

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION No 9676
BY MACDONALD & MUIR LTD
FOR A DECLARATION OF INVALIDITY
IN RESPECT OF TRADE MARK NO. 1579872
IN THE NAME OF STEWART SHEPLEY
TRADING AS SHACKLEFORD MARKETING ASSOCIATES**

TRADE MARKS ACT 1994

5 **In the matter of application No.9676**
by Macdonald & Muir Ltd for a declaration of invalidity
in respect of Trade Mark No. 1579872 in the name of
Steward Shepley trading as Shackleford Marketing Associates

10 **BACKGROUND**

Trade Mark No. 1579872 stands registered from the filing date of 27th July 1994. It is in
respect of the trade mark GLENMOY. The registration was in the name of Brodie &
15 Crawford Co. Limited at the time the application for the declaration of invalidity referred to
below was made, but after an assignment in full dated 14 January 1998 the proprietors
changed to Brodie & Crawford (Brands) Ltd and then after another assignment in full dated
29 October 1999, the proprietorship of the mark changed and currently stands in the name of
20 Steward Shepley trading as Shackleford Marketing Associates. It is in respect of a
specification of goods in Class 33 as follows:-

Wines, spirits, liqueurs; all included in Class 33.

25 On 17 July 1997 Macdonald & Muir Ltd made an application under Section 47(1) of the
Trade Marks Act 1994 to have the trade mark registration declared invalid. The grounds of
the application are, in summary:

- 30 (i) **under Section 3(6)** in that the application for registration was made in bad
faith, the applicants for registration having no bona fide intention to use the
mark in the form shown on the form of application but they intended to use and
uses the mark in the form THE GLENMOY, as in their registration No
1524416 in a label form. The registration should therefore be declared invalid
under the provisions of **Section 47(1)** of the Act.
- 35 (ii) **under Section 5(2)(b)** because the mark GLENMOY is confusingly similar to
the earlier trade mark GLEN MORAY (registration No. 1059369) and is
registered for goods identical to those for which the earlier trade mark is
protected, having regard to **Section 47(2)(a)** because the applicant for the
40 declaration of invalidity has not consented to the registration of the mark in
suit.

The registered proprietors filed a counterstatement in which they deny all grounds. Both sides
45 seek an award of costs.

Both sides filed evidence in these proceedings. Neither side has asked for a hearing. Acting
on behalf of the Registrar and after a careful study of the papers, I give this decision.

Applicants' Evidence - Rule 13(4)

5 This consists of a statutory declaration dated 14 April 1998 by Caroline Teresa Bonella. Ms Bonella states that she is a registered trade mark agent and is currently acting on behalf of Trade Mark Owners Association Limited, the agents for the applicants for the declaration of invalidity.

10 Ms Bonella exhibits at CTB1 a 1996 reprint of a book, (first published in 1987) entitled "The World Guide to Whisky" by Michael Jackson. She states that pages 14 - 97 inclusive deal with Scotch Whisky with particular reference to specific brands and that many of those brands carry the prefix THE. She then goes on to list 11 such instances and by way of example of these I note the brands THE FAMOUS GROUSE, THE GLENLIVET, THE BALVENIE,
15 THE GLENDRONACH and THE GLENTURRET.

She states that it is clear that within the Scotch whisky industry there is a well established practice of using the definite article in front of a brand name or trade mark in a way which is perhaps not seen in any other industry and that, in certain instances, the presence or absence of
20 the definite article can indicate a difference in the source of the product. She then uses the geographical term Glenlivet and the trade mark THE GLENLIVET as an example and states that information about this is contained on pages 78-91 of Mr Jackson's book.

Next Ms Bonella exhibits at CTB2 samples of recent advertisements of brands of Scotch
25 whisky which carry the definite articles as a prefix and as an integral part of the trademark. These she states further support the evidence contained in Mr Jackson's book, and demonstrates that the presence or absence of the definite article in a trade mark used on Scotch whisky is still significant now. Having perused these advertisements, it appears to me that the first eleven have already been exhibited at CTB1 to this declaration. There are a
30 further three advertisements, two of which relate to THE FAMOUS GROUSE whisky and are published in The Grocer and one which relates to THE MACMILLAN whisky and is published in Private Eye. I am not given any details about these publications, however, I note that the three advertisements were published after the material date in these proceedings so can be given little, if any, weight. However, as the point this evidence seeks to establish is that
35 the practice of using the word "THE" (the definite article) in the Scotch whisky trade is still prevalent today, I take note of the point and will give it weight commensurate with its importance in my decision.

Finally, Ms Bonella exhibits at CTB3 a label used by the registered proprietor which shows the
40 trade mark THE GLENMOY. The trade mark shown, she states, is covered by registration No. 1524416, details of which she has included in exhibit CTB3, and not the trade mark GLENMOY (simpliciter) as registered under No. 1579872.

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Registered proprietors' evidence (Rule 13(6))

5 This consists of two statutory declarations, both dated 19 January 1999. They are by Mr Pierpaolo A M Pacitti and Mr Ronald George Jenkins. Both state that they are Registered Trade Mark Agents, employed by Murgitroyd & Company. Mr Pacitti states that his declaration is made from his own knowledge and under the authority of Brodie & Crawford Co. Ltd (the then proprietors) and Mr Jenkins states that his declaration is made from his own knowledge.

10 Taking Mr Pacitti's declaration first, he makes comments about the provision of Section 46(2) of the Trade Marks Act 1994, namely that it provides that use of a Trade Mark in a form differing in elements which do not alter the distinctive character of the Mark will be accepted as use of a registered Trade Mark. This provision, he states, is mandatory and he then contrasts it with Section 30(1) of the Trade Marks Act 1938 which was discretionary. He states that the addition of the definite article does not alter the distinctive character of GLENMOY, it merely serves to emphasise the importance of the word which follows.

20 He explains that once application 1524416 (THE GLENMOY in label form) had been accepted the proprietor made plans to develop the mark GLENMOY (solus) as a main brand name. He exhibits at PPP1 a letter dated 19 July 1994 from his firm, Murgitroyd & Company to Brodie Crawford and Company Limited which confirms a telephone conversation where this intention was discussed. This, he states is evidence that the trade mark application was made in good faith and that even in the unlikely event that use of THE GLENMOY is not seen to be use of the registered trade mark GLENMOY, the mark is not vulnerable to revocation, on the ground of non-use, until 7 July 2000.

30 Next Mr Pacitti makes observations about the similarity between the trade marks GLENMOY and GLENMORAY. I note that Mr Pacitti refers to "GLENMORAY" as one word, whereas in fact the registration referred to in the pleadings, No 1059369 stands as two words, GLEN MORAY. Mr Jenkins' declaration also relates to the similarity of these two trade marks and the main observations emerging from them both are as follows:

35 S GLEN is commonly used in the whisky trade and to support this Mr Pacitti exhibits at PPP2 a list of marks incorporating the word GLEN, in Class 33, from the Marquesa Trade Mark Search System.

40 S Consumers of whisky are discerning and well used to distinguishing between brands sharing the common element GLEN. No proprietor has a monopoly in the word GLEN.

S It is common practice that when many registered marks share a common feature, this feature may be discounted when comparing the marks.

45 S Thus the words to be compared are MOY and MORAY. MOY is a village in Inverness on the west side of Loch Moy. MORAY is an administrative district of the Grampian region. The fact that these words both operate as place names in the same area without confusion means that they are demonstrably conceptually different.

5 S The words MOY and MORAY are each comparatively short, and thus every letter of each assumes a deal of significance. The words are visually, conceptually and phonetically dissimilar. MORAY is pronounced "Murray" a sound indisputably different from MOY.

Applicants' evidence in reply (Rule 13(7))

10 This consists of a statutory declaration dated 6 April 1999 by Mr Alan McBray. Mr McBray states that he is a trade mark agent employed by Trade Mark Owners Association and that, in this capacity, he acts for Macdonald & Muir Limited. He states that he is authorised to make this declaration and that he is familiar with all correspondence and evidence relating to this matter.

15 In response to paragraph 3 of Mr Pacitti's declaration Mr McBray states that the addition of the definite article does have the affect of altering the distinctive character of the mark, and cannot therefore be accepted as use of the registered trade mark. To support this Mr McBray refers to Exhibit CTB 1 pages 78-81 of Ms Bonella's declaration.

20 Mr McBray next acknowledges that the word GLEN is commonly used in connection with whisky brands but disagrees with Mr Pacitti that this is the only similarity between the two marks. He states that there is a great deal of similarity between the words GLENMOY and GLENMORAY, both phonetically and visually, which could lead to confusion in choice of brands by the consumer. Once again I note that Mr McBray refers to "GLENMORAY" as one word, whereas in fact the registration referred to in the pleadings, No 1059369 stands as two words, GLEN MORAY.

30 In response to paragraph 8 of Mr Pacitti's declaration Mr McBray states that the fact both MOY and MORAY are geographical locations in the North of Scotland would tend to strengthen the possibility of confusion rather than lessen it and that customers with only a limited knowledge of the geography of the North of Scotland could not be expected readily to differentiate between MOY and MORAY. He also states that the fact that the words MOY and MORAY are each comparatively short words would serve to strengthen, rather than
35 lessen, the possibility of confusion. He acknowledges that the words do have some visual differences, but he states that he feels these are likely to be lessened by the presentation of the goods for sale and he uses an example of subdued, discreet and subtle lighting used in Off Licences.

40 Finally, Mr McBray states the words MORAY and MOY are phonetically similar, and denies that the word MORAY is always pronounced MURRAY.

45 That concludes my review of the evidence.

DECISION

SECTION 47(1) HAVING REGARD TO SECTION 3(6)

Section 47 (1) of the Act states:

47. - (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

Section 3(6) of the Act reads as follows:

3.- (6)A trade mark shall not be registered if or to the extent that the application is made in bad faith.

Although the burden of proof is on them, the applicants for the declaration for invalidity adduce no evidence to support this particular pleaded ground. In the absence of such evidence, I can normally do no more than dismiss it. However, in this case the registered proprietors have addressed this issue directly in the statutory declaration of Mr Pierpaolo Pacitti at paragraph 4 and his exhibit PPP1. This refers to and exhibits a copy of a letter dated 19 July 1994 from Murgitroyd & Company to Brodie Crawford and Company Limited (the then registered proprietors) recommending they file an application for the mark GLENMOY (solus), as they intend to use it as “a main brand name” and as their application for the label device of THE GLENMOY had just been accepted by the Trade Marks Registry. This seems, in the absence of any evidence or argument to the contrary, to adequately address the issue of bad faith and intention to use. The Section 3(6) ground consequently fails.

SECTION 47(2)(a) HAVING REGARD TO SECTION 5(2) (b)

Section 47(2)(a) of the Act reads as follows:

47.- (2) The registration of a trade mark may be declared invalid on the ground-(
a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or
(b)-----

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

Section 5(2)(b) of the Act reads:

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

(a) -----

10 (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,

15 there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

15 The two marks in question in this case are:

20 1579872 - GLENMOY- - the subject mark against which the application for invalidity is made - registered in Class 33 for “Wines, spirits, liqueurs; all included in Class 33”, and

 1059369 - GLEN MORAY - the earlier pleaded trade mark under Section 5(2)(b)of the Act - registered in Class 33 for “Scotch whisky”.

25 There are assertions in the evidence from both parties about how the marks in question should be viewed and compared. I approach the matter taking account of the following guidance from the European Court of Justice (ECJ) in *Sabel BV, Puma AG (1998 RPC 199 at 224)*, *Canon v MGM (1999 ETMR 1)*, *Lloyd Schufabrik Meyer & Co GmbH v Klijsen Handel BV (1999 ETMR 690 at 698)* and *Marca Mode CV v Addidas AG & Others (2000 ETMR 723)*:

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

35 b) the matter must be judged through the eyes of the average consumer, of the goods/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 the marks and must instead rely upon the imperfect picture of them he has kept in his mind;

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

45

5 d) the visual, aural and conceptual similarities of the mark must therefore be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive components;

e) a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa;

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

15 g) mere association, in the strict sense that the later mark simply brings the earlier mark to mind, is not sufficient for the purposes of Section 5(2);

20 h) further, 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;

25 i) but if the association between the marks results in a likelihood that the average consumer will wrongly believe that the respective goods come from the same economically linked undertakings, there is a likelihood of confusion within the meaning of the Section.

30 With this in mind, I should say at the outset that there is no argument between the parties that the goods in question are for the purposes of comparison here, identical, so the matter rests on a comparison of the marks. Submissions are made by both parties on the significance of three particular elements in this comparison:

The significance of the word “The”.

35 The first is the use in the Scotch whisky trade of the word “The” (ie the definite article). I have summarised these submissions in my review of the evidence above for the sake of completeness, but to all intents and purposes the submissions on this issue are irrelevant in these proceedings. The word “The” does not appear in either of the marks in suit, so cannot be a factor. It seems the submissions are based on the premise that there is/is not a significant
40 difference in the way the mark is ostensibly being *used* compared to the form in which it is *registered*. This may or may not be the case, but it is not a factor I need consider in these proceedings for a declaration of invalidity under Section 47(1) & (2) of the Act. The arguments stem from the type of variant use envisaged by Section 46(2) of the Act, but that is in relation to an action for revocation, not invalidity. I do not intend to comment on them as a
45 purely academic exercise here.

The significance of the shared GLEN elements

5 That leaves the second element in the marks on which both parties have made submissions,
that is the shared GLEN elements in both marks. The applicants for the declaration of
invalidity do not comment on this in the evidence of Ms Bonella, but the statutory declaration
of Mr McBray acknowledges that GLEN is common in the trade, a point originally made by
both Mr Pacitti and Mr Jenkins for the registered proprietors. To support his view Mr Pacitti
10 produces an exhibit PPP2. The exhibit refers to state of the register evidence to show that the
GLEN element is common in this Class of goods. However, it is well settled that this sort of
evidence is in principle irrelevant and I take no account of it here.

15 However, having accepted that GLEN is commonly used in the industry, I have then to
address the question of whether this fact is indeed significant in the comparison of the marks
GLENMOY and GLEN MORAY and important in the context of arriving at a conclusion as
to the likelihood of confusion between them. The submissions from the registered proprietors
representatives Mr Pacitti and Mr Jenkins seek to persuade me that it is indeed important to
the issue of confusion and it is suggested I should ignore the GLEN element, given that it is
20 common in the trade and consumers are therefore used to encountering it and distinguishing
between brands containing it. Interestingly Mr McBray on behalf of the applicants for the
declaration of invalidity largely concurs with this view. Both parties concentrate instead on
comparing the remaining elements of the marks ie MOY with MORAY. I think this is the
wrong approach.

25 It can be seen from the tests I have outlined above that while looking at matters in the round, I
should do a whole mark comparison. Clearly both marks share the GLEN element and it must
therefore be a factor in my considerations. I have already found that it is a common element in
the Scotch whisky industry, by which I mean both the producers and purchasers of the product
are used to encountering it, but that does not lead me to conclude that I should dismiss it in
30 any assessment of the likelihood of confusion. To do that is to artificially impose a dissection
of the marks which I certainly do not believe the average consumer would make and then to
make an assumption that having artificially broken up the mark, part of it is to be ignored
entirely. This must be wrong.

35 **The MOY/MORAY elements**

40 The third element on which both parties make submissions is the remaining (if one ignores the
GLEN elements) MOY/MORAY features. Both parties make submissions on the similarity or
otherwise of these elements when compared with each other. Not surprisingly, they reach
different conclusions. For the reasons I have already given, I think this is an artificial dissection
of the marks and is not the correct application of the global tests for the comparison of the
marks in suit. I therefore do not propose to comment on these elements per se. However,
45 comparing the marks in totality will inevitably in turn require me to consider the submissions
made on those elements.

In the tests outlined above, one of the important considerations is a comparison of the visual, aural and conceptual similarities of the marks. I think there must be said to be a certain visual similarity because of the shared GLEN element, particularly as it is the first element in both marks. However, GLEN is a separate integer in one mark (the GLEN MORAY mark of the applicants) whereas it is an integral part of the GLENMOY mark of the registered proprietors. I find that an important consideration in this instance for goods which very often can be purchased by direct reference to the product (labelling) on shelves in supermarkets, off-licences, wine merchants etc. or even via mail order or electronic means, where one by necessity makes a visual selection. Although that selection may not be direct comparison of these marks, I think the visual impression left by the one word mark, even accounting for imperfect recollection, is usually going to be sufficiently different to render it unlikely to be confused with the two word mark. Of course in arriving at this view I have accounted for the impression left by the MORAY and MOY elements in the way they juxtapose with the GLEN feature and I find that overall, the marks are not visually confusing.

The visual arrangement of the marks is of course not significant in an aural comparison of the marks. I think here it is difficult to judge quite how the marks will be pronounced and heard, particularly the GLEN MORAY mark, over which both parties disagree on pronunciation. My view is that there is a *possibility* that the marks may be mis-pronounced and mis-heard (over the telephone for example), but that it is not *likely*. There is after all a different syllabic construction (two versus three), which I think in marks of this overall length (or lack of it) must be significant. Whether MORAY is pronounced “Murray” (as suggested by Mr Jenkins) or in other possible ways (and I do not think that these can be too numerous), I still feel all possibilities would be sufficiently removed from the pronunciation of MOY (which surely has only one possible way of being pronounced) to make them readily distinguishable, when combined with the GLEN elements.

On the conceptual consideration, I think it is unlikely that beyond a few potential consumers who may know of the geographical nature of the MOY/MORAY elements, that anything in the marks beyond the commonly encountered prefix GLEN would play a significant part in their consciousness. Even here, given that the GLEN element would seem to be semi-descriptive, or at least quasi-evocative of Scottish origin and thereby somewhat lacking in distinctive character for these goods, I cannot see that the conceptual similarity would be a major factor leading to a likelihood of confusion. Certainly it would not be a sufficiently strong criterion to override my findings on the visual and aural aspects.

For completeness, I should also consider the potential purchasing environments of these products. Mr McBray seeks to suggest that Off Licence sales conditions could lead to confusion, but of course in this day and age this method of buying whisky is not all that is available to the consumer, even if I accepted the “subdued, discreet and subtle lighting” as being a true representation of the said environment (which I do not in all cases). As mentioned above, buying the product from supermarkets, via electronic media or through mail order, for example, are commonly used means. In all cases, although perhaps weighted somewhat differently in different environments, in relation to the relative importance of the visual, aural and conceptual factors discussed above, I think confusion of the public to be unlikely to arise.

I would hesitate to rule out entirely that in differing purchasing environments, a customer for example viewing labels from a distance, might be mistakenly drawn to the wrong mark . Or that in certain circumstances, the marks might be mis-heard or imperfectly recalled. However, I see this type of potential confusion as mere *possibilities* in unusual or extreme circumstances, rather than the *likelihood* of confusion called for by the statute. Given that the average consumer is said to be at least reasonably well informed, circumspect and observant (and I think this is very likely the case with the goods in suit where consumers tend to favour certain brands or types of whisky) I think any confusion might be ephemeral and unlikely to survive the normal purchasing process, where rather closer attention is likely to be paid to the brand name.

All of the considerations and the conclusions that I draw from them have, of course, been based on the evidence before me. No evidence was adduced from the applicants for the declaration of invalidity to show that the mark GLEN MORAY had been used by the date of the application for registration (of the mark GLENMOY) to the extent that its inherent distinctive character had been significantly enhanced thereby increasing the likelihood of confusion. In all the circumstances then and in short, I do not consider there will be a likelihood of confusion between the marks GLENMOY and GLEN MORAY for Scotch whisky under the terms of section 5(2) of the Act and consequently the challenge under section 47(2)(a) also fails.

CONCLUSION

Section 72 of the Act reads as follows:

72.- In all legal proceedings relating to a registered trade mark (including proceedings for rectification of the register) the registration of a person as proprietor of a trade mark shall be prima facie evidence of the validity of the original registration and of any subsequent assignment or other transmission of it.

Because registration is prima facie evidence of validity, the onus is therefore on the applicant for the declaration of invalidity to show that the registration was wrongly made. For the reasons set out in this decision, I am not persuaded that that onus has been discharged. The application for a declaration of invalidity consequently has failed on all grounds.

As the registered proprietors have been successful, they are entitled to a contribution towards their costs. I direct that the applicants for the declaration of invalidity pay the registered proprietors the sum of £435.00 . This sum to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 20 day of December 2000

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**Glenn Rose' Meyer
For the Registrar
the Comptroller-General**

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