O/470/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003480610 BY
MORRISON SCOTCH WHISKY DISTILLERS LIMITED
TO REGISTER:

MORRISON SCOTCH WHISKY DISTILLERS LTD

AS A TRADE MARK IN CLASSES 33 & 40

AND

IN THE MATTER OF THE OPPOSITION THERETO
UNDER NO. 421085 BY
WM MORRISON SUPERMARKETS PLC

BACKGROUND AND PLEADINGS

1. On 10 April 2020, Morrison Scotch Whisky Distillers Limited ("the applicant") applied to register the trade mark shown on the cover of this decision ("the applicant's mark") in the UK for the following goods and services:[1]

   Class 33: Scotch whisky and Scotch whisky based drinks, all being produced in Scotland.

   Class 40: Distilling services; information, advisory and consultancy services relating to the same.

2. The applicant's mark was published for opposition purposes on 1 May 2020 and, on 3 August 2020, it was opposed by WM Morrison Supermarkets PLC ("the opponent"). The opposition is based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). In respect of the section 5(2)(b) grounds, the opponent relies on the following marks:

   MORRISONS
   EUTM: 1466713[2]
   Filing date 19 January 2000; registration date 16 October 2002
   Relying on some services, namely:

   Class 35: Retail services; selecting, buying, bringing together and displaying on premises, in catalogues and over the Internet of goods (in particular […] foods and drinks).

   ("the opponent's first mark");

[1] The applicant's mark was initially applied for in the name of Morrison and Mackay Limited. However, by way of a Form TM21A dated 8 September 2020, the applicant confirmed the change of its name to Morrison Scotch Whisky Distillers Ltd. This change was confirmed by the Registrar by way of a letter to the applicant's representative dated 24 October 2020.

[2] Although the UK has left the EU and the EUTM relied upon by the opponent now enjoys protection in the UK as a comparable trade mark, the EUTM remains the relevant right in these proceedings. That is because the application was filed before the end of the Implementation Period and, under the transitional provisions of the Trade Marks (Amendment etc.) (EU Exit) Regulations 2019, I am obliged to decide the opposition on the basis of the law as it stood at the date of application

MORRISONS

UK registration no. 2137961

Filing date 4 July 1997; registration date 12 May 2000

Relying on some goods, namely:

Class 33: Alcoholic beverages (except beers).

("the opponent's second mark");

Morrisons

UK registration no. 3129379

Filing date 30 September 2015; registration date 8 April 2016

Relying on some goods and services, namely:

Class 33: Alcoholic beverages (except beers).

Class 35: Retail services connected with the sale of […] malt, beers, [and] alcoholic beverages (except beers).

("the opponent's third mark"); and

Morrisons
Since 1899
The Best

UK registration no. 3442692

Filing date 8 November 2019; registration date 31 January 2020

Relying on some goods and services, namely:

Class 33: Alcoholic beverages; alcoholic preparations for making beverages; wines; spirits.

Class 35: Retail, wholesale, mail order and online retail services, all connected with the sale of […] food and drink products, […]

alcoholic beverages, alcoholic preparations for making beverages, wines [and] spirits.

("the opponent's fourth mark").

3. Under its 5(2)(b) ground, the opponent claims that the applicant's mark should not be registered because it is similar to its own trade marks and covers identical or similar goods and services meaning that there is a likelihood of confusion on the part of the public, including the likelihood of association.

4. Under its 5(3) ground, the opponent relies upon its first, third and fourth marks only. The opponent claims to have obtained a reputation for those marks in respect of the same goods and services relied upon under its 5(2)(b) ground. The opponent claims that as a result of the significant reputation its marks, use of the applicant's mark would (1) lead the relevant public to believe that the marks are used by a single undertaking or that there is an economic connection between them, (2) result in the applicant obtaining an unfair advantage by virtue of free-riding on the reputation of the opponent's marks and (3) lead to a dilution or blurring of the reputation and distinctive character of the opponent's marks that would alter the economic behaviour of the average consumer (or at least seriously be likely that a change would occur).

5. Under its 5(4)(a) ground, the opponent claims to have obtained goodwill in the following unregistered signs:

   MORRISONS

   being a sign it claims to have used throughout the UK since 1899 for "alcoholic beverages, wines and spirits" and "retail services of food and drinks, alcoholic beverages, wines and spirits."

   ("the opponent's first sign");

Morrisons

being a sign it claims to have used throughout the UK since 1899 for “alcoholic beverages (except beers)” and “retail services connected with the sale of food and drinks, alcoholic beverages, wines, spirits.”
(“the opponent’s second sign”); and

being a sign it claims to have used throughout the UK since 2016 for “alcoholic beverages, wines, spirits” and “retail services”
(“the opponent’s third sign”);

6. The opponent claims that as a result of the goodwill obtained in these signs, use of the applicant’s mark constitutes a misrepresentation and will deceive customers into thinking that the goods and services provided under it are the opponent’s or somehow endorsed by or relate to the opponent. The opponent claims that this would cause damage to its goodwill and business.

7. The applicant filed a counterstatement wherein it, generally, denied the claims made but did admit that the goods of the opponent in class 33 encompassed its own goods in class 33. Further, the applicant put the opponent to proof of use of its second mark for “whisky, scotch whisky, whisky based drinks, liqueurs, spirits and alcoholic beverages with the exception of wine”. These goods are not ones for which the opponent’s second mark is specifically registered. Instead, these goods are ones that fall within the opponent’s broader term of “alcoholic beverages (except beers)”.

8. The opponent is represented by Wilson Gunn and the applicant is represented by Murgitroyd & Company. Both parties filed evidence in chief with the opponent also filing further evidence in reply. No hearing was requested and both parties filed

written submissions in lieu. This decision is taken following a careful perusal of the papers.

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

EVIDENCE

10. The opponent's evidence in chief came in the form of the witness statement of John William Morris dated 16 July 2021. Mr Morris has been employed by the opponent since August 1998 and his present role is as the Category Director for Beers, Wines, Spirits & Tobacco for the opponent, a position he has held since February 2021. Mr Morris's statement is accompanied by 24 exhibits.

11. The applicant's evidence in chief came in the form of two witness statements, the first of which is the witness statement of Jamie Walker Stanley Pringle Morrison dated 19 October 2021. Mr Morrison is the Chairman of the applicant, a position he has held since 7 January 2013. Mr Morrison's statement is accompanied by fourteen exhibits. The second witness statement filed by the applicant was that of Ms Eleanor Gail Coates dated 19 October 2021. Ms Coates is a Chartered Trade Mark Attorney of the applicant's representative and is, therefore, duly authorised to provide a statement on its behalf. Ms Coates' statement was accompanied by two exhibits.

12. The opponent's evidence in reply was the witness statement of Ms Alison Charnock dated 26 January 2022. Ms Charnock is the legal director of the opponent and her statement is accompanied by two exhibits.

13. I do not intend to reproduce the evidence or submissions in full here, however, I will refer to them below where necessary.

PRELIMINARY ISSUES

The applicant's claim to have an unregistered earlier right

14. In its written submissions, the applicant submitted that:

> "22. The evidence of the Applicant set out and evidenced the history of the Morrison family (Jamie Morrison being the controlling interest at the Applicant) in relation to whisky brokerage and distilling in the public domain. The family members have operated whisky distilleries prior to the filing date of any of the Opponent's Earlier Registration. The Morrison family is described by external parties as being "the famous whisky Morrison dynasty".
>
> […]
>
> 24. As such, the Applicant has an earlier right to use the name MORRISON in relation to whisky and should the Opponent seek to label whisky under the MORRISONS name would have a ground to challenged [*sic*] that use as it would give rise to a misrepresentation that one of the famous Morrison whisky family was involved."

15. In support of this argument, the applicant filed evidence regarding the historic involvement of the Morrison family in relation to Scotch whisky and claims that the name "is very well known in the Scotch whisky industry to refer to our family, known as a family of distillers of whisky."[3] A number of press articles in support of this claim have been provided.[4]

[3] Paragraph 6 of the Witness Statement of Jamie Walker Stanley Pringle Morrison
[4] Exhibit JM3 of *ibid*

16. For the avoidance of doubt, the fact that the applicant claims to have an earlier unregistered right or that the family name 'Morrison' has become well-known in the whisky industry prior to the opponent's mark being applied for/registered, is not a defence in law to the opposition under section 5(2) of the Act. Tribunal Practice Notice 4/2009 explains this as follows:

> "*The position with regard to defences based on use of the trade mark under attack which precedes the date of use or registration of the attacker's mark.*
>
> 4. The viability of such a defence was considered by Ms Anna Carboni, sitting as the appointed person in Ion Associates Ltd v Philip Stainton and Another, BL O-211-09. Ms Carboni rejected the defence as being wrong in law.
>
> 5. Users of the Intellectual Property Office are therefore reminded that defences to section 5(1) or (2) grounds based on the applicant for registration/registered proprietor owning another mark which is earlier still compared to the attacker's mark, or having used the trade mark before the attacker used or registered its mark are wrong in law. If the owner of the mark under attack has an earlier mark or right which could be used to oppose or invalidate the trade mark relied upon by the attacker, and the applicant for registration/registered proprietor wishes to invoke that earlier mark/right, the proper course is to oppose or apply to invalidate the attacker's mark."

17. As set out in the above Tribunal Practice Notice, if the applicant wanted to challenge the validity of the opponent's mark, then the correct course of action would have been to issue proceedings for invalidation. The applicant has not done so. The outcome of this opposition will, therefore, be determined after making a global assessment whilst taking into account all relevant factors and the existence of an earlier unregistered right owned by the applicant is not relevant to the 5(2)(b) claim.

Use of ‘MORRISON’ as a company name

18. The applicant has provided evidence that shows a number of entries on the Companies House register that show ‘MORRISON’ as being part of either the company name or trading name.[5] In addition, the applicant’s evidence also shows extracts from third party companies showing them operating under a company name that incorporates the word ‘MORRISON’[6] and print-outs from Yell.com that show businesses operating in and around Perth, Glasgow and Edinburgh that all utilise the name ‘MORRISON’.[7] The applicant is arguing here that the widespread use of companies using the name ‘MORRISON’ means that the average consumer (being members of the general public over the age of 18) would not be confused by the presence of a company under the name ‘MORRISON’, provided it was not a supermarket retailer. While the evidence on this point is noted, it has no bearing on the outcome of this decision. My reasons follow.

19. Firstly, I do not consider that the existence of these companies on the directories provided is sufficient to demonstrate that any of them are actually present in the marketplace. I note that no evidence has been filed to that effect. In addition, I do not consider these businesses’ existence as evidence that the average consumer would not be confused. On this point, there is no evidence of the marks being encountered by average consumers in circumstances that would give rise to confusion.

20. I note that the Companies House evidence refers to a total of 1,164 search results, however, I have a number of issues with this evidence. Firstly that that the print-outs do not show the full list of 1,164 results and it is not clear what the search parameters were (i.e., whether the search includes companies with names *similar* to ‘MORRISON’ and not exact matches). Second, the print-outs are dated 2 September 2021 and include results showing companies that were incorporated after the date of the application at issue. Third, the print-outs show a number of companies that no longer operate under the name ‘MORRISON’ (i.e. GF FRESH

[5] Exhibit JM13 of the Witness Statement of Jamie Walker Stanley Pringle Morrison
[6] Exhibit EC1 of the Witness Statement of Eleanor Gail Coates
[7] Exhibit EC2 of *ibid*

LTD). Further, there is no evidence that these companies are in operation and whether they exist in the marketplace. Finally, there is no explanation or additional evidence as to whether these entities operate in the same or similar fields as the opponent that would give rise to there being confusion. On this point I note that there are references to 'AVIATION', 'HOME IMPROVEMENT' and 'BUILDING ENGINEERING' companies indicating that they operate in significantly different fields. Turning to the yell.com print-outs, I note that only two of the businesses listed show reviews and that a number of the businesses listed are for services unrelated to the opponent's field of activity such as Solicitors, Carpenters and Joiners, Driving Schools and Tree Surgeons. Even for those businesses that can be said to operate in the same or similar fields as the opponent, I reiterate my point about there being no evidence of their existence on the marketplace. In summary, the evidence is not sufficient to demonstrate that the average consumer would not be confused when confronted with any mark bearing the name 'MORRISON'.

21. In addition to my comments above, I have also considered this argument insofar as it may be used to point towards a weakened distinctive character of the opponent's marks due to the presence of a number of entities bearing the name 'MORRISON'. On this point, I refer to the case of *Zero Industry Srl v OHIM, Case T-400/06*, wherein the General Court ("GC") stated that:

> "73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '… there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865,

paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). "

22. The fact that there may be a multitude of entities on the Companies House register, online or on Yell.com using the word 'MORRISON' is not a relevant factor to the distinctiveness of the opponent's marks. I have set out above that no evidence has been filed to demonstrate that any of these marks are actually in use in the marketplace. The outcome of this opposition will be determined after making a global assessment whilst taking into account all relevant factors and the evidence referred to here is not relevant to that assessment.

Proof of use issues

23. As referred to at paragraph seven above, the applicant has requested proof of use in respect of the opponent's second mark only for a specific range of alcoholic beverages that are not technically included within the opponent's specification. However, given that the opponent's specification includes the broader term "alcoholic beverages (except beers)" that can be said to encompass all the specific terms requested by the applicant, I am content to accept this as a valid request that the opponent prove use for all of its goods in its second mark's specification. On the issue of proof of use, I note that in its written submissions, the applicant argues that the opponent has failed to provide proof of use in relation to Class 33 or Class 43. For the avoidance of doubt, the opponent has not relied upon any of its marks' class 43 services. As for the claim that the opponent has failed to provide proof of use, I will address this substantively below.

DECISION

Proof of use

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

"(6)(1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered."

25. Given their filing dates, the opponent's marks qualify as earlier trade marks under the above provisions. On the basis that the opponent's first three marks completed their registration process over five years prior to the date of the application at issue, it was open for the applicant to request proof of use evidence in respect of these marks. The opponent's fourth mark is not subject to the proof of use provisions on the basis that it was registered less than five years prior to the application date of the mark at issue. In its counterstatement, the applicant only sought to put the opponent to proof of use of its second mark for "whisky, scotch whisky, whisky based drinks, liqueurs, spirits and alcoholic beverages with the exception of wine". This means that, as well as its fourth mark, the opponent may continue to rely on all of the goods and services for which its first and third marks are registered. As I have set out above, I will procced to consider proof of use for "alcoholic beverages (except beers)" in the opponent's second mark's specification.

26. The relevant statutory provisions are as follows:

"Raising of relative grounds in opposition proceedings in case of non-use

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), (b) 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 period of five years ending with the date of publication.

(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 mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the period of five years ending with the date of publication of the application 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) In relation to a Community trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(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."

27. Section 100 of the Act is also relevant, which reads:

"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."

28. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) summarised the law relating to genuine use as follows:

"114……The CJEU has considered what amounts to "genuine use" of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp* v *Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v*

Bundervsvereinigung Kamaradschaft 'Feldmarschall Radetsky' [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, 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] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases 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]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(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]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(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] and [22]. 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]; *Reber* at [29].

(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]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(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] and [76]-[77]; *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]."

29. Pursuant to Section 6A of the Act, the relevant period for assessing whether there has been genuine use of the opponent's second mark is the 5-year period ending with the date of the application at issue, being 10 April 2020. Therefore, the relevant period for this assessment is 11 April 2015 to 10 April 2020.

30. Proven use of a mark which fails to establish that "the commercial exploitation of the mark is real"[8] because the use would not be "viewed as warranted in the economic sector concerned to maintain or create a share in the mark for the goods or services protected by the mark"[9] is, therefore, not genuine use.

Form of the Mark

31. In *Colloseum Holdings AG v Levi Strauss & Co.,* Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union ("the CJEU") found that:

"31. It is true that the 'use' through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas 'genuine use', within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, 'use' within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish 'use' within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestlé*, the 'use' of a mark, in its literal sense, generally encompasses both its

[8] *Jumpman* BL O/222/16
[9] *ibid*

independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition by a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35 Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

32. The applicant submits that the opponent has not used its mark on its own branded alcoholic beverages in that the opponent's mark has not been used. The applicant's argument is that, firstly, the marks shown on alcoholic beverages in the evidence are not those relied on by the opponent and, secondly, the branding is displayed very small font at the bottom of the front labels or on the back labels and that it is well established through case law that use of the back of a label does not constitute trade mark use. On this point, the applicant submits that:

"the logo variant mark which is on the front of the bottle (which is registered under a UK registration which was not relied upon in the opposition, therefore clearly a different mark) is so small and insignificant that the average consumer would not perceive it as being a trade mark or a name of the product. It is perfectly foreseeable, that the average consumer, undertaking a weekly shop and selecting several items, would not note the logo variant due to its small size and positioning and instead would select the product on price alone."

33. Before moving to consider the use shown in the evidence, I wish to address the argument that the average consumer would select the product on price alone and not notice the logo due to its small size and position. While I will address the average consumer in further detail below, for now I will say that I disagree with these submissions in that I do not consider that they would buy the products on price alone. Instead, I am of the view that they will give further consideration during the selection process, which would result in them noticing the small logo shown, particularly given its location on the front of the bottles not solely on the back, as the applicant submits (although I do appreciate that there is evidence of photos that show the opponent's name on the back labels).

34. Of the evidence shown, I note that the mark is used on the following labels:

35. All of the above labels show use of the following mark, albeit in different colours:

Morrisons
Since 1899

36. Dealing with the applicant's arguments in turn, I am of the view that the above example is use of the opponent's second mark as registered. In accordance with *Colloseum* (cited above), when marks are used as part of a composite mark, they are still capable of being use of the mark as registered so long as the mark remains the primary indication of origin within the composite mark. This is clearly the case here with the word 'MORRISONS' remaining as the primary indicator of origin. The presence of the device element and the word/numbers 'Since 1899' do nothing to alter this. Dealing with the second argument posed by the applicant, I am of the view that the above labels will not be seen as marks themselves. Instead, when a consumer selects one of the bottles displaying the above labels, they will inspect its label further and determine that 'MORRISONS' is the provider of the goods. This does not, in my view, require a thorough examination of the bottle or its rear label but, instead, the consumer will simply scan the front label and notice the 'MORRISONS' mark and view that as the indicator of origin for these goods. This is on the basis that the labels themselves, save for the 'MORRISONS' element, consist of purely descriptive and/or suggestive elements and those element are, in

my view, typical words/elements that are commonly used on the presentation of the various alcoholic beverages at issue.

Sufficient Use

37. 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.[10]

38. Before moving to discuss the opponent's evidence in respect of proof of use, I consider it necessary to address some of the submissions made by the applicant in respect of the opponent's proof of use evidence. Specifically, I note that the applicant submitted that:

> "The Opponent did not file proof of use in relation to the above request. Proof of use must show the time, date and extent of use of the mark in respect of the goods."

39. However, as I will discuss below, the opponent's evidence consisted of turnover figures relating to the sale of alcoholic beverages between 2019 and 2020, awards given from 2016 to 2019 and annual advertising expenditure. In no way did the opponent, as the applicant puts it, fail to file proof of use evidence in relation to the applicant's request.

40. The applicant also aimed some criticism at the fact that the opponent filed evidence mainly based upon its activity in the retail services sector. Given that the opponent relies on retail services under its other marks and also under its 5(3) and 5(4)(a) grounds, it is expected that evidence of this nature would be filed. The applicant also went on to submit that:

[10] *New York SHK Jeans GmbH & Co KG v OHIM*, T-415/09

"Consumers understand the concept that some supermarkets offer own brand products of certain basic items such as pasta, teabags, canned goods. It does not follow that supermarkets own branded alcohol and, as demonstrated by the Opponent's evidence, in fact the very opposite is true. Supermarkets do not put their own name as the product name of alcohol. The below image is of a whisky sold by Tesco, bottled on its behalf and as can be seen, the generic words or SPECIAL RESERVE are placed as the brand name, just as the Opponent uses SCOTCH BLEND."

41. The evidence the opponent filed does not, as the applicant submits, demonstrate the 'very opposite'. I have discussed the issue regarding the form of the mark above and again, I reiterate the fact that the opponent has indeed filed evidence in support of its position that it does sell its own branded alcoholic beverages (which I will discuss further below). In addition, the activity of Tesco in selling its own alcoholic beverages has absolutely no bearing on the decision I must make.

42. Finally, before moving to consider the evidence in full, I wish to address the applicant's claim that "the Opponent could have manipulated its website to include the word MORRISONS in the description of the product which is not evident on the actual product after the filing date to support the opposition." This is a serious allegation made against the opponent that it manipulated its evidence. The applicant, should it have wished to do so, had the opportunity to request to cross-examine the opponent's witness on this point but elected not to do so. I do not consider it appropriate to raise such an allegation at such a late stage in proceedings and I will give it no further consideration.

43. The opponent's evidence sets out that it provides a wide range of its own branded alcoholic beverages including wines, perry, whisky, cider, vodka, gin, sherry, rum, brandy, port and pre-mixed cocktails. In support of this, the opponent has provided an undated print-out that show a range of 'MORRISONS' branded alcoholic products for sale on its own website.[11] The opponent has also provided

[11] Exhibit JM9 of the Witness Statement of John William Morris

photographs of its bottled alcoholic beverages.[12] The applicant has taken issue with this evidence on the basis that it is undated. While that is the case, it does not render them useless for the purpose of this assessment. On this point, this evidence is capable of being cross-referenced with the narrative evidence of the opponent in that it has provided turnover figures from the beginning of 2019 to week 11 of 2020 (which I have calculated to be 18 March 2020). During this time, the opponent confirms that it sold 4,739,858 units of its own branded spirits for a total sales figure of £45,381,670. This included 662,669 units of whisky for a total sales figure of £6,299,846. In addition to whisky, I note that the turnover is broken down into different types of alcoholic beverages including "Morrisons" branded rum (dark, spiced and white), imperial vodka, dry gin and napoleon brandy. Given that the sales figures are from within the relevant period, I am of the view that the undated print-outs and photos assist in painting a picture of the position during that time. Further, I have no reason to disbelieve the opponent's evidence as being reflective of the position during the relevant period.

44. The opponent has also filed evidence regarding awards being provided to the opponent between 2016 and 2019 in respect of its own brand alcoholic beverages.[13] While this is noted, there is no evidence or explanation as to the basis for the awards given. For example, it is unclear as to who determines these awards (are they voted for by a specialist panel or members of the general public) or what the reach of these awards is amongst the relevant public at large. I do not intend to consider these awards as being capable of pointing to widespread awareness of the opponent's own branded alcoholic beverages. However, I accept that the presence of awards being given to the opponent from 2016 onwards for its own branded alcoholic beverages further demonstrates the existence of the opponent's own products prior to the relevant date. On the point of these awards, I note that, as well as consisting of the name 'MORRISONS', they include the names 'Whyte and Mackay', 'Quintessential Brands' and 'Distell Ltd'. The print-outs also include what appears to be hyperlinks to 'View other results from Whyte and Mackay' (and so on). While I have no explanation as to what the purpose of these additional

[12] Exhibit JM10 of *ibid*
[13] Exhibit JM23 of *ibid*

names is, it is possible that they are the provider of the awards or their sponsors. In any event, I note that the name 'MORRISONS' is prominent in each award and I do not consider that it takes away from the fact from between 2016 and 2019, the opponent was selling its own branded spirits.

45. In respect of promotion, the opponent sets out that in promoting the alcoholic drinks it sells, it spends £5 million every year. While there is no specific indication of the years over which such an expenditure took place, I have no reason to disbelieve this as being an approximate annual figure. On this point, I note that the applicant did not seek to challenge this claim which may have prompted the opponent to expand upon this issue further in any evidence in reply. As an additional point, I note that these figures refer to 'alcoholic drinks' that the opponent's sells and may, therefore, include figures spent in relation to third party brands as well as other types of 'MORRISONS' branded alcoholic drinks such as beers and ciders, which do not fall within the goods for which the mark is registered. Even bearing these points in mind, I accept that some of the expenditure will have related to its own range of goods covered by the specification at issue and accept it as an ongoing and significant expenditure.

46. Based on the evidence of turnover and advertising expenditure provided, I am content to conclude that the opponent has put its second mark to use for the goods within its specification. On this point I note that while the figures provided are not particularly longstanding, the supporting evidence of awards points to the existence of use of the opponent's own branded alcoholic beverages since 2016. Given that the use shown covers a number of different types of alcoholic beverages, namely whisky, vodka, rum, gin and brandy, I am content to conclude that when confronted with the wide range of use shown, the average consumer would fairly categorise it as being for alcoholic beverages and they would not seek to interpret it by using narrower terms.[14] Therefore, I am content to accept that the opponent has shown use for its broad term, being "alcoholic beverages (except beers)".

[14] *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch)

Section 5(2)(b)

My approach

47. For the purpose of the following 5(2)(b) assessment, I will focus on the opponent's second mark only. This is on the basis that it is the word only mark 'MORRISONS' and its specification covers the closest range of goods when compared to the applicant's. In the event that I find a likelihood of confusion in respect of this mark, any finding of confusion in respect of the remaining marks does not further the opponent's case. On the contrary, if I find no likelihood of confusion for the second mark, it follows that the same finding will apply to the remaining marks on the basis that they share, at best, the same level of similarity with the applicant's mark and its goods/services. For the remainder of the 5(2)(b) assessment, I will refer to the opponent's second mark as 'the opponent's mark'. If required, I will address this point further when considering any final remarks at the conclusion of this decision.

Legislation and case law

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

> "(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 or association with the earlier trade mark."

49. Section 5A of the Act states as follows:

"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."

50. 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 Office for Harmonization in the Internal Market (Trade Marks and Designs) ("OHIM")*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

(i) mere association, in the strict sense that the later mark brings 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

51. The competing goods and services are as follows:

The opponent's goods	**The applicant's goods and services**
Class 33 Alcoholic beverages (except beers).	Class 33 Scotch whisky and Scotch whisky based drinks, all being produced in Scotland.

	Class 40 Distilling services; information, advisory and consultancy services relating to the same.

52. 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 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".

53. 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.

54. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T-133/05, that, even if goods or services are not worded identically, they can still be considered identical if one term falls within the scope of another or (vice versa):

> "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".

55. I have submissions from both parties regarding the similarity of the goods and services. While I do not intend to reproduce them here, I confirm that I have taken them into account in making my following assessment. However, should I consider it necessary to refer to specific submissions, I will do so below.

Class 33 goods

56. As I have set out above, the applicant admits that the opponent's goods in class 33, namely its alcoholic beverage goods encompassed its own class 33 goods. I accept this admission and, therefore, find that "Scotch whisky and Scotch whisky based drinks, all being produced in Scotland" are identical under the principle outlined in *Meric* with the "alcoholic beverages (except beers)" in the opponent's specification.

Class 40

57. I note that the applicant submits that:

"Distilling services are highly specialised and removed from the retail of the products. Distilling services are correct to Class 40 as a treatment of materials, and it is not the case the case that treatment of materials is deemed similar to goods subsequently made and sold after the treatment. For example, abrasive polishing is a treatment of a material and a service correct to Class 40. It is not however similar to a hand tool in Class 8, which may have been made after the treatment to the metal. The same is true of distilling services and alcoholic beverages/Scotch Whisky."

58. While these submissions are noted, the reference to abrasive polishing services and hand tools is not relevant to the comparison I must make. On this point, I am reminded of the fact that goods and services in separate classes are still capable of sharing a level of similarity.

59. While I appreciate that "distilling services" in the applicant's specification are different in nature, purpose and method of use to "alcoholic beverages (except beers)" in the opponent's specification, I am of the view that they share some level of similarity. The distillery service of the applicant describes the process of producing spirits that require distillation, such as whisky, gin or rum, for example. This process is essential for the existence of the goods in the opponent's specification on the basis that they can include the spirits I have previously referred to. Having said that, I am of the view that the user of the goods and services are likely to differ. For example, the user of the applicant's service will be a business user looking for a third party to distil its own alcoholic beverage whereas the user of the opponent's class 33 goods either be a member of the general public over the age of 18 or a business user looking to stock alcoholic beverages in its store/restaurant/bar. While this may be the case, there is an overlap in trade channels in that an undertaking that offers distilling services is also likely to produce its own alcoholic beverage for sale. For example, when a consumer buys a bottle of whisky from one undertaking, they are likely to believe that it was distilled by the same undertaking. Further, I consider that these goods and services are complementary on the basis that the distilling process is important and indispensable to whisky, gin or rum (all of which fall within the opponent's goods)

and vice versa. In my view, the average consumer is likely to consider that the undertaking responsible for one is responsible for the other.[15] Given the complementary relationship between these goods and services and their overlap in trade channels, I am of the view that they are similar to a medium degree.

60. Further to the above comparison, I note that the applicant's specification also includes "information, advisory and consultancy services relating to the same", being distillery services. Due to the close association between distillery services are "alcoholic beverages (except beers)" in the opponent's second mark's specification, that I have discussed above, I consider that there is a level of similarity between these services and the opponent's goods. The provider of this service is likely to be the provider of the alcoholic beverages meaning an overlap in trade channels. On this point, it is my understanding that it is common in the trade for information regarding the distilling process of a whisky, for example, to be provided on the label of the bottle itself or via the producer's website. As I will come to discuss below, the user is likely to seek out such information in that the distilling process may point towards the origin, age and flavour of the beverage. Further, I consider that the consumer is likely to believe that these goods and services share a degree of complementarity on the basis that the end product of an alcoholic beverage is important to the services regarding information, advice and consultancy regarding its distillation process and is, therefore, likely to believe they originate from the same undertaking. Overall, I consider that these goods and services are similar to a medium degree.

The average consumer and the nature of the purchasing act

61. As the case law set out above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods and services. I must then decide the manner in which these goods and services are likely to be selected by the average consumer in the course of trade. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited,*

[15] *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM),* Case T-325/06

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 words "average" denotes that the person is typical. The term "average" does not denote some form of numerical mean, mode or median."

62. I note that I have submissions from both parties in respect of the average consumer. While I will not reproduce these here, I have taken them into account in making my following assessment.

Class 33 goods

63. I find that the average consumer of the goods at issue will be a member of the general public over the age of 18 or a business user who will look to stock the goods at their stores/restaurants/bars. For the member of the general public, the goods at issue are most likely to be sold through a range of retail outlets such as supermarkets and off-licences, their online equivalents or specialist suppliers (such as the producer itself). Some of the goods will also be sold in restaurants, bars and public houses. In retail outlets, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as restaurants, bars and public houses, the goods are likely to be on display, for example, behind the counter at bars or on drinks menus. For the business user, the goods are likely to be available from the producer itself or wholesale retailers. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments or after discussions with sales persons, this is likely to take place after a visual inspection of the goods, a menu or via a catalogue or online

image. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part.

64. The goods at issue are not everyday beverage products but are likely to be purchased on a semi-regular basis. The costs of the goods at issue will likely be fairly inexpensive but I appreciate that for some goods, such as high end whisky, it may be more expensive. When selecting the goods, the average consumer is likely to consider such things as the origin of the goods, the age of the goods, size, flavour, use by/best before dates and alcoholic content. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the goods. I consider this to be the case even where the goods are on the more expensive end of the scale.

Class 40 services

65. The average consumer of the class 40 services at issue is likely to be a business user looking to obtain distilling services for the creation of their own alcoholic beverages. I am of the view that these services will be offered directly by the provider and the user will select them having had discussions with the provider and possibly having visited the distillery for a tour of the premises. As a result, I consider that the services will be selected via visual and aural means. The average consumer is likely to have a number of considerations such as the expertise of those involved in the production of the beverages and the processes and equipment used. I am of the view that the level of attention paid will be reasonably high (but not the highest) on the basis that the selection is likely to have an impact on the taste of their products and is, therefore, likely to impact upon the success of the product and, consequently, the user's business.

Distinctive character of the opponent's mark

66. 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)."

67. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it. In its notice of opposition, the opponent stated that it "will claim the benefit of enhanced distinctive character for its trade mark arising through its repute in the UK". While its submissions go on to refer to an enhanced degree of distinctive character for the services relied upon, it has filed evidence in respect of use for alcoholic beverages. Given the approach I have taken in respect of the 5(2)(b) ground, I will consider whether the opponent's use of these goods is sufficient to enhance its distinctive character in relation to them. I also have evidence and submissions from the applicant that appear to argue that the distinctiveness of the opponent's mark

is diluted due to the fact that 'MORRISON' is a common name and is used as a company or trade name for a wide-range of companies in the UK. In respect of the latter argument, I have addressed this in detail at paragraphs 18 to 22 above. To reiterate, I do not consider this argument to be of any assistance to the applicant. Before moving to consider whether or not there is enhanced distinctiveness through use, I will consider the inherent position.

68. Firstly, I accept that 'MORRISON' is a popular name across the UK. Having said that, I do not consider it to be one that is very common. The applicant has submitted that any distinctiveness provided to the opponent's mark lies in the fact that it is presented in the plural, being 'MORRISONS' and that this is highly unusual and grammatically incorrect. While I am of the view that the applicant is correct in that, as a popular surname, 'MORRISON' is not particularly distinctive, I do not agree that any distinctiveness lies in the use of the name in the plural. This is on the basis that the average consumer is unlikely to give any significant consideration to this or to the lack of an apostrophe to indicate it is a business owned by a person named Morrison. Further, I consider it to be common in the trade for undertakings that produce alcoholic beverages to brand their products with names of people. I am of the view that the average consumer will be aware of this. Taking all of this into account, I find that the inherent distinctive character of the opponent's mark is low. I will now consider the position in respect of the opponent's claim that its mark has obtained an enhanced level of distinctiveness through use.

69. For the avoidance of doubt, my findings above do not mean that an undertaking using a popular name for its business cannot acquire a higher level of distinctiveness through use.

70. Given that the only goods at issue in the opponent's specification are "alcoholic beverages (except beers)", I must consider any enhanced distinctiveness through use in respect of those goods only. I have no evidence or submissions as to the size of the market for alcoholic beverages in the UK. In the absence of such, I am of the view that the market is a large one with an annual turnover in the region of billions of pounds. I have summarised the evidence in respect of the use for these

goods in full at paragraphs 37 to 46 above. I am of the view that the figures provided are substantial and, despite only being accrued over approximately 15 months, there is evidence of more longstanding use in the presence of awards from 2016 onwards. The sales figures of £45,381,670 over a 15 month period are undoubtedly significant and while they are not necessarily high when compared to the market at issue, they do represent a substantial volume of sales in what is a very competitive market which consists of a vast number of businesses in operation. Overall, I do not consider that the evidence points to an enhancement of the distinctiveness character to a high degree, however, I am satisfied that it is sufficient to enhance the distinctiveness to a medium degree.

Comparison of the marks

71. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

72. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

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

73. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the

marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

74. The respective trade marks are shown below:

The opponent's mark	The applicant's mark
MORRISONS	MORRISON SCOTCH WHISKY DISTILLERS LTD

75. As has been the case throughout this decision, both parties have filed submissions in respect of the comparison of the marks. While I do not intend to reproduce those in full, I can confirm that I have considered them in full.

Overall Impression

The applicant's mark

76. The applicant's mark is a word only mark being 'MORRISON SCOTCH WHISKY DISTILLERS LTD'. For reasons I will come to discuss later in this decision, I am of the view that it is the word 'MORRISON' that dominates the overall impression of the mark with the remaining words playing a lesser role.

The opponent's mark

77. The opponent's mark is also a word only mark consisting solely of the word 'MORRISONS'. There are no other elements that contribute to the overall impression of the mark that lies in the word itself.

Visual Comparison

78. The marks are visually similar to the extent that they both consist of the word 'MORRISON', albeit with the applicant's mark being in the singular and the

opponent's mark in the plural. The marks differ further in the presence of the words 'SCOTCH WHISKY DISTILLERS LTD' in the applicant's mark which have no counterpart in the opponent's mark. Despite my comments in respect of the role these words play in the applicant's mark, they still constitute a visual difference. Taking into account all of the above together with the fact that the similarity between the marks lies in their beginnings, being where the average consumer tends to focus,[16] I am of the view that these marks are similar to a medium degree.

Aural Comparison

79. A case can be made that the applicant's whole mark will not be pronounced on the basis that it consists of a number of descriptive words after the word 'MORRISON'. However, despite this, I am of the view that they will be pronounced. On this point, I refer to the case of *Purity Hemp Company Improving Life as Nature Intended*[17] wherein Mr Phillip Harris, sitting as the Appointed Person, stated that descriptiveness does not of itself render an element negligible or aurally invisible. As a result, the applicant's mark will consist of 12 syllables that will be pronounced in the ordinary way. As for the opponent's mark, this will consist of three syllables, again, pronounced in the ordinary way. The first three syllables of the applicant's mark are almost identical with the entire aural element of the opponent's mark, with the only difference coming in the pronunciation of the letter 'S'. The additional words in the applicant's mark make for a much longer mark, however, bearing in mind their lesser role in the applicant's mark and the identity of the beginning marks, being where the average consumer tends to focus, I am of the view that the marks are aurally similar to a medium degree.

Conceptual Comparison

80. I have already addressed and accepted the submissions from the applicant that 'MORRISON' is a popular name across the UK. In the opponent's mark, I am of the view that the average consumer will either understand it as 'MORRISON' in the

[16] *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02
[17] Case BL O/115/22

plural, indicating the presence of a number of people with the name 'MORRISON' or as a possessive noun, in that it is a business belonging to someone with that name. I make the latter finding even taking into account that there is no apostrophe on the basis that the average consumer is likely to overlook this point. In any event, the name 'MORRISON' will be the dominant concept. Turning to the applicant's mark, the meaning of 'MORRISON' will be the same as above. While the additional words of the applicant's mark are noted, it will still be dominated by the name 'MORRISON' on the basis that those additional words will be understood as a reference to a limited company owned by someone with the name 'Morrison' that offers Scotch whisky and/or operates a distillery for making Scotch whisky. On the point of concepts of surnames, I refer to the case of *Luciano Sandrone v EUIPO*[18] wherein the GC stated that:

> "85. […] a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.
>
> 86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.
>
> 87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM— McKenzie (McKENZIE)*, T502/07, not published, EU: T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM— Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July

[18] Case T-268/18

2018, *ANTONIO RUBINI, T707/16*, not published, EU:T:2018:424, paragraph 65)."

81. Following the findings of the GC, I do not consider it possible to make a conceptual comparison in respect of the name 'MORRISON' on the basis that it is not a surname that is particularly well known as the name of a famous person. While I note the applicant's position that the Morrison family is famous in the production of Scotch Whisky, I am of the view that, regardless of whether the evidence shows this or not, I do not consider this to constitute it being the name 'of a famous person'. Taking this into account, I am view that the 'MORRISON'/'MORRISONS' element is conceptually neutral across both marks. However, the additional elements in the applicant's mark, which have no counterpart in the opponent's mark, result in the marks as wholes being conceptually dissimilar.

Likelihood of confusion

82. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and 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.

83. I have found the applicant's goods and services to be either identical or similar to a medium degree with the opponent's goods. I have found the average consumer for the goods and services to be either members of the general public over the age of 18 or business users. The goods will be selected through primarily visual means, although I do not discount an aural component. However, the services will be selected through both visual and aural means. I have concluded that the average consumer will pay a medium degree of attention when selecting the goods and a reasonably high (but not the highest) degree of attention when selecting the services. I have found that the opponent's mark is inherently distinctive to a low degree but that this has been enhanced through use to a medium degree. I have found the applicant's mark to be visually and aurally similar to a medium degree and conceptually dissimilar with the 'MORRISON'/'MORRISONS' element being conceptually neutral.

84. Taking all of the above factors and the principle of imperfect recollection into account, I consider that the average consumer would mistakenly recall or misremember the marks for one another. This is particularly the case given the fact that both parties' marks are dominated by the highly similar words 'MORRISON'/'MORRISONS'. When confronted by both marks, I consider it likely that the average consumer will imperfectly recollect which mark consisted of the word 'MORRISON' in the singular or in the plural. This is particularly the case given the level of distinctiveness that I have found to be attributable to the use of the opponent's mark. Further, while I consider that the additional words in the applicant's mark will contribute to the differences between the marks, I am of the view that, due to their lessened roles, they will be forgotten or misremembered by the average consumer, particularly given their descriptive nature. I do not consider that the different elements will be sufficient to overcome the shared use of 'MORRISON' (be that singular or plural), being the dominant element of the marks. I make this finding even taking into account the conceptually neutral position of the common element and the conceptual dissimilarity of the marks as wholes. Consequently, I consider there to be a likelihood of direct confusion between the marks. I make this finding even in circumstances on the services that are similar to a medium degree and where the average consumer pays a reasonably high degree

of attention. This is on the basis of the descriptive nature of the differences and the dominance of the highly similar common element. In the event that I am wrong to find direct confusion between the marks, I will proceed to consider indirect confusion.

85. Indirect confusion involves recognition by the average consumer of the differences between the marks. However, even if the differences between the marks are noticed, I consider that the reference to 'MORRISON' in the singular (in the applicant's mark) and the plural (in the opponent's mark) will be overlooked or misremembered by the average consumer. I have found the word 'MORRISON' (whether in the singular or plural) to be the dominant element of the parties' marks. As a result, I am of the view that the differences between the marks, being the descriptive words 'SCOTCH WHISKY DISTILLERS LTD' will be seen by the average consumer as indicators of alternative marks from the same or economically linked undertakings.[19] For example, the average consumer, when confronted by both marks, will view the applicant's mark as a sub-brand of the opponent's alcoholic beverage business that focuses on offering distillery services. Alternatively, the differences may be seen by the average consumers as consistent with a logical rebranding. For example, when confronted by the brand 'MORRISONS', and overlooking the use of singular/plural, the average consumer may consider the removal of 'SCOTCH WHISKY DISTILLERS LTD' to be a logical step an undertaking may take to re-brand itself. In my view, this is particularly the case considering the length of those additional elements with their removal likely being considered an attempt to streamline the mark. Consequently, I consider there to be a likelihood of indirect confusion between the marks. As above, I make this finding in respect of those services that are similar to a medium degree and in circumstances where the average consumer may pay a higher degree of attention.

86. As a result of my findings above, the opposition under section 5(2)(b) succeeds in full. I will now proceed to consider the remaining grounds of the opposition.

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

Section 5(3)

87. Section 5(3) of the Act states:

> "5(3) A trade mark which –
>
> is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark."

88. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors,* Case 252/07, *Intel,* Case C-408/01, *Adidas-Salomon,* Case C-487/07, *L'Oreal v Bellure,* Case C-323/09, *Marks and Spencer v Interflora,* Case C383/12P, *Environmental Manufacturing LLP v OHIM.* The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors, paragraph 24.*

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; G*eneral Motors, paragraph 26.*

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Salomon, paragraph 29* and *Intel, paragraph 63.*

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks

and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68;* whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79.*

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* and *Environmental Manufacturing, paragraph 34.*

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74.*

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial

compensation, the marketing effort expended by the holder of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora, paragraph 74 and the court's answer to question 1 in L'Oreal v Bellure).*

89. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of its earlier marks being brought to mind by the applicant's later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

90. The relevant date for the assessment under section 5(3) is the date of the application at issue, being 10 April 2020.

Reputation

91. In *General Motors,* Case C-375/97, the CJEU held that:

"25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it."

92. In its notice of opposition, the opponent claimed that its marks have a reputation in respect of the goods and services listed at paragraph two above. At this point, I consider it necessary to point out that I will proceed to consider the 5(3) ground based on the claimed reputation in respect of "retail services", being a term relied upon in the opponent's first mark only. If the opponent's reliance upon any reputation in retail services fails, I will return to consider this ground in respect of the retail services in respect of alcoholic beverages and of the alcoholic beverage goods themselves, being the other terms relied upon in the opponent's second, third and fourth marks. For the remaining assessment under this ground, I will refer to the opponent's first mark as the opponent's mark.

93. The opponent's mark is an EUTM meaning that the relevant territory is the European Community and the trade mark must have a reputation in a substantial part of that territory. On this point, I bear in mind that a territory of a Member State of the EU may be considered a substantial part of the territory of the Community[20] and that the UK can, therefore, be regarded as a substantial part of the Community with or without the addition of evidence of reputation in other territories.[21]

[20] *Pago International GmbH v Tirolmilch registrierte GmbH*, Case C-301/07
[21] *Whirlpool Corporations and others v Kenwood Limited* [2009] ETMR 5 (HC)

94. The opponent's evidence sets out the history of the opponent's business in that it was founded in 1899 and incorporated as a Public Limited Company in 1967. Since incorporation, the opponent claims to have grown significantly. The opponent currently operates from just under 500 stores as well as offering an online home delivery service and sells mainly food, beverages, domestic goods and clothing to around 9 million customers a week in the UK. On the point of stores, I note that a print-out is provided showing all current (as at the date of the witness statement, being some 15 months after the relevant date) stores operated by the opponent and I note that this listed 641 stores.[22] The opponent has provided a number of photos of its store fronts showing how the brand 'MORRISONS' is displayed.[23] Despite slightly different uses shown in these photos (and throughout the remainder of the evidence for that matter), any reputation accrued by these forms is attributable to the 'MORRISONS' brand and, therefore, vests in the opponent. I make this finding given the fact that the word 'MORRISONS' still dominates the uses shown in the evidence. At this point, it is necessary to point out that the evidence indicates that its supermarket business is its core business.

95. In discussing its current position in the market, the opponent sets out that it is the fourth largest supermarket chain in the UK and holds a 10% share of the UK grocery market. A print-out from statista.com showing the market share of grocery stores in Great Britain from January 2017 to May 2021.[24] While I have no explanation as to what 'Statista' is, it is my understanding that it is a website that provides information and data relating to markets and consumer data and I have no reason to disbelieve it as an accurate reflection of the market.

96. The opponent goes on to discuss its annual turnover figures from 2014 to 2021 in respect of its business as a whole. I note that these figures are broken down into financial years, which appear to begin on 1 February of one year and end on 31 January of the next. The figures are as follows:

[22] Exhibit JM4 of the Witness Statement of John William Morris
[23] Exhibit JM5 of *ibid*
[24] Exhibit JM6 of *ibid*

a. £16,816,000,000 for the financial year ending 31 January 2015;
b. £16,122,000,000 for the financial year ending 31 January 2016;
c. £16,317,000,000 for the financial year ending 31 January 2017;
d. £17,262,000,000 for the financial year ending 31 January 2018;
e. £17,735,000,000 for the financial year ending 31 January 2019;
f. £17,536,000,000 for the financial year ending 31 January 2020; and
g. £17,598,000,000 for the financial year ending 31 January 2021.

I note that these figures are supported by print-outs of the opponent's annual report.[25] Further, given that the relevant date is 10 April 2020, I appreciate that some of the figures from the year ending 31 January 2021 will inevitably fall after that.

97. In respect of advertising, the opponent confirms that it spends many millions of pounds on promoting its goods and services and this includes £35 million a year on media advertising and a further £12 million a year on point-of-sale investments. While the above is noted, there is no yearly breakdown of advertising/promotion expenditure meaning that I am unable to precisely determine the expenditure over the years leading up to the relevant date. However, there is supporting evidence to suggest that such promotional activities have been ongoing for many years. Of this evidence I note the following:

a. the opponent has actively promoted its products and services via its own website since 2004;
b. the opponent launched its own 'Morrisons Magazine' in 2013, which then was replaced by 'Morrisons Price News' in 2015;[26]
c. a loyalty card launched in 2014 that was signed up for by over 2 million users within the first four weeks of its launch and, as at the date of the statement, there was 10.8 million users, although I bear in mind that the statement is some 15 months after the relevant date;[27]

[25] Exhibit JM7 of *ibid*
[26] Exhibit JM15 of *ibid*
[27] Exhibit JM17 of *ibid*

d. various YouTube advertising videos that were posted to the website in 2018;[28]
e. sponsorship on the television shows 'Britain's Got Talent' and 'Saturday Night Takeaway' in 2013.[29] While I have no evidence as to the viewership of these programmes, I do not consider it to be a subject of serious debate to suggest that these shows are popular mainstream television shows within the UK;[30]
f. press coverage showing the opponent's business in articles across various UK-wide publications, namely The Guardian, BBC.co.uk and The Grocer.[31] In addition, there is additional evidence regarding the opponent's 'Let's Grow' campaign in The Guardian.[32]

98. On balance of the evidence discussed above, I am content to conclude that while the exact expenditure it not provided, it is clear that the opponent has invested a significant amount of money in the years prior to the relevant date in promoting its brand.

99. I have no submissions as to the size of the relevant market at issue. In light of the evidence of the market via the statista.com print-out (showing that the opponent owns a 10% market share) and bearing in mind the opponent's annual turnover, I am content to conclude that the market at issue is a very large one with a turnover in the hundreds of billions of pounds per annum. Even given the size of the market, I am of the view that the evidence provided by the opponent is substantial. The evidence of turnover is extremely high in the total of tens of billions of pounds per annum. Further, the evidence pointing to the fact that the opponent's is the fourth largest supermarket chain the UK with a market share of 10% between 2017 and 2021 (albeit the latter date being after the relevant date) is significant, particularly given the competitive nature of the market at issue. In my view, the evidence points to the operation of a very large business within the UK, particularly given its ranking as the fourth largest supermarket in the UK. While I note that the evidence does not show turnover figures prior to 2014, it does set out that the retail services have been provided for a significant amount of time (1899 at the earliest). I am content

[28] Exhibit JM18 of *ibid*
[29] Exhibit JM19 of *ibid*
[30] *Chorkee Ltd v Cherokee Inc.,* Case BL O/048/08
[31] Exhibit JM21 of the Witness Statement of John William Morris
[32] Exhibit JM22 of *ibid*

to conclude that the large turnover figures from 2014 would not have occurred overnight and demonstrate the existence of a significant ongoing business prior to that date. While the advertising expenditure evidence is not precise, the supporting evidence of ongoing advertising and promotional efforts support the position that the opponent has incurred significant expenditure over the years prior to the relevant date. Lastly, it is clear from such a large annual turnover, the existence of approximately 500 (or 641, depending on the evidence) stores and presence in advertising on popular television shows and coverage in UK-wide publications that the opponent has operated its business across the entirety of the UK. Overall, I am content to conclude that the opponent has demonstrated that its mark has acquired a very strong reputation amongst the significant public in the UK.

100. While the opponent's claim is for "retail services" at large, I consider that, given the broad nature of the term, this includes retail of goods that the opponent has provided no evidence for. Given that the opponent's evidence points towards its core business being that of a supermarket, I am of the view that it is appropriate for the reputation to be limited accordingly. Therefore, I am of the view that the very strong reputation alluded to above is limited to "supermarket retail services".

Link

101. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks.

102. I have found the applicant's mark to be visually, aurally and conceptually similar to a medium degree with the opponent's second mark. Given the identity between the opponent's second mark and its mark at issue here, the same findings apply.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.

103. As above, the opponent has demonstrated a reputation in "supermarket retail services". I am of the view that there is a degree of similarity between these services and the applicant's goods in class 33, being "Scotch whisky and Scotch whisky based drinks, all being produced in Scotland". This is on the basis that supermarkets commonly retail in alcoholic beverages, which includes Scotch whisky and Scotch whisky based drinks. On this point, I refer to the case of *Oakley, Inc v OHIM*,[33] wherein the GC set out that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore, similar to a degree. I do not consider it a topic of serious dispute to conclude that it is common for a supermarket retailer to also provide its own branded alcoholic beverages. On this point, I have found above that the opponent itself sells its own branded alcoholic beverages and the average consumer will be aware of the complementary relationship between a creator of an alcoholic beverage and the retailing of such goods. In my view, it follows that a medium degree of similarity exists between these goods and services.

104. As for the applicant's class 40 services, being "distilling services" and "information, advisory and consultancy services relating to the same", I consider that they differ in nature, method of use, purpose and trade channels with the opponent's "supermarket retail services". While I consider that there is an overlap in user on the basis that the average consumer for the opponent's service is the general public at large and will, therefore, include users of the applicant's service, this is not sufficient to give rise to a finding of similarity between them. The services are, therefore, dissimilar. However, given that the average consumer for the opponent's services covers members of the general public at large, the relevant publics are not completely distinct.

The strength of the earlier mark's reputation

105. The opponent's second mark has a very strong reputation in the UK.

[33] Case T-116/06

The degree of the earlier mark's distinctive character, whether inherent or acquired through use

106. I have found above that the inherent distinctive character of the opponent's mark is low. While I have found this to be enhanced through use to a medium degree, this finding related to "alcoholic beverages (except beers)". However, I have not considered the position in respect of "supermarket retail services", I have discussed the evidence regarding this service in detail above and do not intend to repeat it again here save as to say that the use shown is significant enough to prove a very strong reputation across the UK. I see no reason to deviate from that finding here when considering enhanced distinctiveness, particularly given the strength of the evidence in respect of turnover, promotional activities and market share. I am of the view that the evidence filed is sufficient to show that the opponent has enhanced the distinctive character of its mark through use to a high degree. In addition, I am of the view that the evidence shows that the opponent's mark strongly identifies the services with a single undertaking.

Whether there is a likelihood of confusion

107. I have found there to be a likelihood of confusion between the marks in respect of the opponent's "alcoholic beverages (except beers)". However, I have not made an assessment based on the opponent's "supermarket retail services". Given the level of similarity between the opponent's service and the applicant's class 33 goods, the enhanced distinctive character of the opponent's mark, the levels of similarities between the marks and the presence of the common element (albeit one in the singular and the other in the plural), I am of the view that there is a likelihood of confusion between the marks in respect of those goods. For these goods, I consider that a significant part of the relevant public will make a link between the parties' marks.

108. Turning now to consider the applicant's class 40 services, I have found these services to be dissimilar with the opponent's service. Therefore, despite the levels of similarity between the marks and the distinctive character of the opponent's mark, there is no likelihood of confusion between the marks. Notwithstanding this, it is my view that, even considering the fact that the word 'MORRISON' is presented in the singular in the applicant's mark but plural in the opponent, a significant part of the relevant public will make a link between the marks in relation to dissimilar services. I make this finding whilst taking all the above factors into account, particularly the distinctiveness of the opponent's mark that has been enhanced through use to a high degree, the strength of the reputation of the opponent's 'MORRISONS' brand and the shared use of the word 'MORRISON' (be it singular or plural). I have reached this conclusion on the basis that, despite being dissimilar, there is a degree of overlap between the relevant public.

Damage

109. The opponent has pleaded that use of the applicant's mark would take unfair advantage of the reputation of the opponent's mark, that it would, without due cause, prove to be detrimental to the reputation of the opponent and the distinctive character of the opponent's mark. I will deal with each head of damage in turn below.

Unfair Advantage

110. I bear in mind that unfair advantage has no effect on the consumers of the opponent's mark's goods and services. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. considered the earlier case law and concluded that:

> "80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant's intention. It is clear both from the wording of Article 5(2) of the Directive and Article 9(1)(c) of the Regulation and from the case law of the Court of Justice

interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

111. It is my view that it is quite clear that there is potential for the applicant to gain an unfair advantage by using the mark 'MORRISON SCOTCH WHISKY DISTILLERS LTD'. The applicant, by using the highly similar prefix 'MORRISON' (being the element that plays the greater role in the applicant's mark), would achieve instant familiarity in the eyes of the average consumers. This is particularly the case given the opponent's mark's very strong reputation and high level of distinctiveness through use together with the levels of similarity between the marks (especially their dominant elements). I consider that these factors would result in people connecting the applicant's mark with the opponent's brand. In my view, this results in the applicant securing a commercial advantage, benefitting from the opponent's reputation without paying financial compensation. Such commercial advantage would not exist were it not for the reputation of the opponent's mark. Therefore, I find it likely that the applicant's mark takes unfair advantage of the opponent's mark.

112. As damage is made out on the basis of unfair advantage, I do not consider it necessary to go on to consider the opponent's other heads of damage. However, given that I have found unfair advantage and on the basis that it was pleaded as a defence by the defence, it is necessary to now consider due cause.

Due cause

113. As above, the applicant has raised the defence of due cause. Of this I note that, in its counterstatement, the applicant submits that as a result of the Morrison family continuously trading as whisky brokerage and distillers with different companies incorporating the name 'MORRISON', the applicant has due cause to file and use the mark subject to this opposition. In raising a due cause defence, the onus is on the applicant using a sign similar to the mark with a reputation to establish that it has due cause for using such a sign.[34] In *Leidseplein Beheer BV v Red Bull,* Case C-65/12, the CJEU held that:

> "60. Consequently, it follows from all of the foregoing considerations that the answer to the question referred is that Article 5(2) of Directive 89/104 must be interpreted as meaning that the proprietor of a trade mark with a reputation may be obliged, pursuant to the concept of 'due cause' within the meaning of that provision, to tolerate the use by a third party of a sign similar to that mark in relation to a product which is identical to that for which that mark was registered, if it is demonstrated that that sign was being used before that mark was filed and that the use of that sign in relation to the identical product is in good faith. In order to determine whether that is so, the national court must take account, in particular, of:
>
> – how that sign has been accepted by, and what its reputation is with, the relevant public;
>
> – the degree of proximity between the goods and services for which that sign was originally used and the product for which the mark with a reputation was registered; and
>
> – the economic and commercial significance of the use for that product of the sign which is similar to that mark."

[34] *Leidseplein Beheer BV v Red Bull,* Case C-65/12

114. While the evidence of the Morrison family businesses is noted, I am not convinced that it is sufficient to give rise to a reputation of the name 'MORRISON' for the goods and services at issue. While I accept that the individuals involved with the applicant's business have the name Morrison, this does not give them an automatic right to apply for the mark at issue. Further, the evidence does not point to any use that is capable of giving rise to a reputation. This is particularly the case given that the applicant only appears to have been operating under its current name since 17 August 2020[35] (being after the relevant date). On this point, the applicant's company appears to have operated under different business names. For example, I note that the evidence refers to the names 'John Murray and Son (Mull) Limited' from 1982 to 2005, 'The Scottish Liqueur Centre Limited' until 2014, 'Morrison & MacKay Limited' until 2020. While the latter business name includes Morrison, it does not, in my view, give rise to due cause to file the mark at issue.

115. I note that the applicant has filed press articles relating to the presence of the Morrison family in the trade.[36] While these articles are noted, a number of them are dated after the relevant date and are not capable of indicating a reputation as at the relevant date. Further, there is no indication of the readership for these websites and, save for an article from 'The Herald Scotland' and a website that refers to a fundraiser in London, there is no indication that the websites are UK based or aimed. All websites are '.com' websites. On this point I note that one article refers to the Japanese and US markets.[37]

116. The evidence also refers to related individuals to those operating the applicant's business in that it refers to companies such as 'Stanley P. Morrison Limited' which became 'Morrison Bowmore Distillers Limited' and was ultimately sold to 'Beam Suntory' in 1994.[38] There is also a reference to another family member operating 'Morrison Glasgow Distillers Limited'.[39] Firstly, these are different companies than the applicant's and I do not consider this to be of any assistance to the applicant's

[35] Exhibit JM1 of the Witness Statement of Jamie Walker Stanley Pringle Morrison
[36] Exhibit JM3 of *ibid*
[37] Pages 22 to 25 at Exhibit JM3 of *ibid*
[38] Paragraph 4 of *ibid*
[39] Paragraph 5 of *ibid*

due cause argument as it does not relate to its own use but that of third parties. Secondly, there is no evidence of use for these marks.

117. Lastly, I consider it necessary to address the applicant's evidence of use via sales of whisky and operations of a distillery. The main issue with this evidence in that it relates to goods that do not appear to have been provided for under the applicant's mark. Instead, the evidence shows use of the brand name 'CARN MOR'. For example, I note that the applicant has provided evidence of turnover from 2015 onwards under its "CARN MOR brand".[40] There is also reference to sub-brands of 'CARN MOR', being 'CARN MOR Celebration of Casks' and 'CARN MOR Strictly Limited'. Further, I note that there are references to whisky brands named 'OLD PERTH',[41] Paul's Dram,[42] BOWMORE[43] and Rattray's[44] and a distillery named 'ABERARGIE Distillery'.[45]

118. Having reviewed the evidence, there is nothing prior to the date of the application at issue that shows any use of the applicant's mark that is capable of giving rise to a defence of due cause. In light of this, and given my findings in respect of unfair advantage above, the opponent's claim under its 5(3) ground succeeds in full. I do not consider it necessary to return to consider the reputation of the opponent's marks in respect of the class 33 goods or the more specific alcoholic retail services. I will, instead, move to consider the opponent's 5(4)(a) ground.

Section 5(4)(a)

119. Section 5(4)(a) of the Act reads as follows:

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

[40] Paragraph 13 of *ibid*
[41] Paragraph 8 of *ibid*
[42] Page 42 at Exhibit JM3 of *ibid*
[43] Page 44 at Exhibit JM3 of *ibid*
[44] Page 48 at Exhibit JM3 of *ibid*
[45] Exhibit JM9 of *ibid*

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

(aa) …..

(b) …..

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

120. Subsection (4A) of Section 5 states:

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

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

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

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

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

122. Halsbury's Laws of England Vol. 97A (2021 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 636 it is noted (with footnotes omitted) that:

"Establishing a likelihood of deception generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive indicium used by the claimant has acquired a reputation[1] among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other indicium which is the same or sufficiently similar that the defendant's goods or business are from the same source[2] or are connected.

While it is helpful to think of these two factual elements as two successive hurdles which the claimant must surmount, consideration of these two aspects cannot be completely separated from each other.

The question whether deception is likely is one for the court, which will have regard to:

(a) the nature and extent of the reputation relied upon,

(b) the closeness or otherwise of the respective fields of activity in which the claimant and the defendant carry on business;

(c) the similarity of the mark, name etc used by the defendant to that of the claimant;

(d) the manner in which the defendant makes use of the name, mark etc complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action."

Relevant Date

123. In *Advanced Perimeter Systems Limited v Multisys Computers Limited,* BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar's assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

"43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

'Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.' "

124. The applicant's mark does not have a priority date. I have given consideration as to whether any of the evidence filed by the applicant is capable of being

considered as being the start of the behaviour complained about. However, I have set out at paragraphs 114 to 117 above that the evidence of use filed by the applicant does not point towards use of the applicant's mark but, instead, other brand names such as 'CARN MOR', 'OLD PERTH', 'Paul's Dram', 'BOWMORE', 'Rattray's' and 'ABERAGIE DISTILLERY'. It is, therefore, not capable of being the start of the behaviour complained about. This means that the relevant date for assessment of the opponent's claim under section 5(4)(a) of the Act is the date of the application for registration, being 10 April 2020.

Goodwill

125. I am of the view that the opponent's best case under its 5(4)(a) claim is in relation to its claim that its first unregistered sign has obtained goodwill in "alcoholic beverages, wines and spirits". The reason for this is that while it has claimed goodwill in retail services relating to those beverages also, I am of the view that it is the potential goodwill in the beverages that is the closer field of activity to the applicant's applied for goods and services. It is my view that while I have found retail services and distillery services to have a degree of closeness in that they share a relevant public, the services operate in different fields of business and this is a factor (as I will discuss below) that works against the opponent's 5(4)(a) claim in respect of goodwill in its "retail services of food and drinks, alcoholic beverages, wines and spirits."

126. The first hurdle for the opponent is that it needs to show that it had the necessary goodwill in the sign 'MORRISONS' at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co's Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

> "What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start."

127. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

> "27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent that the enquiry under s.11 of the 1938 Act (see Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.
>
> 28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur."

128. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

> "[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie,

that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application."

129. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) stated that:

"62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by *s.2(2) of the Trade Marks Act 1994*. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in *BALI Trade Mark [1969] R.P.C. 472*. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used "but had not acquired any significant reputation" (the trial judge's finding). Again that shows one is looking for more than a minimal reputation."

130. Goodwill arises as a result of trading activities. In undertaking my assessment of the opponent's 5(2)(b) claim, I provided a detailed summary of the opponent's evidence in respect of its goods, being "alcoholic beverages (except beers)". While the assessment under the opponent's 5(4)(a) claim is for "alcoholic beverages, wines and spirits", the same detailed summary is applicable here. I do not intend to repeat the summary of the evidence again here save as to say that the opponent appears to have been selling its own branded alcoholic beverages since at least 2016 and between the beginning of 2019 and 18 March 2020, the opponent sold 4,739,858 units of its own branded spirits for a total sales figure of £45,381,670. This included 662,669 units of whisky for a total sales figure of £6,299,846. In

addition, the opponent incurs a year advertising expenditure of £5 million (although I am aware that this figure also includes promotion of brands other than its own).

131. I remind myself that, when assessing goodwill, absent an agreement to the contrary, the goodwill of a business is owned by the undertaking that the customers perceive as being responsible for the trade.[46] While I have addressed the issue raised by the applicant in respect of the origin of the products shown in the evidence at paragraphs 34 to 36 above, I will say here that I am of the view that upon purchasing the alcoholic beverages provided for in the opponent's evidence, the customer would see the opponent as being responsible for the goods themselves. Therefore, I am content to conclude that any goodwill attributable to these trading activities would vest in the opponent.

132. Based on the evidence of turnover and advertising expenditure provided, I am content to conclude that the opponent has demonstrated that it had a protectable goodwill at the relevant date. Given that the majority of the evidence relates to spirits, I consider it appropriate to limit the goodwill to "spirits" only on the basis that it fairly describes the use shown. While I note that I have found the evidence to be sufficient to show genuine use for "alcoholic beverages" at large, it is not necessary to expand the scope of the 5(4)(a) claim to those goods. This is on the basis that the evidence is more than sufficient to demonstrate a goodwill in "spirits" only, being a more specific term upon which the opponent relies under its 5(4)(a) claim.

133. Overall, I am prepared to accept that the opponent has a fairly strong degree of goodwill in the UK in relation to "spirits". I am satisfied that the opponent's sign relied upon was distinctive of that goodwill at the relevant date.

Misrepresentation and damage

134. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

[46] *MedGen v Passion For Life* [2001] FSR 30

> "There is no dispute as to what the correct legal principle is. As stated by Lord Oliver of Aylmerton in *Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is
>
> > "is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]"
>
> The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd*. (1941) 58 R.P.C. 147 at page 175; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101."

And later in the same judgment:

> ".... for my part, I think that references, in this context, to "more than *de minimis*" and "above a trivial level" are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion."

135. I recognise that it is not essential under the law of passing off for the parties to be engaged in the same fields of business activity (see *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA)). Taking this into account together with the closeness of the parties' respective fields, in that they operate in the same alcoholic beverage sector (albeit one provides both the goods themselves and the service of distilling them whereas the other only provides the goods), and the fairly strong level of goodwill in the opponent's business, I am of the view that a

substantial number of members of the public are likely to be misled into purchasing the applicant's goods and services in the mistaken belief that they are the goods and services of the opponent. I make this finding in respect of all of the goods and services in the applicant's specification and also whilst bearing in mind that the marks share a highly similar common element ('MORRISON'/'MORRISONS' – being each marks' dominant element) and the descriptive nature of the additional words in the applicant's mark.

136. Given that I have found that there is a misrepresentation in respect of all of the applicant's goods and services, I consider that damage through diversion of sales is easily foreseeable. The opposition based upon section 5(4)(a) is, therefore, successful.

Honest Concurrent Use

137. I note that the applicant's evidence refers to historic sales of its own branded whisky. The applicant has not expressly pleaded honest concurrent use as a defence, and that would, in my view, be sufficient reason to dismiss the claims. Nevertheless, I will give my brief views for the sake of completeness.

138. While honest concurrent use is a defence that is capable of being used in both 5(2)(b) and 5(4)(a) oppositions, the evidence provided by the applicant (being the evidence that I have summarised at paragraphs 114 to 117 above) refers to the brands 'CARN MOR', 'OLD PERTH', 'Paul's Dram', 'BOWMORE', 'Rattray's' and 'ABERAGIE DISTILLERY' and not the applicant's mark. While there may have been a level of sales of these brands of Scotch whisky and use of the distillery services over a number of years, it is not use that would be capable of being considered as giving rise to a defence of honest concurrent use. This is because such a defence can only be raised where two separate entities have co-existed for a long period, honestly using the same or closely similar name.[47] The uses of

[47] *Victoria Plum Ltd v Victorian Plumbing Ltd* [2016] EWHC 2911 (Ch)

‘CARN MOR’, ‘OLD PERTH’ and ‘ABERARGIE’ are in no way the same or closely similar name to ‘MORRISONS’.

139. Further, when considering due cause, I noted that the applicant only changed its name to its current form after the relevant date so while there is evidence referring to the historic existence of the applicant, this is not use of the applicant’s mark. The applicant’s business has gone through several name changes, namely ‘John Murray and Son (Mull) Limited’, ‘The Scottish Liqueur Centre Limited’ and ‘Morrison & MacKay Limited’. I do not consider that any historic use of these names is capable of giving rise to a defence of honest concurrent use on the basis that they are not the same (or even closely similar, for that matter) to the opponent’s mark. On this point, I note that the applicant’s best case lies in the name, ‘Morrison & MacKay Limited’. However, this includes the additional distinctive element of ‘MacKay’ that distances it from the opponent’s mark to the point that it is not closely similar and therefore, not capable of giving rise to a defence of honest concurrent use.

140. My view is that the evidence is not capable of establishing that there has been parallel trade under the applicant’s mark that resulted in the average consumer being accustomed to distinguishing between the entities. I am not satisfied that the likelihood of confusion under the 5(2)(b) ground or misrepresentation under the 5(4)(a) ground would be avoided because of honest concurrent use.

CONCLUSION

141. The opposition succeeds in full and, as a result, the application is refused in its entirety.

COSTS

142. 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. In the

circumstances, I award the opponent the sum of **£1,500** as a contribution towards its costs. The sum is calculated as follows:

Preparing a notice of opposition and considering the applicant's counter statement:	£200
Preparing evidence and considering applicant's evidence:	£800
Preparing submissions in lieu of a hearing:	£300
Official Fees:	£200
Total	**£1,500**

143. I therefore order Morrison Scotch Whisky Distillers Limited to pay WM Morrison Supermarkets PLC the sum of £1,500. 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 31st day of May 2022

A COOPER
For the Registrar