

O-568-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3306951
BY ABOUT LEISURE BUSINESS & ACCOMMODATION LIMITED TO REGISTER
THE TRADE MARK**



IN CLASSES 33 AND 35

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 413870 BY
VIKING RIVER CRUISES (BERMUDA) LIMITED**

BACKGROUND AND PLEADINGS

1) About Leisure Business & Accommodation Limited (hereafter “the applicant”) applied on the 27 April 2018 to register the following trade mark that was then subsequently published for opposition purposes on 29 June 2018:



2) The application was filed in respect of the following list of goods and services:

Class 33: *Scotch whisky (malt); Mead [hydromel]; Mulled wine; Mulled wines; Natural sparkling wines; Pre-mixed alcoholic beverages all being Scotch Whisky based liqueurs and mixed alcoholic beverages, all produced in Scotland; Pre-mixed alcoholic beverages, other than beer-based all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland ; Preparations for making alcoholic beverages; Prepared alcoholic cocktails all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Prepared wine cocktails; Red wine; Red wines; Rose wines; Rum; Rum [alcoholic beverage]; Rum infused with vitamins; Rum punch; Rum-based beverages; Schnapps; Scotch whisky; Scotch whisky based liqueurs; Sherry; Sparkling grape wine; Sparkling red wines; Sparkling white wines; Sparkling wine; Sparkling wines; Spirits all being Scotch whisky, Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland, Spirits and liquors all being scotch whisky; Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Spirits [beverages] all being Scotch Whisky, Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; till wine; Sweet cider; Sweet wine; Sweet wines; Table wines;*

Vermouth; Vodka; Whiskey being Scotch whisky Whiskey [whisky] being Scotch whisky; Whisky being Scotch whisky; White wine; White wines; Wine; Wine coolers [drinks]; Wine punch; Wine-based aperitifs; Wine-based drinks; Wines; Wines of protected appellation of origin; Wines of protected geographical indication; Absinthe; Acanthopanax wine [Ogapiju]; Aguardiente [sugarcane spirits]; Alcohol (Rice -); Alcoholic aperitif bitters; Alcoholic aperitifs all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages containing fruit all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages, except beer all being Scotch whisky, Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages (except beer) all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages except beers all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland Alcoholic beverages (except beers) all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages [except beers] all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic beverages of fruit; Alcoholic bitters; Alcoholic carbonated beverages, except beer all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland Alcoholic cocktail mixes all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic cocktails all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic cocktails containing milk all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland Alcoholic cocktails in the form of chilled gelatins all being Scotch Whisky based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic egg nog; Alcoholic energy drinks all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic essences all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic extracts all being Scotch whisky Scotch Whisky-based liqueurs and

mixed alcoholic beverages, all produced in Scotland; Alcoholic fruit beverages; Alcoholic fruit cocktail drinks; Alcoholic fruit extracts; Alcoholic jellies all being Scotch whisky Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland ;Alcoholic punches all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic tea-based beverage all being made with Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Alcoholic wines; Alcopops; Amontillado; Anise [liqueur];Anisette; Anisette [liqueur];Aperitif wines;Aperitifs all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Aperitifs with a distilled alcoholic liquor base all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Arak; Arak [arrack];Arrack; Arrack [arak];Baijiu [Chinese distilled alcoholic beverage];Beverages (Alcoholic -), except beer all being Scotch Whisky, scotch whisky based liqueurs and mixed alcoholic drinks all produced in Scotland; Beverages containing wine [spritzers];Beverages (Distilled -) all being Scotch whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Bitters; Black raspberry wine (Bokbunjaju);Blackcurrant liqueur; Blended whisky being Scotch Whisky; Bourbon whiskey; Brandy; Cachaca; Calvados; Canadian whisky; Cherry brandy; Chinese brewed liquor (laojiou);Chinese mixed liquor (wujiapiejiou);Chinese spirit of sorghum (gaolian-jiou);Chinese white liquor (baiganr);Chinese white liquor [baiganr];Cider; Ciders; Cocktails; Coffee-based liqueurs; Cooking brandy; Cooking wine; Cordials [alcoholic beverages];Cream liqueurs all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Curacao;Dessert wines; Digesters [liqueurs and spirits] all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Distilled beverages all being Scotch whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Distilled rice spirits [awamori];Distilled spirits being Scotch whisky, or Scotch whisky based liqueurs or mixed alcoholic beverages produced in Scotland; Distilled spirits of rice (awamori);Dry cider; Extracts of spiritous liquors all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in

Scotland; Fermented spirit; Flavored tonic liquors; Fortified wines; Fruit (Alcoholic beverages containing -);Fruit extracts, alcoholic;Fruit wine;Gaolian-jjou [sorghum-based Chinese spirits];Gin;Ginseng liquor;Grape wine;Grappa;Herb liqueurs all being Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland;Hulless barley liquor;Hydromel [mead];Japanese liquor containing herb extracts;Japanese liquor containing mamushi-snake extracts;Japanese liquor flavored with Japanese plum extracts;Japanese liquor flavored with pine needle extracts; Japanese regenerated liquors(naoish); Japanese sweet grape wine containing extracts of gingseng and crichona bark.

Class 35: *Retail services connected with the sale of clothing and clothing accessories; Retail services connected with the sale of furniture; Retail services in relation to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland'; Retail services in relation to art materials; Retail services in relation to beer; Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to fashion accessories; Retail services in relation to foodstuffs; Retail services in relation to furniture; Retail services in relation to meats; Retail services in relation to non-alcoholic beverages; Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services in relation to tableware; Retail services relating to alcoholic beverages all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Retail services relating to delicatessen products; Retail services relating to food; Retail services relating to furniture; Retail services relating to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland via catalogues; Retail services relating to beer via catalogues.*

3) Viking River Cruises Limited (hereafter “the opponent”) opposed the application on the basis of section 5(2)(b), 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). It subsequently decided not to pursue the latter two grounds and the case

comes to be decided based upon section 5(2)(b) only. The opponent relies upon seven earlier European Union Trade Marks (“EUTMs”), the relevant details of which are:

EUTM No. 13298542
 <p>Colours claimed: Red; Black; White Filing date: 25 September 2014 Priority date: 24 September 2014 Date of entry in register: 4 February 2015</p>
<p>The list of goods:</p> <p>Class 33: <i>Vodka; distilled spirits.</i></p>

EUTM No. 10374734
<p>VIKING VODKA</p> <p>Filing date: 27 October 2011 Date of entry in register: 23 April 2018</p>
<p>The list of goods:</p> <p>Class 33: Alcoholic beverages; vodka, spirits, liqueurs and cocktails.</p>

EUTM No. 10374643

VIKING

Filing date: 27 November 2011

Date of entry in register: 10 April 2018

The list of goods:

Class 33: Alcoholic beverages; vodka, spirits, liqueurs, cocktails and champagne.

EUTM No. 10374858

VIKING AQUAVIT

Filing date: 27 October 2011

Date of entry in register: 7 May 2018

The list of goods (relied upon):

Class 33: *Alcoholic beverages; vodka, spirits, liqueurs, cocktails and champagne.*

Class 43: *Catering services; services for providing food and drink; ...*

EUTM No. 12494662



Filing date: 13 January 2014

Priority date: 3 August 2013

Date of entry in register: 27 May 2014

The list of goods:

Class 25: Coats; fleece pullovers; fleece tops; fleece vests; hats; jackets; polo shirts; shirts; sweatshirts; t-shirts; tops; visors; wind resistant jackets; all the aforesaid goods not for sports purposes.

EUTM No. 13385711 [against Class 35 only]

VIKING EXPLORER SOCIETY

Filing date: 21 October 2014

Priority date: 22 May 2014

Date of entry in register: 16 March 2015

The list of goods and services (relied upon):

Class 25: *Coats; fleece pullovers; fleece tops; hats; jackets; polo shirts; shirts; sweatshirts; T-shirts; tops; wind resistant jackets; all the aforesaid goods not specifically for sports purposes.*

Class 35: *Organization, operation and supervision of customer loyalty services for commercial, promotional and/or advertising purposes relating to travel tour services; providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services; advice and consultancy relating to all the aforesaid.*

EUTM No. 13385737 [against CI 35 only]



Filing date: 21 October 2014 2014

Priority date: 22 May 2014

Date of entry in register: 16 March 2015

The list of goods (relied upon):

Class 25: *Coats; fleece pullovers; fleece tops; hats; jackets; polo shirts; shirts; sweatshirts; T-shirts; tops; wind resistant jackets; all the aforesaid goods not specifically for sports purposes.*

Class 35: *Organization, operation and supervision of customer loyalty services for commercial, promotional and/or advertising purposes relating to travel tour services; providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services; advice and consultancy relating to all the aforesaid.*

4) The opponent's marks are earlier marks within the meaning of section 6(1) of the Act because they all have an earlier filing date than the contested application. They completed their registration procedures less than five years before the publication date of the contested application and, as a result, they are not subject to the proof of use provisions contained in section 6A of the Act. The consequence of this is that the opponent may rely upon the full list of goods and services contained in its earlier marks.

5) The opponent asserts that registration of the contested application would be contrary to section 5(2)(b) of the Act because the respective marks are similar and in respect of identical or similar goods and services. It contends that, as a result, there is a likelihood of confusion.

6) The applicant filed a counterstatement denying the claims made. It asserts that:

- (i) its mark suggests whisky of a Viking or made by a Viking, whereas the opponent's (first two) marks, being or incorporating "Viking Vodka", suggest that it is either made by Vikings or by the opponent itself;
- (ii) there are differences between the logo of a Viking long ship that appears in the respective parties' marks;
- (iii) the opponent's first mark uses the colours red and white whereas the applicant uses black and blue with white letters;

- (iv) its mark is only used in respect of Scottish products, but the opponent does not trade Scottish products, nor does it trade in Scotland;
- (v) the opponent does not trade in whisky;
- (vi) the opponent appears to only trade in spirits that are available to its own cruise ship customers and there is no possibility to purchase their products online or in stores. Therefore, it is impossible to “pass-off” as the opponent;
- (vii) the collision in class 33 is with vodka, Cognac and Aquavit. The applicant does not trade in such goods and it “would offer to change the class specification”, and;
- (viii) the applicant’s class 35 specification is included in the application because it mainly trades in whisky barrels and furniture made of barrels, but it “seems” clear that the opponent is not registered under the class 35 because of the retail of furniture”.

7) The opponent is represented, in these proceedings, by Bristows LLP. The applicant is not represented.

8) The opponent filed written submissions on 3 April 2019 and 5 August 2019. I will refer to these to the extent that I consider it necessary. No hearing was requested. I take this decision after careful consideration of the papers.

DECISION

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”.

Comparison of goods and services

10) In its counterstatement, the applicant has made various observations and assertions regarding the parties' current marketing strategies. I have summarised these at points (iv) to (viii) in paragraph 5, above. However, for the purposes of considering grounds based upon section 5(2), the level of similarity between the parties' respective goods and services must be based upon the notional and fair use of all the goods and services listed in the respective specifications of goods and services and not just a subset that reflects the current business model. As Kitchen L.J. noted in *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220:

“80. The reason for the absence of confusion may be that the mark has only been used to a limited extent or in relation to only some of the goods or services for which it is registered, or in such a way that there has been no possibility of the one being taken for the other. So there may, in truth, have been limited opportunity for real confusion to occur.”

11) It is for this reason, that I reject the applicant's assertions and I will undertake an analysis of the similarity of the respective goods and services based on all the goods and services listed in the opponent's registrations and the contested application.

12) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

13) 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.

14) In addition, I also keep in mind the guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, when it stated that:

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

Class 33

15) When applying the guidance in *Merica*, it is self-evident that, with the exception of *preparations for making alcoholic beverages*, all of the applicant’s goods are included in the broad term *alcoholic beverages* present in the Class 33 specification of the opponent’s VIKING VODKA (10374734), VIKING (10374643) and VIKING AQUAVIT (10374858) marks. Therefore, they are considered identical.

16) In respect of the applicant's *preparations for making alcoholic beverages*, this term includes such goods as alcoholic extracts and alcoholic essences that can be added to alcoholic beverages to add flavour or another characteristic. As such, they have a different nature and purpose from the opponent's *alcoholic beverages*, but are likely to have overlapping distribution channels and average consumers and such preparations are also complementary to alcoholic beverages in the sense that they are "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"¹. Taking all of this into account, I conclude that they share a medium level of similarity.

Class 35

17) In considering the level of similarity between the parties' respective goods and services, I keep in mind the guidance of the General Court ("the GC") in *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, where it held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree.

18) In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. sitting as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

"9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under

¹ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06

Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent's earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are 'similar' to goods are not clear cut."

19) However, on the basis of the European courts' judgments in *Sanco SA v OHIM*², and *Assembled Investments (Proprietary) Ltd v. OHIM*³, upheld on appeal in *Waterford Wedgewood Plc v. Assembled Investments (Proprietary) Ltd*⁴, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

² Case C-411/13P

³ Case T-105/05, at paragraphs [30] to [35] of the judgment

⁴ Case C-398/07P

20) With this guidance in mind, I consider the similarity of the opponent's goods to the applicant's various retail services:

Retail services connected with the sale of clothing and clothing accessories, Retail services in relation to clothing; Retail services in relation to clothing accessories

21) These services, insofar as they relate to "clothing" at large, relate to a broad range of goods that include the same clothing listed in the Class 25 specifications of the opponent's VIKING (plus device) (12494662), VIKING EXPLORER SOCIETY (13385711) and VIKING EXPLOER SOCIETY (and device`) (13385737). The opponent submits that the intended purpose of these retail services is to encourage the sale of the same goods as included in its Class 25 specification and, therefore, the goods are indispensable to the retail services relating to them. It further submits that retailers of clothing are often also responsible for the manufacturing of the goods and, therefore, the respective goods and services go hand-in-hand with the consumer believing that the responsibility for both the goods and the retailing of them lies with the same undertaking.

22) I do not agree that the purpose is the same. The purpose of clothes is to cover and, sometimes, decorate the body whereas, the purpose of a retail service is to present goods to the consumer and to provide advice regarding said goods with a view to selling them. Their nature and method of use is also, self-evidently, different with one being goods for wearing and the other a service to aid purchasing. However, I agree with the opponent that, in respect of these goods and their retailing, the average consumer will be familiar with traders providing both. Therefore, there is an overlap of trade channels. They are also complementary in the sense that clothing is indispensable to the retailing of the same in such a way that customers are may think that the responsibility for the goods lies with the same undertaking. Taking all of the above into account, I conclude that the respective goods and services share a medium level of similarity.

23) The opponent also submits that its Class 35 services consisting of various promotional and purchase incentive related services are commonly used by retailers and are, therefore, also complementary to the applicant's services. I note that the

first term of the Class 35 lists of services that it relies upon (in 13385711 and 13385737) is limited as "... *relating to travel tour services*". Consequently, these services cannot relate to the retail of clothing. In light of this, I find there is very little, if any similarity to the applicant's services. In respect of the second of the opponent's Class 35 terms, namely, *providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services*, these are not so limited, but rather, they are limited by way of the actual rewards offered. Therefore, such an incentive award program could be offered by a clothing retailer. As a result, there is an element of complementarity because the same trader may be expected to provide both, leading to some overlap of trade channels. I conclude that there is similarity, but it is no more than low, placing the opponent in no stronger position than when relying upon its goods.

Retail services in relation to fashion accessories

24) This term includes "fashion accessories" that includes "clothing accessories" and, therefore, the considerations regarding similarity are the same as for clothing accessories (considered above), and I conclude that these services share a medium level of similarity with the opponent's Class 25 goods. My findings regarding the opponent's reliance upon its Class 35 services are identical to those set out in paragraph 23, above and I find that there is a low level of similarity with its incentive award programs.

Retail services in relation to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland'; Retail services relating to alcoholic beverages all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Retail services relating to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland via catalogues

25) The position in respect of these services is, to some extent, analogous to the issues set out in paragraphs 21 to 23, above. Whilst considering that issue, as an average consumer, I recognised that clothing manufacturers may also make their clothing ranges available through their own retail services provision. In respect of alcoholic beverages, retailers may sell “own-branded” beverages and this, in a similar way to the way I have previously assessed clothing/retail of clothing, may create an expectation that the same or linked undertaking is responsible for both the goods and the retail services related to them. I take account that the respective goods and services are self-evidently different in nature, intended purpose, they are not in competition and their method of use also differs. I take all these points together and conclude that there is medium level of similarity between the respective goods and services.

26) In respect of the opponent's case based upon similarity to its *providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services* it is in no stronger position. In respect of the opponent's services, the considerations are identical to those discussed in paragraph 23. I conclude that there is similarity, but that it is no more than low.

27) In respect of the opponent's *catering services and services for providing food and drink* present in its VIKING AQUAVIT registration, these services are reasonably closely aligned to the retail of foodstuffs and delicatessen products and the consumer will be familiar with both services being provided from the same premises by the same undertaking. I conclude there is at least a medium level of similarity.

Retail services in relation to beer; Retail services in relation to non-alcoholic beverages; Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services relating to beer via catalogues

28) These services relate to goods that are not identical to the opponent's goods and consequently, the similarity can be no better than in my previous consideration. I find that if there is any similarity, it is no more than low. Therefore, the opponent's best case is, once again, its Class 35 services (as per the previous paragraph), where I find that there is at least a medium level of similarity.

Retail services connected with the sale of furniture; Retail services in relation to art materials; Retail services in relation to foodstuffs; Retail services in relation to furniture; Retail services in relation to meats; Retail services in relation to tableware; Retail services relating to delicatessen products; Retail services relating to food; Retail services relating to furniture

29) These remaining services all relate to goods not covered by the opponent's specifications, but it does rely upon *catering services* and *services for providing food and drink* present in its earlier VIKING AQUAVIT mark (10374858) even though it makes no specific submissions. It is my view that the similarity exists for the same reasons as set out in paragraph 27, above. I conclude that there is at least a medium level of similarity between all of the applicant's terms that describe the retail of various food and delicatessen goods.

30) The remaining terms, namely *retail services connected with the sale of furniture; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to tableware; Retail services relating to furniture* are not obviously similar to any goods relied upon by the opponent, but as discussed earlier, its *providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services* share a no more than low level of similarity.

Comparison of marks

31) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, 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 CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....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.”

32) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of the distinctive and dominant components of the 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.

33) The opponent's VIKING VODKA (and device) mark (13298542) places it in no stronger position than when it relies upon its word mark VIKING VODKA (10374734), therefore, for convenience, I will only consider the latter of these two. Similarly, it is my view that its VIKING EXPOLOER SOCIETY word mark (13385711) places the opponent in no stronger position than its VIKING EXPLORER SOCIETY device mark (13385737). Therefore, again for convenience, I will only consider similarity to the latter of these. The respective marks are, therefore:

Opponent's marks	Applicant's mark
<p data-bbox="379 304 616 338">VIKING VODKA</p> <p data-bbox="440 416 555 450">VIKING</p> <p data-bbox="365 528 630 562">VIKING AQUAVIT</p>  <p data-bbox="276 804 687 887">VIKING</p> 	

Similarity to the opponent's VIKING mark

34) The opponent's mark consists of the single word VIKING and this is, self-evidently, the dominant and distinctive element of the mark. The applicant's mark consists of the words WHISKY and VIKING together with a device of what appears to be a Viking long boat where the sail is represented by a Scottish flag (further emphasised by it appearing in the colours blue and white). Additionally, the mark also includes the text "EST. 2018" a dark, circular background and a circular border consisting of a broken black line. It is the words WHISKY VIKING and the device of the long boat that are the dominant elements of the mark, but the word WHISKY has little, if any distinctive character in respect of many of the applicant's goods and services that relate to whisky goods.

35) Visually, the common element of both marks is the word VIKING. No other element of the applicant's mark is reproduced in the opponent's mark. The word VIKING is one of the three dominant elements of the applicant's mark. Taking all of this into account, I find that the respective marks share a low to medium level of visual similarity.

36) Aurally, the opponent's mark consists of the two syllables VI-KING. I agree with the opponent's submission that, in the applicant's mark, it is the VIKING and WHISKY elements that are likely to be expressed, but because the word WHISKY is descriptive and it is normal for the descriptor to come after the distinctive element, it may be expressed as VI-KING-WHISS-KEY. However, although I believe it to be less likely, I recognise that it may be expressed in the order presented in the mark, namely, WHISS-KEY-VI-KING. The other elements present in the applicant's mark are not likely to be expressed when it is referred to. Where the first expression of the applicant's mark occurs, it will share a medium or slightly higher similarity to the opponent's mark. Where the latter expression of the applicant's mark occurs, the similarity will be lower but not significantly so.

37) Conceptually, the opponent's mark is likely to be perceived as per its ordinary meaning of "Scandinavian seafaring pirates and traders..."⁵. The term is widely understood by the UK public. The applicant's mark consists of a number of elements, but the concept of "Viking" is prominent because of the presence of the word and this is reinforced by the presence of the device of a Viking long boat. The concept of "whisky" is also present, but because, as noted earlier, this concept has a descriptive role in respect of many of the goods concerned, it has a lesser impact than the concept of the elements that are distinctive. The circular background element and the text "Est. 2018" plays either no or a low relevant distinctive role in the mark. Taking all of this into account, I find that the respective marks share a good deal of conceptual similarity.

⁵ <https://www.oxfordreference.com/search?q=viking&searchBtn=Search&isQuickSearch=true>

Similarity to the opponent's VIKING VODKA and VIKING AQUAVIT marks

38) In respect of these marks, I take account that in both cases the additional element is a description of a type of alcoholic spirit beverage and the dominant and distinctive element is the VIKING element. Consequently, whilst the VODKA and AQUAVIT elements add an additional visual, aural and conceptual dimension to the marks, it is one of a description rather than as a distinctive element that assists in identifying trade origin. I find that, because of this, the level of visual, aural and conceptual similarity is very similar to that discussed above in respect of the similarity to the opponent's VIKING mark.

Similarity to the opponent's VIKING (plus long boat device) mark

39) The dominant and distinctive elements of the applicant's mark, namely the word VIKING and the device of a Viking long boat are reproduced in the opponent's mark. The word VIKING and the device of a long boat share equal dominance within the mark. I recognise that the device of the long boat exhibits differences upon close inspection, but with the possible exception of the Scottish flag sail of the applicant's device, these differences are likely to go unnoticed by the average consumer. I do not ignore that the applicant's mark also includes the elements "WHISKY", "EST. 2018" and the dark circular background with the dotted line boundary and recognise that these reduce the visual similarity but, nevertheless, I would put this as reasonably high. Aurally and conceptually, the considerations are identical to those discussed in paragraph 36 and 37, above and I find a medium or slightly higher aural similarity where the applicant's mark is expressed as VIKING WHISKY or lower, but not significantly so, where it is expressed as WHISKY VIKING. Conceptually, there is a good deal of similarity.

Similarity to the opponent's VIKING EXPLORER SOCIETY (and device) mark

40) The VIKING and long boat device elements are the dominant and distinctive elements of the mark but the EXPLORER SOCIETY elements combine to create a description that has no direct meaning to the goods and services covered by the

mark. Consequently, these elements add to the overall distinctive character of the mark to a certain extent.

41) Visually, the marks coincide because of the common occurrence of the VIKING element and because of a device of a Viking long boat. I have already commented upon the impact of the differences and similarities between the devices. I also note that both marks include a circular background even though one is dark and the other white. I also keep in mind that the words EXPLORER SOCIETY are absent in the applicant's mark and that the word WHISKY and the text "EST. 2018" are absent in the opponent's mark. I conclude that the respective marks share a good deal of visual similarity. Aurally, as I have already noted, the applicant's mark will be expressed as either WHIS-KEY-VI-KING or VI-KING-WHIS-KEY. The opponent's mark is likely to be expressed as VI-KING-EX-PLOR-ER-SO-SI-ET-EE. Their aural similarity is low.

42) The marks of both parties share the same concept of "viking" but in all other respects they are different. However, because of the dominant position of the VIKING element of the opponent's mark and the VIKING and long boat device in the applicant's mark, it will be the most prominent concept in both and I conclude that the respective marks share at least a medium level of conceptual similarity.

Average consumer and the purchasing act

43) 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*.

44) 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.”

45) The relevant average consumer of the respective goods and services is, predominantly, likely to be an ordinary member of the public. The goods and services in issue are all generally aimed at the general public who will purchase, if not every day, then on a regular basis. The level of care and attention paid during the purchasing act of such goods and services is likely to be average. In all cases, visual impressions are likely to be important, but I do not ignore that aural considerations may play a part in the purchasing process where the consumer may aurally request the goods or services.

Distinctive character of the earlier trade marks

46) 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 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).”

47) The opponent makes no claim to an enhanced level of distinctive character acquired through use (as of the relevant date in these proceedings, namely, the filing date of the contested application – 27 April 2018) and provides no evidence. Therefore, I only have to consider the inherent level of distinctive character of its various marks.

48) In respect of its VIKING VODKA, VIKING and VIKING AQUAVIT marks, the distinctive character rests with the VIKING element. The VODKA and AQUAVIT elements describe an alcoholic beverage and, consequently add little or nothing to the distinctive character. The word VIKING has no obvious meaning in respect to the goods and services and I find, when considering the marks as a whole, that they share a medium to high level of distinctive character.

49) In respect of the following mark:



the addition of a device of a Viking long boat reinforces the meaning of the word and the device is also distinctive in its own right. When the two elements are used together as in this mark, the level of distinctive character is greater than for the previous three marks and I conclude that it has a high level of distinctive character.

50) In respect of the following mark:



the distinctive character is influenced primarily by the word VIKING and the device of a long boat, but I do not ignore the impact of the circular borders and the words EXPLORER SOCIETY. Each of the distinctive elements has a slightly less dominant impact upon this mark because of their relative size within the mark. I conclude that this mark is endowed with a medium to high level of distinctive character.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

51) The following principles are obtained from the decisions of the 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:

(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.

52) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer who rarely has the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

53) Insofar as the contested application covers Class 33 goods, the opponent's best case lies with those earlier marks that also include Class 33 goods, namely, the marks VIKING VODKA, VIKING and VIKING AQUAVIT. I have not included the opponent's VIKING VODKA (and device) mark because its Class 33 specification is less extensive than the others and, therefore, potentially represents a less strong case and is certainly no stronger than that provided by the others.

54) I have found that:

- The majority of the respective goods are identical;
- In respect of the non-identical goods, namely, *preparations for making alcoholic beverages*, they share a medium level of similarity to the opponent's goods;
- The applicant's mark consists of a number of elements, but its dominant elements are the words WHISKY and VIKING and the device of a Viking long boat. However, I have noted the lack of distinctive character in the word WHISKY. In all three of the opponent's marks, the dominant and distinctive element is the word VIKING;
- In respect of the opponent's VIKING mark, the applicant's mark shares a low to medium level of visual similarity, a medium (or slightly higher) level of aural similarity and a good deal of conceptual similarity;

- The average consumer is predominantly ordinary members of the public. The degree of care and attention paid during the purchasing act will be average;
- The purchasing process is likely to be visual, but I recognise that aural considerations may play a part;
- The opponent's marks share a medium to high level of inherent distinctive character and that this has not been enhanced through use.

55) Taking account of all of the above, I conclude that the presence of the device element and the presentation in a dark, circular background in the applicant's mark is not likely to go unnoticed by the average consumer and, therefore, there is no likelihood of direct confusion where one mark is mistaken for the other. However, I must also consider if there is a likelihood of indirect confusion. The difference between the two types of confusion was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10:

“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.

56) In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

57) Mr Mellor warns against a finding of indirect confusion merely because both marks share a common element. However, in the current case the “VIKING” element, common to both the opponent’s and applicant’s marks is either the dominant and distinctive element or, in the case of the applicant’s mark, shares dominance of the mark with the device of a Viking long boat that, as I have already observed, reinforces the meaning of the word. Therefore, this device element, whilst it will not go unnoticed, neither does it offset the impression created by the “VIKING” element. The remaining elements of the applicant’s mark do not detract from this impression. Taking all of this into account together with my other findings, including the identity of most of the respective goods and a medium similarity in respect of the other, and when considering the complete respective marks, I find that the average consumer is likely to believe that all the goods provided under the respective marks are provided by the same or linked undertaking. Consequently, there is a likelihood of indirect confusion.

58) In respect of most of the applicant’s Class 35 services, the opponent’s best case lies with its marks that include goods in Class 25 and/or services in Class 35 and/or Class 43, namely, 10374858 VIKING AQUAVIT (Class 43), 12494662 VIKING and device (Class 25) and 133855737 VIKING EXPLORER SOCIETY and device (Classes 25 and 35). I have not included the opponent’s mark VIKING EXPLORER SOCIETY (13385711) because it offers it no better chance of success than when it relies upon its word and device mark incorporating the same words.

59) In respect of the applicant’s various retail services relating to alcohol products, the opponent’s best case also partially lies with its 10374734 VIKING VODKA, 10374643 VIKING and 10374858 VIKING AQUAVIT.

60) My findings regarding similarity of the respective goods and services can be summarised as follows:

Applicant's services	Opponent's services
<p><i>Retail services connected with the sale of clothing and clothing accessories, Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to fashion accessories</i></p>	<p>Found to share a medium level of similarity with the following goods:</p> <p>12494662: Class 25: <i>Coats; fleece pullovers; fleece tops; fleece vests; hats; jackets; polo shirts; shirts; sweatshirts; t-shirts; tops; visors; wind resistant jackets; all the aforesaid goods not for sports purposes</i></p> <p>13385737: Class 25: <i>Coats; fleece pullovers; fleece tops; hats; jackets; polo shirts; shirts; sweatshirts; T-shirts; tops; wind resistant jackets; all the aforesaid goods not specifically for sports purposes.</i></p> <p>Found to share a low level of similarity with the following services:</p> <p>13385737: Class 35: <i>...; providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services; advice and consultancy relating to all the aforesaid.</i></p>
<p><i>Retail services in relation to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland'; Retail services relating to alcoholic beverages all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Retail services relating to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland via catalogues</i></p>	<p>Found to share a medium level of similarity:</p> <p>10374734, 10374643 and 10374858: Class 33: <i>Alcoholic beverages; vodka, spirits, liqueurs, cocktails and champagne.</i></p> <p>Found to share at least a medium level of similarity:</p> <p>10374858: Class 43: <i>Catering services; services for providing food and drink</i></p>

<p><i>Retail services in relation to beer; Retail services in relation to non-alcoholic beverages; Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services relating to beer via catalogues</i></p>	
<p><i>Retail services in relation to foodstuffs; Retail services in relation to meats; Retail services relating to delicatessen products; Retail services relating to food;</i></p>	<p>Found to share at least a medium level of similarity:</p> <p>10374858: Class 43: <i>Catering services; services for providing food and drink</i></p> <p>Found to share a low level of similarity with the following services:</p> <p>13385737: Class 35: <i>...; providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services; advice and consultancy relating to all the aforesaid.</i></p>
<p><i>Retail services connected with the sale of furniture; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to tableware; Retail services relating to furniture</i></p>	<p>Found to share a low level of similarity with the following services:</p> <p>13385737: Class 35: <i>...; providing incentive award programs through issuance and processing of loyalty points, discount loyalty coupons, electronic offers and incentives, namely, travel credits and participation in exclusive entertainment events, for purchase of a company's goods and services; advice and consultancy relating to all the aforesaid.</i></p>



61) In addition, I have found that:

- The applicant's mark consists of a number of elements, but its dominant elements are the words WHISKY and VIKING and the device of a Viking long

boat. However, I have noted the lack of distinctive character in the word WHISKY. In the opponent's VIKING VODKA, VIKING and VIKING AQUAVIT word marks, the dominant and distinctive element is the word VIKING. In respect of its VIKING and long boat device mark and VIKING EXPLORER SOCIETY device mark, I have found that the word VIKING and the device of a long boat share equal dominance in the mark;

- In respect of the opponent's VIKING VODKA, VIKING and VIKING AQUAVIT word marks, they share a low to medium level of visual similarity, a medium (or slightly higher) level of aural similarity and a good deal of conceptual similarity to the applicant's mark;
- In respect of the opponent's VIKING and device mark, it shares a reasonably high level of visual similarity, a medium or slightly higher level of aural similarity and a good deal of conceptual similarity to the applicant's mark;
- In respect of the opponent's VIKING EXPLORER SOCIETY device mark, it shares a good deal of visual similarity, low aural similarity and at least a medium level of conceptual similarity;
- The average consumer is predominantly ordinary members of the public. The degree of care and attention paid during the purchasing act will be average;
- The purchasing process is likely to be visual, but I recognised that aural considerations may play a part;
- The opponent's marks share a medium to high level of inherent distinctive character and that this has not been enhanced through use.

62) Taking account of all of the above, and for the same reasons as I explained in paragraph 54, I find there is no likelihood of direct confusion. However, where I have found that there is a medium or higher level of similarity to the opponent's goods and services, there is a likelihood of indirect confusion because the respective goods/services and the respective marks are such that the average consumer is likely to believe that the providers of the goods and services are the same or economically linked. My finding applies as set out in the following table:

Applicant's services	Likelihood of confusion with the following of the opponent's marks and goods and services
<p><i>Retail services connected with the sale of clothing and clothing accessories, Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to fashion accessories</i></p>	<p>12494662</p>  <p>Class 25: <i>Coats; fleece pullovers; fleece tops; fleece vests; hats; jackets; polo shirts; shirts; sweatshirts; t-shirts; tops; visors; wind resistant jackets; all the aforesaid goods not for sports purposes</i></p> <p>13385737</p>  <p>Class 25: <i>Coats; fleece pullovers; fleece tops; hats; jackets; polo shirts; shirts; sweatshirts; T-shirts; tops; wind resistant jackets; all the aforesaid goods not specifically for sports purposes.</i></p>

<p><i>Retail services in relation to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland'; Retail services relating to alcoholic beverages all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Retail services relating to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland via catalogues</i></p> <p><i>Retail services in relation to beer; Retail services in relation to non-alcoholic beverages; Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services relating to beer via catalogues</i></p>	<p>10374858 VIKING AQUAVIT</p> <p>Class 43: <i>Catering services; services for providing food and drink</i></p>
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63) The opposition fails in respect of the remaining Class 35 services.

Summary

64) The opposition succeeds in respect of all the applicant's goods and the following list of services and, subject to any successful appeal, the application will be refused in respect of all of these:

Retail services connected with the sale of clothing and clothing accessories, Retail services in relation to clothing; Retail services in relation to clothing accessories; Retail services in relation to fashion accessories;

Retail services in relation to foodstuffs; Retail services in relation to meats; Retail services relating to delicatessen products; Retail services relating to food;

Retail services in relation to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic

beverages, all produced in Scotland'; Retail services relating to alcoholic beverages all being Scotch Whisky and Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland; Retail services relating to alcoholic beverages (except beer) all being Scotch whisky and 'Scotch Whisky-based liqueurs and mixed alcoholic beverages, all produced in Scotland via catalogues Retail services in relation to beer; Retail services in relation to non-alcoholic beverages; Retail services in relation to preparations for making alcoholic beverages; Retail services in relation to preparations for making beverages; Retail services relating to beer via catalogues

65) The opposition fails in respect of the following of the applicant's Class 35 services:

Retail services connected with the sale of furniture; Retail services in relation to art materials; Retail services in relation to furniture; Retail services in relation to tableware; Retail services relating to furniture

Costs

66) As the opponent has been largely successful, it 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 opponent costs as a contribution towards the costs of the proceedings, as follows:

Preparing a statement and considering the applicant's statement (including official fee of £200)	£500
Preparing written submissions	£400
Total	£900

67) I therefore order About Leisure Business & Accommodation Limited to pay Viking River Cruises (Bermuda) Limited the sum of £900 This sum should be paid within 21

days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

26 September 2019

Mark Bryant

For the Registrar

The Comptroller-General