

O/909/21

TRADE MARKS ACT 1994

**IN THE MATTER OF
INTERNATIONAL REGISTRATION NO. 1550950
DESIGNATING THE UNITED KINGDOM
IN THE NAME OF ENTOURAGE IP HOLDINGS, LLC:**

BANG

IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 600001766
BY RAJINDER SHARMA**

Background and pleadings

1. On 14 August 2020, Entourage IP Holdings, LLC (“the holder”) registered the International trade mark **BANG**, under number 1550950 (“the IR”). With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR claims a priority date of 10 August 2020 from the United States Patent and Trademark Office.

2. The IR was accepted for protection in the UK and published in the Trade Marks Journal on 12 March 2021 in respect of the following goods:

Class 33: Alcoholic beverages, except beer; alcoholic beverages, namely, hard seltzer; alcoholic carbonated beverages, except beer; alcoholic cocktail mixes; alcoholic energy drinks; alcoholic mixed beverages except beers; hard seltzer; pre-mixed alcoholic beverages, other than beer-based; prepared alcoholic cocktail.

3. On 10 June 2021, Rajinder Sharma (“the opponent”) filed a notice of opposition. The opposition is brought under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all the goods of the IR.

4. The opponent relies upon its UK trade mark number 3175063, (“the earlier mark”), which consists of the following sign:

BANG BANG

The earlier mark was filed on 17 July 2016 and became registered on 21 October 2016 in respect of the following goods, all of which are relied upon for the purposes of the opposition:

Class 30: Aerated drinks [with coffee, cocoa or chocolate base]; artificial coffee; artificial coffee; artificial coffee and tea; beverages based on coffee; beverages (cocoa-based-); beverages (cocoa-based-); beverages (coffee-based-); beverages (coffee-based-); beverages consisting principally of cocoa; beverages consisting principally of coffee; beverages (flavorings [flavourings], other than essential oils, for-); beverages (flavorings [flavourings], other than essential oils, for-); beverages made from cocoa; beverages made from coffee; beverages made of coffee; beverages with a cocoa base; beverages with coffee base; caffeine-free coffee; cocoa; cocoa based creams in the form of spreads; cocoa beverages; cocoa beverages with milk; cocoa extracts for human consumption; cocoa for use in making beverages; cocoa mixes; cocoa powder; cocoa preparations; cocoa preparations for use in making beverages; cocoa products; cocoa [roasted, powdered, granulated, or in drinks]; cocoa-based beverages; cocoa-based ingredients for confectionery products; coffee; coffee (artificial-); coffee (artificial-); coffee bags; coffee based beverages; coffee based drinks; coffee based fillings; coffee beans; coffee beverages; coffee beverages with milk; coffee capsules; coffee concentrates; coffee drinks; coffee essence; coffee essences; coffee essences for use as substitutes for coffee; coffee extracts; coffee extracts for use as substitutes for coffee; coffee flavorings [flavourings]; coffee flavourings; coffee in brewed form; coffee in ground form; coffee in whole-bean form; coffee mixtures; coffee oils; coffee pods; coffee [roasted, powdered, granulated, or in drinks]; coffee substitutes [artificial coffee or vegetable preparations for use as coffee]; coffee substitutes [grain or chicory based]; coffee substitutes (vegetal preparations for use as-); coffee substitutes (vegetal preparations for use as-); coffee, tea, cocoa and artificial coffee; coffee (unroasted-); coffee (unroasted-); coffee-based beverage containing milk; coffee-based beverages; decaffeinated coffee; drinking cocoa paste; drinks based on cocoa; drinks containing cocoa; drinks containing milk flavouring; drinks in powder form containing cocoa; drinks prepared from cocoa; extracts of cocoa for use as flavours in beverages; extracts of coffee for use as flavours in beverages; flavoured coffee; freeze-dried coffee; ice beverages with a cocoa base; ice beverages with a coffee base; instant cocoa powder; mixtures of coffee; mixtures of coffee and chicory; mixtures of coffee and malt; mixtures of coffee essences and coffee extracts;

mixtures of malt coffee extracts with coffee; mixtures of malt coffee with cocoa; mixtures of malt coffee with coffee; preparations composed of glucose for use in creaming coffee; preparations for making beverages [coffee based]; preparations for making beverages [tea based]; preparations of chicory for use as a substitute for coffee; prepared cocoa and cocoa-based beverages; prepared coffee and coffee-based beverages; prepared coffee beverages; roasted barley and malt for use as substitute for coffee; roasted coffee beans; unroasted coffee.

Class 32: Aerated fruit juices; aerated fruit juices; aerated juices; aerated mineral waters; aerated water; aerated water (preparations for making-); aerated water [soda water]; alcohol free beverages; aloe juice beverages; aperitifs, non-alcoholic; apple juice beverages; beverages consisting of a blend of fruit and vegetable juices; beverages consisting principally of fruit juices; beverages enriched with added minerals; beverages enriched with added minerals [not for medical purposes]; beverages enriched with added trace elements; beverages enriched with added trace elements [not for medical purposes]; beverages enriched with added vitamins; beverages enriched with added vitamins [not for medical purposes]; beverages (non-alcoholic-); beverages (non-alcoholic-); carbonated mineral water; carbonated non-alcoholic drinks; cocktails, non-alcoholic; coffee-flavored soft drinks; concentrated fruit juice; de-alcoholized drinks; energy drinks; energy drinks [not for medical purposes]; essences for making non-alcoholic drinks, not in the nature of essential oils; extracts for making beverages; fruit beverages; fruit flavored drinks; fruit juice beverages (non-alcoholic-); fruit juice concentrates; fruit juice for use as a beverages; fruit juices and fruit drinks; fruit nectars, non-alcoholic; fruit-based beverages; fruit-flavored beverages; fruit-flavoured beverages; isotonic beverages; isotonic beverages [not for medical purposes]; isotonic drinks; mineral and aerated waters; mineral and aerated waters and other non-alcoholic beverages; non-alcoholic beer; non-alcoholic beer flavored beverages; non-alcoholic beverages; non-alcoholic beverages containing fruit juices; non-alcoholic beverages containing vegetable juices; non-alcoholic cocktail bases; non-alcoholic cocktail mixes; non-alcoholic cocktails; non-alcoholic drinks; non-alcoholic flavored carbonated beverages; non-alcoholic

fruit cocktails; non-alcoholic fruit drinks; non-alcoholic fruit extracts; non-alcoholic fruit extracts used in the preparation of beverages; non-alcoholic fruit juice beverages; non-alcoholic fruit punch; non-alcoholic malt drinks; non-alcoholic malt free beverages [other than for medical use]; non-alcoholic punch; non-alcoholic soda beverages flavoured with tea; non-alcoholic sparkling fruit juice drinks; non-alcoholic vegetable juice drinks; non-alcoholic wines; non-carbonated soft drinks; nutritionally fortified beverages; nutritionally fortified water; sports drinks; sports drinks containing electrolytes; vegetable juices [beverage]; vegetable juices [beverages]; vegetable smoothies.

5. The opponent's mark is an earlier mark, in accordance with Section 6 of the Act. However, as it had not been registered for five years or more at the priority filing date claimed by the IR, it is not subject to the proof of use requirements specified within Section 6A of the Act. Consequently, the opponent may rely upon all of the goods identified, without having to demonstrate genuine use.

7. The opponent argues that the competing trade marks are similar as they share a common element in the word "BANG". This, the opponent submits, is what will be retained in the minds of consumers and what they will recall, especially under the principle of imperfect recollection. Furthermore, the opponent maintains that the contested goods in class 33 of the IR are identical or similar to those in classes 30 and 32 of the earlier mark. These factors, the opponent contends, will result in a likelihood of confusion.

8. The holder filed a counterstatement denying the ground of opposition. Contrary to the opponent's arguments, the holder disputes that the competing trade marks are similar to any meaningful degree. The holder bases this argument on the presence of the additional word "BANG" within the earlier mark. Moreover, the holder disputes that the respective goods are similar. As a result, the holder denies that there is a likelihood of confusion.

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. Both parties have been professionally represented throughout these proceedings; the opponent by Withers & Rogers LLP and the holder by Lane IP. 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. Both parties filed written submissions. This decision is taken following a careful perusal of the papers keeping all submissions in mind.

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 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.

Section 5(2)(b)

Legislation and case law

12. 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.”

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

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

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

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

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

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

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

(g) a lesser degree of similarity between the goods or services may be offset by a 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

14. 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."

15. Put simply, this means that whether the goods are in the same or different classes is not decisive in determining whether they are similar or dissimilar. Therefore, what matters is the actual goods at issue and whether they are similar or not having regard to the case law that follows.

16. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated at paragraph 23 of its judgment that:

"In assessing the similarity of the goods or services concerned, [...] 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".

17. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

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

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

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

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

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

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

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

“[...] Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

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. 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. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court (“GC”) 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”.

21. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. chicken against transport services for chickens. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C., sitting as the Appointed Person, noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL O/255/13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes”,

whilst on the other hand:

“[...] it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together”.

22. The goods to be compared are outlined at paragraphs 2 and 4 above.

Alcoholic beverages, except beer; alcoholic carbonated beverages, except beer; alcoholic mixed beverages except beers; pre-mixed alcoholic beverages, other than beer-based

23. The terms “alcoholic beverages, except beer; alcoholic carbonated beverages, except beer; alcoholic mixed beverages except beers; pre-mixed alcoholic beverages, other than beer-based” in the holder’s specification are broad enough to encompass goods such as wines, spirits, ciders, flavoured liquors, pre-mixed drinks (such as rum and cola or gin and tonic), and drinks with low alcoholic content. The opponent’s term “non-alcoholic beverages” would cover a wide range of goods such as waters, carbonated drinks and juices but, more importantly, it would also incorporate non-alcoholic equivalents of the holder’s goods such as non-alcoholic spirits, non-alcoholic wines and non-alcoholic mixed beverages. As a result, there is an overlap in nature, intended purpose and method of use, as both are consumable liquids that will be drunk to quench thirst, for taste or enjoyment. The users of the goods will coincide with respect to the adult population, but I keep in mind that users of the opponent’s goods will also include those under the age of 18 given that the opponent’s goods cover non-alcoholic versions of the holder’s goods. There will also be an element of competition as the average consumer may choose, for example, for health reasons or lifestyle choices, the opponent’s goods instead of the holder’s goods or vice versa. The distribution channels are also likely to overlap especially in a hospitality setting where the competing goods may be located in close proximity behind the bar or may appear on the same menu.

24. However, that said, there are also differences between alcoholic and non-alcoholic beverages, in that alcoholic beverages can only be sold by licensed establishments. In wholesalers and shops, alcoholic goods are usually situated on one shop aisle, whereas non-alcoholic products can be sold without restriction and are usually located in a separate aisle. Furthermore, alcoholic beverages can only be sold to those over the age of 18.

25. Complementarity is argued by the opponent in their written submissions.¹ The opponent argues that the identical nature, intended purpose and method of use of the goods means that they are often combined and consumed together; providing the example that the average consumer would consume alcohol in combination with a non-alcoholic drink and certain terms in the holder's goods would contain non-alcoholic beverages. Although I find that non-alcoholic drinks may be used together with alcoholic drinks, such as whiskey and cola, simply because the goods can be used together is not sufficient for a finding of complementarity as it does not mean that they are important or indispensable to one another in such a way that consumers will assume they are produced by the same undertaking. In my opinion, alcoholic and non-alcoholic beverages are not typically produced by the same undertakings and consumers would not assume that they are, simply because they are sometimes consumed together. I have also considered non-alcoholic drinks that are for the intended purpose of imitating alcoholic drinks such as alcohol free gin or alcohol free cider, however, these would not be drunk with alcoholic beverages as that would defeat their intended purpose within the market, as such these drinks are more likely to be competitive in nature than complimentary.

26. In respect of the goods identified above, I find that they are similar to a medium degree.

Alcoholic beverages, namely, hard seltzer; hard seltzer

27. A hard seltzer, found in the holder's specification, is defined in the dictionary as a drink consisting of fizzy water, alcohol and flavouring.² There is some overlap between hard seltzer and the opponent's goods, namely, "non-alcoholic beverages", as they cover drinks such as flavoured and unflavoured carbonated waters which will be similar to a hard seltzer except for the alcoholic content. Consequently, there is overlap in nature and method of use, as both are consumable liquids that will be drunk to quench thirst, for taste or enjoyment. The users of the goods will coincide with respect to the adult population; however, the

¹ See opponent's written submissions dated 4 November, paragraph 16.

² <https://dictionary.cambridge.org/dictionary/english/hard-seltzer>

users of the opponent's goods will also include those under the age of 18. Intended purpose of the goods will differ, given that the opponent's goods cover the non-alcoholic versions of the holder's goods, the average consumer will therefore choose the opponent's goods to avoid becoming inebriated; although I do accept that the competing goods also share an intended purpose as both goods may be consumed for their taste. The distribution channels are also likely to overlap especially in a hospitality setting, however, there are some differences to the distribution of the goods as the holder's goods can only be sold in licensed establishments. The goods are also competitive as the one could be selected over the other, particularly where the consumer is wanting to make healthier choices or doesn't want to consume alcohol because of their lifestyle.

28. In relation to complementarity, the opponent argues that non-alcoholic beverages are a component within alcoholic beverages such as hard seltzer. However, it has been established that the mere fact that a particular good is used as a part, element or component of another does not suffice in itself to show that the finished goods containing those parts or components are similar.³ This in my view would apply to ingredients within a drink, such as a carbonated flavoured water within a hard seltzer. As carbonated flavoured water as a whole is not important or indispensable to the use of hard seltzers in such a way that consumers will assume that they are produced from the same undertakings. Furthermore, there is no evidence before me that this is typical in trade.

29. As a result, I find that these goods are similar to a medium degree.

Alcoholic energy drinks

30. "Alcoholic energy drinks" in the holder's specification and "energy drinks" within the opponent's specification have similarities within their nature and method of use, but also within their distribution channels, covering again both establishments within the hospitality setting as well as shops and supermarkets, albeit that the holder's goods can only be sold within licenced venues. The

³ *Les Éditions Albert René v OHIM*, Case T-336/03, Paragraph 21

intended purpose is similar in the sense that both the holder's and opponent's goods will be drunk for taste, but the intended purpose does differ in respect of wanting to consume or refrain from alcohol as a result, the goods would also be in competition with each other. As discussed above, the users of the goods whilst overlapping will also include those under the age of 18 in respect of the opponent's goods. In relation to complementarity, I find that the reasoning applied above to hard seltzers also apply to alcoholic energy drinks.

31. For these goods, I find that there is a medium degree of similarity.

Alcoholic cocktail mixes and prepared alcoholic cocktails

32. I now turn to "alcoholic cocktail mixes" and "prepared alcoholic cocktails" in the holder's specification against "non-alcoholic cocktails" and "non-alcoholic cocktail mixes" in the opponent's specification. The opponent's goods would encompass non-alcoholic cocktails commonly referred to as "mocktails". These goods are again similar in their nature and method of use. Their intended purpose overlaps insofar as they can both be consumed for refreshment, taste or enjoyment. They differ in as much as one will be consumed for its alcoholic content whilst the other will be consumed exactly because it does not contain any alcohol. For the same reason, however, there will also be an element of competition between the goods. There are similarities within their distribution channels, covering the hospitality setting as well as retail within shops. However, the goods differ insofar as the holder's goods can only be sold within licenced venues. As discussed above, the users of the goods whilst overlapping will also include those under the age of 18 in respect of the opponent's goods. In relation to complementarity, I find that the reasoning applied above to hard seltzers and alcoholic energy drinks also apply to prepared alcoholic cocktails and alcoholic cocktail mixes.

33. Taking into account all the above factors, I find that the respective goods are similar to between a medium degree.

34. 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

35. 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.

36. 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.”

37. 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. Additionally, for the opponent’s goods only, consumers will also consist of those under the age of 18.

38. On average, the general public are likely to purchase the goods rather frequently for the purposes of quenching thirst, 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 when selecting the products. In addition, the general public will consider the alcoholic content of the product when selecting the holder’s goods. 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 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 cafés, drinks kiosks, restaurants, bars, nightclubs and public houses. In these environments, there may be an aural component to the selection process, such as requests to serving 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 list, 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.⁴

39. As indicated above, the goods may also be purchased by the owners of businesses such as, for example, shops, kiosks, cafés, 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

⁴ *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

salespersons about the products. Therefore, I do not discount aural considerations entirely.

Comparison of the marks

40. It is clear from *Sabel BV v. Puma AG*⁵ 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:

“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.”

41. 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.

42. The respective trade marks are shown below:

Earlier mark	Contested mark
BANG BANG	BANG

⁵ Case C-251/95, paragraph 23

Overall impressions

43. The earlier mark encompasses the words 'BANG BANG'. The repeated words are aligned side by side in a bold font in capital letters. The particular font used is likely to be overlooked as it consists of a standardised typeface. There are no other components to the mark. Therefore, the overall impression of the mark lies in the words 'BANG BANG'.
44. The contested mark is in word-only format and consists of the word 'BANG'. This word is not stylised and there are no other components to the mark. As such the overall impression of the mark lies in the word itself.

Visual comparison

45. The competing marks are visually similar as they share an identical word 'BANG'. The marks are visually different insofar as the word "BANG" appears twice in the earlier mark and only once in the contested mark. The earlier mark is double the length of the contested mark, but this is only as a result of the word being duplicated in the earlier mark. The earlier mark has a standard typeface and has a bold font; however, this does not create a significant visual difference between the marks. The identical word "BANG" appears at the beginning of the respective marks, a position which is generally considered to have more impact due to consumers in the UK reading from left to right.⁶ Overall, the competing marks are visually similar to high degree.

Aural comparison

46. The earlier mark comprises two syllables, i.e. "BANG-BANG", whereas the contested mark consists of just one syllable, i.e. "BANG". The competing marks aurally coincide in the common syllable "BANG", the only difference being that

⁶ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

this will be pronounced once in the contested mark and twice in the earlier mark. These similarities result in a high degree of similarity overall.

Conceptual comparison

47. In my view, the word “BANG” in the competing marks would be recognised by consumers in accordance with its dictionary definition, meaning a sudden loud, sharp noise.⁷ The competing marks are conceptually identical in that they both convey the meaning associated with the dominant word “BANG”. However, the repetition of the word “BANG” in the earlier mark may change the conceptual meaning as it emphasises it, allowing for another sudden loud noise. Bearing in mind my assessment of the overall impressions, I find that the competing marks are conceptually similar to a high degree, if not identical.

Distinctive character of the earlier mark

48. 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 *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

⁷ <https://www.lexico.com/definition/bang>

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).”

49. 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.
50. 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.
51. The earlier mark comprises the words “BANG BANG”. As outlined above, the word “BANG” will be understood by consumers as meaning a sudden loud, sharp noise. The duplication of the word “BANG” creates the overall impression to consumers that the sudden loud, sharp noise will also be duplicated. The bold font forms part of the mark, but, as a standard typeface, it will be overlooked. In my view, the distinctiveness overwhelmingly lies in the words “BANG BANG” together. I note that the word has no allusive or descriptive qualities in relation to the goods for which the mark is registered. Overall, it is considered that the earlier mark possesses a medium degree of inherent distinctive character.

Likelihood of confusion

52. 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.
53. 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.
54. 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).”

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

56. I have found that the respective goods are similar to a medium degree. I have found that the relevant consumers of the goods would include adult members of the general public, along with those under the age of 18, 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 is dominated by the words “BANG BANG”. The overall impression of the contested mark lies in the word “BANG”, being the only element of the mark. I have found that the earlier mark and the contested mark are visually and aurally similar to a high degree, and

conceptually similar to a high degree, if not identical. I have found that the earlier mark has a medium level of inherent distinctive character.

57. I acknowledge that the dominant element of the competing marks, i.e. the word “BANG”, is identical. Overall, there is a relatively high level of similarity between the competing marks. It is likely that consumers will fail to recall the simple replication of the word in the earlier mark or that it would be misremembered 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.⁸ Moreover, as it has been established that the attention of the consumer is usually directed towards the beginning of trade marks, the visual similarities between the competing marks are more noticeable given their identical beginnings. The replication of the word in the earlier mark will not enable customers to sufficiently distinguish between the marks and as a result there is likely to be confusion between them. Aurally, the number of syllables in the earlier mark doubles those in the contested mark; however, the second syllable is the same as the first. The competing mark consists of the identical word “BANG” which is simply repeated in the earlier mark; as a result, they are likely to be mistaken for one another where the goods are purchased orally in, for example, a busy bar or restaurant. I have also found that the marks are conceptually similar to a high degree, if not identical. In my judgement, taking all the above factors into account, the similarities between the competing trade marks are likely to cause consumers, paying at least an average degree of attention, to mistake the contested mark for the earlier mark (or vice versa), even though the goods are not identical. Therefore, when factoring in the principles of imperfect recollection and interdependency, I consider there to be a likelihood of direct confusion.

58. Even where consumers do recognise the differences between the marks and are able to accurately identify and recall that one consists of the words “BANG BANG” whilst the other consists only of the word “BANG” in the singular, consumers are liable to assume that contested mark is a shortened rebrand of the original mark. Whether consciously or unconsciously, consumers will be led

⁸ *Quelle AG v OHIM*, Case T-88/05

through the mental process described above, namely, that there is a subtle difference between the marks, but there is also something in common and that they derive from the same or economically linked undertakings. Further, the differences between the marks are conducive to a brand extension; it is my view that consumers may perceive the contested mark as an inventive way of marketing the “BANG BANG” brand, by creating a shorter, snappier mark to extend their market into the sale of alcoholic goods. The shortening of “BANG BANG” to simply “BANG” appears to be a logical brand extension and therefore the marks could be seen as alternative marks from the same or economically linked undertakings. I bear in mind that a finding of indirect confusion should not be made merely because the two marks share a common element and that it is not sufficient that a mark merely calls to mind another mark.⁹ However, for the reasons outlined above, I am satisfied that consumers would assume a commercial association between the parties, or sponsorship on the part of the opponent. 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 opposition under Section 5(2)(b) of the Act has succeeded in its entirety. Subject to any successful appeal, the IR will be refused in respect of all the designated goods in class 33.

Costs

60. The opposition has been successful and, therefore, the opponent is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice (“TPN”) 2/2015. Applying the guidance in that TPN, I award the opponent the sum of £400, which is calculated as follows:

⁹ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

Official fee:	£100
Filing a notice of opposition:	£100
Preparing written submissions:	£200
Total:	£400

61.I therefore order Entourage IP Holdings, LLC to pay Rajinder Sharma the sum of £400. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 16th day of December 2021

**Sarah Wallace
For the Registrar**