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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91183753
Party	Plaintiff Heaven Hill Distilleries, Inc.
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

HEAVEN HILL DISTILLERIES, INC.,	)		
	)		
Opposer,	)	Opposition No.	91183753
	)		
v.	)		
	)	Serial No.	77/266,196
DIALLO YASSINN PATRICE,	)	Mark:	HYPNOTIZER
	)	Int'l Class:	033
Respondent.	)		

OPPOSER'S REPLY BRIEF

Heaven Hill Distilleries, Inc. ("Heaven Hill"), the Opposer, submits this Reply Brief in opposition to Application Serial Number 77/266,196 pursuant to 37 C.F.R. § 2.128.

INTRODUCTION

The sole issue in this case is whether the registration of the HYPNOTIZER mark for use in connection with a plethora of beverage alcohol products is likely to cause confusion with Heaven Hill's HPNOTIQ mark, which is registered for use with liqueur and other goods, and a number of Heaven Hill's unregistered marks that are related to its HPNOTIQ mark. In support of its position, Heaven Hill has provided substantial documentary and testimonial evidence establishing the strength of its HPNOTIQ mark and its related, unregistered marks; the similarity of the HYPNOTIZER mark to Heaven Hill's marks; and the likelihood of confusion that would result from the registration of Diallo's HYPNOTIZER mark. In contrast, Diallo Yassin Patrice ("Diallo"), the Respondent, has presented no evidence to the contrary and elected to not cross-examine Heaven Hill's witnesses during their trial depositions. Instead, Diallo relies on false representations to the Board regarding his rights to the HYPNOTIZER mark, meritless arguments that the testimony of Heaven Hill's witnesses should be excluded, documents that are not in evidence, and arguments that have no legal merit.

The Board should, therefore, sustain Heaven Hill's opposition and refuse registration to Diallo's HYPNOTIZER mark.

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REBUTTAL ARGUMENT

1. Diallo's Misrepresentations Regarding His Rights to the HYPNOTIZER Mark.

In his Main Brief, Diallo states to the Board that he "owns" the trademark HYPNOTIZER in France. This is simply not true with regard to beverage alcohol products, the goods at issue in this proceeding. This is evidenced by the May 10, 2006, decision of the Court of Appeal of Paris that is attached as Exhibit 28 to the deposition of Justin Ames. This decision conclusively establishes that the Director of the National Industrial Property Office rejected Diallo's application to register the HYPNOTIZER mark for use in connection with "beers; mineral waters; alcoholic beverages; wines; spirits" on November 25, 2005 and that Diallo's subsequent appeal of this decision was thereafter rejected by the Court of Appeal of Paris with respect to all goods except "mineral waters." Thus, Diallo's statements and representations in his brief that he has the right to use the HYPNOTIZER mark in France in connection with beverage alcohol products are completely and absolutely false and were intentionally and knowingly made to the Board to advance his position.

Diallo also states in his brief that the case in the United Kingdom remains pending. This too is untrue. In the decision of the U.K. Registrar dated September 4, 2009 and entered into evidence by Heaven Hill as Exhibit 29 to the deposition of Justin Ames, the Registrar clearly and unequivocally refused registration to Diallo's HYPNOTIZER mark based on Heaven Hill's prior registration and use of the HPNOTIQ mark in connection with liqueur. In addition, on March 30, 2010, well after the close of Heaven Hill's testimony period, Diallo's final appeal of the U.K. Registrar's decision was denied. A true and accurate copy of this

decision is attached to this reply brief as Exhibit A.[1] Thus, Diallo's statements and representations in his brief that was filed on August 30, 2010, that this matter remains pending are completely and absolutely false and were intentionally and knowingly made to the Board to advance his position.

Diallo's knowing and willful submission of his brief to the Board with these false statements clearly violates the rule set forth in 37 C.F.R. § 11.18(b). Accordingly, the Board should strike Diallo's brief in its entirety and terminate this proceeding in Heaven Hill's favor pursuant to 37 C.F.R. § 11.18(c).

2. The Testimony of Heaven Hill's Witnesses and the Exhibits Introduced Therein Are Properly of Record.

Diallo has made a number of filings in this matter asking the Board to strike the testimony of Norman Drew Wesley and Justin Ames because the trial depositions were allegedly not taken before a person before whom depositions can be taken in the United States. Diallo's contentions are simply wrong.

Under 37 C.F.R. § 2.123(d), a trial deposition "may be taken before persons designated by Rule 28 of the Federal Rules of Civil Procedure." Rule 28(a) provides that a deposition taken in the United States may be taken by "an officer authorized to administer oaths either by federal law or by the law in the place of examination"—Kentucky in this case. Finally, Kentucky Rule of Civil Procedure 28 provides that depositions within Kentucky may be taken before a notary public. Here, the testimony of each witness was taken before a notary public,

[1] Heaven Hill recognizes that attaching this decision as an exhibit to this brief will not result in the decision being entered into evidence in this proceeding. Heaven Hill is not, however, relying on this decision in support of its position that registration of Diallo's HYPNOTIZER mark is likely to cause confusion with Heaven Hill's HPNOTIQ mark. Rather, Heaven Hill is providing a copy of this decision to rebut Diallo's claim that the U.K. proceeding is still pending and to demonstrate that Diallo knew that this claim was false when he asserted it in his brief that was filed five (5) months after this final, non-appealable decision was issued.

Donna Chuppe, as shown by Chuppe's certificate that is appended to the transcript of each deposition.

Diallo further asserts that the testimony of the witnesses should be struck because Ames is an employee of Heaven Hill and Wesley is an employee of a company that provides services to Heaven Hill, facts that Heaven Hill disclosed via direct examination of the witnesses. Obviously the connection of Ames and Wesley to Heaven Hill is a factor that can be considered in deciding what weight to give their testimony, but Diallo has provided no authority for the complete exclusion of their testimony from evidence because no such authority exists. Diallo had, but declined, the opportunity to cross-examine each of these witnesses. Diallo also chose to forego putting on his own witnesses to introduce evidence to support his position or rebut the testimony of Heaven Hill's witnesses.

Diallo's arguments that the Board should simply disregard the witnesses' testimony and the evidence they authenticated are meritless. His objections to and requests to strike the testimony of Wesley and Ames should therefore be denied.

3. <u>Exhibits 1-5 and 8-13 to Diallo's Main Brief Are Not Properly in Evidence.</u>

During his designated testimony period, Diallo did not file a Notice of Reliance or offer any testimony. Accordingly, Exhibits 1-5 and 8-13 to Diallo's brief are not properly in evidence and should be struck and not considered by the Board. (Heaven Hill recognizes that the Board may consider Exhibits 6 and 7, but only because the information in these exhibits, the TESS information for the application being opposed in this proceeding and a registration certificate for Heaven Hill's HPNOTIQ mark, is independently of record in this proceeding.) To the extent the factual allegations in Diallo's brief are supported solely by reference to Exhibits 1-5 and 8-13, the Board should strike and not consider these portions of his brief.

To the extent the Board might choose to characterize Diallo's submission of Exhibits 1-5 and 8-11 with his prior "Final Brief on the Merits" that was filed during his testimony period as the submission of a Notice of Reliance, Heaven Hill objects and notes that, with the exception of Exhibit 1, the proffered exhibits are not properly admissible via a Notice of Reliance. Moreover, Exhibits 12 and 13 were not filed with Diallo's prior "Final Brief" during his testimony period and are not part of the application file for the application that is the subject of this proceeding. Thus, the Board must not consider Exhibits 1-5 and 8-13. 37 C.F.R. § 2.123(l).

4. Registration of Diallo's HYPNOTIZER Mark is Likely to Cause Confusion.

In its principal brief, Heaven Hill has provided the Board with an extensive review of the undisputed testimonial and documentary evidence it has presented in support of its case and an extensive analysis demonstrating that all of the relevant factors support Heaven Hill's position that registration of the HYPNOTIZER mark would result in a likelihood of confusion. It is not Heaven Hill's objective to repeat this analysis in this reply brief. Heaven Hill notes, however, that Diallo's brief is unorganized, repetitive, and written in ungrammatical English, making it difficult to provide an organized response without some reference to the same analysis offered in Heaven Hill's principal brief.

A. The Examining Attorney's Decision to Publish Diallo's Application Is Irrelevant.

At several points in his brief, Diallo argues that this issue has already been determined in his favor because the Examining Attorney stated in a communication concerning Diallo's prior, now-abandoned, application to register the HYPNOTIZER mark that "no similar registered or pending mark has been found that would bar registration" of the HYPNOTIZER mark. Giving Diallo the benefit of the doubt and recognizing that the Examining Attorney

doubtlessly reached this same conclusion in the application that is the subject of this proceeding, such a conclusion by the Examining Attorney is not dispositive of the issue before the Board in this proceeding and is, in fact, legally and factually irrelevant.

In deciding this matter, the Board must make its own, independent determination based on the evidence of record, most of which was not available to the Examining Attorney. Moreover, if the conclusion of the Examining Attorney for an application were dispositive, no opposition would ever be sustained since the Examining Attorney has presumably reached such a conclusion for any application that is published for opposition.

B. Diallo's HYPNOTIZER Mark Is Strikingly Similar to Heaven Hill's HPNOTIQ Mark in Terms of Its Meaning, Pronunciation, and Appearance.

Diallo makes a number of arguments at various points in his brief that minor differences between his HYPNOTIZER mark and Heaven Hill's HPNOTIQ mark would preclude confusion in the marketplace. Whether there are such minor differences between the parties' marks that may serve to distinguish the marks in a searching, side-by-side comparison is not, however, dispositive of whether registration of the junior mark would result in a likelihood of confusion. *Owens-Illinois Glass Co. v. Clevite Corp.*, 324 F.2d 1010, 139 U.S.P.Q. 505, 507 (C.C.P.A. 1963). Instead, the determination of whether registration would result in a likelihood of confusion must focus on the general impression of trademarks that a typical consumer retains. *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1660 (T.T.A.B. 2002).

Here, Heaven Hill has presented substantial, undisputed evidence that its efforts have created a lasting connotation in its HPNOTIQ mark that consumers associate with hypnosis and hypnotism. In fact, Heaven Hill's HPNOTIQ liqueur is the only beverage alcohol product in the marketplace that utilizes a mark that is related to or synonymous with hypnosis or hypnotism. And based on the strength of the HPNOTIQ mark and its strong connection with hypnosis and

hypnotism, the undisputed testimony of a marketing professional concludes that consumers encountering a beverage alcohol product with a theme related to hypnosis or hypnotism are likely to associate that product with HPNOTIQ liqueur. This conclusion is further supported by the undisputed testimony that consumers of beverage alcohol products are conditioned to expect new extensions of well-known brands, making consumers likely to mistakenly view a HYPNOTIZER product from Diallo as a new extension of Heaven Hill's HPNOTIQ product line.

Moreover, Heaven Hill has provided the Board with citations to a number of cases involving marks for beverage alcohol products that were, if anything, less similar than Diallo's HYPNOTIZER mark is to Heaven Hill's HPNOTIQ mark. *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377, 144 U.S.P.Q. 249 (8th Cir. 1965) (finding SARNOFF for vodka to be confusingly similar to SMIRNOFF also for vodka); *Brown-Forman Distillery Co. v. Arthur M. Bloch Liquor Importers, Inc.*, 99 F.2d 708, 39 U.S.P.Q. 304 (7th Cir. 1938) (finding OLD FOSTER for whiskey to be confusingly similar to OLD FORESTER also for whiskey); *Jules Berman & Assocs., Inc. v. Consol. Distilled Prods., Inc.*, 202 U.S.P.Q. 67 (T.T.A.B. 1979) (finding CHULA for coffee-flavored liqueur to be confusingly similar to KAHLUA also for coffee-flavored liqueur); *Beck & Co. v. Package Distribs. of America, Inc.*, 198 U.S.P.Q. 573 (T.T.A.B. 1978) (finding EX BIER for beer to be confusingly similar to BECK'S BEER also for beer). In each case, it was held that a likelihood of confusion existed.

Thus, as detailed in Heaven Hill's principal brief, any small differences in spelling between Heaven Hill's HPNOTIQ mark and Diallo's HYPNOTIZER mark are overwhelmed by the similarities of the marks in meaning, sound, and appearance.

C. Heaven Hill Is Entitled to Rely on Its Unregistered Marks in This Proceeding.

Diallo argues that Heaven Hill cannot rely on its unregistered marks to oppose his application because "they have no registration, no certificate." This, however, represents a fundamental misunderstanding of U.S. trademark law by Diallo. It is a fundamental premise of U.S. trademark law that protectable rights in a mark can arise through use. Here, Heaven Hill has provided extensive evidence of widespread, ongoing use of its unregistered marks that first established rights in those marks more than two (2) years before the filing date of Diallo's application on August 28, 2007.

Diallo further argues, without any supporting evidence, that Heaven Hill should not be entitled to assert these unregistered marks because Heaven Hill created them "to claim" his mark. This assertion is simply not true. In his deposition, Ames testified that Heaven Hill created the unregistered marks, such as HPNOTIZER, for use as the names of cocktails prepared with HPNOTIQ liqueur and that the marks were specifically intended to "incorporate the name of Hpnotiq into the drink so the consumer can quickly and easily associate the drink with the Hpnotiq mark."

Diallo makes much of the fact that Heaven Hill published its first recipe book with these drink names in May, 2005, a few months after he had originally applied to register HYPNOTIZER in France, but this proves nothing. There is no evidence that Heaven Hill adopted its unregistered marks with the bad faith intent to trade off Diallo's HYPNOTIZER mark. Moreover, as discussed above, due to Heaven Hill's rights in the HPNOTIQ mark, Diallo never had any right to use the HYPNOTIZER mark in connection with beverage alcohol products in France.

D. The Cases Cited by Heaven Hill Are on Point and Relevant to This Matter.

Diallo argues that "[a]ll the cases cited by Heaven Hill concern cases that have nothing to do with the present case and are notorious[2] brands," but this argument too is without merit. A review of the cases cited by Heaven Hill in its principal brief, in particular those cases finding a likelihood of confusion in the case of similarly named beverage alcohol products, reveals the holding in each of these cases were not based on a finding that the senior mark was a "famous" mark. Rather, as here, in each case the owner of the senior mark was able to demonstrate that its mark was well-known in the beverage alcohol product marketplace and that the similarities between its mark and the junior user's mark would lead to confusion in the marketplace. *See David Sherman,* 144 U.S.P.Q. 249; *Brown-Forman*, 39 U.S.P.Q. 304; *Jules Berman*, 202 U.S.P.Q. 67; *Beck & Co.*, 198 U.S.P.Q. 573.

CONCLUSION

Heaven Hill has presented ample evidence establishing that its registered HPNOTIQ mark is widely recognized in the beverage alcohol product marketplace; that consumers associate its HPNOTIQ mark with hypnosis and hypnotism; and that, consequently, registration of Diallo's HYPNOTIZER mark would create a likelihood of confusion in the marketplace. Diallo has presented no evidence to the contrary and he has cited no authority that would lead to a different conclusion of law. Accordingly, the Board should sustain Heaven Hill's opposition and refuse registration to Diallo's HYPNOTIZER mark.

[2] For purposes of this Reply Brief, Heaven Hill assumes by the use of the term "notorious" Diallo is attempting to argue that each of the cases involved "famous" marks, somehow making their rationale inapplicable to Heaven Hill's well-known HPNOTIQ mark.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the foregoing Opposer's Reply Brief has been served, via Federal Express, International Priority, this **16th** day of **September, 2010**:

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EXHIBIT A

TRADE MARKS ACT 1994

UK APPLICATION NO. 2462677 "HYPNOTIZER" IN THE NAME OF PATRICE YASSINN DIALLO

OPPOSITION THERETO BY HEAVEN HILL DISTILLERIES INC.

APPEAL TO THE APPOINTED PERSON

DECISION

Introduction

1. This is an appeal from the decision of the hearing officer Mr Landau on an opposition brought by Heaven Hill Distilleries ("Heaven Hill") against an application made by a French national Mr Yassinn Patrice Diallo ("M Diallo").

2. The application is for the word HYPNOTIZER in respect of *alcoholic beverages, wines, spirits.*

3. It was opposed under s5(2)(b) of the Trade Marks Act 1994 on the basis of two trade marks owned by Heaven Hill, numbers 2620466 and 2989085. The former registration is for the word HPNOTIQ. The latter is for a device of the shape of a bottle bearing the trade mark HPNOTIQ and an arrangement of some of the letters of the word HPNOTIQ. Both marks are registered for *liqueur.*

4. The trade mark application was also opposed by Heaven Hill on the basis of its alleged rights in passing off under s5(4)(a).

5. The opposition succeeded under s5(2)(b). The hearing officer did not address the s5(4)(a) grounds, and no respondent's notice was served so I can ignore them for the purpose of this appeal. I can also ignore the 2989085 registration, since it is obvious that Heaven Hill's strongest case is based on the word mark alone.

The evidence

6. The evidence in the case was not extensive. The hearing officer summarised it between paragraphs 8 and 19 of his decision. Neither party takes any issue with the accuracy of this summary.

7. The evidence showed that Heaven Hill had made some use of their trade mark HPNOTIQ in the United Kingdom. Some sales had been made through night clubs and cash and carry retailers. The precise extent of the sales and the promotion of the mark was not entirely clear on the evidence, but they were both at a fairly low level. The hearing officer was clearly right to decide that the trade mark HPNOTIQ was not known to a significant proportion of relevant consumers in the United Kingdom, and that Heaven Hill could not therefore rely on any "reputation" in the United Kingdom as increasing the likelihood of confusion between the marks.

The decision of the hearing officer

8. The hearing officer proceeded to consider the likelihood of confusion between the marks HYPNOTIZER and HPNOTIQ on the assumption of ordinary and fair use of those marks in relation to the goods within the respective specifications.

9. He concluded that the similarity between the words was at the "higher end of the scale". Furthermore, HPNOTIQ was a highly distinctive mark in relation to liqueurs. In the circumstances, he held that the public was likely to be confused not only if HYPNOTIZER was used as a brand of liqueur or spirits (identical or very similar goods) but also if it was used as a brand of wine (goods with a relatively low degree of similarity).

The appeal

10. M Diallo was not represented on the appeal. Furthermore, he chose not to appear before me, although he did submit written arguments. Heaven Hill was represented by Mr Potter of Harrison Goddard Foote.

Preliminary objection

11. At the hearing, Mr Potter took an objection to the Notice of Appeal, contending that it did not identify any error of principle in the decision of the hearing officer. Rather, he said, it simply alleged that the hearing officer was wrong to make a finding of likelihood of confusion, for pretty much the same reasons which had been argued at the original hearing. Therefore, he submitted, the Notice did not identify any ground upon which the Appointed Person could overturn the decision, in the light of the guidance of the Court of Appeal in Reef Trade Mark [2003] RPC 5. He invited me to dismiss the Appeal without further ado.

12. It seems to me that this is not an appropriate course to take for a number of reasons:

(a) The submission that a decision of a hearing officer on likelihood of confusion cannot be overturned without identifying an error of principle is a misreading of Reef. The actual words used by Robert Walker LJ in the well-known passage in paragraph 28 of his judgment in that case (dealing with the same situation to the present, where an appeal is made against the finding of a hearing officer on likelihood of confusion based on written testimony only) were as follows:

"In such circumstances an appellate court should in my view show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle."

A "real reluctance" is different from an absolute bar. Although it is obviously a lot easier to succeed on an appeal where an error of principle can be shown, there is no reason why a party should not be permitted to argue an appeal to the Appointed Person on the simple basis that the hearing officer's view on likelihood of confusion was wrong in all the circumstances. If the Appointed Person, having applied the necessary degree of caution, is satisfied that the hearing officer was clearly wrong to make the finding he did, then the appeal will succeed. There is thus nothing wrong *per se* in a Notice of Appeal which does not identify any error of principle in the decision appealed from.

(b) If an application is to be made to dismiss a Notice of Appeal, then it should be made well in advance of the hearing itself. Even where there are good grounds for such an application, it would be normal to permit the appellant an opportunity to correct the Notice, which cannot practically be achieved during the hearing itself. It is obviously unsatisfactory to attempt to resolve pleading issues at the substantive hearing of an appeal. This is particularly the case where the appellant is (i) not legally represented; (ii) not present; and (iii) lives abroad.

(c) I do not take the view that the Notice of Appeal in this case is defective. It adequately (bearing in mind that English is not M Diallo's mother tongue) identifies the issues. It may be criticised as being over-long and discursive, but it is not particularly difficult to identify the primary points which M Diallo wishes to make about the hearing officer's decision.

Litigants without representation

13. As I have noted, M Diallo was not legally represented and did not appear in person before me, although I had the benefit of his written submissions. The hearing therefore took the form simply of oral submissions from Mr Potter, with interventions from myself.

14. In the course of argument, Mr Potter submitted on a number of occasions that it was not for the Appointed Person in those circumstances to take points on

behalf of the Appellant which the Appellant may not have properly identified himself. He described this as "doing the job for the Appellant", which he submitted was not part of the role of the appellate tribunal.

15. Because of these submissions, I will set out below the principles which I think should be applied by Appointed Persons in these circumstances, and which I have endeavoured to apply in the present case.

16. In hearing an Appeal where one party is not legally represented, I believe the following policies (which may sometimes pull in different directions) should be borne in mind:

    (a) The Trade Mark Registry and its associated tribunals, including the Appointed Person, should be accessible to everyone who needs to use their services. Although the consumers of these services are almost inevitably traders of one kind or another, they are not necessarily substantial or wealthy businesses. They include persons or companies who cannot afford the services of trade mark attorneys, solicitors or barristers. Although it is reasonable to expect someone choosing to act in person before the Trade Mark Registry to have acquired a basic knowledge of the principles which will be applied to decide their dispute, it is not reasonable to expect them to have a detailed or completely up-to-date knowledge of all the legal authorities (including ECJ judgments) which may be relevant. Some degree of assistance from the tribunal in terms of explaining the relevant law and procedure which applies to the dispute is likely to be necessary to ensure that the litigant in person is not disadvantaged to such a degree that justice cannot properly be done. Although the CPR does not apply to these proceedings, it is notable that the "overriding objective" of "dealing with cases justly" is said by Part 1.1(2)(a) to be served firstly by "ensuring that the parties are on an equal footing."

    (b) The rights and legitimate expectations of other litigants ought not to be diminished or prejudiced by the fact that there is a litigant in person on

the other side. These include the right to know the case which is being put against them and a proper opportunity to deal with it.

(c) The tribunal itself must endeavour so far as possible not to act (to adopt the terminology used by Geoffrey Hobbs QC in CITIBOND O/197/06) "protagonistically towards either side in the dispute". Although the ultimate aim of proceedings before the Appointed Person (and indeed the hearing officer) is, like any legal process, to reach a just result, the process is an adversarial one. The Appointed Person (and the hearing officer) is a neutral arbiter in that process.

17. In the usual case, where the litigant in person is present at the hearing, the tribunal will explore with him or her in the course of argument the precise ambit of the submissions being made, and may take the opportunity to explain elements of the relevant law on the issue. A new point or even a new ground of appeal may be identified in the course of such discussion which the litigant had not previously relied on, and the litigant may then decide for himself whether to seek to pursue it. This is entirely legitimate and the fact that the point was only identified in the course of discussion with the tribunal is not a problem in itself, provided that the opponent is properly protected against being taken by surprise (potentially by an adjournment).

18. If the litigant in person is not present at the hearing, this approach is not open. In those circumstances the only way a new point would be able to be taken on behalf of the litigant in person would be if the tribunal took the decision to argue the point itself. To my mind this goes beyond what a neutral arbiter in adversarial proceedings can properly do. Not only is there a danger of the tribunal appearing to lack neutrality, there is the further danger in some circumstances that it may take points "on behalf of" a party which the party himself might (for collateral reasons of its own) have preferred not to take. However, this does not mean that the tribunal must take a narrow or literal view of the submissions which have been made. On the contrary, I believe that one should err on the generous side when construing written submissions which have been advanced by litigants in person (provided always that the

other side are protected against any prejudice as a result of having reasonably construed the submissions more narrowly).

19. In writing this decision, therefore, I have taken into account only those points and grounds of appeal which I consider have been identified by Mr Diallo on a fair (and generous) reading of his written submissions and Notice of Appeal.

The substance of this appeal

20. M Diallo attacks the decision on a number of grounds.

21. First he says that the hearing officer was wrong to find that the marks were similar and that the similarity was "at the higher end of the scale". He points out that the marks are quite different in length, have a different number of syllables, and make a different visual impression.

22. M Diallo makes three particular complaints about the approach taken by the hearing officer to the comparison of the marks. First he points to what he considers to be an inconsistency (or "incoherence" to use his word) in the analysis of the hearing officer. In paragraph 29 of his decision, the hearing officer stated that neither trade mark could be divided into distinctive and dominant components and they stand or fall in their entireties. However, in paragraph 30, he notionally divides up the trade marks by considering whether their beginnings are more "important" than their endings (he finds that they are), and refers to the visually striking nature of certain parts of the earlier mark HPNOTIQ. I can understand why these paragraphs appear to M Diallo to be contradictory, and the passage in paragraph 29 is in my view not very well expressed. Clearly, any comparison of marks has to look at the marks as a whole, not simply individual components of the marks. Equally clearly, such a comparison must take into account the "distinctive and dominant components" of the marks (following the guidance of the ECJ in Sabel v Puma). Overall, however, I do not consider that the hearing officer misdirected himself here. He clearly considered the similarity of the marks taking account of the

distinctive elements of the marks, for example the absence of the Y in HPNOTIQ.

23. M Diallo makes another related point. The hearing officer found in paragraph 30 that the beginning of the marks is more important than their endings. He also found that the absence of the Y at the beginning of HPNOTIQ is "visually quite striking". Obviously the word HYPNOTIZER does not have this "striking" element in the most important part of the mark. M Diallo suggests that in those circumstances, the finding of similarity was another "incoherence". I think that there is no basis to criticise the decision on this ground. In paragraph 30 the hearing officer was, very fairly, identifying the various points of distinction and similarity between the marks, and giving them a "weighting" according to their significance.

24. The third point made by Mr Diallo concerns the pronunciation of the word HPNOTIQ. He criticises the hearing officer for his "arbitrary" conclusion that the public would pronounce the word "HPNOTIQ" as if it were written "HYPNOTIC". I do not consider this to be a fair criticism either. It seems to me that the hearing officer was perfectly entitled to reach this conclusion in the absence of evidence.

25. Overall, I consider that the finding by the hearing officer that the similarity between the marks was "at the higher end of the scale" was a perfectly reasonable conclusion.

26. M Diallo's second ground of appeal is that the hearing officer was wrong to find that there was identity and/or similarity between the goods for which the trade mark was applied for and the goods for which the earlier mark was registered.

27. The earlier mark is registered for "liqueurs". The hearing officer considered that there was identity between these goods and the general category of "alcoholic beverages" for which the mark was applied for. Given that "alcoholic beverages" includes "liqueurs", this conclusion was plainly correct

as a matter of law and supported by the authorities which the hearing officer cites including Metric v OHIM [T-133/05 at paragraph 29]. It would appear from his submissions that M Diallo has misunderstood the law in this area, believing that the fact that liqueurs were not specifically mentioned in his application meant that they were not covered.

28. So far as the other goods for which the mark was applied for are concerned, "spirits" are to my mind either identical or extremely similar to "liqueurs". Similarity between "wines" and "liqueurs" on the other hand is plainly at the low end of the scale, being limited to the fact that they are both alcoholic drinks. The hearing officer came to the same view, so I consider that he was right.

29. Finally, M Diallo challenges the hearing officer's conclusion that there is a likelihood of confusion between the two trade marks. It seems to me that this was not a clear-cut case. I might personally have reached a different conclusion from the hearing officer in relation to those goods with only a low degree of similarity. However, I consider that his decision was well within the set of reasonable conclusions open to him with which an appellate tribunal exercising "real reluctance" ought not to interfere. Since no error of principle in his approach has been identified, I therefore uphold the decision.

Conclusion and costs

30. The Appeal is dismissed. Heaven Hill is entitled to £750 costs of the appeal.

IAIN PURVIS QC

THE APPOINTED PERSON

30 March 2010

IN THE MATTER OF THE TRADE MARKS ACT 1994

AND IN THE MATTER OF UK APPLICATION NO. 2462677 "HYPNOTIZER" IN THE NAME OF PATRICE YASSINN DIALLO

AND IN THE MATTER OF THE OPPOSITION THERETO BY HEAVEN HILL DISTILLERIES INC.

APPEAL TO THE APPOINTED PERSON

The Appointed Person having on 5 February 2010 heard the appeal of the above named Applicant from the decision of Mr David Landau dated 4 September 2009 acting for the Registrar of Trade Marks

DOTH HEREBY ORDER THAT:

(1) The Appeal be dismissed

(2) The Applicant Patrice Yassinn Diallo do pay the sum of £750 costs to Heaven Hill Distilleries Inc.

IAIN PURVIS QC

THE APPOINTED PERSON

30 March 2010