

O/763/22

TRADE MARKS ACT 1994

TRADE MARK REGISTRATION 3272691

IN THE NAMES OF BENCHMARK DRINKS LIMITED AND SIR IAN BOTHAM

AND

APPLICATION 503337

BY E.I. WINES LIMITED

FOR THE INVALIDATION OF THE REGISTERED TRADE MARK

Background and pleadings

1. This is an application by E.I. Wines Limited (“the applicant”) under section 47(2) of the Trade Marks Act 1994 (“the Act”) to invalidate trade mark registration 3272691 (“the contested trade mark”).

2. The contested trade mark consists of the word **BEEFY**. It is registered in the joint names of Benchmark Drinks Limited and Sir Ian Botham, now Lord Botham (“the proprietors”).

3. The application to register the contested trade mark was filed on 23rd November 2017 (“the relevant date”) and the mark was registered on 10th August 2020 in relation to *wines* in class 33.

4. The application to invalidate the contested trade mark was made on 16th September 2020. The applicant is the proprietor of a series of two earlier trade marks registered under 3113488. The marks are the words **BEEF BROTHERS** and **THE BEEF BROTHERS**. The application to register these marks was filed on 16th June 2015 and the marks were registered on 18th September 2015. They are clearly ‘earlier trade marks’ as defined in Section 6 of the Act. The earlier marks are registered in relation to *alcoholic beverages, wines* in class 33.

5. The applicant claims that registration of the contested mark was contrary to section 5(2)(b) of the Act because:

- (i) the earlier marks are similar to the contested mark;
- (ii) the respective goods are identical or highly similar;
- (iii) there is a likelihood of confusion on the part of the public, including the likelihood of association.

6. The applicant filed a counterstatement denying that there is a likelihood of confusion. In particular, the proprietors say that:

“Lord Botham is a famous former UK cricket captain with a strong reputation among UK consumers. Lord Botham enjoys the well-recognised nickname of

“Beefy” which has been widely used throughout the UK by Lord Botham, both in a personal and professional capacity instead of Lord Botham’s given name but also as part of various charitable and business endeavours including those in the food and drink sector. The Proprietor’s (sic) mark will therefore be recognised by consumers of the relevant goods as a nickname associated with Lord Botham.”

In contrast, the mark BEEF BROTHERS or THE BEEF BROTHERS gives a very different impression to consumers, namely as a business run by two or more brothers involved in selling food products containing beef.”

Representation

7. The applicant is represented by Oakleigh IP Services Limited. The proprietors are represented by Potter Clarkson LLP. Neither party requested an oral hearing. Both sides filed written submissions in lieu of a hearing (the applicant also filed written submissions during the period for filing evidence), which I have taken into account.

The evidence

8. The applicant filed no factual evidence.

9. The proprietors filed a witness statement by Lord Botham (with 13 exhibits). The purpose of Lord Botham’s evidence is to show that (a) BEEFY is a nickname he acquired whilst playing cricket for England, (b) he has retained that nickname ever since, (c) as a result of his charitable and business activities, as well as commentating on cricket, he has remained in the public spotlight since retiring from playing cricket, and (d) he has a business marketing wines and hospitality services on the basis of his fame as a cricketer.

The series of earlier trade marks

10. The use of the definite article in the second of the earlier marks relied on by the applicant - THE BEEF BROTHERS - makes no difference to the merits of its case. For the sake of simplicity, I will therefore approach the matter solely on the basis of

the applicant's other earlier trade mark - BEEF BROTHERS. If the applicant does not succeed on this mark it will be no better off relying on THE BEEF BROTHERS.

Sections 47(2) and 5(2) of the Act

11. The relevant statutory provisions are set out below:

“47(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.”

12. Section 47(2A) sets out the 'proof of use' requirements which apply where the earlier trade mark has been registered for 5 years or more by the date of the application for invalidation of the contested mark. The applicant's earlier mark was registered less than 5 years before the date of the application to invalidate the contested mark. Consequently, the 'proof of use' provisions do not apply.

13. Section 47(2G) provides that the later trade mark shall not be refused if the earlier mark was itself liable to be declared invalid at the relevant date on the grounds of lack of distinctiveness, or if it had not by that time acquired sufficient distinctiveness to create a likelihood of confusion. It is not suggested that the earlier mark is so lacking in distinctiveness that it was liable to be declared invalid at the relevant date, or that the absence of a likelihood of confusion is attributable to BEEF BROTHERS having only acquired a highly distinctive character for wines etc. after the relevant date. Therefore, section 47(2G) does not apply either.

14. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

15. 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 retained EU trade mark law.

16. 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.

The principles

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

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

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

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

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

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

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

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

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

(j) 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;

(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. The earlier mark and the contested mark both cover *wines*. Consequently, the respective goods are identical.

The average consumer and the selection process

18. The average consumer of wines is likely to be an adult member of the general public. Wines are typically selected by visual means, from a website, or a shelf in a wine shop or supermarket. However, wines are also ordered in bars and restaurants. Word of mouth recommendations may also play some part in the selection process. Therefore, in assessing the likelihood of confusion the way the marks look is important, but the way they sound must also be taken into account.

19. The applicant's representative submits that wines are everyday goods bought regularly. Therefore, the consumer's level of attention is likely to be lower than when purchasing a product bought only once or twice a year. The registered proprietors' representative submits that wines are selected based on grape variety, taste, and alcohol level. The need to pay attention to such matters means that wines are chosen with at least an average degree of attention.

20. In my view, the level of attention paid when selecting wines is liable to vary according to the circumstances in which wine is chosen and the cost of the wine. Some wines are selected by connoisseurs paying an exceptionally high level of attention. Those people constitute one category of average consumers. However, for the reasons given by the registered proprietors' representative, I find that the majority of wines are chosen by average consumers paying a medium (not low) degree of attention.

Comparison of marks

21. The trade marks to be compared are shown below:

Earlier trade mark	Contested trade mark
BEEF BROTHERS	BEEFY

The earlier mark consists of two words whereas the contested mark is a single word. This makes the earlier mark noticeably longer than the contested mark: 12 letters against 5. Further, the word BROTHERS is longer than BEEF and cannot easily be overlooked (or dismissed as merely descriptive of the goods). Therefore, BEEF does not dominate the overall impression created by BEEF BROTHERS. Rather, both words contribute to the overall impression created by the mark. It follows that by virtue of being much longer than the contested mark, BEEF BROTHERS creates a different overall impression to BEEFY from a visual perspective.

22. On the other hand, the first four letters of the contested mark (B-E-E-F) correspond to the first word in the earlier mark. Consumers read from left to right. Therefore, the word BEEF will attract consumers attention before BROTHERS in the earlier mark. The visual similarity between BEEFY and BEEF is obvious. I therefore find that the resemblance between BEEFY and BEEF is sufficient to create a medium degree of visual similarity between the marks as wholes.

23. The earlier mark will be verbalised as BEEF-BRUTH-ERS. The contested mark has two syllables: BEEF-EE. Therefore, the sound of the marks coincide so far as the first syllable is concerned, but differs so far as the second and (in the earlier mark) third syllable is concerned. Again, the identity of the sound of the first syllable will make a more significant aural impression on consumers by virtue of the fact that it is the opening syllable of both marks. Overall, I find the marks are aurally similar to a medium degree.

24. The proprietors contend that the marks are conceptually dissimilar because (a) BEEFY will be recognised as Lord Botham's nickname, and (b) the inherent meaning

of that word is a muscular or robust person, whereas the conceptual meaning of BEEF BROTHERS is brothers involved in selling food products containing beef.

25. The applicant contends that the marks are conceptually similar. The only explanation for this submission is that they “..carry the same meaning and message because of their identical origin.” I am not sure what that means. It may be a reference to the word BEEFY being derived from the word BEEF.

26. Furthermore, the applicant (a) denies that BEEFY will be recognised as Lord Botham’s nickname by average consumers of wines, and (b) submits that in order to be able to rely on the alleged reputation of Lord Botham as ‘Beefy’ there must be evidence of use of the contested mark prior to the relevant date in relation to wines (which there is not).

27. The proprietors’ representative draws my attention to the judgment of the CJEU in *The Picasso Estate v OHIM*¹ where the court found that the EU’s Court of First Instance should have taken account of the conceptual meaning of PICASSO (as the name of the famous artist) when assessing the degree of similarity (and therefore the likelihood of confusion) between that mark and the later-filed trade mark PICARO when used in relation to vehicles. It is true that this case was based on a mark consisting of the surname of a famous person. However, I see no reason why, as a matter of principle, it should be any different when it comes to a well-known nickname.

28. More recently in *Lionel Andrés Messi Cuccittini v EUIPO*,² the CJEO dealt with an appeal concerning a mark corresponding to one of the given names of Mr Cuccittini, who is a well-known footballer usually called just ‘Messi’. Mr Cuccittini had applied to register a mark containing MESSI as an EU trade mark for ‘rescue devices’ in class 9, clothing in class 25, and sporting articles in class 28. The appellant argued the EU’s General Court had been wrong to regard the reputation of Messi as a footballer as a relevant factor in the assessment of the likelihood of confusion between the mark shown below and an earlier EU trade mark - MASSI.

¹ Case C-361/04 P

² Joined cases C-449/18P & C-474/18P



29. Relying on *Aceites del Sur-Coosur*,³ the appellant submitted that only the reputation of the earlier mark could be taken into account when assessing whether there was a likelihood of confusion. The CJEU rejected this submission stating that:

“44. In so far as JM-EV criticizes the General Court for disregarding Article 8(1)(b) of Regulation No 207/2009 by considering, in paragraph 62 of the judgment under appeal, that there was account of the notoriety of Mr Messi Cuccittini in the context of the assessment of the likelihood of confusion, within the meaning of that provision, it should be recalled that, according to settled case-law of the Court, the existence of a likelihood of confusion in the mind of the public must be assessed globally taking into account all the relevant factors of the case.

45. According to equally settled case-law, the overall assessment of the likelihood of confusion must, as regards the visual, phonetic or conceptual similarity of the signs at issue, be based on the overall impression produced by them, taking into account, in particular, of their distinctive and dominant elements.

46. In the context of that overall assessment, the reputation of the earlier mark is, admittedly, a relevant factor for the purposes of assessing the likelihood of confusion.

47. However, as the Court has held, account must also be taken of the possible notoriety of the person applying for his name to be registered as a trade mark,

³ Case C-498/07 P

since that reputation may obviously , have an influence on the perception of the mark by the relevant public (see, to that effect, judgment of 24 June 2010, Becker v Harman International Industries, C-51/09 P, paragraph 37).

48. It follows that the General Court was right to consider, in paragraph 62 of the judgment under appeal, that the notoriety of Mr Messi Cuccittini constituted a relevant factor in order to establish a difference at the conceptual level between the term ‘messi’ and the term ‘massi’.”

30. It follows that Lord Botham’s reputation as a former cricketer known as BEEFY is capable, in principle, of influencing the conceptual meaning of the contested mark to the relevant public for wines. This could be relevant to my assessment of the conceptual similarity between the marks at issue and, by extension, the likelihood of confusion. In order to have any such relevance I must be satisfied that average consumers of wine would have associated the meaning of BEEFY with Lord Botham at the relevant date. This is because it is well established that this is the date at which the likelihood of confusion must be assessed. Accordingly, it is not sufficient for the proprietors to show (only) that average consumers of wines would have recognised BEEFY as Lord Botham’s nickname at the date of the application for invalidation in 2020, or at some later date.

31. The question of whether relevant average consumers would recognise BEEFY as meaning, inter alia, Lord Botham is a matter of fact. The applicant accepts that Lord Botham is “*known for being the best cricket player of all time.*” The factual issue in dispute is whether BEEFY would, at the relevant date, have conveyed the meaning ‘Ian Botham’ to average consumers of wine. This breaks down into two sub-issues. Firstly, whether and to what extent BEEFY denoted Lord Botham to the public. Secondly, whether it would have done so in the context of a trade in wines. It is convenient at this point to turn to the proprietor’s evidence.

32. Lord Botham’s evidence is that he became affectionately known as ‘Beefy’ during his cricketing career. It is also a name he uses to refer to himself.⁴ After his retirement from cricket in 1993 he remained in the public eye by becoming a cricket commentator

⁴ Exhibit LIB02 is a Twitter page showing the handle “BeefyBotham”, which Lord Botham has used since December 2011. He had around 468k ‘followers’ in 2021.

for Sky Sports TV, a position he held until 2019. Lord Botham says that he continued to be referred to as 'Beefy' throughout this time.

33. Outside of cricket, Lord Botham has been involved in charitable activities since the 1980s. He engaged in 16 well-publicised charity walks for leukaemia research between 1985 – 2017, which raised over £13 million for the cause.⁵ He also founded his own non-profit organisation called 'Beefy's Charity Foundation.'⁶

34. In 2007, Ian Botham was knighted for his charitable work. Much of the coverage in the press at the time referred to him as 'Sir Beefy'.⁷

35. Prior to this Lord Botham says that he contributed to the development and launch of a range of wines in collaboration with fellow cricketer Bob Willis and Australian winemaker Geoff Merrill. He provides copies of two related articles from The Telegraph in 2003 and the website harpers.co.uk in 2008, both of which had headlines referring to these wines as 'beefy wine'. Lord Botham suggests that this was a play on his nickname Beefy,⁸ which is indeed how it appears from the articles.

36. Lord Botham says that in 2015 he became involved in the hospitality sector with the launch of his own restaurant at the Ageas Bowl in Southampton under the name 'BEEFY'S'. Exhibit LIB05 includes an article from Hospitality & Catering News which covered the launch. It stated that "*Sir Ian Botham, universally referred to by his nickname 'Beefy', is an advocate of great food and fine wines.*" The same exhibit includes an extract from the website of the Ageas Bowl showing that the marketing of the restaurant draws on the connection with Sir Ian (now Lord) Botham.

37. In July 2018, Lord Botham launched a range of wines under his own name. This was 9 months after the relevant date and is therefore irrelevant. However, Lord Botham states that market research carried out prior to the launch of his wines showed that 85% of UK wine drinkers knew of him as a sportsman and/or for his charity work.

⁵ Exhibit LIB03 includes an extract from skysports.com titled "Beefy's Big Sri Lanka Walk: Sir Ian Botham ends day seven on the beach", dated November 2013, reporting the progress of a charity walk in Sri Lanka.

⁶ Exhibit LIB03 also includes a copy of an article published in Living North in 2013 recording an interview with a journalist about the establishment of 'Beefy's Charity Foundation'.

⁷ Exhibit LIB04 includes articles from The Guardian, Business Live, Mirror, and The Mail Online published at the time, all referencing him as 'Sir Beefy'.

⁸ See exhibit LIB13

This is potentially relevant because it sheds light on the position around the relevant date. The research itself is not in evidence, but the press release issued at the launch of his wines is.⁹ It describes the results of the research in the same terms as Lord Botham and thereby provides some contemporaneous support for his claim about what it showed.

38. In my view the evidence as a whole shows that (a) Lord Botham was known at the relevant date to a large proportion of the relevant public for wines, (b) a significant proportion of consumers in this category with the attributes of an average consumer would also have known that BEEFY was Lord Botham's nickname, and (c) a smaller-but-still-significant proportion of average consumers of wine would have known that Lord Botham had a commercial interest in wines and hospitality. I therefore find that the conceptual meaning of BEEFY to a significant proportion of average consumers of wines (including most of those in category (c) above, but also many in category (b)) was likely to have been, or include, Ian Botham the famous cricketer.

39. However, this meaning is unlikely to have been immediately apparent to many other average consumers of wines. Therefore, BEEFY will have had only its ordinary dictionary meaning(s) to consumers in this group. According to Collins Dictionary, "*Someone, especially a man, who is beefy has a big body and large muscles.*" The word 'beefy' can also be used to mean "*like beef*" (as in resembling beef). At least the first of these meanings would also be apparent to average consumers who recognise BEEFY as Lord Botham's nickname.

40. There is no single meaning rule: *Soulcycle Inc v Matalan Ltd.*¹⁰ It is therefore necessary to take account of the meaning(s) of BEEFY to different categories of average consumers where they each constitute a significant proportion of the relevant public.

41. According to Collins Dictionary, BEEF has several meanings, the most common of which is the flesh of a bovine animal. It also means "*a complaint*" (i.e. to 'beef' about something). The word can also be used informally to mean "*to strengthen*", or as a reference to "*human flesh, especially when muscular.*" The primary meaning of

⁹ See LIB07

¹⁰ [2017] EWHC 496 (Ch), Mann J.

BROTHERS is obvious: male siblings. The word 'brothers' can also be used to describe another male of the same race, religion, country, trade union etc. with similar beliefs.

42. I consider it likely that average consumers will think of BEEF BROTHERS as a composite term because BEEF appears to qualify BROTHERS in some way. I do not therefore accept that BEEF is the distinctive and dominant element of BEEF BROTHERS.

43. Most average consumers will understand the words BEEF and BROTHERS, individually, to mean 'meat of a cow' and 'male siblings', respectively. However, I am not convinced that average consumers of wines will, as the proprietors contend, go to the trouble of analysing the combination of the meanings of these words in sufficient depth to attribute to them the collective meaning 'brothers involved in selling food products containing beef'.

44. I have considered whether BEEF BROTHERS might strike average consumers as the surname of brothers called 'Beef'. However, although many average consumers might consider this possibility, I doubt whether many would be sure about it. This is because, so far as I am aware, BEEF is not a recognised surname.

45. I have also considered whether one of the informal meanings of BEEF as "*human flesh, especially when muscular*" supports a finding that BEEF BROTHERS will be understood as 'muscular brothers' or similar. If so, this would create a substantial degree of conceptual similarity to the first dictionary meaning of BEEFY. I have concluded that this meaning will not be immediately apparent to any significant proportion of average consumers of wines. This is because the analysis required to connect the meaning "*human flesh, especially when muscular*" with 'male siblings' so as to arrive at the collective meaning of 'muscular brothers' is again probably more than average consumers of wine are likely to undertake. The mere fact that the word 'beefy' is probably derived from the 'beef' is not sufficient to create a significant degree of conceptual similarity between the marks when, in the context of BEEF BROTHERS, that meaning is not immediately apparent.

46. Finally, I have considered whether BEEF BROTHERS will be understood as conveying the idea of bothers with a complaint (i.e. a ‘beef’ about something). One again I find that although some average consumers might see this meaning, most would not. And even those who do will probably be unsure if this is the intended meaning of BEEF BROTHERS.

47. I therefore find that although the two words in the earlier trade mark look (and sound) as though they should have a connected meaning, BEEF BROTHERS is unlikely to convey any clear and specific meaning to average consumers of wines. By contrast, relevant average consumers are likely to immediately attribute to BEEFY the conceptual meaning of “*a man... [who] has a big body and large muscles*” and/or ‘Ian Botham’. I therefore find there is no conceptual similarity between the marks.

Distinctive character of the earlier mark

48. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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

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

chambers of commerce and industry or other trade and professional associations.”

49. There is no evidence of use of the earlier mark. Consequently, my assessment of the distinctive character of the mark must be based on its inherent characteristics. The applicant’s representative submits that BEEF BROTHERS is unique, unusual, and therefore highly distinctive.

50. The words BEEF BROTHERS are clearly not descriptive of wines. However, the lack of descriptiveness does not necessarily mean that the mark is highly distinctive. After all, the law does not permit the *prima facie* registration of descriptive marks and, therefore, the majority of registered trade marks are not descriptive. They cannot all be of above average distinctiveness. There is no evidence either way as to whether the earlier mark is unique in utilising the word BEEF in relation to wine. I accept it is unlikely to be commonplace and that BEEF BROTHERS will probably strike consumers as a distinctive mark for wines. I do not accept that this makes it a highly distinctive mark, such as an entirely made-up word. In my view, the earlier mark, particularly the element resembling BEEFY (i.e. the word BEEF),¹¹ has a ‘normal’ or medium degree of distinctive character in relation to wines.

Global assessment of the likelihood of confusion

51. The applicant submits that there is a likelihood of direct confusion and confusion through association. In support of the first part of this submission, the applicant points out that wines are often ordered in busy bars with loud ambient music. According to the applicant, the public tend to shorten trade marks, especially in settings with loud ambient noise. The suggested result will be that the aural similarity between BEEF and BEEFY will cause confusion between customers and bartenders.

52. The applicant has filed no evidence. Consequently, there is nothing to show that consumers habitually shorten its trade mark to BEEF when ordering wines in bars, or generally. I see no reason why consumers would do so because BROTHERS appears to be an integral part of the earlier mark. As to the argument that BEEF may be

¹¹ *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.

misheard as BEEF-EE in settings where is loud ambient noise, I note that in *Rani Refreshments FZCO v OHIM*,¹² the General Court held that the likelihood of confusion must be assessed on the basis of normal marketing conditions. Therefore, whilst it is appropriate to make some allowance for the fact that wines are sometimes sold in settings with significant background noise, it is not appropriate to assess the likelihood of confusion in settings with so much noise that consumers cannot make themselves properly heard. Further, as the General Court observed in *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*,¹³ alcoholic beverages are normally sold in self-service shops where the marks can be seen. And even in the case of noisy bars and restaurants, consumers usually choose wines from a wine list, where again the mark can be seen. Therefore, whilst it is necessary to consider the effect of all normal and fair use of the contested mark, it is not appropriate to give disproportionate weight to the likelihood of confusion in noisy bars. This is all the more so where the suggested likelihood of aural confusion depends in part on consumers artificially shortening the earlier mark to BEEF.

53. In *The Picasso Estate v OHIM* the CJEU found that:

“20. By stating in paragraph 56 of the judgment under appeal that, where the meaning of at least one of the two signs at issue is clear and specific so that it can be grasped immediately by the relevant public, the conceptual differences observed between those signs may counteract the visual and phonetic similarities between them, and by subsequently holding that that applies in the present case, the Court of First Instance did not in any way err in law.”

54. Taking account of:

- (i) the medium degree of visual and aural similarity between the marks;
- (ii) the identity of the goods;
- (iii) the possibility of confusion through imperfect recollection;

¹² Case T-523/12

¹³ Case T-187/17

(iv) the fact that BEEFY will convey a conceptual meaning to average consumers of wines (as a person with a big body and large muscles and/or Lord Botham's nickname), whereas the earlier mark as a whole has no clear and specific meaning (or at least no clear similar meaning);

(v) there is no evidence that BEEF BROTHERS had acquired a particularly high distinctive character through use in relation to wines by the relevant date;

(vi) there is no evidence that BEEF BROTHERS is shortened to BEEF in use and such shortening seems inherently unlikely;

(vii) average consumers of wines pay at least a normal or average degree when selecting such goods;

- I find that there was no likelihood of direct confusion amongst any significant proportion of average consumers at the relevant date.

55. As to the likelihood of indirect confusion, I remind myself that it is not sufficient that the contested mark simply calls the earlier trade mark to mind. This is mere association, not a species of confusion. In the now well-known case of *L.A. Sugar Limited v By Back Beat Inc.*,¹⁴ Mr Iain Purvis QC (as the Appointed Person) very clearly explained what indirect confusion is. He said:

"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

¹⁴ Case BL O/375/10

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’.

56. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,¹⁵ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria*,¹⁶ where he said that “*a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion.*” Arnold LJ agreed saying that there must be a “*proper basis*” for concluding that there is a likelihood of indirect confusion, where there is no likelihood of direct confusion.

57. The applicant has not provided any specific basis, let alone a proper basis, to support its case of indirect confusion. For my part, I cannot see why an average consumer who is aware of the difference between BEEFY and BEEF BROTHERS would be likely to assume that these marks are used by the same or connected undertakings. BEEFY has a different meaning to the usual meaning of BEEF. Therefore, even assuming that BEEF is a plausible variation on the mark BEEF BROTHERS, this makes it unlikely that BEEFY would be used as a variant of BEEF BROTHERS.

58. The applicant’s case of indirect confusion through association therefore also fails.

59. This means that the applicant’s sole ground for invalidation based on section 5(2) of the Act must be rejected.

Outcome

60. The application for invalidation is dismissed.

Costs

61. The application has failed and the proprietors are entitled to a contribution towards their costs. I assess the appropriate contribution as follows:

¹⁵ [2021] EWCA Civ 1207

¹⁶ BL O/219/16 at [16]

£300 for considering the application and filing a counterstatement;

£1100 for filing evidence;

£300 for filing written submissions in lieu of a hearing.

62. I therefore order E.I. Wines Limited to pay Benchmark Drinks Limited and Lord Ian Botham the (total) sum of £1700 towards the cost of dealing with this application. This sum to be paid within 21 days of the end of the period allowed for appeal or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings (subject to any order of the appellate tribunal).

Dated 6th September 2022

Allan James
For the Registrar