O/108/22

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NO. UK3517903
IN THE NAME OF GLEANN MOR SPIRITS COMPANY
TO REGISTER AS A TRADE MARK

Ginsky
{jin-skay}

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. OP000423117
BY CAMPARI AMERICA LLC

BACKGROUND AND PLEADINGS

1. On 31 July 2020, Gleann Mor Spirits Company ("the applicant") applied to register the trade mark shown on the cover page of this decision in the United Kingdom. The application was accepted and published for opposition purposes on 06 November 2020, in respect of the following goods:

Class 33: *Alcoholic beverages consisting of or containing Gin; spirits and liqueurs containing Gin; prepared alcoholic cocktails containing Gin; potable distilled spirits, alcoholic extracts; Alcoholic beverages consisting of or containing Whisky; spirits and liqueurs contains Whisky, prepared alcoholic cocktails containing Whisky; but in so far as whisky and whisky based liqueurs are concerned with only whisky and whisky based liqueurs produced in Scotland complying with the specifications of the PGI of Scotch whisky.*

2. The application is opposed by Campari America LLC ("the opponent"). The opposition was filed on 08 February 2021 and is based upon Section 5(2)(b)[1] of the Trade Marks Act 1994 ("the Act"). The opposition is directed against all of the goods in the application. The opponent relies upon the following marks:

SKYY

UK trade mark registration number 2529959
Filing date: 27 October 2009
Registration date: 16 April 2010
Registered in Classes 32, 33, 42 and 43
Relying on all goods and services, namely:

[1] The opposition was originally filed under 5(2)(b) and 5(3) grounds, however the 5(3) grounds were later struck out as the opponent did not file evidence in support of these grounds. The opposition therefore proceeds under Section 5(2)(b) only.

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparation for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

Class 42: *Providing a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.*

Class 43: *Services for providing food and drink; temporary accommodation; pubs; bar and restaurant services; self-services restaurants; snack bar and canteen services; wine bars; brewpub services; Cafes; Cafeterias; Carry-out services; Catering for the provision of food and drink.*

("Mark 1"); and

SKYY

EU Registration No. 001037191[2]

EU Filing date: 05 January 1999

EU Registration date: 29 March 2000

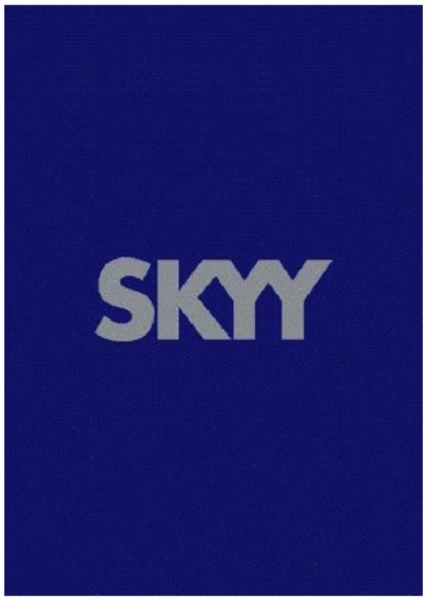
Registered in Class 33

Relying on all goods, namely:

Distilled spirits, namely vodka in class 33.

("Mark 2"); and

[2] Although the UK has left the EU and the transition period has now expired, EUTMs and International Marks which have designated the EU for protection are still relevant in these proceedings given the impact of the transitional provisions of The Trade Marks (Amendment etc.) (EU Exit) Regulations 2019 – please see Tribunal Practice Notice 2/2020 for further information.



EU Registration No. 009260076[3]

EU Filing date: 20 July 2010

EU Registration date: 03 January 2011

Registered in Classes 32, 33, 42 and 43

Relying on the following goods and services only:

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.*

Class 33: *Alcoholic beverages (except beers); alcoholic essences; alcoholic extracts; fruit extracts, alcoholic.*

Class 42: *Hosting a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.*

Class 43: *Services for providing food and drink; temporary accommodation; public house services; bar and restaurant services; self-service restaurants; snack bar and canteen services; wine bars; cafès; cafeterias; takeaway services; catering for the provision of food and drink.*

("Mark 3"); and

[3] This mark is subject to cancellation proceedings against it at the EUIPO and as such, it is possible that it may be removed from the EUIPO register. In the event that this decision is reliant upon this mark only, it can only be provisional, subject to the outcome of the EUIPO proceedings.

MARK DESCRIPTION: Specific colours SILVER GREY (PMS 877C) and COBALT BLUE (RAL 5013) claimed as a feature of the mark

UK trade mark registration number 2536791
Filing date: 21 January 2010
Registration date: 25 June 2010
Registered in Classes 32, 33, 42 and 43
Relying on all goods and services, namely:

Class 32: *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparation for making beverages.*

Class 33: *Alcoholic beverages (except beers).*

Class 42: *Providing a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.*

Class 43: *Services for providing food and drink; temporary accommodation; public house services; bar and restaurant services; self-services restaurants; snack bar and canteen services; wine bars; cafes; cafeterias; takeaway services; catering for the provision of food and drink.*

("Mark 4").

3. The opponent claims that the mark subject of the application is highly similar to the earlier registered rights due to it containing the highly similar element “Ginsky”, and submits that “the contested goods in class 33 are clearly identical to the Earlier Registered Rights coverage in class 33, as well as being highly similar to the Earlier Registered Rights’ coverage in classes 32, 42 and 43”. Consequently, it claims that the relevant public is likely to erroneously believe that the goods in question originate from the opponent or that the opponent is economically-linked with the applicant, leading to a likelihood of confusion or association with the opponent’s earlier registered rights. The opponent requests that the application be refused in its entirety and that an award of costs be made in its favour.

4. The applicant filed a counterstatement denying the claims and asserts that there are clear visual distinctions between the opponent’s registered marks and the mark applied for by the applicant, to such an extent that there could not be any likelihood of confusion. It further claims that the applicant’s goods are distinct from the opponent’s goods and services as the applicant’s specification is limited to gin and whisky products while the opponent’s SKYY product is vodka.

5. The applicant filed written submissions, and both parties filed written submissions in lieu of a hearing, which will not be summarised, but will be referred to as and where appropriate during this decision. Only the applicant elected to file evidence, which will be summarised to the extent considered necessary. Neither party requested a hearing, therefore this decision is taken following a careful perusal of the papers.

6. In these proceedings, the opponent is represented by Potter Clarkson LLP and the applicant is represented by BTO Solicitors LLP.

Evidence

7. The applicant filed evidence by way of a witness statement dated 3 October 2021 in the name of Derek Joseph Mair in his capacity as the co-founder and sole director of Gleann Mor Spirits Company Limited (“Gleann Mor”). Mr Mair submits that there is no similarity between the marks nor would confusion be cause or be likely to be caused

by the registration of the "Ginsky" mark. Mr Mair adduces eight exhibits in support of the application, labelled DJM1 – DJM8 accordingly.

8. Mr Mair states that "Ginsky" is sold through a number of boutique retailers, both online and instore. Exhibits DJM1 – DJM6 show examples of this in the form of printouts of web pages from online retailers Yumbles, BoroughBox, Not On The High Street, and Amazon UK. In each of these exhibits the mark is shown in use as a label on the product bottle.

9. Exhibit DJM7 shows a printout of the opponent's mark being offered for sale on Amazon UK, while exhibit DJM8 shows a printout of the opponent's mark on what appears to be an advertisement for its "SKYY" product on the opponent's own website.

10. In paragraph 6 of the witness statement, Mr Mair submits that the customer review of the Ginsky product in exhibit DM4, which the reviewer says is "An unusual and interesting product", demonstrates that consumers consider that it would not be easily confused with any other spirit or drink on the market. However, to my mind, the reviewer is talking about the contents inside the bottle and not the brand name, and as such does not support the case for lack of confusion.

11. Mr Mair further submits that the branding and marketing of the Ginsky product sets it apart from other products and that exhibits DJM7 - DJM8 show that the opponent's products are clearly different and distinct to the Ginsky mark, with no risk of confusion.[4]

DECISION

12. Although the UK has left the European Union, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. Therefore, this decision contains references to the trade mark case-law of the European courts.

[4] Paragraph 8 of witness statement.

Section 5(2)(b)

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

> "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".

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

> "6.- (1) In this Act an "earlier trade mark" means –
>
> (a) a registered trade mark, international trade mark (UK), European Union trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,
>
> …"

15. Given their filing dates, each of the trade marks upon which the opponent relies qualify as an earlier trade mark under the above provisions. The earlier marks were registered more than 5 years before the date of application of the contested mark and so the applicant could have required the opponent to provide proof of use of the marks under section 6A of the Act. As it did not do so, the opponent is able to rely on all the goods and services for which the earlier marks are registered.

16. I am guided by the following principles which 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 Office for Harmonisation in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P 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

17. In *Canon*, Case C-39/97, the Court of Justice of the European Union ("CJEU") stated that:

> "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".[5]

[5] Paragraph 23

18. Guidance on this issue has also come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

> "(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."

19. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court ("GC") stated that "complementary" means:

> "...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking".[6]

20. The goods and services to be compared are:

[6] Paragraph 82

Opponent's goods and services	Applicant's goods
Mark 1 Class 32 *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparation for making beverages.* Class 33 *Alcoholic beverages (except beers).* Class 42 *Providing a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.* Class 43 *Services for providing food and drink; temporary accommodation; pubs; bar and restaurant services; self-services restaurants; snack bar and canteen services; wine bars; brewpub services; Cafes; Cafeterias; Carry-out services; Catering for the provision of food and drink.*	Class 33 *Alcoholic beverages consisting of or containing Gin; spirits and liqueurs containing Gin; prepared alcoholic cocktails containing Gin; potable distilled spirits, alcoholic extracts; Alcoholic beverages consisting of or containing Whisky; spirits and liqueurs contains Whisky, prepared alcoholic cocktails containing Whisky; but in so far as whisky and whisky based liqueurs are concerned with only whisky and whisky based liqueurs produced in Scotland complying with the specifications of the PGI of Scotch whisky.*
Mark 2 Class 33 *Distilled spirits, namely vodka in class 33.*	
Mark 3 Class 32 *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.* Class 33	

Alcoholic beverages (except beers); alcoholic essences; alcoholic extracts; fruit extracts, alcoholic. Class 42 *Hosting a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.* Class 43 *Services for providing food and drink; temporary accommodation; public house services; bar and restaurant services; self-services restaurants; snack bar and canteen services; wine bars; cafes; cafeterias; takeaway services; catering for the provision of food and drink.*	
Mark 4 Class 32 *Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparation for making beverages.* Class 33 *Alcoholic beverages (except beers).* Class 42 *Providing a web site featuring a searchable collection of alcoholic and non-alcoholic cocktail recipes.* Class 43 *Services for providing food and drink; temporary accommodation; public house services; bar and restaurant services; self-services restaurants; snack bar and canteen services; wine bars; cafes; cafeterias; takeaway services; catering for the provision of food and drink.*	

21. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where appropriate. In *Separode Trade Mark*, BL O-399-10, Mr Geoffrey Hobbs QC, sitting as the Appointed Person, said:

> "The determination must be made with reference to each of the different species of goods listed in the opposed application for registration; if and to the extent that the list includes goods which are sufficiently comparable to be assessable for registration in essentially the same way for essentially the same reasons, the decision taker may address them collectively in his or her decision."[7]

22. In *Gérard Meric v OHIM,* Case T-133/05, the GC stated that:

> "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".[8]

23. In its Statement of Grounds, the opponent submits that "the contested goods are clearly identical to the Earlier Registered Rights' coverage in class 33, as well as being highly similar to the Earlier Registered Rights' coverage in classes 32, 42 and 43".[9]

24. In its written submissions, the applicant submits that its goods "are specifically limited to gin and whisky based spirits" and that "the limited uses of these goods … and the non-competing nature of the goods do not give rise to any similarity".[10]

[7] Paragraph 5
[8] Paragraph 29
[9] Paragraph 4.
[10] Paragraph 21 of written submissions dated 04 October 2021.

25. The applicant's "*Alcoholic beverages consisting of or containing Gin; spirits and liqueurs containing Gin; prepared alcoholic cocktails containing Gin; potable distilled spirits, alcoholic extracts; Alcoholic beverages consisting of or containing Whisky; spirits and liqueurs contains Whisky, prepared alcoholic cocktails containing Whisky; but in so far as whisky and whisky based liqueurs are concerned with only whisky and whisky based liqueurs produced in Scotland complying with the specifications of the PGI of Scotch whisky"* are clearly encompassed within the broader term "*Alcoholic beverages (except beers)"* as specified in Class 33 of the opponent's earlier Mark 1, Mark 3 and Mark 4. Applying the principle set out in *Meric*, I therefore find the competing goods to be identical.

The average consumer and the nature of the purchasing act

26. 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. (as he was then) described the average consumer in these terms:

> "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 word "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median".[11]

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

28. In its written submissions, the opponent submits that the relevant consumer of the contested goods is a member of the adult general public who falls between the inattentive habitual drinker and the focused specialist, and that the purchasing act will

[11] Paragraph 60.

be fairly quick, although the degree of attention applied will depend on, inter alia, the knowledge, experience and purchase involvement of the consumer, but is no higher than an average degree.[12]

29. In my view, due to the alcoholic nature of the goods, the average consumer will be an adult member of the general public of 18 years of age or older who will purchase the goods for consumption at home or in a social setting of a bar or restaurant. The goods will also be purchased by buyers for venues such as public bars and restaurants.

30. The goods are sold through a range of channels, including wholesale outlets and retail outlets such as supermarkets and off-licences, as well as through specialist suppliers and online. In bricks and mortar stores, the goods will be sold on shelves where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. The goods will also be sold in restaurants, bars and public houses, where they are likely to be displayed behind the counter or listed on a drinks menu. Considered overall, the selection process is predominantly visual, although I do not discount aural considerations, particularly in bars and restaurants, where the goods may also be selected and requested verbally. The value of the goods, which are not considered to be an everyday purchase, but are likely to be purchased on a semi-regular basis by the general public, will vary in price, but are considered to be relatively inexpensive.

31. Overall, I consider that the average consumer will pay a medium level of attention during the selection process, basing their selection on the type of beverage and personal taste, as well as the cost of the product and the occasion for which it is being purchased.

Comparison of marks

[12] Paragraphs 11 – 12 of submissions dated 13 December 2021.

32. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a 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 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 in *Bimbo SA v OHIM* Case C-591/12P, that:

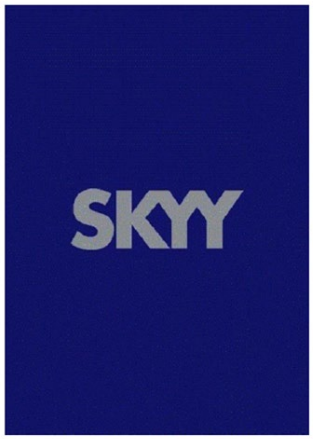
> ".....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion."[13]

33. 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.

34. The respective trade marks are shown below:

Opponent's trade marks	**Applicant's trade mark**
Marks 1 & 2 **SKYY**	Ginsky {jin-skay}
Mark 3	

[13] Paragraph 34

	
Mark 4 	

35. The opponent submits that the dominant and distinctive element of both its word marks and its stylised marks is plainly the word "SKYY", and that the background to the stylised marks does not alter the distinctive character of the key element, being the word "SKYY", in those marks. It further submits that the prefix "Gin" in the contested mark is entirely descriptive of the goods and therefore cannot perform a distinctive role within the sign. The opponent references EUIPO Opposition No B 2 694 654 *Campari America LLC v Kim Köhler* (28 November 2018) in support of this submission.[14] Whilst I have considered the impact of this decision, I am not bound by the findings of the EUIPO, and I draw my own conclusions based on the evidence before me.

36. The applicant submits that the opponent's highest case is that the competing marks contain three of the same letters, however the marks are of different lengths

[14] See paragraphs 17-19 of opponent's written submissions.

and the words begin with different letters and can be easily distinguished. It submits that its own mark is a combination of the names of the two main ingredients of the product to which the mark is applied, being gin and whisky. Further, the braces around the phonetic pronunciation element gives the mark a high degree of distinction visually. It submits that the second syllable of the first word would be pronounced in the same way as the second syllable of the word "whisky, and not as "sky" as in the name of the atmosphere above the earth. The applicant makes reference to the *London Lubricants* (1925) case, and submits that the first syllable of the mark is most dominant and likely to be most emphasised.[15]

Overall impression

37. It is my view that there is a greater level of similarity between the contested mark and the opponent's word marks than there is between the contested mark and the stylised marks.

38. The opponent's Mark 1 and Mark 2 are identical in that they each consist of the plain word "SKYY", presented in a standard font and capital letters without any other elements to contribute to the overall impression. The overall impression conveyed by each mark therefore rests in the word itself.

39. The opponent's Mark 3 and Mark 4 each consist of the word "SKYY" presented in a silver grey standard font in upper case, positioned in the centre of a blue rectangular background, with the rectangular shape running vertically. The colours SILVER GREY (PMS 877C) and COBALT BLUE (RAL 5013) are claimed as a feature of Mark 4. While there is a slight variation in colour between Mark 3 and Mark 4, to my mind this would only be noticed if the two marks were presented side by side and for all intents and purposes, the marks are identical in appearance. In my view, it is the word "SKYY" itself which is the dominant and distinctive element and plays the greatest role in the overall impression of the mark. I consider the background to be a purely decorative element which does not add to the trade mark message conveyed by the word and as such does little to contribute to the overall impression of the mark.

[15] Paragraph 3 of applicant's written submissions in lieu.

40. The applicant's mark consists of two separate components: the word "Ginsky" is presented in Title case in a standard bold black typeface. Below it, presented in lower case in the same standard black typeface and encased in curly brackets, is the word jin-skay (**{jin-skay}**), the brackets and hyphenation giving the appearance that it is a guide to the pronunciation of the word Ginsky. To my mind, the word in brackets plays a secondary role and although it would not go unnoticed, it is the word Ginsky which plays the greatest role in the overall impression of the mark.

Visual comparison

41. All four of the opponent's earlier marks contain the same four letter word "SKYY". The last three letters of the contested mark "Ginsky" share the first three letters of the earlier marks, however that is where the visual resemblance ends. In *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02, the General Court noted that the beginning of words tend to have more visual and aural impact than the ends, although I accept that this is not always the case. Considering the marks as a whole, I find there to be a very low degree of visual similarity between them.

Aural comparison

42. In spite of the double YY at the end of the word, I consider that the average consumer would pronounce the word "SKYY" in the opponent's marks as "SKY" (skʌɪ). The word "Ginsky" in the applicant's mark is likely to be pronounced as two syllables, GIN SKI (dʒɪn skiː), or, if the consumer perceives that the word beneath Ginsky is an aid to the pronunciation, they would articulate it as two syllables GIN SKAY (dʒɪn skeɪ). While some consumers would articulate both words, voicing the whole mark as either GIN SKI GIN SKAY or GIN SKAY GIN SKAY, to my mind, a significant proportion of consumers would only voice the first word "Ginsky". In whichever way the contested mark is pronounced, I consider that the competing marks are aurally dissimilar.

Conceptual comparison

43. To those consumers who see the word “SKYY” in the opponent’s marks as a made-up term, it will have no conceptual identity. However, I consider it more likely that the word “SKYY” will be seen as either alluding to, or as an unusual or alternate spelling of, the word “SKY”, which may be reinforced by the blue background, rather than being perceived as an invented word. In either case, there is no connection between the word “SKYY” and the goods and services of the marks. To those consumers who see the word “Ginsky” in the applicant’s mark as a made-up term, it will have no conceptual identity, although to my mind it is more likely that a significant proportion of consumers will perceive it as alluding to the alcoholic beverage gin, due to the first three letters of the word and in direct relation to the goods of the application. However, I do not agree with the opponent’s assertion that the dominant and distinctive element of the contested mark is the word “sky” and that the conceptual meaning of the applicant’s mark has to therefore be derived from “sky”, rendering it conceptually identical to the earlier marks. Although case law directs me to bear in mind the dominant and distinctive elements of the marks, the average consumer views the mark as a whole and is not in the habit of unnaturally dissecting words in order to find an underlying conceptual meaning. In this case, I consider that the average consumer will consider the word “Ginsky” as a whole and as such will see the sign as allusive of the goods. Taking all of this into account, I consider that the competing marks are conceptually dissimilar.

Distinctive character of the earlier marks

44. The distinctive character of a trade mark can be appraised only, first, by reference to the goods in respect of which registration is sought and, secondly, by reference to the way it is perceived by the relevant public – *Rewe Zentral AG v OHIM (LITE)* [2002] ETMR 91.

45. 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 *WindsurfingChiemsee* v *Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

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

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

47. The opponent claims in its statement of grounds and reiterates in its written submissions that the earlier marks enjoy enhanced distinctive character due to the extensive use of the marks by the opponent, citing the commercial success of the SKYY brand, including the volume of custom, the geographical reach within the UK and the positive brand message conveyed thereunder. The opponent submits that the applicant's exhibit DJM7 further evidences this, showing a large number of customer reviews, with positive ratings and recognition of the product through the gold award symbol in front of the bottle. The opponent has not, however, filed evidence of its own to support its claims of enhanced distinctiveness.

48. It is my view that the blue background to Mark 3 and Mark 4 do not significantly add to the distinctiveness of the marks, being seen as mere decoration. I do not consider the word “SKYY” in the four earlier marks to be a natural mis-spelling of the word “SKY”, although it may well be perceived as an unusual spelling of the word. Neither do I consider that the marks are either descriptive or allusive of the goods and services for which they are registered. Consequently, I consider that the earlier mark has a high level of inherent distinctive character where the average consumer perceives the word “SKYY” to be an invented word, and at least a medium level of distinctive character where the consumer perceives it to be a mis-spelling of “SKY”.

49. While I note that the applicant’s exhibits DJM7 - DJM8 show some use of the earlier mark, I consider that the limited nature of the opponent’s submissions in relation to enhanced distinctive character through use is insufficient to support such a finding.

Likelihood of confusion

50. There is no simple formula for determining whether there is a likelihood of confusion. In determining whether there is a likelihood of confusion, a number of factors need to be borne in mind.

51. It is clear then that I must make a global assessment of the competing factors (*Sabel* at [22]), keeping in mind the interdependency between them i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa (*Canon* at [17]). In making my assessment, I must consider the various factors from the perspective of the average consumer, bearing in mind 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 he has retained in his mind (*Lloyd Schuhfabrik* at [26]).

52. There are two types of possible confusion: direct, where the average consumer mistakes one mark for the other, or indirect, where the average consumer realises the marks are not the same but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related. The distinction

between these was explained by Mr Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v Back Beat Inc*, Case BL-O/375/10. He said:

> "16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: "The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.
>
> 17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:
>
> (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right ("26 RED TESCO" would no doubt be such a case).
>
> (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as "LITE", "EXPRESS", "WORLDWIDE", "MINI" etc.).
>
> (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ("FAT FACE" to "BRAT FACE" for example)."

53. The above are examples only which are intended to be illustrative of the general approach. These examples are not exhaustive but provide helpful focus.

54. Earlier in this decision, I found that:

- The level of attention of the adult general public as the average consumer will be medium when selecting the goods;

- The goods at issue will be selected by predominantly visual means, although I do not discount aural considerations;

- The competing trade marks are visually similar to a very low degree and are aurally and conceptually dissimilar;

- The earlier marks are inherently distinctive to at least a medium degree where they are perceived as an unusual spelling of, or alluding to, the word "SKY", and are inherently distinctive to a high degree where the word "SKYY" is seen as an invented word;

- The contested goods are identical to the Class 33 goods of the opponent's Marks 1, 3 and 4 and are similar to a high degree to the opponent's goods in its earlier Mark 2.

55. In its written submissions dated 04 October 2021, the applicant submits that the opponent has not produced any evidence to suggest that there has been any confusion.[16] In paragraph 5 of the witness statement, Mr Mair states that he has never known there to be a situation where a member of the public has confused Ginsky with any other product on the market. However, absence of evidence of confusion does not necessarily mean an absence of actual confusion.[17]

[16] Paragraph 37.
[17] See paragraph 80, *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220.

56. Taking into account the previously outlined guidance of Mr Iain Purvis Q.C. on likelihood of confusion, while allowing that the average consumer is unlikely to see the marks side-by-side and will therefore be reliant on the imperfect picture of them they have kept in their mind, I consider it unlikely that they would mistake one mark for the other. In my view, the average consumer will notice and recall the visual, aural and conceptual differences between the marks. I do not consider there is any likelihood of direct confusion, even where I found the respective goods to be identical, which offsets a lesser degree of similarity between the marks, as the differences between the marks are too great for confusion to arise.

57. I now turn to consider whether there might be a likelihood of indirect confusion. Here the average consumer recognises that the marks are different but assumes that the goods are the responsibility of the same or connected undertakings. In *Duebros Limited v Heirler Cenovis GmbH,* BL O/547/17, Mr James Mellor Q.C. (as he then was), as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

58. In *Liverpool Gin Distillery Ltd and others v Sazerac Brands, LLC and others* [2021] EWCA Civ 1207, the Court of Appeal dismissed an appeal against a ruling of the High Court that trade marks for the words EAGLE RARE registered for whisky and bourbon whiskey were infringed by the launch of a bourbon whiskey under the sign "American Eagle". In his decision, Lord Justice Arnold stated that:

> “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.”

59. Keeping in mind the global assessment of the competing factors in my decision, and in particular the very low degree of visual similarity between the marks, as well as the aural and conceptual dissimilarities, it is my view that it is unlikely that the average consumer would assume that there is an economic connection between the parties. I acknowledge that the categories listed by Mr Iain Purvis Q.C. in *L.A. Sugar* are not exhaustive, however, I do not see anything which would lead the average consumer into believing that one mark is a brand extension of the other, or assume that there is an economic connection between the parties. I therefore find no likelihood of indirect confusion.

60. Based on these conclusions, the opposition fails under section 5(2)(b).

Conclusion

61. The opposition has failed and, subject to any successful appeal, the application by Gleann Mor Spirits Company may proceed to registration.

Costs

62. The applicant has been successful, and is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 2/2016. As the evidence submitted by the applicant in support of the application was considered to be irrelevant, I will make no award for that evidence. Applying the guidance in the TPN, I award the applicant the sum of £700, which is calculated as follows:

Considering the notice of opposition and preparing a counterstatement:	£300
Preparing written submissions in lieu of a hearing:	£400
Total:	**£700**

63. I therefore order Campari America LLC to pay Gleann Mor Spirits Company the sum of £700. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 8th day of February 2022

Suzanne Hitchings
For the Registrar,
the Comptroller-General