

O/0073/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. 3722517

**IN THE NAME OF
MUHARREM BAKLAN**

**TO REGISTER THE FOLLOWING TRADE
MARK:**



IN CLASSES 30 & 32

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 432372
BY COORS BREWING COMPANY**

Background and pleadings

1. On 17 November 2021, Muharrem Baklan (the “applicant”) applied to register the trade mark shown on the front page of this decision in the UK. The application was published for opposition purposes on 4 February 2022 and registration is sought for the following goods:

Class 30: Coffee; tea; cocoa; artificial coffee; rice; pasta; noodles; tapioca; sago; flour; cereal preparations; bread; pastries; confectionery; chocolate; sweets (candy), candy bars and chewing gum; chewing gum; chewing gum [sugar-free]; sugar-free chewing gum; chewing gum for breath freshening; ice cream; sherbets [ices]; edible ices; sugar; honey; treacle; yeast; baking powder; salt; seasonings; spices; preserved herbs; vinegar; sauces; other condiments; ice [frozen water].

Class 32: Energy drinks, ice tea.

2. On 4 April 2022, Coors Brewing Company (“the opponent”) opposed the application in respect of goods in class 32 only on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following marks:

<p>(“the first earlier mark”)</p> <p>BLUE MOON</p>	<p>Registration no: UK00002428821</p> <p>Filing date: 02/08/2006</p> <p>Registration date: 28/03/2008</p> <p>Class 32: Beer, stout, lager, porter, ale.</p>
<p>(“the second earlier mark”)</p> 	<p>Registration no: UK00801335401</p> <p>Filing date: 23/09/2016</p> <p>Registration date: 25/08/2017</p> <p>Class 32: Beers, stout, lager, porter and ale; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</p>

3. The opponent submits that there is a likelihood of confusion because the applicant's mark is similar to the opponent's and the respective goods are identical or similar.

4. By virtue of their earlier filing dates, the above registrations constitute as earlier marks within the meaning of section 6 of the Act. The first earlier mark had completed its registration processes more than five years before the application date of the contested mark and is therefore subject to the proof of use provisions contained in section 6A of the Act. The second earlier mark, however, had been registered for less than five years at the filing date of the application in issue and is therefore not subject to proof of use pursuant to section 6A of the Act. Consequently, the opponent can rely upon all of the goods it has identified for its second earlier mark.

5. The applicant filed a counterstatement denying the claims made and putting the opponent to proof of use in respect of its first earlier mark.

6. Both parties are professionally represented in these proceedings, the opponent by Groom Wilkes and Wright LLP and the applicant by Forresters IP LLP. Whilst the opponent filed evidence and submissions, the applicant did not. Neither party requested a hearing nor filed written submissions in lieu. I now make this decision after careful consideration of the papers before me.

7. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

8. The opponent's evidence was filed in the form of a witness statement dated 3 August 2022 from the company's Legal Counsel in Western Europe, Victoria Bowers

and includes 9 exhibits in total. Whilst I do not intend to summarise the evidence here, I have taken it into consideration in reaching my decision and I will refer to it below where necessary.

DECISION

Section 5(2)(b)

9. 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”.

10. 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) 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.

My approach

11. The opponent has relied upon two earlier rights under Section 5(2)(b). I find the goods covered by the opponent's second mark to be more similar to the applicant's goods than those covered by the opponent's first mark relied upon. Further, I consider there to be additional visual similarities between the opponent's second earlier mark and the applicant's mark, such as the shared representation of a moon. I will therefore proceed initially by considering the opponent's second mark only. However, in the event that there is no likelihood of confusion, I will return to consider the opponent's first earlier mark, and if the opponent's position under this ground may be improved by its reliance on the same.

Comparison of Goods

12. The General Court ("GC") confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

"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".

13. 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).

14. The goods to be compared are as follows:

Opponent's Goods	Applicant's Goods
The second earlier mark: Class 32: Beers, stout, lager, porter and ale; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.	Class 32: Energy drinks, ice tea.

15. The applicant's goods *energy drinks* and *ice tea* are both non-alcoholic drinks. On that basis, I consider these goods to be identical to the opponent's [...] *other non-alcoholic drinks* based on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

16. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' services. I must then determine the manner in which the services are likely to be selected by the average consumer. 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."

17. The average consumer for the contested goods will primarily comprise members of the general public. However, there will also be some business users purchasing on behalf of a commercial undertaking. The goods will be available to the general public through trade channels such as shops and supermarkets and will likely

be self-selected by the consumer from shelves or chilled cabinets in shops. In these circumstances visual considerations are likely to dominate. I also consider that the goods would also be available in bars, public houses and cafes. In these circumstances, there may be an aural aspect to the selection process, such as requesting the goods from a member of staff however, visual considerations would still likely dominate as the goods would likely be displayed behind bars or on a menu¹.

18. The purchasing act will not require an overly considered thought process as, overall, they are relatively inexpensive everyday purchases; the purchasing of the goods is likely to be more casual than careful. The general public will, nevertheless, consider factors such as the flavour, nutritional value and dietary requirements as they will wish to ensure that what they are purchasing meets their individual requirements. Taking the above factors into account, I find that the level of attention of the general public in respect of the identical goods would be below medium.

19. In respect of the business user the goods will be available via wholesale websites, catalogues, and stores. They will likely pay a medium degree of attention when purchasing goods on behalf of a business. Whilst the visual considerations are also likely to dominate in these circumstances the goods may be ordered over the phone, and so I cannot completely discount the aural considerations in this respect either.

Comparison of marks



20. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

¹ *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

“...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 relevant 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.”

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

22. The marks to be compared are as follows:

Opponent's Mark	Applicant's Mark
	

23. The opponent's earlier mark comprises several elements. The words 'BLUE MOON' are presented in a stylised royal blue font on a white banner. The wording and the banner both sweep upwards diagonally from left to right across a light blue stylised full moon device. The banner, wording and full-moon element are all presented on a royal blue rectangular background. I consider the 'BLUE MOON' wording to be the most dominant and distinctive part of the mark due in part to its size and positioning, in addition to the fact it is a word element. The banner and the full-

moon device elements, whilst playing a secondary role, will not go unnoticed by the average consumer. The blue background merely serves as a backdrop for the other elements, and the stylisation of the font also plays only a small role in the overall impression.

24. The applicant's mark comprises the words 'BLUU MOON' in a grey stylised cursive font. The wording sweeps upwards from left to right. Above the wording is a figurative grey and white stylised full moon device. The wording and figurative elements sit atop a black rectangular background. Whilst the figurative full moon device appears to be large in size and bold in comparison to the word element, it is well established that in the case of a mark consisting of both word and figurative elements, the word elements must generally be regarded as more distinctive than the figurative elements, or even as dominant, since the relevant public will keep in mind the word elements to identify the mark concerned, the figurative elements being perceived more as decorative elements². With this in mind, I find the 'BLUU MOON' element and the full moon device to be equally dominant in the overall impression whereas the black backdrop and cursive font play only a minor role.

Visual comparison

25. The marks coincide visually through their use of the wording 'BLUE/BLUU MOON' however, I note the difference in the opponent using the standard English dictionary spelling of the word 'BLUE' whereas the applicant appears to have deliberately misspelt this word as 'BLUU'. Both marks also include a figurative full moon device, although this is placed in different positions in each of the marks. I also note the similarity in the way the wording is presented in both marks by sweeping upwards in a diagonal motion although the wording in the opponent's mark is presented on a banner laid on top of the moon device whereas the wording in the applicant's mark is presented below the moon device in a stylised cursive font. Differences also lie in the colour scheme of the respective marks with the opponent adopting a blue colour scheme and the applicant's mark being presented in a greyscale scheme though it seems that fair and normal use would permit the use of

² see *Migros-Genossenschafts-Bund v EUIPO – Luigi Lavazza (CReMESPRESSO)*, Case T-189/16, paragraph 52

the opponent's mark in a greyscale colour scheme. Weighing up these factors, I consider the marks to be visually similar to a high degree.

Aural comparison

26. Notwithstanding the slight variation in spelling, I consider that both the opponent's earlier marks and the applicant's mark will all be articulated as two words containing two syllables in total, using the standard English pronunciation of the words BLUE-MOON. Consequently, I find that the competing marks are aurally identical.

Conceptual comparison

27. Conceptually, the word "MOON" in the earlier mark will likely be understood as a celestial object which travels around a planet. The word "BLUE" in the earlier mark will be understood as describing the colour of the moon thus conveying the concept of a moon that is blue in colour. The figurative elements present in the mark will further reinforce this idea. I also acknowledge that the term "BLUE MOON" will call to mind for some consumers the concept of a blue moon, a moon that looks blue in the sky and appears only occasionally. Turning to the applicant's mark, I consider that the term "BLUU" will either be perceived as a fanciful misspelling of "BLUE" or alternatively, the misspelling will be overlooked and again, the word will be seen as "BLUE". I find that this along with the figurative moon device will result in the average consumer bringing to mind the same conceptual messages as the earlier mark, rendering the marks conceptually identical.

Distinctive character of the earlier mark

28. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91. In determining the distinctive character of a trade mark and, accordingly, in assessing whether it is highly distinctive, it is necessary to make an overall assessment of the greater or lesser capacity of the trade mark to identify the goods for which it has been registered as coming from a particular undertaking and

thus to distinguish those goods from those of other undertakings - *Windsurfing Chiemsee v Huber and Attenberger* Joined Cases C-108/97 and C-109/97 [1999] ETMR 585. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

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

29. 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, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

30. I acknowledge that the opponent has filed evidence in these proceedings however I note that this evidence is directed towards the use of its first earlier mark in relation to beers and ales. As such, I do not find that this evidence would assist the opponent in demonstrating that the distinctiveness of its second mark has been

enhanced through use in relation to non-alcoholic drinks. Therefore, I find it appropriate to only consider the inherent position of the second earlier mark.

31. The mark consists of two recognisable dictionary words which, as outlined previously, will be perceived as describing a moon that is blue in colour or referring to a blue moon, namely a moon that looks blue in the sky and appears only occasionally. The figurative image of a blue moon further emphasises these concepts. I do not find the wording or the figurative elements in the mark to be allusive to the goods in question. Consequently, I find the opponent's mark holds a medium degree of inherent distinctive character.

Likelihood of confusion

32. There is no simple formula for determining whether there is a likelihood of confusion. I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them (*Canon* at [17]) and considering the various factors from the perspective of the average consumer. In making my assessment, I must bear in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

33. 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.

34. Earlier in my decision, I found the respective goods to be identical. I identified the average consumer to be a member of the general public or business users purchasing on behalf of a business undertaking and in both cases the goods will be purchased predominantly by visual means, though I do not discount an aural element to the purchase. I also concluded that no more than a below medium degree of attention will be paid during the purchasing process in respect of the general public,

and this will be higher in respect of the business consumer who will pay a medium degree of attention.

35. I found the respective marks to be visually similar to a high degree and aurally and conceptually identical. I also found the earlier mark to have a medium level of inherent distinctive character in respect of its registered goods however, the distinctiveness of the mark has not been enhanced through the use made of it.

36. In this case, the distinctive and dominant elements in the competing marks are highly similar, namely the 'BLUE/BLUU MOON' wording and the full moon device in relation to the applicant's mark. As a general rule, the beginning of marks tend to have more of an impact than the endings³ so I find that the one letter difference at the end of the words 'BLUE/BLUU' may go unnoticed or be misremembered by the average consumer who will pay a below medium degree of attention. I find that the shared concept between the marks will aid consumers in remembering the marks' features such as 'BLUE MOON' and the full moon devices but, through imperfect recollection the exact positioning of these elements and the stylisation may be misremembered. The aural identity between the same means there is still less to help the consumer differentiate between the marks when recalling the same. Considering these factors along with the interdependency principle, I am of the view that there exists a likelihood of direct confusion between the respective marks.

37. I now go on to consider indirect confusion.

38. 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

³ See *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

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.)

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

40. Firstly, I note that this situation is not one that appears to fall into the categories set out in *L.A. Sugar*, however, I remind myself that they were not intended to be exhaustive. Having previously concluded that there is a high degree of similarity between “BLUE MOON” and “BLUU MOON” (and that the difference between them may be imperfectly recalled), I am of the view that even if average consumer recognises the differences in the stylisation of the marks they are still likely to imperfectly recollect the differences in spelling between the word elements. In those instances, it is my view that the differences between the stylisation would likely be

attributed to a brand revamp rather than denoting identical goods from different undertakings. I consider that it is not uncommon for undertakings to undergo a brand 're-fresh' or 'brand-revamp' from time to time to accommodate changes in marketing considerations. Due to the aural and conceptual identity, in addition to the identity of the goods, the perception that all of the key visual elements in the marks are shared to an extent, and the medium level of distinctiveness held by the earlier mark, I find that if the average consumer notices these stylistic differences these will not in this case be put down to coincidence, but they will therefore regard the applicant's mark as an alternative stylisation of the opponent's mark. Consequently, I find there is a likelihood of indirect confusion.

Conclusion

41. The opposition under section 5(2)(b) of the Act has succeeded. Subject to any successful appeal against my decision, the application will be refused in the UK for the following goods:

Class 32: Energy drinks, ice tea.

42. Given that I have found a likelihood of confusion based on the opponent's second earlier mark, I do not consider it necessary to consider the remaining mark on the basis that doing so will not improve the opponent's position.

COSTS

43. The opponent has been successful and is entitled to a contribution towards its costs. Awards of costs in proceedings commenced after 1 July 2016 are governed by Annex A of Tribunal Practice Notice ('TPN') 2 of 2016. Using that TPN as a guide, I award the opponent the sum of £800 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee:	£100
Preparing a statement and considering the other side's statement:	£200

Filing evidence:

£500

44. I therefore order Muharrem Baklan to pay the sum of £800 to COORS BREWING COMPANY. 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 24th day of January 2023

Catrin Williams

For the Registrar