

O/0225/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003490730
IN THE NAME OF EVELYN ROBERTS LIMITED
FOR THE TRADE MARK**



IN CLASS 33

AND

**THE OPPOSITION THERETO UNDER NO. 421604
BY INTERNATIONAL DRINKS LIMITED**

Background and pleadings

1. On 17 May 2020, Evelyn Roberts Limited (“the applicant”)¹ applied to register the trade mark shown in the cover page of this decision in the UK.

2. The application was accepted and published in the Trade Marks Journal on 26 June 2020 in respect of the following goods:

Class 33: *Vodka, Whisky, Rum, Gin, Brandy, Tequila, Mezcal.*

3. On 28 September 2020, International Drinks Limited (“the opponent”) opposed the application under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the three trade marks set out below:²

EU018118455 (“the First Earlier Mark”)

TAYLOR’S SELECT

Filing date: 02 September 2019; registration date: 09 January 2020

Class 33: *Alcoholic beverages (except beers); Wines; Fortified wines; sparkling wines; port wine.*

EU018185931 (“the Second Earlier Mark”)



TAYLOR'S

Filing date: 20 January 2020; registration date: 22 May 2020

¹ The application was initially filed in the name of Robert Kaniu but the owner’s name was subsequently changed upon a request by Mr Kaniu received 2 May 2020.

² Although the UK has left the EU and the EUTMs relied upon by the opponent enjoy protection in the UK as comparable trade marks, the EUTMs remain the relevant rights in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application.

Class 33: *Wines; wines including fortified wines; fortified wines; port; port wine.*

Class 35: *Retail and wholesale services relating to wines, wines including fortified wines, fortified wines, port, port wine, books, books relating to the history of port, books relating to port, recipe books, food and drink, stationery, pads of paper, and clothing.*

UK00000544283 (“the Third Earlier Mark”)

TAYLOR'S

Filing date: 04 September 1933; registration date:04 September 1933

Class 33: *Port wine.*

4. The opponent’s marks have filing dates that are earlier than the filing date of the contested application and, therefore, they are earlier marks, in accordance with Section 6 of the Act. Only the third earlier mark had completed its registration process more than five years before the filing date of the contested application and is subject to the proof of use conditions as per Section 6A of the Act. Since the use provisions at Section 6A of the Act do not apply to the first and second earlier mark, the opponent can rely on these marks for all of the goods and services it has identified in its notice of opposition without demonstrating that it has used them.

5. The opponent claims that there is a likelihood of confusion because the applicant’s mark is similar to its own marks, and the respective goods and services are identical or highly similar.

6. The applicant filed a defence and counterstatement, denying all the grounds. In particular the applicant:

- states that the words ‘TAYLOR’ and ‘TAILOR’ in the respective marks are conceptually different, one being a first name or surname, the other meaning “*a person whose job is to make clothes*”. In this connection, the applicant provides statistics about the number of babies named ‘TAYLOR’ and ‘TAILOR’ between 1996 and 2019, these being 15 and 50,000 respectively, and states that

Companies House shows more than 1,000 companies using the common name 'TAYLOR' and that other marks with the component 'TAYLOR' have co-existed on the IPO registry. This, the applicant claims, shows that 'TAYLOR' is a common name. The applicant further states that the contested mark *"was crafted with the pre-eminence of London's Savile Row in mind, the centre of global clothes tailoring expertise which is well documented"*;

- refers to a previous decision of the Singapore Trade Mark Office, in which the opponent opposed the registration of the mark 'TAYLORS WAKEFIELD' whilst relying on the same mark in this case, namely 'TAYLOR'S';
- refers to, amongst others, previous decisions of other Hearing Officers whereby the competing marks incorporated names and the oppositions were rejected;
- provides images of the parties' respective products and get-ups and highlights the differences between the respective marks;
- claims that the opponent's port wines will not be confused with the applicant's spirits, due to the different factors involved in the selection of the goods, including alcohol strength, color of the product, positioning within supermarkets, price, ingredients, country of origin, shelf life, type of packaging, size of packaging and colour of packaging;
- claims that *"public interest is not served when legitimate commercial enterprise is barred from exploiting its trade descriptive and the use of the trade marks must not be used by one entity to stifle genuine trade competition"*.

7. In addition to the Form TM8 and the counterstatement, the applicant provided 12 exhibits, a number of which contain evidence aimed at supporting some of the statements made in the counterstatement, including, inter alia, copies of webpages showing statistics about baby names, copies of trade mark decisions and state of the register evidence referred to in the counterstatement. These documents were subsequently refiled in the form of written submissions, however, as they were not filed in evidential format, I will disregard them.

8. Only the opponent filed evidence during the evidence rounds. The applicant filed written submissions dated 22 September 2021. I shall refer to the evidence and submissions to the extent that I consider necessary.

9. The opponent is represented by Boulton Wade Tennant LLP and the applicant represents itself. Neither party asked to be heard nor did they file submissions in lieu of a hearing.

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 Trade Marks 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.

The evidence

11. The opponent's evidence consists of two witness statements by Andrew John Smith and two affidavits of Rui Jorge de Almeida e Sousa Magalhães.

12. Mr Smith is the Finance and Operations Director and Company Secretary of Mentzendorff & Co Ltd, the exclusive UK distributor for products produced and supplied by Quinta and Vineyards Bottlers Vinhos S.A. sold using the portfolio of trade marks incorporating the brand "TAYLOR'S" under license from the opponent. Mr Smith's witness statements are both dated 24 March 2021, however, the first witness statement is marked as "*confidential*" as it contains three confidential exhibits (AJS-1 - AJS-3). Attached to the second witness statement are 12 further (non-confidential) exhibits (AJS 4 – AJS 15).

13. Mr Magalhães is the Financial Director of The Fladgate Partnership - Vinhos, S.A., of which, Quinta and Vineyards Bottlers Vinhos S.A is said to be a subsidiary company. Mr Magalhães' affidavits are both dated 25 March 2021, however, the first affidavit is marked as "*confidential*" as it contains a confidential exhibit (RM1). Attached to Mr Magalhães' second affidavit are 10 further (non-confidential) exhibits ((RM2 - RM11).

My approach to the proof of use

14. In the present opposition, the opponent relies on three earlier marks. As I have said above, the first and the second earlier mark are not subject to proof of use, however, the third earlier mark is. Whilst the third earlier mark is, admittedly, closer to the contested mark, the additional elements which are present in the first and the second earlier mark, namely the word 'SELECT' (in the first earlier mark) and the coat of arms (in the second earlier mark) are either laudatory (the word 'SELECT' being understood as referring to a particular selection of goods or to the fact that the goods are of a particular quality) or decorative, and the common element 'TAYLOR'S' still retains an independent role in those marks. This means that, effectively, I am unlikely to reach different conclusions on the likelihood of confusion based on the additional differences between these marks and the contested mark.

15. Despite being closer in terms of marks, the third earlier is only registered for *Port wine*, and, it clearly does not provide a stronger case for the opponent in terms of similarity of goods, compared to the first earlier mark (because, as I will explain, this mark covers identical goods) and also to the second earlier mark (because this mark cover the same goods covered by the third earlier mark). Consequently, I will carry out my assessment of the likelihood of confusion, based on the first and second earlier marks (which are not subject to proof of use) and I will return to the third earlier mark at the end, only if it became necessary.

DECISION

Section 5(2)(b)

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

“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”.

17. Section 5A of the Act is as follows:

“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.”

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing

in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods and services

19. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

20. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

21. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, 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:

“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”.

22. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking.”

23. The goods and services to be compared are as follows:

The applicant’s goods	The opponent’s goods and services
<p>Class 33: <i>Vodka, Whisky, Rum, Gin, Brandy, Tequila, Mezcal.</i></p>	<p>The first earlier mark</p> <p>Class 33: <i>Alcoholic beverages (except beers); Wines; Fortified wines; sparkling wines; port wine.</i></p> <p>The second earlier mark</p> <p>Class 33: <i>Wines; wines including fortified wines; fortified wines; port; port wine.</i></p> <p>Class 35: <i>Retail and wholesale services relating to wines, wines including fortified wines, fortified wines, port, port wine, books, books relating to the history of</i></p>

	<p><i>port, books relating to port, recipe books, food and drink, stationery, pads of paper, and clothing.</i></p>
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24. The opponent's first earlier mark is registered for a wide specification covering *Alcoholic beverages (except beers)*. *Alcoholic beverages* is wide enough to cover all the goods for which the contested mark seeks registration, namely *Vodka, Whisky, Rum, Gin, Brandy, Tequila, Mezcal* (none of which is beer). These goods are identical on the principle outlined in *Meric*.

25. The second earlier mark covers a variety of wines. The contested mark seeks registration for different types of spirits, namely *Vodka, Whisky, Rum, Gin, Brandy, Tequila, Mezcal*. Although the production process of the opponent's wine is different from that of the contested spirits, these goods all belong to the same category of alcoholic drinks intended for the general public. The goods are therefore similar in nature at the general level of both being alcoholic drinks. The purpose of the goods is also the same, i.e. the goods are drunk as a matter of taste and in order to obtain the effect of alcohol. The goods can be served in restaurants and in bars, are on sale in supermarkets and grocery stores and may be consumed together by the general public at social events, whether in homes or establishments dedicated to leisure and catering. However, they are usually made from different ingredients to wines. Further, they are usually short drinks and higher in alcohol. People who drink spirits are therefore less likely to see them as alternatives to wines. Wines and spirits are therefore not usually in competition. Nor are they complementary. I find that these goods are similar to a low degree.

Average consumer

26. 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*. 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. (as he then was) 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.”

27. The average consumer of the goods at issue is the adult general public. The goods may be bought in supermarkets, off-licences and their online equivalents. This all suggests a more visual selection process. The goods are also sold in restaurants, bars and public houses, where they may be requested orally, although this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount aural considerations.



28. The goods are not everyday beverage products but are likely to be purchased on a semi-regular basis. The goods are not inexpensive and when selecting them the average consumer is likely to consider factors such as flavour and alcoholic content. The average consumer is, therefore, likely to pay a medium degree of attention during selecting the goods.

Comparison of marks

29. 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 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.”

30. It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account 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. The respective marks are shown below:

The applicant's mark	The opponent's marks
	<p>TAYLOR'S SELECT (The first earlier mark)</p>  <p>TAYLOR'S (The second earlier mark)</p>

Overall impression

The contested mark

31. The contested mark consists of a number of elements, i.e. words, a figurative element and colour. The figurative element of the mark depicts a waiter carrying a bottle of wine, a glass of wine and two cocktail glasses on a tray. This element is presented in black and gold colours and is placed above a black banner on which the word 'TAILOR'S' is written in bold gold characters, with the words 'ESTABLISHED IN

LONDON' presented in black, in a smaller size, underneath it within a gold rectangular frame.

32. The opponent states that the primary, dominant and distinctive element of the contested mark is "TAILOR'S". I agree. The word 'TAILOR'S' has an average degree of inherent distinctiveness in the context of the goods at issue and whilst the particular graphic representation of the waiter in the act of serving drinks is distinctive and creates a visual impact, the concept conveyed by it lacks distinctiveness in itself because the relevant public will see it as a direct reference to the goods, which are alcoholic beverages. Hence, even when considering the particular graphic representation of the waiter, it does not overcome the basic tenet that words speak louder than devices - because the average consumer will more readily refer to the goods in question by quoting the name of the trade mark than by describing its figurative element. The banner will also have a visual impact, but is very low in distinctiveness, being a purely decorative element. Likewise, the words 'ESTABLISHED IN LONDON' are descriptive of the origin of the goods and are markedly smaller in size and will have little impact in the overall impression conveyed by the mark.

The first earlier mark

33. The first earlier mark consists entirely of the words 'TAYLOR'S SELECT'. The 'SELECT' element of the registration carries much less weight in the impression created by the mark than the element 'TAYLOR'S' because, as I have anticipated above, the word 'SELECT' is laudatory. Further, the combination of 'TAYLOR'S SELECT' does not have an ordinary English meaning and does not form a meaningful unit, which means that the element 'TAYLOR'S' is likely to be viewed as a surname functioning as the primary mark, with 'SELECT' functioning as a sub-brand of goods which are specially chosen on account of their excellence.

The second earlier mark

34. The second earlier mark consists of the word 'TAYLOR'S' presented in a slightly stylised typeface below a coat of arms incorporating the year 1692, the number 4 placed above the letters 'XX', and the words 'TAYLOR FLADGATE'. Whilst the coat of arms contributes to the overall distinctiveness of the mark, the word 'TAYLOR'S' is

still the most distinctive element because (i) according to aforementioned principle than words speak louder than devices (which reflects settled case-law)³, where a trade mark is composed of word and figurative elements, the former are, in principle, more distinctive than the latter, and (ii) the word element 'TAYLOR'S' appears twice in the mark; it appears, first, in the lower part of the mark, and secondly, in the upper part of the mark, within the figurative element which represents the coat of arms.

35. As regards the coats of arms, it constitutes only a decorative element without any actual meaning – the only meaning which is likely to be perceived being that of representing the coat of arms of the 'TAYLOR' family established in 1692. Consequently, it does not dominate the image which the relevant public will have of the mark and does not constitute the dominant element in the overall impression created by that mark.

Visual similarity

The contested mark versus the first earlier mark

36. Visually, there is a strong similarity between the verbal element 'TAILOR'S' in the contested mark and the verbal element 'TAYLOR'S' in the first earlier mark. The only difference between these elements is in fact one letter, namely the third letter which is a 'l' in the contested mark and a 'Y' in the first earlier mark. I consider the words 'TAILOR'S' and 'TAYLOR'S' to be visually similar to a very high degree, because: (i) they coincide in six out of seven letter; (ii) they have a similar structure, being followed by the element 'S' which is indicative of a possessive form, (ii) the impact created by the different letters 'l' and 'Y' in the respective marks is reduced by the fact that they are placed in the middle of the marks and have a similar shape. However, the element 'SELECT' in the earlier mark and the presence of the other matter in the contested mark (including the figurative elements, the colour and the word 'ESTABLISHED IN LONDON') introduce a number of visual differences between the marks.

³ See for example *Cervecería Modelo v OHIM — Plataforma Continental (LA VICTORIA DE MEXICO)*, T-205/10, not published, EU:T:2012:36, paragraph 38

37. Taking into account that the words 'TAILOR'S' and 'TAYLOR'S' - which represent the most distinctive elements of the marks - are visually similar to a very high degree, and that the average consumer generally pays more attention to elements at the beginning of a mark, I consider these marks to be similar to a medium degree.

The contested mark versus the second earlier mark

38. Similar considerations apply here, although the coat of arms introduces a visual differences that is more impactful than that introduced by the word 'SELECT' in the first earlier mark. The marks are visually similar to a low to medium degree.

Aural similarity

The contested mark versus the first earlier mark

39. Consumers are likely to articulate only the 'TAILOR'S' element of the contested mark, given the descriptive nature of the remaining words 'ESTABLISHED IN LONDON' and their size which may be too small for consumers to read. The first earlier mark will be pronounced as 'TAYLOR'S SELECT' with the pronunciation of the word 'TAYLOR'S' being identical to that of the word 'TAILOR'S' in the contested mark. This results in what I consider to be a medium to high degree of aural similarity.

The contested mark versus the second earlier mark

40. As the device in the contested mark will not be articulated, nor the words and numerals contained within the coat of arms device, the marks are aurally identical.

Conceptual similarity

The contested mark versus the first earlier mark

41. The opponent did not comment on the conceptual similarity between the marks. I have already referred to the applicant's assertions concerning the semantic content conveyed by the marks. I agree with the applicant that the word 'TAYLOR'S' in the opponent's marks is likely to be perceived as a surname.

42. As regards the perception of the element 'TAILOR'S' in the contested mark, the dictionary definition of the word tailor is "*someone who makes clothes to fit individual customers*". However (a) the nature of the goods in relation to which the contested

mark seeks registration (all of which are spirits and have nothing to do with clothes), (b) the presence in the contested mark of the image of a waiter in the act of serving drinks, and (c) the use of the possessive form (i.e. the apostrophe followed by the letter 'S' which is used to say that something or someone belongs to a person) are all factors which create a dissonance with the dictionary meaning of the word 'TAILOR', making that meaning less readily perceptible. I note that in his counterstatement the applicant stated that the contested mark was adopted with London Savile Row in mind, however, there is nothing in the mark which creates an association with Savile Row and the average consumer will certainly not make that connection absent any supplemental clues which the mark does not contain.

43. Taking into account all of the above, I consider that the overall impression of the contested mark is likely to support the perception by the relevant public of the element 'TAILOR'S' as referring to someone called 'TAILOR', rather than as a reference to the dictionary definition of "tailor". On the basis that both marks are likely to be perceived as the possessive form of a similar name/surname but taking into account that 'TAILOR' is also a dictionary word, and that the word 'SELECT' introduces an additional concept in the earlier mark, I consider the mark to be conceptually similar to a medium degree.

The contested mark versus the second earlier mark

44. The same considerations apply here, although the additional concept in the earlier mark is introduced by the coat of arms. The marks are conceptually similar to a medium degree.

Distinctive character of earlier mark

45. 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).”

46. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

47. I agree with the applicant that the element ‘TAYLOR’S’ in the earlier marks is likely to be perceived as a surname. As such, it has no descriptive or allusive significance in the context of the opponent’s goods and enjoys a medium degree of distinctive character. The first earlier mark also contains the additional element ‘SELECT’, however being it a laudatory term, it does not materially increase the distinctiveness of the mark. Although the coat of arms in the second earlier mark elevates its distinctiveness to an above medium degree, this does not assist the opponent, because it is the distinctiveness of the shared element that matters.

48. Turning to the question of whether the distinctiveness of the earlier marks has been enhanced through the use made of them, the evidence shows that use of the mark ‘TAYLOR’S’ in relation to port wine by the opponent (or its predecessor in title)

is very long-standing, dating back to 1692. TAYLOR'S port wine is produced in Portugal, but it has been continuously sold in the UK since the 1800's to date. This claim is corroborated by evidence including a copy of a catalogue of a sale of bottled wines at auction in Liverpool dating from 1880 which lists a number of TAYLOR ports⁴ and a copy of an Annual Circular (a document for company's shareholders) dated from 1851 in London.⁵ The opponent's licensor exported between over [REDACTED] litres and over [REDACTED] litres a year of 'TAYLOR'S' branded port wines in the UK in the period between 2002 and 2020, generating an annual turnover of between over [REDACTED] and over [REDACTED] over the same period, for a total of over [REDACTED]. The opponent's customers are said to include main UK retailers such as The Co-Operative, Tesco's and Asda. The goods are said to be advertised on highly regarded national publications such as The Independent, The Daily Telegraph, Sunday Express, Evening Standard, Financial Times, The Observer Magazine and GQ Magazine, as well as Trade Publications such as The Drinks Business and Off Licence News. The evidence includes examples of promotional material and press clippings (the earliest of those which are enclosed being dated 1977) as well as sample invoices (with prices redacted) issued between 2013 and 2020. An article from 2016 also refers to the brand 'TAYLOR'S' holding a 21.8% share of the UK port wine market as shown below:

Andrew Hawes, managing director of Mentzendorff & Co, which represents The Fladgate Partnership, said:
"Port's 2% value growth was driven by its two strongest brands, with Taylor's leading the 12 week Christmas 2015 period with a 27% off-trade value share, with the nearest competitor at 20.2%. On an MAT basis Taylor's holds a 21.8% value share with Cockburn's at 22.2%.

"Taylor's Late Bottled Vintage is also the number two Port line by value on an MAT basis behind only Cockburn's Special Reserve.

"The rise of Aged Tawny is another notable trend. Once again Taylor's leads the market in this premium segment with Taylor's 10 Year Old Tawny enjoying growth of +14% by value on an MAT basis and +23% by value over the Christmas period."

49. In 2017 the brand 'TAYLOR'S' was also awarded a Royal Warrant of Appointment as a supplier of Port Wines to Her Majesty Queen Elizabeth II - this is granted as a

⁴ RM4

⁵ RM5

mark of recognition that the Warrant Holder is a regular supplier to Her Majesty or to her Household.⁶

50. I am satisfied that taken as a whole, the evidence filed by the opponent shows a level of use of the brand 'TAYLOR'S' that establishes enhanced distinctiveness in respect of port wine, elevating the distinctiveness of the element 'TAYLOR'S' in the earlier marks to a high degree.

Likelihood of confusion

51. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

52. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where Iain Purvis Q.C. as the Appointed Person explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later

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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).”

53. Earlier in this decision I found that:

- the contested goods are identical to the goods of the first earlier mark and similar to a low degree to the goods of the second earlier mark;
- the average consumer is a person over the age of 18. The goods will be selected visually with a medium degree of attention, although I do not discount aural consideration;
- the contested mark and the first earlier mark are visually similar to a medium degree, aurally similar to a medium to high degree and conceptually similar to a medium degree;

- the contested mark and the second earlier mark are visually similar to a low to medium degree, aurally identical and conceptually similar to a medium degree;
- the earlier marks are distinctive to a medium (the first earlier mark) and above medium degree (the second earlier mark) and the distinctiveness of the element 'TAYLOR'S' in the marks has been enhanced to high through use.

54. Taking all of the above into account, my conclusion is that there is a likelihood of indirect confusion between the marks. This is because, whilst the figurative elements of the contested mark are sufficient for the average consumer to avoid directly mistaking one mark for the other, they are not sufficient to prevent the average consumer from confusing the words 'TAILOR'S' and 'TAYLOR'S'.

55. In *PINKIES*, BL-O566/19, Geoffrey Hobbs QC (as he was), sitting as the Appointed Person, stated:

"29. The Court thus emphasised that there is no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences. It insisted upon the need for two distinct stages in the analysis of the overall likelihood of confusion, with the first being directed to 'a finding of the conceptual differences between the signs at issue' and the second being directed to 'assessment of the degree of conceptual differences' with a view to determining whether they 'may lead to the neutralisation of visual and phonetic similarities'.

[...]

More generally, the proposition that use of a meaningful word cannot conflict with the protection conferred by registration of an invented word only has to be stated in order to be rejected.

30. I have set out the Hearing Officer's assessment of 'conceptual meaning' in paragraph 18 above. This was the first of the two stages identified in *Wolf Oil*. As I have noted in paragraph 19 above, she envisaged that even by consumers to whom the mark *PINKIES* seemed to be alluding to the concept

of fingers rather than colour, it would not necessarily or immediately be taken to be referring to pinkie rings if it was not being used with reference to rings specifically. Conversely she did not find that the mark PINKIES would be taken to be referring to pinkie rings either by consumers to whom it seemed to be alluding to the concept of colour rather than fingers or when it was being used in relation to goods of the kind listed in the contested application for registration other than rings.

31. At the second of the two stages identified in *Wolf Oil*, the Hearing Officer had to grapple with the question whether the 'meaning of PINKIES' would serve to prevent the high degree of visual and aural similarity between the marks from giving rise to the existence of a likelihood of confusion across the full range of goods covered by the contested application for registration. Both as a consequence of there being no rule to the effect that visual and aural similarities are automatically neutralised by conceptual differences and as a consequence of there being no rule to the effect that use of a meaningful word cannot conflict with the protection conferred by registration of an invented word, a reasoned assessment was required as to why or how that would or would not be the case.

32. I have set out the Hearing Officer's overall assessment with regard to the likelihood of confusion in paragraph 12 above. On the basis that the 'conceptual differences' between the marks PIMKIE and PINKIES 'are too great to be missed by the average consumer paying at least a reasonable degree of attention', she decided that the 'meaning of PINKIES will counteract the visual and aural similarities between them'. However, I do not accept that her assessment to that effect went as far as it needed to go into the matters I have referred to in paragraph 31 above and I consider that the conclusion she arrived at was wrong for the reasons I will now explain.

33. It is firmly established (as noted in paragraph 17(h) of the Hearing Officer's decision) that in cases within the scope of s. 5(2)(b) of the Act there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use which has been made of it. That applies here. The trade mark PIMKIE is (and the Hearing Officer rightly affirmed that it

was) possessed of a high degree of inherent distinctiveness. Moreover, the marks PIMKIE and PINKIES are visually and aurally similar to a degree which would easily enable them to become tangled up with one another in the perceptions and recollections of consumers exposed to concurrent use of them for Class 14 goods of the kind listed in the earlier registration and the contested application for registration.

34. To envisage that there would nevertheless be no mingling of identities in the overall impression conveyed by the marks is to suppose that the visual and aural similarities between them would be subject to the neutralising effect of a contradistinction based on the absence of meaning in the case of PIMKIE and the presence of meaning in the case of PINKIES. However, an assessment of overall impression should (as noted in paragraphs 17(b) to (d) of the Hearing Officer's decision) proceed on the basis that consumers normally perceive a mark as a whole without engaging in analysis of its details and must, in situations where they do not have the opportunity to make direct comparisons, rely on the imperfect recollection of it which they have kept in mind. Those considerations apply here.

35. It can be expected in the context of the Hearing Officer's assessment of the purchasing process for the goods concerned (set out in paragraph 10 above) that the relevant consumers would do as consumers ordinarily do: take the marks PIMKIE and PINKIES as they find them, without pausing to analyse or compare them generally or with reference to the presence or absence of meaning in either case. I see no reason to expect them to think their way through the high degree of visual and aural similarity between the marks by a process of contradistinguishing between the former as a word which has no conceptual connotations of its own and the latter as a word linked to the concept of fingers or colour. That, in my view, is a thought process which involves examination by way of trade mark analysis and comparison of a kind they would not naturally undertake on exposure to marks with this degree of similarity. I consider that the Hearing Officer's observation to the effect that the 'conceptual differences' between PIMKIE and PINKIES are 'too great to be missed' is the product of just such an examination."

56. Similar considerations apply here. Although the word 'TAILOR' is a dictionary word, and the word 'TAYLOR' is a surname, the meaning of the word 'TAILOR' does not neutralise the similarity between the distinctive and dominant elements 'TAILOR'S' and 'TAYLOR'S' in the respective marks, and does not prevent the very high degree of visual similarity and the aural identity between these elements from giving rise to the existence of a likelihood of confusion. In this connection, one can easily envisage circumstances where the average consumer having misread 'TAILOR'S' for 'TAYLOR'S' will put the other (less distinctive) differences between the marks down to sub-branding or use of a variant mark by same undertaking. This is all of the more so, given the presence of the identical possessive form at the end of the words and the high distinctive character possessed by the brand 'TAYLOR'S'. The degree of visual similarity and the aural identity of the distinctive and dominant elements of the marks is in my view sufficient in the present case to give rise to the existence of a likelihood of confusion at least when identical goods are involved (as covered by the first earlier mark).

57. Finally, I want to deal with the documents filed by the applicant that were not admitted into the proceedings because they had not been filed in evidential format. First, the previous decisions to which the applicant refers are not binding upon me but, in any event, the factual analogy with those cases is not helpful, given that they relate to different marks.⁷ Secondly, the likelihood of confusion must be based on the marks as they are registered and applied for, and any additional matter extraneous to the marks and used by the parties on the product get-up is not something which I should take into consideration. Finally, state of the register evidence or evidence of records from Companies House showing registration of trade marks and companies names incorporating the word 'TAYLOR' is not relevant because it has no bearing on the assessment of the distinctive character of the earlier marks.⁸ So even if the documents filed by the applicant had been admitted, it would not have changed the outcome of the case.

⁷ *Abercrombie vs Abercromby* BL- O/151/01, *Gabrielle vs Gabrielle Chanel* BL-O/646/17, *Harry's Gordon Bar vs Hary's Bar*, BL- O/219/18, *Jenny Aves vs Jenny Aves*, BL-O/264/19, *Whyte and Mackay Limited v Origin Wine UK Limited and Dolce Co Investing* [2015] EWHC 1271 (Ch)High Court Ruling CH/2014/0462

⁸ *Zero Industry Srl v OHIM*, Case T-400/06

57. The opposition under Section 5(2)(b) succeeds accordingly.

OUTCOME

58. The opposition is successful, and the application will be refused registration.

COSTS

59. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the opponent the sum of £1,600 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

Preparing the notice of opposition	
And considering the applicant's counterstatement	£300
Preparing evidence:	£1,200
Official fees:	£100
Total	£1,600

60. I therefore order Evelyn Roberts Limited to pay International Drinks Limited the sum of £1,600. This 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 1st day of March 2023

Teresa Perks
For the Registrar

