

O/0369/23

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NUMBER 3737633
BY EYAD HADI MESFER AL THABETI
TO REGISTER THE FOLLOWING TRADE MARK:



The trade mark consists of the word 'berain' in a lowercase, sans-serif font, positioned above the Arabic word 'بيرين' (Bairin) in a stylized, bold font. The Arabic letters are connected and have a modern, geometric appearance.

IN CLASS 34

AND

AN OPPOSITION THERETO UNDER NUMBER 432772
BY GLOBAL BEVERAGE COMPANY LTD.

BACKGROUND AND PLEADINGS

1. On 29 December 2021, Eyad Hadi Mesfer Al Thabeti (“the applicant”) applied to register the mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on 21 January 2022 and registration is sought for the following goods:

Class 34: Tobacco, raw or manufactured; tobacco products; cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); electronic cigarettes; tobacco products for the purpose of being heated; electronic devices and their parts for the purpose of heating cigarettes or tobacco in order to release nicotine-containing aerosol for inhalation; liquid nicotine solutions for use in electronic cigarettes; smokers` articles, cigarette paper, cigarette tubes, cigarette filters, tobacco tins, cigarette cases, ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters, matches.

2. On 21 April 2022, Global Beverage Company Ltd. (“the opponent”) opposed the application in full, based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon UK trade mark number 3260956, which has a filing date of 3 October 2017 and a registration date of 29 December 2017. The representation of the mark and the list of registered goods (all of which are relied upon) is below:



Class 32: Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.

3. Under section 5(2)(b), the opponent claims that there is similarity between the marks and the goods, resulting in a likelihood of confusion.

4. As a result of its earlier filing date, the mark relied upon by the opponent qualifies as an earlier mark for the purpose of section 6(1)(a) of the Act. In accordance with section 6A of the Act, the earlier mark is not subject to proof of use and so the opponent may rely upon all the goods in its specification without being required to prove genuine use.

5. The applicant filed a defence and counterstatement denying the ground of opposition on the basis of a lack of similarity between the marks and the goods.

6. The opponent is represented by Page, White & Farrer Limited; the applicant by Trade Mark Wizards Limited. Only the opponent filed evidence in these proceedings. Neither party requested a hearing, nor did they file written submissions in lieu.

EVIDENCE

7. The opponent filed evidence in the form of the witness statement of James Philip Cornish dated 18 October 2022 and its corresponding nine exhibits (JPC1 – JPC9). Mr Cornish is a UK Trade Mark Attorney representing the opponent.

8. Other than Exhibit JPC1, which purports to show the word BERAIN used in relation to the opponent's business and that it will be seen as an invented word in the UK, the evidence is intended to demonstrate similarity between the parties' goods. The gist of the opponent's arguments in this regard and the corresponding exhibits are as follows:

- The opponent's water products would be suitable for 'Hookah pipes', a key part of the Arabic culture, which is pertinent since the relevant goods are of particular interest to Arabic speakers. The opponent's *water* and the applicant's *tobacco* and *pipes* would therefore be used by the same consumers. Exhibit JPC2 contains online articles referring to the use of Hookah pipes.

- The opponent's water products are likely to be sold side by side in the same establishments as tobacco products. Exhibit JPC3 is intended to show Shisha bars in the UK selling these goods side by side to the same consumers. The exhibit contains undated screenshots of the menus of three establishments in either London or Brighton and online articles relating to Shisha bars, all aiming to show that Shisha bars sell tobacco products alongside water and other drinks.
- Alcohol and tobacco have overlapping health risks and Exhibit JPC4 contains related articles.
- Alcohol and tobacco are sold side by side in duty free establishments in the UK such as airports. Exhibit JPC5 contains related online articles dated between 2019 and 2021. Mr Cornish attests to a close association between these goods as a result.
- Websites recommend to consumers what tobacco to use with what drinks. Exhibit JPC6 contains online articles from various websites which pair tobacco products with different drinks. Mr Cornish claims this demonstrates the same consumers will buy and use these items together.
- Drinks and tobacco products have the same suppliers, such as Philip Morris, who is the owner of 7Up lemonade and Marlboro cigarettes. An associated Wikipedia page is provided at Exhibit JPC7. Mr Cornish's witness statement and a Wikipedia page mention Nabisco selling tobacco and food products and plans for Philip Morris to purchase the Nabisco company in 2000.
- Tobacco can be an ingredient of drinks: Exhibit JPC8 contains one undated article titled "Why Tobacco Cocktails Are a Terrible Idea".
- Approaches to advertising tobacco and soft drinks are similar in that they seek brand loyalty and seek to stress the link between those goods and social attributes young people may wish to have. This is referred to in an article dated 13 October 2021 titled "Sugary Drinks and Tobacco – Different Industries,

Same Playbook”. The article draws parallels between beverage and tobacco industries’ marketing practices.

9. I have considered the entirety of this evidence and will refer to it, where necessary, during my decision.

DECISION

Relevance of EU law

10. 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. This is why this decision continues to make reference to the trade mark case law of EU courts.

Section 5(2)(b)

11. Sections 5(2)(b) and 5A of the Act state:

“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.”

Relevant law

12. The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case 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.

Comparison of goods

13. In comparing the respective specifications, all relevant factors should be considered, as per *Canon*, where the CJEU stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be

taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

14. Additionally, the criteria identified in *British Sugar Plc v James Robertson & Sons Limited* (“*Treat*”) [1996] RPC 281 for assessing similarity between goods and services also include an assessment of the channels of trade of the respective goods or services and, in the case of self-serve consumer items, where in practice they are respectively found.

15. Further, in *Kurt Hesse v OHIM*,¹ the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods/services. In *Boston Scientific Ltd v OHIM*,² the General Court (“GC”) stated that “complementary” means:

“...there is 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.”

16. I bear in mind that it is permissible to group goods together for the purposes of assessment: *Separode Trade Mark*:³

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

17. The competing goods are shown in the table below:

¹ Case C-50/15 P

² Case T-325/06

³ BL O/399/10

The opponent's goods	The applicant's goods
<p>Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic beverages; fruit beverages and fruit juices; syrups and other preparations for making beverages.</i></p>	<p>Class 34: <i>Tobacco, raw or manufactured; tobacco products; cigars, cigarettes, cigarillos, tobacco for roll your own cigarettes, pipe tobacco, chewing tobacco, snuff tobacco, kretek; snus; tobacco substitutes (not for medical purposes); electronic cigarettes; tobacco products for the purpose of being heated; electronic devices and their parts for the purpose of heating cigarettes or tobacco in order to release nicotine-containing aerosol for inhalation; liquid nicotine solutions for use in electronic cigarettes; smokers' articles, cigarette paper, cigarette tubes, cigarette filters, tobacco tins, cigarette cases, ashtrays, pipes, pocket apparatus for rolling cigarettes, lighters, matches.</i></p>

18. The factors to consider in determining similarity between goods are well established by the above case law, from which I do not intend to deviate.

19. To my mind, both parties' goods can be grouped together, respectively, and compared in the same way for the same reasons.

20. It is clear that the nature of the opponent's goods differs to that of the applicant's goods. The opponent's goods are drinks or liquids used to make drinks. The applicant's goods are tobacco and tobacco-related goods as well as apparatus and articles for use in smoking, and lighters and matches. Their intended purpose clearly differs as does the way in which the goods are used. Consumers will not choose

between purchasing a drink and purchasing any of the applicant's goods and so I do not consider there to be any competition between them.

21. In regard to complementarity, the case law is clear that this factor involves a two-step test. Firstly, the goods must be considered important or indispensable for one another. Secondly, this must result in consumers thinking the responsibility for the goods lies with the same undertaking. In line with the case law, the parties' goods are simply not so important for one another that consumers would assume linked undertakings. The goods are not complementary. I note that the opponent's evidence indicates that water can be used with some pipes but as Mr Daniel Alexander QC (as he then was) noted in *Sandra Amelia Mary Elliot v LRC Holdings Limited*,⁴ even if goods are always used together, it does not follow that they are similar goods for trade mark purposes.

22. Given the differences between the goods, it is not standard for them to reach the market through the same trade channels.

23. In relation to the location of the goods in physical premises, the opponent's evidence indicates that alcohol and tobacco products are often sold side by side in the duty free departments of airports. I do not consider this, in itself, to be sufficient for a finding of similarity. All other relevant factors point away from similarity between the goods and so the mere fact that goods may be sold, in very few circumstances, side by side does not persuade me that the goods at issue are similar in a trade mark sense.

24. The fact that tobacco can be an ingredient in drinks is also not decisive. In *Les Éditions Albert René v OHIM*, Case T-336/03, the GC found that the mere fact that one good may be used as part of another does not show that they are similar since their nature, purpose and customers may be completely different. I consider that to be the case here.

⁴ BL O/255/13.

25. The remainder of the opponent's evidence is not persuasive since it goes to arguments which are not relevant to the assessment I am required to make – websites pairing tobacco with drinks; beverage and tobacco industries' marketing practices; and alcohol and tobacco having overlapping health risks, for example.

26. Overall, I am not satisfied that there is any meaningful similarity between the parties' goods and the evidence does not persuade me otherwise.

27. In accordance with *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, if there is no similarity between goods, there is no likelihood of confusion to be considered. Consequently, the opposition has failed.

CONCLUSION

28. The opposition has failed in its entirety and the application may proceed to registration.

COSTS

29. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £400, calculated as follows.

Considering the opponent's statement and preparing a counterstatement: £200

Considering the opponent's evidence: £200⁵

Total **£400**

30. I therefore order Global Beverage Company Ltd. to pay Eyad Hadi Mesfer Al Thabeti the sum of £400. This sum should be paid within 21 days of the expiry of the

⁵ This is below the scale minima due to the applicant not filing evidence.

appeal period or, if there is an appeal, within 21 days of the final determination of the appeal proceedings.

Dated this 18th day of April 2023

E FISHER (née VENABLES)

For the Registrar