

O/0346/26

TRADE MARKS ACT 1994

IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001726784

DESIGNATING THE UK  
BY INDUSTRIA GROUP, LLC



**MONKEY**  
**HANGER**

IN CLASSES 25, 30 AND 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 443881

BY WILLIAM GRANT & SONS LIMITED

## BACKGROUND AND PLEADINGS

1. International trade mark 1726784 (“the IR”) consists of the sign shown on the cover page of this decision. The holder is Industria Group, LLC. The IR is registered with effect from 29 January 2023. With effect from the same date, the holder designated the UK as a territory in which it seeks to protect the IR under the terms of the Protocol to the Madrid Agreement. The holder seeks protection for the IR in relation to the goods contained in Annex 1.

2. The request to protect the IR was published on 28 July 2023. On 30 October 2023, William Grant & Sons Limited (“the opponent”) partially opposed the protection of the IR in the UK based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), and the opposition is directed against the following goods:<sup>1</sup>

Class 33      Gin; spirits; distilled spirits.

3. Under section 5(2)(b) of the Act, the opponent relies upon the following marks:

# **MONKEY SHOULDER**

Comparable UK trade mark (EU) registration no. UK00904575486

Filing date 29 July 2005; Registration date 21 August 2006.

**(the First Earlier Mark)**

# **SMOKEY MONKEY**

Comparable UK trade mark (EU) registration no. UK00918248107

Filing date 3 June 2020; Registration date 16 September 2020.

**(the Second Earlier Mark)**

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<sup>1</sup>In its Form TM7, the opponent had partially opposed the IR based upon section 5(2)(b), but fully opposed the IR under sections 5(3) and 5(4)(a). However, in its email dated 15 April 2025, the opponent confirmed that the opposition “*is directed solely against Class 33 of the Application in respect of all grounds of Opposition, including Section 5(3) and 5(4)(a) TMA*”. The opponent’s submissions in lieu also only refer to the holder’s class 33 goods.

# GINGER MONKEY

Comparable UK trade mark (EU) registration no. UK00918248114

Filing date 3 June 2020; Registration date 16 September 2020.

## **(the Third Earlier Mark)**

4. I bear in mind that all of the opponent's marks are comparable marks. Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

5. Under section 5(2)(b), the opponent claims that the holder's class 33 goods are identical to all of the goods for which its First, Second and Third Earlier Marks are registered, contained in Annex 2 to this decision. The opponent also claims that there is a likelihood of confusion because of the identity of the goods and the parties' marks are visually, aurally and conceptually similar. The opponent relies upon their family of Monkey Marks, and claims that "as all of the marks share the identical common element 'MONKEY', they of course display characteristics that give grounds for regarding them as forming part of a single family".

6. Under section 5(3), the opponent only relies upon its First Earlier Mark, which they claim to have "acquired a substantial reputation in the United Kingdom and internationally in relation to *whisky*" as a result of its significant promotion and long-term use made of its mark. The opponent claims that due to the high degree of similarity between the parties' marks, "the enhanced level of distinctiveness, the Monkey Family of Marks and the extent of the significant reputation" possessed by its First Earlier Mark, a mental link will be made between the First Earlier Mark and the Holder's IR. The opponent also claims that use of the holder's IR would, without due cause, take unfair advantage of its First Earlier Mark, by free-riding on its distinctiveness and reputation, which could cause detriment to the opponent if the

holder's goods are of inferior quality. The opponent claims that if the holder's IR brings to mind the First Earlier Mark, this is likely to lead to a change in the economic behaviour of the opponent's customers. Lastly, the opponent claims that use of the holder's IR will "dilute the attractive power of the Monkey Family of Marks", and will "have a negative impact on the consumers' recognition of the MONKEY element of the Monkey Family of Marks".

7. Under section 5(4)(a), the opponent relies upon its **MONKEY SHOULDER** sign which it claims to have used throughout the UK since June 2005 for "Whisky". The opponent claims that use of the holder's IR on its class 33 goods would be contrary to the law of passing off.

8. The holder filed a counterstatement denying the claims made, subjecting the First Earlier Mark to proof of use.

9. The opponent is represented by Taylor Wessing International LLP (now named Winston Taylor International LLP) and the holder is represented by McDaniels Law. Both parties filed evidence in chief, and the holder filed submissions during the evidence rounds. Neither party requested a hearing, however, both parties filed submissions in lieu. I make this decision having taken full account of all the papers.

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

## **EVIDENCE**

11. The opponent's evidence consists of the witness statement of Ifan Jenkins dated 17 October 2024. Mr Jenkins is the Global Brand Managing Director for the opponent and his statement is accompanied by 52 exhibits (IJ1-IJ52).

12. The holder's evidence consists of the witness statement of Amelia Pearce dated 20 December 2024. Ms Pearce is the Founder and Managing Director of the holder, a position which she has held since its incorporation on 21 June 2022. Ms Pearce's statement is accompanied by 14 exhibits (1-14).

13. Whilst I do not propose to summarise them here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

## **DECISION**

### **Section 5(2)(b)**

14. Section 5(2)(b) reads as follows:

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

(a)...

(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.”

15. The opponent's First, Second and Third Earlier Marks qualify as earlier marks in accordance with section 6(1)(a) of the Act as their filing dates are earlier than the designation date of the holder's IR.

16. As the opponent's First Earlier Mark completed its registration process more than five years before the designation date of the IR in issue, it is subject to proof of use pursuant to section 6A of the Act.

17. The opponent's Second and Third Earlier Marks completed their registration process less than five years before the designation date of the IR. Accordingly, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used its Second and Third Earlier Marks.<sup>2</sup>

### **Proof of use**

18. I will begin by assessing whether there has been genuine use of the First Earlier Mark. The relevant statutory provisions are as follows:

19. Section 6A of the Act states:

“(1) This section applies where

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed  
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

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<sup>2</sup> This is in relation to the proof of use section. In regard to the opponent's family of marks claim which I shall deal with later in my decision, the opponent will have to show and provide evidence that these marks are present on the UK market.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

20. Pursuant to section 6A of the Act, the relevant period for assessing whether there has been genuine use of the First Earlier Mark is the five years ending on the designation date of the holder’s IR, i.e. 30 January 2018 to 29 January 2023. By virtue of paragraph 7 of Part 1, Schedule 2A of the Act, use within the EU is relevant for the

entirety of the relevant period which falls prior to IP Completion Day (31 December 2020). After that date, only use in the UK will be relevant.

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

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversammlung Kamaradschaft 'Feldmarschall Radetsky'*[2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

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

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

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

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

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

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

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

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

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

### Evidence of use

22. The opponent has filed a significant amount of evidence, including that which falls before the relevant period (to establish a reputation, for example) or which pertains to its other Earlier Marks. I shall therefore focus only on the evidence that pertains to the First Earlier Mark during the proof of use period.

23. Mr Jenkins confirms that the opponent has a list of flagship products which includes its Monkey Shoulder Scotch whisky which was launched in June 2005.<sup>3</sup> Throughout his witness statement, and the evidence, Monkey Shoulder whisky is described as being designed for mixing in cocktails. The opponent’s worldwide sales figures for Monkey Shoulder whisky during the relevant period are as follows:

<b>Year</b>	<b>Gross Sales Value</b>	<b>Volume of 9 Litre Cases</b>
<b>2018</b>	£50,010,993	411,362
<b>2019</b>	£59,704,146	489,832
<b>2020</b>	£59,202,665	453,611
<b>2021</b>	£85,010,352	623,958
<b>2022</b>	£93,870,285	690,575

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<sup>3</sup> Paragraph 20 of his witness statement

24. I have also been provided with the following sales figures during the relevant period for cases and bottles of Monkey Shoulder sold in the UK:

<i>Year</i>	<i>Net Sales Value (£)</i>	<i>Volume of 9 Litre Cases</i>	<i>Bottles sold across the UK</i>
<b>2019</b>	£4,209,675	38,133	457,596
<b>2020</b>	£4,834,828	42,443	509,316
<b>2021</b>	£5,847,058	48,616	583,392
<b>2022</b>	£5,716,682	49,536	594,432

25. Mr Jenkins confirms that the cases within the table above would each contain 12 bottles of whisky. At paragraph 38 of his statement, Mr Jenkins states that “licensed premises (i.e. cafés, bars, clubs, pubs and restaurants) typically sell the whisky to consumers in 25ml measures. As a result, it should be borne in mind that each 75cl bottle sold through such channels equates to 30 separate consumer transactions made by reference to the brand. That means that the 1.7 million bottles referred to above will have involved many millions of consumer transactions by reference to the brand throughout the UK”.

26. Mr Jenkins has also provided the following advertising and promotional spend:

- a) The opponent’s UK advertising spend in 2018 was £1.3 million.
- b) The opponent’s total global spend in 2019 reached over £17 million.
- c) The global advertising spend in 2020 was £12.5 million (lower than previous years due to the Coronavirus pandemic).
- d) The global advertising spend in 2021 was £23.1 million.
- e) The above global figures were not just spent on advertising but covered marketing investments, consumer events and PR, local brand ambassadors (**exhibit IJ37**), and trade events.
- f) The UK advertising spend in 2019 was £1.5 million.
- g) £631,000 was spent on advertising in the UK in 2020 and £421,000 was spent in 2021 (this was again impacted by the Coronavirus pandemic).
- h) Spending on advertising in the UK rose back to over £2 million in 2022.

27. “To promote the brand’s vision” the opponent has hosted numerous Monkey Shoulder branded events across the UK. In 2016, The Scotch Whisky Ambassadors Team, "SWAT", was trialled, where elite bartenders targeted on-trade bars and offered Monkey Shoulder sampling. In 2019, a total of 87 SWATs with 3,573 samples were handed out across Liverpool, Manchester, Edinburgh and Glasgow over three months. “The team would jump out of the van and "storm" the venue with three bartenders taking over the bars for 15-30 minutes, allowing consumers an opportunity to sample the signature Monkey Shoulder cocktails”.<sup>4</sup> This is supported by **exhibit IJ16** which contains a 2019 presentation called the “2019 Event Wrap-Up” which confirms that during the SWAT events, “all customers will be sampled with 50ml of Lazy Old Fashioned”. The presentation also refers to the Monkey Bar Drinks trolley, which “delivers signature serve samples whether it be an office, a bar or in a field”. There were “7 trolley activations” in 2019, with more than 300 samples served. The following photographs of the Monkey Shoulder trolley are shown in the presentation:



28. The 2019 presentation also contains the following “2019 event wrap-up” calendar for Monkey Shoulder, showing when its Trolley, SWAT and Mixer truck events occurred:

MANCHESTER		LIVERPOOL				
MON 15 <sup>th</sup> APRIL	TUE 16 <sup>th</sup> APRIL	WED 17 <sup>th</sup> APRIL	THU 18 <sup>th</sup> APRIL	FRI 19 <sup>th</sup> APRIL	SAT 20 <sup>th</sup> APRIL	SUN 21 <sup>st</sup> APRIL
				OOH PAINTBALLING ROPEWALK SQUARE, OFF BOLD STREET		
	MIXER TRUCK SPINNINGFIELDS, M3 3EB 12:00 – 20:00				MIXER TRUCK THE BALTIC MARKET, L6 5RE 14:00 – 00:00	
	TROLLEY: WEWORK, SPINNINGFIELDS 14:00 – 17:00				TROLLEY: OOH SAMPLING, ROPEWALK SQ. (OFF BOLD STREET) L1 4HY 16:00 – 20:00	S.W.A.T ALMA DE CUBA, L1 4BF 23:00 – 23:30
TROLLEY: REVOLUTION, DEANSGATE 19:30 – 22:20	TROLLEY: REVOLUTION, PARSONAGE GARDENS 19:30 – 22:20	TROLLEY: REVOLUTION, ALBERT DOCK 19:30 – 22:20	TROLLEY: REVOLUTION, ST PETER'S SQUARE 19:30 – 2:20			
	TROLLEY: BE AT ONE 13 BARTON ARCADE, M3 2BB 19:30 – 21:00		TROLLEY: BE AT ONE, 13 BARTON ARCADE L1 4AD 19:30 – 21:00			
	S.W.A.E FOUNDRY PROJECT, M4 1BD 20:00 – 20:30		S.W.A.E SOME PLACE, L1 4AZ 22:00 – 22:30			
	S.W.A.E NIGHT & DAY, M1 1JN 23:00 – 23:30		S.W.A.T ZANZIBAR, L1 4AZ 23:00 – 23:30			

<sup>4</sup> Paragraph 41 of Mr Jenkin’s statement

29. The presentation states that the mixer truck (which is a truck capable of dispensing up to 11 types of drink) was booked for the Spinningfields and Baltic Market, whereby 2,447 samples were distributed. This is confirmed by the Master of Malt article dated 9 April 2019, contained in **exhibit IJ23**. This article confirms that mixer truck was at Manchester's Spinningfields Market on 15 and 16 April 2019 and at Liverpool's Baltic Market on 20 and 21 April 2019. The article also lists that the cocktails on offer included the Lazy Old Fashioned, Monkey Mojito, Ape Spritz and Show me the Monkey. I note that photographs of the mixer truck included within the 2019 presentation are as follows:



30. The 2019 presentation also refers to a venue takeover at Baltic Market where they sold 460 Monkey Shoulder cocktails, and it lists 2 larger events attended by the opponent, including London Cocktail Week and the Edinburgh Fringe. At paragraph 50 of his statement, Mr Jenkins states that the London Cocktail week is “one of the most important drinks festivals in the UK. In 2019 alone, there were 17,000 attendees to The Cocktail Village, 607 consumers sampling across a range of 5 days, 607 sales made of a combination of Monkey Shoulder cocktails and a total sales revenue of £4,230 generated over just a few days”. The opponent attended with its 12-foot, 11,000 litre cocktail mixer truck for its Silent Whisky Tasting,<sup>5</sup> a photo of which is contained in the 2019 presentation and the 2018 articles exhibited in **IJ22**.

31. The opponent also attended the Edinburgh Fringe in 2019, which was reported in the edinburghlive article dated 15 August 2019.<sup>6</sup> This article states that for the whole

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<sup>5</sup> **Exhibit IJ20**, article from allinlondon.com which dates the event as 13 October 2019

<sup>6</sup> **Exhibit IJ22**

of August, Monkey Shoulder Whisky hosted its “Silent Whisky Tasting” disco with its aforementioned mixer truck. The tasting disco is 10 minutes long and the music is paired with 3 Monkey Shoulder cocktails (the Lazy Old Fashioned, Show Me the Monkey and the Ginger Monkey).<sup>7</sup> Mr Jenkins confirms that at the 2019 Edinburgh Fringe, across all 4 weeks, 1,015 customers tried samples, with 3,276 bar sales made in regard to its cocktails which generated over £19,000 of sales.<sup>8</sup> In the presentation contained in **exhibit IJ21**, it lists that the fringe media promoting its Silent Whisky Tasting had a 5 million estimated coverage. In his witness statement, Mr Jenkins also states that 3 million tickets were sold to the Fringe event in 2019, which would have provided “incredible exposure for the brand”.<sup>9</sup>

32. In the Master of Malt article dated 9 April 2019,<sup>10</sup> it states that “Monkey Shoulder, the blended malt whisky made for mixing, is heading to Manchester and Liverpool next week to connect with drinkers”, hosing a “series of high energy bar takeovers, an interactive balloon experience, and refreshing cocktails” served from its mixer truck. The article also reports on the “Monkey Shoulder Breakdown service” which was to be hosted in Manchester on 15 and 16 April, and in Liverpool from 17 to 21 April. This is a service that supports bartenders when closing down the bar. Mr Jenkins confirms that as part of this service, “the team provides lazy Old Fashioned and Boilermaker cocktails, alongside other treats, to the bartenders in the hours of clean-up” which has been a big success with bartenders.<sup>11</sup> In the presentation contained in **exhibit IJ15**, it states that in 2019, they provided this service to 22 bars across Liverpool and Manchester.

33. In **exhibits IJ23** and **IJ39**, I have been provided with 2 articles dated 19 July 2019 reporting on a Monkey Shoulder Scottish Bar Tour. The Scottish Licensed Trade News article contained in **exhibit IJ39** states that the opponent is holding a “services of in bar-events”, “over 60 bars in Glasgow and Edinburgh”, “to promote its Monkey Shoulder whisky brand”. The scottishfield.com article contained in **exhibit IJ23** states that the “tour was set to run from “Wednesday 24 July to Saturday 27 July”. Both of

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<sup>7</sup> **Exhibit IJ22**, the LIST article

<sup>8</sup> Paragraph 54

<sup>9</sup> Paragraph 52

<sup>10</sup> **Exhibit IJ23**

<sup>11</sup> Paragraph 53

the articles also refer to the “newly launched Monkey Shoulder Breakdown Service”, the SWAT team, and the Monkey Shoulder drinks trolley which was set to hand out free cocktails in 3 Edinburgh venues on 25 and 27 July 2019.

34. In 2021, the opponent again attended the London Cocktail Week, where they served 260 cocktails, all of which were made using Monkey Shoulder Whisky.<sup>12</sup> This is shown by the following cocktail list contained within the 2021 Activations Wrap Up Report in **exhibit IJ19**:



35. The 2021 London Cocktail week was advertised in a campaignlive.co.uk article, contained in **exhibit IJ44**. It states that Monkey Shoulder was to set up a bar in Shoreditch on 21 October, where it was hosting its “silent disco fused with a whisky tasting”, where drinkers would get to taste 3 different Monkey Shoulder cocktails. The silent disco hosted on 21 October 2021 was also advertised in a london-tv.co.uk article dated September 2021, also contained in **exhibit IJ44**.

36. Mr Jenkins states that in his view, the opponent “is responsible for some of the most widely known and recognised whiskies ever created”. This is supported **exhibits IJ26** and **IJ05**. The article contained in **exhibit IJ26** states that Monkey Shoulder has

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<sup>12</sup> **Exhibit IJ19**

been voted as the top trending Scotch by the World's Best 50 bars (as voted by bartenders) in 2015, 2016, 2017 and 2018. It also refers to Monkey Shoulder as "the blended malt made for cocktails". **Exhibit IJ05** which contains an article from scotchwhisky.com, dated 4 January 2019 states that according to the 2019 Brands Report (compiled by industry magazine Drinks International), bartenders named Monkey Shoulder as the bestselling and trendiest Scotch Whisky. The report was compiled from a survey of award-winning bartenders, and bar owners, managers and head bartenders working for award-winning bars around the world, and "Monkey Shoulder was named the preferred Scotch at 22% of bars". I also note that in the article from The Spirit Business dated 19 November 2018, it states that "in the UK, Monkey Shoulder has gone mainstream, with listings in all the major supermarkets".<sup>13</sup> In all 3 aforementioned articles, the opponent's goods are shown as follows:



37. At paragraph 25 of his statement, Mr Jenkins provides the opponent's market share for its Monkey Shoulder whisky, which passed 5% in 2015 and reached 7.3% in 2020. Whilst the 2015 date falls before the relevant period, I believe that it casts a light on the relevant period itself, with the opponent's market share percentage for 2018 and 2019 likely falling between the two percentages provided.

38. I have been provided with a list of awards won by Monkey Shoulder, however, the only one which falls within the relevant period is the IWSC gold award from the International Wine and Spirit Competition in 2018.<sup>14</sup> Mr Jenkins also states that the opponent has hosted a Monkey Shoulder Ultimate Bartender competition which was

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<sup>13</sup> **Exhibit IJ06**

<sup>14</sup> **Exhibit IJ34** page 233

highly publicised. This competition was hosted in 2018 and 2019, with competitors participating across the world, including the UK.<sup>15</sup>

39. Lastly, in June 2021, Monkey Shoulder pre-batched cocktails were released in the UK. This is reported on in a range of articles dated June 2021 contained in **exhibits IJ10** and **exhibit IJ45**. All of the articles refer to, and depict the “Monkey Shoulder Lazy Old Fashioned”.

#### Form of the mark

40. The evidence I have outlined above shows the following variant of the opponent’s First Earlier Mark used on its whisky bottles:



41. The words “MONKEY SHOULDER” are presented on top of one another, in a minimally capitalised stylised typeface. The presentation of the words on top of each other does not alter the way the mark is understood, because the relevant public will still read it as “MONKEY SHOULDER”. I also find that the use of the slightly stylised typeface does not alter the distinctive character of the mark,<sup>16</sup> which resides in the words “MONKEY SHOULDER”, which are clearly visible and still continues to indicate origin.<sup>17</sup> This variant is therefore acceptable use of the opponent’s First Earlier Mark.

42. The remaining mark which has been used throughout the evidence, appearing on the mixer truck, trolley, cups and posters used at promotional events, is:



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<sup>15</sup> **Exhibit IJ42**

<sup>16</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

<sup>17</sup> *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31-35

43. The words “MONKEY” and “SHOULDER” are presented in a white minimally capitalised stylised typeface, and are separated by a device consisting of 3 white monkeys. These elements are all underlined, and underneath is the descriptive wording “100% MALT WHISKY MADE FOR MIXING” also presented in white. All of these elements are presented against an orange background. The distinctive character of the First Earlier Mark resides in the words “MONKEY SHOULDER”, and I find that the stylisation, the orange background and the descriptive wording does not alter the distinctive character. I also consider that the device depicting 3 monkeys is reflective of the word “MONKEY”, and therefore this element also does not alter the distinctive character of the opponent’s mark. On the basis that the words “MONKEY SHOULDER” clearly visible and still continues to indicate origin, I consider that this variant is also acceptable use of the opponent’s First Earlier Mark.

#### Assessment of genuine use

44. I will now consider whether the evidence shows that the First Earlier Mark has been genuinely used.

45. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>18</sup> As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

46. Whilst a notable proportion of the opponent’s evidence falls either before or after the relevant period, it is clear from the sales figures provided above, that a significant amount of MONKEY SHOULDER whisky was sold in the UK. The turnover for 2019 to 2022 in the UK amounts to £20,608,243, with 178,728 nine Litre cases being sold and 2,144,736 bottles being sold across the UK.

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<sup>18</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

47. Whilst I have not been provided with any invoice evidence from the relevant period, the opponent has provided significant evidence in terms of promotional activities undertaken to promote its MONKEY SHOULDER whisky, from attendance to large scale events such as London Cocktail Week and the Edinburgh Fringe, to smaller scale events such as the Spinningfields and Baltic Market. The opponent has conducted its own events such as SWAT, Silent Whisky Tastings, and the Monkey Shoulder Breakdown services, which resulted in consumers tasting the opponent's goods. Whilst I note that for many of the events attended or hosted by the opponent, the goods tasted by the public were cocktails made with its whisky, such as the "Monkey Shoulder Lazy Old Fashioned" (which the opponent eventually made into a pre-made mixer), it has been signposted throughout the evidence that the opponent's whisky is designed for mixing in cocktails. Therefore, the opponent has clearly advertised not just its whisky goods, but how these goods are meant to be used/consumed (i.e. in a cocktail). I also bear in mind that the location of the advertising events are geographically spread through the UK (Liverpool, Manchester, London and Edinburgh), and it has been supported by significant UK advertising figures, as well as interaction figures (for example, how many attended the evidence and how many tasters were given out).

48. The MONKEY SHOULDER whisky has consecutively been recognised as one of the top trending Scotch whiskies by the world's best bars and bartenders (including in 2018 and 2019), and it has also won the IWSC gold award from the International Wine and Spirit Competition in 2018. Whilst I note that I have been provided with the opponent's market share above, I bear in mind that Mr Jenkins has not confirmed whether this is the share of the UK market. Nevertheless, based on the significant sales figures before me, I consider that it is likely the opponent holds a notable proportion of the UK whisky market. Therefore, taking all of the above into account, I am satisfied that the opponent has shown genuine use of the First Earlier Mark within the relevant period.

#### Fair Specification

49. I must now consider whether, or the extent to which, the evidence shows use of the goods relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,

BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

50. In *Merck KGaA v Merck Sharp & Dohme Corp & Ors*, [2017] EWCA Civ 1834, Kitchin LJ (as he then was) set out the approach to be followed when considering partial revocation of a trade mark. The same approach is relevant when framing a fair specification. He said:

“244. As I described in *Maier v Asos*, the approach to be adopted is relatively straightforward (although I readily acknowledge that it may on occasion be difficult to apply) and it is in my view consistent with the earlier decisions of the Court of Appeal to which I referred at paragraph [63]. On reflection, I think it can be expressed more clearly as follows.

245. First, it is necessary to identify the goods or services in relation to which the mark has been used during the relevant period.

246. Secondly, the goods or services for which the mark is registered must be considered. If the mark is registered for a category of goods or services which is sufficiently broad that it is possible to identify within it a number of subcategories capable of being viewed independently, use of the mark in relation to one or more of the subcategories will not constitute use of the mark in relation to all of the other subcategories.

247. Thirdly, it is not possible for a proprietor to use the mark in relation to all possible variations of a product or service. So care must be taken to ensure this exercise does not result in the proprietor being stripped of protection for goods

or services which, though not the same as those for which use has been proved, are not in essence different from them and cannot be distinguished from them other than in an arbitrary way.

248. Fourthly, these issues are to be considered having regard to the perception of the average consumer and the purpose and intended use of the products or services in issue. Ultimately it is the task of the tribunal to arrive at a fair specification of goods or services having regard to the use which has been made of the mark.

249. This approach does strike an appropriate balance. It gives effect to the clear intention of the EU legislature that marks must actually be used or, if not used, be subject to revocation. [...] It is also fair to proprietors for it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. I am also satisfied that it gives appropriate protection to the legitimate interest of a proprietor in being able in the future to extend his range of goods or services within the scope of the terms describing the goods or services for which its mark is registered.”

51. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, subject to the proviso that it must be seen in light of more recent guidance by the CJEU that that the essential criterion to apply for the purposes of identifying a coherent subcategory of goods or services capable of being viewed independently is their purpose and intended use (for example, *Ferrari SpA v DU* (Joined Cases C-720/18 and C-721/18) EU:C:2020:854; [2021] Bus LR 106, at paragraphs 36-53).

52. The First Earlier Mark is registered for “alcoholic beverages” in class 33, and the holder asserts that “the opponent has failed to prove they have used their marks enough to substantiate the wideness of the scope they have registered. The lack of reference to or promotion of other alcoholic beverages, and the constant reference to

whiskey solidifies the association of the marks with whiskey alone”.<sup>19</sup> I agree that the term “alcoholic beverages” is very broad and can be generally described as encompassing goods that are consumed either for pleasure whilst socialising, or with the intention of becoming intoxicated. I also agree that the above evidence shows use of the First Earlier Mark only on whisky.<sup>20</sup> However, I bear in mind that the above case law makes it clear that I must have regard to the *purpose and intended use* of the goods in issue in order to determine whether there is a subcategory capable of being viewed independently of the broader term.

53. I consider that the intended use of whisky is the same as other spirits (which is also another term that falls within the broader category of “alcoholic beverages”). Whilst spirits can be consumed neat in small quantities/measurements (usually a shot size of about 25ml), they are more commonly consumed by being combined with mixers and other ingredients, such as to create a cocktail. I also bear in mind that spirits are a type of strong and distilled alcoholic beverage (and are therefore made via the same or very similar processes) which are distinct, for example, from other types of alcoholic beverages such as wine or beer, and are typically consumed in larger quantities (from 125ml to 250ml for wine, and beer is measured in pints or half-pints).<sup>21</sup> I therefore find that, applying the above case law, a subcategory capable of being viewed independently from “alcoholic beverages”, for which the opponent has shown use, is “spirits”. This is on the basis that all spirits share the same purpose and intended use, and therefore, to limit the opponent’s specification any further would result in the opponent being stripped of protection for goods which are not in essence different, and to make such a distinction between them would be arbitrary.

54. Therefore, taking the above into account, I consider that a fair specification of the First Earlier Mark is:

Class 33      Spirits.

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<sup>19</sup> Paragraph 19 of their written submissions filed during the evidence rounds.

<sup>20</sup> Whilst there is evidence that the opponent introduced the “lazy old fashioned” pre-mix cocktail into the market in 2021 (a year before the end of the relevant period), I have not been provided with any sales figures in relation to these goods, and thus, I do not consider the opponent has demonstrated use of pre-mixed cocktails.

<sup>21</sup> I also appreciate that these goods are produced in different ways.

## Section 5(2)(b) - case law

55. The following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25:

(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, in certain circumstances, be dominated by one or more of its components;

(f) and beyond the usual case, where the overall impression created by a mark depends heavily on the dominant features of the mark, it is quite 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 greater 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; and

(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.

### Comparison of goods

56. The parties' competing goods are as follows:

Opponent's goods	Holder's goods
<b>The First Earlier Mark</b> <u>Class 33</u> Spirits.	<u>Class 33</u> Gin; spirits; distilled spirits.
<b>The Second Earlier Mark</b> <u>Class 33</u> Alcoholic beverages (except beers).	
<b>The Third Earlier Mark</b> <u>Class 33</u> Alcoholic beverages (except beers).	

57. At paragraph 17 of the holder's witness statement, they submit that:

“Whilst the [holder's] mark is applied for against a class which crosses over with the Opponent's marks in class 33, the goods specified within the [holder's] mark are specific and limited. Conversely, the specification contained within the Opponent's mark is overly broad and it is not possible from that specification to determine the extent of the protection sought in class 33. Where the specification is too general and covers too wide a range of goods it is not possible for that mark to act as an indicator of origin (*CIPA v Registrar of Trade Marks* (Case C-307/10)). Therefore, the [holder] denies that the goods and services covered under the Opponent's mark are similar to the goods and services covered by the [holder's] mark.”

58. In the opponent's submissions in lieu, they state that the term “alcoholic beverages (except beers)” is a term expressly included in the Nice Classification system, and it is also a term included in the harmonised database of terms pre-approved by various intellectual property offices, including the UKIPO. The opponent also submits that it is a “clearly understood term in the beverage industry and by the public at large”, and that “gin, spirits and distilled spirits are unquestionably alcoholic beverages”.

59. I agree with the opponent. I do not consider that the term “alcoholic beverages” is too general and wide that it prevents the opponent's marks from acting as an indicator of origin. The term can clearly be defined as drinks of an alcoholic nature, and the average consumer would therefore understand this term as encompassing all alcoholic drinks. On this basis, I do not consider that the above submission assists the holder.

60. In *Gérard Meric v OHIM*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM – Educational Services* (ELS) [2002] ECR II-4301, paragraph 53) or

where the goods designated by the trade mark application are included in a more general category designated by the earlier mark.”

61. The term “spirits” appears identically in the opponent’s First Earlier Mark’s specification and the holder’s specification. I also find that the holder’s terms “distilled spirits” and “gin” falls within the opponent’s broader category of “spirits” in its First Earlier Mark’s specification. The goods are identical on the principle outlined in *Meric*.

62. All of the holder’s class 33 goods, that being “gin”, “spirits” and “distilled spirits”, falls within the opponent’s broader categories of “alcoholic beverages (except beers)” in the Second and Third Earlier Marks specifications. The goods are therefore identical on the principle outlined in *Meric*.

### **The average consumer and the nature of the purchasing act**

63. 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 in question: *Lloyd Schuhfabrik Meyer, Case C-342/97*. In *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25, the Supreme Court approved the comments of Arnold LJ in *Lidl Great Britain Ltd & Anor v Tesco Stores Ltd & Anor (Rev1)* [2024] EWCA Civ 262, where he pointed out that:

(a) Consumers who are ill-informed or careless, or consumers with specialised knowledge or who are excessively careful are excluded from consideration;

(b) The average consumer provides a standard which enables the courts to strike a balance between the competing interests involved, such as trade mark owners, their competitors and consumers;

(c) The average consumer is neither a single hypothetical person nor a mathematical average; assessment from the perspective of the average

consumer does not involve a statistical test. There is no single meaning rule and if, having regard to the perceptions and expectations of the average consumer, the court considers that a significant proportion of the relevant public is likely to be confused, a finding of infringement may properly be made;

(d) Assessment from the perspective of the average consumer is intended to facilitate adjudication of trade mark disputes by providing an objective criterion, by promoting consistency of assessment and by enabling courts and tribunals to determine such issues so far as possible without the need for evidence;

(e) The average consumer's level of attention varies according to the category of goods or services in question; and

(f) the average consumer rarely has the opportunity to make direct comparisons between trade marks (or between trade marks and signs) and must instead rely upon the imperfect picture of the trade mark they have kept in their mind.

64. Before I conduct my assessment on the average consumer, I note that at paragraph 14 of its written submissions, the holder states that “the [holder’s] goods and services are specifically targeted toward the gin market, with no intention of entering the whiskey market in the future. It is also the case that they are specifically aimed at consumers in the Hartlepool and wider North-East area. The average consumer for the [holder’s] goods is likely to be a casual gin drinker with a strong connection to that area. It is that story which drives customers to the [holder’s] products.”

65. Whilst the holder may indeed aim to only target the gin market and consumers the Hartlepool and wider North-East area, I have to carry out a notional assessment based upon the specifications before me and all the circumstances in which the UK mark applied for might be used if it were registered.<sup>22</sup> On this basis, this submission does not assist the holder.

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<sup>22</sup> *O2 Holdings Limited & Anor v Hutchison 3G UK Limited*, Case C-533/06, paragraph 66.

66. I find that the average consumers for all of the parties' goods will be adult members of the general public over the age of 18. The cost of the goods in question is likely to vary considerably, however, overall it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the origin of the goods, the cost, flavour and alcohol percentage. I therefore find that a medium degree of attention will be paid during the purchasing process.

67. The goods are likely to be purchased by self-selection from the shelves of retail outlets such as supermarkets and off-licences, and their online equivalents. Alcoholic beverages can also be sold in bars and restaurants, being displayed behind the counter or on a drink's menu. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be verbally ordered at a table or bar, or if stocked behind a counter, the average consumer may have to ask the sales assistant for them.


### **Comparison of the trade marks**

68. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. 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.”

69. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account 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.

70. The respective trade marks are shown below:

Opponent's marks	Holder's IR
<p><b>MONKEY SHOULDER</b> (the First Earlier Mark)</p> <p><b>SMOKEY MONKEY</b> (the Second Earlier Mark)</p> <p><b>GINGER MONKEY</b> (the Third Earlier Mark)</p>	 <p><b>MONKEY</b> HANGER</p>

Overall impression

71. The First Earlier Mark consists of the words “MONKEY SHOULDER”. I consider that the overall impression lies in the combination of these elements.

72. The Second Earlier Mark consists of the words “SMOKEY MONKEY”. I consider that the overall impression lies in the combination of these elements.

73. The Third Earlier Mark consists of the words “GINGER MONKEY”. I consider that the overall impression lies in the combination of these elements.

74. The holder's IR consists of a monkey dressed as an admiral, presented against a blue circle. The admiral monkey is presented above the word "Monkey", which is presented in a large black minimally stylised typeface. Underneath the word "Monkey" is the word "Hanger" (presented as HanGeR in the same letter size) presented in a smaller minimally stylised black typeface. Albeit the word "Monkey" is clearly larger than the word "Hanger", for reasons I shall come to discuss in the conceptual comparison, I nevertheless find that both words play an equal role in the overall impression. Although the eye is naturally drawn to the element of the IR that can be read, and although the monkey device reinforces the meaning of the word "Monkey", on the basis that the monkey is dressed as an admiral (which as I will come to discuss in the conceptual comparison, introduces another meaning to the mark), and given the size and positioning of the admiral monkey device at the top centre of the IR, I consider that it plays a roughly equal role in the overall impression with the words "Monkey Hanger".

### Visual Comparison

#### *The First Earlier Mark and the holder's IR*

75. The parties' marks both contain the word "MONKEY". This is a point of visual similarity. However, the First Earlier Mark ends in the word "SHOULDER" and the holder's IR ends in the word "Hanger". These clearly act as visual points of difference. The holder's IR also consists of the admiral monkey device which is another point of visual difference. On this basis, I find that the marks are visually similar, but to between a low and medium degree.

#### *The Second Earlier Mark and the holder's IR*

76. The parties' marks both consist of the word "MONKEY". This is a point of visual similarity. However, the Second Earlier Mark begins with the word "SMOKEY" and the holder's IR begins with the admiral monkey device. The holder's IR also ends in the word "Hanger". These all act as visual points of difference. I therefore find that the parties' marks are similar to between a low and medium degree.

### *The Third Earlier Mark and the holder's IR*

77. The parties' marks both consist of the word "MONKEY". This is a point of visual similarity. However, the Third Earlier Mark begins with the word "GINGER" and the holder's IR begins with the admiral monkey device. The holder's IR also ends in the word "Hanger". These all act as visual points of difference. Consequently, the parties' marks are visually similar to between a low and medium degree.

### Aural Comparison

#### *The First Earlier Mark and the holder's IR*

78. The admiral monkey device will not be articulated in the holder's IR. Therefore, both marks will overlap in the pronunciation of the ordinary dictionary word "MONKEY" at the beginning of them. However, the ordinary dictionary words "SHOULDER" and "Hanger" are aurally dissimilar. I therefore find that the marks, as a whole, are aurally similar to a medium degree.

#### *The Second Earlier Mark and the holder's IR*

79. Again, the admiral monkey device will not be articulated in the holder's IR. Therefore the parties' marks will overlap in the pronunciation of the ordinary dictionary word "MONKEY", albeit they will be articulated at different parts (the end vs the beginning). The ordinary dictionary words "SMOKEY" and "Hanger" are aurally dissimilar. I therefore find that the parties' marks are aurally similar to no more than a medium degree.

#### *The Third Earlier Mark and the holder's IR*

80. The admiral monkey device will not be articulated in the holder's IR. Consequently, the parties' marks will overlap in the pronunciation of the ordinary dictionary word "MONKEY", albeit they will be articulated at different parts (the end vs the beginning). The ordinary dictionary words "GINGER" and "Hanger" are aurally dissimilar. Consequently, the parties' marks are aurally similar to no more than a medium degree.

## Conceptual Comparison

### *The First Earlier Mark and the holder's IR*

81. Throughout the proceedings, the holder has submitted that:

“The phrase “MONKEY HANGER” is a colloquial nickname for people from Hartlepool, originating from a legend about locals hanging a monkey mistaken for a French spy during the Napoleonic Wars. This term is reflected in Hartlepool United FC’s mascot, H’Angus the Monkey, and was used in a political campaign in the 2000s. The [holder’s] Mark incorporates this historical reference with an image of a monkey in military uniform, conveying a distinct conceptual message. In contrast, the Opponent’s Marks do not consistently use the term “MONKEY” in a way that conveys a clear conceptual meaning.”<sup>23</sup>

82. To support this, within **exhibit AP02**, the holder has provided media clippings detailing this story.

83. Whilst the exhibit contains multiple printouts, including from larger publications like the BBC and The Guardian, with the BBC article dated 17 September 2017 (before the designation date), I do not consider this evidence is sufficient enough to establish that a significant proportion of consumers would know the story of, or the nickname “MONKEY HANGER”. I also bear in mind that for a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] ECR I-643; [2006] E.T.M.R 29. Consequently, even if the average consumer was aware of the story regarding the monkey, I do not consider that the average consumer would immediately recognise, or assign this meaning, to the holder’s IR.

84. In its submissions in lieu, the opponent provides multiple submissions as to the meaning of the word “HANGER” in the holder’s mark, including:

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<sup>23</sup> Paragraph 29(c) of its written submissions in lieu.

1. The word “HANGER” does not have an obvious connection with alcoholic beverages.
2. It could conceivably refer to a bottle neck hanger (a promotional item typically printed on card which is fastened around the bottle’s neck).
3. It could convey something about the manufacturing process, where “perhaps an ingredient is hung somewhere, or is made in a hanger, or it involves hanging racks”.
4. “The reality is that the average consumer would likely not understand the meaning of HANGER in this context at all and so they will attribute little weight to that element and little mental effort to remember.”

85. In regard to point 4, if the average consumer did not understand the meaning of the word HANGER, this would not result in them attributing little weight to it or making little effort to remember it. Instead it would make it more memorable. I therefore dismiss this line of argument. I am also not convinced by points 2 and 3. This is on the basis that the word “Hanger” is an ordinary dictionary word, which conveys the meaning of a person who hangs from something. Therefore, in combination with the word “Monkey”, an animal which typically hangs from trees, I find that together, the words “Monkey Hanger” qualify each other to evoke the meaning of a monkey that hangs from things. I also bear in mind that the admiral monkey device reinforces the meaning of the word monkey, but also introduces the concept of an admiral.

86. The opponent’s First Earlier Mark, “MONKEY SHOULDER”, consists of 2 ordinary dictionary words, which qualify each other, to evoke the meaning of the shoulder of a monkey.

87. In its written submissions in lieu, the opponent states that the words “SHOULDER” and “Hanger” act as qualifiers to the main noun MONKEY, “such that the concept remains rooted in the idea of a monkey. On this basis, the opponent submits that the marks should be found to be conceptually similar to a very high degree, and they find that this analysis is consistent with the findings of a previous Hearing Officer in *POWDER MONKEY* BL O/0145/23. However, in this case, the Hearing Officer only

found the marks to be similar to between a medium and high degree<sup>24</sup> as the concepts were revolved around the concept of a monkey.

88. I bear in mind that I am not bound by the decisions of previous Hearing Officers, and in this instance, albeit the words “SHOULDER” and “Hanger” qualify the word MONKEY, they still contribute conceptually to the mark. Both word elements within the parties’ marks form a unit that are imperative to one another, and alters the concept conveyed by the marks (a monkey’s shoulder vs a monkey that likes to hang). I therefore find that the words “SHOULDER” and “Hanger” play an integral role in contributing to the concept. Nevertheless, as both marks convey the meaning of a monkey, I find they are conceptually similar to at least a medium degree.

#### *The Second Earlier Mark and the holder’s IR*

89. The ordinary dictionary words “SMOKEY MONKEY” in the Second Earlier Mark qualify each other, and are likely to evoke the meaning of a monkey that is smokey<sup>25</sup> (i.e. the monkey smells like smoke, it looks like smoke, potentially being grey in colour, or it is surrounded by smoke). Nevertheless, as both of the parties’ marks evokes the meaning of a monkey, they are conceptually similar to at least a medium degree.

#### *The Third Earlier Mark and the holder’s IR*

90. The ordinary dictionary words “GINGER MONKEY” in the Third Earlier Mark qualify each other, and thus evokes a monkey that is ginger in colour. Therefore, on the basis that both of the parties’ marks evokes the meaning of a monkey, they are conceptually similar to at least a medium degree.

### **Distinctive character of the earlier trade marks**

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

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<sup>24</sup> Paragraph 62 of the decision

<sup>25</sup> I appreciate that another spelling of this word is “smoky”.

“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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

92. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

93. Before my assessment of the inherent distinctive character of the opponent’s First, Second and Third Earlier Marks, I note that in its written submissions, the holder states that “the term “monkey” is widely used in the alcohol industry, with numerous products incorporating it into their branding. Additionally, there are many trademarks featuring the term that are registered with the UKIPO in class 33”, such as: Monkey 47, Monkey Bay, Monkey Rum, Sun Monkey, Blue Monkey, Dead Monkey, Sour Monkey, Brass Monkey, Dirty Monkey, Fruity Monkey, Green Monkey, Lucky Monkey, Monkey Island and Monkey’s Tail.

94. To support this, the holder has filed evidence in **exhibit AP14** to show the “numerous alcoholic beverages in the market that utilise the term monkey”. I note that this exhibit contains the following photos:



95. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06 the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T-135/04 GfK v OHIM – *BUS(Online Bus)* [2005] ECR II-4865,

paragraph 68, and Case T-29/04 *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)* [2005] ECR II-5309, paragraph 71.”

96. The mere fact that there may be multiple marks that contain the word “MONKEY” being used in the UK for class 33 goods is not relevant to my assessment. Whilst Ms Pearce has provided photos to show how the goods have been labelled, I have no evidence of how these marks have been used in practice i.e. screenshots of retailers showing these goods actually for sale, the turnover generated from these sales, and what market share the third parties hold of the alcoholic beverages market. This submission, therefore, does not assist the holder.

97. I will now assess the inherent distinctive character of the opponent’s marks. The First, Second and Third Earlier Marks (MONKEY SHOULDER, SMOKEY MONKEY, and GINGER MONKEY) consist of 2 ordinary dictionary words which are neither allusive or descriptive of the opponent’s goods. On this basis, they are inherently distinctive to a medium degree.

98. In its written submissions in lieu, the opponent states that “due to the longstanding and widespread promotion and sale of the opponent’s MONKEY SHOULDER product by the opponent, that mark has a high level of enhanced distinctiveness acquired through use in relation to whisky”. I bear in mind that the relevant market for assessing this is the UK market.

99. In addition to the evidence of use of the First Earlier Mark, summarised at paragraphs 22 to 39 above, I note that I have been provided with a report titled “The Serious Business of Monkeying Around” from 2009.<sup>26</sup> This summarises the opponent’s activities from 2009 onwards, such as:

- a) In 2011, the opponent attended “one of the UK’s favourite festivals: Bestival” and created an “Inner Sanctum” in the Treehouse, creating a bar led installation, making guests a signature cocktail, and 3,000 guests tried their samples over 3 days.

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<sup>26</sup> Exhibit IJ14

- b) In 2015 they held the Ultimate Bartender Championships with 40 bartenders from 15 markets around the world competing.
- c) In 2015 they also created their first “pop-down” bar in East London for 3 days, where cocktails were made from Monkey Shoulder. This is supported by an article contained in **exhibit IJ18** dated 18 June 2015 which states that the pop down bar was hosted in London (E1 6QR) on Thursday to Sunday.
- d) In 2016, SWAT and the Monkey Shoulder Drinks Trolley was created. At the end of 2016, at London Cocktail Week, the opponent hit the 50,000 samples mark for that year.

100. I also note that at paragraph 49 of his statement, Mr Jenkins confirmed that in 2017, the drinks trolley went to 153 events including London Fashion week, the BoxPark Takeover, the London Coffee Festival and the Taste of London, with the number of customers who sampled its Monkey Shoulder whisky at these events amounting to 106,000.

101. At paragraphs 73 to 77 of his witness statement, Mr Jenkins also lists the following awards won by the Monkey Shoulder between 2014 to 2017:

1. The 2014 Gold quality award in the International Wine and Spirit Competition (“IWSC”), as exhibited in **IJ34**. Mr Jenkins confirms that IWSC is an international body that recognises the best wines and spirits across the world.
2. In 2014, it was also awarded Gold in the “Speyside No Age Statement” category at the Scotch Whisky Masters 2014. This was reported and listed in the Spirits Business article, dated 24 June 2014, contained in **exhibit IJ34**.
3. It was awarded the Gold Best in Class award in the International Spirits Challenge 2015. The certificate of which is contained in **exhibit IJ34**.
4. In 2015, Monkey Shoulder was also awarded Gold in the “Blended Malt: Premium” category at The Global Scotch Whisky Masters. This was reported and listed in the Spirits Business article, dated 2 June 2015, contained in **exhibit IJ34**.
5. It was awarded the Gold quality award by the IWSC in 2016. This is shown in **exhibit IJ34**.

6. In 2017, Monkey shoulder was awarded Silver at the World Whiskies Awards. This is shown in **exhibit IJ34**.

102. As I have mentioned above, the opponent has filed evidence of use, which I have already, in part, assessed. Given my previous observations in relation to the First Earlier Mark, taking into account the length of use, the huge UK turnover made from 2019 to 2021 amounting to £14,891,561, and the UK marketing spend made from 2018 to 2022 amounting to over £5,852,000, supported by the significant amount of promotional activities conducted by the opponent under its MONKEY SHOULDER mark, and the likely UK market share held, I am satisfied that, by the relevant date, the distinctive character of the First Earlier Mark has been enhanced through use to a high degree for whisky.<sup>27</sup>

103. I also note that I can consider any evidence which pertains to the opponent's Second and Third Earlier Marks. However, there is no exhibited evidence showing use of the opponent's Third Earlier "GINGER MONKEY" Mark. Therefore, the distinctiveness of the Third Earlier Mark cannot be enhanced.

104. In regard to the Second Earlier Mark, I note that I have been provided with limited evidence in regard to this mark. **Exhibit IJ09** contains a screenshot dated 17 June 2022 showing "SMOKEY MONKEY" being sold on House of Malt. This is supported by an article dated 7 August 2017 from scotchwhisky.com advertising Smokey Monkey, which states it was "available to purchase at selected bars in the UK and France from August". **Exhibit IJ12** contains an undated blog review of Smokey Monkey and screenshots of Smokey Monkey for sale at third party retailers dated October 2024. The Time Out London and About Time Magazine articles contained in **exhibit IJ29** confirms that in July 2021, the Wingmans chicken restaurant collaborated with the opponent and its Smokey Monkey whisky to create a limited edition chicken wing. However, I bear in mind that there is no detailed turnover or marketing figures or any indication of the market share held by the opponent under its SMOKEY

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<sup>27</sup> Whilst this finding differs to my proof of use finding above (i.e. the opponent had shown use of the broader term "spirits"), the case law applied resulting in such a conclusion, specifically the application of *Merek* in determining a fair specification, is different to the case law and the assessment that is made when determining whether the distinctive character of the First Earlier Mark has been enhanced.

MONKEY mark. Consequently, I find that the evidence is not sufficient to establish that the distinctiveness of the Second Earlier Mark has been enhanced through use.

### **Family of marks**

105. Before proceeding to consider a likelihood of confusion in the ordinary way, I wish to firstly address the opponent's family of marks argument. On this point, I refer to the case of *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order

for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a 'family' or 'series', the earlier trade marks which are part of that 'family' or 'series' must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to 'marks in a series'."

106. For the opponent's marks to constitute as a 'family', there must be several of them which possess common characteristics, all of which must be present on the market.

107. The First Earlier Mark consists of the word "MONKEY" followed by the word "SHOULDER", the Second Earlier Mark consists of the word "SMOKEY" followed by the word "MONKEY", and the Third Earlier Mark consists of the word "GINGER" followed by the word "MONKEY". I therefore find that only the Second and Third Earlier Marks display characteristics which render them capable of association with a family (i.e. they begin with an adjective followed by the word "MONKEY"). The First Earlier Mark does not fit this pattern as it begins with the word "MONKEY" and ends by listing a body part.

108. While there is some evidence to show that the opponent's Second Earlier Mark was being used in the UK, albeit this is very minimal, there is no evidence of use before me regarding the opponent's Third Earlier Mark. On this basis, I am unable to conclude that the Third Earlier Mark was present on the UK market. Therefore, the opponent's family of marks argument fails as one out of the two marks which could constitute as a family was not present on the UK market. However, for the sake of completeness,

even if the opponent had provided evidence to show that its Third Earlier Mark was present on the UK market, the case law makes it clear that there must be a sufficient number of marks on the UK market for a party to demonstrate that there is family of marks. However, I do not consider that 2 marks would amount to a sufficient number. On this basis, I find that the evidence is insufficient to establish that the opponent's earlier marks constitute a family.

### **Likelihood of confusion**

109. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. Nevertheless, the following standard summary of the principles applicable to the assessment of the likelihood of confusion was approved by the Supreme Court in *Iconix Luxembourg Holdings SARL v Dream Paris Europe Inc & Anor*, [2025] UKSC 25 as listed in paragraph 55 above.

#### *The First Earlier Mark and the holder's IR*

110. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to a medium degree.
- I have found the marks to be conceptually similar to at least a medium degree.
- I have found the First Earlier Mark to be inherently distinctive to a medium degree.
- I have found that the distinctiveness of the First Earlier Mark has been enhanced to a high degree.

- I have identified the average consumer as adult members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical.

111. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that a consumer paying a medium degree of attention during the purchasing process would overlook the differences between the words "SHOULDER" and "Hanger" at the end of the parties' marks on the basis that they are clearly visually, aurally and conceptually dissimilar. I also consider it unlikely that the average consumer would overlook the admiral monkey device at the top of the holder's IR due to its size and placement, as well due to its conceptual contribution to the mark (i.e. the admiral element). I therefore do not consider there to be a likelihood of direct confusion.

112. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

"16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the

common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ('26 RED TESCO' would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

113. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that "a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion". Arnold LJ agreed, pointing out that there must be a "proper basis" for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

114. As highlighted above, Mr Purvis Q.C. in *L.A. Sugar Limited* sets out that there are three main categories of indirect confusion, and that indirect confusion 'tends' to fall in one of them. I note that the opponent has not stated specifically what category this

case would fall within or suggested any alternative way in which indirect confusion might arise. However, for the sake of completeness, I will go through each category.

115. Category (a) is where indirect confusion might arise where the common element is so strikingly distinctive that the average consumer would assume that no-one else, but the brand owner, would be using it. However, in this instance, I do not consider that the ordinary dictionary word, "MONKEY", which has a recognisable meaning to the average consumer, is so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. Whilst I have found that the distinctiveness of the earlier mark has been enhanced to a high degree, this is via the use of both the words "MONKEY" and "SHOULDER", and in this case, the word "SHOULDER" is clearly not present within the holder's IR. Therefore, category (a) is not satisfied.

116. Category (b) from *L.A. Sugar* is where the later mark simply adds a non-distinctive element to the earlier mark. For this category to be satisfied, the opponent's mark as a whole, that being "MONKEY SHOULDER", would need to be reproduced, with an addition of a non-distinctive element. However, as I have highlighted above, this is not the case. Therefore, this category is also not satisfied.

117. Lastly, category (c) is where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. In this case, the word "MONKEY" is both marks are followed by the word "SHOULDER" or "Hanger". However, I do not consider that changing the word "SHOULDER" to "Hanger", or vice versa, is logical, nor consistent with a brand extension. Firstly, as highlighted above, the words "MONKEY SHOULDER" and "Monkey Hanger" play an equal role in the overall impressions of the parties' marks. Secondly, whilst the opponent highlights that the words "SHOULDER" and "Hanger" act as qualifiers to the main noun "MONKEY", they qualify the word "MONKEY" in very different ways. The addition of the word shoulder indicates a body part of the monkey, and the addition of the word hanger indicates that the monkey likes to hang off of things. I therefore consider that the holder's IR is a step too-far removed from being an obvious or logical brand extension, or a logical sub-brand of the opponent's mark. I do not consider that the third category is satisfied.

118. I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of how the holder's IR could be indirectly confused with the opponent's mark and the opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. As highlighted above, the marks are not natural variants or brand extensions of each other. Even if the First Earlier Mark is brought to mind by the holder's IR, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Taking the above into account, I consider there is no likelihood of indirect confusion.

#### *The Second and Third Earlier Marks and the holder's IR*

119. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to no more than a medium degree.
- I have found the marks to be conceptually similar to at least a medium degree.
- I have found the Second and Third Earlier Marks to be inherently distinctive to a medium degree.
- I have identified the average consumer as adult members of the general public who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process.
- I have found the parties' goods to be identical.

120. Taking all of the above into account, even bearing in mind the principle of imperfect recollection, I am satisfied that the parties' marks are unlikely to be mistakenly recalled as each other. I do not consider that a consumer paying a medium degree of attention during the purchasing process will overlook the differences

between the words “SMOKEY” and “GINGER” at the beginning of the opponent’s marks, and the word “Hanger” at the end of the holder’s IR on the basis that they appear in different positions within the marks, and they are clearly visually, aurally and conceptually dissimilar. I also consider it unlikely that the average consumer would overlook the admiral monkey device at the top of the holder’s IR. I therefore do not consider there to be a likelihood of direct confusion.

121. In regard to indirect confusion, I shall, again, also go through the three main categories listed by Mr Purvis Q.C. in *L.A. Sugar Limited* above.

122. As highlighted by paragraph 115 above, the word MONKEY which appears in all 3 of the marks is an ordinary dictionary word which has a recognisable meaning to the average consumer. It is, therefore, not so strikingly distinctive that the average consumer would think that no-one else but the opponent would use it. This is supported by my finding of the Second and Third Earlier Marks being inherently distinctive to a medium degree. On this basis, category (a) of *L.A. Sugar* is not satisfied. The opponent’s “SMOKEY MONKEY” and “GINGER MONKEY” marks are also not reproduced as whole, with the addition of a non-distinctive element. Therefore category (b) of *L.A. Sugar* is not satisfied.

123. Lastly, I do not consider that changing the words “SMOKEY” and “GINGER” to “Hanger”, or vice versa, is logical, nor consistent with a brand extension. Firstly, as highlighted above “SMOKEY MONKEY”, “GINGER MONKEY” and “Monkey Hanger” play an equal role in the overall impressions of the parties’ marks. Secondly, whilst the words SMOKEY, GINGER and Hanger are all used to describe the monkey, they are different types of descriptors, with SMOKEY and GINGER describing the way that the monkey looks or smells, whereas “hanger” is commenting on how the monkey likes to hang from things. I therefore consider that the holder’s IR is a step too-far removed from being an obvious or logical brand extension, or a logical sub-brand of the opponent’s mark. Taking the above into account, I do not consider that the third category is satisfied.

124. Again, I bear in mind that the examples above set out by Mr Purvis Q.C. are not exhaustive. However, I do not consider that there are any other logical examples of

how the holder's IR could be indirectly confused with the opponent's marks and the opponent has not suggested any. I consider that having noticed that the trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings.

125. As highlighted above, the marks are not natural variants or brand extensions of each other, and even if the Second and Third Earlier Marks are brought to mind by the holder's IR, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion

126. The opposition under section 5(2)(b) fails.

### **Final Remarks**

127. I note that in paragraph 15 of the holder's written submissions they submit that:

“It is a well-established principle that, when both parties have coexisted in the same marketplace for a period, any likelihood of confusion would typically result in actual examples of such confusion. Since the Applicant commenced trading on 1 August 2023, no such instances of confusion have occurred.”

128. Whilst this wording is usually indicative of an honest concurrent use defence, the applicant did not actively plead such a defence in its Form TM8. This, in my view, would be a sufficient reason to dismiss the claim. That being said, I note that all of the holder's evidence provided in Ms Pearce's witness statement shows that the holder has been trading under the Monkey Hanger mark since 1 August 2023. This is clearly 7 months after the relevant date. Therefore, the holder's evidence cannot establish that there has been a long period of honest concurrent use between the marks,<sup>28</sup> and, as a result, any reliance upon this defence is dismissed.

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<sup>28</sup> This needs to be present as per *Budejovicky Budvar NP v Anheuser-Busch Inc* Case C-482/09, EU:C:2011:605 and *Match Group, LLC & Ors v Muzmatch Ltd & Anor* [2023] EWCA Civ 454 at [115] to [117]

## **Section 5(3)**

128. Section 5(3) of the Act states:

“5(3) A trade mark which –

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), 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 repute of the earlier trade mark.”

129. Section 5(3A) of the Act states:

“Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

130. The relevant case law can be found in the following judgments of the CJEU: *General Motors Corp v Yplon SA* (Case C-375/97), *Intel Corporation Inc v CPM United Kingdom Ltd* (Case C-252/07), *Adidas Salomon AG v Fitnessworld Trading Ltd* (Case C-408/01), *L’Oréal SA & Ors v Bellure & Ors* (Case C-487/07), *Interflora Inc & Anor v Marks and Spencer plc & Anor* (Case C-323/09) and *Environmental Manufacturing LLP v OHIM* (Case C-383/12 P). 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) The more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark; *L'Oréal, paragraph 44*.

(g) 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* and *Environmental Manufacturing, paragraph 34*.

(h) 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*.

(i) 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'Oréal v Bellure NV*, paragraph 40.

(j) 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; *Interflora*, paragraph 74, and the court's answer to question 1 in *L'Oréal*.

131. The conditions of section 5(3) are cumulative. Firstly, the opponent's First Earlier Mark and holder's IR must be identical or similar, and I have discussed their level of similarity in paragraphs 75, 78, and 81 to 88 above. Secondly, the opponent must show that its First Earlier Mark has achieved a level of knowledge/reputation amongst a significant part of the public. Thirdly, it must have established that the level of reputation and the similarities between the marks will cause the public to make a link between them, in the sense of the opponent's mark being brought to mind by the later mark. Fourthly, assuming that the first, second and third conditions have been met, section 5(3) requires that one or more types of damage claimed will occur. It is unnecessary for the purposes of section 5(3) that the goods be similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

132. The relevant date for the assessment under section 5(3) is the designation date of the holder's IR i.e. 29 January 2023.

## Reputation

133. In *General Motors*, Case C-375/97, the CJEU held that:

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

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

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

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

134. In determining whether the opponent has demonstrated a reputation for the goods in issue, it is necessary for me to consider whether its mark will be known by a significant part of the public concerned with the goods.

135. In reaching this decision, I must take all of the evidence into account including “the market share held by the trade mark, the intensity, geographical extent and duration of use, and the size of the investment made by the undertakings in promoting it.”

136. I have found that the distinctive character of the opponent’s First Earlier “MONKEY SHOULDER” Mark has been enhanced through use for its whisky goods. I recognise that reputation is not the same as enhanced distinctive character, but the

same factors are to be taken into account in both assessments.<sup>29</sup> Nevertheless, I note that I have been provided with significant evidence to show that the opponent has been using its First Earlier Mark since at least 2011. Whilst I have only been provided with UK sales from 2019 to 2021, I note that the turnover is significant, amounting to £14,891,561 from the sale of MONKEY SHOULDER bottles of whisky. I also consider that based on these sales, the opponent holds a notable proportion of the UK whisky market. I have also been provided with high UK advertising figures, which between 2018 and 2019 amounted to £5,852,000. The opponent has also conducted a vast amount of promotional activities, from its SWAT events to its silent whisky tasting discos, and attendance at larger scale events such as London Cocktail Week and the Edinburgh Fringe. It is also clear that the opponent has won many awards and titles for its MONKEY SHOULDER whisky, including been deemed the “trendiest whisky”. I am therefore satisfied that the mark had a strong reputation for whisky at the relevant date.<sup>30</sup>

## Link

137. As I noted above, my assessment of whether the public will make the required mental ‘link’ between the marks must take account of all relevant factors. The factors identified in *Intel* are:

### The degree of similarity between the conflicting marks

As noted in paragraphs 75, 78 and 81 to 88 above, I have found the First Earlier Mark and the holder’s IR to be visually similar to between a low and medium degree, aurally similar to a medium degree and conceptually similar to at least a medium degree. I have found that the First Earlier Mark and the holder’s IR are visually, aurally and conceptually similar on the basis that they share the word “MONKEY”, a word which is neither allusive nor descriptive of the class 33 goods.

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<sup>29</sup> *O2 Worldwide Limited v CX02.COM (UK) Limited*, BL O/393/19, paragraph 39

<sup>30</sup> Whilst this finding differs to my proof of use finding above (i.e. the opponent had shown use of the broader term “spirits”), the case law applied resulting in such a conclusion, specifically the application of *Merek* in determining a fair specification, is different to the case law and the assessment that is made when determining if the opponent has a reputation.

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

The opponent's "whisky" falls within the broader categories of "spirits" and "distilled spirits" in the holder's class 33 specification. The goods are therefore identical.

The opponent's "whisky" and the holder's "gin" goods are both types of distilled spirits, which are commonly consumed for pleasure whilst socialising, or with the intention of becoming intoxicated. They can be consumed neat, however, they are more commonly consumed by being combined with mixers and ingredients, such as to create a cocktail. As a result, the goods overlap in method of use and purpose. I also bear in mind that the goods overlap in user, being consumed by adults over the age of 18. Thus, taking the above into account, I consider that the goods would be sold in close proximity within the same retailers, being sold in alcohol aisles in supermarkets and off licences, and displayed near each other behind a bar. Therefore, to the extent that they are both types of spirits, the goods may be in competition with each other. Nevertheless, I appreciate that the respective goods can be made from different ingredients, which results in their taste being very different. On this basis, I find that the goods are similar to a high degree.

The strength of the earlier mark's reputation

As noted in paragraph 136 above, the First Earlier Mark has a strong reputation for whisky.

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

I found the First Earlier Mark to be inherently distinctive to a medium degree, which has been enhanced through use to a high degree.

### Whether there is a likelihood of confusion

I found there to be no likelihood of direct or indirect confusion.

138. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's First Earlier Mark to mind when confronted with the holder's IR. That is, to make a link between them.

139. I remind myself at this stage that finding a likelihood of confusion is not required in order to find a link would be made between the marks. I also recognise that a lesser degree of similarity between the marks than that required for a likelihood of confusion may be sufficient for a relevant section of the public to make a connection between those marks.<sup>31</sup> Moreover, I bear in mind that the closeness of the goods is a factor to be taken into account when considering if the use of the later IR would bring the earlier mark to mind.

140. I note the opponent's strong reputation which resides in the words "MONKEY SHOULDER", combined with the enhanced distinctiveness of the First Earlier Mark. I also bear in mind the identity or high similarity of the parties' class 33 goods, and the similarity of the marks arising from the common presence of the word "MONKEY" at the beginning of them. Although I have found that the relevant public will not confuse the marks, I find that the use of the word "MONKEY" in the holder's IR will bring the First Earlier Mark to mind, in relation to the applicant's class 33 goods. Consequently, taking all of the above into account, I find that a significant part of the UK relevant public would make a link between the First Earlier Mark and the holder's IR.

### **Damage**

141. As noted by paragraph 6 above, the opponent argues that use of the holder's IR would, without due cause, take unfair advantage of its First Earlier Mark, by free-riding on its distinctiveness and reputation, which would likely to lead to a change in the economic behaviour of the opponent's customers.

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<sup>31</sup> *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

142. I also note that in *Argos Limited v Argos Systems Inc* [2018] EWCA Civ 2211, the Court of Appeal held that a change in the economic behaviour of the customers for the goods and/or services offered under the later trade mark was required to establish unfair advantage. This may be inferred where the later trade mark would gain a commercial advantage from the transfer of the image of the earlier trade mark to the later mark: see *Claridges Hotel Limited v Claridge Candles Limited & Anor* [2019] EWHC 2003 (IPEC).

143. Unfair advantage does not require proof of a subjective intention by the applicant to benefit from the reputation of the opponent's mark. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

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

144. For there to be an unfair advantage, it means that consumers are more likely to buy the goods of the contested IR than they would otherwise have been if they had not been reminded of the earlier mark.

145. I also bear in mind that unfair advantage can be taken of an earlier mark where there is no likelihood of confusion between it and the later mark. In these

circumstances, the unfair advantage is usually the result of the transfer of the image of the earlier mark, or of the characteristics it projects, to the goods identified by the later mark. It is also important to keep in mind that the existence of a link does not automatically mean that there is unfair advantage.

146. Having ruled out confusion, I nevertheless find that the holder's IR would take unfair advantage of the opponent's First Earlier Mark for the goods for which I have found a link above. The holder will benefit from the instant familiarity created by the parties' goods being either identical or highly similar, and the marks sharing the same "MONKEY" element at the beginning of the marks. Consequently, I consider that there is a sufficiently serious risk that the holder would benefit from the opponent's significant marketing efforts, without having to do as much groundwork as would normally be required for a new mark, if the IR were used for its goods in class 33.

147. The holder would also benefit from the power of attraction and image transfer from the opponent's mark. The image of a trendy and engaging brand, known for fun and playful marketing events (such as its SWAT and breakdown services, as well as the silent discos and tasting events using its mixer truck), and its award winning top trending/trendiest whisky, will be transferred to the holder's IR and enable the holder to obtain a marketing and commercial advantage, benefitting from the opponent's reputation without paying financial compensation. This is unfair, since the holder has not had to do its own marketing to achieve the result, but would instead be free-riding on the reputation of the First Earlier Mark and the marketing efforts of the opponent.

148. The reputation of the First Earlier Mark will also cause consumers to have expectations about the later mark which they would not otherwise have had, without the applicant having to do its own marketing to create those expectations.<sup>32</sup> Such a finding can be made if that is the objective effect of the later mark, even if there is no proof that the holder intended to take unfair advantage of the earlier mark's reputation.<sup>33</sup>

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<sup>32</sup> *L'Oreal v Bellure and Delta Air Lines, Inc v Marriot Worldwide Corporation* [2023] EWHC 283 (Ch)

<sup>33</sup> *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) and *Monster Energy Company v Red Bull GmbH* [2022] EWHC 2155 (Ch).

149. As I have found there to be unfair advantage, I do not need to consider the other pleaded heads of damage.

150. The opposition based upon section 5(3) of the Act succeeds in its entirety.

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

151. Section 5(4)(a) of the Act states as follows:

“5(4) 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, where the condition in subsection (4A) is met,

aa)...

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”.

152. Subsection (4A) of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

153. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (Reckitt & Colman Product v Borden [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether "a substantial number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

### **Relevant date**

154. Whether there has been passing off must be judged at a particular point (or points) in time. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, sitting as the Appointed Person, considered the relevant date for the purposes of s.5(4)(a) of the Act and stated as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows: ‘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.’” **(my emphasis)**

155. The prima facie relevant date is the IR’s date of designation in the UK i.e. 29 January 2023. It is also necessary to consider what the position would have been at the start of the behaviour complained about. In this case, that will be the date of the first public facing use of the holder’s IR. However, the evidence provided by the holder

shows that it has been trading since 1 August 2023, which is 7 months after its designation date. On this basis, I only have the prima facie relevant date to consider.

## **Goodwill**

156. The House of Lords in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL) provided the following guidance regarding goodwill:

“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 customers. It is the one thing which distinguishes an old-established business from a new business at its first start.”

157. Goodwill arises as a result of trading activities, and it is clear from the turnover figures provided by Mr Jenkins that the opponent has been trading since at least 2019. From 2019 to 2022, the opponent had made £20,608,243 from sales of MONKEY SHOULDER in the UK. This turnover was generated from the sale of 178,728 nine Litre cases, which amounted to 2,144,736 bottles being sold across the UK. I have also been provided with UK advertising figures from 2018 to 2022 amounting to over £5,852,000, and significant evidence showing the many ways in which the opponent has been advertising its brand since 2011.

158. I also bear in mind that the opponent has won multiple awards for its MONKEY SHOULDER whisky, as well as being voted as the top trending Scotch by the World's Best 50 bars in 2015, 2016, 2017, 2018 and 2019. I am therefore satisfied that the opponent has demonstrated a substantial degree of goodwill in relation to whisky, and that its MONKEY SHOULDER sign was distinctive of the opponent's goodwill at the relevant date.

## **Misrepresentation and damage**

159. 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.”

160. I recognise that the test for misrepresentation is different from that for likelihood of confusion in that it entails “deception of a substantial number of members of the public” rather than “confusion of the average consumer”. However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that to be the case here.

161. Under section 5(4)(a), the opponent relies upon its “MONKEY SHOULDER” sign, which mirrors the opponent’s First Earlier Mark that it relies upon under section 5(2)(b).

The evidence that the opponent relies upon for section 5(4)(a) is also the same evidence as summarised in paragraphs 22 to 39, and 99 to 101 above.

162. Albeit the opponent had a substantial degree of goodwill at the relevant date and that the sign relied upon was distinctive of that goodwill, and the holder's class 33 goods are identical and highly similar to the opponent's whisky, I consider that the differences between the opponent's sign and the holder's IR would be sufficient to avoid a substantial number of the opponent's customers and potential customers purchasing the holder's goods in the mistaken belief that they are provided by the opponent's business. As I have found there is no misrepresentation, there can be no damage.

163. The opposition under section 5(4)(a) is unsuccessful.

## **CONCLUSION**

164. The partial opposition is fully successful under section 5(3) only. The IR is therefore refused for the following goods:

Class 33      Gin; spirits; distilled spirits.

165. The opposition was not directed against the IR's following goods for which the request for protection in the UK may be granted:

Class 25      Hoodies; sweaters; aprons; beanies; bucket hats; cap peaks; knit tops; polo shirts; pullovers; t-shirts; vests; children's cloth eating bibs; jackets [clothing]; polo knit tops; tank-tops.

Class 30      Coffee; tea.

## **COSTS**

166. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 1/2023. In the

circumstances, I award the opponent the sum of £2,100 as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and Considering the holder's counterstatement	£250
Preparing and filing evidence	£1,300
Preparing and filing submissions in lieu	£350
Official Fee	£200
<b>Total</b>	<b>£2,100</b>

167. I therefore order Industria Group, LLC to pay William Grant & Sons Limited the sum of £2,100. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 24th day of April 2026**

**L FAYTER**  
**For the Registrar**

## ANNEX 1

### **Holder's applied for goods**

#### Class 25

Hoodies; sweaters; aprons; beanies; bucket hats; cap peaks; knit tops; polo shirts; pullovers; t-shirts; vests; children's cloth eating bibs; jackets [clothing]; polo knit tops; tank-tops.

#### Class 30

Coffee; tea.

#### Class 33

Gin; spirits; distilled spirits.

## **ANNEX 2**

### **The First Earlier Mark**

#### Class 33

Alcoholic beverages.

### **The Second Earlier Mark**

#### Class 33

Alcoholic beverages (except beers).

### **The Third Earlier Mark**

#### Class 33

Alcoholic beverages (except beers).