

O-183-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3281243
BY VIVEK ANASANE TO REGISTER THE TRADE MARK**



IN CLASS 33

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 412343 BY
WILLIAM GRANT & SONS LIMITED**

BACKGROUND AND PLEADINGS

1) Vivek Anasane (hereafter “the applicant”) applied to register the following trade mark:



2) The relevant details are:

Filing date: 9 January 2018

Publication date: 2 February 2018

Class 33: *Scotch whisky.*

3) William Grant & Sons Limited (hereafter “the opponent”) opposes the application. The opposition is based upon section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the first two grounds, the opponent relies on the following mark:

UK Mark No. 809941
GLENFIDDICH Filing date: 26 August 1960 Registration date: 26 August 1960
The list of goods: Class 33: <i>Scotch whisky.</i>

4) The opponent's mark is an earlier mark within the meaning of section 6(1) of the Trade Marks Act 1994 ("the Act") because it has a filing date earlier than the filing date of the contested application. This earlier mark completed its registration procedures more than five years before the publication date of the contested application and, as a result, it is potentially subject to the proof of use provisions contained in section 6A of the Act.

5) The opponent's pleadings in respect of these two grounds are as follows:

- Registration of the contested marks would be contrary to section 5(2)(b) of the Act because GLENFIELD is visually and phonetically highly similar to GLENFIDDICH, with both including the prefix GLEN and the letters F and D in the remaining element of each mark and because the contested goods are identical to the opponent's goods. It concludes that, consequently, there exists a likelihood of confusion;
- Use of the contested marks would offend under section 5(3) of the Act because the opponent's mark has acquired a reputation in its earlier mark as the result of extensive use throughout the UK since at least 1960 in relation to scotch whisky. As a result:
 - consumers are likely to associate the GLENFIELD mark with the opponent's brand leading to an unfair benefit;
 - use of the applicant's mark would cause detriment to the reputation of the earlier mark, particularly if the goods offered are of a lower quality than the opponent's goods;
 - use of the applicant's mark would result in detriment to the earlier mark's distinctive character, reducing the value of the earlier mark and affecting the purchasing decisions of consumers.

6) In respect of the ground based upon section 5(4)(a), the opponent relies upon its "substantial" goodwill in the UK, since at least 1960, in respect of its scotch whisky attached to the sign GLENFIDDICH and also the following sign:



7) This poor representation is described by the opponent as “the appearance of the core GLENFIDDICH bottle ... The bottle uses the colour combination green and gold, as well as features an image of a stag device which has become highly recognisable to consumers”. It is claimed that any use of the applicant’s mark in relation to the identical goods would constitute a misrepresentation to the public which is likely to cause damage to the opponent’s business.

8) The applicant filed a counterstatement denying the claims made. There is no indication provided to the question “Do you want the opponent to provide “proof of use”. In the absence of a positive indication, I proceed on the basis that the opponent has not been put to proof of use. The applicant states that it was established in 2017 and has built a reputation for itself and its products in India and now wishes to start business in the UK. It provides a list of third party marks on the UK register of trade marks that contain the word GLEN and are in respect to Class 33 goods. Further, it submits that no one can claim the right in the word GLEN because it describes “a narrow valley, especially in mountain”.

9) Only the opponent filed evidence. I will refer to this to the extent that I consider it necessary. Neither side requested to be heard and I make my decision giving due regard to all the papers on file.

10) The opponent was represented in these proceedings by Wildbore & Gibbons. The applicant, who is based in India, provides a name and address for service in the UK but does not appear to be represented.

Opponent's Evidence

11) This takes the form of a witness statement by Coralie Vial, Global Brand Manager of the opponent. She provides information regarding the history and use of the GLENFIDDICH mark. This can be summarised as follows:

- The GLENFIDDICH brand has been used in the UK for a single malt scotch whisky since at least 1960 and consistently used since that date. Various different whisky products bearing labels the same or similar to the label relied upon for the purposes of section 5(4)(a) are provided but undated¹;
- The GLENFIDDICH label has used the colours green and gold for many years and she confirms that this has been so since she joined the opponent in 2008²;
- Sales figures in the EU (including the UK) in respect of all GLENFIDDICH products are provided³. These have been obtained from an independent source. In respect of the UK, between 2005 and 2014, volumes have been in the region of 100,000 nine litre cases a year;
- The opponent has a wide network of customers and local distributors for its GLENFIDDICH products in the UK⁴ and numerous sample invoices are provided all dated from 2012 to 2015⁵;
- GLENFIDDICH products have a strong presence in duty free establishments throughout the UK and is available at all UK airports. It is asserted that GLENFIDDICH products have exposure to many millions of air passengers using these airports. Ms Vial pointed out that the number of passengers passing through UK airports in 2014 was 241 million⁶;

¹ Ms Vial's Exhibit 2

² Ms Vial's witness statement, para 5

³ Ms Vial's Exhibit 3

⁴ Ms Vial's witness statement, para 17

⁵ Exhibit 5

⁶ Ms Vial's witness statement, paras 13 & 14 and Exhibit 4

- Promotional spend in respect of GLENFIDDICH products across the EU was in the range of £8.6 million to £11.4 million a year between 2009 and 2014⁷ and examples of advertising and news articles reporting on its advertising are provided⁸;
- A number of media articles are provided⁹ reviewing, discussing, offering for sale of GLENFIDDICH whisky as well as corporate news items reporting on new marketing initiatives of these products. They are dated between 2007 to 2015;
- A number of articles contained in the exhibits mentioned above describe GLENFIDDICH whisky as having a 30% share of the worldwide market for single malt whisky¹⁰. An article in the trade publication *The Drinks Business* , dated 10 September 2010, ranked GLENFIDDICH as the top global brand of scotch whisky¹¹

DECISION

Section 5(2)(b)

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

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods

13) The respective goods are identical.

⁷ Ditto para 19

⁸ Exhibit 6

⁹ Exhibit 7

¹⁰ Witness statement, para 26

¹¹ Exhibit 9

Comparison of marks

14) It is clear from *Sabel BV v. Puma AG*, Case C-251/95 (particularly paragraph 23), Case C-251/95, that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union (“the CJEU”) stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

15) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take account of the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

16) The respective marks are:

Earlier mark	Contested mark
GLENFIDDICH	 The logo for Glenfield Blended Scotch Whisky is a shield-shaped emblem with a dark green background and a gold border. At the top, two golden stag heads with antlers flank a central shield containing the letters 'G' and 'F'. Below this, the word 'Glenfield' is written in a large, white, serif font. Underneath, 'BLENDED SCOTCH WHISKY' is written in a smaller, gold, sans-serif font. At the bottom, the phrase 'Product of Scotland' is written in a cursive, gold script.

17) The earlier mark consists of the word GLENFIDDICH. It is self-evidently the dominant and distinctive element. The applicant's mark is a complex label mark that consists of the word GLENFIELD in large thick white letters, set against a dark green label. The words BLENDED SCOTCH WHISKY appear below the word GLENFIELD but these are less dominant due to their size and colour, being gold and consequently does not contrast with the background colour to the same extent as the white letters. The words *Product of Scotland* also appear in a fancy script, but these are smaller still and appear at the bottom of the device. At the top of the device, is a shield flanked on each side by a stag rampant. The shield itself is divided into four creating a harlequin-type effect with the top right and bottom left quarters being coloured gold. The letter G appears in the top left quarter and the letter F appears in the bottom right quarter. The label itself also has a gold border that mirrors the outline of the device itself. The word GLENFIELD is the dominant distinctive element. The remaining words have descriptive qualities and do not contribute to the distinctive character. The label and the device of the shield and stags rampant also contribute to the distinctive character.

18) Visually, the marks share some similarity because the dominant element of the applicant's mark is a single word beginning with GLEN and the opponent's mark also begins with GLEN. The opponent asserts that there is further similarity because the second half of these words, namely FIELD and FIDDICH both also contain the letters "F" and "D" appearing in the same order. I also recognise that the letter "I" also appears in both. Whilst the common occurrence of these letters cannot be denied, I am of the view that this common occurrence has little visual impact. It is offset by the fact that the opponent's mark is noticeably longer and forms a different word. In all other respects the marks are dissimilar, with the numerous additional elements present in the applicant's mark all being absent in the opponent's mark and this introduces significant visual differences. Taking all of this into account, I conclude that the respective marks share a very low level of visual similarity.

19) Aurally, the applicant's mark is likely to be pronounced only by reference to the GLENFIELD element of its mark. Consequently, it will share the first syllable GLEN with the opponent's mark, together with the "F" sound at the start of the second syllable. However, they differ in that the opponent's mark consists of three syllables,

the last two of which are different to the second (and last) syllable of the applicant's GLENFIELD element of its mark. Taking all of this together, I conclude that the level of aural similarity is low to medium.

20) Conceptually, other than the common occurrence of GLEN, meaning "*a narrow valley, especially in Scotland or Ireland*"¹², the respective marks have no conceptual similarity. The applicant's mark has a number of elements that impact upon its conceptual identity, such as the FIELD part of the word GLENFIELD, the device of the two stags rampant and a shield, all of which are absent in the opponent's mark. Taking all of this into account I conclude that the respective marks share a very low level of conceptual similarity.

Average consumer and the purchasing act

21) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*.

22) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

"60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

¹² <http://www.oxfordreference.com/search?q=Glen&searchBtn=Search&isQuickSearch=true>

23) The relevant average consumer will generally be the whisky drinking general public who will pay a normal level of care and attention during the purchasing process, being neither particularly low or high. The nature of the purchasing act will vary depending upon where the whisky is being purchased. In a public house, when ordering over the bar, aural considerations play a role as do visual considerations with the whisky bottle and label often visible on shelves behind the bar. In a retail environment, visual considerations are paramount, but I don't ignore that in some retail establishments, whisky may be aurally requested.

Distinctive character of the earlier trade marks

24) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

25) The opponent's mark consists of an invented word that, because of the presence of the GLEN element, may allude to a Scottish connection. It has a reasonably high level of inherent distinctive character. Further, the opponent has provided cogent evidence that its GLENFIDDICH whisky products has a long-standing reputation in the UK and beyond. Such a reputation results in its mark's distinctive character being elevated to high.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

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

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when

all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

27) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). These factors must be assessed from the viewpoint of the average consumer. Confusion can be direct (which occurs when the average consumer mistakes one mark for the other) or indirect (where the

average consumer realises the marks are not the same but puts the similarity that exists between the marks and goods down to the responsible undertakings being the same or related).

28) I have found that:

- The respective goods are identical;
- The dominant and distinctive element of the applicant's mark is the GLENFIELD element and, as the opponent's mark consists only of the word GLENFIDDICH, it is self-evidently the dominant and distinctive element;
- The respective marks share a very low level of visual and conceptual similarity and a low to medium level of aural similarity;
- The average consumer is likely to be the whisky drinking general public who will pay a normal level of care and attention during the purchasing process, which is likely to be visual or aural in nature;
- The opponent's mark benefits from a high level of distinctive character as a result of its longstanding and extensive use in the UK.

29) Taking account of all of the above, I note that there are certain findings that point towards a finding of a likelihood of confusion, such as the high level of distinctive character of the earlier mark, identical goods and the dominance of the GLENFIELD element in the applicant's mark that is the only element that has any similarity to the opponent's mark. However, these factors are more than offset by the differences between the marks. The very low level of visual and conceptual similarity and the low to medium level of aural similarity arises because the only similarity is the common occurrence of the GLEN element that is likely to be readily understood by the average consumer as an allusion to Scotland. This is likely to be the overriding perception of the consumer and when this is factored into consideration of likelihood of confusion and when considering the marks as a whole, I am of the view that the applicant's mark will not even bring the opponent's mark to mind let alone confuse the consumer into believing that the goods sold under the respective marks originate from the same or linked undertaking. This finding applies equally to situations where the purchasing act is aural as well as when it is visual in nature.

30) The opponent relies upon the common occurrence of the letters “F” and “D” being present in the second element of GLENFIDDICH and the GLENFIELD element of the applicant’s mark (and as I noted earlier, so does the letter “I”). However, the visual length of the two words, the conceptual meaning of “field” that is absent in the opponent’s mark and the fact that the FIDDICH part of the opponent’s mark has no obvious meaning results in it being extremely unlikely to be mistaken for the word FIELD. As a result, I dismiss the opponent’s claim that because the letters “F” and “D” appear in the same order in the words GLENFIDDICH and GLENFIELD, this increases the likelihood of confusion.

31) I conclude that the opposition, insofar as it is based upon section 5(2)(b) of the Act, fails in its entirety.

Section 5(3)

32) Section 5(3) states:

“(3) A trade mark which –

- (a) is identical with or similar to an earlier trade mark,
- (b) (repealed)

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EU) in the European Union) 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.”

33) The relevant case law can be found in the following judgments of the 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 of 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*).

Reputation

34) The relevant date for assessing if the opponent has a necessary reputation is the filing date of the contested mark, namely, 9 January 2018. The evidence that I summarised at paragraph 10, above, clearly illustrates a long-standing and significant level of use of the opponent's mark in the UK and I have little hesitation in concluding that this use results in the mark having a significant reputation in respect to whisky products.

Link

35) In *Intra-Press SAS v OHIM*, joined cases C-581/13P & C-582/13P, the CJEU stated (at paragraph 72 of its judgment) that:

“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 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).”

36) Therefore, the level of similarity between the respective marks may be less than required under section 5(2)(b) of the Act. However, the relevant section of the public must still make a connection between the marks. As I discussed in paragraph 28 and 29, above, I have found that the applicant’s mark is not likely to bring the opponent’s mark to mind let alone confuse the consumer into believing that the goods sold under the respective marks originate from the same or linked undertaking. In the absence of the bringing of the opponent’s mark to mind, there can be no link for the purposes of section 5(3). In light of this, there can be no detriment or unfair advantage of the opponent’s mark that may result from use of the applicant’s mark.

37) In summary, the ground of opposition based upon section 5(3) fails in its entirety.

Section 5(4)(a)

38) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

39) Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or

as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

40) Further guidance is given in paragraphs 184 to 188 of the same volume with regard to the establishing of a likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

41) The relevant date for assessing if section 5(4)(a) applies has been discussed by Mr Daniel Alexander QC sitting as the Appointed Person in *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11. A summary of the position provided by Allan James, for the Registrar, in *SWORDERS TM O-212-06* was quoted with approval and I reproduce it below:

“Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.”

42) The relevant date for the purposes of these proceedings is the filing date of the contested application, namely 9 January 2018. In the counterstatement the applicant makes reference to the fact that it wishes to expand its successful business

in India to the UK. The inference from this is that, at this date, it had no competing goodwill in which to rely upon. Even if I am wrong regarding this, in the absence of any evidence substantiating a competing goodwill in the UK, I must find that there is no such goodwill. As a consequence of this, the filing date of the application is the only relevant date for assessing the issue of passing off in these proceedings.

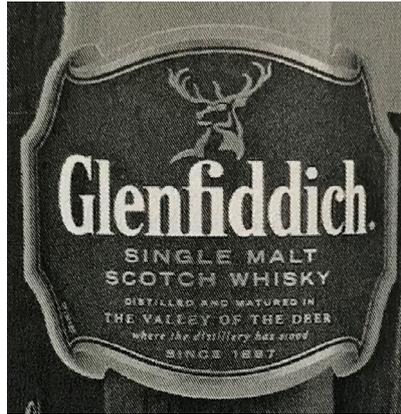
Goodwill

43) A long-standing definition of goodwill is provided in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

44) I have found that the opponent has a long-standing and significant reputation in respect of its word mark GLENFIDDICH and it is evident to me that the same use that led me to reach that conclusion also leads me to find that the opponent has a considerable goodwill identified by that mark.

45) The opponent also relies upon a second mark shown in paragraph 6, above, and in its grounds of opposition states that “the bottle uses the colour combination green and gold, as well as features an image of a stag device which has become highly recognisable to consumers”. The representation of this mark is not particularly clear and has not been provided in colour. The evidence does show clearer representations of this label, but again, they are not in colour. The best representation of this label appears on page 5 of Exhibit 7 and this is shown below:



46) It is not identical because the small text present at the bottom of the label spans four lines whereas the text in the same position of the relied upon mark (shown in the Form TM7) spans only two lines, Therefore. The text, although difficult to read in the relied upon mark, cannot be the same. However, for the purposes of my analysis here, I will proceed on the basis that it is. Further, and again for the purposes of this decision, I will accept that this label device is presented in the same colour combinations as claimed by the opponent, i.e. the word GLENFIDDICH in white, all other text, the device of a stag and the border in gold and the label background in dark green.

47) The evidence includes a number of exhibits that show this label, but it is one of a number of different labels and colour schemes used. For example, on page 1 of Exhibit 2 there are images of light coloured labels, clear labels and several that do not feature the word GLENFIDDICH prominently or at all (the images are too small to be certain), a clear label shown at page 6 of Exhibit 6 and a light-coloured label shown at page 31 of Exhibit 8. Taking account of these variations, I find that the evidence still demonstrates a significant goodwill identified by the label mark relied upon but this is less than for the word mark because the opponent's use of various other labels, some of which do not share the same colour combinations.

Misrepresentation and Damage

48) In *Neutrogena Corporation and Another v Golden Limited and Another*, 1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] R.P.C. 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

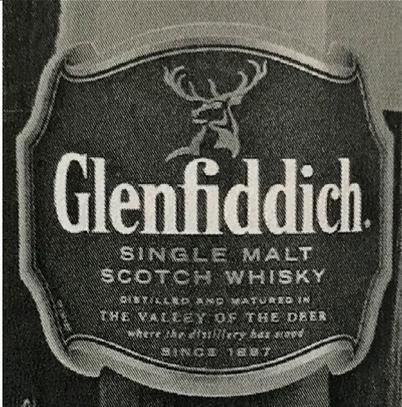
And later in the same judgment:

“.... for my part, I think that references, in this context, to “more than *de minimis* ” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

49) When considering the grounds under section 5(2)(b) and section 5(3), I have found that the opponent's word mark GLENFIDDICH will not even bring the opponent's mark to mind and therefore, I found there would be no likelihood of confusion, not would there be the requisite link made between the marks. I acknowledge that the test for misrepresentation is different under section 5(4)(a), but for the same reasons that led me to these earlier findings, I find that the differences between the marks are such as to not confuse a substantial number of the relevant

public. Therefore, the section 5(4)(a) ground fails in respect as it is based upon the opponent's word mark.

50) Next, I turn to consider the question of misrepresentation of the opponent's label mark. For ease of reference, I show both marks below:

Opponent's earlier mark	Applicant's mark
 <p>The image shows a dark, textured label for Glenfiddich Single Malt Scotch Whisky. At the top is a stag head with large antlers. Below it, the word "Glenfiddich" is written in a large, white, serif font. Underneath, in smaller white capital letters, it says "SINGLE MALT SCOTCH WHISKY". Further down, in even smaller text, it reads "DISTILLED AND MATURED IN THE VALLEY OF THE DEER where the distillery has stood SINCE 1897".</p>	 <p>The image shows a dark green label for Glenfield Blended Scotch Whisky. At the top is a heraldic crest featuring two stags rampant on either side of a shield containing the letters 'G' and 'F'. Below the crest, the word "Glenfield" is written in a large, white, serif font. Underneath, in smaller white capital letters, it says "BLENDED SCOTCH WHISKY". At the bottom, in a cursive script, it reads "Product of Scotland".</p>

51) Beyond the assumed coincidence of the same colours, the similarities are that both marks present stag devices at the top of the label, the elements GLENFIDDICH and GLENFIELD both begin with the same GLEN prefix and the letters F, I and D and they both share the words SCOTCH WHISKY. The common occurrence of these last words does not create any meaningful similarity because they merely describe the product and therefore have no distinctive character. I have already dismissed the opponent's submissions regarding the similarity of the GLENFIDDICH/GLENFIELD word elements, concluding that they share only a very low level of visual and conceptual similarity and a low to medium level of aural similarity. The presence of a device of a single stag exhibits differences to the applicant's heraldic device featuring two stags rampant that are unlikely to go unnoticed. In respect of the colour combinations, these provide some similarity and may serve to fleetingly bring the other mark to mind, but the significant differences, particularly in the dominant elements GLENFIDDICH and GLENFIELD are such that when all of the above are factored into my assessment, I find that the differences outweigh the similarities and the applicant's mark will do no more than bring the opponent's mark fleetingly to mind. Therefore, there is insufficient similarity for a misrepresentation to occur.

52) Taking all of this together, the grounds based upon section 5(4)(a) fails.

Summary

53) The opposition fails on all grounds and the application can proceed to registration.

Costs

54) The applicant has been successful and is entitled to a contribution towards its costs. However, as an unrepresented party, he was directed to complete a costs proforma by 29 January 2019. He did not comply with this direction and no completed costs proforma was filed. Therefore, I make no award of costs.

Dated 8 April 2019

Mark Bryant

For the Registrar

The Comptroller-General