

**O/853/21**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3523282  
BY THATCHERS CIDER COMPANY LIMITED  
TO REGISTER THE TRADE MARK:**

**ZING**

**IN CLASS 33**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 600001568  
BY WORLD OF ZING LTD**

## **Background and pleadings**

1. On 17 August 2020, Thatchers Cider Company Limited (“the applicant”) applied to register the trade mark **ZING** in the UK, under number 3523282 (“the contested mark”). The contested mark was published in the Trade Marks Journal for opposition purposes on 18 December 2020. Registration is sought for the following goods:

Class 33: Cider; Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

2. On 6 January 2021, World of Zing LTD (“the opponent”) filed a notice of opposition.<sup>1</sup> The partial opposition is brought under section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). Within its Form TM7F, the opponent indicated that its claim was directed against “alcoholic beverages (except beers); Alcoholic fruit beverages”. As it was not deemed sufficiently clear, the Tribunal wrote to the opponent on 26 October 2021 to request that it identify the specific goods in respect of which the opposition was directed. By response on 5 November 2021, the opponent confirmed that it had been its intention to oppose the following goods:

Class 33: Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

3. In my view, the goods identified by the opponent remain within the scope of the original opposition and the opponent’s response represents a clarification, rather than an amendment. I will, therefore, proceed to determine the opposition based upon those goods identified in the opponent’s response dated 5 November 2021.

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<sup>1</sup> In the Form TM7F, the name of the opponent was given as ‘Pritesh Mody, Director of World of Zing Ltd’. More shall be said about this below.

4. It is also worth mentioning at this point that the opponent's response included written submissions on the merits of the case. However, as the deadline for providing written submissions expired on 10 September 2021, I cannot take these into account.

5. The opponent relies upon its UK trade mark number 3439549, **World of Zing** ("the earlier mark"). The earlier mark was filed on 26 October 2019 and became registered on 24 January 2020 in respect of a range of goods and services in classes 30, 32, 33 and 43. However, for the purpose of the opposition, the opponent relies upon some of its goods, namely:

Class 33: Alcoholic cocktails; Alcoholic cocktails containing milk; Prepared alcoholic cocktails; Prepared wine cocktails; Alcoholic cocktail mixes; Prepared alcoholic cocktails; Prepared wine cocktails; 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 bitters; Alcoholic carbonated beverages, except beer; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches; Alcoholic tea-based beverage; Alcoholic wines; Alcopops; Aperitif wines; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Coffee-based liqueurs; Cordials [alcoholic beverages]; Distilled beverages; Distilled spirits; Fermented spirit; Flavoured tonic liquors; Fruit (Alcoholic beverages containing -); Fruit extract<sup>2</sup>

6. Given the respective filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it has not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods for which the earlier mark is registered without having to establish genuine use.

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<sup>2</sup> Although I note the full term in the opponent's class 33 specification is "*fruit extracts, alcoholic*", as will become apparent, these goods will have no impact on the outcome of this decision. Therefore, I reproduce it exactly as it appears within Form TM7F.

7. The opponent essentially argues that the respective goods are identical or similar and that the marks are similar, giving rise to a likelihood of confusion.

8. The applicant filed a counterstatement denying the claims made. It was not considered necessary to provide the applicant time in which to provide any submissions on the effect of the opponent's clarification. This is because the applicant's counterstatement was made in respect of the full specification of the applied-for goods, including all of those identified by the opponent within its response.<sup>3</sup> Further, within its counterstatement, the applicant had already provided submissions on the comparison of the parties' respective goods, as well as the global assessment of whether there is a likelihood of confusion, based upon this full specification.

9. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1 to 3 of rule 20 of the Trade Mark Rules 2008 but provides that rule 20(4) shall continue to apply. Rule 20(4) stipulates that "the Registrar may, at any time, give leave to either party to file evidence upon such terms as the Registrar thinks fit". The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.

10. The applicant is professionally represented by Stephens Scown LLP, whereas the opponent represents itself. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard only if (i) the Office requests it, or (ii) either party to the proceedings requests it and the Registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Neither party has filed written submissions in lieu of an oral hearing. This decision is taken following a careful perusal of the papers.

11. Although the UK has left the EU, section 6(3)(a) of the European Union (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

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<sup>3</sup> See counterstatement dated 9 August 2021, paragraph 2.

of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark case law.

### **Preliminary issue**

12. In its counterstatement, the applicant argues that the opposition ought to be dismissed as the opponent is not the owner of the earlier mark, submitting that:

“19. The Opponent is not the owner of the Earlier mark, suggesting that the Opposition has been invalidly filed. The Earlier mark is owned by World of Zing Ltd, whereas the Opposition has been submitted by “Pritesh Mody a director of World of Zing Ltd”. This indicates that this Opposition is invalid as only the proprietor of an earlier trade mark may oppose another mark on relative grounds.”

13. I note that the opponent is an unrepresented party. For the sake of convenience, I remind myself that question 3 of the Form TM7F, which reads “Full name of opponent”, was completed in the following manner:

“Pritesh Mody, Director of World of Zing Ltd”

14. I note that in its correspondence to the parties, the Tribunal has identified the opponent as being “Pritesh Mody”. However, I further note that the Form TM7F includes the following phrases at question 13: “[...] World of Zing has operated [...]” and “We have a huge media profile [...]” (emphasis added). In my view, when considered as a totality, I am satisfied that, as Mr Mody completed the Form TM7F in his capacity as the director and controlling mind of World of Zing LTD, it is palpably clear that the opponent in these proceedings is World of Zing LTD and not Mr Mody personally. There is no doubt that Mr Mody was filing the opposition on behalf of the company, that being the registered proprietor of the earlier mark. As such, while the name of the opponent could be regularised without issue – for example, by the filing of an amended Form TM7F – I do not consider it necessary to do so at this stage. Neither do I consider it appropriate to dismiss the opposition.

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

### **Legislation and case law**

15. Sections 5(2)(b) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because-

[...]

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

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

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

16. I am guided by the following principles which are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

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

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed

and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

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

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

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

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

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

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

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

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

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

17. 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.”

18. In *Gérard Meric v Office for Harmonisation in the Internal Market ('Merici')*<sup>4</sup>, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut 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”.

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<sup>4</sup> Case T-133/05



19. For the purposes of considering the issue of similarity of goods or services, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

20. The goods to be compared are as follows:

Opponent's goods	Applicant's goods
Class 33: Alcoholic cocktails; Alcoholic cocktails containing milk; Prepared alcoholic cocktails; Prepared wine cocktails; Alcoholic cocktail mixes; Prepared alcoholic cocktails; Prepared wine cocktails; 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 bitters; Alcoholic carbonated beverages, except beer; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic punches; Alcoholic tea-based beverage; Alcoholic wines; Alcopops; Aperitif wines; Aperitifs; Aperitifs with a distilled alcoholic liquor base; Coffee-based liqueurs; Cordials [alcoholic	Class 33: Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

beverages]; Distilled beverages; Distilled spirits; Fermented spirit; Flavoured tonic liquors; Fruit (Alcoholic beverages containing -); Fruit extract	
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21. In its counterstatement, the applicant describes various differences between the actual goods provided by the parties, submitting that:

“11. [...] Although both marks cover alcoholic beverages, the [contested] mark primarily covers cider and alcoholic fruit beverages and the Earlier mark focuses on alcoholic cocktails and spirits and liqueurs.”

[...]

“13. The Opponent is clearly aligning their products within the cocktail and ready-to-drink (RTD) drinks market. This is far removed from [the applicant’s] product market which is the cider beverage market.”

22. Pausing here, it is important to explain why, as a matter of law, these points will have no bearing on the outcome of this opposition.

23. Until a trade mark has been registered for five years, it is entitled to protection in relation to all the goods/services for which it is registered. As previously outlined, the opponent’s earlier mark had not been registered for five years at the filing date of the contested application. Consequently, the opponent is not required to prove use of its mark for any of the goods for which it is registered. The opponent’s earlier mark is therefore entitled to protection against a likelihood of confusion with the applicant’s mark based on the ‘notional’ use of that earlier mark for all the good and services listed on the register.

24. The concept of notional use was explained by Laddie J. in *Compass Publishing BV v Compass Logistics Ltd*<sup>5</sup> like this:

"22. [...] It must be borne in mind that the provisions in the legislation relating to infringement are not simply reflective of what is happening in the market. It is possible to register a mark which is not being used. Infringement in such a case must involve considering notional use of the registered mark. In such a case there can be no confusion in practice, yet it is possible for there to be a finding of infringement. Similarly, even when the proprietor of a registered mark uses it, he may well not use it throughout the whole width of the registration or he may use it on a scale which is very small compared with the sector of trade in which the mark is registered and the alleged infringer's use may be very limited also. In the former situation, the court must consider notional use extended to the full width of the classification of goods or services. In the latter it must consider notional use on a scale where direct competition between the proprietor and the alleged infringer could take place."

25. So far as the applicant's proposed or claimed use of its mark is concerned, in *O2 (UK) Limited v Hutchison 3G UK Limited*,<sup>6</sup> the Court of Justice of the European Union ("CJEU") stated at paragraph 66 that:

"[...] 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."

26. As a result, even though the applicant has suggested differences between the goods and the way in which the contested mark will be used, my assessment must take into account only the applied-for mark – and its specification – and any *potential* conflict with the opponent's earlier mark. Any differences between the *actual* goods

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<sup>5</sup> [2004] RPC 41

<sup>6</sup> Case C-533/06

provided by the parties, or differences in their consumer market, are irrelevant unless those differences are apparent from the respective marks.

27. The applicant's "[...] beverages (alcoholic -), except beer; alcoholic beverages [except beers]; alcoholic beverages, except beer; alcoholic beverages (except beer); alcoholic beverages containing fruit; [...] alcoholic fruit beverages" have direct counterparts in the opponent's specification. As such, I find that they are identical.

28. Furthermore, to my mind, the applicant's "ciders; dry cider; sweet cider; perry; [...] alcoholic beverages of fruit; [...] low alcohol cider; low alcoholic drinks" are all covered under the term "alcoholic beverages, (except beer)" and are therefore encompassed by the opponent's broader term. As such, I find that the respective goods are identical under the principle outlined in *Meric*.

29. It should be noted that I have considered the other goods relied upon by the opponent. However, none put the opponent in a more favourable position.

### **The average consumer and the nature of the purchasing act**

30. 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.

31. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words

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

32. The applicant has contended that the goods produced by the parties have very different target audiences.<sup>7</sup> I am unable to accept this assertion. It is important to note that the provisions in the Act are not merely a reflection of what is happening in the market. As the earlier mark is not subject to proof of use, as discussed above, I must consider notional use of the marks and all the circumstances in which they might be used. My assessment must take into account the contested mark – and its specification – and any potential conflict with the earlier mark. Given that the goods in question are identical, it is not apparent from the competing marks that they will target different consumers.

33. I find that relevant consumers of the goods at issue will include adult members of the general public as well as members of the business community.

34. On average, the general public are likely to purchase the goods rather frequently for the purposes of enjoyment or socialising. The price of the goods is likely to vary, though, overall, they are relatively inexpensive purchases. As such, I find that the purchasing process is likely to be more casual than careful and will not require an overly considered thought process. The general public will, however, consider factors such as quality, price, origin of the goods, taste or flavour and alcoholic content when selecting the products. Taking the above factors into account, I find that the general public will demonstrate an average level of attention in respect of these goods. The goods are typically sold through a range of retail outlets, such as supermarkets and off-licences, and their online equivalents. In such outlets, the goods will be displayed on shelves or in chilled cabinets, from which they will be self-selected by consumers. A similar process will apply to websites, where consumers will select the goods after viewing images and information displayed on a webpage. In the foregoing circumstances, visual considerations would dominate. Goods such as these are also sold in hospitality settings such as in restaurants, bars, nightclubs and public houses. In these environments, there may be an aural component to the selection process,

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<sup>7</sup> Counterstatement, paragraph 14

such as requests to bar and waiting staff. However, even where the goods are ordered in this way, the selection process would still be in the context of a visual inspection of the goods or a drinks menu, for example, prior to the order being placed. As such, overall, it is my view that the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.<sup>8</sup>

35. As indicated above, the goods may also be purchased by the owners of businesses such as, for example, bars, public houses, restaurants and nightclubs. For these consumers, the goods are likely to be frequent purchases for the ongoing operation of the business. In addition to the factors considered by the general public during the selection process, these consumers will be acutely aware that the goods they are selecting will be consumed by their customers, as well as the negative impact of choosing the wrong goods for their business. Due to this increased responsibility and liability, it is my view that consumers from the business community will demonstrate an above average level of attention when purchasing these goods. Businesses are likely to purchase the goods from distributors and wholesalers, as well as through online channels. In these circumstances, the goods are likely to be purchased after a visual inspection of the product, or after viewing information in brochures or on the Internet. As such, the purchasing process will be largely visual in nature. However, businesses may also engage in discussions with salespersons about the products. Therefore, I do not discount aural considerations entirely.

### **Comparison of the marks**

36. It is clear from *Sabel BV v. Puma AG*<sup>9</sup> that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, Case C-591/12P, that:

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<sup>8</sup> *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

<sup>9</sup> Case C-251/95, paragraph 23

“34. [...] 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.”

37. It would therefore be wrong to artificially dissect the trade marks, although it is necessary to take into account their distinctive and dominant components and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions they create.

38. The respective trade marks are shown below:

<b>Earlier mark</b>	<b>Contested mark</b>
World of Zing	ZING

#### Overall impressions

39. The earlier mark is in word-only format and comprises the words “World of Zing”. To my mind, the words “World of” form a phrase that qualify the word “Zing”, being the subject of the phrase. While they will not be overlooked entirely, I find that they play a lesser role in the overall impression of the mark. I agree with the opponent that the overall impression of the mark is dominated by the word “Zing”, which forms the distinctive element of the mark and has a greater impact.

40. The contested mark is also in word-only format and consists of the word “ZING”. Given that it is the only element of the mark, the overall impression lies in the word itself.

### Visual comparison

41. The competing marks are visually similar, insofar that they share the same four-letter word “Zing/ZING”. As outlined above, this word is the dominant element of both marks. I do not consider the distinction in letter case between the earlier mark and the contested mark to be a point of significant difference between them. This is because the registration of word-only marks provides protection for the word itself, irrespective of whether it is presented in upper or lower case. The competing marks are visually different in that the earlier mark contains an additional two words that are not replicated in the contested mark. This difference appears at the beginning of the competing marks, being where consumers tend to focus,<sup>10</sup> and renders them quite different in length. While the additional words constitute a visual difference, I have found that they will play a lesser role in the overall impression of the earlier mark. Overall, the competing marks are visually similar to between a low and medium degree.

### Aural comparison

42. The contested mark comprises one syllable, i.e. “ZING”, whereas the earlier mark consists of three syllables, i.e. “WORLD-OF-ZING”. The competing marks aurally coincide in the common syllable “ZING”. Although this word falls at the end of the earlier mark, it is, in my view, a significant point of similarity given its dominance in the marks. The earlier mark bears two additional syllables which are absent from the contested mark. Overall, I find that the competing marks are aurally similar to between a low and medium degree.

### Conceptual comparison

43. In my view, the word “Zing/ZING” in the competing marks would be recognised by consumers in accordance with its dictionary definition, meaning energy, enthusiasm or liveliness.<sup>11</sup> The phrase “World of” in the earlier mark will either be

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<sup>10</sup> *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

<sup>11</sup> [www.lexico.com/definition/zing](http://www.lexico.com/definition/zing)



perceived as a reference to the amount of “Zing”, in that there is a great deal of it, or as a reference to the origin of the “Zing”, in terms of a place (whether real or metaphorical) where “Zing” is a prominent characteristic. Clearly, the competing marks are conceptually similar as they both convey the meaning associated with the dominant word “Zing/ZING”. The competing marks are conceptually different insofar as the earlier mark also conveys the meaning(s) associated with the phrase “World of”. However, bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to at least a medium degree.

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

44. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *WindsurfingChiemsee 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).”

45. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The degree of distinctiveness is an important factor as it directly relates to whether there is a likelihood of confusion; the more distinctive the earlier mark, the greater the likelihood of confusion.

46. In *Kurt Geiger v A-List Corporate Limited*, BL O/075/13, Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of ‘distinctive character’ is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:

“38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that ‘the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion’. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.

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.”

47. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask ‘in what does the distinctive character of the earlier mark lie?’ Only after that has been done can a proper assessment of the likelihood of confusion be carried out.

48. Neither party has made any specific comments on the overall distinctiveness of the earlier mark or the level of distinctive character it possesses. Further, although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use (nor was it required to do so). Consequently, I have only the inherent position to consider.

49. The earlier mark comprises the words “World of Zing”. As outlined above, the word “Zing” will be understood by consumers as meaning energy, enthusiasm or liveliness. The words “World of” will be perceived as a phrase which qualifies the word “Zing”, either by reference to its quantity or origin. Therefore, in my view, the mark as a whole may be understood as meaning a great deal of energy, enthusiasm or liveliness. Alternatively, it may be understood as referring to a metaphorical or real place which is prominently characterised by energy, enthusiasm or liveliness. It has no allusive or descriptive qualities in relation to the goods for which it is registered. Overall, it is considered that the earlier mark possesses a medium degree of inherent distinctive character. I should add that, given that the words “World of” qualify the word “Zing”, as well as it being a somewhat unusual word, the distinctive character of the mark predominantly lies in the latter.

### **Likelihood of confusion**

50. Whether there is a likelihood of confusion must be assessed globally, taking into account a number of factors. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods, and vice versa. It is also necessary for me to keep in mind the distinctive character of the opponent’s trade mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be aware of the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

51. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the

average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

52. I have found that the respective goods are identical. I have found that the relevant consumers of the goods would include adult members of the general public and members of the business community. I have found that the general public would pay an average degree of attention when selecting the goods, while businesses would pay an above average degree of attention. I have found that the purchasing process will be largely visual, however, I have not discounted aural considerations. The overall impression of the earlier mark would be dominated by the word “Zing”, while the words “World of” would play a reduced role. The overall impression of the contested mark lies in the word “Zing”, being the only element of the mark. I have found that the earlier mark and the contested mark are visually and aurally similar to between a low and medium degree, and conceptually similar to at least a medium degree. I have found that the earlier mark has a medium level of inherent distinctive character.

53. I acknowledge that the dominant element of the competing marks, i.e. the word “Zing/ZING”, is identical. Nevertheless, the earlier mark also contains the phrase “World of”. This phrase has no counterpart in the contested mark and, although I have found it to play a lesser role, the addition of this phrase to the earlier mark is not negligible. It would not be entirely overlooked or disregarded by consumers upon a visual inspection of the mark, which is of heightened importance given that I have found the purchasing process to be predominantly visual in nature.<sup>12</sup> Indeed, visually, the additional words in the earlier mark render it more than double the length of the contested mark. The impact of this is that, when perceiving the respective marks on a menu or drinks board, for example, it is unlikely that consumers will mistake them for each other. Moreover, as it has been established that the attention of the consumer is usually directed towards the beginning of trademarks, the visual differences between the competing marks are more noticeable given their very different beginnings. Aurally, the number of syllables in the earlier mark more than double

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<sup>12</sup> *Quelle AG v OHIM*, Case T-88/05

those in the contested mark and, overall, there is a relatively low level of similarity between the competing marks. Even in circumstances where the goods are purchased aurally – in, for instance, a busy bar or restaurant – it is unlikely that consumers would mistake the marks for one another when hearing them uttered aloud or making orders verbally. Although I have found that the marks are conceptually similar to at least a medium degree, this is, in my view, counteracted by the aforementioned visual and aural differences. In my judgement, taking all the above factors into account, despite the earlier mark having a medium level of inherent distinctive character, the differences between the competing trade marks are likely to be sufficient to avoid consumers, paying at least an average degree of attention, from mistaking the contested mark for the earlier mark (or vice versa), even on goods which are identical. Therefore, even when factoring in the principles of imperfect recollection and interdependency, I do not consider there to be a likelihood of direct confusion.

54. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

55. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.”

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.)

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

56. These examples are not exhaustive but provide helpful focus.

57. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.<sup>13</sup>

58. As explained above, consumers will recognise that there is a difference between the competing marks in the words “World of”. However, they will also recognise the common element “Zing/ZING”, which is the dominant and distinctive element of both trade marks. Whether consciously or unconsciously, this will lead consumers through the mental process described above, namely, that there is a difference between the marks, but there is also something in common. Taking account of the common element in the context of the contested mark, I am satisfied that the differences between the marks will be seen by consumers as indicative of alternative marks from

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<sup>13</sup> *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

the same or economically linked undertakings. For instance, I consider it entirely plausible that the contested mark may be perceived by consumers as a shortened rebranding of the “World of Zing” mark. Further, the differences between the marks are conducive to a brand extension; it is my view that consumers may consider the addition of the words “World of” in the earlier mark to be an inventive way of marketing the “Zing” brand, by conjuring connotations of a great deal of “Zing”, or a place (whether real or metaphorical) which is full of “Zing”. Given that the parties’ goods are identical, the potential for the marks to be seen as alternative marks from the same or economically linked undertakings is greatly magnified. I am satisfied that consumers would assume a commercial association between the parties, or sponsorship on the part of the opponent, due to the shared dominant element “Zing/ZING”. Consequently, I consider there to be a likelihood of indirect confusion, even where consumers pay an above average degree of attention during the purchasing process.

## **Conclusion**

59. The partial opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused in respect of the following goods:

Class 33: Ciders; Dry cider; Sweet cider; Perry; Beverages (Alcoholic -), except beer; Alcoholic beverages [except beers]; Alcoholic beverages, except beer; Alcoholic beverages (except beer); Alcoholic beverages containing fruit; Alcoholic beverages of fruit; Alcoholic fruit beverages; Low alcohol cider; Low alcoholic drinks.

60. The application will proceed to registration to the following goods, which were not opposed:

Class 33: Cider.

## **Costs**

61. The opponent has been successful and would, ordinarily, be entitled to an award of costs. However, as the opponent had not instructed professional representatives, they were invited by the Tribunal to indicate whether they intended to make a request for an award of costs, including accurate estimates of the number of hours spent on a range of given activities relating to defending the proceedings. It was made clear by letter dated 10 August 2021 that, if the pro-forma was not completed, no costs would be awarded. The opponent did not return a completed pro-forma to the Tribunal and, on this basis, no costs are awarded other than the official fee of £100 for the filing of the Form TM7F.

62. I therefore order Thatchers Cider Company Limited, to pay World of Zing LTD the sum of **£100**. This should be paid within twenty-one days of the expiry of the appeal period or, if there is an unsuccessful appeal, within twenty-one days of the appeal proceedings.

**Dated this 19th day of November 2021**

**Sarah Wallace**  
**For the Registrar**