

**O/1200/25**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK3810603**

**BY JAMES MARTIN**

**TO REGISTER THE TRADE MARKS:**

**JAMES MARTIN**

**JAMES MARTIN'S**

**(SERIES OF 2)**

**IN CLASSES 32, 33 & 41**

**AND**

**IN THE MATTER OF OPPOSITION THERETO**

**UNDER NO. 437499**

**BY MACDONALD & MUIR LIMITED**

## **Background and pleadings**

1. James Martin (“the applicant”) applied to register the series of trade marks shown on the cover page of this decision on 18 July 2022. The marks were published on 12 August 2022.

2. The goods and services applied for were as follows:

Class 32: Soft drinks; non-alcoholic distilled spirits; non-alcoholic gin; non-alcoholic cocktails; alcohol free wine; beer; ale, craft ales; lager; craft lager; mineral and aerated waters; non-alcoholic drinks; ginger ale; ginger beer; fruit drinks and fruit juices; syrups and preparations for making beverages; shandy; low alcohol beer; alcohol-free beers.

Class 33: Alcoholic beverages; spirits; gin; wine; sparkling wine; low alcoholic wine; spritzers; liqueurs; rum; botanical spirits.

Class 41: Entertainment services; musical entertainment; organisation of festivals; presentation of live performances; live entertainment; radio and television entertainment services; practical demonstrations for educational and/or entertainment purposes; educational and entertainment services provided by on-line access; production of radio and television programmes; film production; production of shows; production, presentation, distribution and syndication of television and radio programmes, interactive entertainment, films and sound and video recordings; club services; fan club services; wine tastings (entertainment); providing on-line electronic publications; organisation and provision of road shows, courses and demonstrations relating to cookery; education services; training services; providing of training; cultural activities; cookery schools; cookery classes; training of chefs; training services related to food and nutrition; educational academy services; arranging and conducting of colloquiums, conferences, congresses, seminars, symposiums and workshops; organisation of shows and competitions; publication of books; publication of electronic books, manuals and magazines on-line; teaching; cookery teaching; provision of on-line advisory services; arranging and conducting educational

workshops in relation to food and cookery matters; providing entertainment through computer networks; operation of interactive electronic media entertainment facilities; interactive television services; electronic games services provided via the Internet or a computer based system; consultancy, information and advisory services relating to all of the aforesaid services.

3. Macdonald & Muir Limited (“the opponent”) opposes the trade mark application. The opposition was filed on 14 November 2022. The opposition is on the basis of sections 5(1) and 5(2)(a) of the Trade Marks Act 1994 (“the Act”). The section 5(1) claim is against the following goods:

Class 33: Alcoholic beverages; spirits.

The section 5(2)(a) claim is against the following goods:

Class 32: Non-alcoholic distilled spirits; non-alcoholic gin; non-alcoholic cocktails; alcohol free wine; beer; ale; craft ales; lager; craft lager; shandy; low alcohol beer; alcohol free beers.

Class 33: Gin; wine; sparkling wine; low alcoholic wine; spritzers; liqueurs; rum; botanical spirits.

4. The following marks are relied upon for the opposition:

UK2124363 (‘the first earlier mark’)

JAMES MARTIN’S

Filing date: 20 February 1997

Registration date: 24 April 1998

UK900085373 ('the second earlier mark')<sup>1</sup>

JAMES MARTIN

Filing date: 1 April 1996

Registration date: 13 March 1998

Both marks are registered for the following goods:

Class 33: Whisky

5. The opponent claims that the marks are identical. In relation to the goods, the opponent states that they are either identical or highly similar and that this leads to a likelihood of confusion.

6. The applicant filed a counterstatement in which it accepted the identity of the marks but denied the identity of the goods and services. It also put the opponent to proof of use of their marks.

7. Both parties filed evidence. A hearing was held before me on 14 January 2025. The applicant was represented by Fiona Lindsay of Limelight Celebrity Management Limited (I note the applicant had legal representation earlier in these proceedings which was subsequently removed). The opponent was represented by Rob Jacob and Joshua Cunnington both of Stephenson Harwood LLP. I make this decision having taken full account of all the papers and the oral submissions, referring to them below as necessary.

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

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<sup>1</sup> Following the end of the transition period of the UK's withdrawal from the EU, all EU trade marks ("EUTM") registered before 1 January 2021 were recorded as comparable trade marks in the UK trade mark register (and as a consequence, have the same legal status as if they had been applied for and registered under UK law). A 'comparable trade mark (EU)' retains the same filing date, priority date (if applicable) and registration date of the EUTM from which it derives.

EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

### **Preliminary Issue**

9. At the beginning of the hearing Mr Jacob raised a preliminary matter that he had noted new evidence contained within the Skeleton Argument from Ms Lindsay. He stated (as mentioned by Ms Lindsay herself) that Ms Lindsay is not a legal representative nor a trade mark specialist and therefore, this was simply filed in error. Ms Lindsay said she was not familiar with the proceedings and had not realised she could not file the new evidence at this point. I stated at the hearing that I had noted this new evidence and that I would only refer to the evidence filed correctly through the sequential evidence rounds. For the avoidance of any doubt, the evidence provided in the skeleton by Ms Lindsay (which was comments on elements of the opponent's website and end of year accounts for 2008) would not have been of any assistance.

### **Evidence**

10. The opponent's evidence in chief comes in the form of a witness statement from Caspar MacRae, who is the President and Chief Executive Officer of the Opponent. The statement is dated 26 August 2023 and is accompanied by 7 exhibits. The main purpose of this evidence is to show proof of use of the opponent's registrations.

11. The applicant's evidence is a witness statement from Fiona Duncan Lindsay, who is the owner and director of Limelight Celebrity Management Limited. This is dated 18 January 2024 and is accompanied by 3 exhibits. The main purpose of this evidence is to rebut the Opponent's claim to have shown use of their registrations.

12. The opponent filed evidence in reply dated 15 April 2024 in the form of a witness statement from Joshua Cunnington, the opponent's legal representative. This evidence is intended to rebut the evidence filed by Ms Lindsay.

## **Decision**

### **Section 5(1) and 5(2)(a)**

13. Section 5(1) of the Act is as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

14. Section 5(2)(a) of the Act is as follows:

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services 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”.

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

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

16. The opponent's marks qualify as earlier marks, in accordance with Section 6 of the Act. The earlier mark is subject to proof of use requirements as it has been registered for five years or more before the application date of the contested mark, as per section 6A of the Act. The applicant has requested that the opponent provides proof of use for the mark.

## Proof of use

17. I will begin by assessing whether there has been genuine use of the earlier registrations.

18. Section 6A:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a),  
(aa) or (ba) in relation to which the conditions set out in section 5(1),  
(2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed  
before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)-(5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

19. As the second earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

20. Section 100 of the Act states that:

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

21. The relevant period for assessing for genuine use is the five year period ending with the filing date of the application i.e. 19 July 2017 to 18 July 2022.

22. 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 Bunderversammlung 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].”

## **Evidence**

23. In his witness statement, Mr MacRae details the background of the ownership of the James Martin’s brand since its establishment in 1878. He goes on to say that

during the relevant period, the opponent has produced in the UK and exported for sale a “blended malt whisky under the name JAMES MARTIN’S with the following appearance:<sup>2</sup>



24. He goes on to explain that due to its ageing being ‘significantly longer’ (he later mentions that throughout the relevant period, the 32 year old variety is the one they produce) and not being mass produced that its average retail price is €399.

25. In paragraphs 12.3 and 12.4 Mr MacRae states that the opponent designs the labels that are affixed to the bottles and exterior packaging. Further, he confirms that during the relevant period, the labels bearing the JAMES MARTIN’S mark were affixed by GXO UK on the opponent’s behalf and exhibit CM1 contains invoices for the labelling and packaging. In paragraph 12.8 he provides a table showing the number of bottles labelled as follows:

Packaging/ Labelling date (week commencing)	GXO invoice number	Lot (MML reference)	Cases (of 6)	Bottles
7 November 2020	8031137373	2404094	458	2,748
30 January 2021	8031143589	2404094	498	3,588
14 August 2021	8031158257	2428339	500	3,000

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<sup>2</sup> Paragraph 9

Packaging/ Labelling date (week commencing)	GXO invoice number	Lot (MML reference)	Cases (of 6)	Bottles
25 September 2021	8031161426	2428339/ 2414000	258	1,548
19 February 2022	8031173061	2428994	183	1,098
<b>TOTAL</b>			<b>1,897</b>	<b>11,382</b>

26. Also provided are numerous photos showing the labels and boxing being done by hand (these are also found in Exhibits CM2 and CM3):



27. Mr MacRae goes on to discuss the exports of their goods. He states that whilst the production and packaging occurs in the UK, sales have been led by exports to the EU, particularly Portugal.<sup>3</sup>

28. He states that there are customs declarations included within Exhibit CM5 and these are summarised in the following table:

Lot	Cases in lot	Date of Labelling & Packaging	Customs Declaration No.	Date of Export	Relevant Invoice(s)	Cases Exported	Bottles exported
2404094	498	January 2021	1157847	1 February 2021	9190002220	494	2,964
2428339	500	August 2021	3189589	20 August 2021	9190002936	504	3,024
2428339/ 2414000	258	August/ September 2021	3580848	29 September 2021	9190002936 9190003066	258	1,548
2428994	183	February 2022	5154775	16 February 2022	9190003529	183	1,098
<b>TOTAL</b>						<b>1,439</b>	<b>8,634</b>

<sup>3</sup> Paragraph 13

29. He claims that a total of 1897 cases or 11,382 bottles of the whisky were exported in the relevant period.

30. Mr MacRae states in paragraph 20 of his witness statement that in 2020, 2736 bottles were sold in Portugal generating an estimated gross retail revenue of €1,091,664. He gives details of further EU sales figures which go past IP Completion Day.

31. Mr MacRae then goes on to discuss the advertising and promotion. To that end, he provides a document in Exhibit CM7 which appears to be an internal document detailing some advertising and promotional activities that include sending promotional boxes to 9 journalists and presenting the new product to various retailers and wholesalers in Portugal. It also includes images of the stand used to present the goods in retail settings. Within paragraph 23 of the witness statement, he lists the following as example retailers in Portugal which sold the goods: Garrafeira, Fernando's Wine House, Cave Lusa and El Corte Ingles. He goes on to say that retailers in 5 locations in Porto and Lisbon have used the following display units to promote the goods during the relevant:



32. Exhibits CM8 and 9 include various adverts and articles for the goods. In his witness statement, at paragraph 27, Mr MacRae advises that in 2020 there were 16 articles referencing the goods with an estimated reach of 282,160 people (these numbers were based on metrics provided by the opponent's marketing agency).<sup>4</sup>

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<sup>4</sup> Paragraph 29 and Exhibit CM8

There are also 4 longer articles with an estimated reach of 636,935 people. Mr MacRae also stated that there was a TV appearance, with a screenshot shown in Exhibit CM8. These are dated in 2020/2021.

## **Analysis**

### **Form of the mark/how the mark is used**

33. The marks, as registered, are word marks which with “normal and fair use” can be used in any typeface and font.<sup>5</sup> The first earlier mark is used on the goods as shown above and in a relatively standard typeface. Therefore, this is acceptable use.

34. The second earlier mark is ‘JAMES MARTIN’ without the apostrophe ‘S’. These features on the bottles as a signature style towards the bottom of label. As mentioned above, the earlier marks can be used in any typeface and it does not alter the distinctive character of the mark.<sup>6</sup> Consequently, this is acceptable use.

### **Conclusions from the evidence on genuine use**

35. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the relevant territory during the relevant five-year period. In making this assessment, I am required to consider all relevant factors, including:

- The scale and frequency of the use shown;
- The nature of the use shown;
- The goods and services for which has been shown;
- The nature of those goods/services and the market(s) for them; and
- The geographical extent of the use shown.

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<sup>5</sup> *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19

<sup>6</sup> *Colloseum Holdings AG v Levi Strauss & Co.* Case C-12/12, paras 31-35

36. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.<sup>7</sup>

37. I will also need to consider what was a major discussion point in both the submissions and at the hearing and was around genuine use where the mark is affixed in the UK but the goods were all exported. There is provision within the Act for this situation which I have quoted above but repeat here for ease of reference:

Section 6A

(4) For these purposes –

(a) [...]

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

38. The opponent raised the case of *Athleta (ITM) Inc. v Sports Group Denmark A/S & Anor* [2024] EWHC 2449 (Ch). The judge agreed that manufacturing for export can amount to genuine use, because it is infringement of a registered trade mark to make goods under the mark in the United Kingdom for export and, if manufacturing for export did not constitute genuine use, a UK manufacturer who only sold their product overseas would find their mark vulnerable to revocation for non-use after five years [48]. Mr Cunnington also pointed me to *Geoffrey Inc's Trade Mark Application* [2004] RPC.

39. The opponent has provided evidence in the form of invoices for a UK packaging company, photos of the stickers being affixed to the bottles and details of exports. I accept that the goods were manufactured by the opponent and that the mark was

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<sup>7</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

affixed to the goods for export on the opponent's instructions/with its consent, which qualifies as genuine use under s.6A(4)(b).

40. Both earlier marks are registered for 'whisky' as their sole good and that is the product that is shown throughout the evidence. Ms Lindsay said in the hearing that the opponent purports to be a malt whisky company whereas the applicant sells blended whiskey. However, I consider the case of *Merck KGaA v Merck Sharp & Dohme Corp & Ors* [2017] EWCA Civ 1834 where the court of appeal said at [249] that it does not require a proprietor to prove that he has used his mark in relation to all possible variations of the goods or services covered by its registration but only those which are sufficiently distinct to constitute coherent categories or subcategories. This approach was approved by the Supreme Court in *SkyKick UK Ltd & Anor v Sky Ltd & Ors (Rev1)* [2024] UKSC 36.

41. Mr MacRae gave evidence that 1897 cases or 11,382 bottles of whisky were sold by the opponent within the relevant period. The main sales figures seem to come in between 2020 and 2022- as pointed out in the evidence, over €1million of revenue in 2020. I consider that the market for alcoholic spirits, in particular whisky, is a very considerable one. However, I also take into account the fact that the average retail price for the whisky in evidence is €399 which is clearly a significant amount and I agree with the opponent's assertion that this would be viewed as a premium product that would not be purchased regularly and therefore, the expected number of sales of it would be lower than an everyday brand. This is further compounded by the evidence from Mr MacRae that this product is produced in smaller quantities rather than being mass produced. Further, as pointed out by Mr Cunnington, there is no *de minimis* rule.

42. Ms Lindsay criticised the invoice evidence of the opponent. However, I note within Mr McRae's witness statement that he explains that the invoices show sales to one of the other group companies for onwards export and sale to the EU. Further she states that there is no evidence of sales in Portugal save for one invoice. However, turnover figures were provided within the narrative evidence of the witness statement of Mr McRae and this was not challenged prior to the hearing.

43. The opponent has not provided the costs of their advertising and marketing. However, they did show an internal document detailing some product launch promotional schemes. I note this appears undated although at the hearing, Mr Cunnington pointed out references to 2020 within the document itself. There are further dated adverts and articles provided, all within that same time period of 2020/2021.

44. As the second earlier mark is a comparable mark, sales within the EU up until IP Completion Day can, of course, be taken into consideration. It is clear in all submissions and evidence that the sales of the whisky have taken place in Portugal. I bear in mind that sales in one Member State may be sufficient to constitute genuine use, even where there are no special factors, such as the market for the goods/services being limited to that area of the Union.<sup>8</sup>

45. Considering all of the above, I find that the opponent has made use of both marks in relation to whisky. The high price point mentioned above means that these are not mass-market goods which will be sold in high volumes because demand will be more limited, and the volumes which have been sold, over a sustained period, are sufficient. Further, I consider that the sales that were made in 2020-2021 were significant when you consider the nature and market of the goods at hand.

### **Identity of the marks**

46. It is a prerequisite of sections 5(1) and 5(2)(a) that the trade marks are identical. In *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/00, the Court of Justice of the European Union (“CJEU”) held that:

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

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<sup>8</sup> *Leno Merken in Case T-398/13, TVR Automotive Ltd v OHIM* (paragraph 57)

Contested Marks	Earlier Marks
<p data-bbox="333 398 655 439" style="text-align: center;">JAMES MARTIN</p> <p data-bbox="316 546 673 586" style="text-align: center;">JAMES MARTIN'S</p> <p data-bbox="400 707 587 741" style="text-align: center;">(SERIES OF 2)</p>	<p data-bbox="890 306 1305 340" style="text-align: center;">(The first earlier registration):</p> <p data-bbox="917 418 1278 459" style="text-align: center;">JAMES MARTIN'S</p> <p data-bbox="865 546 1332 580" style="text-align: center;">(The second earlier registration):</p> <p data-bbox="938 674 1257 714" style="text-align: center;">JAMES MARTIN</p>

47. The applicant accepts within their Form TM8 that the earlier trade marks of the Opponent and the trade marks of the application are identical. I agree that the two earlier registrations are self evidently identical to the series of 2 contested marks.

### Comparison of goods

48. In the judgment of the 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”.

49. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (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.

50. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM) ('Meric')*, Case T-133/05, the GC stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM - Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

51. 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 GC stated that ‘complementary’ means:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking”.

52. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Separode Trade Mark* (BL O/399/10) and *BVBA Management, Training en Consultancy v. Benelux-Merkenbureau* [2007] ETMR 35 at paragraphs 30 to 38).

53. The Parties’ respective specifications are:

Contested goods	Opponent’s goods
Class 32: Non-alcoholic distilled spirits; non-alcoholic gin; non-alcoholic cocktails; alcohol free wine; beer; ale; craft ales; lager; craft lager; shandy; low alcohol beer; alcohol free beers. Class 33: Alcoholic beverages; spirits; Gin; wine; sparkling wine; low alcoholic wine; spritzers; liqueurs; rum; botanical spirits.	Class 33: Whisky

54. Mr Jacob gave fairly detailed submissions at the hearing in relation to the goods to be compared which I have considered whilst making this comparison.

55. In *Absolut Company Aktiebolag v Dongguan Topson Electronic Technology Co. Ltd*, BL O/0488/25, Phillip Johnson, as the Appointed Person, identified the following considerations relevant to the comparison of alcoholic beverages and other drinks:

“13. First, the fact that spirits are mixed with soft-drinks (mixers) does not make the products complimentary (*Yilmaz*, [55]; *Wesergold*, [40]; *CHIC*, [53 to 55]), but it does mean there is a partial (but not significant) overlap between spirits and soft drinks (*Wesergold*, [32 and 33]).

14. Second, soft-drinks, water and (possibly) beer are drunk to quench the thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]; *ROSALIA DE CASTRO*, [31]; the *CHIC* case takes a different view that low alcoholic drinks are not consumed to quench thirst, *CHIC*, [44]), but in any event spirits are not consumed to quench thirst (*Yilmaz*, [54]; *Wesergold*, [35 and 36]).

15. Thirdly, the methods of production for alcoholic drinks (and between alcoholic drinks and non-alcoholic drinks) differ and this is relevant to the similarity between them: *Mezzopane*, [64 and 69]; *Bodegas*, [29]; *Yilmaz*, [54]. Likewise, products which are processed versions of each other might be more similar (eg wine and Brandy): *Vanhove*, [87].

16. Fourthly, the differences between the colour, aroma and taste of two alcoholic drinks suggests to consumers that they are different: *Mezzopane*, [65]; *Yilmaz*, [54].

17. Finally, the alcoholic content of the goods is a very relevant factor in determining the similarity of the goods: *Bodegas*, [32]; *Wesergold*, [31]; *CHIC*, [40 and 41]; *FLÜGEL*, [84]. However, a non-alcoholic version of an equivalent alcoholic drink is likely to be highly similar to it: *CERVISIA*, [20]. Nevertheless, the Grand Board highlighted that a drink's alcoholic content is only a factor in the assessment of similarity and is not determinative: *ZORAYA*, [68]."

### Class 32:

#### *Non-alcoholic distilled spirits;*

56. I consider there to be an overlap in nature, intended purpose and method of use, as both the above goods and the opponent's 'whisky' are consumable liquids, likely consumed for their taste and enjoyment (as these are spirits, it is unlikely that they alone will be drunk to quench thirst) however, alcoholic spirits are consumed for their intoxicating effect, which is not a purpose shared by their non-alcoholic versions. The users of the goods will coincide with respect to the adult population, but I keep in mind that users of the applicant's goods may also include those under the age of 18 given

that the opponent's goods cover non-alcoholic versions of the opponent's goods. There will also be an element of competition as the average consumer may choose, for example, for health reasons or lifestyle choices, the applicant's goods instead of the opponent's goods or vice versa. The distribution channels are also likely to overlap especially in a hospitality setting where the competing goods may be located in close proximity behind the bar or may appear on the same menu. As these are non-alcoholic spirits, that is they are versions of spirits that do not contain alcohol, they are likely to be located in similar locations within stores and retailers. However, that said, there are also differences between alcoholic and non-alcoholic beverages, in that alcoholic beverages can only be sold by licensed establishments. They are not complementary. I therefore find them to be similar to between a medium and a high degree.

#### *Non-alcoholic gin*

57. I consider there to be an overlap in intended purpose and method of use, as I mentioned in the previous paragraph. Whilst there is a general overlap in nature, whisky is usually an amber/brown colour whereas gin is clear, they also differ in taste. The users of the goods will coincide as I have set out above. These are not likely to be in competition as it is not a natural choice between non-alcoholic gin and whisky. The distribution channels might overlap especially in a hospitality setting where the goods may be located in close proximity behind the bar or may appear on the same menu. As this is non-alcoholic gin, it is likely to be located in similar locations to its alcoholic version (and therefore in the same general area as the opponent's goods) within stores and retailers. However, that said, there are also differences between alcoholic and non-alcoholic beverages, in that alcoholic beverages can only be sold by licensed establishments. They are not complementary. I therefore find them to be similar to between a low and medium degree.

#### *Non-alcoholic cocktails;*

58. There is a shared nature between the above goods and the opponent's whisky (as the cocktails could include whisky alternatives) however, their production methods differ. These goods from the applicant's specification are likely to be long drinks which could be drunk to quench thirst and so there is less overlap in purpose. I do not believe

these will be in competition. There is a chance they will be found relatively closely in a large retailer (i.e. in the wine, beer and spirit section but usually on different shelves or aisles) but in licensed premises spirits are usually displayed in bottles behind a bar, whilst non-alcoholic beer would be on taps at the front of the bar or in fridges (along with the non-alcoholic cocktails and wine). I therefore find them to be similar to a low degree.

*Alcohol free wine;*

59. I consider there to be an overlap in intended purpose and method of use, as I mentioned in the previous paragraph. Whilst there is a general overlap in nature, they differ in colour and they also differ in taste. Wine is not usually drunk to quench first, but as this is a non-alcoholic version it also isn't drunk for its intoxicating effects and therefore, the goods differ here. There is a chance they will be found relatively closely in a large retailer (i.e. in the wine, beer and spirit section but usually on different shelves or aisles) but in licensed premises spirits are usually displayed in bottles behind a bar, whereas wine is usually kept in fridges or under the bar. I therefore find them to be similar to a low degree.

*Low alcohol beer; alcohol free beers*

60. I consider the same findings apply here as the paragraph above and find these goods similar to a low degree.

*Beer; ale; craft ales; lager; craft lager; shandy*

61. There is a shared nature between the above goods and the opponent's whisky however, their production methods differ. These goods from the applicant's specification are likely to be long drinks which could be drunk to quench thirst but they could both be drunk for their intoxicating effects. Whilst there is a general overlap in nature, they differ in colour and they also differ in taste. There is a chance they will be found relatively closely in a large retailer (i.e. in the wine, beer and spirit section but usually on different shelves or aisles) but in licensed premises spirits are usually displayed in bottles behind a bar, whereas beer is usually kept in fridges or provided

by the taps on the bar. I therefore find these goods to be similar to a low degree. I find this reasoning to be supported in part by the decision in *James Duncan Abbott v Alpes Marques* [BL no. O/693/19] in which the appointed person Miss Emma Himsworth QC overturned a finding that beers and whisky were not similar, stating:

“72. In my view, had the Hearing Officer: (1) gone through a proper analysis of the factors relevant to his assessment of the similarity of the goods in the particular case that was before him; and (2) specifically considered the position by reference to perception of the average consumer in the UK in accordance with the approach set out in in BALMORAL TM and CALEDONIAN TM he could and would have found that beer and whisky were similar but only to a low degree.”

### Class 33

*Alcoholic beverages; spirits;*

62. I consider that whisky is an alcoholic beverage and a type of spirit and therefore, using the *Meric* principles, I find the goods to be identical.

*Gin; liqueurs; rum; botanical spirits*

63. I consider again that to an extent the above goods will share a nature with the earlier whisky with all being spirits containing a high alcohol content however, they will differ in taste and colour. These are drinks that may be drunk neat or be mixed with another beverage. When they are served neat, they may be served in similar receptacles. Again, the method of use will largely be shared and the goods will share the purpose of being consumed for enjoyment or relaxation. Whilst these goods are also unlikely to be placed directly next to each other in shops such as supermarkets, they are likely to be placed very near each other in a ‘spirits’ section of the same, and there will likely be a degree of overlap in trade channels. There is an overlap in users, being the general public and also businesses such as bars and public houses. There may be a degree of competition between the goods, with the consumer choosing between the above or a whisky from a store to enjoy at home, or from a drink’s menu

within a bar or public house. The goods will not be complementary. Overall, considering all of the relevant factors, I find the goods to be similar to a fairly high degree.

*Wine; sparkling wine; low alcoholic wine; spritzers;*

64. There is a general shared nature between the above goods and the opponent's whisky however, they differ in their taste and colour and also their production methods. Wine is sold in different measurements to whisky and so there is less overlap in purpose. I do not believe these will be in competition as they are a step further removed – you would not naturally choose between whisky and wine. There is a chance they will be found relatively closely in a large retailer (i.e. in the beers, wine and spirits section) but in licensed premises spirits are usually displayed in bottles behind a bar, whilst wine would be in bottles either in fridges or under the bar. I therefore find them to be similar to a low degree.

65. As I have found the marks to be identical and 'alcoholic beverages; spirits' to be identical, the section 5(1) claim is successful.

66. I will now continue with the section 5(2)(a) claim.

### **Average consumer and the purchasing act**

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

68. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. (as he then was) 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.”

69. The average consumer for the goods will be a member of the general public (who is over the age of 18, in the case of alcoholic drinks). The cost of the goods is likely to be relatively low (although, as per the evidence provided from the opponent, it is possible that some of these goods can be higher), and they are likely to be reasonably frequent purchases. However, factors such as flavour and alcohol content are likely to be considered when purchasing the goods. Consequently, I consider that a medium degree of attention is likely to be paid.

70. The goods are likely to be self-selected from the shelves of a retail outlet or an online equivalent. They may also be purchased following perusal of the goods at food and drink venues (either on taps, on shelves or in fridges behind the bar or, alternatively, on a drinks list). Consequently, visual considerations are likely to dominate the purchasing process. However, I do not discount an aural component to the purchase given that advice may be sought from retail assistants and orders may be placed verbally in a bar or restaurant.

### **Distinctive Character of the Earlier Mark**

71. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other

undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR 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).”

75. Registered trade marks possess varying degrees of inherent distinctive character, being lower where they are allusive or suggestive of a characteristic of the goods and/or services, ranging up to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. However distinctiveness is assessed from the perspective of the UK consumer, and as the only sales in the UK were to a single group company, the evidence does not support a finding of enhanced distinctiveness., I therefore only have the inherent position to determine.

76. The earlier marks contain two names: James and Martin, although both can be used as forenames, I find that they will be perceived as a forename and surname in these marks. Both are relatively common names and have no relation to the goods at issue. The first earlier registration has an apostrophe and ‘S’ on the end which gives the meaning of ownership of the goods to that name. However, I do not believe this alters the inherent position. Mr Cunnington raised at the hearing that the applicant has made multiple mentions that reference to ‘James Martin’ would be known as the celebrity. These submissions stray more into the realm of the conceptual meaning of the marks (which, it is admitted, are identical) rather than inherent distinctiveness and,

therefore, I considered this no further. I find the earlier marks to be inherently distinctive to a medium degree.

### **Likelihood of confusion**

77. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and services and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

78. In the present case, as is necessary for all section 5(2)(a) claims, the marks are identical. I have found the remaining goods and services to range in similarity from a very low to a fairly high degree. Due to the interdependency principle, the identity of the marks together with the medium degree of inherent distinctiveness will offset the lower levels of similarity between the goods and will mean the average consumer is likely to mistake one for the other. Therefore, I consider there to be a likelihood of direct confusion.

### **Conclusion**

79. The section 5(1) and section 5(2)(a) claims succeed in their entirety and therefore, registration is refused for the following goods:

Class 32: Non-alcoholic distilled spirits; non-alcoholic gin; non-alcoholic cocktails; alcohol free wine; beer; ale; craft ales; lager; craft lager; shandy; low alcohol beer; alcohol free beers.

Class 33: Alcoholic beverages; spirits; gin; wine; sparkling wine; low alcoholic wine; spritzers; liqueurs; rum; botanical spirits.

## **Costs**

80. As the opponent has been successful, it is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016 (as proceedings commenced prior to 1 February 2023). At the hearing, Mr Jacob stated that for the most part they would seek costs on the scale set out in the TPN however, they would ask for off-scale costs in relation to responding to Ms Lindsay's statement and the requirement for there to be a paragraph that was translated.

81. Rule 67 of the Trade Marks Rules 2008 provides: "The registrar may, in any proceedings under the Act or these Rules, by order award to any party such costs as the registrar may consider reasonable, and direct how and what parties they are to be paid."

82. Tribunal Practice Notice ("TPN") 4/2007 indicates that the Tribunal has a wide discretion when it comes to the issue of costs, including making awards above or below the published scale where the circumstances warrant it. The TPN stipulates that costs off the scale are available "to deal proportionately with wider breaches of rules, delaying tactics or other unreasonable behaviour"

83. I acknowledge that Ms Lindsay filed an exhibit that was partially translated (and not officially certified), and that the opponent subsequently filed a professional translation. However, there is nothing to suggest that the behaviour by the applicant was an abuse of process, nor a tactic to delay the proceedings. In my view, the opponent can be adequately compensated for their time and expenditure within the parameters of the normal scale. Consequently, I do not consider that off-scale costs would be appropriate in this instance.

Official fee	£100.00
Preparing the Notice of Opposition and Considering the counterstatement	£300.00
Preparing evidence and considering and commenting on the other side's evidence	£700.00
Preparing for and attending a hearing	£800.00
<b>Total</b>	<b>£1900.00</b>

I therefore order James Martin to pay Macdonald & Muir Limited the sum of £1900. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 22<sup>nd</sup> day of December 2025**

**L Nicholas**  
**For the Registrar**