

O/0679/25

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3980741
BY THE MALT MIND SPIRITS COMPANY LTD**

IN RESPECT OF THE TRADE MARK:



VIKING BLOOD
HIGHLAND SINGLE MALT SCOTCH WHISKY

IN CLASS 33

AND

**IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 446424
BY VIKING RIVER CRUISES (BERMUDA) LTD**

BACKGROUND AND PLEADINGS

1. On 17 November 2023, THE MALT MIND SPIRITS COMPANY LTD (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”) in the UK. The application was published for opposition purposes on 29 December 2023, and registration is sought for goods in Class 33.¹

2. On 15 March 2024, the application was opposed in full by Viking River Cruises (Bermuda) Ltd (“the opponent”). Initially the opposition was based upon sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”), however in a letter dated 12 July 2024, the opponent withdrew the section 5(3) and 5(4)(a) grounds leaving section 5(2)(b) only. The opponent relies upon three earlier comparable United Kingdom Trade Marks (“UKTM”)² for its opposition:

i) UKTM 917655978 – ‘VIKING’ (“the First Earlier Mark”)

Filing date: 3 January 2018;

Registration date: 17 January 2020;

Registered in Classes 9, 36, 39, 41, 43 and 44;

For the purpose of these proceedings the opponent relies upon all the Class 43 services.³

ii) UKTM 917896531 – ‘VIKING WHISKY’ (“the Second Earlier Mark”)

Filing date: 8 May 2018;

Registration date: 27 February 2019;

Priority date: 2 May 2018;⁴

Registered in Class 33;

For the purpose of these proceedings the opponent relies upon all the Class 33 goods.⁵

¹ See goods comparison.

² Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing registered EUTM or International Registration designating the EU. As a result, the opponent’s mark was converted into a comparable UK trade mark. Comparable UK marks are now recorded in the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same. See also Tribunal Practice Notice (“TPN”) 2/2020 End of Transition Period – impact on tribunal proceedings.

³ See the Annex at the end of this decision.

⁴ UNITED STATES OF AMERICA (US) 87903848.

⁵ See goods comparison.

iii) UKTM 917896532 – ‘VIKING GIN’ (“the Third Earlier Mark”)

Filing date: 8 May 2018;

Registration date: 27 February 2019;

Priority date: 2 May 2018;⁶

Registered in Class 33;

For the purpose of these proceedings the opponent relies upon all the Class 33 goods.⁷

3. The opponent claims that the marks are highly similar and that the goods and services covered by the marks are either identical or similar, resulting in a likelihood of confusion on the part of the public, which includes a likelihood of association.

4. The applicant filed a counterstatement denying the grounds of opposition.

5. The opponent’s marks qualify as earlier marks under section 6(1) of the Act. As they had not completed their registration procedure more than five years before the application date for the contested mark, they are not subject to the use provisions contained in section 6A of the Act. Consequently, the opponent may rely upon all of the goods and services for which the earlier marks are registered without having to establish genuine use.

6. The applicant is represented by JINXUJIA; the opponent is represented by Bristows LLP. No hearing was requested and only the opponent chose to file written submissions in lieu of a hearing. This decision is taken following a careful review of the papers.

7. 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.

⁶ UNITED STATES OF AMERICA(US) 87903845.

⁷ See the Annex at the end of this decision.

MY APPROACH

8. The opponent relies upon three earlier marks. In my view, the Second Earlier Mark, UKTM 917896531 'VIKING WHISKY' and its respective Class 33 goods are the closest in terms of similarity with the contested mark and the Class 33 goods at issue. Accordingly, I will consider the opposition on the basis of that mark, in the first instance, returning to the First and Third Earlier Marks only to the extent that it is necessary to do so. For ease of reference, going forward, I will refer to the opponent's Second Earlier Mark as, simply, 'the opponent's mark'.

DECISION

Section 5(2)(b): legislation and case law

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

“(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.”

10. I am guided by the following principles, gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *SABEL BV v Puma AG* (Case C-251/95), *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (Case C-39/97), *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV* (Case C-342/97), *Marca Mode CV v Adidas AG & Adidas Benelux BV* (Case C-425/98), *Matratzen Concord GmbH v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (Case C-3/03), *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*

(Case C-120/04), *Shaker di L. Laudato & C. Sas v OHIM* (Case C-334/05 P) and *Bimbo SA v OHIM* (Case C-519/12 P):

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

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

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

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

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

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

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

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

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

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

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

Comparison of goods

11. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 33</u> Distilled spirits; whisky.	<u>Class 33</u> Scotch Whisky complying with the specifications of the PGI Scotch whisky.

12. In *Gérard Meric v Office for Harmonisation in the Internal Market*, 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."

13. The applicant's goods fall within the opponent's broad terms *distilled spirits; whisky*. Consequently, the goods are identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

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

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

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

16. The relevant consumers of the goods at issue will include adult members of the general public as well as members of the business community. The goods at issue will typically be sold through a range of retail outlets, such as supermarkets and off-licences, and their online equivalents, where the goods will be displayed on shelves, from which they will be self-selected by consumers. A similar process will apply to websites, where consumers will select the goods after viewing images and information displayed on a webpage. Accordingly, visual considerations would dominate. Goods such as these are also sold in hospitality settings such as in restaurants, bars, nightclubs and public houses. In these environments, there may be an aural component to the selection process, such as requests to bar and waiting staff.

However, even where the goods are ordered in this way, the selection process would still be in the context of a visual inspection of the goods on a drinks' menu, for example, prior to the order being placed. Therefore, in general, the purchasing process would be primarily visual in nature, though I do not discount that aural considerations will play their part.⁸

17. On average, the general public are likely to purchase the goods fairly frequently for the purposes of enjoyment or socialising. The price of the goods is likely to vary, however, in general, they are relatively inexpensive purchases. I find that the purchasing process is likely to be more casual than careful and will not require an overly considered thought process. The general public will, however, consider factors such as quality, price, taste or flavour and alcoholic content, etc., when selecting the products. Taking the above factors into account, I find that the general public will demonstrate a medium level of attention in respect of these goods.

18. As previously indicated, the goods may also be purchased by the owners of businesses such as, for example, bars, public houses, restaurants and nightclubs. For these consumers, the goods are likely to be frequent purchases for the ongoing operation of the business. Businesses are likely to purchase the goods from distributors and wholesalers, as well as through online channels. In these circumstances, the goods are likely to be purchased after a visual inspection of the product, or after viewing information in brochures or on the Internet. As such, the purchasing process will be largely visual in nature. However, businesses may also engage in discussions with salespersons about the products. Therefore, I do not discount aural considerations entirely. In addition to the factors considered by the general public during the selection process, these consumers will be acutely aware that the goods they are selecting will be consumed by their customers, as well as the negative impact of choosing the wrong goods for their business. Due to this increased responsibility and liability, it is my view that the level of attention paid by consumers from the business community when purchasing these goods will be slightly higher than medium, although not considerably so.

⁸ *Rani Refreshments FZCO v OHIM*, Case T-523/12; *Devinlec v OHIM — TIME ART (QUANTUM)* [2006] ECR II 11, Case T 147/03; *Anton Riemerschmid Weinbrennerei und Likörfabrik GmbH & Co. KG v EUIPO*, T-187/17.

Comparison of the marks

19. It is clear from *Sabel BV v. Puma AG* 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 them, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo SA v OHIM*, that:

“34. [...] 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.”

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

21. The trade marks to be compared are as follows:

The opponent's mark	The applicant's mark
VIKING WHISKY	 VIKING BLOOD HIGHLAND SINGLE MALT SCOTCH WHISKY

22. Both parties have filed lengthy submissions⁹ regarding the similarity of the marks. Whilst I do not propose to reproduce those here, I have taken them all into consideration in reaching my decision.

Overall impression

23. The applicant's mark contains the words 'VIKING BLOOD' in a large, uppercase, stylised font. Positioned below 'VIKING BLOOD' are the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY' which are presented in a much smaller font. Positioned above 'VIKING BLOOD' is a circular device, incorporating an unbroken decorative design around its outer edge and a decorative design element resembling a large, stylised letter 'V' at its centre. In my view the words 'VIKING BLOOD' play the greater role in the overall impression due to their size and position in the mark and the fact that the eye is naturally drawn to the element of the mark that can easily be read.¹⁰ The decorative device element and stylisation present in the mark are not particularly remarkable, and therefore play a slightly lesser role, with the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY' playing a much lesser role due to their size and descriptive nature.

24. The opponent's mark consists of the words 'VIKING WHISKY' presented in standard uppercase letters without any stylisation. Whilst the 'WHISKY' element adds an additional visual, aural and conceptual dimension to the mark, in my view, it is one of a description rather than as a distinctive element that assists in identifying trade origin. Accordingly, I find the word 'VIKING' to be the dominant and distinctive element in the mark.

Visual comparison

25. Visually the marks coincide insofar as they share the same first word 'VIKING' and the last word 'WHISKY'. I do not consider the distinction in letter stylisation between the marks to be points of significant difference between them.¹¹ The marks are visually

⁹ The applicant's submissions were contained in its TM8 and counterstatement.

¹⁰ *MigrosGenossenschafts-Bund v EUIPO*, T-68/17.

¹¹ *Bentley Motors Limited v Bentley 1962 Limited*, BL O/158/17.

different in that the applicant's mark contains a device element as well as the additional words 'BLOOD' and 'HIGHLAND SINGLE MALT SCOTCH', none of which are replicated in the opponent's mark. I find the marks to be visually similar to between a low to medium degree.

Aural comparison

26. I acknowledge that a case can be made that neither of the marks at issue will be articulated in full on the basis that they contain descriptive words, namely the word 'WHISKY' in the opponent's mark and the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY' in the applicant's mark. However, despite this, I will proceed on the basis that they will be pronounced. On this point, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended*,¹² wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible.

27. The opponent's mark consists of four syllables, namely 'VI-KING-WHIS-KY'; the applicant's mark consists of eleven syllables, namely 'VI-KING-BLOOD-HIGH-LAND-SIN-GLE-MALT-SCOTCH-WHIS-KY', therefore the marks share their first two and last two syllables. The applicant's circular device element and the decorative element around the outer edge of the device will not be articulated. The decorative element at the centre of the device will either be perceived as just that, or as a stylised letter 'V'. If perceived as a letter 'V', it would likely be articulated as 'vee', if pronounced. However, I am of the view that it is unlikely that it will be articulated. I acknowledge that the additional words in the applicant's mark make for a much longer mark, however, in respect of the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY' in the applicant's mark, and 'WHISKY' in the opponent's mark, I keep in mind their lesser roles within the respective marks along with the identity of the beginning of the marks, i.e. 'VIKING', being where the average consumer tends to focus. Accordingly, I am of the view that the marks are aurally similar to a medium degree.

¹² Case BL O/115/22.

Conceptual comparison

28. 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] E.C.R.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

29. The word 'VIKING' present in the respective marks will be an immediately recognisable word for the average consumer, i.e. as reference to Scandinavian seafarers, namely *the Danes, Norwegians, and Swedes who raided by sea most of Northern and Western Europe from the 8th to the 11th centuries, later often settling, as in parts of Britain.*¹³ Accordingly, this element in the marks share the same concept. The fact that this word is stylised in the applicant's mark does not detract from this concept.

30. With regards to the ordinary dictionary word 'BLOOD', present in the applicant's mark, this acts as a point of conceptual difference. However, I am of the view that this word will be considered in combination with the word 'VIKING', i.e. 'VIKING BLOOD'. Accordingly, in this context, contrary to the applicant's submissions,¹⁴ I am of the view that consumers will likely perceive the word 'BLOOD', not as the red liquid that flows inside a body, but rather as being reference to *a relationship through being of the same family, race or kind (kinship)*,¹⁵ for example, being of 'Viking' origin or 'Viking' lineage, etc. Therefore, in respect of the goods concerned, I am of the view that consumers will perceive the words 'VIKING BLOOD' as being an indication that they are of 'Viking' origin or 'Viking' lineage, etc., and not that the goods themselves are intended to represent the blood of a 'Viking'.

31. The word 'WHISKY' in the opponent's mark and the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY' in the applicant's mark, will be widely understood by the relevant consumers as references to a strong alcoholic drink made from grain such as barley or rye. Accordingly, these elements in the marks share the same concept.

¹³ www.collinsdictionary.com/dictionary/english/viking.

¹⁴ Form TM8 and Counterstatement, dated 15 May 2024.

¹⁵ www.collinsdictionary.com/dictionary/english/blood.

However, as noted earlier, this concept plays a descriptive role in respect of the goods concerned, and therefore has a lesser impact than the concept of the elements that are distinctive.

32. As for the device element present in the applicant's mark, this will merely be perceived as a decorative element, with no clear relationship to the words 'VIKING BLOOD HIGHLAND SINGLE MALT SCOTCH WHISKY'. Alternatively, if the figurative element at the centre of the device is perceived as the letter 'V', this will likely be understood as representing the twenty-second letter of the English alphabet, and as the first letter of the word 'VIKING'.

33. The marks of both parties share the same concept of 'VIKING' and 'WHISKY' but in all other respects they are different. However, due to the dominant position of the 'VIKING' element in the marks, I find that it will be the most prominent concept in both. Accordingly, keeping in mind my comments regarding the conceptual meaning of 'VIKING BLOOD', i.e. being of 'Viking' origin or 'Viking' lineage, etc., I conclude that the respective marks share at least a medium level of conceptual similarity.

Distinctive character of the opponent's mark

34. The distinctive character of a trade mark can be measured only, first, by reference to the goods or services in respect of which registration is sought and, second, by reference to the way it is perceived by the relevant public. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, the CJEU stated that:

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

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

35. 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 goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

36. Although the distinctiveness of a mark can be enhanced by virtue of the use that has been made of it, the opponent has not filed any evidence of use in relation to the earlier mark. Consequently, I have only the inherent position to consider

37. The earlier mark is a word mark comprising the words ‘VIKING WHISKY’. As previously stated, the word ‘VIKING’ will be understood as a reference to a Scandinavian seafarer who raided and settled in Europe and beyond from the 8th to the 11th century; the word ‘WHISKY’ will be understood as reference to a strong alcoholic drink, made from grain such as barley or rye. Consequently, as the word ‘WHISKY’ adds little or nothing to the distinctive character of the mark, the distinctive character rests with the ‘VIKING’ element which has no obvious meaning in respect of the goods at issue. As such, when considering the mark as a whole, I find it to be inherently distinctive to a medium degree.

Likelihood of confusion

38. 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. One such factor is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier trade mark, the average consumer for the goods and services, and the nature of the purchasing process. In doing so, I must be mindful to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that they have retained in their mind.

39. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one trade mark for the other, while indirect confusion is where the average consumer realises the trade marks are not the same but puts the similarity that exists between the trade marks and goods down to the responsible undertakings being the same or related.

40. Earlier in the decision I found that:

- The marks are visually similar to between a low to medium degree, aurally similar to a medium degree and conceptually similar to at least a medium degree;
- I have found the parties' goods to be identical under the principle outlined in *Meric*.
- The earlier mark is inherently distinctive to a medium degree.
- The average consumer would include members of the general public (those over the age of 18) as well as members of the business community, who will source the goods by both visual and aural means. Given the nature of the goods, I have concluded that the level of attention paid will range from medium to slightly higher than medium, although not considerably so.

41. Taking all the above factors into account, bearing in mind the visual differences between the marks, as well as the predominantly visual purchasing process, I do not consider it likely that the marks will be mistakenly recalled or misremembered as each other. Consequently, I do not consider there to be a likelihood of direct confusion.

42. Having found no likelihood of direct confusion, I now go on to consider indirect confusion.

43. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC (as he then was), as the Appointed Person, explained that:

“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).”

44. These examples are not exhaustive but provide helpful focus.

45. 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.

46. I acknowledge that a finding of indirect confusion should not be made merely because the respective marks share a common element; and it is not sufficient that a mark merely calls to mind another mark:¹⁶ this is mere association not indirect confusion. However, in the current case I find that the ‘VIKING’ element, common to both the opponent’s and applicant’s marks is the dominant and distinctive element in the earlier mark. Likewise, with regards to the applicant’s mark, whilst the word ‘VIKING’ will likely be considered in combination with the word ‘BLOOD’, namely ‘VIKING BLOOD’, meaning being of ‘Viking’ origin or ‘Viking’ lineage, etc, I am of the view that the ‘VIKING’ element plays an independent distinctive role.¹⁷ This impression is not offset by the device element present in the mark. Furthermore, due to the lack of distinctive character in the words ‘WHISKY’ and ‘HIGHLAND SINGLE MALT SCOTCH WHISKY’ in the respective marks, whilst these elements are unlikely to go unnoticed, I find that due to their wholly descriptive nature in terms of the goods at

¹⁶ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17.

¹⁷ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch).

issue, these elements add little or nothing to the overall distinctive character of the marks.

47. Accordingly, in my view, the present case falls into the first category identified above in *LA Sugar*. Due to the distinctive nature of the word 'VIKING' and in terms of the identical goods at issue, the average consumer is likely to assume that no-one else, but the brand owner would be using the word 'VIKING' in a mark. Therefore, with regards to the applicant's mark, I find that the addition of the word 'BLOOD' (indicating origin or lineage, etc), to the distinctive word 'VIKING', along with the device element is consistent with a brand variant, and as such, the average consumer is likely to perceive the marks at issue as originating from the same or economically connected undertakings. I consider that there is such a risk because the goods at issue are identical, and the marks have clear similarity, indicative of a possible connection between them. Accordingly, I am of the view that it will be natural for a consumer to assume that the applicant's mark is a version of the opponent's mark, or vice versa. Consequently, taking all of this into account together with my other findings, including the identity of the respective goods, when considering the marks, as a whole, I find that the average consumer is likely to believe that all the goods provided under the marks are provided by the same or linked undertaking. Therefore, there is a likelihood of indirect confusion

CONCLUSION

48. Given that the opposition based on the Second Earlier Mark has been wholly successful, the outcome of the opposition in respect of the opponent's First and Third Earlier Marks would not advance the opponent's position. That said, whilst I see no merit in carrying out a full and detailed comparison of the respective marks and their goods and services, for the sake of completeness, I consider it appropriate to set out, briefly, whether there would exist a likelihood of confusion.

The First Earlier Mark - UKTM 917655978 'VIKING' (Class 43¹⁸)

49. I am of the view that a likelihood of confusion would exist between the opponent's First Earlier Mark and the applicant's mark. Firstly, I am of the view that the applicant's goods, namely *Scotch Whisky complying with the specifications of the PGI Scotch whisky* and the opponent's *bar services* have a low degree of similarity on the basis that they can coincide in their target audience, suppliers and distribution channels. There is also a degree of complementarity on the basis that the applicant's goods are indispensable for the provision of the opponent's services and therefore, consumers might think that the responsibility for the goods and services lies with the same undertaking.¹⁹ Secondly, the respective marks identically share the distinctive word 'VIKING'. Accordingly, as per paragraphs 46 and 47 of this decision, notwithstanding the lack of the word 'BLOOD' or the figurative device element, present in the applicant's mark, and bearing in mind the lack of distinctive character in the words 'HIGHLAND SINGLE MALT SCOTCH WHISKY', I consider that the First Earlier Mark and the contested mark represent an example of an instance wherein the consumer would consider the differences between them to be logical indicators of brand variants. Therefore, for the same reasons, I find that a likelihood of indirect confusion exists between the marks.

The Third Earlier Mark - UKTM 917896532 'VIKING GIN' (Class 33²⁰)

50. I consider that a likelihood of confusion would exist between the *Third Earlier Mark* and the applicant's mark. I say this firstly on the basis that the goods at issue are *Meric* identical as the applicant's goods fall within the opponent's broad term *distilled spirits*; and secondly, because the respective marks identically share the distinctive word 'VIKING'. Accordingly, as per paragraphs 46 and 47 of this decision, for the same reasons, notwithstanding the lack of the word 'BLOOD' or the figurative device element, present in the applicant's mark, and bearing in mind the lack of distinctive character in the words 'GIN' and 'HIGHLAND SINGLE MALT SCOTCH WHISKY' respectively, I consider that the Third Earlier Mark and the contested mark represent

¹⁸ See Annex.

¹⁹ CIPRIANI - T-438/16, CIPRIANI / HOTEL CIPRIANI et al., EU:T:2018:110.

²⁰ See Annex.

an example of an instance wherein the consumer would consider the differences between them to be logical indicators of brand variants. Therefore, I find that a likelihood of indirect confusion exists between the marks.

51. Accordingly, as the opposition under section 5(2)(b) succeeds in full, the applicant's mark is hereby, subject to any successful appeal of my decision, refused registration for all the goods applied for.

COSTS

52. As the opponent has succeeded, it is entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023. I award costs to the opponent on the following basis:

Official fee: ²¹	£100
Preparing a notice of opposition and considering the counterstatement:	£300
Written submissions in lieu :	£350
Total:	£750

53. I therefore order THE MALT MIND SPIRITS COMPANY LTD to pay Viking River Cruises (Bermuda) Ltd the sum of £750. The above sum should 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.

²¹ Although the opponent initially opposed under sections 5(2)(b), 5(3) and 5(4)(a), the latter two grounds were withdrawn in submissions dated 12 July 2024, without being evidenced so the case proceeded on 5(2)(b) only. Therefore, I have reduced the opposition fee accordingly.

Dated this 22nd day of July 2025

**Sam Congreve
For the Registrar**

Annex

UKTM 917655978 - VIKING ("the First Earlier Mark")

Class 43 Services for providing food and drink; temporary accommodations; hotel services; restaurant services; bar services; café services; travel agency services, namely, making reservations and bookings for hotels, restaurants, bars and temporary accommodations; reservation and booking services for hotels, bars, restaurants and temporary accommodations; consultancy and advisory services relating to all the aforesaid.

UKTM 917896532 - VIKING GIN ("the Third Earlier Mark")

Class 33 Distilled spirits; gin.