

O-0744-25

TRADE MARKS ACT 1994
IN THE MATTER OF CONSOLIDATED PROCEEDINGS BEING
TRADE MARK APPLICATION NOS. 3831924 & 3634530
BY GLENS OF ANTRIM POTATOES LIMITED
TO REGISTER



(SERIES OF TWO)

AND

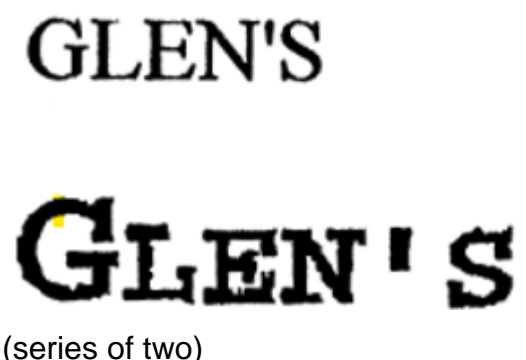
GLENS OF ANTRIM

AS TRADE MARKS IN CLASSES 16, 21, 25, 33 & 43
AND OPPOSITIONS THEREOF UNDER NOS. 438887 & 430482
BY LOCH LOMOND DISTILLERS LIMITED

BACKGROUND AND PLEADINGS

1. Glens of Antrim Potatoes Limited (“the applicant”) applied for the figurative mark, set out above on the title page as a series of two marks, on 22 September 2022. It was published in the Trade Marks Journal on 28 October 2022 in classes 16, 21, 25, 33 and 43. The applicant applied for the word mark, set out above on the title page, on 29 April 2021. It was published on 22 October 2021 in classes 21, 25 and 33. Only some goods in class 33 have been opposed and it is the same goods in both applications, namely *alcoholic beverages (except beer); spirits; distilled spirits; spirits and liquors; gin; vodka; schnapps*.¹

2. Loch Lomond Distillers Limited (“the opponent”) partially opposed the word application on 24 January 2022 and the figurative application on 27 January 2023. In both cases opposition is brought on the basis of section 5(2)(b) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). Under section 5(2)(b) the opponent relies on the following UK and comparable² trade mark registrations.

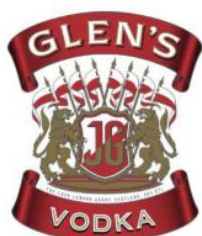
Earlier UK TMs	Goods relied on
No. 2324314  (series of two)	33: <i>alcoholic beverages, excluding beer and whisky.</i>

¹ In the Notices of Opposition, the opponent states at section Q3 “in as far as the broad terms *“alcoholic beverages (except beer); spirits; distilled spirits; spirits and liquors* are concerned, the opposition is not directed to *whisky and whisky based liquors*.”

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 marks were converted into comparable UK trade marks. 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.

<p>Filing date: 20 February 2003 Registration date: 23 March 2007</p>	
<p>No. 2319225A GLEN'S GLEN'S VODKA GLEN'S GIN GLEN'S WHITE RUM GLEN'S DARK RUM (series of five)³ Filing date: 18 December 2002 Registration date: 26 January 2007</p>	<p><i>33: alcoholic beverages excluding whisky; vodka, gin.</i></p>
<p>No. 903231131 GLEN'S Filing date: 18 June 2003 Registration date: 10 September 2009</p>	<p><i>33: alcoholic beverages excluding whisky; vodka, gin.</i></p>

3. Under section 5(4)(a) of the Act, the opponent claims use of the sign set out below since 2003 for *distilled spirits; vodka*.



³ In the Notices of Opposition, the opponent states at section A that it relies on only the first three marks of this series.

4. The applicant filed counterstatements in which it denied the respective marks were similar and put the opponent to proof of its claims.
5. The proceedings were consolidated and confirmation of the same was sent by the Tribunal in its letter dated 5 October 2023.
6. The parties have been represented throughout these proceedings. The applicant's representative is Lewis Silkin LLP and the opponent's is Keltie LLP.
7. The opponent filed evidence, and the applicant filed written submissions during these proceedings. A hearing was requested. The matter was heard before me, via video conference, on 19 November 2024. The applicant was represented by Sam Carter of Counsel, instructed by Lewis Silkin and the opponent was represented by Tariq Usman of Counsel, instructed by Keltie.
8. I make this decision following consideration of all the material before me and the submissions made at the hearing.
9. 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

Preliminary issues

10. The opponent's registrations have filing dates that are earlier than the filing dates of the applications and are therefore earlier marks, in accordance with section 6 of the Act. As the registration procedures for all earlier marks were completed more than 5 years prior to the filing date of the contested applications, they are subject to the use conditions, as per section 6A of the Act. The opponent made a statement of use in respect of all the goods it relies on.

Relevant periods

11. My first task is to establish whether, or to what extent, the opponent has shown genuine use of its earlier marks within the 'relevant period'. The relevant period is defined as being a period of five years ending with the filing or priority date of the contested application. The relevant periods are as follows:

- for the contested figurative mark - 23 September 2017 to 22 September 2022
- for the contested word mark - 30 April 2016 to 29 April 2021.

Opponent's evidence in chief

12. The opponent filed a witness statement dated 12 December 2023, in the name of Christopher Mitchell, who holds the position of Director. Mr Mitchell appends 8 exhibits. The pertinent points are set out below.

13. Mr Mitchell states that the opponent is the trading subsidiary of Loch Lomond Group and "is responsible for the manufacture, bottling and sale of the company's alcoholic beverages brands in the UK and overseas, in particular Scotch whiskey, vodka, gin and rum".⁴ Mr Mitchell also states that the opponent's mark, namely GLEN'S, was first used for vodka in 2003 and in 2014 for its gin and rum products.

14. Mr Mitchell sets out the following turnover between 2015 – 2022 for the opponent's vodka and gin products.

	Sales of vodka	Sales of gin
2015	£15,755,333	
2016	£15,912,682	£44,024
2017	£15,738,703	£55,996
2018	£15,448,619	£60,092
2019	£16,962,142	£79,064
2020	£22,466,155	£57,139
2021	£26,308,875	£61,951

⁴ Christopher Mitchell, witness statement paragraph 4.

2022	£30,000,456	£63,429
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15. Mr Mitchell gives the following advertising expenditure for GLEN'S branded spirits.

2019	£127,867
2020	£101,987
2021	£493,032
2022	£704,258
2023 YTD	£620,238

16. Mr Mitchell provides information from an annual survey undertaken by Nielsen Market Research and The Grocer indicating that GLEN'S VODKA was the 11th best selling brand in the top 100 UK biggest selling alcohol brands in 2014. Between 2015 and 2021, the mark GLEN'S rather than GLEN'S VODKA is used in the chart and its position fell down in the list in successive years but overall it remained in the top 25 during this period.⁵

17. Mr Mitchell exhibits a number of photographs dated between 2015 – 2022 showing bottles, boxes and crates of the opponent's products for sale in various retail and wholesale premises, such as Booker Wholesale and Wine World. The marks used on the goods comprise GLEN'S solus, GLEN'S VODKA, GLEN'S GIN and the sign identified at paragraph 3 of this decision. The prices, where displayed, are in pounds sterling. Three illustrative examples of the exhibited images are set out below:⁶



⁵ Exhibit CAM6.

⁶ Exhibit CAM1.

18. Mr Mitchell also exhibits a number of invoices⁷ issued by the Loch Lomond Group for orders of its GLEN'S branded vodka, gin and rum products to UK and EU customers dated between 2015-2022.⁸

19. Courtesy of the Wayback Machine internet archive service, Mr Mitchell exhibits screen shots from the opponent's website, namely glensvodka.com, dated between June 2016 and January 2022, and showing images of the sign shown at paragraph 3 and also showing use of GLEN'S and GLEN'S VODKA in text. The images show the regular and platinum vodka products. Mr Mitchell states the opponent has a social media presence on Facebook and Instagram using the handle Glen's Vodka. An illustrative example of posts dated between 2016 and 2022 are exhibited.⁹

20. Mr Mitchell exhibits a screenshot dated 30 June 2021 consisting of an image of the Scottish Professional Football League ("SPFL") Premiership trophy, positioned next to a bottle of GLEN'S VODKA under the banner "The Spirit of the SPFL".¹⁰ Mr Mitchell states that the opponent has been a sponsor of the SPFL since 2020 under the GLEN'S VODKA brand. Sponsorship includes pitch side advertising as well as presenting rights for the manager of the month and season awards and a women's international player of the year award. In addition, the opponent also sponsors the Scottish Premiership side Motherwell FC and in particular the GLEN'S VODKA brand appears on the team kit. Mr Mitchell exhibits a number of mainstream and trade press articles relating to the opponent's SPFL sponsorship deal during 2020/21 season.¹¹ The opponent's parent company, Loch Lomond Group, also sponsor the rugby league team Wigan Warriors. Mr Mitchell exhibits a screenshot of an online statement from Wigan Warriors welcoming its new sponsor partner, dated September 2021. The brand GLEN'S VODKA is mentioned in the text.¹²

⁷ Exhibit CAM2.

⁸ Exhibit CAM2.

⁹ Exhibit CAM4.

¹⁰ Exhibit CAM3.

¹¹ Exhibit CAM5.

¹² Exhibit CAM5.

Applicant's submissions in reply

21. The applicant filed written submissions dated 14 February 2024 in reply to the opponent's evidence in chief. The applicant claimed that much of the evidence should be disregarded for a number of reasons. In particular it claimed that the figures given as turnover and advertising expenditure were not substantiated and that the declarant did not state which of the earlier registered marks were in evidence.

Opponent's evidence in reply

22. The opponent filed a second witness statement in the name of Christopher Mitchell dated 5 April 2024. In the second statement Mr Mitchell confirms that all turnover and advertising expenditure figures were taken from the opponent's company records to which he has access. In addition Mr Mitchell also cross referenced the earlier marks relied on with the exhibits annexed to the first witness statement.

23. This completes my summary of the evidence.

Relevant statutory provision: Section 6A:

24. "(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.

(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.”

25. As the opponent’s earlier mark No. 903231131 is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the “five-year period”) has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

26. Section 100 of the Act states that:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

27. 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 Bunderversvereinigung 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 Merken 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].”

28. I also find the following case law to be helpful where in *Awareness Limited v Plymouth City Council*,¹³ Mr Daniel Alexander Q.C. (as he was then) as the Appointed Person stated that:

¹³ Case BL O/236/13

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

Variant use

29. The opponent’s earlier marks are registered in both serif and sans serif typefaces. The use in evidence consists chiefly of the stylised sign as applied to the bottles themselves or GLEN’S and GLEN’S VODKA in plain block capitals when used in text.

There are also examples in the evidence of the opponent using the mark in a stylised form, namely the words Glen's and Vodka in a curved form separately placed on banderoles, such as the example given below.



The question I must consider is whether use in the stylised forms constitutes acceptable variant use of the earlier registered marks.

30. In *PW Branding, Inc v Zabou Group Limited*,¹⁴ Mr Philip Harris, sitting as the Appointed Person, considered the matter of variant use for stylisations and summarised the current case law on the issue. He said,

“it is quite clear – the font must not be taken into account in considering the use of word marks. The protection is for the distinctive character of the words themselves, not in form they are presented”.

31. On the basis of the guidance given above, I find the above to be an acceptable variant of the earlier registered marks.

Sufficiency of use

32. I find that opponent has demonstrated a reasonable turnover for its vodka and gin products. Although no turnover is given for its rum products, I note that the invoices given in evidence at exhibit CAM2 do indicate rum sales to the extent of several thousand pounds during the relevant period. In addition I find the opponent has demonstrated use of GLEN'S and GLEN'S VODKA in its promotional materials and social media material. Its vodka sales have been sufficient to warrant inclusion

¹⁴ BL O/0234/25 at 68

in the annual top 100 best selling alcoholic brands poll undertaken by The Grocer and Nielsen during the relevant period. Moreover in its skeleton argument,¹⁵ the applicant accepted that the opponent had shown genuine use of GLEN'S VODKA in relation to vodka products and similarly for GLEN'S GIN in relation to gin products. Taking all this in to account I find that the opponent has demonstrated sufficient genuine use.

Framing a fair specification

33. The next stage is to decide whether the opponent's use entitles it to rely on all of the goods for which its earlier marks are registered based on my assessments given above. In framing a fair specification, I rely on guidance given in the following judgments. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*,¹⁶ 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.”

34. Moreover in *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors*,¹⁷ Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

¹⁵ Applicant's skeleton argument at paragraph 16

¹⁶ BL O/345/10

¹⁷ [2016] EWHC 3103 (Ch)

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

35. I have found that the opponent has demonstrated use on vodka and gin products. Furthermore there are some sales of rum products shown in its evidence. However, its registrations contain the broader term *alcoholic beverages excluding beer and whisky*. Much was made of this term in the hearing, with the opponent

submitting that the average consumer would see the specific goods as being alcoholic beverages as they are displayed and purchased from a selection of goods which belong to the category of alcoholic beverages. Unsurprisingly the applicant takes the contrary view that the average consumer would simply see the goods as being types of vodkas, gins and rums. I have considered the breadth of the term alcoholic beverages, and I note that within that term there are different classes of beverage defined by reference to alcohol by volume (“ABV”), namely beers, wines and spirits. Leaving aside the ABV definition, from my own consumer knowledge, I understand the term alcoholic beverages can contain everything from absinthe to alcopops but in my view some of those goods, even though they are alcoholic beverages, will have a wide distance been them. As such I feel the term alcoholic beverages is too broad a category for what has been provided in evidence and would give the opponent an unfair monopoly of goods for which there is no use. However, following the guidance set out above in *Property Renaissance Ltd*, I find that most consumers would view the specific goods as belonging to the spirits subcategory of alcoholic beverages. The photographs shown in exhibit CAM1 which are of retail displays demonstrate that the goods are displayed with other spirits like brandies, liqueurs and whiskies and are not displayed with wines or beers. As such I find that *spirits, not including beer and whisky; vodka, gin, rum* is a fair specification.

Section 5(2)(b)

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

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

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

37. The following principles are gleaned from the judgments of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C3/03, *Medion AG v Thomson Multimedia*

Sales Germany & Austria GmbH, Case C-120/04, *Shaker di L.Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles:

(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 the 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 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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of the goods

38. In *Canon*,¹⁸ the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

39. Guidance on this issue has also come from Jacob J. (as he then was) in *British Sugar Plc v James Robertson & Sons Ltd* (the *Treat* case),¹⁹ where he identified the factors for assessing similarity as:

¹⁸ *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, C-39/97

¹⁹ [1996] R.P.C. 281

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

40. In addition I find the following case law to be helpful when in *Gérard Meric v Office for Harmonisation in the Internal Market*,²⁰ 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.”

41. The goods to be compared are:

Opponent’s goods	Applicant’s goods
<i>Spirits, not including beer and whisky; vodka, gin, rum.</i>	<i>alcoholic beverages (except beer); spirits; distilled spirits; spirits and liquors; gin; vodka; schnapps.</i>

²⁰ Case T- 133/05

42. The terms *vodka* and *gin* appear in both specifications and are self-evidently identical.

43. The applicant's term *alcoholic beverages (except beer)* is sufficiently broad to cover the opponent's goods and they are therefore considered identical on the *Meric* principle.

44. The applicant's terms *spirits; distilled spirits; spirits and liquors* are sufficiently broad to cover the opponent's goods and are therefore considered identical on the *Meric* principle.

45. I consider the applicant's term *schnapps* to be similar to a medium degree to *vodka* and *gin* as it is also a distilled spirit flavoured with fruit or herbs. Therefore it is similar in nature and purpose. Moreover the respective goods will attract the same users and the goods will be sold through the same trade channels. There is also a degree of competition between the respective goods.

Average consumer and the purchasing process

46. I next consider who the average consumer is for the goods at issue and how they are purchased. It is settled case law that the average consumer is deemed to be reasonably well informed and reasonably observant and circumspect.²¹ 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.²²

47. The average consumers for the contested goods are members of the public who are over 18 years old. The goods will be available through a number of trade channels. These can include retail outlets such as supermarkets, convenience stores or off-licences as well as pubs, bars, clubs and restaurants.

48. The purchasing process is therefore likely to be predominantly visual for self-selection of goods from a shelf in a retail establishment or online equivalent, but I

²¹ *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).

²² *Lloyd Schuhfabrik Meyer*, Case C-342/97.

bear in mind the aural component especially for ordering drinks in a bar setting. The goods at issue are relatively inexpensive items which are purchased on a reasonably frequent basis. Consumers will consider factors such as the type, flavour and alcoholic strength of the drink when making their selection. In my view a medium level of attention is likely to be paid.

Mark comparisons


49. 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 *Bimbo SA v OHIM*,²³ 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.”

50. 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.

²³ Case C-591/12P

51. The respective trade marks to be compared are:

Opponent's marks	Applicant's marks
<p>GLEN'S</p> <p>GLEN'S</p>	
<p>GLEN'S</p> <p>GLEN'S VODKA</p> <p>GLEN'S GIN</p>	<p>GLENS OF ANTRIM</p>
<p>GLEN'S</p>	

52. The opponent's marks all essentially consist of the word **GLEN'S** in either plain or slightly stylised serif typeface and with two marks having an additional descriptive word namely vodka and gin. As such I find **GLEN'S** is the dominant and distinctive element.

53. The applicant's word mark consists of **GLENS OF ANTRIM** in block capitals and plain typeface. These three words form a unitary meaning and is greater than the sum of its parts. Each word contributes equally to the overall impression of the mark.

54. The applicant's figurative mark is a composite word and device arrangement and is a series of two marks. The difference in the series being only that the first mark is

rendered in colour, being orange on a blue background, and the second mark is its greyscale equivalent. The device is of a skein of four geese or waterfowl, rendered in a light and dark shade of orange, positioned above the words **Glens of Antrim** in title case, also rendered in orange. **Glens of Antrim** are in turn positioned above the word **DISTILLERY** in block capitals and also in orange. The final line below **DISTILLERY** consists of the words **SPIRITS, MYTHS & LEGENDS** as a strapline in block capitals, also in orange. The device and words contribute to the overall impression of the mark although it is not an equal contribution. In marks which consist of words and devices, it is a general rule of thumb that the words will speak louder than the devices. I consider that rule to be applicable in this case. Although the device here is significant in terms of its size, position and stylisation and will make a substantial visual impact, the mark is likely to be referred to by the **Glens of Antrim** word element, especially as the word **DISTILLERY** is non-distinctive in relation to alcoholic beverages and **SPIRITS, MYTHS & LEGENDS** is much smaller in scale in relation to the remainder of the mark above it.

Visual comparison of the earlier registrations and the figurative mark

55. The respective marks share the letters G-L-E-N-S. In the earlier registrations the letter S is preceded by an apostrophe and in two of the marks there are additional words, namely **VODKA** and **GIN**. In the figurative mark, there is no apostrophe and there are six additional words, namely **of Antrim, DISTILLERY, SPIRITS, MYTHS & LEGENDS** and a complex device element, none of which have any counterpart in the earlier registration. In its skeleton argument,²⁴ the opponent drew my attention to the settled case law²⁵ that the beginnings of words tend to have greater visual and aural impact on consumers. I note this reference but put simply there are many more visual aspects to the applicant's mark which look quite different from the opponent's registrations. Taking all of the aforesaid into account, I find there is a low degree of visual similarity.

²⁴ Opponent's skeleton argument, paragraph 49.

²⁵ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02.

Visual comparison of the earlier registrations and the word mark

56. As previously stated, the respective marks share the letters G-L-E-N-S. In the earlier marks the letter S is preceded by an apostrophe and in two of the marks there are additional words, namely **VODKA** and **GIN**. In the applicant's word mark, there is no apostrophe and there are two additional words, namely **of Antrim** which have no counterpart in the earlier marks. Overall I find there is a medium degree of visual similarity.

Aural comparison of the earlier registrations and the figurative mark

57. The shared letters G-L-E-N-S in the respective marks will be pronounced identically in all cases and the apostrophe will make no aural difference. Where the opponent's registrations have additional words namely **VODKA** and **GIN**, these will be pronounced in the usual way. Given the number of additional words in the applicant's figurative mark it is unlikely that all words would be verbalised; it is more likely that only the words **Glens of Antrim** will be pronounced in full and given their usual pronunciation. On that basis I find there is a medium degree of aural similarity. However if all words in the applicant's mark are verbalised, then the degree of aural similarity will be lower.

Aural comparison of the earlier registrations and the word mark

58. As stated above, the shared letters G-L-E-N-S will be pronounced identically in all cases and the apostrophe will make no aural difference. Where the opponent's registrations have additional words namely **VODKA** and **GIN**, these will be pronounced in the usual way. The applicant's additional words **of Antrim** will also be pronounced in their usual way. Overall I find there is a medium degree of aural similarity.

Conceptual comparison of the earlier registrations and the figurative mark

59. The opponent's earlier registrations essentially consist of the word **GLEN'S** so that the concept brought to mind as a result of the apostrophe would be the possessive form of the personal name Glen. Where the registrations contain the additional words **VODKA** and **GIN**, then the concept would be of these alcoholic spirits either belonging to or being attributed to Glen. At the hearing the opponent submitted that an average consumer paying only an average degree of attention is

“unlikely to notice or have much regard to the apostrophe”. I agree only to the extent that some punctuation like a full stop may play a lesser role in comparison to the letters. However in a mark that is only five letters (or six characters) long and where the apostrophe is in the body of the word, if not quite the middle, then in my view it will be noticeable.

60. The **GLENS** word element of the applicant’s figurative mark does not have an apostrophe so an ordinary understanding of the word would be as the plural of the word glen, which some average consumers may know as a geographical term. The following words, **of Antrim**, further qualify where the glens may be located. The applicant, in its skeleton argument, states that “the concept conveyed by the word application is of the valleys of the Antrim region of Ireland”.²⁶ I agree with the applicant’s submission as to this concept of Glens of Antrim. The applicant’s figurative mark has a number of other elements to it, not found in the opponent’s marks, so it will bring to mind several different concepts. Firstly the device of birds in flight, and the word **DISTILLERY** which is clearly meaningful in relation to alcoholic beverages. Finally there is the strapline **SPIRITS, MYTHS & LEGENDS**. The word **SPIRITS** may be seen as a pun or play on words given its meaning in relation to alcoholic beverages but equally, given its other meanings in particular in relation to the supernatural, it is more likely, in my view, to form a concept along those lines with the additional words **MYTHS & LEGENDS**. Overall taking all the above factors into account, I find the respective marks to be conceptually dissimilar.

Conceptual comparison of the earlier registrations and the word mark

61. Much of my finding, as set out above, is applied here, namely the opponent’s marks will be seen as the possessive form of a personal name and the applicant’s word mark will be seen as meaning the valleys of a region of Ireland. As such I find the respective marks are conceptually dissimilar.

Distinctive character of the earlier registered trade marks

62. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic

²⁶ Applicant’s skeleton argument, paragraph 48.

of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*,²⁷ 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-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 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).”

64. I will first consider the inherent distinctiveness of the earlier registrations. These marks essentially consist of the word **GLEN'S** in either a plain or slightly stylised serif typeface. The **GLEN'S** marks do not have any descriptive meaning in relation to the goods for which they are registered. Two of the earlier registrations have additional, wholly descriptive words, namely **VODKA** and **GIN**, but these words add nothing to

²⁷ Case C-342/97

the distinctiveness of the marks. Overall I find there is inherent distinctiveness to a medium degree.

65. I next consider whether the opponent can claim enhanced distinctiveness of its earlier marks, because of the use made of them. The relevant market I must consider is the UK and I bear in mind the *Chiemsee* factors given above. The opponent's evidence is examined at paragraphs 12-20. I note that the opponent's vodka products have contributed to the majority of the turnover and GLEN'S VODKA is the mark which is most prevalent in the promotional and social media material, although there is some use of GLEN's solus in text and of GLEN'S PLATINUM VODKA too. The Grocer/Nielsen annual survey results demonstrate the longstanding nature of the brand and I note that GLEN'S VODKA was the recipient of a silver award in 2019 from International Spirits Challenge²⁸ and the opponent's platinum vodka product received a gold award in 2019 from the World Vodka Awards.²⁹ The applicant, in its skeleton argument,³⁰ accepts that the opponent has a modest degree of enhanced distinctive character in relation to GLEN'S VODKA only. I would agree with that assessment but would go further to find the distinctive character of the marks GLEN'S VODKA and GLEN's solus in relation to vodka has been enhanced to a modest degree.

Likelihood of confusion

66. 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 and services 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. The factors are interdependent, and include the principle that 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

²⁸ Exhibit CAM4

²⁹ Exhibit CAM8

³⁰ Paragraph 36

mind the distinctive character of the opponent's registrations, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alert 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.

67. In *L.A. Sugar Limited*,³¹ Iain Purvis K.C. sitting 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

³¹ *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

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)."

68. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors*,³² Arnold LJ approved Mr Purvis's formulation but added:

"13. As James Mellor QC sitting as the Appointed Person pointed out in *Cheeky Italian Ltd v Sutaria* (O/219/16) at [16] 'a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion'. Mr Mellor went on to say that, if there is no likelihood of direct confusion, 'one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion'. I would prefer to say that there must be a proper basis for concluding that there is a likelihood of indirect confusion given that there is no likelihood of direct confusion."

68. However it is also settled case law that it is not sufficient to find a likelihood of confusion if a mark merely calls to mind another mark.³³ This is considered mere association not indirect confusion.

69. I also find the following case law to be helpful in this decision where in *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another*,³⁴ Arnold J. considered the impact of the CJEU's judgment in *Bimbo*, Case C-591/12P, on the court's earlier judgment in *Medion v Thomson*. The judge said:

"18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark

³² [2021] EWCA Civ 1207

³³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

³⁴ [2015] EWHC 1271 (Ch)

contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

70. So far in this decision I have found that

- The goods are identical and similar.
- The average consumer is an adult over 18 and will pay a medium level of attention during the primarily visual purchasing process, but I consider that aural considerations may play a part.

- There is a low degree of visual similarity between the opponent's marks and the applicant's figurative mark.
- There is a medium degree of visual similarity between the opponent's word marks and the applicant's word mark.
- There is a medium degree of aural similarity between the respective marks but if all the words are verbalised in the applicant's figurative mark then the degree of similarity is lower.
- There is conceptual dissimilarity between the respective marks.
- The opponent's earlier marks are inherently distinctive to a medium degree, although the distinctiveness of GLEN'S VODKA and GLEN'S solus for vodka goods have been enhanced modestly through use.

Likelihood of confusion between the opponent's earlier marks and the applicant's word mark

71. Taking all of the above into account and bearing in mind the principle of imperfect recollection, it is my view that consumers will be able to perceive the visual and conceptual differences between the marks and use those differences to recall which mark was which. I appreciate that there is an aural similarity between the respective marks regarding the shared letters G-L-E-N-S, however in my view this is not sufficient to outweigh the visual and conceptual differences contained in **Glens of Antrim**. Consequently, I do not consider that there exists a likelihood of direct confusion between the marks at issue, even when viewed on identical or similar goods.

72. Having found that there is no likelihood of direct confusion, I now consider whether there is any indirect confusion. I remind myself of the guidance given in *L.A.Sugar* that indirect confusion requires a consumer to undertake a thought process whereby they acknowledge the differences between the marks yet attribute the common element to a shared undertaking, taking one mark to be a possible brand extension or sub brand of the other mark. However, I am also alert to the guidance in *Duebros* that a finding of indirect confusion should not be made simply because the respective marks share a common element.

73. At the heart of this case is whether **Glens of Antrim** would be seen as confusable with **GLEN'S** or **GLEN'S VODKA/GIN**. Having considered the respective marks from the visual, aural and conceptual perspectives, I cannot see a reason why the average consumer on seeing the applicant's word mark would assume that this could be a brand extension from the opponent's range of goods. The words **Glens of Antrim** form a single conceptual unit, moreover the phrase does have an "immediately graspable concept",³⁵ the meaning of which is different to the concept of the opponent's marks as the possessive form of a personal name. The common element, namely the letters G-L-E-N-S, are considered differently because of the apostrophe. In my view that difference of concept is sufficient for consumers not to be confused into thinking the goods come from the same or connected undertakings. As such I find there is no likelihood of indirect confusion with any of the opponent's earlier registrations.

Likelihood of confusion between the opponent's earlier marks and the applicant's figurative mark

74. Given the number of elements within the applicant's figurative mark, namely the device, the presentation of text and the overall stylisation, I do not find that consumers are likely to directly confuse the respective marks, even though the letters G-L-E-N-S are shared, as the visual and conceptual differences are too great.

75. In terms of indirect confusion, I have set out my reasoning in the paragraphs above and if anything the number of elements in the applicant's mark make it even less likely that indirect confusion will occur. I do not find a likelihood of indirect confusion.

76. The opposition brought under section 5(2)(b) has failed.

Section 5(4)(a)

77. I remind myself that under section 5(4)(a) of the Act the opponent claims use of the sign below, since 2003 for *distilled spirits; vodka*.

³⁵ *The Picasso Estate v OHIM*, Case C-361/04 P at [20].



78. Section 5(4)(a) states:

“(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.”

79. Subsection (4A) of Section 5 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.”

80. Section 5A of the Act is as follows:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

81. In *Reckitt & Colman Products Limited v Borden Inc. & Ors*,³⁶ Lord Oliver of Aylmerton described the 'classical trinity' that must be proved in order to reach a finding of passing off:

"First, [the plaintiff] must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying 'get-up' (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff's goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant's misrepresentation that the source of the defendant's goods or services is the same as the source of those offered by the plaintiff."

82. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

- (1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation among a relevant class of persons; and
- (2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

³⁶ [1990] RPC 341, HL, page 406.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

- (a) the nature and extent of the reputation relied upon;
- (b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;
- (c) the similarity of the mark, name etc used by the defendant to that of the claimant;
- (d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and
- (e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

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

Relevant date

83. In terms of the relevant date for assessment of section 5(4)(a), in *Advanced Perimeter Systems Limited v Multisys Computers Limited*,³⁷ Mr Daniel Alexander QC (as he was then), sitting as the Appointed Person, quoted with approval the summary made by Mr Allan James, acting for the Registrar, in *SWORDERS Trade Mark*:³⁸

‘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

³⁷ BL O-410-11

³⁸ BL O-212-06

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.”

83. The filing date for the applicant’s word mark is 29 April 2021 and for the figurative mark it is 22 September 2022. As such, all factors will be considered as at these dates.

Goodwill

84. The first hurdle for the opponent is to show that they had the required goodwill at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd*³⁹ viz,

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

85. In *Smart Planet Technologies, Inc. v Rajinda Sharm*,⁴⁰ Mr Thomas Mitcheson QC (as he was then), sitting as the Appointed Person, reviewed the following authorities about the establishment of goodwill for the purposes of passing-off: *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2015] UKSC 31, paragraph 52, *Reckitt & Colman Product v Borden* [1990] RPC 341, HL and *Erven Warnink B.V. v. J. Townend & Sons (Hull) Ltd* [1980] R.P.C. 31. After reviewing these authorities Mr Mitcheson concluded that:

“.. a successful claimant in a passing off claim needs to demonstrate more than nominal goodwill. It needs to demonstrate significant or substantial goodwill and

³⁹ [1901] AC 217 (HOL)

⁴⁰ BL O/304/20

at the very least sufficient goodwill to be able to conclude that there would be substantial damage on the basis of the misrepresentation relied upon.”

86. Goodwill arises as a result of trading activities and accrues to the business that the public thinks is responsible for the goods. The relevant market for assessing goodwill is the UK. I reviewed the opponent’s evidence at paragraphs 12-20. At the relevant dates I find that the opponent had achieved a good annual turnover for its vodka, had appeared in the top 25 of the 100 UK biggest selling alcohol brands between 2014 and 2021 and was promoting its vodka not only through retail and wholesale trade channels but also via high profile sponsorship of the SPFL. Taking all this into account I find that the opponent has established the necessary goodwill in relation to vodka under section 5(4)(a). The issue of establishing goodwill was also accepted by the applicant in its skeleton arguments.

Misrepresentation

87. Having cleared the first hurdle of goodwill, I now go on to consider the second hurdle, that of misrepresentation. 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.”


88. On the subject of how many of the relevant public must be deceived or confused for the opponent to be successful in a claim under this ground, I bear in mind the decision in *Lumos Skincare Limited v Sweet Squared Limited and others*,⁴¹ where Lord Justice Lloyd commented on the paragraph above as follows:

“64. One point which emerges clearly from what was said in that case, both by Jacob J and by the Court of Appeal, is that the “substantial number” of people who have been or would be misled by the Defendant's use of the mark, if the Claimant is to succeed, is not to be assessed in absolute numbers, nor is it applied to the public in general. It is a substantial number of the Claimant's actual or potential customers. If those customers, actual or potential, are small in number, because of the nature or extent of the Claimant's business, then the substantial number will also be proportionately small.”

89. Accordingly, once it has been established that the party relying on the existence of an earlier right under section 5(4)(a) had sufficient goodwill at the relevant date to find a passing-off claim, the likelihood that only a relatively small number of persons would be likely to be deceived does not mean that the case must fail. There will be a misrepresentation if a substantial number of customers, or potential customers, of the claimant's actual business would be likely to be deceived.

⁴¹ [2013] EWCA Civ 590.



90. I have found that the opponent has established goodwill in its sign . This is a complex arrangement of a heraldic style device and the word's **GLEN'S VODKA**. The contested word mark is **Glens of Antrim** which I find to be visually similar to a low degree, aurally similar to a medium degree and conceptually dissimilar to the opponent's sign. The contested figurative mark is set out in paragraph 51 and I find this to be visually similar only to a very low degree as the respective devices look so different from each other, aurally similar to a medium degree and conceptually dissimilar. In my view the sign relied on by the opponent is even further away from the applicant's marks than the word marks it relied on under section 5(2)(b).

91. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumers are confused". However, as recognised by Lewison L.J. in *Marks and Spencer PLC v Interflora*,⁴² it is doubtful whether the difference between the legal tests will produce different outcomes. In my view, this is the case here. I do not find that the relevant consumers when faced with the respective marks will believe that there is a connection between them. The differences between the marks are too significant and there is not a logical progression from one to the other to give rise to misrepresentation. As such the opposition based on section 5(4)(a) fails.

Overall conclusion

92. The opposition has failed in its entirety. Subject to any appeal of this decision, the applications can proceed to registration.

Costs

93. The applicant has been successful in these proceedings. As such it is entitled to a contribution towards the costs incurred. Awards of costs for proceedings commenced

⁴² [2012] EWCA (Civ) 1501

before 1 February 2023 are governed by Annex A of Tribunal Practice Notice (TPN) 2/2016. Bearing in mind the guidance given in TPN 2/2016, I award costs as follows:

£400 Considering Notices of Opposition & preparing counterstatements

£800 Considering other side's evidence

£900 Preparation for & attending the hearing

£2100 Total

94. I order Loch Lomond Distillers Limited to pay Glens of Antrim Potatoes Limited the sum of £2100. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 8th day of August 2025

June Ralph

For the Registrar

The Comptroller-General