

O/1170/25

TRADE MARKS ACT 1994

IN THE MATTER OF
TRADE MARK APPLICATION NUMBER 4059970
BY MUCKLE BRIG LTD
TO REGISTER THE TRADE MARK:



IN CLASSES 21, 33, 41 AND 43

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 449124
BY GLEANN MOR SPIRITS COMPANY LIMITED

Background and pleadings

1. On 5 June 2024, Muckle Brig Ltd (“the applicant”) applied to register the trade mark shown on the cover page of this decision (“the contested mark”). The application was accepted and published in the Trade Marks Journal on 28 June 2024 and registration is sought for the following goods and services:

Class 21: Glass bowls; Glass containers; Glass cups; Glass decanters; Glass dishes; Glass flasks; Glass jars; Glasses, drinking vessels and barware; Glassware for household purposes; Beverage glassware; Bottles.

Class 33: Alcoholic beverages (except beers); Scotch Whisky complying with the specifications of the GI Scotch Whisky; Gin; alcoholic cocktails; alcoholic punches; distilled spirits; distilled beverages; low alcohol drinks; alcoholic extracts; alcoholic essences; liqueurs; brandy; rum; sherry; vermouth; vodka; in respect of all the aforesaid goods in so far as whisky and whisky based beverages are concerned, only Scotch whisky and Scotch whisky based beverages produced in Scotland complying with the specifications of the GI Scotch Whisky.

Class 41: Education, training and entertainment services in the field of beverages, including alcoholic beverages; education, training and entertainment services; organising and conducting tasting events for beverages (including alcoholic beverages); arranging and conducting events, conferences, conventions and exhibitions relating to beverages, including alcoholic beverages; arranging and conducting events, conferences, conventions and exhibitions; providing visitor attractions for cultural, education and entertainment purposes; provision of cultural activities; organising and conducting guided tours; organising and conducting of tours for training and education purposes; organising and conducting of tours for entertainment and cultural purposes; arranging of courses of instruction for tourists; publication of educational and

training guides; publication of books, including electronic books, texts and newsletters; publication of tasting notes relating to alcoholic beverages; advice, information and consultancy relating to beverages; advice, information and consultancy services in relation to all of the aforesaid services.

Class 43: Services for providing food and drink; catering services, café, restaurant and bar services; public house services; provision of exhibition and event facilities; cocktail lounge services; provision of facilities for the consumption of alcohol and non-alcoholic beverages; information, advisory and consultancy services relating to the above.

2. On 14 August 2024, Gleann Mor Spirits Company Limited, (“the Opponent”) opposed the application in full under Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”).
3. The Opponent relies upon the following UK trade mark:



UK Registration no. 3483112

Filing date: 21 April 2020

Date of registration: 14 August 2020

Relying upon the following goods and services:

Class 21: Cocktail sticks; cocktail shakers; cocktail stirrers; cocktail glasses; cocktail picks; shot glasses; tumblers; pitchers; highball glasses; cocktail

strainers; glasses; bottles made of glass; parts and fittings relating to the aforesaid.

Class 33: Alcoholic beverages; spirits; liqueurs; Scotch whisky; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based all complying with the specifications of the PGI Scotch Whisky.

Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; cultural, educational and entertainment events for the tasting, storage and production of beer, wine, spirits, and other beverages; Arranging of exhibitions for cultural purposes; Conducting of exhibitions for amusement purposes; Exhibition of video films; Organising of educational exhibitions; Organising of exhibitions for entertainment purposes; Arranging of displays for cultural purposes; Arranging of displays for educational purposes; Organisation of shows; Wine tastings [entertainment services]; Beverage tastings [educational services]; Arranging and conducting of symposia; organisation, planning, arranging and conducting events, colloquiums, forums, conferences, conventions, and exhibitions for entertainment or cultural purposes; publication services; information, consultancy and advisory services related to the aforesaid services.

4. Given the filing dates, the opponent's mark is an earlier mark, in accordance with section 6 of the Act. However, as it had not been registered for five years or more at the filing date of the application, it is not subject to the proof of use requirements specified within section 6A of the Act. As a consequence, the opponent may rely upon all of the goods and services for which the earlier mark is registered without having to establish genuine use.
5. The Opponent submits in its notice of opposition that the contested mark and the earlier mark are visually and aurally highly similar and that the goods and services are identical to the goods and services for which the earlier mark is registered.

And the degree of similarity between the marks is such that there exists a likelihood of confusion on the part of the public.¹

6. The Applicant filed a counterstatement denying the grounds of the opposition.²
7. The applicant is represented by MBM Commercial LLP and the opponent is represented by BTO Solicitors LLP. The opponent filed evidence and written submissions and the applicant filed written submissions during the evidence rounds. The opponent did not file evidence in reply. Neither party requested a hearing, but the opponent filed written submissions in lieu. This decision is taken following careful consideration of the papers.
8. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

Evidence and submissions

9. The opponent filed a witness statement of Derek Joseph Mair, signed and dated 7 January 2025. Derek Joseph Mair is the director of the opponent. The witness statement is accompanied by 5 exhibits, DM1 – DM5. The opponent also filed written submissions on 8 January 2025.
10. The applicant filed written submissions dated 10 March 2025.
11. The opponent filed written submission in lieu of a hearing dated 28 April 2025.

¹ Notice of Opposition and Statement of Grounds filed 20 August 2024, paragraph 22.

² TM8 and counterstatement filed 1 November 2024, paragraph 1.

Preliminary matters

12. Having considered the parties evidence and submissions I note the following issues which I will address here.
13. Firstly, the evidence provided by the opponent contains correspondence between the parties or their representatives in relation to the trade marks subject to these proceedings. I consider this correspondence to be without prejudice information. The without prejudice principle is that parties should be at liberty to pursue negotiations and settlement without running a risk that documents relating to such discussions will be put forward in relation to the strengths or weaknesses of their substantive cases. Therefore, I place no weight on these documents which are found at Exhibits DM4-DM5. Neither will I consider the comments made by the opponent that the applicant agreed to change the name of its mark before changing its mind and then proceeding to register the disputed mark. I note that the opponent argues that this is important not for bad faith under section 3(6) grounds which it accepts has not been pleaded but for honest and concurrent use,³ however for reasons discussed below I do not agree. In my view, this evidence has no material bearing on the pleaded section 5(2)(b) ground.
14. Equally, I note that the applicant has raised within its submissions two unsuccessful applications made by the opponent for word only marks containing the place name Leith and a spirit product, i.e. "Leith Gin" (UK00003193028) and "Leith Rum" (UK00003333719). The applicant contends that this shows that the opponent is trying to monopolise any and all use of the words 'Leith Whisky'.⁴ However, whether or not these previous applications can be considered a pattern of behaviour that shows any bad faith is irrelevant because no bad faith ground under section 3(6) has been pleaded. Further, I am not bound by the decisions of trade mark examiners on previous applications, instead I must consider the marks before me alongside the evidence and submissions presented to determine whether there is a likelihood of confusion between those marks.

³ Opponent's submissions, dated 28 April 2025, paragraphs 14 and 15

⁴ Applicant's submission, paragraph 6

15. Turning next to references made within the parties' submissions of how each of the respective parties use their marks in practice. As referenced above the earlier mark has not been registered for five years or more at the date of application and so it is not subject to proof of use and the opponent can rely on notional use of all of the goods and services within its specification. Equally, I note that there is a reference to the applicant's mark not being used on the market for the goods and services applied for. This does not necessarily cause an issue for the applicant as once a party applies to register a mark, if it proceeds to registration, they then have five years to use the mark. There is no requirement to show that they are already using it at the time of application. Therefore, I will conduct a comparison of the respective marks' specification based on notional rather than actual use.

16. Finally, in relation to the opponent submissions on honest concurrent use. It is important to highlight that this is typically a defence/argument against there being a likelihood of confusion relied upon by applicants. Honest concurrent use is based upon the fact that both the earlier mark and the applied for mark have been used on the market for a significant time prior to the application and that due to simultaneous use of both marks, consumers will not confuse the marks as they are familiar with differentiating between them. I note that honest concurrent use is raised by the opponent within its final submissions,⁵ where it relies on paragraphs 28 to 38 of its submissions dated 8 January 2025. Notwithstanding the merits of these submissions, I note that the applicant has not pleaded a defence of honest concurrent use. Even if it had, I have no evidence that both marks were used concurrently on the market prior to the application. Absent of evidence to show the duration or extent of use of each of the marks, I am unable to properly consider any honest concurrent use arguments on which the applicant could rely. Moreover, given the length of time that the opponent claims to have been trading, and the opponent's assertion that the applicant is yet to use its applied for mark, this defence would appear to merit little success by the applicant if it had been pursued.

⁵ Paragraph 15

DECISION

Legislation

Sections 5(2)(b) and 5A of the Act.

17. The opposition is based upon Sections 5(2)(b) of the Act, which read 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”.

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

Case law

18. 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 great degree of similarity between the marks, and vice versa; Page 8 of 20

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

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

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

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

Comparison of goods and services

19. The goods and services for comparison are as follows:

Applicant's goods and services	Opponent's goods and services
<p>Class 21: Glass bowls; Glass containers; Glass cups; Glass decanters; Glass dishes; Glass flasks; Glass jars; Glasses, drinking vessels and barware; Glassware for household purposes; Beverage glassware; Bottles.</p>	<p>Class 21: Cocktail sticks; cocktail shakers; cocktail stirrers; cocktail glasses; cocktail picks; shot glasses; tumblers; pitchers; highball glasses; cocktail strainers; glasses; bottles made of glass; parts and fittings relating to the aforesaid.</p>
<p>Class 33: Alcoholic beverages (except beers); Scotch Whisky complying with the specifications of the GI Scotch Whisky; Gin; alcoholic cocktails; alcoholic punches; distilled spirits; distilled beverages; low alcohol drinks; alcoholic extracts; alcoholic essences; liqueurs; brandy; rum; sherry; vermouth; vodka; in respect of all the aforesaid goods in so far as whisky and whisky based beverages are concerned, only Scotch whisky and Scotch whisky based beverages produced in Scotland complying with the specifications of the GI Scotch Whisky.</p>	<p>Class 33: Alcoholic beverages; spirits; liqueurs; Scotch whisky; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based all complying with the specifications of the PGI Scotch Whisky.</p>

<p>Class 41: Education, training and entertainment services in the field of beverages, including alcoholic beverages; education, training and entertainment services; organising and conducting tasting events for beverages (including alcoholic beverages); arranging and conducting events, conferences, conventions and exhibitions relating to beverages, including alcoholic beverages; arranging and conducting events, conferences, conventions and exhibitions; providing visitor attractions for cultural, education and entertainment purposes; provision of cultural activities; organising and conducting guided tours; organising and conducting of tours for training and education purposes; organising and conducting of tours for entertainment and cultural purposes; arranging of courses of instruction for tourists; publication of educational and training guides; publication of books, including electronic books, texts and newsletters; publication of tasting notes relating to alcoholic beverages; advice, information and consultancy relating to beverages; advice, information and consultancy services in relation to all of the aforesaid services.</p>	<p>Class 41: Education; Providing of training; Entertainment; Sporting and cultural activities; cultural, educational and entertainment events for the tasting, storage and production of beer, wine, spirits, and other beverages; Arranging of exhibitions for cultural purposes; Conducting of exhibitions for amusement purposes; Exhibition of video films; Organising of educational exhibitions; Organising of exhibitions for entertainment purposes; Arranging of displays for cultural purposes; Arranging of displays for educational purposes; Organisation of shows; Wine tastings [entertainment services]; Beverage tastings [educational services]; Arranging and conducting of symposia; organisation, planning, arranging and conducting events, colloquiums, forums, conferences, conventions, and exhibitions for entertainment or cultural purposes; publication services; information, consultancy and advisory services related to the aforesaid services.</p>
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<p>Class 43:</p> <p>Services for providing food and drink; catering services, café, restaurant and bar services; public house services; provision of exhibition and event facilities; cocktail lounge services; provision of facilities for the consumption of alcohol and non-alcoholic beverages; information, advisory and consultancy services relating to the above.</p>	
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20. In *Gérard Meric v OHIM*, Case T-133/05, the General Court (“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”.

21. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.

22. Guidance on this issue has 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.

23. 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:

“82. ...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”.

24. For the purposes of considering the issue of similarity of the goods and services, it is permissible to consider groups of terms collectively where appropriate: *Separode Trade Mark*, BL O-399-10.

25. In *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36, Lord Kitchin set out the proper approach to considering terms in specifications:

“365. [...] The correct approach, as a matter of principle, in considering a specification of services which is defined by terms which are not clear or precise, is to confine the terms used to the substance or core of their possible meanings: see, for example, *Reed Executive plc v Reed Business Information Ltd* [2004] EWCA Civ 159; [2004] RPC 40, at para 43. So too, if a specification of goods is defined by terms which are ambiguous, then it should be confined to those goods which are clearly covered. These principles are consistent with first, the requirement that the specifications of goods and services must be clear and precise so that others know what they can and cannot do; and secondly, general fairness because any ambiguity is the responsibility of the owner of the mark. If despite this, the words used are still unclear so that they cannot be interpreted, then it is permissible to disregard them. But, in my opinion, that will rarely be the case.”

26. In *YouView TV Ltd v Total Ltd* [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question.”

Class 21

Glass cups; Glasses, drinking vessels and barware; Beverage glassware;

27. All of the above are (or in the case of barware include) types of glasses that would be drunk out of and as such would all be identical on the principle outlined in *Meric* to the opponent's earlier term "*glasses*". Furthermore, in relation to "barware" I understand this term to not only include glasses but as a term used to describe a collection of tools, utensils and glassware used for preparing, serving and enjoying alcoholic beverages. As such it will also encompass the opponent's following terms, "*Cocktail sticks; cocktail shakers; cocktail stirrers; cocktail glasses; cocktail picks; shot glasses; tumblers; pitchers; highball glasses; cocktail strainers*". Consequently, I find these goods to be *identical under the Meric principles*.

Glassware for household purposes

28. I will address this separately as in my view, glassware for household purposes could include both glassware for drinking from as well as other types of glassware such as glass kitchenware or glass bottles. As such I consider this term to encompass the opponent's goods such as "*glasses; pitchers; bottles made of glass*". As such I consider the competing goods to be *Meric identical*.

Bottles

29. The above term would include the opponent's term "*bottles made of glass*" therefore, it follows that these goods are *identical under Meric*.

Glass decanters

30. In my view, the applied for goods are most similar to the opponent's term "*pitchers*", this is because they overlap in nature, method of use and purpose as they are both vessels designed to hold and pour liquids. However, decanters typically hold wines or spirits whilst pitchers commonly hold an array of different liquids. The trade channels may overlap as they are both types of kitchenware or dinnerware and users may also overlap. The goods could be in competition to the extent that a

wine could be held in either pitchers or decanters. However, the goods are not complementary. Overall, the goods are highly similar.

Glass bowls; Glass containers; Glass dishes; Glass flasks; Glass jars

31. The above are various types of kitchenware or dinnerware made of glass that cannot typically be drunk from, but that instead hold or store food or beverages. I consider there to be a degree of similarity between the above goods and the opponent's "glasses" and "pitchers". Whilst the competing goods are all made from glass and have a broad overlap in method of use and purpose to the extent that they are all glass items of kitchenware or dinnerware that are used for holding food or beverages, they have different precise methods of use and purposes. The goods are likely to be provided by the same undertaking that offers kitchenware or dinnerware, furthermore, the goods are likely to be found within the same area of a homeware store. As a result, the trade channels overlap as will users of the goods. The goods are not competitive as they cannot be substituted for one another given the specific purposes. Neither are they complementary as although the goods are often used in conjunction with one another, they are not important or indispensable to one another. Overall, I consider these goods to be similar to at least a medium degree.

Class 33

Alcoholic beverages (except beers); Scotch Whisky complying with the specifications of the GI Scotch Whisky; Gin; alcoholic cocktails; alcoholic punches; distilled spirits; distilled beverages; low alcohol drinks; liqueurs; brandy; rum; sherry; vermouth; vodka; in respect of all the aforesaid goods in so far as whisky and whisky based beverages are concerned, only Scotch whisky and Scotch whisky based beverages produced in Scotland complying with the specifications of the GI Scotch Whisky.

32. The above terms are all alcoholic beverages that are either identical or would be included within the opponent's class 33 goods "Alcoholic beverages; spirits; liqueurs; Scotch whisky; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based all complying with the

specifications of the PGI Scotch Whisky". Therefore, the respective goods are either identical or Merically identical.

Alcoholic extracts; alcoholic essences

33. Whilst the above goods and the opponent's "alcoholic beverages" all contain alcohol, they differ in their specific nature, method of use and intended purpose as the opponent's beverages are drinks which are either consumed as they are or mixed with other beverages and consumed. By contrast, the applicant's goods are not beverages themselves, but concentrated alcoholic based flavourings or extracts. Trade channels differ to the extent that alcoholic beverages are found in supermarkets, bars and liquor stores, whilst alcoholic extracts and essences are more likely to be found in speciality stores, although I appreciate that they may be sold together in cocktail making kits or home brewing kits where alcoholic flavours may be added to vodkas or gins. Equally bars and cocktail lounges may use both alcoholic beverages and alcoholic essence/extracts. In such circumstances users may overlap. The goods are not competitive as they cannot replace the function of the other, neither are the goods complementary as they are not essential to one another and moreover whilst they may be found together in cocktail making sets or home brewing sets, typically consumers are unlikely to expect the same undertaking to be responsible for providing both of the respective goods. Overall, I find that the goods are similar to only a low degree.

Class 41

Education, training and entertainment services in the field of beverages, including alcoholic beverages; education, training and entertainment services; organising and conducting tasting events for beverages (including alcoholic beverages); arranging and conducting events, conferences, conventions and exhibitions relating to beverages, including alcoholic beverages; arranging and conducting events, conferences, conventions and exhibitions; providing visitor attractions for cultural, education and entertainment purposes; provision of cultural activities

34. The above are all services for education, training and entertainment predominantly in the field of alcoholic beverages and the arrangement and organisation of such. In my view, these services are all clearly identical to the opponent's services "*Education; Providing of training; Entertainment; [...] cultural activities; cultural, educational and entertainment events for the tasting, storage and production of beer, wine, spirits, and other beverages; Arranging of exhibitions for cultural purposes; Conducting of exhibitions for amusement purposes; Organising of educational exhibitions; Organising of exhibitions for entertainment purposes; Organisation of shows; Wine tastings [entertainment services]; Beverage tastings [educational services]; Arranging and conducting of symposia; organisation, planning, arranging and conducting events, colloquiums, forums, conferences, conventions, and exhibitions for entertainment or cultural purposes*" as they are merely different ways of expressing the same services or they are identical on the principle outlined in *Meric*.

Organising and conducting guided tours; organising and conducting of tours for training and education purposes; organising and conducting of tours for entertainment and cultural purposes; arranging of courses of instruction for tourists

35. These are all services for guided tours or tourist events and are encompassed within the opponent's broad terms "*Entertainment; Organising of educational exhibitions; organisation, planning, arranging and conducting events, colloquiums, forums, conferences, conventions, and exhibitions for entertainment or cultural purposes*", and therefore *Meric identical*.

Publication of educational and training guides; publication of books, including electronic books, texts and newsletters; publication of tasting notes relating to alcoholic beverages

36. These are all publication services and as such they all fall under the opponent's wide term "*Publication services*". As such, it follows that the competing services are *Meric identical*.

Advice, information and consultancy services in relation to all of the aforesaid services.

37. These are *identical* to the opponent's term "*information, consultancy and advisory services related to the aforesaid services*" which describes the same services expressed in a slightly alternative way.

Advice, information and consultancy relating to beverages

38. As for the above term, this will also be *identical under Meric* to the opponent's term "*information, consultancy and advisory services related to the aforesaid services*" as the opponent's aforesaid services cover alcoholic beverages and related services such as wine tours, therefore, one is encompassed by the other.

Class 43

Services for providing [...] drink; catering services, [...] bar services; Public house services; cocktail lounge services; provision of facilities for the consumption of alcohol and non-alcoholic beverages; information, advisory and consultancy services relating to the above.

39. I observe that the opponent identifies that the above services in class 43 are similar to its class 41 services, in particular: "*cultural, educational and entertainment events for the tasting, storage and production of beer, wine, spirits, and other beverages; Wine tastings [entertainment services]; Beverage tastings [educational services]*".⁶

40. I find that the nature, method of use and core purposes of these services differ as the applicant's services are primarily concerned predominantly with the provision of drink delivered to consumers in a hospitality setting, whilst the opponent's services are event-based services focused on the tasting of, and learning about, alcoholic beverages. Trade channels may overlap as for example bar services may offer tasting events and users may also coincide. However, I do not consider there to be complementarity; although tastings can be held at bars or other hospitality settings, these events can also be held independently of each other and, as such, I do not consider these services to be important or essential to one another. Neither

⁶ Opponent's written submissions dated 8 January 2025, paragraph 16

do I consider the services to be in competition as consumers would not typically choose between attending a tasting event or having a drink in a hospitality setting. Overall, I consider the services to be similar to a low degree.

Provision of exhibition and event facilities; information, advisory and consultancy services relating to the above.

41. The opponent claims that the above term is similar to its class 41 services “*Arranging of exhibitions for cultural purposes; conducting of exhibitions for amusement purposes; organising of educational exhibitions; organising of exhibitions for entertainment purposes; organisation, planning, arranging and conducting events, colloquiums, forums, conferences, conventions and exhibitions for entertainment of cultural purposes*”. Whilst not specifically relating to the comparison of these services, the opponent then goes on to say: “*It is further submitted that the nature of the goods and services of the Applicant on one hand and the Opponent on the other which are submitted to be (i) identical and (ii) similar would each have the same end users; would be used and consumed in the same way; and are competing goods and services (Canon Kabushiki v Metro-Goldwyn Mayer Inc C-39/97, paras 22 and 23).*”

42. I understand the above term to refer to the provision of spaces for exhibitions and events such as in hotel conference rooms, or in arenas. I consider that the provision of exhibition and event facilities are important to the opponent’s services for the arrangement and organisation of such as without the facilities to host the events they cannot take place. However, I do not consider that consumers would reasonably expect the competing services to be offered by the same undertaking, as in reality facility providers and event organisers are normally separate businesses. As such, I do not consider there to be complementarity. The nature, method of use and purpose also differ, as the class 41 services are the events themselves that provide entertainment or information/knowledge to users, whilst the class 43 services are the provision of physical spaces or amenities for that event. There is a degree of competition to the extent that users may choose to hire a venue and organise their own event or they may choose to use the services of an event company. As such I consider there to be only a low level of similarity between the services.

Services for providing food [...]; catering services, café, restaurant [...] services; information, advisory and consultancy services relating to the above.

43. The opponent also identifies that the above applied for services in class 43 are similar to its class 41 services, in particular: “*cultural, educational and entertainment events for the tasting, storage and production of beer, wine, spirits, and other beverages; Wine tastings [entertainment services]; Beverage tastings [educational services]*”.⁷ Comparing these services, I find that their natures, methods of use and intended purposes differ as the applied for services are centred on the provision of food to consumers for their consumption to address hunger. Typically delivered through the operation of hospitality venues such as cafés and restaurants. In contrast, the opponent’s services are focused on delivering events and staging tasting experiences that are for the purpose of providing entertainment and information. Trade channels would differ as venues focused predominantly on offering food are unlikely to also provide alcohol tastings. Equally, the services are not complementary as they are not important to one another, nor are they competitive as an alcohol tasting event is not an adequate substitution for restaurant services. Although some users may overlap, this will be to such a general degree that it does not engage similarity. Consequently, overall, the competing services are dissimilar.

44. As some degree of similarity between the goods and services is necessary to engage the test for a likelihood of confusion under section 5(2)(b) grounds, my findings above mean that the opposition must fail against goods and services of the registered mark that I have found to be dissimilar, namely:⁸

Class 43: Services for providing food [...]; catering services, café, restaurant [...] services; information, advisory and consultancy services relating to the above.

⁷ Opponent’s written submissions dated 8 January 2025, paragraph 16

⁸ *eSure Insurance v Direct Line Insurance* [2008] ETMR 77 CA

The average consumer and the nature of the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then determine the manner in which the goods and services are likely to be selected by the average consumer. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

46. In relation to the average consumer and the nature of the purchasing act, I do not have any specific submissions from the applicant that identifies who the average consumer is. However, the opponent states:

“It is submitted that the average consumer for these purposes is a member of the general public who consumes whisky and who would perceive the mark as a whole, who is reasonably well informed and reasonably circumspect and observant (*Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel BV*, [1999] 2 CMLR 1343, para 26). That average consumer may purchase the goods in respect of which both marks are or are to be registered in classes 21 and 33 off the shelf by self selection, for example in an off-licence or supermarket or may be ordered at a bar (where aural similarity, which is high, is particularly important).”⁹

⁹ Opponent's written submissions, dated 8 January 2025, paragraph 4.

47. In my view, the average consumer of the goods at issue will predominately be the general public (in relation to alcohol, of drinking age), rather than specifically members of the public that drink whisky as the goods at issue involve more than just whisky, whilst for the services at issue this will be both the general public and businesses or professional users.
48. The goods will be moderately priced whilst the cost of the services is likely to vary depending on their nature but is unlikely to be particularly expensive. In relation to the alcoholic goods in class 33, these are likely to be purchased reasonably regularly, whilst the goods in class 21 and the services are likely to be purchased less frequently. Consumers will consider factors such as price and suitability for all the goods and services as well as for class 33 goods, the type of alcohol, its alcoholic content and taste, for class 21 goods, the style and type of material used, and for the services, availability and service standard. Overall consumers will pay a medium level of attention when purchasing these goods.
49. The goods will be found either at hospitality settings, physical stores, or their online equivalent, whilst the services will be offered through service providers online and advertised on posters and brochures where they will be purchased by consumers following a visual inspection of the services on offer. Therefore, visual considerations will dominate, although I do not discount that there may be an aural component where assistance is sought from sales assistants. Even where the goods are purchased verbally such as at a bar or restaurant, this will typically be after consumers have had the opportunity to inspect the goods from either a menu or on a list behind a bar, therefore whilst aural considerations are important, visual components will still dominate.

Distinctive character of the earlier trade mark

50. The distinctive character of a trade mark can be appraised only, first, by reference to the goods and services 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. In *Lloyd Schuhfabrik*, the CJEU stated that:

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

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

51. The opponent claims that its mark is recognised for whisky, it states, “*It is submitted that there is a degree of recognition of the Earlier Mark. The whisky to which the Earlier Mark is applied and the Earlier Mark are synonymous with the Opponent and the Opponent’s Leith Whisky product.*”¹⁰ However, I have limited evidence in relation to use which is found within the narrative evidence and applies solely to whisky. Here it is asserted that the earlier mark has been used since 2022¹¹ and that roughly 20 cases are sold each month, more during the holidays such as Christmas and Burns Night,¹² but I do not have any information as to how many bottles that amounts to, nor any turnover figures for such. Regardless, an average of roughly 20 cases per month does not sound like a particularly extensive amount given the potential size of the market in the UK. Moreover, use is certainly not long

¹⁰ Opponent’s written submissions, dated 8 January 2025, paragraph 21

¹¹ Witness statement of Derek Mair, paragraph 7

¹² *Ibid*, paragraph 6

standing given that it is claimed the mark has only been used since 2022. Further, whilst the narrative evidence lists various websites and establishments where the goods have been sold,¹³ the evidence does not disclose precise details as to the frequency with which goods have been sold via these channels of trade and over what period, but in any event, it will not have been before 2022. It appears that the goods are predominantly sold to establishments within the Edinburgh area, meaning use appears to be fairly geographically limited. Although it is claimed that the goods are also sold online, such as on amazon and other online sites including the opponent's own website, again no information has been provided regarding the extent of sales generated from these websites, nor the geographical spread of the goods.

52. There is reference to advertising on public display in Edinburgh, however I have no further information in relation to this. Finally, there is no third party evidence referencing the goods and no information regarding market share. Whilst it is mentioned that "*We are also the official spirits partner for two main Scottish Premier Football clubs [...]*",¹⁴ this is in the context of the company not the mark. Overall, I am not satisfied that the narrative evidence provided meets the threshold for demonstrating that through use within the UK the goods have received enough exposure that consumers would recognise the mark for those goods and hence have an enhanced level of distinctiveness.

53. Before, I consider the inherent position, I pause here to examine the applicant's submissions in relation to the earlier mark and its distinctive character. It claims that the opponent is seeking to monopolise the words "Leith Whisky" by claiming that these words are the dominant and distinctive element of the earlier mark when they are in fact the combination of a place name and a product name.¹⁵ These submissions have been reiterated through out these proceedings but may best be summarised within the applicant's counterstatement where it states:

¹³ Ibid, paragraph 5

¹⁴ Ibid, paragraph 8

¹⁵ Applicant's submissions paragraph 5

“The opponent's assertion that "Leith Whisky and the Earlier Mark are synonymous with the Opponent" seeks to artificially break up the components of the logo mark on which the opposition is based. The opponent's current claim is based solely on the Earlier Mark as they have defined, and does not extend to "Leith Whisky" as a term in plain wording. The opponent does not have exclusive rights over the term "Leith Whisky" or indeed "Leith". It is noted that the opponent has not successfully registered word mark applications filed previously for "Leith Gin" or "Leith Rum" (see UK00003193028 and UK00003333719).

The opponent's registration of the Earlier Mark does not inherently grant exclusivity to the opponent as a single entity over any or all uses of the term "Leith Whisky" in association with whisky and related goods and services. Monopolisation or attempted monopolisation of simple, commonly used wording such as a geographical name/product name combination goes against public interests.”¹⁶

54. However, the applicant has filed no evidence to suggest that the word “LEITH” is descriptive of the goods/services.
55. As discussed above, the earlier mark is a figurative mark and encompasses the words “LEITH WHISKY” at the centre of a banner, behind which is a ships’ helm device.
56. When assessing whether “LEITH” as a geographical name is descriptive, I keep in mind the guidance relating to geographical names under section 3(1)(c) as set out by the CJEU in *Windsurfing Chiemsee v Boots Attenberger* (“Chiemsee”), C108/97 and C-109/97:

“31. Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or ‘UKTMA’], the competent authority must assess whether a geographical name in respect of which an application for

¹⁶ Applicant’s counterstatement, paragraph 3

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, regards 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 [section 3(1)(c) UKTMA] 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.

34. However, it cannot be ruled out that the name may serve to designate geographical origin within the meaning of Article 3(1)(c) [section 3(1)(c) UKTMA], even for goods such as those in the main proceedings [being, in that particular case, items of sports clothing], provided that the name could be understood by the relevant class of persons [to include the shores of the lake or the surrounding area].

35. It follows from the foregoing that the application of Article 3(1)(c) [section 3(1)(c) UKTMA] does not depend on there being a real, current or serious need to leave a sign or indication free.

36. Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) [section 3(1)(c) UKTMA] applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location might

depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

57. Taking the word element first, without evidence to the contrary LEITH seems to be a relatively obscure geographical location. Indeed, I observe that Derek Mair, the co-founder and sole director for the opponent states that “*Leith is now generally regarded as a suburb of Edinburgh but was formerly a port town in its own right, sitting on the Firth of Forth*”.¹⁷ Therefore, I keep in mind that as it is currently viewed as a suburb of Edinburgh it may be less well known to tourists and other UK consumers as a town in its own right. Other than this, and information regarding the precise locations from which the parties operate, which is less relevant, I have no further evidence regarding the size of LEITH or how well known it is to consumers across the UK. There is nothing before me to suggest that LEITH, as a place, is associated with the relevant goods/services in the mind of consumers 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 LEITH, the characteristics of the place designated by the name and the category of goods/services in question.

58. As noted above, I am not convinced that LEITH will be a very well known place and I have no evidence before me to suggest otherwise. I bear in mind, of course, that Scotland is known for whisky production and that distilleries are a common feature of many places across the country. That is a factor in favour of the applicant. However, I must balance that against a place name which is relatively unknown and the fact that there is nothing in terms of the characteristic of the place itself which would lend itself to an association with production of the relevant goods/services (such as being a location of a natural freshwater source which might be used for whisky production, for example). Taking all of this into account, I do not find LEITH to be descriptive for any of the goods/services. For the avoidance of doubt, even if LEITH is known to average consumers as a place name, this is still just one factor which is relevant to my assessment. It seems to

¹⁷ Witness statement of Derek Mair, paragraph 4

me that it can only possibly be a reasonably well known place name (it is not, for example, on the same scale as Edinburgh or London), and this weighed against the other factors discussed above would still lead me to conclude that it would not be descriptive for the relevant goods/services.

59. In reaching this conclusion, I acknowledge the decision of BL O/042/18, where the hearing officer reached a different conclusion as to whether consumers would perceive LEITH as designating geographical origin in relation to spirits, namely gin. However, in that case, the applicant had filed evidence to support its contention that the word LEITH was descriptive/non-distinctive for the relevant goods. The applicant in this case has not done so. Ultimately, if the applicant wished to rely upon that line of argument in these proceedings, then the burden falls on the applicant to prove its case and, in my view, it has failed to do so. Further, the only goods in issue in that case were alcoholic beverages; in this case, the goods and services in issue are far broader.

60. Consequently, I do not find that the word “LEITH” used within the earlier trade mark is purely descriptive as it does not serve to designate geographical origin of the goods and services relied on. Indeed, in my view it is capable of denoting trade origin and is distinctive to a medium degree. However, I accept that the word ‘whisky’ is clearly descriptive for whisky and descriptive, or at least non-distinctive for some of the related services, for example whisky tasting.

61. With regards to the device element of a ship’s helm, this has no obvious connection with the goods or services. Overall, when taken as a whole, the earlier mark has a medium level of inherent distinctiveness.

Comparison of the marks

62. The respective trade marks pleaded under 5(2)(b) are shown below:

Earlier trade mark	Contested trade mark
	

Overall impression

63. The contested mark is a circular figurative mark containing a large stylised device that may be identified as an ear of barley at the centre with the words “LEITH WHISKY CLUB” curved around it. The mark appears in black and white. Despite the size of the device element, the overall impression rests predominantly in the words which typically attract more attention as elements that consumers will read. This is because consumers will more easily refer to the goods and services in question by quoting their name than by describing the figurative element of the trade mark.¹⁸

64. The earlier mark is also a figurative mark and encompasses the words “LEITH WHISKY” at the centre of a banner, behind which is a ship's helm device. The overall impression lies predominantly in the word element; however, the helm device element provides a contribution.

Visual similarity

65. The marks coincide in the words “LEITH WHISKY” but differ in the addition of the word “CLUB” found within the applied for mark which is absent from the earlier mark. The marks also differ in the device elements present in the respective marks. Overall, the competing marks are visually similar to a medium degree.

¹⁸ *Wassen International Ltd v OHIM (SELENIUM-ACE)*, Case T-312/03, paragraph 37

Aural similarity

66. The earlier mark comprises of three syllables, i.e. LEITH-WISS-KEY whereas the applied for mark comprises of four syllables, i.e. LEITH-WISS-KEY-CLUB. Therefore, the marks share three identical syllables at the beginning of the mark and differ in the additional syllable found in the applied for mark. Overall, the marks are aurally similar to at least a medium degree.

Conceptual similarity

67. For a conceptual message to be relevant it must be capable of immediate grasp by the average consumer. This is highlighted in numerous judgments of the GC and the CJEU including *Ruiz Picasso v OHIM* [2006] e.c.r.-I-643; [2006] E.T.M.R 29. The assessment must, therefore, be made from the point of view of the average consumer.

68. The earlier mark will be seen as referring to whisky that is from Leith, with the ship's helm device conveying a nautical theme.

69. As for the applied for mark, I note that the parties have contrasting submissions to how this mark will be perceived by consumers. The opponent contends:

*"[...] A natural reading of the Opposed Mark is that it is mark [sic] used by a club relating to Leith Whisky. The order of the words in the Applicant's mark suggests that it is a club which relates to the product Leith Whisky as opposed to a whisky club which is located in Leith."*¹⁹

70. Whereas the applicant suggests that the meaning of the mark is a whisky club located in Leith.²⁰

¹⁹ Opponent's written submissions, dated 1 January 2025, paragraph 5

²⁰ See the applicant's written submissions, paragraph 8

71. I keep in mind that a mark is capable of more than one meaning and indeed the applied for mark may be interpreted by consumers as having either meaning.²¹ Therefore, for the purposes of assessing whether there is a likelihood of confusion, I will consider this from the perspective of the significant proportion of average consumers that will view the contested mark as meaning a club for Leith Whisky as this represents the group of consumers for which there will be the closest level of conceptual similarity.

72. With regards to the device element, the opponent refers to this as being an ear of barley, which the applicant does not refute. The opponent further argues that this device will be viewed as descriptive of the goods as barley is one of the main ingredients of whisky and that the use of an ear of barley merely serves to re-enforce the overall impression of the mark for Leith Whisky.²² I accept that the device element will be recognised as either an ear of barley or alternatively a flutter of wheat or a leaf of rye and that irrespective of which precise grain is recognised, they are all possible core ingredients for Whisky. As such whilst the device element may not be directly descriptive of the goods, it may be perceived as being allusive of the goods and emphasising the idea of whisky, despite the stylisation of the device.

73. Therefore, taking the marks as wholes, for those consumers that view the applied for mark as meaning a club associated with Leith whisky there will be a shared concept relating to whisky from the area of Leith. However, I accept that they differ insofar as the earlier mark will be seen as referring to the whisky itself whereas the applied for mark will be understood as a club for such. Furthermore, the marks conceptually differ in the meanings arising from the different device elements, although the device within the applied for mark may be allusive of the goods. Overall, the marks are conceptually similar to a medium degree.

²¹ See *Soulcycle Inc v Matalan Ltd*, [2017] EWHC 496 (Ch) and *Interflora Inc v Marks and Spencer plc* [2013] EWHC 1291 (Ch)

²² The opponent's written submissions, dated 8 January 2025, paragraph 9

Likelihood of confusion

74. I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods or services may be offset by a greater similarity between the marks, and vice versa (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the principle that the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) the factor of imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).
75. There are two types of confusion that may occur. Direct confusion is where the average consumer mistakes one mark for the other, while indirect confusion is where the average consumer recognises that the marks are different, but for some reason assumes that the later mark also identifies the goods or services of the owner of the earlier mark, or that the two undertakings are related: see *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10, paragraph 16.
76. I have found the marks to be visually and conceptually similar to a medium degree, and aurally similar to at least a medium degree. I have found the earlier mark to possess a medium level of inherent distinctive character overall. However, the 'whisky' element found within the mark will clearly be descriptive for whisky and descriptive/non-distinctive for some of the related services. I have identified the average consumer of the goods to be members of the general public, (in relation to alcohol, of drinking age) who will pay a medium degree of attention. As for the services the average consumer will be either the general public or business/professional users who will also exercise a medium degree of attention. I have found visual considerations are likely to dominate the purchasing act, however, I do not discount aural considerations, particularly for goods purchased in a hospitality setting. Finally, I find there to be identity between some of the goods and services and at least some level of similarity ranging from high to low for the remaining goods and services.

77. As I have found, discussed above, the word “Leith”, although a place name, is not a familiar place name and it is certainly not a place particularly known (or likely to become known) for its association with whisky, or indeed any of the other goods or services found under the earlier mark. As a result, in my view, upon seeing the earlier mark consumers are likely to retain in their mind the words “LEITH WHISKY”. However, even taking into account imperfect recollection, on balance, I find that collectively there are enough differences that will prevent consumers from misremembering the marks for one another. As such, I do not find that there is a likelihood of direct confusion between the marks.

78. I will now go on to consider whether there is any indirect confusion. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis QC, (as he then was) sitting as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all.

This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand 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).”

79. These three categories are not exhaustive; rather, they were intended to be illustrative of the general approach, as has been confirmed by the Court of Appeal. I recognise that a finding of indirect confusion should not be made merely because the competing marks share a common element. In this connection, it is not sufficient that a mark merely calls to mind another mark: this is mere association not indirect confusion.²³

80. Furthermore, in *Liverpool Gin*,²⁴ Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

81. Although consumers will recognise the differences between the marks, they will also identify the shared word elements “LEITH WHISKY”. As such, the addition of the word “CLUB” will merely be perceived as a logical brand variation, sub brand or brand extension. This is because the word “CLUB” is not particularly distinctive,

²³ *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17

²⁴ *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207

rather it gives the impression of a club related to goods/services offered under the earlier mark. Equally the change in devices, and overall get up, is likely to be viewed as simply an alternative presentation being used as part of the sub-brand or brand extension. Particularly as the device in the contested mark may symbolise a key ingredient of whisky, and as such is not very distinctive for the goods and services which include whisky themselves or goods and services related to alcoholic drinks which can include whisky. Consequently, taking into account the interdependency principle, I find that there is a likelihood of indirect confusion between the competing marks, for goods and services that are similar to a medium degree or above.

CONCLUSION

82. The opposition based upon 5(2)(b) has been partially successful. Therefore, the applicant's goods in classes 21 and 33 (except for terms "*Alcoholic extracts; alcoholic essences*" in class 33), and services in class 41 will not proceed to registration.

83. However, the terms "*Alcoholic extracts; alcoholic essences*" in class 33, and the applied for services in class 43 that I have found to be either dissimilar or similar to only a low degree will proceed to registration.

COSTS

84. As the opponent has enjoyed the greater degree of success, it is therefore entitled to a contribution towards its costs based upon the scale published in Tribunal Practice Notice ("TPN") 1/2023 with a proportionate deduction to reflect some success by the applicant. Applying the guidance in the TPN, I award the following:

Official fee for opposition form	£100 ²⁵
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Filing a notice of opposition and considering	
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²⁵ This fee is not subject to any deductions.

the applicant's counterstatement	£200
Preparing and filing evidence and submissions filed in the evidence rounds	£200 ²⁶
Filing final submissions	£300
Total:	£800

85. I therefore order Muckle Brig Ltd to pay Gleann Mor Spirits Company Limited the sum of **£800**. This 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 16th day of December 2025

Sarah Wallace
For the Registrar

²⁶ I have awarded this amount as the evidence provided was light and the exhibits filed were not materially relevant to the outcome of this decision.