

O/0754/25

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NO. UK00003924385

IN THE NAME OF AARON ROSS

IN CLASS 33

AND OPPOSITION THERETO UNDER NO. 443927

BY THE WEST HIGHLAND WOODLANDS

**AND IN THE MATTER OF REGISTRATION NOS. UK00003427527 AND
UK00003919382 IN THE NAME OF THE WEST HIGHLAND WOODLANDS**

AND APPLICATIONS FOR DECLARATIONS OF INVALIDITY THERETO

UNDER NOS. 506900 AND 506899

BY AARON ROSS

BACKGROUND AND PLEADINGS

1. On 19 June 2023, Aaron Ross (“Mr Ross”) applied to register the following trade mark under application no. 3924385 in the UK:



2. The 385 Mark was published for opposition purposes on 1 September 2023 and registration is sought for the following goods:

Class 33 Gin.

3. On 31 October 2023, the application for the 385 Mark was opposed by The West Highland Woodlands (“WHW”) on the basis of sections 5(1), 5(2)(b) and 3(6) of the Trade Marks Act 1994 (“the Act”). Under sections 5(1) and 5(2)(b) of the Act, WHW relies upon the following trade marks:

FASSFERN/FASS FERN (series of 2)

UKTM no. 3427527

Filing date 10 September 2019; registration date 29 November 2019

(“the 527 Mark”)

FASSFERN

UKTM no. 3919382

Filing date 6 June 2023; registration date 3 November 2023

(“the 382 Mark”)

4. The goods and services for which the 527 and 382 Marks are registered are set out in the Annex to this decision. WHW relies upon the goods and services underlined in the Annex for the purposes of its opposition under these grounds.

5. WHW claims that the marks are identical or similar, and that the goods/services are identical or similar, with the result that there is a likelihood of confusion.

6. Under section 3(6) of the Act, WHW claims that the parties were in negotiations regarding the building of a distillery on WHW's land. WHW claims that Mr Ross was aware of its ownership of the mark FASSFERN and the application for the 385 Mark is an attempt to appropriate WHW's intellectual property. As such, WHW states that the application for the 385 Mark has been filed in bad faith.

7. Mr Ross filed a counterstatement denying the grounds of opposition.

8. Mr Ross also filed applications for invalidity against the 527 and 382 Marks. These applications are based upon sections 5(4)(a), 3(1)(b), 3(1)(c) and 3(6) of the Act.

9. Under section 5(4)(a) of the Act, Mr Ross claims to have been using the sign FASSFERN throughout the UK since 2019 in relation to "services of a distillery; gin". Mr Ross claims that use of the 527 and 382 Marks would amount to passing off. Mr Ross also claims that as he operates a distillery under the name FASSFERN, he has exclusive rights pursuant to The Scotch Whisky Regulations 2009 ("TSWR 2009").

10. Under section 3(1)(b) and 3(1)(c) of the Act, Mr Ross claims that FASSFERN is a place in Scotland. As a result, he claims that it will be recognised as an indicator of the geographical origin of the goods/services and, as such, is descriptive/non-distinctive.

11. Under section 3(6) of the Act, Mr Ross claims that WHW was aware of Mr Ross' intention to use the name FASSFERN in connection with his business and he did not challenge WHW's application for its trade marks on the basis that he believed they were being obtained on his behalf and would be transferred at a later date. As such, Mr Ross claims that WHW did not intend to use the mark itself. Mr Ross claims that the applications for the 527 and 382 Marks were made in bad faith.

12. WHW filed counterstatements denying the grounds of invalidity.

THE HEARING AND REPRESENTATION

13. A hearing took place before me on 25 June 2025, by video conference. Both parties filed skeleton arguments and authorities in advance of the hearing, which I have fully considered in reaching this decision.

14. Mr Ross was represented by Mr Jamie Watt of Harper Macleod LLP, who has represented Mr Ross throughout these proceedings.

15. WHW was represented by Ms Eleanor Coates of Murgitroyd & Company, who has represented WHW throughout these proceedings.

EVIDENCE AND SUBMISSIONS

16. WHW filed evidence in chief in the form of:

- a. The witness statement of Anthony Richard Tulloch dated 26 June 2024, which is accompanied by 8 exhibits (RT1 to RT8). Mr Tulloch is the Director of WHW, a position he has held since July 2007.
- b. The witness statement of Bruce Taylor dated 25 June 2024, which is accompanied by 8 exhibits (BT1 to BT8). Mr Taylor was the Factor and Estate Manager of the Fassfern Estate on behalf of WHW for the period November 2012 to February 2023.
- c. The witness statement of Ms Coates dated 28 June 2024, which is accompanied by one exhibit (EC1). As noted above, Ms Coates is WHW's representative in these proceedings.

17. Mr Ross filed evidence in the form of the witness statement of Mr Watt dated 10 July 2024, which is accompanied by 13 exhibits (JW1 to JW13). As noted above, Mr Watt is Mr Ross' representative in these proceedings.

18. Only Mr Ross filed evidence in reply. This took the form of the witness statement of Mr Ross dated 10 September 2024, which is accompanied by 6 exhibits (AR1 to AR6).

RELEVANCE OF EU LAW

19. 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.

PRELIMINARY POINT

20. Ms Coates submitted that the evidence given by Mr Watt should be given low or no weight; she claims that it is hearsay evidence because, as a legal representative, he does not have first hand knowledge of the matters contained within his witness statement. I accept Ms Coates point that any narrative evidence given by Mr Watt should be treated with caution; however, the vast majority of Mr Watt's statement simply serves to introduce documentary evidence which speaks for itself. I see no reason to attribute less or no weight to those documents. I will proceed on that basis.

DECISION

My Approach

21. As the two earlier rights relied upon in the opposition are subject to invalidation, I will deal with the invalidation actions first. I will then return to the opposition once the validity of the earlier rights relied upon has been determined.

The Invalidations

22. The relevant parts of section 47 state:

“47. (1) The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration). Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered.

(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

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

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

Section 3(1)(c)

23. Section 3(1) of the Act reads as follows:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

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

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

24. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. (as he then was) in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article

7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see, by analogy, [2004] ECR I-1699, paragraph 19; as regards Article 7 of Regulation No 40/94, see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18, paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461, paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94. Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia, *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44, paragraph 45, and *Lego Juris v OHIM* (C-48/09 P), paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley*, paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94, it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie*, paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I-2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in Article 3 of Directive 89/104, *Koninklijke KPN Nederland*, paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal

set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94, the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56)."

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and

Koninklijke KPN Nederland NV v Benelux-Merkenbureau (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

25. The crux of the section 3(1)(c) case is that the word FASSFERN will be recognised as a geographical place name and is, therefore, descriptive. The leading authority in this regard is *Windsurfing Chiemsee* (referenced above). In particular:

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

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

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

33. In that connection, Article 3(1)(c) of the Directive does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons – or at least unknown as the designation of a geographical location – or of names in respect of which, because of the type of

place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.”

26. Ms Coates submitted that she did not think issue should be taken with FASSFERN as a mark, when there are marks such as EDINBURGH (which is clearly a much larger place) registered for gin. In my view, that line of argument is not persuasive. Marks which are prima facie descriptive may become registered due to acquired distinctiveness; consequently, each case must be decided on its own merits and on the evidence filed.

27. It is not in dispute that Fassfern is a place in Scotland. It is, I think, a notorious fact that Scotland is associated with whisky and the position would have been the same at the relevant date. However, I see nothing in the evidence before me to suggest that Fassfern specifically was associated with any of the goods concerned at the relevant date. The question is, therefore, whether it is reasonable to assume that such an association would be formed in the future. In this regard, the case law states that I should take into account the degree of familiarity amongst the relevant public with the name Fassfern, the characteristics of the place designated by the name and the category of goods concerned.

28. I note that Mr Ross has filed the following evidence regarding Fassfern:

- a. A print out of the website of Fassfern guesthouse.¹ This is undated and there is nothing to confirm whether this is actually located in Fassfern or just named after it.
- b. A number of print outs of walking and riding routes which reference Fassfern.² These are all undated.
- c. A print out from Wikipedia which confirms that Fassfern is a hamlet in Scotland.³

¹ Page 16, exhibit JW2.

² Pages, 17, 18, 21 and 27, exhibit JW2.

³ Page 19, exhibit JW2.

- d. A print out from the BBC website which shows the weather in Fassfern.⁴
- e. A print out from the website of Fassfern Mussels and confirmation of their marine licence which was applied for in October 2023.⁵
- f. A website discussing the best things to do in Fassfern.⁶ However, these actually appear to refer to activities in, *inter alia*, Fort William, Glencoe and Skye.
- g. Listings for houses available for sale in Fassfern.⁷ The result says that there are 703 properties available for sale in Fassfern. However, when the listings (only 3 are visible) are examined, these appear to be located in places other than Fassfern. A second page is provided which lists a plot for sale which is located in Fassfern.⁸
- h. A print out from a website called crosstown.co.uk with a page entitled “Fassfern donut/doughnut delivery”.⁹ It is undated. It goes on to state “whatever you call them Fassfern, our handcrafted artisan doughnuts are available to buy online”. It is not, therefore, clear whether this business is located in Fassfern or is simply advertising that it delivers to Fassfern.
- i. A website describing the best cafes located near Fassfern.¹⁰ The locations are not listed for any of them.
- j. A print out showing an ordnance survey map of the area, which states that “paddlers commonly call [the river] Fassfern” after the hamlet located nearby, because it is easier to pronounce”.¹¹

⁴ Page 20, exhibit JW2.

⁵ Page 22, exhibit JW2.

⁶ Page 23, exhibit JW2.

⁷ Page 24, exhibit JW2.

⁸ Page 28, exhibit JW2.

⁹ Page 25, exhibit JW2.

¹⁰ Page 26, exhibit JW2.

¹¹ Page 29, exhibit JW2.

- k. A print out from booking.com which shows four accommodation options which are described as “near Fassfern”.¹²
- l. A website which confirms that there are no old photographs of Fassfern available.¹³
- m. A series of search results from Google Books, in which books reference Fassfern.¹⁴
- n. A photograph of an egg box with the label “Laid by Happy Hens at Fassfern” and a photograph of onion chutney with a label that reads “Fassfern Chutney’s and Jams”.¹⁵
- o. A photograph of a sign for FASSFERN which Mr Ross states is on the main road between Fort William and Mallaig.¹⁶ This appears as follows:



29. Clearly, the evidence filed is very thin. I have no evidence as to visitor numbers for the area, population size or how many businesses in total (in the relevant sector or otherwise) operate in Fassfern. It seems to me that on Mr Watt’s own evidence, Fassfern is a very small place. Any evidence which demonstrates business activity in the area is very limited. As noted above, I have no evidence before me as to population size, but it seems reasonable to infer that it is very small indeed. That is, of course, not reflective of the number of people who would be familiar with Fassfern as a place

¹² Page 30, exhibit JW2.

¹³ Page 31, exhibit JW2.

¹⁴ Pages 32, 33, 34 and 35, exhibit JW2.

¹⁵ Page 36, exhibit JW2.

¹⁶ Exhibit AR5

name because this would include not just those who live there, but those who have visited and/or live in the surrounding areas. However, as noted above, I have no evidence before me to suggest upon what scale visitors might pass through Fassfern. The high point of the evidence regarding how well known FASSFERN is, is the sign which is located on the main road between two larger locations (Fort William and Mallaig). However, there is nothing to suggest whether that sign was in situ at the relevant date or how visible it is from the road (I note that it does not appear as a typical road sign, but rather a sign that has been placed on what appears to be a private wall).

30. The goods in issue are spirits, including whisky. It seems to me that it is a relevant factor that whisky is commonly produced in Scotland and that distilleries are a common feature of many places (big and small) across the country. In my view, that is a factor in favour of Mr Ross. However, I must balance this against what appears to be a name with which very few members of the relevant public will be familiar. Further, it seems to me that any business activities in the area are limited and with such a small area (both in terms of geographical size and population) it is unlikely that there would be more than one distillery in the area.

31. I have borne in mind the authorities referred to by Mr Watt in this regard. In particular, Mr Watt relied upon the decision of this Tribunal in *STAMFORD STONE* as an example of a similarly small geographical place having been found to be descriptive. However, in that case, there was evidence of an association between the place and a type of stone, as well as there being quarries located in that area.¹⁷ The same association cannot be said of the present case and it can, therefore, be distinguished on that basis.

32. Taking all of this into account, and balancing all of the factors discussed in the case law, I am not satisfied that the 527 and 382 Marks fall foul of section 3(1)(c) of the Act. As such, the applications for invalidity on that basis are dismissed.

¹⁷ O/580/22

Section 3(1)(b)

33. Section 3(1)(b) of the Act reads as follows:

“3.— Absolute grounds for refusal of registration

(1) The following shall not be registered—

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

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

34. Although Mr Ross has pleaded section 3(1)(b), he has not identified any basis upon which the 527 and 382 Marks might be non-distinctive, other than the claim that they are descriptive as already considered above.

35. I have already found against Mr Ross in that regard. On that basis, the applications for invalidation based upon section 3(1)(b) of the Act are dismissed.

Section 5(4)(a)

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

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented -

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

aa)...

b) ...

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

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

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

38. As noted above, there are two aspects to Mr Ross’ claim under this ground; the first relates to a claim of passing off, and the second relates to The Scotch Whisky Regulations 2009 (“TSWR 2009”). I will deal with these in turn.

Passing Off

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

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

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per

Interflora Inc v Marks and Spencer Plc [2012] EWCA Civ 1501, [2013] FSR 21).”

Relevant date

40. The prima facie relevant date is the date of the application for the 527 and 382 Marks i.e. 10 September 2019 and 6 June 2023 respectively. There is no suggestion that any earlier relevant date may apply in this case.

Goodwill

41. *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL):

“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.”

42. There is very limited evidence of use before me. Mr Watt has provided a series of Google search results, some of which have associated screenshots and some of which do not.¹⁸ The ones that do not are of limited evidential value, because all I can see is a snapshot of what is said on the page, without being able to properly review the context. Of those that do have an accompanying screenshot, I note the following:

- a. A copy of what appears to be Mr Ross's website is provided which the search engine records as having been available since 1 October 2019. However, we do not, of course, know whether it appeared as shown in the screenshot provided (which appears to be contemporaneous to Mr Watt's witness statement). The screenshot refers to Fassfern Gin and Fassfern Highland Gin.

¹⁸ Exhibit JW1

- b. There is a screenshot of the Lochaber Chamber of Commerce website which records Mr Ross as the contact for Fassfern Highland gins.
- c. There is a screenshot of a Trip Advisor review for a hotel, in which the customer states that it had a good selection of gins and that they enjoyed the “Fassfern Bramble”, which I take to be a type of gin. The review is dated 1 September 2021.
- d. There is a print out of the Scottish Gin Awards website, which lists Fassfern Dry Highland Gin. The Google search result for the page gives a date of 28 October 2021, but it is not clear to me whether this is a recording of how the page would have appeared at that date or whether the page has simply been available since that date (but subject to change).
- e. A screenshot from Outdoor Capital website which describes Fassfern Highland Gin as a hand crafted distillery selling 3 different types of gin. Again, it is not clear to me whether the search result date of 17 March 2022 refers to the date that this page first became available or whether the screenshot shown is a record of what the page looked like at that date.

43. That is the totality of the notable evidence of use recorded in either Mr Watt’s or Mr Ross’s witness statements. I have also been able to identify some limited references to use of the sign relied upon in the accompanying exhibits. For example, there is an email from Mr Ross to WHW dated 1 June 2021 in evidence, which states:

“Just wanted to give you a bit of an update on progress. We attended the Spring Market on Saturday [...] and pretty much sold out of stock on the day. 19 bottles of Bramble and 13 of Dry as well as some whisky and a gift hamper we had made up. A very successful day.

That has meant that we are almost out of stock of gin, new batches ordered and ready soon and whisky, 12 left from 180! Have a further cask ready for bottling, trying to get this done locally too.”

44. There is certainly no evidence of use which pre-dates the filing date for the 527 Mark (10 September 2019). It is not, therefore, possible for Mr Ross to have had goodwill at that relevant date. With regard to the relevant date for the 382 Mark (6 June 2023), there was clearly some use taking place prior to that date (in the form of whisky and gin sales). However, the evidence before me is so limited that I am unable to properly assess the extent of that use. This is important because the law of passing off protects a business with a small goodwill, but does not protect a goodwill of trivial extent.¹⁹ Consequently, it is important for me to properly assess whether any goodwill is small (but protectable) or trivial (and not protectable). The evidence before me is simply insufficient to establish the former. Consequently, the passing off ground must fall at the first hurdle.

TSWR 2009

45. In its pleadings, Mr Ross relies upon section 9 of TSWR 2009 which states as follows:

“(1) The name of a distillery mentioned in Schedule 1 must not be used as a brand name, or as part of a brand name of a Scotch Whisky, or be used in a similar fashion in terms of its positioning or prominence, unless the whisky has been wholly distilled at that distillery.

(2) Any name adopted for a Scotch Whisky distillery after these Regulations come into force, including the name of a new or re-opened Scotch Whisky distillery, must not be used by the proprietor of that distillery as a brand name, or as part of a brand name, for a Scotch Whisky, or be used in a similar fashion in terms of its position or prominence, unless the Scotch Whisky has been wholly distilled at that distillery.

(3) But paragraph (2) does not apply in the circumstances identified in Schedule 2.

¹⁹ *Hart v Relentless Records* [2002] EWHC 1984 (Ch)

(4) Scotch Whisky must not be labelled, packaged, advertised or promoted in any other way that, having regard to the presentation of the product as a whole, creates a likelihood that the public may think that it has been distilled at any distillery or place other than the distillery or place at which it was actually distilled.

(5) Single Malt Scotch Whisky and Single Grain Scotch Whisky must not be labelled, packaged, advertised or promoted in any way that, having regard to the presentation of the product as a whole, creates a likelihood that the public may think that the whisky was distilled by any person other than the person who distilled it, or the owner or operator of the distillery at which it was distilled, whether by an indication that that person is the distiller, the owner or operator of the distillery, or otherwise.

(6) A person must not label, package, advertise or promote any Scotch Whisky in a way that contravenes the requirements of paragraphs (1), (2), (4) or (5), or sell any Scotch Whisky that has been labelled or packaged in that way.”

46. In his skeleton argument, Mr Watt stated as follows:

“25. Further, pursuant to [TSWR 2009], [Mr Ross] has a senior right to the name “FASSFERN” in relation to scotch whisky, as [Mr Ross] operates a distillery under the name “FASSFERN” [Footnote: See for example JW4], being the mark set out in the 527 Registration and the 382 Registration. Please see sections 9(2), and (4) to (6) of those Regulations. Simply by the fact that [Mr Ross] uses the name “FASSFERN” in relation to a distillery, and [WHW] does not, [Mr Ross] has pursuant to these sections a senior right to the name “FASSFERN” in the case of scotch whisky.”

47. There are a number of issues with this ground. Firstly, subsection (2) referred to by Mr Watt does not discuss trade origin of the goods; it simply confirms that a whisky should not be sold under the name of a distillery unless it was wholly distilled there (unless any of the exemptions apply). It cannot, therefore, to my mind, have any bearing on the use of trade marks (which are, inherently, indicative of trade origin).

48. Secondly, subsection (4) deals with circumstances in which the public may be led to believe that a whisky has been distilled somewhere other than where it was actually distilled; this does not appear to me to prevent someone from using a name as, or as part of their product name, simply because someone else is doing the same. It is about ensuring accurate descriptions of origin, rather than conflicting rights in trade names.

49. Thirdly, whilst subsection (5) does appear to deal with conflicts as to trade origin, this is in the context of an existing distillery name being used by someone who is not actually operating from that distillery or producing their whisky at that distillery. Firstly, as Ms Coates pointed out, there is no evidence before me that Mr Ross is (or was at the relevant dates) operating a distillery. Certainly, he was not in 2019. Indeed, at that time he was still in discussions with WHW about the possibility of building a distillery on their land. By 2023, the relationship with WHW had broken down and it might be that Mr Ross was operating a distillery elsewhere; however, there is no evidence of this before me. The evidence referred to by Mr Watt in his skeleton argument (being exhibit JW4) simply refers to a company name registration for Mr Ross's company, Fassfern Distillery Ltd. However, that does not evidence that a distillery is actually being operated, that simply evidences that a company has been registered which includes the word Distillery in its name. I also note that the evidence of use (such that it is), mostly relates to sales of gin rather than Scotch whisky.

50. Taking all of this into account, I do not consider that there is any basis for a successful claim under TSWR 2009.

51. Consequently, the applications for invalidation under section 5(4)(a) of the Act are dismissed.

Section 3(6)

52. Section 3(6) of the Act states:

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

53. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin summarised the general principles applicable to bad faith at [240] as follows:

“(i) [...]”

(ii) The date for assessing whether an application to register [a] trade mark was made in bad faith is the date the application for registration was made (*Lindt*, para 35).

(iii) Bad faith in this context is an autonomous concept of EU law which must be given a uniform interpretation [...], and must be interpreted in the context of Directive 89/104 in the same manner as in the context of Regulation 40/94 (*Malaysia Dairy Industries Pte Ltd v Ankenaevnet for Patenter og Varemaerker* (C-320/12) EU:C:2013:435 (“*Malaysia Dairy*”), para 29; [*Sky plc v SkyKick UK Ltd* (C-371/18) EU:C:2020:45 (“*Sky CJEU*”), para 73).

(iv) While, in accordance with its usual meaning in everyday language, the concept of bad faith presupposes the presence of a dishonest state of mind or intention, the concept must also be understood in the context of trade mark law, which involves the use of marks in the course of trade. Further, it must have regard to the objectives of the [...] law of trade marks, namely the establishment and functioning of [...] a system of undistorted competition in which each undertaking must, in order to attract and retain customers by the quality of its goods or services, be able to have registered as trade marks signs which enable consumers, without any possibility of confusion, to distinguish those goods or services from those which have a different origin (*Lindt*, para 45; [*Koton Mağazacılık Tekstil Sanayi ve Ticaret AS v European Union Intellectual Property Office (EUIPO)* (C-104/18) EU:C:2019:724 (“*Koton*”), para 45).

(v) Consequently, the objection will be made out where the proprietor made the application for registration, not with the aim of engaging fairly in competition but either (a) with the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties; or (b) with the intention of obtaining,

without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark, and in particular the essential function of indicating origin (*Koton*, para 46; *Sky CJEU*, para 75).

(vi) The intention of the applicant is a subjective matter, but it must be capable of being established objectively by the competent administrative or judicial authorities having regard to the objective circumstances of the case (*[Hasbro Inc v EUIPO, Kreativni Dogaaji d.o.o. (intervening)* (Case T-663/19) EU:T:2021:211 (“*Hasbro*”)], paras 39 and 40; *Koton*, para 47).

(vii) The burden of proving that an application for a registered mark was made in bad faith lies on the party making the allegation. But where the circumstances of the case may lead to a rebuttal of the presumption of good faith, it is for the proprietor of the mark to explain and provide a plausible explanation of the objectives and commercial logic pursued by the application for registration (*Hasbro*, paras 42 and 43).

(viii) Whether the applicant was acting in bad faith must be the subject of an overall assessment, taking into account all of the factors relevant to the particular case (*Lindt*, para 37).

(ix) The applicant for a trade mark is not required to indicate or to know precisely when the application is filed or examined, the use that will be made of it (*Sky CJEU*, para 76; *[AS v Deutsches Patent-und Markenamt* (C-541/18) EU:C:2019:725], para 22).

(x) Nevertheless, the registration by an applicant of a mark without any intention to use it in relation to the goods and services covered by the registration may constitute bad faith where there is no rationale for the application in the light of the aims referred to in Regulation 40/94 and Directive 89/104 (*Sky CJEU*, para 77).

(xi) Such bad faith may, however, be established only where there are objective, relevant and consistent indicia tending to show that, when the

application was filed, the applicant for registration had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark (*Sky CJEU*, para 77).

(xii) It follows that the bad faith of the applicant cannot be presumed on the basis of a mere finding that, at the time of filing the application, the applicant had no economic activity corresponding to the goods and services referred to in the application (*Sky CJEU*, para 78).

(xiii) When the absence of an intention to use the mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that constitutes making the application in bad faith only in so far as it relates to those goods or services (*Sky CJEU*, para 81).

(xiv) If, at the end of the day, the court concludes that, despite formal observance of the relevant rules and conditions for obtaining registration, the purpose of the rules has not been achieved, and that there was an intention to take advantage of the rules by creating artificially the conditions laid down for obtaining the registration, this may amount to an abuse sufficient to find that the application was made in bad faith (see, for example, *Hasbro*, para 72).

(xv) Directive 89/104 does not preclude a provision of national law under which an applicant for registration must state that the mark is being used in relation to the goods or services in relation to which it is sought to register the mark, or that the applicant has a *bona fide* intention that it should be used, provided that infringement of such an obligation cannot constitute a ground for invalidity. It may, however, constitute evidence for the purposes of establishing possible bad faith on the part of the applicant when the application was filed (*Sky CJEU*, paras 86 and 87).”

54. According to *Alexander Trade Mark*, BL O/036/18, the key questions for determination in a claim of bad faith are (with amendments made to reflect that this is an invalidation, rather than an opposition):

(a) What, in concrete terms, was the objective that the [proprietor] has been accused of pursuing?

(b) Was that an objective for the purposes of which the contested [mark] could not be properly filed? and

(c) Was it established that the contested [mark] was filed in pursuit of that objective?

What, in concrete terms, was the objective that the [proprietor] has been accused of pursuing?

55. Mr Ross's pleaded case is as follows:

"20. [...] [Mr Ross] and [WHW] interacted prior to the date upon which the application to register the [527 and 382 Marks] was made by [WHW]. In those discussions, [Mr Ross] indicated [his] intention to use the name "FASSFERN" in connection with [his] business, and following that [WHW] sought to acquire rights in the [527 and 382 Marks]. [Mr Ross] did not challenge that, as [he] had understood that rights in the [527 and 382 Marks] were being acquired by [WHW] for an on behalf of [Mr Ross], and would be transferred to [him] at a later date. In connection with such matters [Mr Ross] was advised by a trade mark attorney. That trade mark attorney was also advising [WHW] concurrently.

56. In summary, Mr Ross claims that there was a prior existing relationship between the parties and Mr Ross understood that WHW was acquiring the 527 and 382 Marks in relation to the joint business venture and that they would subsequently be transferred to him. As such, WHW had no intention to use the marks.

Was that an objective for the purposes of which the contested [mark] could not be properly filed?

57. Mr Watt referred me to a number of authorities regarding bad faith. The outcome of those cases cannot be determinative in terms of the outcome of this case, because each case has to turn upon its own facts. However, what is clear from the case law, is that applying for a trade mark with no intention to use it may be grounds for a finding of bad faith. Similarly, applying for a trade mark that you know to belong to another party with whom you have an existing business relationship, with the intention of blocking or otherwise gaining from that registration may also be grounds for a finding of bad faith. I do not believe that the law in this regard is in dispute between the parties.

Was it established that the contested [marks were] filed in pursuit of that objective?

58. There is no doubt that there was a pre-existing relationship between the parties at the time both the 527 and 382 Marks were filed. This relationship began in July 2019 when Mr Ross approached WHW to pitch the idea of developing a new whisky distillery on the land owned by WHW, being the Fassfern Estate.²⁰ This does not appear to be in dispute between the parties and it was clearly Mr Ross who came up with the idea for the project.²¹ However, there are no property rights in an idea and so this does not assist Mr Ross. At the time of making the pitch, Mr Ross was working for another distillery called Ben Nevis. There are various documents in evidence which show that Mr Ross was intending to use the sign FASSFERN in relation to the project. For example, he sought legal advice regarding the registration of various Fassfern domain names in October 2019 and in December 2019 he showed a presentation to WHW which included a reference to the Fassfern Distillery.²²

²⁰ See paragraph 5 of Mr Ross's statement.

²¹ See paragraph 2 of Mr Taylor's statement.

²² Exhibits JW7 and JW8

59. There was another party involved in the project, a business called Meadowside Blending (“MB”). It is not clear when MB first became involved in the project, but certainly by October 2019 they were participating in discussions about it.²³

60. As noted above, it seems to have been the goal of the project to build a distillery on WHW’s land, with the intention of selling whisky and other spirits under the FASSFERN name. However, they do not appear to have ever reached a point at which a distillery was built, although there do appear to have been some sales of spirits made by Mr Ross.

61. The crux of this dispute goes to the agreement between the parties as to who would own the trade mark(s) required for the project. As is often the case, there does not appear to be anything formal in place in that regard. It was MB that filed for the first FASSFERN trade mark (being the 527 Mark). As noted above, this was filed on 10 September 2019, early on in the project. At some point in 2020, MB parted ways with WHW and Mr Ross. As is clear from the Register, MB assigned ownership of the 527 Mark to WHW on 29 July 2020.²⁴ This is where the dispute arises.

62. The parties differ in their accounts as to why the 527 Mark was transferred to WHW. Mr Taylor, on behalf of WHW, states as follows:²⁵

“[Mr Ross] rang me on 16 June 2020 to ask if [WHW] could be the owner [of the 527 Mark]. [Mr Ross] in that call advised that he would pay the purchase price but that [WHW] would be the owner.”

63. This is supported by an email dated 25 June 2020 in which Mr Taylor reported the conversation that he had had with Mr Ross to his colleagues.²⁶ In that email, he stated:

“Donald [of MB] obviously wishes to distance himself from [Mr Ross]’s ideas as he has a high value of spirit stored at the Ben Nevis Distillery. So he does not

²³ Exhibit BT2

²⁴ Exhibit BT5

²⁵ Paragraph 6 of Mr Taylor’s statement.

²⁶ Exhibit BT4

want to sell the trademarks to [Mr Ross] but will sell to [WHW] for cost price (£4,000) and pay for the re-registration himself as a gesture of goodwill. I have asked him to confirm this in writing [...]

[Mr Ross] will pay, in advance, [WHW], for the cost incurred. He will not own the trademarks but does not want the Estate to be out-of pocket. I have given him an expected figure of £5,000 at this time as the cost is not yet confirmed and I have put a bit of time into this. He is willing to pay whatever it takes to have the trademarks secured.”

64. Mr Ross disputes Mr Taylor’s account of the matter. He states:

“I agreed with [WHW] that they would purchase the “Fassfern” registered trade mark on our behalf and then sell it on to us at an increased price so that [WHW] would be compensated. This was because various concerns Ben Nevis Distillery had in relation to transferring the mark directly to [me], arising out of my departure from that business and their relationship with [MB].”

65. It is clear, therefore, that they both agree, in part, that the reason for the transfer to WHW was because MB had an ongoing business relationship with Ben Nevis Distillery (being Mr Ross’s former employer) and were concerned about the impact that transferring the 527 Mark directly to Mr Ross would have on their relationship with Ben Nevis Distillery. However, the parties disagree as to whether it was the intention that WHW would own the marks outright or whether they were simply intended as an intermediary, with Mr Ross being the ultimate beneficiary.

66. In this regard, Mr Ross relies upon an email from Mr Taylor of WHW dated 27 August 2021 which states:²⁷

“Not unexpectedly, the directors of [WHW] have asked if it would not be better for Fassfern to hold all the Trademarks? This would save you some initial cost but let me have your views on this. The Estate remain committed to working

²⁷ Exhibit JW13

with you on the distillery plan, whatever form this may take to achieve investor input and the desired end result..." (my emphasis)

67. Mr Watt submits that the initial question posed here (underlined above) suggests that the idea of WHW holding all of the trade marks was a divergence from the original plan; what else, says Mr Watt, could the original plan have been other than for Mr Ross to own the trade marks? The answer to that question, it seems to me, is that we simply do not know. It might be that the original intention was for the trade mark ownership to be transferred to Mr Ross, or it might be that they are referring to a plan for the company set up to run the joint venture having previously been intended as the trade mark owner. In the absence of any clear evidence on the point, we simply do not know and I do not consider it appropriate to draw such an inference based on such limited evidence.

68. There is evidence which, in my view, points the other way i.e. that it was the intention of the parties that WHW would retain ownership of the intellectual property rights. For example there is an email dated October 2020 from Aaron Ross to WHW which states: "Before taking this any further with them, I wanted to make sure that we had the permission to use the Trademark for our Gin products as of course it is the estate which own the rights to these?"²⁸ If it was always the intention that Mr Ross was the ultimate beneficiary of those rights, it is not clear to me why he would have sought permission from WHW to use them. Similarly, in August 2021, Mr Ross sent Mr Taylor an email stating that he had taken legal advice on protecting the marks, inter alia, Fassfern Distilleries. He stated that:

"[The legal representative] was informed that the Trademark was held rightfully by the estate and that we were to be working together on the Fassfern Distillery project via the Dormant company set up as Fassfern Distillery Ltd, planned as a joint venture and the vessel for us to secure investors into this new business."²⁹ (my emphasis)

²⁸ Exhibit BT6

²⁹ Exhibit BT8

69. It does not, therefore, appear that Mr Ross was disputing that the intellectual property was rightfully held by WHW. Further, I have no evidence before me that Mr Ross actually paid WHW any money in respect of the trade marks as appears to have been the original agreement (see paragraph 63 above). On the balance of probabilities, it seems to me that it was the intention that WHW be the owner of the intellectual property rights in FASSFERN.

70. In any event, whether or not it was the intention that ownership would ultimately be transferred to Mr Ross cannot, to my mind, be relevant to the question of whether the 527 Mark was filed in bad faith. There does not appear to be any suggestion by either party that MB was not entitled to file the application for the 527 Mark and there does not appear to be any claim that MB had no intention to use the mark; indeed, they were very clearly involved in the project with Mr Ross and WHW. Rather, the dispute appears to relate to whether the assignment from MB to WHW was made in bad faith. However, as Ms Coates pointed out at the hearing, the question of bad faith under section 3(6) of the Act goes to the filing of the mark, not any subsequent dealings with it. If Mr Ross believes that there was an agreement to the contrary in place, then the appropriate recourse is to sue for breach of that agreement. Consequently, there does not appear to me to be any basis upon which I could find that the 527 Mark was filed in bad faith.

71. The 382 Mark was filed after the relationship between the parties had broken down. However, the case is put in identical terms in respect of the 382 Mark. Consequently, as the case is pleaded, it seems to me that there is no allegation of bad faith at the time of filing the 382 Mark. The pleaded case is such that Mr Ross consented to the initial filings, but that the subsequent actions of WHW after the time of filing are the cause for concern. Consequently, I do not consider that there can be a finding of bad faith in respect of the 382 Mark for the same reasons. However, even if I am wrong in that finding, I would still not have found bad faith. This is because:

- a. There is no evidence upon which I can make an inference that it was the intention of the parties that the intellectual property rights belong to Mr Ross. In fact, the evidence before me appears to support WHW's position; that they were intended to be the owner of the sign FASSFERN. The burden of proving bad

faith is on Mr Ross and he has failed to establish that there was ever an intention that he was the owner of the mark FASSFERN.

- b. Unlike many of the authorities relied upon by Mr Watt, this is not a case where one party already had goodwill in a sign and a second party has applied for that sign to pre-empt the rightful owner from using it, or to otherwise gain an advantage of that party. In this case, I have found that there was no goodwill at the filing date of either the 382 Mark or the 527 Mark.
- c. WHW is the owner of land called the Fassfern Estate and in the absence of any conflicting rights to prevent them from doing so (and having found that FASSFERN is not descriptive/non-distinctive) it seems to me that their actions in filing the 382 Mark are justified.
- d. There is documentary evidence supporting the fact that WHW intended to build a distillery on their land (with or without Mr Ross).³⁰ As such, I can see no basis for concluding that they had no intention to use the 382 Mark at the time of filing.

72. Taking all of this into account, the applications based upon section 3(6) of the Act are dismissed.

The Opposition

73. As the 527 and 382 Marks have survived the applications for invalidation, I will now turn to consider the opposition.

Section 5(1)

74. Section 5(1) of the Act states:

³⁰ Exhibit RT4, page 63

“A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

75. By virtue of their earlier filing dates, the 527 and 382 Marks qualify as earlier trade marks pursuant to section 6 of the Act. As the 527 and 382 Marks had not completed their registration process more than 5 years before the filing date of the 385 Mark, they are not subject to the use provisions contained in section 6A of the Act.

76. It is a prerequisite of section 5(1) of the Act that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the CJEU held that:

“54... a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by the average consumer.”

77. In my view, the fern device would not go unnoticed by the average consumer given its size and positioning within the mark. Consequently, the marks are not identical.

78. The opposition based upon section 5(1) of the Act is dismissed.

Section 5(2)(b)

79. Section 5(2)(b) of the Act reads as follows:

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

(a)...

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected

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

80. The following principles are gleaned from the decisions 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 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-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(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 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 goods

81. Mr Watt accepted at the hearing that the goods are identical.

The average consumer and the nature of the purchasing act

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

83. 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.”

84. The average consumer for the goods will be a member of the general public (who is over the age of 18). The goods are unlikely to be everyday purchases and will vary in price, but will not be at the highest end of the cost scale. The average consumer is likely to take factors such as flavour, ingredients and alcohol content into account in purchasing the goods. Consequently, I consider that a medium degree of attention will be paid during the purchasing process.

85. The goods are likely to be self-selected from the shelves of a retail outlet or online equivalents. They may also be purchased following perusal of bottles behind a bar, or on drinks menus. Consequently, visual considerations will dominate the purchasing process. However, given that orders may be placed verbally and advice may be sought from retail assistants, I do not discount an aural component.


Comparison of the trade marks

86. It is clear from *Sabel* 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 marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“... it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

87. It would be wrong, therefore, to dissect the trade marks artificially, 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.

88. The respective trade marks are shown below:

<p style="text-align: center;">The 385 Mark (the applicant’s mark)</p>	<p style="text-align: center;">The 382 Mark and the 527 Mark³¹ (the opponent’s marks)</p>
	<p>FASSFERN</p>

Overall Impression

89. The 382 and 527 Marks consist of the word FASSFERN. There are no other elements to contribute to the overall impression, which resides in the word itself.

90. The 385 Mark consists of the word FASSFERN, presented in a slightly stylised font, beneath a fern device. The eye is naturally drawn to the element of the mark that can be read, and so the word FASSFERN plays the greater role in the overall impression, with the fern device playing a lesser role. The stylisation plays a much lesser role.

³¹ Whilst I note that the 527 Mark is a series of two trade marks, being FASSFERN and FASS FERN, I do not consider that anything will turn on the spacing in the second of these two marks. Consequently, the assessment that I carry out here will apply equally to both.

Visual Comparison

91. The only element of the 382 and 527 Marks appears in the 385 Mark. The 382 and 527 Marks are word only marks and so could be used in any font. The fern device is a point of visual difference. The marks are visually similar to between a medium and high degree.

Aural Comparison

92. The only element of the 385 Mark that will be articulated is the word FASSFERN. Consequently, the marks are aurally identical.

Conceptual Comparison

93. In my view, the word FASSFERN will be viewed as an invented word. Whilst some people will be familiar with it as a geographical place name, they will not make up a significant proportion of average consumers. The 382 and 527 Marks will not, therefore, convey any conceptual message. The word element of the 385 Mark will also not convey any conceptual message, but the device will be recognised as a fern. Consequently, the marks overall are conceptually dissimilar, with the common element being conceptually neutral.

Distinctive character of the earlier marks

94. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 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 1-2779, 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).”

95. 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. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it.

96. WHW has not filed any evidence of use and, consequently, I have only the inherent position to consider. The word FASSFERN will be viewed as an invented word with no clear meaning. In my view, it is inherently distinctive to a high degree.

Likelihood of confusion

97. 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 them and the goods down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the marks may be offset by a greater degree of similarity between

the goods, and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive 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 he has retained in his mind.

98. I have found as follows:

- a. The goods are identical.
- b. The average consumer is a member of the general public (who is over the age of 18) and who will pay a medium degree of attention during the purchasing process.
- c. The purchasing process is predominantly visual, although I do not discount an aural component.
- d. The marks are visually similar to between a medium and high degree, aurally identical and conceptually dissimilar overall (although the common element is conceptually neutral).
- e. The 382 and 527 Marks are inherently distinctive to a high degree.

99. In my view, there is potential for the average consumer to only recall the word element of the mark, resulting in one mark being mistaken for the other. This is particularly the case given that the parties' goods are identical. Consequently, there is a likelihood of direct confusion.

100. Even if I am wrong in that finding, the common use of the distinctive element FASSFERN with the addition of a fern device is likely to be viewed as an alternative mark being used by the same, or economically linked, undertakings. It is common in trade for parties to use a word as their brand and for this to be used, in some contexts, on its own and, in other contexts, in conjunction with a device as part of a composite

mark. The marks are, therefore, logical and consistent with a brand extension. Further, the common element is so distinctive that the average consumer would expect only one undertaking to be using it.³² Consequently, I consider there to be a likelihood of indirect confusion.

101. The opposition based upon section 5(2)(b) of the Act succeeds in full.

Section 3(6)

102. I have set out the legislation and case law in relation to section 3(6) above. I apply the same here.

What, in concrete terms, was the objective that the applicant has been accused of pursuing?

103. WHW's pleaded case is as follows:

“[WHW] and [Mr Ross] were involved in negotiations for a distillery to be built on the land of [WHW] which is on the Fassfern Estate and the Opponent registered [the 527 Mark] for the products which would arise as a result of the project and gave consent to [Mr Ross] to use the mark with its permission on gin until such time as the parties entered into a formal agreement and lease relating to the distillery. [Mr Ross] was aware of the ownership of [the 527 Mark] by [WHW], that by filing the application it is seeking to appropriate [WHW]'s mark. [Mr Ross] also had filed UK application No. UK00003644574 FASSFERN during negotiations which was also opposed and abandoned by [Mr Ross]. Whilst the standard of business conduct for bad faith to be determined is high, [WHW] can demonstrate prolonged negotiations with [Mr Ross] relating to the lease of land for a distillery and licence for the trade mark.”

³² *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10

Was that an objective for the purposes of which the contested application could not be properly filed?

104. Applying for a trade mark in the knowledge that you are only permitted to use it with consent of the owner of that mark is a basis, in my view, for a finding of bad faith.

Was it established that the contested application was filed in pursuit of that objective?

105. I note that Mr Ross claims to have had an agreement with WHW that they would transfer the ownership of the trade mark(s) FASSFERN to him at some point. There is nothing in evidence to support that claim. Further, as noted above, there is evidence to the contrary. Mr Ross sought permission from WHW before commencing use of the FASSFERN mark in relation to gin. He also confirmed to legal representatives that it was WHW that “rightfully” owned the FASSFERN mark. With this in mind, it seems to me that Mr Ross knew that he was not entitled to register the sign FASSFERN. That is, of course, not the end of the matter because the mark applied for is not just the word FASSFERN; it is the word plus the fern device. However, given my finding that the word FASSFERN is the dominant element of that mark, I consider that it is also bad faith to have applied for the 385 Mark in the circumstances.

106. In making this finding, I have borne in mind Mr Ross’s claim that FASSFERN is a place name and so should be free to all to use. In that context, I can see that there is an argument that Mr Ross was applying for the particular style of the word FASSFERN in the 385 Mark and the device, rather than an exclusive right to the word FASSFERN. However, that argument is somewhat undermined by the documentary evidence which shows Mr Ross’s support for the registration of the word only mark FASSFERN, which would exclude all others from using it in any form.

107. The opposition based upon section 3(6) of the Act succeeds.

CONCLUSION

108. The application for invalidation in relation to UKTM no. 3427527 fails and, subject to any successful appeal, it may remain registered.

109. The application for invalidation in relation to UKTM no. 3919382 fails and, subject to any successful appeal, it may remain registered.

110. The opposition against UKTM no. 3924385 is successful and, subject to any successful appeal, the application is refused.

COSTS

111. WHW has been successful in both the applications for invalidation and the opposition. They have requested costs off the scale.

112. I therefore direct WHW to file full written reasons for their request for costs off the scale, along with details of those costs within 14 days.

113. Mr Ross will then have a period of 14 days in which to reply.

114. A subsequent decision on costs will then be issued.

Dated this 13th day of August 2025

S WILSON

For the Registrar

ANNEX

The 527 Mark

Class 33

Alcoholic beverages; spirits; whisky; liqueurs; but insofar as whisky and whisky based liqueurs are concerned, only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.

The 382 Mark

Class 33

Alcoholic beverages; spirits; liqueurs; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based, all being produced in Scotland; Scotch whisky; gin.

Class 35

Business organisation and management of country estate services, including management and promotion of walking and hiking trails, business organisation and management of hunting, shooting and fishing services and business management of leisure facilities; business management of visitor attractions; business management of entertainment venues; organising and conducting volunteer projects and community projects; Retail services and on-line retail services connected with the sale of agricultural, horticultural and forestry products and grains, living animals, fresh fruits and vegetables, seeds, natural plants and flowers, foodstuffs for animals, malt, food and drink, event and festival tickets, educational events, printed matter, alcoholic beverages, spirits, whisky, gin, liqueurs, waters [beverages], mineral water, aerated water, non-alcoholic beverages, printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and packaging materials, plastic materials for packaging, signs and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses,

tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear, aprons, caps, visors, belts, bags foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.

Class 41

Education and entertainment services; education services relating to conservation, agriculture and estate management; education, training apprenticeship and youth training scheme services in the fields of estate management, holiday accommodation, leisure facilities and attractions and catering; provision of leisure facilities; provision and rental of temporary lodgings; provision of visitor attractions for cultural purposes; provision of visitor attractions for entertainment purposes; presentation of live performances; organisation and provision of musical and cultural activities; provision of entertainment, events and show facilities; provision of cultural events, festivals relating to food, drink, agriculture, leisure, music or entertainment; arranging, organising and conducting of sports events; provision of facilities for golf; provision of facilities for general recreation; arranging and conducting conferences and seminars; arranging of courses of instruction for tourists; corporate hospitality (entertainment); whisky tasting services; distillery tours; provision of club recreation services; publication of texts and newsletters; arranging and conducting talks, tastings, conferences and exhibitions; publication of tasting notes and bottling lists; arranging of competitions for educational, entertainment and cultural purposes; organisation of competitions and prize giving; provision of courses of instruction for tourists; cultural

facilities; presentation of live performances; publication of books; information and advisory services relating to the foregoing services.

Class 43

Provision of holiday accommodation; provision and rental of temporary lodgings; provision of holiday homes and holiday accommodation; rental of holiday homes and holiday accommodation; campground facilities; caravan park facilities; booking of accommodation for travellers; provision of on-line booking services relating to accommodation; provision of camping facilities; provision of museum, presentation and exhibition facilities; restaurant and bar services; services for providing food and drink; temporary accommodation; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding receptions (food and drink); restaurants; corporate hospitality (provision of food and); whisky tasting services (provision of beverages); cafes; cafeterias.