

**BL O/0251/26**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF UK REGISTRATION NO. 3145202**

**IN THE NAME OF ACEO LIMITED**

**IN RESPECT OF THE FOLLOWING TRADE MARK**

**Bothy Whisky**

**IN CLASS 33**

**AND**

**AN APPLICATION FOR REVOCATION THEREOF**

**UNDER NUMBER 507763**

**BY BOTHY TRADING LIMITED**

## **Background and pleadings**

1. The UK trade mark (“UKTM”) shown on the front page of this decision (UKTM no: UK3145202) (“the contested mark”) stands registered in the name of Aceo Limited (“the registered proprietor”). It was filed on 19 January 2016 and completed its registration process on 15 April 2016. The mark stands registered for the following goods:

Class 33      Alcoholic beverages (except beer); spirits and liqueurs; Scotch Whisky but in so far as whisky and whisky based based liquers are concerned only Scotch whisky and Scotch whisky based liquers produced in Scotland.

2. On 3 September 2024, Bothy Trading Limited (“the cancellation applicant”) applied to revoke the contested mark in accordance with sections 46(1)(a) and 46(1)(b) of the Trade Marks Act 1994 (“the Act”). Revocation is sought in respect of the specification in its entirety. The periods in respect of which non-use is claimed are 16 April 2016 to 15 April 2021, with an effective date of revocation of **16 April 2021** under section 46(1)(a) (“the first relevant period”), and 2 January 2017 to 1 January 2022, with an effective date of revocation of **2 January 2022** (“the second relevant period”), 2 January 2018 to 1 January 2023, with an effective date of revocation of **2 January 2023** (“the third relevant period”), and 2 January 2019 to 1 January 2024, with an effective date of revocation of **2 January 2024** (“the fourth relevant period”) under section 46(1)(b).

3. The registered proprietor filed a defence and counterstatement in which it denies the claims against it in their entirety. The registered proprietor states that it has made genuine use of the contested mark, for the goods covered by the registration, within the relevant periods.

4. The registered proprietor is represented by Potter Clarkson LLP and the cancellation applicant is represented by Scintilla Intellectual Property Ltd. Both parties filed evidence in these proceedings. No hearing was requested, however both parties filed written submissions in lieu of a hearing.

## **Evidence and Submissions**

5. The registered proprietor filed evidence in chief in the form of a witness statement of Edward Odum, dated 3 February 2025, accompanied by exhibits EO1 – EO9. Mr Odum is the managing director of Aceo Limited.

6. The cancellation applicant filed evidence consisting of the witness statement of Kirsten Coetzee, dated 24 April 2025, accompanied by exhibit KC1. Ms Coetzee is a Trade Mark Attorney acting on behalf of the cancellation applicant.

7. The cancellation applicant filed written submissions dated 24 April 2025.

8. The registered proprietor's evidence in reply was filed in the form of a further witness statement of Edward Odum, dated 9 July 2025, accompanied by exhibits EO10 – EO37.

9. Both parties also filed written submissions in lieu of a hearing dated 18 August 2025 respectively.

10. I have given due consideration to all of the documents filed by both parties but will only refer to the evidence/submissions as appropriate to the extent that is necessary in my decision.

## **Preliminary Issues**

11. In its written submissions of 24 April 2025, the cancellation applicant raised concerns as to the veracity of the internal emails provided by the registered proprietor, as follows:

“It is submitted that it is peculiar and unusual for an internal email to contain the information as shown in the email of 12 April 2020 forming part of Exhibit EO2, discussing an interest in the Contested Mark in internal correspondence. This casts doubt on the accuracy and reliability of this email. It is submitted that the accuracy and reliability of this email is of such a nature that it should not be considered in these proceedings.”

Any challenge to the veracity of the evidence should have been dealt with during the evidence rounds, in order to allow the registered proprietor the opportunity to reply<sup>1</sup>. I note that the cancellation applicant had previously been warned by the Registry in correspondence dated 12 May 2025, that if they reserved specific criticisms of the other party's evidence until final written submissions, and the hearing officer considered that this would cause unfairness to the registered proprietor, their submissions may be given reduced or no weight. I am entitled to take the evidence before me at face value, and I have no reason to doubt the authenticity of the internal emails provided by the registered proprietor. I shall therefore assess these in the usual way and will say no more about this.

12. The registered proprietor has submitted that it has made genuine commercial use of the contested mark in relation to the relevant goods within all of the relevant five year periods but has gone on to plead proper reasons for non-use within its written submissions. I note the cancellation applicant's submission that the registered proprietor did not set out proper reasons for non-use within their TM8, and that this contradicts its earlier submission that it had made uninterrupted use of the contested mark during all of the relevant periods. The cancellation applicant submits that these reasons for non-use should not be considered or accepted. In the alternative, it is submitted that the reasons put forward are insufficient to establish proper reasons for non-use. I will deal with these submissions later in my decision when I come to assess the evidence.

### **Decision**

13. Section 46 of the Act states:

“46. - (1) The registration of a trade mark may be revoked on any of the following grounds-

(a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the

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<sup>1</sup> *TUI UK Ltd v Griffiths* [2023] UKSC 48

goods or services for which it is registered, and there are no proper reasons for non-use;

(b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;

(c) [...]

(d) [...]

(2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) [...]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from-

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date.”

14. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

15. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK’s withdrawal from the EU.

### **General principles**

16. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 *P Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-

9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C-720/18 and C-721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle*

at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].

17. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL O/404/13, Mr Geoffrey Hobbs QC (as he then was), sitting as the Appointed Person stated that:

“22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

18. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me, and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the contested mark.

## **EVIDENCE OF USE**

### The Registered proprietor’s Evidence

19. I note the following from the first witness statement of Mr Odim:

- a. Mr Odim states that Aceo Limited (“Aceo”) is a “well-established company in the Scotch whisky industry supplying bottled whisky, bulk whisky (cask whisky) and related whisky services”<sup>2</sup>.
- b. 50% of Aceo's business is its bottled spirits sales. Aceo has its own branded bottled whisky products. Its leading brand is Murray McDavid Scotch whiskies. Aceo also sells brands of whisky and other spirits through its Aceo Spirits division. These include Bothy Scotch whisky

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<sup>2</sup> First witness statement of Mr Odim para 2

which is one of their Aceo Spirits products. Aceo, also sells through its Aceo Spirits division, its own brands of spirit that include Iguana Rum, Emerald Isle Irish Whiskey, Metropolitan Gin and Rodchenko Vodka. These products are sold around the world<sup>3</sup>.

- c. Aceo's Design Team first designed and developed a whisky product using the trademark Bothy whisky in 2018<sup>4</sup>. Aceo registered 'Bothy Whisky' as a trademark because, at the time, it was working with the Mountain Bothies Association ("MBA") on producing a bottle of whisky for the association using the trademark. Mr Odim states that there was a charitable element to this arrangement as each bottle sold would result in a contribution to the MBA for the upkeep of their bothies. Mr Odim confirms that Aceo were keen to help the MBA by producing a bottle of whisky that their members could buy, and it could sell commercially through their customer network, with some of the proceeds of sale going to the MBA. Mr Odim accepts that progress on this project was very slow, and that this was also impacted by the Covid-19 pandemic. Mr Odim states by way of example that Aceo entered a similar arrangement with the 'Glenlee' Tallship charity which also took "a long time to get going", but the 'Glenlee' whisky that Aceo produces for them has now had sales of around 160,000 worldwide.
- d. Aceo acquired a piece of land in the Highlands<sup>5</sup> which had on it the remains of an old stone bothy, the image and existence of which the registered proprietor uses in connection with their Bothy Whisky trademark<sup>6</sup>, known as 'The Old Bothy' at Balliemore, Glenrinnes. This was purchased with a view to holding regular Bothy whisky events around a bonfire beside the stone ruin. I note from email correspondence that this was in the process of being purchased (although the purchase does not appear to have completed) in April 2020<sup>7</sup>.

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<sup>3</sup> First witness statement of Mr Odim para 8

<sup>4</sup> Exhibit EO1

<sup>5</sup> First witness statement of Mr Odim, para 12

<sup>6</sup> Exhibit EO2 and EO3

<sup>7</sup> Exhibit EO2

- e. Since 'The Old Bothy' has been purchased, events at the property have commenced and are called 'drams under the stars'. Mr Odim has provided copies of two leaflets advertising these events<sup>8</sup> and I note that the dates were once per month throughout July, August and September 2023. A further leaflet has been provided for an event in November 2023. I note that these leaflets do not feature the contested mark and refer to the "Murray McDavid team" as being the event hosts. Mr Odim states that Murray McDavid is Aceo's leading brand<sup>9</sup>. Photographs of the events have also been provided which feature the Bothy Whisky mark on bottles of whisky which are on display. These photographs are undated.
- f. Mr Odim states that he worked on designing a Bothy Whisky product over several years and produced a final 'Bothy Whisky' design<sup>10</sup> which was in turn used on the product which went on sale, at both the evening events and in shops and online. This label features the Bothy mark and is dated 27 September 2022.
- g. A copy of the HMRC Spirit Drinks Verification ("SDV") has been provided by Mr Odim which shows The Bothy is registered for Scotch Whisky. I note that this is undated<sup>11</sup>.
- h. Mr Odim confirms that the most current version of the product was designed and developed in 2022. The initial Bothy whisky bottling operation began in April 2023. An initial 168 bottles were produced and 96 of them sold in and around the Spirit of Speyside Festival ("SSWF") of that year. More bottles were sold at the SSWF in 2024. There are plans to increase the stock of this in line with demand for the product<sup>12</sup>.
- i. Mr Odim states that the spirit that goes into this product is an 8 year old Auchroisk single malt whisky that has been finished in sherry casks. In

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<sup>8</sup> Exhibit EO4

<sup>9</sup> First witness statement of Mr Odim, para 8

<sup>10</sup> Exhibit EO5

<sup>11</sup> Exhibit EO6

<sup>12</sup> First witness statement of Mr Odim, para 20

order to fulfil the future demand for this product, the registered proprietor has laid down casks of Auchroisk single malt whisky in their maturation warehouse that will be ready for bottling under the Bothy brand when they reach 8 years old. Mr Odim confirms that long-term planning is essential when building a single malt whisky brand<sup>13</sup>.

### The Cancellation Applicant's Evidence

20. I note the following from the witness evidence of Ms Coetzee:

- a. The only information contained within this statement is an exhibit<sup>14</sup> featuring a screen shot of a source code from the registered proprietor's website <https://aceospirits.co.uk/product/bothy-single-malt-scotch-whisky/> relating to the relevant goods and contested mark, showing the first published date of the web page as being 11 September 2024.

### Evidence in reply

21. I note the following from the witness evidence of Mr Odim:

- a. Mr Odim states that commercial use was made of the trade mark during the relevant periods, and has provided screenshots of emails, both internal and external of discussions regarding the mark and brand<sup>15</sup>.
- b. Mr Odim states that plans had been made to continue to make commercial use of the mark in early 2020. However, the pandemic directly interrupted the company and business for three years, with the periods of lockdown causing an office closure and fundamental re-organisation of the business i.e. re-location and redundancies. Mr Odim

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<sup>13</sup> Second witness statement of Mr Odim, para 20

<sup>14</sup> Exhibit KC1

<sup>15</sup> Exhibits EO13-EO16

states that this constitutes proper reasons for non-use, being extreme complications which were out of their control<sup>16</sup>.

- c. Mr Odim provides emails which confirm that the purchase details of 'The Old Bothy' were initially sent to the registered proprietor on 10 January 2020<sup>17</sup>.
- d. Mr Odim states that the purchase of 'The Old Bothy' is relevant to proceedings as it is evidence of the commercial use of the mark because:

"it shows the investment and commercial activity openly going on in the development of our Bothy Whisky product bearing the Bothy Whisky trade mark. We bought the Bothy as part of the wider strategy to build a brand and brand story. The Bothy site is where customers come to enjoy whisky experiences and our Bothy Whisky, which in turn, will help it to gain popularity amongst the wider public. Our paying visitors post and blog about the product, sharing images of it on social media etc"<sup>18</sup>.

- e. Evidence of the gatherings referred to above, shows that 'drams under the stars' events were held between April 2022 and May 2024. I note that the number of tickets sold ranged from 29 to 179 tickets per event. The total raised from these events was £19,906<sup>19</sup>, although only £11,870 falls within the relevant periods, and I do not consider that all of this can be attributed to the sale of Bothy Whisky due to evidence before me that the product was not produced until April 2023 (discussed below).
- f. Sales information pertaining to Bothy Whisky has also been provided. Sales range from 27 April 2023 to 16 June 2025. A total of 69 sales was

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<sup>16</sup> Second witness statement of Mr Odim, para 4

<sup>17</sup> Exhibit EO16

<sup>18</sup> Second witness statement of Mr Odim, para 14

<sup>19</sup> Exhibit EO20

made during this time at a value of £1,586.79<sup>20</sup>. However, I note that only £525 of these sales fall within the relevant periods.

g. Mr Odim explains that:

“It’s recommended retail price is £25 (£1.25 per cl.) If the spirit was in a 70cl bottle, it would work out at £87.50 per bottle. (Bottles of our Bothy Whisky are currently being sold with a 21% ‘market introduction’ discount, i.e. £19.80 per bottle.) This, with or without the discount, makes our 20cl Bothy Whisky product expensive compared to the average bottle of young single malt.

The average price of a bottle of 8-year-old single malt in specialist whisky shops is around £36\*, our which means, very roughly, that the whisky in a standard 70cl bottle costs a consumer around 51p per cl of spirit, whereas the spirit in our 20cl Bothy Whisky product costs around £1.25 per cl of spirit (approx. £1 with the 20% reduction). It is quite clear that the margin (profit) we make on our 20cl Bothy Whisky product is considerably better than the margin/profit on our standard 70cl bottled products. (\*Aceo sells its products in specialist whisky and spirit shops – not in supermarkets. However, if you take into account the average supermarket price of around £30 for a single malt in a 70cl bottle<sup>21</sup>, the price per cl of spirit is even lower at £43p).”<sup>22</sup>

h. Mr Odim makes the following statements regarding the impact of the Covid-19 pandemic upon Bothy Whisky:

i. The first ‘drams under the stars’ events were planned to take place in early 2020 but had to be cancelled due to the Covid-19 pandemic. These were due to be rearranged later in the year;

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<sup>20</sup> Exhibit EO21

<sup>21</sup> Exhibit EO25

<sup>22</sup> Second witness statement of Mr Odim, para 23

however, these were unable to go ahead due to the pandemic being ongoing.

- ii. A number of staff were furloughed which impacted the sales of Bothy Whisky
- iii. At the start of 2022 the company hoped to get the Bothy Whisky brand on track post-pandemic and planned to run a 'Drams under the Stars event' at SSWF festival, but due to post-pandemic uncertainties, and staffing issues, this again had to be postponed<sup>23</sup>.
- iv. The Covid-19 pandemic had a significant impact on the company, both financially and practically. Mr Odim states that pre-pandemic Aceo Limited reported the following profits:
  - a. 2017 - £1.1 million
  - b. 2018 - £2.6 million
  - c. 2019 - £1.1 million

However, due to the pandemic, profits dropped dramatically in 2020 and 2021, to £482000 and -£50,000 respectively<sup>24</sup>.

- v. Mr Odim states that the Covid-19 pandemic resulted in the closure of the company's Gloucestershire office which was relocated to Edinburgh. As a result of this, a number of staff who were working on Bothy Whisky were made redundant, which Mr Odim accepts "was a massive disruption to the business, [and] meant that progress on our Bothy Whisky events and sales in 2022 was slow"<sup>25</sup>. Bothy Whisky events and sales were being held in early 2023.

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<sup>23</sup> Second witness statement of Mr Odim, para 27

<sup>24</sup> Exhibit EO27

<sup>25</sup> Second witness statement of Mr Odim, para 29

- vi. Mr Odim states that the 2022 SSWF was poorly attended, with the festival generating 35% less income than pre-Covid<sup>26</sup>. Mr Odim states that in the end it approached the festival tentatively and it was poorly attended. He goes on to say:

“Although we promoted our Bothy Whisky to visitors who attended our events, including Drams under the Stars, we focused on selling the backlog of unsold stock that had built up during the two years of effective lockdown. That said, the Bothy Whisky Drams under the Stars events were well received, and as an event was shortlisted for the Best New Event of the festival.”<sup>27</sup>

This statement appears to be at odds with the information provided in paragraph 27 of Mr Odim’s statement, in which he states that the registered proprietor postponed their events and opportunities in 2022 due to the pandemic.

- i. Mr Odim states that the registered proprietor has invested considerable time, money and resources into the Bothy Whisky brand, which would be further advanced, but for the pandemic. However, since early 2023 they are now hosting Drams under the Stars events and the product is on sale in their three retail shops “the Old Bank Whisky Shop in Forres, Moray (Speyside), at Dallas Dhu Distillery and our shop in our brand property Dallas Dhu House”<sup>28</sup>.
- j. As well as the purchase of The Old Bothy, Mr Odim states that the following commercial activities have been undertaken:

“• Paid staff to work on our Bothy Whisky product from 2016 onwards.

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<sup>26</sup> Second witness statement of Mr Odim, para 31

<sup>27</sup> Second witness statement of Mr Odim, para 32

<sup>28</sup> Second witness statement of Mr Odim, para 36

- Worked with the MBA on marketing the product to a wide audience.
- Selected and matured the spirit for our Bothy Whisky product.
- Designed and produced the Bothy Whisky product.
- Bottled the Bothy Whisky product.
- Sold the Bothy Whisky product.”<sup>29</sup>

k. Mr Odim’s statement is accompanied by an operation warrant which shows that the Bothy Whisky product was produced in April 2023<sup>30</sup>. Total deliveries are shown as 121.49.

l. Regarding Scotch whisky as a product, Mr Odim explains:

“The top 10 big Scotch whisky companies have 90% of the single malt market (bottled 70cl products.) The 50 or more companies in the Scotch whisky industry, that includes Aceo, compete for the remaining 10% of the single malt market around the world. This picture in Scotland and the UK, where we targeted our Bothy Whisky product is even more acute and there are many small whisky companies putting out small volumes of products to win small shares of a very small market. However, although small, a successful product in this sub-category of the markets, can prove very profitable”<sup>31</sup>.

m. Mr Odim has provided a print out from the Scotch Whisky association which shows that in 2024, Aceo produced a volume of 8.871 of Malt Scotch<sup>32</sup>. An email from Graeme Littlejohn of the Scotch Whisky Association dated 9 July 2025 also confirms as follows:

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<sup>29</sup> Second witness statement of Mr Odim, para 38

<sup>30</sup> Exhibit EO32

<sup>31</sup> Second witness statement of Mr Odim, para 51 and Exhibit EO37

<sup>32</sup> Exhibit EO37

Market share of Single Malt over last 6 years (% of total Scotch Whisky export volume)					
2019	2020	2021	2022	2023	2024
10.56%	11.25%	10.02%	10.77%	11.53%	9.08%

The attached file gives a full breakdown by country of category share. It does not include the UK – where ironically good data is hard to come by – but our expectation is that the UK is along global trends – ie Single Malt is 10% by volume and 30% by value.

I understand the above information to relate to Aceo Limited's Scotch Whisky sales as a whole, and not specifically to Bothy Whisky.

### Form of the mark in use

22. Before I move on to assess the sufficiency of the evidence, I shall begin by addressing the way in which the contested mark has been displayed in relation to the relevant goods in evidence.

23. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union found that:

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot

be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)." (emphasis added)

24. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

"13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU\*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does

not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still.”

25. The contested mark is a word only mark presented in a mixture of upper and lower case. Given that normal and fair use of the registration will cover use in any standard typeface or font, where the mark is used in capitals or title case, this is use of the mark as registered and is use upon which the registered proprietor may rely. The mark is also shown as follows throughout the evidence:



26. The above variation is a figurative mark in which the word BOTHY is prominently displayed at the top of the mark in a large stylised white font. The mark depicts a nighttime landscape under a star-filled sky. In the centre foreground is a small stone bothy which is illuminated by a fire. Behind the bothy is the silhouette of hills and trees. Underneath the word BOTHY there is the phrase 'Single Malt Scotch Whisky' which appears in the same font as BOTHY, albeit that the text is smaller. At the bottom of the mark in a hand-written style font is the phrase 'drams under the stars'. The mark also contains additional text which reads "200ml e" at the bottom left and "46% alc/vol" on the bottom right of the mark.

27. As the image in the figurative mark is of a bothy, I consider that this reinforces the name of the product. The word 'dram' is a Scottish word that is widely understood as referring to a small measurement of whisky. Therefore, the phrase 'drams under the stars' is descriptive of the product and the mark above as a whole. Whilst I note that the mark 'Bothy Whisky' does not appear in full, above, I find 'whisky' to be non-distinctive as it is the name of the goods, and therefore I find that this omission does not alter the distinctive character of the mark as a whole<sup>33</sup>. I consider that the word, BOTHY, remains the dominant element of the figurative mark, and that this figurative form is therefore an acceptable variation of the mark and is use upon which the registered proprietor can rely.

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<sup>33</sup> As per paragraph 15 of *Lactalis*, above

## Genuine Use

### Assessment of Evidence

28. With regard to the evidence of use submitted, I must now consider if it sufficiently demonstrates genuine use, whilst reminding myself that use does not have to be quantitatively significant to be genuine. The burden is on the registered proprietor to prove that it has used its mark within the relevant periods. Therefore, it was the registered proprietor's responsibility to provide proof that the mark was used within the UK during the relevant periods.

29. Whether the evidence is sufficient for this purpose will depend on whether it demonstrates that there has been real commercial exploitation of the mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods for which use has been shown;
- The nature of those goods and the market(s) for them; and
- The geographical extent of the use shown.

30. I have carefully considered the evidence provided by the registered proprietor and whether this meets the requirements for genuine use as per *easyGroup*, set out earlier in this decision. I am also mindful of the guidance from the *Dosenbach-Ochsner* (as cited above) and *Awareness Limited v Plymouth City Council*<sup>34</sup>, in which Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if

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<sup>34</sup> Case BL O/236/13

it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

31. With the above in mind I find there are various shortcomings in the evidence. The registered proprietor has put forward limited evidence in respect of turnover figures resulting from its use of the mark. I have no invoices; however, I do have a sales summary<sup>35</sup>. I am unclear as to whether this represents the entirety of the sales of Bothy Whisky. The total sales in this document amount to £1,586.79 gross, however, only a

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<sup>35</sup> Exhibit EO21

small proportion of these sales fall within the relevant periods. I note that the registered proprietor has provided turnover figures which range from £2.6 million to a loss of £50,000, however, these figures are for Aceo as a whole and are not specific to Bothy Whisky, and as such I am unable to take these into account.

32. In total, exhibit EO21 shows that the bottles sold amount to 69, which I do not consider to be significant. I note that the registered proprietor has claimed that 168 bottles have been produced, however, I have no evidence of additional sales. Mr Odim states that the Bothy Whisky product is sold in three of their retail outlets and online through the websites of its stockists. I have no evidence before me regarding online sales, or that the product is sold in other retail outlets, or how much revenue is generated from sales at these outlets (or whether these sales are included within the figures above).

33. The registered proprietor has provided information pertaining to market share. However, a printout from the Scotch Whisky association shows that in 2024, Aceo produced a volume of 8.871 (000 70cl bottles) of Malt Scotch<sup>36</sup>. I note that this figure relates to Aceo's production of Malt Scotch as a whole and is not specific to Bothy Whisky. Therefore, I do not have any evidence before me pertaining to the market share of Bothy Whisky.

34. The registered proprietor submits that the Bothy Whisky product was ready to be sold in 2020, however, within the first witness statement of Mr Odim it is stated that the first bottling of the product was in 2023, which contradicts the earlier statement. This appears to be supported by the operation warrant showing that Bothy Whisky was produced in April 2023<sup>37</sup>. I have no other evidence before me to show that the product was in production prior to this time. Mr Odim also states that since early 2023 the product has been sold at the 'drams under the stars' events and in three of the registered proprietor's retail shops, which also appears to support the contention that the product was not sold prior to 2023.

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<sup>36</sup> Exhibit EO37

<sup>37</sup> Exhibit EO32

35. The registered proprietor has submitted that 'The Old Bothy' was purchased in 2020 as the venue for their regular Bothy Whisky 'drams under the stars' events, and that the events that were held at this venue were part of the registered proprietor's marketing strategy. I bear in mind that, as per *Ansul BV v Ajax Brandbeveiliging BV*<sup>38</sup>, where preparations are underway to secure customers, this may be sufficient to establish genuine use. I understand that these events were planned for 2020 but were unable to go ahead as scheduled due to the Covid-19 pandemic and various subsequent lockdowns. These events eventually commenced in 2022 (although as per para 34, the evidence suggests that the first bottling of Bothy Whisky did not take place until 2023, so it is unlikely that Bothy Whisky would have been sold at these events, even if they had gone ahead as planned). I have been provided with various documents in relation to The Old Bothy and the events that have been advertised/held there. Within its witness evidence the registered proprietor states that Aceo's "leading brand is Murray McDavid". In respect of the 'drams under the stars' events, I note that the contested mark does not appear on any of the leaflets advertising the event, and the photographs show that staff attending the event are wearing tops which bear the words "Murray McDavid". The flyer also references the "Murray McDavid team". Despite the statement made by Mr Odim that these are "Bothy Whisky events", none of the other evidence before me indicates that this is the case. Whilst I accept that Bothy Whisky is available for tasting / purchase at these events, I do not consider that this in itself is sufficient to show that the events are targeted solely at this product. I note that the 'drams under the stars' events were also held/due to be held at the SSWF which also takes place in Scotland, however, I have nothing before me to indicate that the marketing of this event would differ to that of the above, i.e. it would not be targeted at Bothy Whisky. I have also found the evidence in regard to attendance at these SSWF events to be unclear at best.

36. I have no other information before me to show how the mark is to be marketed. Even taking the information that I have been provided regarding the 'drams under the stars' events, the mere existence of leaflets in isolation are of little evidentiary value without any supporting information such as an indication as to how many people viewed this information, over what period or the location of those people. I have

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<sup>38</sup> [2003] ECR I-2439

already found that the relevant consumer would not have been exposed to the mark by viewing this material, as the leaflets do not bear the mark, however, none of these additional details have been provided. As I have no other information in respect of how the mark was to be marketed, if the intention was only to market this via selling the product at the 'drams under the stars' events and SSWF, and given that these events only take place in Scotland, I consider the marketing reach to be extremely limited.

37. Either insufficient, or no evidence, has been produced to demonstrate the extent of use of the mark. The sales revenue is extremely low and I have no information regarding the turnover generated specifically by the mark. The evidence before me in regard to promotional activity undertaken is also limited and the vast majority of this does not show the mark in use. I find that the product was first produced in 2023, and I only have evidence that 68 bottles have been sold. I find this level of use to be insufficient to create or maintain a market under the mark. Consequently, I do not find that it constitutes a serious attempt by the registered proprietor to create or maintain a market under the trade mark during any of the relevant periods. It follows that, subject to the registered proprietor's case that there were proper reasons for non-use, the trade mark should be revoked in its entirety for non-use.

### **Proper reasons for non-use**

38. As noted earlier in my decision, the registered proprietor's case is based upon the Covid-19 pandemic and the direct impact that this has had upon its ability to use the mark. It did not plead this within its TM8(N) but has relied upon this within its written submissions and evidence. According to Mr Odim, the Covid-19 pandemic impacted the registered proprietor's business from the first lockdown (March 2020) for the reasons set out in paragraph 21(h). Mr Odim links this impact with the various lockdowns resulting in cancelled/poor attendance at events. Mr Odim also references staff being furloughed which impacted the sales of the product, and he also blames the Covid-19 pandemic for necessitating the closure of the company's Gloucestershire office, which was subsequently relocated to Edinburgh, meaning that staff who were working on the mark in Gloucestershire were made redundant.

39. In *Armin Häupl v Lidl Stiftung & Co.* KG,<sup>41</sup> the CJEU held that:

“... Art.12(1) of the Directive must be interpreted as meaning that obstacles having a direct relationship with a trade mark which make its use impossible or unreasonable and which are independent of the will of the proprietor of that mark constitute “proper reasons for non-use” of the mark.”

40. Insofar as the effects of the Covid-19 pandemic, I find that there is no merit in the registered proprietor’s argument. Whilst the hospitality industry did experience difficulties during the periods of lockdown in 2020 and 2021 and travel was restricted during this time, this accounted for about four and a half months of both years. The lockdown themselves were in Spring to early Summer 2020 and December 2020 to mid May 2021. This only accounts for 9 months of the relevant 5-year period, whereas the mark at issue has been registered since April 2016. Whilst the Covid-19 pandemic could have been an event that was an obstacle preventing the registered proprietor and its affiliates from being able to conduct its business, no evidence has been provided as to the actual impact it had. There is no evidence for example of the number of bookings that had to be cancelled or postponed, no evidence of emails from customers raising concerns and no evidence as to the number of staff that had to be furloughed. The registered proprietor has also stated:

“The unused Gloucestershire office was costing the company about £70,000 per annum and the company was in trouble and needed to do something to get trading profitably again. A decision was taken to close our Gloucestershire Head Office and end the Lease of the building, with a view to relocating the Head Office to near Edinburgh in the Central Belt.

29. The decision to relocate the company’s Head Office to Scotland (a decision that was in the long-term interest of the company)”<sup>39</sup>

The registered proprietor has acknowledged that this move was in the long-term interest of the company, which can be understood by the fact that The Old Bothy and all of the company’s events appear to be held in Scotland. I therefore do not consider

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<sup>39</sup> Second witness statement of Mr Odim, paras 28 and 29

that this move and the subsequent redundancies can be said to be solely as the result of the Covid-19 pandemic, as it appears that this would have taken place in any event.

41. There is no evidence at all of any significant use during 2016 to 2019/2020 when the pandemic began for a comparison as to any impact made. Further the evidence does not show that the mark was put to any significant use in the UK in the period between the Covid-19 restrictions being finally lifted in May 2021 and the end of the relevant period being January 2024. I consider that the use that has been made of the mark has been trivial<sup>40</sup>. For these reasons, I do not accept that the evidence establishes that had it not been for the Covid-19 pandemic, the registered proprietor would have made genuine use of the mark during the relevant periods in relation to the goods it relies upon.

## **Conclusion**

42. The application for revocation on grounds of non-use against the registered proprietor's registration No. UK3145202 has been successful. As a result, the contested registration is hereby revoked, with effect from **16 April 2021**, for all of the goods in its specification.

## **Costs**

43. The cancellation applicant has been successful and is entitled to a contribution towards its costs. In the circumstances, I award the cancellation applicant the sum of £1,550 as a contribution towards the cost of the proceedings, in accordance with Tribunal Practice Notice 1/2023.

The sum is calculated as follows:

Official fee:	£200
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Preparing and filing the TM26(N) and considering the counterstatement:	£350
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<sup>40</sup> *Memory Opticians Ltd's Application*, BL O/528/15

Considering the other side's evidence  
and preparing and filing evidence: £1,000

Total: £1,550

44. I therefore order Aceo Limited to pay the sum of £1,550 to Bothy Trading Limited. The above sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 24<sup>th</sup> day of March 2026**

**LA Bailey**

**For the Registrar,**

**The Comptroller-General**