

BL O/0789/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO 3674255  
BY  
SPRINGFIELD PROPERTIES (SCOTLAND) LIMITED.

TO REGISTER THE TRADE MARK

# Inverfiddich

IN CLASS 33

AND

THE OPPOSITION THERETO UNDER NO 428882  
BY  
WILLIAM GRANT & SONS LIMITED

## BACKGROUND AND PLEADINGS

1. On 28 July 2021, Springfield Properties (Scotland) Limited ("the applicant") applied to register the above trade mark in class 33, for the following goods:<sup>1</sup>

Alcoholic beverages, except beers, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs complying with the specifications of the PGI Scotch whisky.

2. The application was published on 10 September 2021, following which William Grant & Sons Limited ("the opponent") filed a notice of opposition against all of the goods in the application.

3. The opponent bases its case on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act").

4. The marks relied on by the opponent for the claims under sections 5(2)(b) and 5(3) are as follows:

Mark details:	Goods relied on:
<p>UKTM: 809941</p> <p><b>GLENFIDDICH</b></p> <p>Filed: 26 August 1960</p> <p>Registered: 26 August 1960</p>	<p><b>Class 33</b></p> <p>Scotch whisky</p>
<p>UKTM: 809941</p> <p><b>GLENFIDDICH</b></p> <p>Filed: 1 April 1996</p>	<p><b>Class 33</b></p> <p>Alcoholic beverages, but in so far as whisky and whisky based liqueurs are concerned,</p>

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<sup>1</sup> International Classification of Goods and Services for the Purposes of the Registration of Marks under the Nice Agreement (15 June 1957, as revised and amended).

<b>Registered:</b> 29 October 1998	only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.
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### **Section 5(2)(b)**

5. Under this ground the opponent claims that the application is highly visually, aurally and conceptually similar to the earlier mark and that it seeks protection for goods which are identical to those covered by the opponent's earlier registrations.

6. Further, it claims an extensive reputation throughout the UK and internationally and submits that, as a consequence, the earlier marks have an enhanced level of distinctive character. Accordingly, there is a likelihood of confusion, including a likelihood of association between the opponent's earlier registrations and the application.

### **Section 5(3)**

7. Under this ground the opponent claims that the application and the earlier marks are highly similar. Further, it claims that the opponent's earlier marks have been in use since May 1904 when the Glenfiddich distillery was founded by the opponent in Dufftown and it concludes that the earlier Glenfiddich marks have acquired a substantial reputation in the United Kingdom and internationally in relation to whisky.

8. Due to the high degree of similarity between the application and the earlier marks, and the extent of the significant reputation of the earlier marks in relation to whisky, as well as the direct overlap between the relevant consumers of the applicant's goods and the reputed goods, a mental link will be made by the relevant public.

9. Accordingly, use of the applied for mark, being without due cause, would take unfair advantage of the earlier marks by free-riding on their distinctiveness and reputation.

10. It submits:

*“16...The Applicant will gain an advantage from the substantial reputation of the Earlier Mark because the Mark will gain attention and marketability for the Applicant's Goods by riding on the coat-tails of the Earlier Mark and benefiting from the Opponent's marketing efforts. Furthermore, the strong reputation of the Earlier Mark will be transposed to the Mark, meaning that the offering for sale of the Applicant's Goods will become easier for the Applicant. The advantage resulting from the use of a similar trade mark must be considered to be an advantage unfairly gained of the distinctive character and the huge repute of the Earlier Mark.*

*17. Use of the Mark will cause detriment to the reputation of the Earlier Mark if the goods are of inferior quality, given that the relevant public is likely to make a mental link between the Mark and the Earlier Mark. This inferior quality is likely to have a negative impact on the image, prestige and huge reputation of the Opponent's Earlier Mark and its power of attraction will therefore be reduced.*

*18. Use of the Mark will cause detriment to the distinctive character of the Earlier Mark because it will dilute its distinctiveness. The ability of the Earlier Mark to uniquely identify the Reputed Goods would be weakened since use of a highly similar mark by a third party would lead to the dispersion of the captivation and the hold in the public mind of the reputed Earlier Mark.*

*19. The Earlier Mark, which at one-time aroused immediate association in the eyes of the relevant public, would no longer be capable of doing so. If the Mark brings to mind the Earlier Mark in the eyes of the relevant public, the use of it will diminish the ability of the Earlier Mark to distinguish its Reputed Goods. This is likely to lead to a change in the economic behaviour of the Opponent's customers.”*

#### **Section 5(4)(a)**

11. Under this ground the opponent relies on the use of GLENFIDDICH throughout the UK, for whisky, since at least May 1904.

12. It claims that use of the applicant's highly similar mark for the applied for goods, which are identical to the opponent's goods, is likely to mislead the public into believing that the applicant's goods are the opponent's goods, that the applicant is authorised or connected to the opponent, or that the opponent has endorsed the applicant's goods.

13. It concludes that this misrepresentation will inevitably cause damage to the Opponent, including the opponent's aforementioned goodwill and reputation in the earlier signs.

14. The applicant filed a counterstatement in which it denied all the grounds of opposition.

15. Both sides filed evidence and a skeleton argument. A hearing took place before me at which the opponent was represented by Tom Alkin, instructed by Taylor Wessing LLP and the applicant was represented by Usman Tariq, instructed by CMS Cameron McKenna Nabarro Olswang LLP.

16. I make this decision having taken full account of all the papers before me and the submissions made at the hearing.

17. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

## **DECISION**

18. In its skeleton argument the opponent leads with its opposition under the 5(3) ground, "[g]iven the strength of the reputation of the GLENFIDDICH brand".<sup>2</sup> I will take the same approach. Section 5(3) of the Act states:

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<sup>2</sup> See paragraph 24 of the opponent's skeleton argument.

“A trade mark which-

is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark”.

19. The relevant case law can be found in the following judgments of the Court of Justice of the European Union (CJEU): Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Adidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows:

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24*.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors, paragraph 26*.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman, paragraph 29* and *Intel, paragraph 63*.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark’s reputation and distinctiveness; *Intel, paragraph 42*.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph*

68; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact on the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation; *Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure*.

20. In *General Motors*,<sup>3</sup> the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

22. The conditions of section 5(3) are cumulative. First, the application must be similar to the earlier marks. Secondly, the opponent must satisfy me that its earlier marks have achieved a level of knowledge/reputation amongst a significant part of the public. Secondly, it must establish that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the earlier mark(s) being brought to mind by the later mark. Thirdly, assuming that the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

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<sup>3</sup> Case C-375/97

## **The opponent's evidence of reputation**

23. In its counterstatement dated 17 February 2022, the applicant accepted that the opponent has used its earlier GLENFIDDICH marks in the UK for single malt scotch whisky and that the opponent has a reputation and goodwill for single malt scotch whisky in the UK.

24. The opponent's evidence is provided by two witness statements by Claudia Falcone, the global brand director for Glenfiddich (within the opponent company). Her first statement is dated 25 April 2022 and has 48 exhibits attached to it. Ms Falcone's second statement is dated 3 October 2022 and has 28 exhibits attached to it.

25. Despite the acceptance by the applicant of the opponent's reputation, it is necessary for me to assess the extent and nature of that reputation. I take the following from Ms Falcone's evidence:

### Company background

26. The opponent is an independent, family-owned Scottish business which was established in 1886 by William Grant. The business established the Glenfiddich distillery in Dufftown in Scotland in the glen of the river Fiddich. One year later, the first Glenfiddich whisky was gathered from stills on Christmas Day 1887. The business was incorporated in 1903 and was owned by members of the Grant family. The business began blending whiskies and selling its own single malt whiskies, under the Glenfiddich name in that year.

27. By 1914, the opponent exported its goods to 30 countries worldwide. In the 1950s the opponent invested in copper stills and dedicated cooperage for Glenfiddich. Ms Falcone comments that the Glenfiddich onsite cooperage is one of very few which remain in distilleries today.

28. By 1960, the opponent was trading in 143 countries and sales amounted to 500,000 cases per year. That figure was in excess of 1 million cases by 1973, 2 million cases by 1988 and 3.5 million cases by 1995.

29. In 1963, Glenfiddich was the first single malt scotch whisky to be marketed beyond Scotland. A visitors' centre was established in the 1970s and is 'still thriving'.

30. The centenary of Glenfiddich was in 1987, since which time the opponent has, 'sold numerous rare and distinguished whiskies under the Glenfiddich brand.' Some of these have given rise to high prices being paid at auction.<sup>4</sup>

### Sales and revenue

31. The opponent's global sales of Glenfiddich amount to more than 7.5 million cases of whisky with a value of more than £3.5 billion in the period between 2015 and 2020.

32. In the UK, in 2021, the opponent sold 79,100 cases of Glenfiddich which amounted to £42.5 million in sales value. Ms Falcone submits that figures have been consistently high throughout the last few years, 'and would not have been significantly different at the filing date'.<sup>5</sup> This submission has not been challenged and I have no reason to doubt its accuracy.

33. In global terms, the opponent's Glenfiddich brand had a 10.9% – 12.1% market share of the global total malt scotch market in the period 2015 – 2020.<sup>6</sup>

34. With regard to its position in the UK, Ms Falcone states:

*"30. By way of illustration only, as of early 2022, Glenfiddich is the No.1 malt whisky in the UK with 14.3% value share of premium+ malt whisky in the total on and off-trade sector. This is according to the data taken from the external sources MAT Nielsen up to 26 February 2022 and CGA up to 29 January 2022, both of which are publicly available (but behind a paywall). This figure is a moving annual total covering the period of January 2021 to February 2022 and would not have been significantly different at the filing Date."<sup>7</sup>*

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<sup>4</sup> See paragraph 19 of Ms Falcone's first witness statement.

<sup>5</sup> See paragraph 28 of Ms Falcone's first witness statement.

<sup>6</sup> See exhibit CF-06.

<sup>7</sup> See exhibit CF-06.

31. According to our external research conducted by a data, market research and advisory company, Savanta, Glenfiddich has 83% awareness amongst UK spirits drinkers as of early 2022. These are moving annual totals covering the period of January 2021 to February 2022. Further, the same research shows that 16% of UK spirit drinkers have tried Glenfiddich in the past 12 months. Both values place Glenfiddich as the top whisky in relation to its competitors. These figures would also not be significantly different at the Filing Date.”

### Advertising and promotion

35. Ms Falcone provides global advertising and marketing figures for 2019-2021, with the caveat that advertising spend fell during the coronavirus pandemic. The figures are as follows:<sup>8</sup>

	<b>2019</b>	<b>2020</b>	<b>2021 – estimate</b>
Customer discount	£38.5m	£32.6m	£44.3m
Advertising	£43.5m	£29.6m	£51.0m
Promotion	£27.3m	£25.2m	£30.6m
Commercial marketing investment	£2.3m	£3.0m	£3.0m
Global marketing investments	£5.3m	£3.1m	£3.7m

36. In November 2021, the opponent launched a Glenfiddich whisky in collaboration with menswear lifestyle brand Mr Porter. Whilst the launch of a limited run of 1500 bottles occurred after the relevant date, preparations would have occurred before that date and press surrounding the launch refers to Glenfiddich’s reputation. The following is taken from the Mr Porter lifestyle journal:<sup>9</sup>

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<sup>9</sup> See exhibit x, ‘The New Glenfiddich Presented By Mr Porter’, 3 November 2021.



*“Earlier this year, MR PORTER decided to do something completely different: we decided to collaborate with Glenfiddich, the world's most awarded single malt Scotch, and create a whisky. Now, you might wonder why on earth we'd do that. We're the men's style destination, after all, not the men's whisky destination. But style, if you ask us, isn't just about the clothes we wear. It's a quality that comes through in everything we do - and a handsomely stocked bar, like a smartly appointed wardrobe, deserves a spot in any man's home.”*

37. Ms Falcone draws my attention to wider promotional activities carried out by the opponent, including the Glenfiddich artists in residence programme, which takes place at the Speyside distillery annually. It is described as, “...one of the world's most sought-after residencies”.<sup>10</sup> In 2020, the London Economic described the award as *the largest of its kind for an emerging artist in Scotland.*<sup>11</sup>

38. Articles are provided concerning Struan Grant Ralph, who was appointed Global Brand Ambassador for Glenfiddich in 2016.<sup>12</sup> In 2019, an article in Business Review included the following:<sup>13</sup>

*“Do you think you have competition on the market?”*

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<sup>10</sup> See exhibit CF13, ‘Artists arrive for 2019 Glenfiddich Residency’, Scottish Field, 11 June 2019.

<sup>11</sup> See exhibit CF13, ‘Artist wins residency award for Brexit-inspired doomsday bunkers’, The London Economic, 15 February 2020.

<sup>12</sup> See exhibit CF14, ‘Struan Grant Ralph is the newly appointed global brand ambassador for Glenfiddich whisky’, Wine and Spirit Education Trust, 15 July 2016.

<sup>13</sup> See exhibit CF14, Business Review interview with Struan Grant Ralph, 13 December 2019.

*It's interesting because Glenfiddich is a market leader and therefore the only competition may be ourselves. I think that we as market leaders have a responsibility to drive the single malt industry, so things like this evening when we will be talking about education, mentorship and advocacy, the fact that over this weekend I will do seminars for over 200 people training them about whisky - those are the kind of actions we should take. This is the responsibility we have: training people and telling them more stories..."*

39. A further article in 'Whisky Auctioneer' also includes an interview with Mr Ralph and described Glenfiddich as "the world's best-selling single malt whisky".<sup>14</sup>

40. The whisky auctioneer website and blog is concerned with auctioning whisky, so the focus of the article is the rare and collectable Glenfiddich whiskies which include, the 1991 release of 50-year-old Glenfiddich<sup>15</sup> and Glenfiddich 1937 Rare Collection.

41. In her witness statement, Ms Falcone refers to an auction of rare Glenfiddich whiskies which took place after the relevant date, but concerns whiskies created by Glenfiddich in the 1950s:<sup>16</sup>

*"36. To further illustrate the world renown status of the Glenfiddich brand, in December 2021, The Distiller's One of One Auction was launched in Edinburgh, the first of a biennial series of auctions of ultra-rare whiskies and experiences to its luxury private clients. In partnership with Sotheby's, Worshipful Company of Distillers, and Burgess Studios, these charitable auctions aim to raise money for youth charities in Scotland, while also increasing brand awareness. The key whiskies sold were the Ladyburn, The Balvenie and Glenfiddich whiskies aged over 50 years. At auction, the Glenfiddich 1950s collection sold for a whopping £1,293,750, the highest price gained for any lot of the entire event and a new auction record for Glenfiddich. This clearly shows the incredible popularity of the Glenfiddich whisky and its status on the worldwide whisky market."*

## Awards

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<sup>14</sup> See exhibit CF14, Whisky Auctioneer, 17 April 2020.

<sup>15</sup> Only 500 bottles ever released. The casks were from the 1930s and were named after the founders' nine children.

<sup>16</sup> See exhibit CF09.

42. Glenfiddich has been awarded 265 medals by the International Spirits Challenge (ISC) up until February 2022.<sup>17</sup> Drinks International, described by Ms Falcone as ‘a leading industry body’, run the International Spirits Challenge (ISC). The ISC receives 1500 entries from 70 countries annually. Ms Falcone describes the awards as, “*an international standard for quality and excellence in the industry.*”

43. The International Wine and Spirit Competition (IWSC) have awarded Glenfiddich 234 awards between 2000 and 2021.<sup>18</sup> The IWSC accepts entries from more than 90 countries annually. The spirits are judged by a panel of more than 400 global experts. Ms Falcone states, these awards are considered particularly high honours in the alcoholic beverages industry.<sup>19</sup>

### Social media

44. Glenfiddich’s Facebook page shows that it was created on 29 September 2015. At the time of printing the page had more than 1.3 million liking and following it.<sup>20</sup> A Facebook post, dated 25 January 2019 appears as follows:



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<sup>17</sup> See exhibit CF10.

<sup>18</sup> See exhibit CF11.

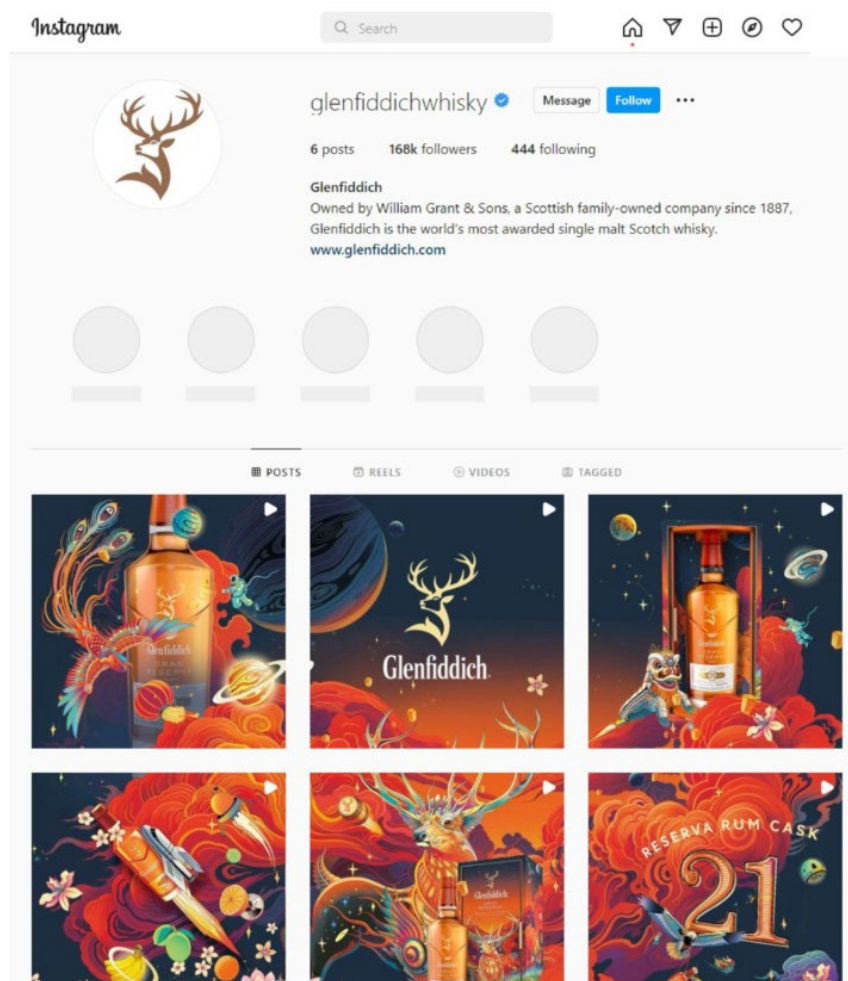
<sup>19</sup> See paragraph 38 of Ms Falcone’s first witness statement.

<sup>20</sup> See exhibit CF24.

45. The post elicited 160 comments, including one from a customer who describes Glenfiddich IPA as superb.

46. A post from 3 October 2018 refers to a festival event described as, "...two days of incredible music, food, comedy, dancing and whisky in our hometown of Dufftown". The post has been shared 99 times and has 181 comments.

47. Glenfiddich's Instagram page appears as follows:<sup>21</sup>



48. The Glenfiddich Whisky Twitter page shows that the opponent joined Twitter in September 2010.<sup>22</sup> At the date of printing the opponent had 32.6 thousand followers. The image at the top of the page appears as follows:

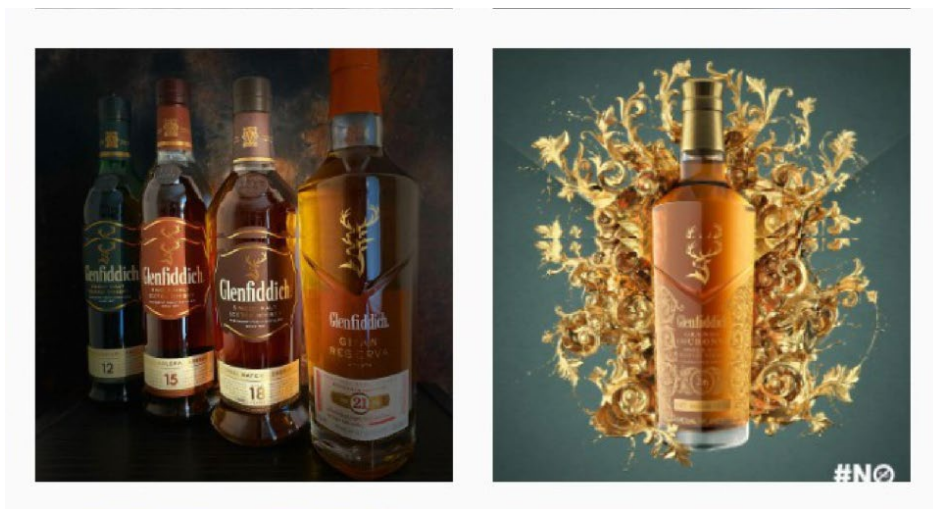
<sup>21</sup> See exhibit CF25.

<sup>22</sup> See exhibit CF26.



49. I note though that images on Twitter accounts and other social media pages can be changed throughout the lifetime of the page or account, meaning that the image present at the print date may not be the same as that used throughout the life of the social media account in question.

50. Ms Falcone also includes images which are photographs appearing on the opponent's Glenfiddich Instagram pages.<sup>23</sup> The images are undated, but include the Glenfiddich bottle in the following forms:



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<sup>23</sup> See exhibit CF27.



51. In addition to the evidence relating to scotch whisky, Ms Falcone also provides details of a range of mixed and bottled cocktails which were made available in the UK in June 2021. The launch of the 'Batch and Bottle' cocktails was featured in, inter alia, Vogue, The Sunday Times and the London Evening Standard.



"The Manhattan is an iconic cocktail. As recognisable the world over as the city that gave it its name, Glenfiddich has reached a similarly iconic status around the world and yet like the Manhattan can be created with only three simple ingredients. For this Glenfiddich Manhattan drink I wanted to showcase the simplicity of the serve itself (whisky, vermouth, bitters) and how these combine to create something greater and more delicious than the sum of their parts.

For this we have selected Glenfiddich (of course!) along with our own sweet vermouth and Granny Gordon's Bitters, a bespoke bitters recipe, created by a matriarch of our founder's family, available nowhere else but here in your Batch and Bottle Manhattan. This is a beautifully aromatic, robust Manhattan recipe with the depth and complexity of the malt playing well with the herbal notes of the bitters, while the warmth and sweetness of vermouth brings it all together with a subtle elegant finish. Worthy of any occasion - enjoy!"

Struan Grant Ralph, Glenfiddich Global Brand Ambassador

52. The green bottle in the 'Batch & Bottle' range is a Manhattan made with Glenfiddich. The Glenfiddich name is displayed on the label in the typeface usually used on Glenfiddich bottles. The description of the product is provided next to the bottle, above.<sup>24</sup>

53. The applicant has accepted the opponent has a reputation for single malt scotch whisky under its Glenfiddich trade mark. The opponent has very significant global turnover, with the UK being a very important part of its market. It spends tens of millions of pounds per year promoting the Glenfiddich brand and it is regularly referred to as 'the world's best-selling whisky', in third party coverage and interviews with Glenfiddich's brand ambassador. Glenfiddich has received hundreds of prestigious trade awards for its whiskies, some of which are auctioned for very large sums of money. The opponent has only provided UK turnover for 2021 (of £42.5m) and UK market share data (14.3% of the market) for a date after the relevant date. However, Ms Falcone confirms that the positions at the relevant date would not have been different and in light of the consistent, very large scale of the opponent's Glenfiddich trade, I find no reason to disbelieve her statement, which has not been challenged by the applicant.

54. I note that the applicant stresses that the opponent's reputation only extends to 'single malt' scotch whisky. I find this to be a narrow interpretation of the way in which the relevant

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<sup>24</sup> See exhibit CF28.

public will view the opponent's use. The opponent has a huge reputation for scotch whisky, the vast majority of which has been single malt in recent decades but within those ranges are 'Glenfiddich Experimental', 'Glenfiddich IPA' whiskies and whisky-based cocktail goods. The opponent also has a history of producing blends of whisky and began its business in those markets. Having considered all of the evidence presented to me, I find that the earlier mark has a very strong reputation in the UK for at least 'scotch whisky'.

## Link

55. In addition to the earlier marks having a reputation, a link must be made between the mark applied for and the earlier marks. In *Intel Corporation Inc v CPM (UK) Ltd*<sup>25</sup> ("Intel") the CJEU provided guidance on the factors to consider when assessing whether a link has been established. It stated:

"41. The existence of such a link must be assessed globally, taking into account all factors relevant to the circumstances of the case..."

56. Those factors include:

### The degree of similarity between the conflicting marks

57. In *Intra-Press SAS v OHIM*,<sup>26</sup> the CJEU stated that:

"72...The Court has consistently held that the degree of similarity required under Article 8(1)(b) of Regulation No 40/94, on the one hand, and Article 8(5) of that regulation, on the other, is different. Whereas the implementation of the protection provided for under Article 8(1)(b) of Regulation No 40/94 is conditional upon a finding of a degree of similarity between the marks at issue so that there exists a likelihood of confusion between them on the part of the relevant section of the public, the existence of such a likelihood is not necessary for the protection conferred by Article 8(5) of that regulation. Accordingly, the types of injury referred to in Article 8(5) of Regulation No 40/94 may be the consequence of a

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<sup>25</sup> C-252-07.

<sup>26</sup> Joined cases C-581/13P & C-582/13P.

lesser degree of similarity between the earlier and the later marks, provided that it is sufficient for the relevant section of the public to make a connection between those marks, that is to say, to establish a link between them (see judgment in *Ferrero v OHMI*, C-552/09 P, EU:C:2011:177, paragraph 53 and the case-law cited).”

58. In other words, the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion.

59. The similarity of signs under sections 5(2) and 5(3) of the Act is assessed in the same way.<sup>27</sup>

60. The application is for the term ‘Inverfiddich’. The opponent relies on two earlier marks, both of which are for the plain word ‘Glenfiddich’. I refer to these marks hereafter as, ‘the Glenfiddich mark’.

61. The opponent’s submissions in terms of the similarity between the marks are as follows:

*“39. The average consumer will perceive the marks as words that differ in their respective prefixes GLEN- and INVER- but share the common main element FIDDICH.*

*40. As to the differing prefixes, the average consumer would have come across both of these in other contexts: GLEN at least as a prefix is used in several other well-known Scotch whisky brands and INVER as a prefix used in several well-known Scottish place names. Accordingly, the average consumer would accord these little distinctive significance in themselves.*

*41. The average consumer would be familiar with the common element FIDDICH only as the main distinctive component of the highly distinctive*

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<sup>27</sup> See the principles established 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.

*GLENFIDDICH brand of Scotch whisky. They would not have come across the term in any other context.*

*42. Accordingly, overall, the average consumer would perceive the two marks as having have a strong degree of distinctive similarity arising from their common FIDDICH element, particularly in view of the exceptional acquired distinctive character enjoyed by the GLENFIDDICH mark.”*

62. The applicant submits the following in its skeleton argument:

*“21. The Applicant accepts that there is similarity between ‘Glenfiddich’ and ‘Inverfiddich’ to the extent that both trade marks include the word ‘fiddich’. However, any similarity is relatively low. The beginnings of the marks share no visual similarity. ‘Inverfiddich’ is also longer in length. ‘Inver’- and ‘Glen’- share no phonetic similarity, and the difference in the beginning of the marks is sufficient to impact overall aural similarity. “Inverfiddich” is also comprised of four syllables, which is different to ‘Glenfiddich’ which is made up of three.*

*22. ‘Glenfiddich’ means ‘valley of the deer’. This concept is central to the Opponent’s branding, which includes a stag logo, and to its backstory. The word ‘glen’ is a recognised word in itself meaning ‘valley’. Neither the concept of a glen/valley or deer are reproduced in the Applicant’s trade mark. On the other hand, ‘Inverfiddich’ comprises the words ‘inver’ and ‘fiddich’ together meaning ‘mouth of the River Fiddich’. This concept of the mouth of the River Fiddich is central to the Applicant’s trade mark and, eventually, its branding which connects the salmon fishing business (named ‘Inverfiddich Fishings’) to this business. Save for consumers who are familiar with the River Fiddich, there is no conceptual connection between ‘Inverfiddich’ and ‘Glenfiddich’. Where consumers are familiar with the River Fiddich, they will nevertheless understand that the Applicant’s trade mark is conceptually different from the Earlier Registrations.”*

63. Clearly the respective marks both end with ‘Fiddich’, with the beginning of the marks being ‘Glen’ and ‘Inver’ respectively. I agree with the opponent that the average consumer

is likely to have encountered the 'Glen' and 'Inver' prefixes in the context of Scottish goods and place names. I find the respective marks visually similar to a medium degree due to the common element, 'fiddich'.

64. Aurally the marks are three and four syllables in length, GLEN-FID-ICH and IN-VER-FID-ICH, with the last two syllables being the same in each mark. I find aural similarity to be at a medium level.

65. Conceptually both marks convey a sense of Scottishness, which is likely to be amplified by the nature of the goods. Some consumers will understand 'Glen' to mean a valley, I am not convinced that a significant proportion of UK consumers will know the specific meaning of 'Inver', though they are likely to have encountered it in the context of Scottish goods and place names. The common 'fiddich' element will have no meaning for the vast majority of UK consumers and both marks in their totalities are likely to be seen as invented words or place names, which may have a connection to Scotland.

The strength of the earlier mark's reputation

66. For the reasons I have already given, the opponent's mark had a very strong reputation at the relevant date.

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

67. The earlier mark is inherently distinctive to a reasonable degree, being seen as an invented word or a place name conveying a sense of Scottishness for scotch whisky. The opponent has enhanced its distinctiveness to the very highest degree by the use made of its mark, such that the opponent's GLENFIDDICH mark is very highly distinctive of the opponent.

The nature of the goods or services for which the conflicting marks were registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

68. In the current case, I have found the opponent to have a very strong reputation for at least scotch whisky in class 33. The applicant has applied for:

Alcoholic beverages, except beers, but in so far as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs complying with the specifications of the PGI Scotch whisky.

69. With regard to the assessment of similarity between the respective goods and services, I bear in mind *Gérard Meric v OHIM*,<sup>28</sup> in which the GC stated that:

“29...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”.

70. Both parties have scotch whisky in their specifications and these are self-evidently identical goods. The applicant’s ‘alcoholic beverages’ clearly includes whisky, which, in accordance with *Merica*, means that these are also identical goods.

71. I pause here to recall the applicant submits that whilst the opponent has a reputation for single malt scotch whisky, it does not have a reputation for scotch whisky at large. The relevance of this from the applicant’s point of view is that the average consumer of single malt whisky is more discerning and will pay a higher level of attention to the purchase of goods than a consumer of the wider category of scotch whisky, which includes goods such as blended whisky. The applicant relies on paragraph 297 of *Tomatin*, a decision of the Scottish Court in which it held:<sup>29</sup>

*“[297] The issue of the likelihood of confusion is not approached in the abstract, but through the eyes of the average consumer. In my view, it is relevant to consider the attributes of the average consumer, being in this case the single*

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<sup>28</sup> Case T-133/05.

<sup>29</sup> See *Tomatin Distillery Co Ltd v Tomatin Trading Company*, 2021 SLT 1327.

*malt whisky aficionado or single malt whisky explorer. On the experts' evidence, that is an individual with a relatively sophisticated understanding or knowledge of the whisky market, as opposed to the general public who are consumers of blended whiskies. Indeed, the very attributes of this kind of consumer - of being an aficionado or explorer - are suggestive that this kind of consumer is discerning and relatively knowledgeable about the product it appreciates or is exploring, and of its typical presentation as a product. Moreover, it may be inferred that, given the nature and price points of the different expressions of single malts, a single malt whisky aficionado or single malt whisky explorer consumer makes such a purchase with a moderate degree of intentionality, which may be contrasted, for example, with the more casual purchases of everyday items such as soap or cereal. It is for these reasons that, notwithstanding the factors the pursuer founds on, I conclude that the average consumer is unlikely to be confused."*

72. I do not find this case persuasive in respect of the facts before me. The court made clear that in this case the average consumer was a 'single malt whisky aficionado' or 'single malt whisky explorer' and it reached this conclusion having considered expert evidence. There is no evidence of that kind in this case and nothing to indicate that I should not consider the average UK consumer of these goods in the usual way. I find unhelpful, the applicant's proposed division of single malt whisky consumers and consumers of the broader range of blended scotch whisky goods. In my experience many supermarkets produce their own single malt whiskies at fairly low prices, while some renowned whisky producers work on complex blends of whiskies which are considered premium products and have high prices attached. I agree with the opponent's submission that scotch whisky is a 'normal consumer product', sold in retail premises and online, to which the relevant public purchasing the goods, will pay a medium level of attention overall.

73. The applicant's director, Callum Robertson, provides a witness statement, dated 15 July 2022. Seventeen exhibits are attached to that statement,<sup>30</sup> one of which is an A-Z list of scotch whisky brands taken from The Whisky Exchange website.<sup>31</sup> The purpose of this exhibit from the applicant's point of view is related to its claim to have due cause in making

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<sup>30</sup> The majority of the exhibits attached to Mr Robertson's statement relate to the applicant's claim to due cause in using the mark applied for. This is a point I will return to later in the decision.

<sup>31</sup> See exhibit CR-10.

the contested trade mark application, a point I will return to later. However, as the opponent points out, it also shows that whilst it is clear that other scotch whisky brands may use 'Glen' in their name, no other brand uses 'Fiddich'. I note that 122 brands are listed and only Glenfiddich uses 'fiddich' in the name of its whisky product.

74. The opponent has a very strong position in the scotch whisky market and I find that its mark is so distinctive of it that the applicant's Inverfiddich mark will result in a link being made between it and the opponent. Put simply, taking account of all the preceding factors, the relevant public will make a link between the opponent's mark Glenfiddich and the application for Inverfiddich for identical goods, being scotch whisky (and alcoholic beverages which include scotch whisky).

## **Damage**

75. The opponent claims two heads of damage, those being dilution and unfair advantage. With regard to dilution the opponent's position is that the applicant's proposed use of Inverfiddich for scotch whisky would weaken the opponent's ability to identify its own goods as originating from it. Secondly, the opponent claims that the applicant's trade mark will take unfair advantage of its Glenfiddich mark by creating an instant cachet for the Inverfiddich brand without any promotional effort.

76. In *L'Oréal*,<sup>32</sup> the CJEU said:

"The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an advantage taken unfairly by that third party of the distinctive character or the repute of that mark where that party seeks by that use to ride on the coat-tails of the mark with a reputation in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image."

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<sup>32</sup> *L'Oréal SA & Ors v Bellure & Ors* - Case C-487/07, paragraph 50.

77. The opponent also claims that the applicant had specific intention to benefit from the opponent's reputation, but there is nothing in evidence to prove such a claim one way or the other. In fact, it is fairly unusual in cases before this tribunal that there is evidence of the intended use of an application when one comes to make an assessment regarding the likelihood of damage. In any case, it is clear from the decision of Arnold J. (as he then was) in *Jack Wills v House of Fraser (Stores) Limited*,<sup>33</sup> that the claim to unfair advantage does not require proof of subjective intention on the part of the applicant. Paragraph 80 of that decision reads:

“The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill.”

78. I agree with the opponent that the success of the earlier mark and its huge reputation amongst purchasers of scotch whisky will make it easier for the attraction of the earlier mark to be projected on to the applicant's mark. I find that there is a risk, which is not hypothetical, that use of the contested mark will make it easier for the applicant to offer its scotch whisky to a section of the relevant public due to the link made between it and the opponent's Glenfiddich mark.

79. As I have found for the opponent under the first head of damage, I do not consider it necessary to go on to consider the remaining heads of damage pleaded.

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<sup>33</sup> [2014] EWHC 110 (Ch)

80. Having found the 5(3) ground to have succeeded the only defence left for the applicant is to show that it has due cause to use the mark applied for. Such a claim was made by the applicant in its counterstatement.

### **Due cause**

81. In *Leidseplein Beheer BV v Red Bull*,<sup>34</sup> the CJEU held that:

“43. In a system for the protection of marks such as that adopted, on the basis of Directive 89/104, by the Benelux Convention, however, the interests of a third party in using, in the course of trade, a sign similar to a mark with a reputation must be considered, in the context of Article 5(2) of that directive, in the light of the possibility for the user of that sign to claim ‘due cause’.

44. Where the proprietor of the mark with a reputation has demonstrated the existence of one of the forms of injury referred to in Article 5(2) of Directive 89/104 and, in particular, has shown that unfair advantage has been taken of the distinctive character or the repute of that mark, the onus is on the third party using a sign similar to the mark with a reputation to establish that he has due cause for using such a sign (see, by analogy, Case C-252/07 *Intel Corporation* [2008] ECR I-8823, paragraph 39).

45. It follows that the concept of ‘due cause’ may not only include objectively overriding reasons but may also relate to the subjective interests of a third party using a sign which is identical or similar to the mark with a reputation.

46. Thus, the concept of ‘due cause’ is intended, not to resolve a conflict between a mark with a reputation and a similar sign which was being used before that trade mark was filed or to restrict the rights which the proprietor of that mark is recognised as having, but to strike a balance between the interests in question by taking account, in the specific context of Article 5(2) of Directive 89/104 and in the light of the enhanced protection enjoyed by that mark, of the interests of the third party using that sign. In so doing, the claim by a third party that there is due cause for using a sign which is similar to a mark with a

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<sup>34</sup> Case C-65/12

reputation cannot lead to the recognition, for the benefit of that third party of the rights connected with a registered mark, but rather obliges the proprietor of the mark with a reputation to tolerate the use of the similar sign.

47. The Court thus held in paragraph 91 of the judgment in *Interflora and Interflora British Unit* (a case concerning the use of keywords for internet referencing) that where the advertisement displayed on the internet on the basis of a keyword corresponding to a trade mark with a reputation puts forward – without offering a mere imitation of the goods or services of the proprietor of that trade mark, without being detrimental to the repute or the distinctive character of that mark and without, moreover, adversely affecting the functions of the trade mark concerned – an alternative to the goods or services of the proprietor of the trade mark with a reputation, it must be concluded that such a use falls, as a rule, within the ambit of fair competition in the sector for the goods or services concerned and is thus not without ‘due cause’.

48. Consequently, the concept of ‘due cause’ cannot be interpreted as being restricted to objectively overriding reasons.”

82. In this case, the CJEU identified the following factors as relevant to the assessment of whether the later mark was filed with due cause:

- how that sign has been accepted by, and what its reputation is with, the relevant public;
- the degree of proximity between the goods and services for which that sign was originally used and the product or service for which the mark with a reputation was registered; and
- the economic and commercial significance of the use for that product or service of the sign which is similar to that mark.

83. The applicant claims in its counterstatement that its use of INVERFIDDICH would be with due cause and in accordance with honest practices because:

*"...it has owned a section of the River Fiddich since 1985, and Inverfiddich fishings (situated at Craigellachie, AB38 9RQ) since 2004. It also owns Dandaleith Farm and Easter Elchies fishings, both in Craigellachie, at the*

*confluence of the River Spey and River Fiddich. The Applicant's mark was chosen due to its ownership of the fishings and to indicate a link between the product and the geographical location in which it is to be bottled, in accordance with honest practices."*

84. The applicant's evidence is provided by a witness statement of Callum Robertson. Mr Robertson is the applicant's Director, his statement is dated 15 July 2022. He submits the following in his statement:

*14. The evolution of fishing estates into producers of whisky and gin has been popular on Speyside in recent times. To give a few examples, Ballindalloch, Gordon Castle and Tulchan are all salmon fishing estates on the River Spey, which also use their brands on spirits.<sup>35</sup> In addition, there is the longstanding and world famous Knockando Scotch whisky, which shares its name with the village of Knockando and the famous salmon fishings on the River Spey at Knockando Estate.<sup>36</sup> A leaping salmon is even the logo for Singleton whisky.<sup>37</sup> Salmon fishing and the production of gin and whisky go hand in hand. It was therefore a logical extension of the Springfield Properties business to expand into alcoholic beverages and Scotch whisky in particular.*

85. Mr Robertson concludes his statement as follows:

*"Springfield Properties' adoption of 'Inverfiddich' for alcoholic beverages, including Scotch whisky, is a logical extension of our existing business already using that name. It refers to the geographical location of the business, like so many other Scotch whiskies."*

86. In order to succeed in such a claim it is necessary for the applicant to show the nature and extent of its current business under the Inverfiddich sign. The fact that some other estates in Scotland use their estate name to produce spirits and that some whiskies are named after specific villages, is not evidence that helps the applicant. This is because a claim of due cause necessitates the competent authority to make an assessment of the

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<sup>35</sup> See exhibit CR08, which includes maps of those estates.

<sup>36</sup> As above.

<sup>37</sup> Also shown in the exhibit referred to above at 35.

competing rights of parties in order to identify where legitimate use of a mark must be tolerated by another right holder, in the interests of commercial fairness.

87. The starting point must be the applicant's own business under the Inverfiddich sign which it claims gives rise to it having due cause to register the Inverfiddich trade mark applied for. Unfortunately for the applicant, it is not possible for me to determine how its fishing business is known to its customers, nor to what extent it has a reputation under Inverfiddich in the mind of the relevant public. This is because the applicant has not provided sufficient evidence of its fishing business for me to establish how its customers encounter the applicant's fishing business. I have no evidence of extent of trade, advertising or promotional material for the applicant's business. In other words, its claim to be seeking to widen an existing fishing business which is offered under the sign Inverfiddich, does not get over the first hurdle.

88. I would add that even if the applicant had established a trade in fishing trips on the Inverfiddich part of the River Spey, under the sign Inverfiddich, this does not seem to me to be sufficient to justify the use of Inverfiddich for scotch whisky, when that sign would, as I have already found, take unfair advantage of the opponent's sufficiently similar mark with a considerable reputation.

89. I find in this case that there is no evidence of a pre-existing business under the Inverfiddich sign and the applicant's claim to have due cause for applying for the contested mark fails.

## **CONCLUSION**

**90. The opponent succeeds under section 5(3) for all of the goods in the application.**

### The remaining grounds

91. I have considered whether or not to deal with the opponent's claims under section 5(2)(b) and 5(4)(a) of the Act. The opponent has succeeded in full on the basis of its considerable reputation under the Glenfiddich mark for scotch whisky. There is nothing to be gained for the opponent by considering the other grounds, especially in light of the fact that the opponent identified section 5(3) as its strongest case.

## **Costs**

92. William Grant & Sons Limited has been successful under section 5(3) and is entitled to a contribution towards its costs. I award costs on the following basis:

Official Fee -	£200
Preparing a statement and considering the other side's statement -	£400
Filing evidence and considering the other side's evidence -	£800
Preparing for and attending a hearing -	£800
<b>Total</b>	<b>£2200</b>

93. I order Springfield Properties Limited to pay William Grant & Sons Limited the sum of £2200. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

**Dated this 16<sup>th</sup> day of August 2023**

**Al Skilton**  
**For the Registrar,**  
**the Comptroller General**