah lounge services; Hotel accommodation reservation services; Hotel accommodation services; Hotel catering services; Hotel services; Hotels; Hotels and motels; Hotels, hostels and boarding houses, holiday and tourist accommodation; Restaurant and bar services; Restaurant information services; Restaurant services; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Restaurants; Services for the preparation of food and drink; Services for the provision of food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Serving of alcoholic beverages; Sommelier services; Wine bar services; Wine bars; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Provision of information relating to bars; Provision of information relating to restaurants; Provision of information relating to the preparation of food and drink; Public</i></p>
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	<p><i>house services; Pubs; Rental of bar equipment; Lounge services (Cocktail -); Night club services [provision of food]; Private members dining club services; Private members drinking club services; Providing drink services; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink in bistros; Providing information about bar services; Providing information about bartending; Providing information about restaurant services; Providing of food and drink; Providing restaurant services; Providing reviews of restaurants and bars; Cafe services; Café services; Cafés; Cafeterias; Carry-out restaurants; Cocktail lounge buffets; Cocktail lounge services; Cocktail lounges; Coffee bar services; Coffee shop services; Coffee shops.</i></p>
	<p>ii) UK00003443582  Incognito Cocktail Company  <b>Class 33:</b></p>

	<p><i>Absinthe; Aguardiente [sugarcane spirits]; Akvavit<sup>13</sup>; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs; Alcoholic beverages containing fruit; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic beverages [except beers]; Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated beverages, except beer; Alcoholic cocktail mixes; Alcoholic cocktails; Alcoholic cocktails containing milk; Alcoholic cocktails in the form of chilled gelatins; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic preparations for making beverages; Alcoholic punches; Alcoholic tea-based beverage; Alcopops; Amontillado<sup>14</sup>; Anise [liqueur]; Anisette; Anisette [liqueur]; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Aquavit; Arak; Arak [arrack]; Arrack; Arrack [arak]; Baijiu [Chinese</i></p>
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<sup>13</sup> Spirit distilled from potatoes and grain and infused with herbs.

<sup>14</sup> A type of sherry wine.

	<p> <i>distilled alcoholic beverage];</i>  <i>Beverages (Alcoholic -), except beer;</i>  <i>Beverages containing wine [spritzers];</i>  <i>Beverages (Distilled -); Bitters; Black</i>  <i>raspberry wine (Bokbunjaju);</i>  <i>Blackcurrant liqueur; Blended whisky;</i>  <i>Bourbon whiskey; Brandy; Cachaca;</i>  <i>Calvados; Canadian whisky; Cherry</i>  <i>brandy; Chinese brewed liquor</i>  <i>(laojiou); Chinese mixed liquor</i>  <i>(wujiapie-jiou); Chinese spirit of</i>  <i>sorghum (gaolian-jiou); Chinese white</i>  <i>liquor (baiganr); Chinese white liquor</i>  <i>[baiganr]; Cider; Ciders; Cocktails;</i>  <i>Coffee-based liqueurs; Cooking</i>  <i>brandy; Cordials [alcoholic</i>  <i>beverages]; Cream liqueurs; Curacao;</i>  <i>Digesters [liqueurs and spirits];</i>  <i>Distilled beverages; Distilled rice</i>  <i>spirits [awamori]; Distilled spirits;</i>  <i>Distilled spirits of rice (awamori); Dry</i>  <i>cider; Extracts of spiritous liquors;</i>  <i>Fermented spirit; Flavored tonic</i>  <i>liquors; Fortified wines; Fruit</i>  <i>(Alcoholic beverages containing -);</i>  <i>Fruit extracts, alcoholic; Gaolian-jiou</i>  <i>[sorghum-based Chinese spirits]; Gin;</i>  <i>Ginseng liquor; Grain-based distilled</i>  <i>alcoholic beverages; Grappa; Herb</i>  <i>liqueurs; Hullless barley liquor;</i>  <i>Hydromel [mead]; Japanese liquor</i>  <i>containing herb extracts; Japanese</i>  <i>liquor containing mamushi-snake</i> </p>
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	<p>extracts; Japanese liquor flavored with Japanese plum extracts; Japanese liquor flavored with pine needle extracts; Japanese regenerated liquors (naoshi); Japanese sweet grape wine containing extracts of ginseng and cinchona bark; Japanese sweet rice-based mixed liquor (shiro-zake); Japanese sweet rice-based mixed liquor [shiro-zake]; Japanese white liquor (shochu); Japanese white liquor [shochu]; Kirsch; Korean distilled spirits (soju); Liqueurs; Liqueurs containing cream; Liquor-based aperitifs; Low alcoholic drinks; Malt whisky; Mead [hydromel]; Nira [sugarcane-based alcoholic beverage]; Peppermint liqueurs; Perry; Piquette<sup>15</sup>; Potable spirits; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Red ginseng liquor; Rice alcohol; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Sake; Sake substitutes; Sangria; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry;</p>
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<sup>15</sup> French wine term for a relatively low alcohol wine made from 'pomace' (the used seeds, stems and skins discarded by winemakers after the first pressing of grapes for standard wines).



	<p><i>Shochu (spirits); Sorghum-based Chinese spirits; Spirits; Spirits and liquors; Spirits [beverages]; Sugar cane juice rum; Sugarcane-based alcoholic beverages; Sweet cider; Tonic liquor containing herb extracts (homeishu); Tonic liquor containing mamushi-snake extracts (mamushi-zake); Tonic liquor flavored with japanese plum extracts (umeshu); Tonic liquor flavored with pine needle extracts (matsuba-zake); Vermouth; Vodka; Whiskey; Whiskey [whisky]; Whisky; Wine coolers [drinks]; Wine-based aperitifs.</i></p>
	<p>iii) UK00003462432  Incognito Cocktail Company [figurative mark]  <b>Class 33:</b>  <i>Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages except beers; Alcoholic beverages (except beers); Alcoholic bitters; Alcoholic cocktail mixes; Alcoholic cocktails; Cocktails; Pre-mixed alcoholic beverages; Pre-mixed alcoholic beverages, other than beer-based; Preparations for making alcoholic beverages; Prepared alcoholic cocktails; Prepared wine cocktails; Rum punch; Spirits; Vermouth; Vodka.</i></p>

48. The Opponent has included, in its written submissions, the following services comparison for its opposition to the application for UK00003436609 Incognito:

**No. 3436609 INCOGNITO – comparison of services**

<b>Earlier mark</b>	<b>Application</b>	
	<b>Identical</b>	<b>Similar to a medium degree</b>
<i>Restaurant services</i>	Bar and restaurant services.... Restaurant and bar services; Restaurant information services;Restaurant services;Restaurant services incorporating licensed bar facilities;Restaurant services provided by hotels;Restaurants.... Serving food and drink for guests in restaurants;Serving food and drink in restaurants and bars.... Provision of food and drink in restaurants... Provision of information relating to restaurants... Providing information about restaurant services... ..Providing restaurant services... Providing reviews of restaurants and bars ...Carry-out restaurants	Hotel accommodation reservation services;Hotel accommodation services..... Hotel services;Hotels;Hotels and motels;Hotels, hostels and boarding houses, holiday and tourist accommodation
<i>bar services</i>	Bar services;Bars;Beer bar services;Beer garden services... Hookah bar services;Hookah lounge services... Sommelier services;Wine bar services;Wine bars... Provision of information relating to bars... Public house services;Pubs;Rental of bar equipment;Lounge services (Cocktail -)... Providing information about bar services;Providing information about bartending ...Cocktail lounge buffets;Cocktail lounge services;Cocktail lounges..	Hotel accommodation services..... Hotel services;Hotels;Hotels and motels;Hotels, hostels and boarding houses, holiday and tourist accommodation
<i>café services</i>	Providing food and drink in bistros... Cafe services;Café services;Cafés;Cafeterias... Coffee bar services;Coffee shop services;Coffee shops	Hotel accommodation services..... Hotel services;Hotels;Hotels and motels;Hotels, hostels and boarding houses, holiday and tourist accommodation
<i>catering services</i>	Food and drink catering;Food and drink catering for banquets;Food and drink catering for cocktail parties;Food and drink catering for institutions; Food preparation... Hotel catering services.... Providing food and drink catering services for convention facilities;Providing food and drink catering services for exhibition facilities;Providing food and drink catering services for fair and exhibition facilities	Hotel accommodation services ...Hotel services;Hotels;Hotels and motels;Hotels, hostels and boarding houses, holiday and tourist accommodation

<i>provision of food and drink</i>	Food preparation ...Services for the preparation of food and drink;Services for the provision of food and drink;Serving food and drink for guests.... Serving food and drinks;Serving of alcoholic beverages... Provision of food and beverages;Provision of food and drink... Provision of information relating to the preparation of food and drink... Night club services [provision of food];Private members dining club services.. Private members drinking club services ...Providing drink services;Providing food and beverages;Providing food and drink... Providing food and drink for guests.. Providing food and drink in bistros... Providing of food and drink....	Hotel accommodation services..... Hotel services;Hotels;Hotels and motels;Hotels, hostels and boarding houses, holiday and tourist accommodation
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49. I also note the Opponent's argument that certain of the Applicant's services fall under more than one of the Opponent's terms e.g. that *private members dining club services* is identical to both *provision of food and drink* and *restaurant services*.<sup>16</sup>

50. The Opponent submits that all of the goods in respect of which the remaining two remaining applications (UK00003443582 and UK00003462432) are sought are identical to the Opponent's goods. It is also submitted<sup>17</sup> that *Alcoholic preparations for making beverages* and *Preparations for making alcoholic beverages* are 'subcategories of *Alcoholic beverages (except beers)*, in the alternative they are complementary and therefore highly similar'.

51. The Applicant has submitted the following in its written submissions:

The Opponent asserts that the classification of goods/services is identical or highly similar. However, this in itself is not a reason on which to base an opposition or to refuse to register the applications. Classes 43 and 33 are wide classes and their very nature anticipates use by multiple trading entities. The Opponent trades ONLY in the Japanese market. The Applicant trades ONLY in the cocktail and bar services market – the consumers wanting Japanese food and drink are *entirely different* from those seeking a quirky cocktail experience.

<sup>16</sup> Opponent's written submission in lieu of hearing, paragraph [11].

<sup>17</sup> As above, paragraph [20].

52. As already noted, the goods and services comparison concerns the *specifications* of the respective marks; any differences that cannot be discerned from those specifications are irrelevant.

53. I will deal with each mark in turn, making my comparison with reference to the Applicant's goods and services, all of which have been opposed.

54. i) UK00003436609

The following of the Applicant's goods appear in the Opponent's specification and are therefore identical with the Opponent's goods:

*Bar services; Restaurant services; Café services; Cafe services.*

The following of the Applicant's goods are self-evidently identical with the Opponent's goods:

*Bars; Pubs; Public house services; Wine bars; Wine bar services; Beer bar services; Beer Garden Services; Cocktail lounges; Cocktail Lounge Services; and Lounge Services (Cocktail -), are self-evidently identical to the Opponent's Bar services;*

*Restaurants and providing restaurant services are self-evidently identical to the Opponent's Restaurant services;*

*Cafés and Cafeterias are self-evidently identical to the Opponent's Café services.*

55. I group the following of the Applicant's services together:

*Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food preparation; Hotel catering services; Services for the preparation of food and drink; Services for the provision of food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Serving of alcoholic beverages; Provision of food and beverages; Provision of food and drink; Provision of food*

*and drink in restaurants; Night club services [provision of food]; Private members dining club services; Private members drinking club services; Providing drink services; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink in bistros; Providing of food and drink; Carry-out restaurants; Cocktail lounge buffets; Coffee shops; Coffee bar services; Coffee shop services*

All of these services relate to the provision of food and drink.

56. All of the above terms fall under the Opponent's broad term *provision of food and drink*. They are therefore *Meric* identical with the Opponent's services.

57. I group the following of the Applicant's services together:

*Bar and restaurant services; Restaurant and bar services; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Sommelier services.*

All of these terms are services relating to restaurants and/or bars.

58. The Applicant's broad term *Bar and restaurant services* (and, therefore, *Restaurant and bar services*) will include the Opponent's term *Restaurant Services*. The remainder of the Applicant's terms enumerated above fall under the Opponent's broader term *Restaurant services*.

59. Consequently, all the Applicant's services listed at [57] are *Meric* identical with the Opponent's services.

60. I group the following of the Applicant's services together:

*Hookah*<sup>18</sup> *bar services; Hookah lounge services.*

Both of these terms relate to bars providing facilities to smoke flavoured tobaccos. These bars also typically provide beverages; they *may* provide food, but not necessarily.

61. These terms fall under the Opponent's broader term *bar services*; they are therefore *Merit* identical with Opponent's services.

62. I group the following of the Applicant's services together:

*Hotel accommodation services; Hotel services; Hotels; Hotels and motels; Hotels, hostels and boarding houses, holiday and tourist accommodation.*

All of these terms are services relating to accommodation.

63. I compare these terms against the Opponent's *provision of food and drink*. The respective services overlap to the extent that both provision of accommodation services and *provision of food and drink* are services within the hospitality sector whose purpose is to ensure the comfort of the consumers of those services. The respective users will often overlap; users of hotel or other accommodation services will often require food and drink services. The physical nature of the respective services will differ to the extent that *provision of food and drink* will always entail food or drink being served, or provided, to the consumer; whereas hotel and accommodation services are provided in relation to the consumer lodging at a particular accommodation provider. It is acknowledged, however, that providing breakfast, for example, will often be part of a 'package' of accommodation provided by a hotel. In the case of both parties' services, the consumer will book the service either online, by telephone or in person on the premises. Trade channels will sometimes be shared; for example, a hotel with a restaurant will likely have a website offering a booking facility for both room and

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<sup>18</sup> A hookah is a device used for smoking flavoured tobaccos. Hookah bars are sometimes referred to as shisha bars.

table bookings. I do not find the respective services to be in a competitive relationship; accommodation services and food and drink services are not substitutable. There is a measure of complementarity to the extent that the provision of breakfast, for example, is part of a 'bed and breakfast' booking.

64. Consequently, I find that the Applicant's services listed at [62] are similar to the Opponent's services to a medium degree.

65. I now compare the Applicant's *Hotel accommodation reservation services* against the Opponent's *Restaurant services*.

66. *Hotel accommodation reservation services* concern the arranging of hotel room bookings and are likely to be offered by a third party rather than the hotel itself, although I recognise that many hotels can also be booked directly. *Restaurant services* relate to the serving of food and drink. The purposes of the respective services are therefore very different. Users of *restaurant services* will be consumers intending to dine, the majority of whom will be members of the general public; I recognise that some consumers will be corporate diners. Users of the Applicant's services will comprise the professional public, i.e. hotel businesses seeking to outsource the managing of bookings to a third-party provider of these services. Although members of the general and professional public will be end-users by virtue of making room bookings via the booking facility provided by the third-party, they are not *buying* those services. Users in the sense of the ultimate purchasers of the respective services will therefore be different.

67. The physical nature of the respective services will differ; provision of *restaurant services* entails serving food and drink whereas providing hotel reservations services entails facilitating room bookings. I consider it unlikely that trade channels will be shared; a hotel seeking a service-provider to manage its room bookings is unlikely to visit the websites of restaurants to this end. I find the respective services to be neither in competition nor complementary. Consequently, I find the Applicant's *Hotel accommodation reservation services* to be dissimilar to the Opponent's *Restaurants services*.



68. In my view, comparison with any other of the Opponent's terms will not yield any similarity.

69. I now compare the Applicant's *rental of bar equipment* against the Opponent's *bar services*.

70. The purpose of *bar services* is the provision of a place for the consumer, in most cases a member of the general public, to purchase and consume drinks (and possibly food). The purpose and user of *rental of bar equipment* are different; consumers of these services will almost always be businesses in the hospitality trade e.g. pubs/bars/restaurants/hotels, although I recognise that some members of the general public might rent bar equipment for a private party. The physical nature of the respective services will differ: *bar services* will entail provision of consumables i.e. drinks (and perhaps food) whereas *rental of bar equipment* entails provision of the use of equipment. Trade channels will be distinct: consumers of *bar services* will receive those services in physical premises i.e. bars, public houses; consumers seeking to rent bar equipment will likely order the equipment online or via telephone before receiving delivery of it at their premises. It is, in my view, unlikely that bars, pubs etc would also offer a rental service for bar equipment. I do not find the respective services to be in competition with one another. I do not find complementarity either; although the rental of bar equipment will be important for many businesses providing bar services, it is, in my view, unlikely that the average consumer would presume both services to be provided by the same undertaking. Consequently, I find the Applicant's *rental of bar equipment* to be dissimilar to the Opponent's *bar services*.

71. In my view, comparison with any other of the Opponent's terms will not yield any similarity.

72. I group together the following of the Applicant's terms, all being services concerning the provision of information in relation to bars, restaurants or preparation of food and drink:

*Restaurant information services; Provision of information relating to bars; Provision of information relating to restaurants; Provision of information relating to the preparation of food and drink; Providing information about bar services; Providing information about bartending; Providing information about restaurant services; Providing reviews of restaurants and bars.*

73. I compare the above terms against the Opponent's *provision of food and drink*.

The purpose and users of the respective services will be different. The services listed above (with the exception of *providing reviews of restaurants and bars*) entail providing information to businesses whose core activity is the serving of food and/or drink. Services under the term *providing reviews of restaurants and bars* will also be purchased by businesses in the food and drink trade; but with the aim of promoting their businesses. The Opponent's *provision of food and drink* encompasses services whose end user is, in most cases, the general public. The physical nature of the respective services will differ: the Applicant's services concern the provision of information; whereas the *provision of food and drink*, self-evidently, entails providing food and/or drink. Trade channels will be different. The Opponent's services will be provided from food and drink outlets, i.e. pubs, bars, restaurants, cafes etc, and service providers will often have their own websites to advertise their outlets. The Applicant's 'information' services will likely be advertised online and in trade publications; consumers will engage these services either online, by telephone or in person at the service-provider's premises. Consumers are highly unlikely to purchase the respective services via the same website or from the same premises. I do not find any competition or complementarity between the respective services. Consequently, I find the Applicant's services, listed at [72], to be dissimilar to the Opponent's *provision of food and drink*.

74. In my view, comparison with any other of the Opponent's terms will not yield any similarity.

75. ii) UK00003443582

I group all of the Applicant's class 33 goods together with the exception of the following (which I will deal with subsequently):

*Alcoholic essences; Alcoholic extracts; Alcoholic fruit extracts; Alcoholic preparations for making beverages; Cooking brandy; Extracts of spiritous liquors; Fruit extracts, alcoholic; Preparations for making alcoholic beverages.*

With the exception of those listed above, the Applicant's goods fall under the Opponent's broad term *Alcoholic beverages (except beers)*. They are therefore *Merit* identical.

76. The goods listed above are considered separately because, in my view, they are ingredients used in beverages (with the exception, perhaps, of *cooking brandy*, which is self-evidently an ingredient in cooking) rather than standalone drinks themselves. I compare them against the Opponent's *Alcoholic beverages (except beers)*. There will be some overlap in purpose to the extent that some alcoholic beverages (except beers) are also used as components of drinks, e.g. cocktails. The respective goods differ to the extent that the Applicant's goods will be used in much smaller amounts by virtue of their concentration or potency. There will be user overlap; both will be used by members of both the general and professional public. The physical nature of the respective goods is similar to the extent that many of the goods listed above are liquids; however, some may be syrups. Trade channels will be shared; physical and online shops. The respective goods will be found in the 'alcohol' sections of shops, possibly sometimes on the same shelves. There will be a measure of competition in some instances; e.g. where a cocktail recipe calls for a particular alcoholic preparation for which a liqueur could be used as an alternative. The goods are not complementary: although the Applicant's goods are ingredients used in cocktails, in my view, the average consumer will unlikely presume that they originate from the same undertaking. Consequently, I find that the Applicant's goods listed at [75] are similar to the Opponent's goods to a medium-high degree.

77. iii) UK00003462432

All of the Applicant's goods, bar *preparations for making alcoholic beverages*, fall within the Opponent's broad term *Alcoholic beverages (except beers)*. They are therefore *Merici* identical with the Opponent's goods.

78. I have already found *preparations for making alcoholic beverages* to be similar to the Opponent's *Alcoholic beverages (except beers)* to a medium-high degree.

### **Average consumer and the purchasing act**

79. 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*.

80. In *Hearst Holdings Inc*<sup>19</sup> Birss J. (as he then was) described the average consumer thus:

“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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

81. I consider that the average consumer of the class 43 services will depend on the particular service. *Restaurants, cafes, bars and coffee shops*, for example, will be used predominantly by members of the general public. However, services such as *rental of bar equipment and providing food and drink catering services for fair and exhibition facilities* will, in most cases, be purchased by the professional public. The average consumer will therefore include both the general and

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<sup>19</sup> *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).


professional public. The services will be booked online, via telephone or in person at the service-provider's premises. The purchasing act will be visual to the extent that: for online bookings, the consumer will view information about the services via the service-provider's website; in-person bookings will be made having entered the service-provider's premises. In both situations, the purchaser will have encountered the parties' marks on the website or on the façade of the premises. I acknowledge that there will be an aural aspect to the purchasing act by way of word-of-mouth recommendations and where the purchaser has made enquiries of services on offer before completing a purchase. I consider the attention level of the average consumer to be in the average to high range, depending on the service being sought. For example, a business seeking to book catering for a corporate event will, in my view, pay a high level of attention; whereas the attention level of a member of the general public ordering a coffee will be average.

82. I now consider the class 33 goods. The respective goods will be purchased either as sealed goods, for consumption at a time of the purchaser's choosing, from physical shops/supermarkets or online stores; or as 'ready-to-drink' beverages from a public house/bar or restaurant. Purchases made from physical shops will, in most cases, be visual in nature; the purchaser self-selecting the goods from shelves. Some purchases will be made aurally by way of requests to retail staff. In a pub or bar setting, the average consumer will order from the bar by way of aural request. There will, in many instances, nevertheless be a visual aspect to the purchasing act to the extent that the beer pumps/taps, spirit optics and bottles containing other beverages on display along or near the bar will be viewed before the purchaser makes their choice.<sup>20</sup> The average consumer may consider factors such as alcohol content and, in the case of wines, vintage and compatibility with certain foods. Some alcoholic goods, for example, spirits, are expensive. Consequently, in my view, the level of attention displayed when purchasing the respective goods will be medium.

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<sup>20</sup> *Rani Refreshments FZCO v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-523/12 and *Simonds Farsons Cisk plc v OHIM*, Case T-3/04, both General Court.

## Comparison of the marks

Opponent's (earlier) mark	Applicant's (contested) marks
<p><b>INKO NITO</b></p>	<p>i) <b>Incognito</b></p> <p>ii) <b>Incognito Cocktail Company</b></p> <p>iii) [figurative mark]</p> <div style="text-align: center;">  </div>

83. 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“...it is necessary to ascertain, in each individual case, the overall

impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

84. 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.

85. The Opponent’s mark comprises two word elements, ‘INKO NITO’, in a plain uniform font, all letters being in upper case. The overall impression of the mark resides in its entirety.

86. The Applicant’s marks:

i) Incognito – this mark comprises a single word in a plain uniform font, the first letter being in upper case. The overall impression resides in its entirety.

ii) Incognito Cocktail Company – this mark comprises three words ‘Incognito Cocktail Company’, in a plain uniform font with the first letter of each word in upper case. ‘Incognito’ is the more dominant element and carries more weight in the visual impression because the words ‘Cocktail Company’ are descriptive.

iii) Incognito Cocktail Company [Figurative mark] – this is a complex figurative mark that includes word elements. An image of a big cat in what might be described as Edwardian costume (i.e. a top hat, double-breasted jacket, starched collar, cravat and pocket watch) is set against a background featuring a section of a world atlas. The central image of the big cat is surrounded by what appear to be stylised acanthus leaves arranged to suggest an ornate mirror frame. A curved banner or ribbon shape is arranged below the cat but overlaid to appear as if the ‘banner’ is in front of it. The ends of the banner are ‘scrolled’ and appear to almost partly wrap around the animal. The word ‘INCOGNITO’ appears across

the banner, in a slightly stylised script, all letters in upper case and emboldened relative to the small word element beneath it. The words ‘Cocktail Company’ appear below the banner in a much smaller standard serif font, the first letter of each word being in upper case. The mark is rendered in muted tones. The big cat device will play an important role in the overall impression owing to its size and central position. The ‘atlas’ background will play a lesser role owing to the muted colour and faintness of the details. In my view, the eye will be drawn to the ‘INCOGNITO’ word element first. The mind generally ‘latches’ on to verbal elements of a mark because they can be articulated. Also, the word is shown on the ‘banner’ which, owing to its curved nature and scrolled ends, appears set forward of the animal and frame devices as if 3-dimensional.

#### 87. Visual comparison

I will compare the Opponent’s mark against each of the Applicant’s marks in turn.

##### i) Incognito:

Both marks are relatively short and in plain fonts. Both begin ‘in’, have ‘o’ as their fourth letter and share ‘nito’ as an ending. Points of difference are: the earlier mark being comprised of two separate word elements as compared to the Applicant’s one word mark; the presence of the letter ‘k’ in the earlier mark, absent in the Applicant’s mark; and the presence of the letter ‘g’ in the Applicant’s mark, absent in the earlier mark.

Courts have been willing to find similarity of marks where there is an identical verbal element that is shared by the respective marks, even though the remaining letters are different. The General Court in the case of *Lancôme v OHIM*<sup>21</sup> considered the word marks ‘ACNO FOCUS’ and ‘FOCUS’ and concluded that there was a certain visual similarity between them by virtue of both marks containing the common element ‘FOCUS’.

In *El Corte Inglés, SA v OHIM*, the General Court observed that the attention of the consumer is *usually* [my emphasis] directed to the beginning of a word

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<sup>21</sup> Case T-466/08 *Lancôme Parfums et Beauté & Cie v OHIM* EU:T:2011:182, para [63].



mark<sup>22</sup>, but I am mindful that this is not an absolute rule.

Consequently, I find the respective marks to be similar to at least a medium degree.

ii) Incognito Cocktail Company:

The 'Incognito' element of the mark has been dealt with. The respective marks differ in length; the Applicant's three words as compared to the Opponent's two-word mark. Other points of difference are the presence of the words 'Cocktail Company' in the Applicant's mark, and their absence from the earlier mark. Although the 'Cocktail Company' element will be seen by the average consumer, it will have a lesser visual impact than 'Incognito' because it is descriptive. Consequently, I find that the level of visual similarity between the respective marks is medium.

iii) Incognito Cocktail Company [Figurative mark]:

The 'Incognito' and 'Cocktail Company' elements of the mark have been dealt with. The Applicant's mark is a complex figurative mark, albeit including word elements, whereas the earlier mark is a simple word-only mark. Consequently, I find a low level of similarity between the respective marks.

## 88. Aural comparison

i) Incognito:

The Opponent's mark has four syllables and will be articulated as 'in-coe-nee-toe', with the emphasis on the third syllable, as demonstrated by the Applicant's sound file exhibited at LKT12. The Applicant's mark also has four syllables and will be articulated as 'in-cog-nee-too'. The first, third and final syllables of the respective marks are aurally identical. The only aural difference is in the second syllable. Consequently, I find the marks to be highly aurally similar.

ii) Incognito Cocktail Company and iii) Incognito Cocktail Company [Figurative mark]:

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<sup>22</sup> Cases T-183/02 and T-184/02 at para [83].

For both of the above marks, I consider that the vast majority of average consumers will omit to articulate the 'Cocktail Company' component; in which case the respective marks will be highly aurally similar. If 'Cocktail Company' is articulated, then the respective marks will be aurally similar to a low degree.

89. Conceptual comparison

The Opponent submits that the individual components of its mark 'have no recognisable meaning' but that consumers will 'recognise the resemblance to the word 'INCOGNITO''<sup>23</sup>. It is argued that "for those consumers who recognise the resemblance of the earlier mark to the word incognito, the marks are conceptually identical because they both convey the idea of something being disguised"<sup>24</sup>.

90. The Applicant submits that the respective marks are 'conceptually completely different': that 'Incognito' is 'entirely English' and conveys the idea of being 'shrouded in mystery'; and that 'INKO NITO' is a Japanese word meaning 'parakeet or parrot'.<sup>25</sup>

91. In my view, a large proportion of average consumers would not ascribe a meaning to 'INKO NITO' but would perceive it as a made-up phrase or, at best, 'Japanese-sounding' words. In my view, although the words might remind some consumers of the word 'incognito', this will unlikely detract from their perception that they are made-up words. I appreciate that there will be *some* average consumers who will understand Japanese, but I consider that this will be a much smaller group.

92. i) Incognito:

The word 'incognito' appears in the English dictionary<sup>26</sup>:

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<sup>23</sup> Opponent's written submissions in lieu of hearing, paragraphs [27] – [28].

<sup>24</sup> Opponent's written submissions in lieu of hearing, paragraph [34].

<sup>25</sup> Applicant's written submissions in lieu of hearing, paragraph [1.1]

<sup>26</sup> I understand from my own general knowledge that the word has its origins in the Italian language.

As an adverb: ‘with one’s identity concealed’; as a noun: ‘one appearing or living incognito’<sup>27</sup>. ‘Someone who is incognito is using a false name or wearing a disguise, in order not to be recognised or identified’<sup>28</sup>.

In my view, although ‘incognito’ appears in the English dictionary, it is not a word often used. I recognise, however, that some web browsers use the term ‘incognito’ for the private browsing mode and that some consumers will therefore have encountered the term in this way. I consider that, although many consumers will be familiar with the word, a significant proportion will not appreciate its precise meaning. I must be mindful of the extent to which certain knowledge may be ascribed to the average consumer.<sup>29</sup> To my mind, a significant number of average consumers will perceive ‘incognito’ as a word in the English language but without knowing its meaning; some may ascribe an Italianate character to it. For the group of average consumers who *know* the meaning of ‘incognito’, the Applicant’s mark will conjure notions of mystery and clandestine encounters; it would create the impression of an edgy and exclusive venue, perhaps reminiscent of a ‘speakeasy’<sup>30</sup>.

Consequently, I find that for the group of average consumers unfamiliar with the meanings of ‘inko nito’ or ‘incognito’, the terms will be perceived as made-up words, or, at best, ‘Japanese-sounding’ words and a word in the English language, respectively. For this group, the marks will be conceptually neutral; the average consumer will be unable to readily ascribe a concept to either mark. For group of average consumers familiar with the meanings of the marks, the marks will be conceptually dissimilar.<sup>31</sup>

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<sup>27</sup> <https://www.merriam-webster.com/dictionary/incognito>, accessed 26 July 2021 at 10:27.

<sup>28</sup> <https://www.collinsdictionary.com/dictionary/english/incognito>, accessed 26 July 2021 at 10:25.

<sup>29</sup> Ms Anna Carboni, as the Appointed Person in *Chorkee Ltd v Cherokee Inc* Case BL O/048/08 urged caution ‘not to assume that one’s personal experience, knowledge and assumptions are more widespread than they are.’ Despite it being a fact that the word Cherokee denotes the name of a tribe indigenous to North America, the Hearing Officer was not entitled to attribute this knowledge to the relevant average consumer.

<sup>30</sup> An illicit or ‘underground’ nightclub or bar in America in the 1920s and 1930s during the period when the sale of alcohol was illegal.

<sup>31</sup> For the average consumer who only knows the meaning of one or other of the marks, the marks will be conceptually dissimilar.

ii) Incognito Cocktail Company:

My observations above also apply to the comparison of the earlier marks against this particular mark. The presence of the words 'Cocktail Company' in the mark would, for average consumers familiar with the meaning of 'incognito', conjure the same ideas of secrecy and clandestine encounters but in a cocktail bar setting.

iii) Incognito Cocktail Company [Figurative mark]:

The above observations in respect of the word 'incognito' also apply to this mark. Additional concepts are conveyed by the figurative elements. The costume worn by the lion, together with the elaborate 'frame' and scrolled banner, evoke the Edwardian era. The muted tones also suggest a bygone era. The 'atlas' background suggests travel and adventure.

For the average consumers unfamiliar with the meaning of 'incognito', their perception of the mark will derive from the figurative elements only. For them, the mark would, in my view, conjure the notion of the old-fashioned drinking establishments of a century-or-so ago e.g. the Gin shops of Victorian London often portrayed in period dramas. The atlas device would suggest voyages to foreign lands. For average consumers who know the meaning of 'incognito', the mark, as a whole, would, in my view, conjure the idea of a cocktail bar favoured by a clandestine adventurer in a bygone era; the cat in costume would reinforce the notion of disguise.

Consequently, I find that, irrespective of whether the average consumer appreciates the meaning of 'incognito', the respective marks are conceptually dissimilar.

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

93. *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must

make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

94. I consider that ‘INKO NITO’ will, for a significant number of average consumers, be perceived as made up words to which no concept will be attached. The mark neither describes, nor alludes to, the goods and services in respect of which it is registered. Consequently, the Opponent’s mark is inherently distinctive to a high degree.

95. The Opponent has not shown in evidence that the mark has the capacity to identify the goods and services in respect of which it is registered with a level of immediacy beyond its inherent capacity to do so.

### **Likelihood of confusion**

96. Confusion can be direct or indirect. Mr Iain Purvis Q. C., as the Appointed Person, explained the difference in the decision of *L.A. Sugar Limited v By Back Beat Inc*<sup>32</sup>. Direct confusion occurs when one mark is mistaken for another. In *Lloyd Schuhfabrik*<sup>33</sup>, the CJEU recognised that the average consumer rarely encounters the two marks side by side but must rely on the imperfect picture of them that he has in his mind. Direct confusion can therefore occur by imperfect recollection when the average consumer sees the later mark before him but mistakenly matches it to the imperfect image of the earlier mark in his ‘mind’s eye’. Indirect confusion occurs when the average consumer recognises that the later mark is indeed different from the earlier mark, but, concludes that the later mark is economically linked to the earlier mark by way of being a ‘sub brand’, for instance.
97. Before arriving at my decision, I must make a global assessment taking into account all of the relevant factors, including the principles a) – k) set out above at [38].
98. When considering all relevant factors ‘in the round’, I must bear in mind that a greater degree of similarity between goods *may* be offset by a lesser degree of similarity between the marks, and vice versa.
99. The Applicant has also submitted that it ‘has gained a substantial reputation in its business and INCOGNITO brand’.<sup>34</sup>
100. In Joined Cases C-449/18 P and C-474/18 P, EU:C:2020:722, *EUIPO v Messi Cuccittini and J.M.-E.V. e hijos v Messi Cuccittini*, the CJEU held that all relevant factors should be taken into account in determining whether there is a likelihood of confusion. In an appropriate case, this could include the potential fame of the applicant on the average consumer’s perception of the contested trade mark. In this case, the reputation of Lionel Messi was such that it was implausible that the average consumer would not associate the trade mark with the footballer when

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<sup>32</sup> Case BL O/375/10 at [16].

<sup>33</sup> *Lloyd Schuhfabrik Meyer and Co GmbH v Klijsen Handel BV* (C-34297) at [26].

<sup>34</sup> Applicant’s written submissions in lieu of hearing, paragraph [3].

used on the goods at issue (in classes 9, 25 and 28); whilst some consumers may not make this association, they would not be typical of the average consumer of sports clothing and equipment. In assessing the likelihood of confusion, it was therefore permissible to take account of the conceptual difference between the marks as a factor which mitigated the risk of confusion from the visual and aural similarities between them.

101. The case of *Retail Royalty Company v Harringtons Clothing Limited* also considered the relevance of an Applicant's reputation to the conceptual meaning of a trade mark<sup>35</sup>.

102. In my view, the Applicant's evidence does not succeed in establishing that the mark 'Incognito' has, through use, 'acquired a level of immediately perceptible notoriety' in relation to the goods and services in respect of which registration is sought.

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<sup>35</sup> In *Retail Royalty Company v Harringtons Clothing Limited*, Phillip Harris, as the Appointed Person, considered the argument that the letters "AE" had, through their use, acquired an independent conceptual significance which would mean that the average consumer would always perceive them as meaning "AMERICAN EAGLE". He said:

"74. The Opponent is trying to equate reputation in a trade mark sense with conceptual meaning. They are not the same thing. Reputation can mean different things, and in trade mark law the term is sometimes used loosely, but in this context, it concerns the factual extent to which a sign is recognised by a significant part of the public *as a trade mark* [original emphasis].

75. In contrast conceptual meaning is, in simple terms, something akin to recognition in dictionaries (beyond a mere trademark acknowledgement) or a level of immediately perceptible notoriety/independent meaning, outside the confines of a purely trade mark context, of which judicial notice can be taken. Whilst a trade mark's reputation might evolve or be converted into a conceptual meaning (possibly to its detriment in terms of genericity), it needs to be properly proven.

76. It is true that there are cases where an extensive reputation has been parlayed into conceptual meaning (for example C-361/04 P *PICASSO/PICARO* and C-449/18 *MESSI*) but these are the exception rather than the rule and depend on their own facts. Furthermore, the "reputation" element in those cases related to the fame attached to the names of the individuals for their roles in society, rather than specifically to a trade mark function. In other words, it was a different sort of reputation."

103. I will deal with each opposition in turn.

104. i) Opposition 419224 – Incognito UK00003443582

My comparison of the respective goods and services has determined that:

- The following of the Applicant's services are **identical** with the Opponent's services:

*Bar services; Restaurant services; Café services; Cafe services; Bars; Pubs; Public house services; Wine bars; Wine bar services; Beer bar services; Beer Garden Services; Cocktail lounges; Cocktail Lounge Services; Lounge Services (Cocktail -); Restaurants; providing restaurant services; Cafés; Cafeterias; Food and drink catering; Food and drink catering for banquets; Food and drink catering for cocktail parties; Food and drink catering for institutions; Food preparation; Hotel catering services; Services for the preparation of food and drink; Services for the provision of food and drink; Serving food and drink for guests; Serving food and drink for guests in restaurants; Serving food and drink in restaurants and bars; Serving food and drinks; Serving of alcoholic beverages; Provision of food and beverages; Provision of food and drink; Provision of food and drink in restaurants; Night club services [provision of food]; Private members dining club services; Private members drinking club services; Providing drink services; Providing food and beverages; Providing food and drink; Providing food and drink catering services for convention facilities; Providing food and drink catering services for exhibition facilities; Providing food and drink catering services for fair and exhibition facilities; Providing food and drink for guests; Providing food and drink in bistros; Providing of food and drink; Carry-out restaurants; Cocktail lounge buffets; Coffee shops; Coffee bar services; Coffee shop services; Bar and restaurant services; Restaurant and bar services; Restaurant services incorporating licensed bar facilities; Restaurant services provided by hotels; Sommelier services; Hookah bar services; Hookah lounge services.*



- The following of the Applicant's services are **similar** to the Opponent's services **to a medium degree**:

*Hotel accommodation services; Hotel services; Hotels; Hotels and motels; Hotels, hostels and boarding houses; holiday and tourist accommodation.*

- The following of the Applicant's services are **dissimilar** to the Opponent's services:

*Hotel accommodation reservation services; rental of bar equipment; Restaurant information services; Provision of information relating to bars; Provision of information relating to restaurants; Provision of information relating to the preparation of food and drink; Providing information about bar services; Providing information about bartending; Providing information about restaurant services; Providing reviews of restaurants and bars.*

105. My comparison of the respective marks has determined that:

- The marks are visually similar to at least a medium degree;
- The marks are aurally similar to a high degree;
- For the group of average consumers who do not know the meaning of either mark, the marks will be conceptually neutral; whereas for the group familiar with the meaning of either 'INKO NITO' or 'Incognito', or both, the marks will be conceptually dissimilar.

106. In my view, the group of average consumers who do not know the meaning of either 'INKO NITO' or 'Incognito' will constitute a significant proportion.

107. I have found that the earlier mark is inherently distinctive to a high degree.

The CJEU held in *Sabel*<sup>36</sup> that:

“24. The more distinctive the earlier mark, the greater will be the likelihood of confusion.”<sup>37</sup>

108. I find that a significant proportion of average consumers would confuse the marks. The distinctiveness of the earlier mark derives from the fact that ‘INKO NITO’ will be perceived by a significant number of average consumers as made up words; the distinctive character of the Applicant’s mark derives from the perception that ‘Incognito’ is a made-up word. The fact that the respective services are either identical or similar to a medium degree, together with the levels of visual and aural similarity between the marks will, in my view, lead to direct confusion. For a substantial proportion of average consumers, the marks will be conceptually neutral; i.e. for either mark, there is no conceptual nexus between the marks. In these circumstances, the visual and aural aspects of the marks will play a greater role. I find that when the average consumer tries to remember the Applicant’s mark while, for example, seeking the Applicant’s venue, should they happen upon the *Opponent’s* venue, ‘Inko Nito’, they may well mistake it for the Applicant’s mark because the mind’s eye has failed to register the visual differences (i.e. ‘Ko’ and ‘Cog’) in the middle of the marks. There is a likelihood of confusion.

109. I have nevertheless recognised that there will be another group of average consumers who *will* understand the meaning of ‘incognito’. I bear in mind the

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<sup>36</sup> *Sabel BV v Puma AG* (C-251/95), [1998] E. T. M. R. 1 (1997) at [24].

<sup>37</sup> This principle was given an important qualification by Mr Iain Purvis Q.C, as the Appointed Person, in the decision of *Kurt Geiger v A-List Corporate Limited* BL O-075-13:

“39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything, it will reduce it.”

case of *Interflora Inc v Marks and Spencer plc* [2013]<sup>38</sup> in which it was held that there is no ‘single meaning rule’ according to which the court must ‘identify one, and one only, perception amongst the relevant class of average consumer, and judge confusion accordingly’. In *Soulcycle Inc v Matalan Ltd*<sup>39</sup>, Mann J. approved the principle that a ‘significant proportion’ of average consumers being confused is sufficient for a finding of likelihood of confusion.

110. ii) Opposition 419548 – Incognito Cocktail Company UK00003443582

My comparison of the respective goods and services has determined that:

- The following of the Applicant’s goods are **similar** to the Opponent’s goods to a **medium-high degree**:

*Alcoholic essences; Alcoholic extracts; Alcoholic fruit extracts; Alcoholic preparations for making beverages; Cooking brandy; Extracts of spiritous liquors; Fruit extracts, alcoholic; Preparations for making alcoholic beverages.*

- The remainder of the Applicant’s goods are **identical** with the Opponent’s goods.

111. My comparison of the respective marks has determined that:

- The level of visual similarity between the respective marks is medium;
- If the ‘Cocktail Company’ element of the Applicant’s mark is not articulated, then the marks will be highly aurally similar; if ‘Cocktail Company’ is articulated, then the level of aural similarity will be low;
- For the average consumer who does not know the meaning of either of the marks, the respective marks will be conceptually neutral; whereas for the

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<sup>38</sup> EWHC 1291 (Ch)

<sup>39</sup> [2017] EWHC 496 (Ch)

group familiar with the meaning of either 'INKO NITO' or 'Incognito', or both, the marks will be conceptually dissimilar.

112. In my view, despite the fact that the similarity of the respective goods ranges from a medium-high degree of similarity to identity, the visual differences between the marks are sufficient for me to find that there is no likelihood of direct confusion.

113. However, the following observations lead me to conclude that there is a likelihood of *indirect* confusion:

- As noted above, the group of average consumers who do not know the meaning of either 'INKO NITO' or 'Incognito' will constitute a significant proportion. The absence of a conceptual aspect for the mind to fix upon when recalling the marks from memory would, in my view, cause perception of the difference in spelling to be diminished, thus leading to imperfect recollection.
- The presence of 'Cocktail Company' in the Applicant's mark (and its absence in the Opponent's mark) would nevertheless be noticed.
- The marks have a high degree of aural similarity if the 'Cocktail Company' element of the mark is not articulated.
- I find that the culmination of these factors will result in a significant proportion of average consumers concluding that the marks relate to economically-linked undertakings e.g. that the Applicant's mark relates to a 'cocktail bar' outlet related to the Opponent.

114. iii) Opposition 420851 – Incognito Cocktail Company [Figurative mark] UK00003462432

My comparison of the respective goods and services has determined that:

- With the sole exception of *preparations for making alcoholic beverages*, all of the Applicant's goods are **identical** with the opponent's goods.
- The Applicant's *preparations for making alcoholic beverages* are **similar** to the Opponent's goods to a **medium-high degree**:

115. My comparison of the respective marks has determined that:

- The level of visual similarity between the respective marks is low;
- If the 'Cocktail Company' element of the Applicant's mark is not articulated, then the marks will be highly aurally similar; if 'Cocktail Company' is articulated, then the level of aural similarity will be low;
- The respective marks are conceptually dissimilar.

116. In my view, the visual differences between the marks are sufficient for me to find that there is no likelihood of direct confusion.

117. However, the following observations lead me to conclude that there is a likelihood of *indirect* confusion:

- The similarity of the respective goods ranges from a medium-high degree of similarity to identity;
- As already noted, a significant proportion of average consumers will not know the meaning of either 'INKO NITO' or 'Incognito'. Therefore, for this group, there will be no concept attached to either 'inko nito' or the 'incognito' aspect of the Applicant's mark. The concept conveyed by the Applicant's mark will derive from the figurative elements and the words 'Cocktail Company'. Where figurative marks are concerned, the average consumer usually 'fixes' upon the verbal elements of a mark because they

can be articulated. In my view, the absence of a conceptual nexus between the *incognito* and *inko nito* components of the marks will lead to imperfect recollection in the way that I have described above at [108].

- The visual differences between the respective marks, i.e. the figurative elements and ‘Cocktail Company’ wording present in the Applicant’s mark, absent from the Opponent’s mark, will be discerned by the average consumer.
- The marks have a high degree of aural similarity if the ‘Cocktail Company’ element of the mark is not articulated.
- I find that the culmination of these factors will result in a significant proportion of the average consumer concluding that the marks relate to economically-linked undertakings e.g. that the Applicant’s mark relates to a ‘cocktail bar’ outlet related to the Opponent.

## Final Remarks

### 118. i) Opposition 419224

This Opposition has been partially successful. The Application *may proceed* (subject, of course, to the outcome of any appeal) in respect of the following services only:

*Hotel accommodation reservation services; rental of bar equipment; Restaurant information services; Provision of information relating to bars; Provision of information relating to restaurants; Provision of information relating to the preparation of food and drink; Providing information about bar services; Providing information about bartending; Providing information about restaurant services; Providing reviews of restaurants and bars.*

The remainder of the Application is refused.

ii) Opposition 419548

This Opposition has succeeded in full. The Application is therefore refused in its entirety.

iii) Opposition 420851

This Opposition has succeeded in full. The Application is therefore refused in its entirety

## COSTS

119. I award the Opponent the sum of **£1,340** as contribution towards its costs, calculated as follows<sup>40</sup>:

Preparation of statement and consideration of the Applicant's statement:	£300
Official fee for 5(2)(b) only [£100 x 3]:	£300
Preparation of evidence:	£500
Written Submissions in lieu of hearing:	£300
<b>Sub-total:</b>	<b>£1,400</b>
Less £60 (to reflect the Applicant's partial success) <sup>41</sup>	
<b>Total:</b>	<b>£1, 340</b>

120. I therefore order Nick Robinson to pay to Azumi Limited **the sum of £1,340**.

This sum is to be paid within twenty-one days of the expiry of the appeal period

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<sup>40</sup> Based upon the scale published in Tribunal Practice Notice 2/2016.

<sup>41</sup> The Applicant has enjoyed partial success in respect of one of the three Oppositions, i.e. Opposition 419224. The sub-total of £1,400 has therefore been divided by 3 to give a 'per opposition' figure of £467. Opposition 419224 was successfully resisted in respect of 10 out of the 75-or-so terms in the applied-for specification i.e. approximately 13%. 13% of £467 is approximately £60. A deduction of £60 has therefore been applied.

or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 2nd day of August 2021**

**Mx N. R. Morris**

**For the Registrar,**

**the Comptroller-General**