O/1109/24

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION NO. 927540
IN THE NAME OF WHYTE AND MACKAY LIMITED
FOR THE FOLLOWING TRADE MARK:

BEN WYVIS

IN CLASS 33
AND
AN APPLICATION FOR REVOCATION THEREOF
ON GROUNDS OF NON-USE
UNDER NO. 504508
BY DRINKSOLOGY LIMITED

Background

1) Whyte and Mackay Limited ('the proprietor') is the registered proprietor of trade mark registration number 927540 for the mark BEN WYVIS in respect of whisky in class 33. The registration procedure of the mark was completed on 11 June 1969.

2) Drinksology Limited ('the applicant') seeks revocation of the trade mark registration on the grounds of non-use under Section 46(1)(a) or (b) of the Trade Marks Act 1994 ('the Act')[1].

3) The section 46(1)(a) claim is based upon the five-year period following registration, namely, 12 June 1969 to 11 June 1974, with a claimed date of revocation of 12 June 1974.

4) The section 46(1)(b) claim is based on three five-year periods. The first period is 20 January 2007 to 19 January 2012 with a claimed date of revocation of 20 January 2012. The second period is 20 January 2012 to 19 January 2017 with a claimed date of revocation of 20 January 2017. The third period is 20 January 2017 to 19 January 2022 with a claimed date of revocation of 20 January 2022.

5) The proprietor filed a counterstatement opposing the application for revocation. It is claimed that the registered mark has been put to genuine use in relation to whisky, in all of the relevant periods The proprietor also states the following:

> "To the extent that there was not use during any of these periods there were proper reasons for non-use, including that whisky brands are rested from time to time, and/or whisky brands are refreshed or relaunched, and/or whisky labels used for private labels on demand."

6) The applicant is represented by Mathys & Squire LLP. The proprietor is represented by Murgitroyd & Company. Only the proprietor filed evidence. This consists of a

[1] Form TM26(N) was initially filed on 20 January 2022 and subsequently amended and re-filed on 1 April 2022.

witness statement from Caitlin McNeish (the proprietor's Legal Manager) with Exhibits CM1 – CM7 thereto. The applicant filed written submissions in response[2]. A hearing took place before me at which the applicant was represented by Mr Andrew Lomas, of Counsel, instructed by Mathys & Squire LLP. The proprietor did not attend the hearing but filed written submissions in lieu[3].

DECISION

Statutory provisions

7) The relevant provisions of section 46 of the Act are as follows:

> "(1) The registration of a trade mark may be revoked on any of the following grounds –
>
> > (a) that within the period of five years following the date of completion of the registration procedure it has not been put to genuine use in the United Kingdom, by the proprietor or with his consent, in relation to the goods or services for which it is registered, and there are no proper reasons for non-use;
> >
> > (b) that such use has been suspended for an uninterrupted period of five years, and there are no proper reasons for non-use;
> >
> > (c) […]
> >
> > (d) […]
>
> (2) For the purpose of subsection (1) use of a trade mark includes use in a form (the "variant form") differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of

[2] Dated 3 January 2023
[3] Dated 3 November 2023

whether or not the trade mark in the variant form is also registered in the name of the proprietor), and use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(3) The registration of a trade mark shall not be revoked on the ground mentioned in subsection (1)(a) or (b) if such use as is referred to in that paragraph is commenced or resumed after the expiry of the five year period and before the application for revocation is made:

Provided that, any such commencement or resumption of use after the expiry of the five year period but within the period of three months before the making Page 6 of 25 of the application shall be disregarded unless preparations for the commencement or resumption began before the proprietor became aware that the application might be made.

(4) […]

(5) Where grounds for revocation exist in respect of only some of the goods or services for which the trade mark is registered, revocation shall relate to those goods or services only.

(6) Where the registration of a trade mark is revoked to any extent, the rights of the proprietor shall be deemed to have ceased to that extent as from –

(a) the date of the application for revocation, or

(b) if the registrar or court is satisfied that the grounds for revocation existing at an earlier date, that date."

8) Section 100 of the Act is also relevant, which reads:

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

Relevant Case law

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

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

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

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

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

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

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

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

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

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark,

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

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

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

11) In *Awareness Limited v Plymouth City Council,* Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the

tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

12) In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd,* Case BL O/404/13*,* Mr Geoffrey Hobbs Q.C. as the Appointed Person stated that:

"21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

> [24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

evidence does and just as importantly what it does not *'show'* (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use."

The proprietor's evidence

13) Ms McNeish states that the mark BEN WYVIS has been used by the proprietor or its predecessors in title since 1965. Ms McNeish also explains, inter alia, that:

- Invergordon Distillers Limited, the proprietor's predecessor in title, built the INVERGORDON Grain Distillery in Ross-shire, part of the Highland whisky region. Production started in 1961 producing single malt whisky using one Coffey still with two more stills added by 1963. Ownership passed in 1965 to Invergordon Distillers (Holdings) Limited. 1965 also saw the creation of a new distillery, the BEN WYVIS Highland Malt Distillery, which was built within the INVERGORDON Distillery complex. The BEN WYVIS distillery produced unpeated malt whisky.
- Only a small handful of official BEN WYVIS bottlings have ever been released and their rarity makes them coveted. The brand is well known amongst those interested in Scotch whisky.
- The BEN WYVIS Distillery was closed in 1977. However, its stills were saved and transferred to a distillery in Campbeltown, and then subsequently back to INVERGORDON Distillery grounds, site of the BEN WYVIS Distillery. In 1993, Invergordon Distillers (Holdings) Limited was acquired by Whyte & Mackay Limited (the proprietor).
- The fact that the BEN WYVIS distillery was in place for such a short time and that only a few bottlings of the whisky were ever released makes BEN WYVIS rare and, therefore, highly sought after by collectors.
- Having bottled what it thought to be the last casks of BEN WYVIS in 1999 under the name 'BEN WYVIS; The Final Resurrection', the proprietor recently discovered one more cask of BEN WYVIS whisky in their warehouses (the

'rediscovered cask'). As its owner had defaulted on their storage fees, the cask was repossessed and bottled by the proprietor. Bottles of BEN WYVIS from both releases are available at very high prices. Ms McNeish states that such bottles have been available since 1999 up to the date of her witness statement (31 October 2022).

- Exhibits CM1 – CM5 consist of, what Ms Mcneish describes as, 'current' listings of BEN WYVIS whisky for sale on various websites (I take this to mean that they are listings which emanate from the date of Ms McNeish's witness statement, being 31 October 2022). The exhibits show, specifically, the following:
    - **CM1** is a listing on 'The Whisky Exchange' website for a bottle of BEN WYVIS Scotch whisky (1965 – 37 years old). This is said to be from the rediscovered cask. It is priced at £5500.
    - **CM2** is a listing on 'Hedonism Wines' website for a bottle of BEN WYVIS Scotch whisky (1965 – 37 years old). This is said to be from the rediscovered cask. It is priced at £5500.
    - **CM3** is a listing on 'Hedonism Wines' website for a bottle of BEN WYVIS 'The Final Resurrection' Scotch whisky (1972 – 27 years old). It is priced at £2310.
    - **CM4** is a listing on 'The Whisky Shop' website for a bottle of BEN WYVIS 'The Final Resurrection' Scotch whisky (1972 – 27 years old). It is priced at £1750.
    - **CM5** is a listing on 'Loch Fyne Whiskies' website for a bottle of BEN WYVIS 'The Final Resurrection' (1972 – 27 years old). It is priced at £1750.
- Exhibit **CM6** is a photograph of an original BEN WYVIS spirit still (I understand a 'still' to be distillation apparatus used for producing whisky) which remains in the proprietor's possession.
- The proprietor has long had in place plans to utilise this still for more bottlings of BEN WYVIS whisky. To this end, Ms McNeish states that labels and bottles were designed in July 2019. Exhibit **CM7** is an image of said bottle and label designs, in preparation for the next bottling.

- Ms McNeish explains that spirit must be matured for a minimum of three years before it can be called whisky and that a premium brand such as BEN WYVIS will be matured for much longer. It is said that it is the maturation that makes the product and allows the proprietor to maintain the reputation of is BEN WYVIS brand.

That completes my summary of the proprietor's relevant evidence.

14) Further, and while I do not intend to set them all out here, it is worth highlighting that the applicant raised a number of criticisms about the sufficiency of the proprietor's evidence of use. For example, the applicant states that:

> "11. There is no evidence of actual sales, marketing activity on the Proprietor's part or communication to the public of the mark by the Proprietor as there were simply no efforts made to create or maintain a market share in the whisky sector since at least 1999 under the 'BEN WYVIS' brand."[4]

I note that the proprietor elected not to file any evidence in reply to the applicant's submissions, despite being provided with the opportunity to do so.

Assessment and conclusions

15) The evidence pertaining to the period claimed under section 46(1)(a) per se is extremely thin (that period being 12 June 1969 to 11 June 1974). Ms McNeish merely states that the BEN WYVIS distillery was created in 1965 and produced unpeated malt whisky. No further evidence is provided to explain how may bottles, if any, were sold between 1969 and 1974 and neither is there anything else at all showing any use during those five years. That said, Ms McNeish goes on to explain that casks of BEN WYVIS 'The Final Resurrection' whisky were bottled in 1999. The bottles shown in exhibits CM3 – CM5 appear to support this statement, because those bottles are all described as being '27 year old' whisky, by reference to the year 1972, which I

[4] Submissions dated 3 January 2023

understand to mean that they are whiskies which had been matured in the cask from 1972 for 27 years and must, therefore, have been bottled in 1999. Further, although she does not state the date on which the 'rediscovered cask' was found, it appears to me that that cask must have been rediscovered around 2002 because Ms McNeish states that the bottles shown in exhibits CM1 and CM2 were taken from that 'rediscovered' cask and the exhibits showing those bottles indicate that they were both '37 year old' whiskies, dating from 1965. Therefore, they must have been matured in the cask from 1965 for 37 years up until 2002 when the cask was then rediscovered, bottled and presumably sold.

16) Bearing in mind the evidence showing that bottlings appear to have been made and, presumably sold, by the proprietor in 1999/2002 under both the BEN WYVIS and BEN WYVIS 'The Final Resurrection' marks, and reminding myself that use of the mark need not always be quantitatively significant for it to be deemed genuine and that even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services, I am inclined to find that such use was genuine use in the context of the whisky market and is sufficient to save the mark from revocation under section 46(1)(a) by virtue of the wording of section 46(3). This is because such use (in 1999/2002) "commenced or resumed after the expiry of the five-year period [claimed under section 46(1)(a)] and before the application for revocation is made". For the avoidance of doubt, it is implicit in this finding that I do not consider that the addition of the words 'The Final Resurrection' alters the distinctive character of the BEN WYVIS mark, as registered. The mark therefore survives revocation under section 46(1)(a) of the Act.

17) I now turn to consider the claims under section 46(1)(b). I remind myself that there are three consecutive five-year periods in which the applicant claims that the mark has not been put to genuine use. Those three periods span fifteen years from January 2007 to January 2022. Again, I bear in mind that there is no requirement for the use to be quantitively significant. However, there is absolutely nothing before me to show that the proprietor made any efforts in any of the periods claimed under section 46(1)(b) to create or maintain a share in the whisky market in the UK. There is no

evidence of any sales (such as invoices or turnover figures or the like), no evidence of any advertising campaigns or marketing efforts and no other kind of evidence at all to show any external use during any of those periods (the photograph of the label and bottle from July 2019 (CM7) and the whisky still (CM6) is not external use of the mark). The bottles shown for sale in exhibits CM1-CM5 also do not show, or suggest, that there was genuine use within any of the relevant five-year periods under section 46(1)(b) because they are described as 'current' listings as at the date of Ms McNeish's witness statement, being October 2022. In any event, there is nothing before me to show when, how and from whom the third-party operators of those websites obtained those bottles of whisky which, on the face of it, all appear to have been bottled many years ago in 1999 and 2002. I therefore cannot tell if such sales were with the proprietor's consent or whether, as Mr Lomas suggested, they are resales, by third parties, of bottles which were initially put on the market by the proprietor many years ago in 1999/2002. There is also nothing in the evidence before me that sheds light backwards in such a way as to be of any assistance to the proprietor. I find that there has been no genuine use of the mark in any of the periods claimed under section 46(1)(b) of the Act.

18) For completeness, I add that section 46(3) also cannot assist the proprietor in relation to any of the periods claimed under section 46(1)(b) because none of the use shown in CM1 – CM5 is use that "commenced or resumed after the expiry of [any of those five-year periods] and before the application for revocation [was] made" (my emphasis). The single internal photograph of a bottle and label design from July 2019 in exhibit CM7 and the image of the whisky still in exhibits CM6 are also, clearly, insufficient, without more, to assist the proprietor under section 46(3) of the Act.

19) In reaching the above conclusions, I have not overlooked Ms McNeish's statement to the effect that whisky needs to be matured for at least three years before being bottled and sold and that a BEN WYVIS will be matured for much longer. I accept that some whiskies are matured for many years before they are bottled and sold. However, that does not explain why there appears to have been no outward facing use at all from around 2002 up to the date on which the revocation was filed. That is a period of at least 20 years. There is nothing before me to show that the proprietor took any steps at all over that 20-year period to at least advertise the mark or promote the BEN

WYVIS brand externally to potential customers which would have been possible regardless of the claimed maturation requirements for its whisky.

20) Finally, as regards the proprietor's claim to have proper reasons for non-use (to the extent that it could not show genuine use in any of the relevant periods), it has filed no evidence in support of that claim. The trade mark registration will, therefore, be revoked under section 46(1)(b) of the Act.

OUTCOME

21) The application for revocation on the grounds of non-use succeeds under section 46(1)(b) of the Act. The trade mark registration is revoked with effect from 20 January 2012[5].

COSTS

22) As the applicant has been successful, it is entitled to a contribution towards its costs. The relevant scale for the purposes of these proceedings can be found in Tribunal Practice Notice 2/2016. Using that scale as a guide, I award the applicant costs on the following basis:

Official fee (Form TM26(N))	£200
Preparing a statement and considering the proprietor's statement	£300
Considering the proprietor's evidence and filing written submissions in response	£300
Preparing for, and attending, the hearing	£500

[5] This being the earliest date sought under section 46(1)(b) of the Act.

Total: **£1300**

23) I order Whyte and Mackay Limited to pay Drinksology Limited the sum of **£1300**. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 21st day of November 2024

Beverley Hedley
For the Registrar,
the Comptroller-General