

O-631-20

**TRADE MARK ACT 1994
IN THE MATTER OF
APPLICATION NUMBER: 3459060
BY MICHAEL MACKENZIE
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33:**

INBHIR NIS

Background

1. On 17 January 2020, Mr Michael MacKenzie ('the applicant') applied to register the above trade mark for the following goods:

Class 33 :Whisky; Malt whisky; Scotch whisky; Whiskey [whisky].

2. On 22 January 2020, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained objections under Section 3(1)(b) and 3(3) (b) of the Trade Marks Act 1994 ('the Act'). The letter read as follows:

"Absolute grounds for refusal

Section 3(1)(b) and (c)

The application is not acceptable in Class 33. There is an objection under Section 3(1)(b) and (c) of the Act. This is because the mark consists exclusively of a sign which may serve in trade to designate the geographical origin of the goods e.g. Inbhir Nis is the Scottish Gaelic name for Inverness.

Absent any unique or distinctive element the average consumer is only going to perceive the sign as an indication that the whisky emanates from Inbhir Nis/Inverness rather than a badge of trade origin capable of distinguishing your whisky from those provided by other undertakings.

Section 3(3)(b)

The application is not acceptable in Class 33 as there is an objection under Section 3(3)(b) of the Act. This is because Inbhir Nis is the Scottish Gaelic name for Inverness and so the mark indicates that the whisky is from Scotland.

Scotland has a reputation in relation to whisky and the average consumer would be deceived if the whisky was not produced in Scotland.

Overcome Objection in relation to Section 3(3)(b)

The objection relating to Section 3(3)(b) can be overcome by adding the following limitation (please note that this will not overcome the Section 3(1)(b) and (c) objection);

Whisky;Malt whisky;Scotch whisky;Whiskey [whisky]; but in so far as whisky is concerned, only Scotch whisky produced in Scotland."

3.The Section 3(1) (b) and (c) objection was thus raised on the basis that the mark was devoid of any distinctive character, as the words 'Inbhir nis' would simply be seen as the

Scottish Gaelic term for 'Inverness', being a geographical place name which could indicate e.g. the geographical origin of the goods.

4. The Section 3(3)(b) objection was raised because the mark would be perceived as indicating the goods were from Scotland. Scotland has a reputation for whisky and whisky based drinks having a certain quality and the average consumer would be deceived if the whisky was not produced in Scotland.

5. A request for a hearing was filed by Mr MacKenzie. At the hearing, which was held on 3 March 2020, this application was considered at the same time as 3459052, 'Inverness', which is the subject of a separate decision issued under reference BL O/545/20.

6. At the hearing Mr MacKenzie explained he was the third generation of his family to be involved in the Scotch whisky industry as a distiller. He was born and raised in Inverness and he had been involved with distilling since 1983. He intended to bring a new blended single malt whisky to market under this brand. The product is blended from whisky distilled in the Inverness and Inverness shire area and is bottled in Inverness. He was aware of the geographical significance of the name, but other Scottish place names had been registered, such as Tobermory and Oban. He has previously applied for 'Old Inverness' which had been published in the Trade Marks Journal but had been withdrawn following publication because of a threatened opposition by an earlier rights holder. The earlier rights holder had indicated they would not oppose an application for 'Inverness' solus.

7. In my hearing report and decision dated 3 March 2020, I maintained the objections under Sections 3(1)(b) and (c) and 3(3)(b) on the following basis:

"I explained that I was not aware of the circumstances surrounding the acceptance of previous geographical names such as Tobermory or Oban. Where the geographical place name has a reputation for the goods claimed in the specification as is the case in this application, then an objection is appropriate. This is because Inbhir Nis is the Scottish Gaelic name for Inverness and Gaelic words are treated the same as the equivalent English word when they are being considered under the Trade Marks Act.

Inbhir Nis/ Inverness has a population of 70,000 and is the capital of the Highland region of Scotland. Scotland has a significant reputation for Scotch whisky and with a number of distilleries in the Inverness area there is a need to keep the name Inbhir Nis/Inverness free for other traders to legitimately use in the course of trade as an indication of the origin of their goods. The acceptance of his previous mark 'Old Inverness' was because it contained a representation of Inverness Castle which added the necessary 'spark' of distinctive character to the mark as a whole.

Section 3(1) of the Trade Marks Act specifically excludes the acceptance of marks consisting exclusively of geographical names when the locality has a reputation for those goods. The only way to overcome such an objection would be to prove that the trade mark has acquired a distinctive character through the use

made of it over a number of years. I understood that the mark has not yet been used, so this is something that may be considered in the future. The refusal of this application does not prevent the use of the mark as an unregistered trade mark, but consideration should be given to adding a distinctive logo to the word if you wish to protect the brand while a reputation is built up.

The objection to the mark in this application must be maintained for the reasons given above, but should you wish to consider filing a fresh application you must consider whether the sign, as a whole, will identify the trade source of the goods to the average consumer. For example, the sign 'Asda Baked Beans' contains the descriptive element 'baked beans' but consumers will be aware of who is providing the goods because of the word 'Asda' appearing in the mark."

8. I should add that, as far as the objection under section 3(3)(b) was concerned, as with the co-pending application, 3459052, Mr MacKenzie agreed to add the limitation to the specification to overcome that objection as his goods were genuine Scotch whisky, produced in Scotland. I will therefore say no more about this objection, assuming the offer of a limitation, on the same lines as 3459052 would have overcome it, had the application not faced a terminal objection under section 3(1)(c) and (b).

9. The mark has not been used prior to the date of filing and Mr MacKenzie would not be able to demonstrate acquired distinctiveness through use. As the objection was maintained in the *prima facie* case the application was formally refused at the same time as the issue of my hearing report.

10. Mr McKenzie then filed a Form TM5 for a full statement of grounds which, although there was some question about when it was received by the IPO and the fee paid these have been resolved in the applicant's favour. I am required, then, under Section 76 of the Act and Rule 69 of the Trade Marks Rules 2008, to state in full the grounds of my decision and the material used in arriving at it. I might add that a Form TM55 was also filed at the same time, but this was premature as an appeal is not generally possible until the full statement of grounds has been sent to the applicant.

11. I will now give my reasons in full as to why I refused the application.

Decision

12. The relevant parts of Section 3 of the Act read as follows:

"3.-(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The relevant legal principles – Section 3(1) (c)

13. There are a number of judgments of the Court of Justice of the European Union (“CJEU”) which deal with the scope of Article 3(1)(c) of the Directive and Article 7(1)(c) of the Regulation, whose provisions correspond to Section 3(1)(c) of the UK Act. I derive the following main guiding principles from the cases noted below:

- Subject to any claim in relation to acquired distinctive character, signs and indications which may serve in trade to designate the characteristics of goods or services are deemed incapable of fulfilling the indication of origin function of a trade mark (*Wm Wrigley Jr & Company v OHIM, C-191/01P ‘Doublemint’, paragraph 30*);
- Article 7(1)(c) (section 3(1)(c)) pursues an aim which is in the public interest that descriptive signs or indications may be freely used by all (*Doublemint, paragraph 31*);
- It is not necessary that such a sign be in use at the time of application in a way that is descriptive of the goods and services in question; it is sufficient that it could be used for such purposes (*Doublemint, paragraph 32*);
- It is irrelevant whether there are other, more usual signs or indications designating the same characteristics of the goods and services. The word ‘exclusively’ in paragraph (c) is not intended to be interpreted as meaning that the sign or indication should be the only way of designating the characteristic(s) in question (*Koninklijke KPN Nederland NV v Benelux Merkenbureau, C-363/99 ‘Postkantoor, paragraph 57*);
- When determining whether a sign is devoid of distinctive character or is descriptive of the goods or services in respect of which registration is sought, it is necessary to take into account the perception of the relevant consumer who is reasonably well-informed and reasonably observant and circumspect (*Matratzen Concord AG v Hukla Germany SA, C-421/04*);
- There must be a sufficiently direct and specific relationship between the sign and the goods in question to enable the relevant consumer immediately to perceive, without further thought, a description of the category of goods and services in question or one of their characteristics (*Ford Motor Co v OHIM, T-67/07*);

14. I am also aware that the test is one of immediacy or first impression, as confirmed by the General Court which, in its decision on *Sykes Enterprises v OHIM (Real People Real Solutions)*, [2002], ECT II-5179, stated:

“...a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods and services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods and services of the owner of the mark from those of a different commercial origin.”

15. In respect, specifically, of geographical names, it is crucial also to recognise the principles laid down in the *Windsurfing* (Joined cases C 108/97 and C 109/97 of the Court of Justice of the European Union) case as below:

“26 As regards, more particularly, signs or indications which may serve to designate the geographical origin of the categories of goods in relation to which registration of the mark is applied for, especially geographical names, it is in the public interest that they remain available, not least because they may be an indication of the quality and other characteristics of the categories of goods concerned, and may also, in various ways, influence consumer tastes by, for instance, associating the goods with a place that may give rise to a favourable response.

27 The public interest underlying the provision which the national court has asked the Court to interpret is also evident in the fact that it is open to the Member States, under Article 15(2) of the Directive, to provide, by way of derogation from Article 3(1)(c), that signs or indications which may serve to designate the geographical origin of the goods may constitute collective marks.

28. In addition, Article 6(1)(b) of the Directive, to which the national court refers in its questions, does not run counter to what has been stated as to the objective of Article 3(1)(c), nor does it have a decisive bearing on the interpretation of that provision. Indeed, Article 6(1)(b), which aims, *inter alia*, to resolve the problems posed by registration of a mark consisting wholly or partly of a geographical name, does not confer on third parties the right to use the name as a trade mark but merely guarantees their right to use it descriptively, that is to say, as an indication of geographical origin, provided that it is used in accordance with honest practices in industrial and commercial matters.

29. Article 3(1)(c) of the Directive is not confined to prohibiting the registration of geographical names as trade marks solely where they designate specified geographical locations which are already famous, or are known for the category of goods concerned, and which are therefore associated with those goods in the mind of the relevant class of persons, that is to say in the trade and amongst average consumers of that category of goods in the territory in respect of which registration is applied for.

30. Indeed, it is clear from the actual wording of Article 3(1)(c), which refers to '... indications which may serve ... to designate ... geographical origin', that geographical names which are liable to be used by undertakings must remain available to such undertakings as indications of the geographical origin of the category of goods concerned.

31. Thus, under Article 3(1)(c) of the Directive, the competent authority must assess whether a geographical name in respect of which application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32. In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regard must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons — or at least unknown as the designation of a geographical location — or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.”

Application of the legal principles

The place name in English - Inverness

16. I would firstly like to consider the application of the principles in relation to the place name, in English, 'Inverness'. Secondly I will give detailed consideration to the place name rendered in Scottish Gaelic, 'Inbhir Nis'. I do not believe the applicant to deny that the words 'Inbhir Nis' are Scottish Gaelic for 'Inverness', notwithstanding that the spelling is rendered 'Inbir Nis' sometimes. The precise meaning of the words in English, as I understand it, is 'Mouth of the River Ness'.

17. Firstly, as regards the place name 'Inverness', the key issues were largely covered in my earlier decision referred to above. I should recall however that the precise mark applied, as a result of an error by the applicant, was the misspelling, 'Invernes'. In my decision I wrote as follows:

“18. Scotland has a well-known reputation for the distillation of Scotch whisky and Scotch whisky is a term protected as Geographical Indication. Inverness is also known as a place where a number of distilleries are based and there is a need to keep the term free for use by other traders to describe the place of production of their goods. It is acknowledged that the mark Invernes is not the geographical name Inverness but it is likely to be taken as being the name when used aurally to request the goods. Visually I consider that the average consumer would perceive the sign as nothing more than a readily comprehensible non-distinctive sign indicating the

goods are produced in Scotland. The mark would not perform the role of a trade mark to identify the goods as originating from a particular undertaking and thus distinguish the goods from those of other undertaking.

19. In essence, the objection was based upon the fact that the term 'Invernes' could be taken to denote the geographical origin or some other plausible characteristic of the goods. Such would serve to constitute a characteristic for the purposes of section 3(1)(c) of the Act. It should be noted that the legal test is whether a mark could constitute a characteristic of the goods and not whether it does in fact, or whether it can be proven that there are others using the term descriptively at the time the application was filed."

20. I should add at this point that in light in particular of the misspelling of the word 'Inverness', an objection was taken under section 3(1)(b) rather than (c). In this case, the objection is under section 3(1)(c), and only under (b) as a consequence of the objection under (c). In other words, (b) and (c) are co-extensive and I will give no separate or contingent finding under section 3(1)(b). There is, in fact, some well-developed case law (*Windsurfing*) regarding geographical names where the objection is taken under section 3(1)(c), and I should refer myself to that case law, as referred to above (*Windsurfing*). Although the objection was taken under (b) in relation to 'Invernes' I think it is clear that the underlying rationale was, in effect, having regard to the word designating a characteristic of the goods.

21. The town of Inverness in Scotland is well known throughout the UK. Scotland, in turn, has a strong association with whisky. It is not hard to conclude, then, that the conditions for an 'association' (as 'Windsurfing' calls it) between the place name and the goods would be immediately apparent and obvious.

22. I should stress at this stage that the 'association' must be made by the relevant consumer of the goods or services and I need to identify that consumer in this case as the general public. Such a consumer, though they may be familiar with whisky, to a lesser or greater degree, will be reasonably circumspect in their purchase of the goods and nothing hinges for me in relation to the particular characteristics of the relevant consumer or nature of the purchase.

23. There is no doubt for me, then, that had the mark been 'Inverness' for the goods specified, it would have been rightly refused under section 3(1)(c) and (b) of the Act. In this case I have not overlooked the fact that there may well be consumers, who, even if they do not speak Gaelic, will recognise 'Inbhir Nis', from a purely linguistic perspective as the town of Inverness. That said, for many it may not be immediately apparent, especially given the visual look of the words and the phonetic sound (especially with a 'bh' rather than a 'v'). For that reason, I need to consider the situation as regards the Scottish Gaelic equivalent place name and on the assumption that the words may not be recognised.

Scottish Gaelic Place Name: public policy and public interest

24. In my hearing report I quoted from the Examination Guide in relation to 'Non-English Words'. The text of the relevant guidance reads as follows:

"Non-English words

Trade marks may consist of words in languages other than English. Where marks contain Welsh or Gaelic words they will be treated in the same way as trade marks consisting of the equivalent English words for the purposes of section 3(1). Where marks contain words from languages other than those mentioned above the following will be considered.

There are no grounds for refusing registration of trade marks on the basis that they are descriptive or non-distinctive in a language which is unlikely to be understood by the relevant trade in the UK or by the relevant average UK consumer of the goods/services in question. In contrast, non-English word marks which are likely to be recognised as a description of a characteristic of the goods or services (or otherwise be descriptive of the goods/services) in the application will be objectionable.”

25. The first thing to mention about this guidance is that it is just that, ‘guidance’. Specifically, and unlike the legal principles to which I have referred earlier, enshrined in *Windsurfing*, it does not have the force of legal precedence behind it. That is why I have chosen to refer to it at this point, rather than as a legal principle set out above. There is an important distinction in this case and a consequent need to look behind the guidance as to the underlying rationale and how that might apply in this particular case.

26. As the registrar’s published guidance, all that is being said is that, in relation to the examination of trade marks, the registrar will treat marks containing Welsh or Gaelic in the same way as trade marks consisting of the equivalent English words, for the purposes of Section 3(1). That guidance has effect, notwithstanding that the two languages, Welsh and Gaelic (including Scottish Gaelic, of course), are not necessarily treated or protected in the same way, or to the same degree under the law relating to minority languages or general public policy.

27. The way that these two minority, indigenous languages – Welsh and Gaelic - are treated under the law is, in my opinion, an important foundational consideration in this case. The reason for this is that there is case law to suggest that, as far as non-English words are concerned, what matters (and all, in effect, that matters) is that the relevant consumer (or vast majority of them) will, or will not understand the language and the words comprising the mark. In brief, this argument runs that if the relevant consumer does not understand the language in the first place it cannot be argued that the particular mark would be seen as designating a particular characteristic under section 3(1)(c). This would assume, as in this case, the goods or services are not pitched at a specific consumer, as in, for example, the Scottish market or Gaelic speakers, in particular. This strand of case law may be found, for example, in the case of BL O/195/15 *Pooja Sweets* at paras 42 and following.

28. Hence there is, on the face of it, some tension between the first and second paragraphs of the examination guidance quoted above and this needs to be examined further. I need to be clear as to the reasons why the registrar considers an indigenous, minority language, spoken in 2011 by only 1.7%¹ of the Scottish population, is given a

¹ Source: Scottish Government see the extract from its website

level of status under the registrar's guidance which may not be accorded other non-English languages.

29. The starting point in my opinion for this analysis is 'The European Charter for Regional and Minority Languages', a Council of Europe treaty measure. I am largely indebted to WIKIPEDIA for the following explanation.

30. This Charter aims to protect and promote historical regional and minority languages in Europe. It provides for many measures that Member States can take in the furtherance of those aims. States may declare that a qualifying language or languages will benefit from a higher level of protection (termed 'Part II' protection), listing a range of actions from which States must agree to undertake at least 35. All States must apply the lower level of protection (termed 'Part III'). To give some context for these two levels of protection, Part II protection includes:

- Recognition of regional or minority languages as an expression of cultural wealth.
- Respect for the geographical area of each regional or minority language.
- The need for resolute action to promote such languages.
- The facilitation and/or encouragement of the use of such languages, in speech and writing, in public and private life.
- The provision of appropriate forms and means for the teaching and study of such languages at all appropriate stages.
- The promotion of relevant transnational exchanges.
- The prohibition of all forms of unjustified distinction, exclusion, restriction or preference relating to the use of a regional or minority language and intended to discourage or endanger its maintenance or development.
- The promotion by states of mutual understanding between all the country's linguistic groups.

31. As far as Part III is concerned, many provisions contain several options, of varying degrees of stringency, which have to be chosen "according to the situation of each language". The areas from which these specific undertakings must be chosen are as follows:

- Education
- Judicial authorities
- Administrative authorities and public services
- Media
- Cultural activities and facilities
- Economic and social life
- Transfrontier exchanges

32. The UK has ratified this Treaty in respect both of Welsh and Scottish Gaelic, and other minority languages. The national laws enacted in the UK in respect of both languages may not reflect the same levels of protection because of the underlying flexibility within the Treaty itself. In the UK the relevant legislation is The Welsh Language Acts of 1967 and 1993. The Act of 1967 gave rise to the concept of 'equal validity' between the Welsh and English languages. As a result, Government Departments began preparing documents in Welsh, and following a campaign of

destroying or vandalising unilingual English road signs by members of Cymdeithas yr Iaith Gymraeg (The Welsh Language Society), local councils were allowed to provide many bilingual signs in Wales. It was, however, the Welsh Language Act 1993 which established that 'in the course of public business and the administration of justice, so far as is reasonably practicable, the Welsh and English languages are to be treated on the basis of equality.

33. Scottish Gaelic, on the other hand, is protected in the UK by The Gaelic Language (Scotland) Act 2005 a measure enacted by the Scottish Government under its devolved powers. As such it is important to recognise that in strict legal terms its provisions do not have effect in other countries of the Union and neither, technically speaking, do they have effect on the registrar in their capacity as a public body based in both England and Wales. That said, it is important to recognise the public policy principles involved.

The Scottish Government provides much of the background and intent behind the Act and this material can be found on its website at:

<https://www.gov.scot/publications/scottish-government-gaelic-language-plan-2016-2021/pages/4/>

I shall be quoting at length below from it.

“Overview

The Gaelic Language (Scotland) Act 2005 was passed by the Scottish Parliament with a view to securing the status of the Gaelic language as an official language of Scotland commanding equal respect to the English language.

This is a critical time for the future of Gaelic. The position of the language is extremely fragile and the declining numbers of those speaking Gaelic fluently threatens the survival of Gaelic as a living language in Scotland. It is essential that steps are taken to create a sustainable future for Gaelic in Scotland.

One of the key features of the 2005 Act is the provision enabling Bòrd na Gàidhlig (the Scottish Government's principal Gaelic development body) to require public bodies to prepare Gaelic Language Plans. This provision was designed to ensure that the public sector in Scotland plays its part in creating a sustainable future for Gaelic by raising its status and profile and creating practical opportunities for its use.

The requirement to prepare a Gaelic Language Plan

The requirement for a public body to prepare a Gaelic Language Plan is initiated by Bòrd na Gàidhlig issuing a formal notice to that effect under section 3 of the 2005 Act. Following our initial notice in 2006, the Scottish Government's Gaelic Language Plan was granted approval by the Bòrd and came in to operation in June 2010.

The planning cycle continues to develop through the review process with organisations expected to maintain current commitments while considering how they

can develop a second iteration of their Plan. This is where the Scottish Government is in this circular development.

Key considerations when preparing a Gaelic Language Plan

The 2005 Act sets out a number of specific criteria which must be taken into account by bodies preparing Gaelic Language Plans. These are designed to ensure that Gaelic Language Plans which are prepared are comprehensive, consistent and appropriate to the particular circumstances of the body preparing it.

(i) the extent to which the persons in relation to whom the authority's functions are exercisable use the Gaelic language, and the potential for developing the use of the Gaelic language in connection with the exercise of those functions.

This consideration is designed to ensure that the Gaelic Language Plans prepared by public bodies take account both of the existing number of speakers within their area of operation, and their potential to develop the use of the language. Generally speaking, the expectation is that public bodies with significant numbers of Gaelic speakers within their area of operation will develop stronger Gaelic Language Plans.

The Scottish Government's area of operation is all of Scotland, and therefore the primary function of this plan is in supporting the National Gaelic Language Plan (see **(iii)**).

(ii) statutory guidance on the preparation of Gaelic Language Plans published by Bòrd na Gàidhlig under section 8 of the 2005 Act Bòrd na Gàidhlig has published statutory guidance under section 8 of the 2005 Act, which provides advice on how Gaelic Language Plans should be structured, and on the content which public authorities should include in their Plans.

(iii) the National Gaelic Language Plan

The National Gaelic Language Plan is a statutory document produced by Bòrd na Gàidhlig under section 2 of the 2005 Act, with the third iteration due to be consulted on and published in 2017. The National Plan offers a holistic overview of Gaelic development needs, covering language acquisition, language usage, language status and language corpus issues. It sets out priorities for Gaelic development, and identifies bodies which are key to achieving them. The Scottish Government has a key role in supporting Bòrd na Gàidhlig with this process, as set out in [Chapter III](#).

(iv) any representations made to the public body preparing its Plan about how it uses Gaelic.

This provision is designed to ensure that public bodies take into account the views of interested parties in the preparation of their Gaelic Language Plans. The principal means of obtaining these views by the Scottish Government is through public consultation on its draft Plan.

(v) the principle of equal respect

The principle of equal respect was incorporated into the 2005 Act by the Scottish Parliament as a positive statement about the value and worth of Gaelic, in recognition of the fact that users of Gaelic aspire to use Gaelic as normally as possible in their lives, that there should be a generosity of spirit towards Gaelic across Scotland, and that the language should not suffer from any lack of respect either at an individual or corporate level.

The Bòrd's guidance states that giving Gaelic equal respect does not automatically mean identical treatment for Gaelic and English, or that a particular level of Gaelic provision must be made available in all circumstances. Instead, it encourages public bodies to endeavour, whatever the particular linguistic landscape they face, to be supportive and generous to Gaelic development and to prepare their Gaelic Language Plans with a view to facilitating the use of Gaelic to the greatest extent that is appropriate to their individual circumstances.

When delivering services in Gaelic, we will ensure they are of an equal standard and quality as those they provide in English. [my emphasis]

.....

National Demographics - Number of Gaelic Speakers

Results from the 2011 Census have shown that the decline in the number of Gaelic speakers has slowed since 2001. The total number of people recorded as being able to speak and/or read and/or understand Gaelic was 87,056. Of these 58,000 people (1.1% of the population) aged three and over in Scotland were able to speak Gaelic. This is a slight fall from 59,000 (1.2% of the population) in the 2001 Census which compares favourably to the previous Census results which recorded an 11% drop in speakers.

In 2011, the proportion of the population aged three and over in Scotland who could speak, read, write or understand Gaelic was 1.7% (87,056), compared with 1.9% (92,000) in 2001. Within this group, the number of people who could speak, read, understand and write Gaelic in 2011 was 32,000, 0.6% of the population aged three and over; this was the same proportion as in 2001.

While there was a decrease in the proportion of people able to speak Gaelic in most age groups there was an increase in those groups aged under 20 years. In total, there was a 0.1 percentage point increase in Gaelic speakers between 2001 and 2011 for the 3-19 age range.

Gaelic speakers are spread throughout Scotland. Of those who identified themselves as Gaelic speakers in the 2011 Census the council areas with the highest proportions able to speak Gaelic were found to be in Na h-Eileanan Siar (52%), Highland (5%) and Argyll & Bute (4%). There is also a high degree of urbanisation within the Gaelic speaking community with large numbers of Gaelic speakers living in Aberdeen, Edinburgh, Greater Glasgow and Inverness.”

34. It is clear to me that the part I have emphasised expresses how the legal protection afforded the Scottish Gaelic language differs in an essential respect from that afforded the Welsh Language in The Welsh Language Act. Whilst the Welsh language has ‘equal validity’ with English, Scottish Gaelic has only ‘equal respect’; the two statuses are plainly not the same, and were purposely not intended to be the same, in strict legal terms. That said, this should not fetter the policy or ability to apply equivalence in terms of section 3 of the Trade Marks Act 1994, adopted by the registrar. In public policy terms, in my opinion this is the registrar’s way of showing respect to the language and in accordance with the wishes of the Scottish Government. But I need to be very clear that this application is not being refused because, in purely public policy terms, the registrar is simply showing respect to the Scottish Gaelic language. It is, though, true that the public policy of protecting and sustaining the minority language in law, necessarily impacts upon and underpins the ‘need to keep free for others to use’, which is the (public interest) basis of an objection under section 3(1)(c) of the Act. I need to clarify this a little further.

35. It is not the case that the registrar is deeming or prescribing the application to be open the objection on the sole basis that it is a descriptive word in a minority, protected language. If that were the case, arguably there would have been an alternative objection based upon public policy under section 3(3)(a) of the Act. The basis of the objection to this application is not, then, ‘public policy’ per se, however laudable that may be.

36. The registrar is not saying, for example, that the registration of a trade mark of a descriptive term in Scottish Gaelic amounts to any ‘disrespect’ for the language, in the sense that it may hamper the dissemination or promotion of the language by conferring a monopoly of a particular word on a single undertaking. This is a common misconception of the public that such monopolies are being conferred; trade marks only apply within the realm of a trading context, and then, in respect only of the goods and services specified. They are not monopolies as such.

37. Furthermore, the registrar is not prescribing or deeming that all potentially descriptive words in a protected minority language and in relation to the specified goods and services must, by definition, result in an objection under section 3(1)(c). Whether there is an objection or not will depend upon the individual circumstances of the case. In this particular case, there are a number of factors which in my opinion arise and coincide.

38. The first of these is that this application is in relation to a place name in Scottish Gaelic. Such a name could well, for example, be the original name given to the particular town and one which for historic and cultural reasons ought especially to be kept free for others to use.

39. It is also an undoubted factor in my decision that, as the Scottish Government states, Inverness represents something of an urban concentration of Scottish Gaelic speakers. I do not believe it is coincidence that it is the home of the Gaelic Language Board, the Bòrd na Gàidhlig. As such, it could I think be reasonably assumed that other traders in the area and throughout Scotland perhaps may wish to use the term in a descriptive fashion in order to support the heritage, culture and uniqueness of the language.

40. It is these unique features in this case which undergird the objection and form its basis. The registrar's stated guidance reflects the fact that the treatment of indigenous and minority languages, protected by UK law, may result in a divergence of treatment with other non-protected 'foreign' languages. The public interest basis of section 3(1)(c) comprises the 'need to keep free' for others to use and where the law gives protection and promotes the use of indigenous, minority languages, now and into the foreseeable future, one can easily understand how that may underpin an objection under section 3(1)(c), in circumstances such as this.

41. The registrar is giving appropriate recognition to the fact that the public authorities in Scotland are under an obligation to promote and sustain the language in everyday life. That is to say that one would expect, for example, bodies like tourist authorities, educational agencies, highway agencies and so forth all to take account of their legal obligations in respect of the language. In Wales, for example, we are used to seeing bi-lingual signage on roads, bi-lingual communications and account being taken of the need to provide bi-lingual public services.

42. All of this, legally required, activity is to sustain and promote the language and one could expect the same or similar in Scotland. It is against that backdrop that the registrar, in this case, says the term should be refused because it could, very plausibly, designate a characteristic of the goods, notwithstanding that very few people speak the language. This is very much in keeping with the principles set out in the *Windsurfing* case, to which I have referred earlier.

43. Finally, and for the sake of completeness, as I mentioned in my hearing report, I noted that Mr MacKenzie referred to registrations of other Scottish place names in his submissions. I would repeat I am not aware of the circumstances surrounding the acceptance of any earlier marks and I am not bound by those earlier decisions. In this respect I refer to the comments of Jacob J in *British Sugar plc v James Robertson & Sons Ltd* [1996] RPC 281:²

"In particular the state of the register does not tell you what is actually happening out in the market and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held that under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. MADAME Trade Mark (1699 RPC 541) and the same must be true of the 1994 Act. I disregard the state of the register evidence."

² See also the reinforcement of those principles in BL O/262/18 BREXIT at paras 10 and following.

In any event I do not find that acceptances of different marks which happen to contain the name of a place in Scotland, to be of any assistance in the progress of this application. I would simply add the marks are not the same, they merely include a geographical element in those marks.

Conclusion

44. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. In this decision I have considered all the documents and arguments submitted in relation to the application. Having done so, and for the reasons given above, the application is refused under Section 3(1)(c) and, as a consequence (b) of the Act for all of the goods applied for in Class 33.

Dated this 15th day of December 2020

Carol Bennett

For the Registrar

Comptroller General