

**O/505/22**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF INTERNATIONAL REGISTRATION NO. WO0000001413693**

**DESIGNATING THE UK**

**IN THE NAME OF AMBER BEVERAGE GROUP, SIA**

**FOR THE MARK**

**CROSS KEYS GIN**

**IN CLASS 33**

**AND**

**AN APPLICATION FOR A DECLARATION OF INVALIDITY**

**UNDER NO. 503702**

**BY VINCENT HURL**

## BACKGROUND AND PLEADINGS

1. AMBER BEVERAGE GROUP, SIA (“the holder”) is the holder of the international registration displayed on the cover page of this decision (“the IR”). The IR was registered on 23 May 2018. With effect from the same date, the holder designated the UK as a territory in which it sought to protect the IR under the terms of the Protocol to the Madrid Agreement. The IR was entered in the UK register on 1 November 2018 and enjoys a priority date of 6 March 2018. It stands registered for *Gin* in Class 33.

2. On 12 March 2021, Vincent Hurl applied to have the IR declared invalid under Section 47(2) of the Trade Marks Act 1994 (“the Act”). The application is based upon Section 5(4)(a) of the Act. This is on the basis of Mr Hurl’s alleged earlier rights in the sign ‘CROSSKEYS INN’. Mr Hurl claims that the sign has been used in relation to *whiskeys and services relating to the provision of alcoholic beverages, in particular whiskeys* since the 18<sup>th</sup> century in the UK and Northern Ireland and he has acquired goodwill under the sign. Use of the IR would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

3. Mr Hurl’s claim is as follows:

*“The mark "CROSSKEYS INN" has been used by the Applicant, or their predecessors in title, since, at least, the 18th century (possibly the 17th century) in respect of services of provision of alcoholic beverages, in particular whiskey. In the 21st century the "CROSSKEYS INN" has been widely promoted by the Applicant and third parties throughout the UK and further afield as a "must see" destination, and the Inn is particularly well known for its range of Irish stout and Irish whiskey. The Applicant himself is well known within the field of Irish Whiskey as an authority on the subject of "Irish Whiskey". Additionally, in the last 10 years, at least, the mark CROSS KEYS INN has been used on whiskey bottle labels and in advertising to promote "whiskey".*

*The use by a third party of a mark containing the dominant and distinctive word CROSS KEYS in respect of a distilled spirit, a mark which has been associated with the Applicant, or their predecessors in title, for so long is likely to*

*misrepresent that such goods originate from the Applicant, or an economically connected party.*

*Gin, as covered by the registration, and whiskey are both distilled spirits and are often produced by a single undertaking. Use of the applied for mark, which contains as its dominant and distinctive element the dominant element of the Applicant's sign, in respect of "gin" would misrepresent that the gin provided under the trade mark derived from the Applicant.*

*Such a misrepresentation would result in damage to the Opponent through loss of sales, or tarnishment of reputation”.*

4. The holder filed a counterstatement denying the claims made.

5. Only Mr Hurl filed evidence in these proceedings. He also filed written submissions dated 16 August 2021. Whilst I do not propose to summarise the evidence and submissions here, I have taken them into account in reaching my decision and will refer to them below where necessary.

6. The holder is represented by Withers & Rogers LLP and Mr Hurl by Ansons. Neither party requested a hearing, though the holder elected to file submissions in lieu. This decision is taken following a careful perusal of the papers.

### **The evidence**

7. Mr Hurl's evidence consists of two witness statements, both dated 16 August 2021. The first witness statement is from Mr Hurl himself, who is the owner of the Crosskeys Inn located in Toomebridge in Northern Ireland and is accompanied by 15 exhibits (VH1-VH15).

8. The second witness statement is from Cherrie Ann Stewart who is a chartered trade mark attorney with the firm Ansons, representatives of the cancellation applicant. Ms Stewart's statement is only a vehicle for introducing two exhibits (CS1-CS2) one

showing website extracts relating to bar distilleries, and another one introducing an online article titled “15 Scotch whiskey distilleries making gin”.

### **Relevance of the EU law**

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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

### **DECISION**

10. Section 5(4)(a) of the Act has application in invalidation proceedings by virtue of Section 47(2) of the Act, which states as follows:

“(1) [...]

(2) [...] the registration of a trade mark may be declared invalid on the ground-  
(a) [...]

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

[...]

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

### **Section 5(4)(a)**

11. Section 5(4)(a) states:

“(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-

(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.”

12. 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.”

13. 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)."

14. 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<sup>1</sup> 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<sup>2</sup> 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”.

### **The relevant date**

15. The matter must be assessed as at the relevant date. 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.”

16. The holder designated the UK for protection of the IR on 23 May 2018, claiming priority based on a trade mark filed in Latvia on 6 March 2018. Therefore, the relevant date for assessing whether Mr Hurl had the necessary goodwill to sustain his action for passing off is 6 March 2018. As the holder has not filed any evidence of use, this is the only date I must consider.

### **Goodwill**

17. The first hurdle for Mr Hurl is to demonstrate that he had the necessary goodwill in the sign ‘CROSSKEYS INN’ at the relevant date. The issue of what constitutes goodwill was discussed in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL):

“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.”

18. 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 than 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.”

19. 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.”

20. I have previously set out the salient features of the legal concept of goodwill. My starting point is that the earlier use by Mr Hurl must relate to the use of the sign ‘CROSSKEYS INN’ for the purposes of distinguishing the goods and services claimed in the application (which I will bear in mind throughout).

21. The Form TM261 states that the sign ‘CROSSKEYS INN’ has been used in relation to *whiskeys and services relating to the provision of alcoholic beverages, in particular whiskeys.*

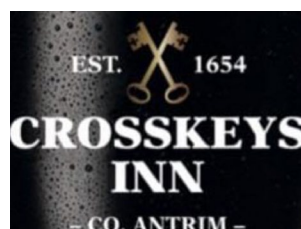
22. The evidence shows use of the sign 'CROSSKEYS INN' as the name of a pub located in Toomebridge, Northern Ireland. Mr Hurl, who claims to be the owner of the pub, states that the 'CROSSKEYS INN' is the oldest thatched pub in Northern Ireland dating back to 1654. He provided photographs of the signage displayed at the business premises, as shown below:



23. Mr Hurl also says:

*"[...] the name CROSSKEY, CROSS KEYS INN and the image of two crossed keys have been used to identify our services for decades"*

and provides the following examples of use:



24. I understand Mr Hurl's reference to the signs being used to identify "the services", as a reference to the pub services provided from the premises of the 'CROSSKEYS INN'.

25. Although Mr Hurl claims to be the owner of the pub, as the holder correctly pointed out in its submissions in lieu, there is no direct evidence of when Mr Hurl purchased any right, title or interest in the pub. Admittedly, the evidence includes a copy of an article (shown below) dated April 2015 from a magazine called 'Licensed and catering News' which refers, incidentally, to the historic 'CROSSKEYS INN' in Toomebridge being "*Mr Hurl's own venue*". The article states:

*"On the Northern Irish Whiskey Trail...*

*Publican Vincent Hurl's passion for Irish whiskey is behind the creation of an exciting new initiative aimed at visitors and locals who share his abiding love of the product. The Bellaghy man has designed the Northern Irish Whiskey Trail – a colourful double sided-map product that can be used by tourists or local enthusiasts to embark on a round-the-province tour of our best distilleries and those pubs and hotels with a special emphasis on Irish whiskey.*

*The project came into being after Vincent's plans for large-scale expansion at his own venue – the historic Crosskeys Inn at Toomebridge in County Antrim – stalled in 2011 amid the spiralling recession and the banks' reluctance to lend cash to small businesses".*

26. Another article suggests that Mr Hurl has owned the 'CROSSKEYS INN' pub since at least 2002. It states:

*"In February 2000 the Crosskeys Inn was partially damaged by fire. It was restored over the course of a year by [E S] and then reopened in 2001. It was purchased by Vincent Hurl later than year and he completed the restoration of the Inn, bringing it back to its formal glory".*

27. The articles exhibited by Mr Hurl do not make any reference to the source of information used by the writer and the information relating to Mr Hurl being the owner of the pub has not been corroborated by any document. It is not possible to determine

on the basis of the evidence and material filed, what the factual position is in regard to the basis of Mr Hurl's claim that he is the owner of the pub (if, indeed, that is in fact the case).

28. It is also important to note that pubs and inns are specific types of businesses. There are different ways to run a pub, for example landlords may purchase the premises, pub tenants may rent the premises off the landlord and licensees may take on the right to occupy the pub for a fixed term to run it as their own business under a pub lease agreement.

29. In this case, there is no evidence that proves that Mr Hurl actually owns the property and I have noted that one of the articles exhibited refers to a previous licensee of the 'CROSSKEYS INN' pub from 1992.<sup>1</sup> But, most importantly, there is no documentary evidence which establishes that, prior to the relevant date, Mr Hurl became the owner of the goodwill associated with the sign 'CROSSKEYS INN' (and so be entitled to bring the claim).

30. In the evidence filed by Mr Hurl, there seems to be an assumption that the alleged facts speak for themselves and that I should make assumptions in Mr Hurl's favour even when there is no documentary evidence to support those facts. I consider however that Mr Hurl's evidence raises more questions than it solves.

31. The goodwill of a pub is of two types. Firstly, there is the personal goodwill associated with the personality of the landlord, whose care for his customers keep them loyal to his pub. As I have said, there is no direct evidence about for how long Mr Hurl has been carrying on his business. Further, there is no evidence as to whether Mr Hurl has generated any personal goodwill by way of him acting as the landlord of the 'CROSSKEYS INN'. In any event, this type of personal goodwill would lie with Mr Hurl personally in his (alleged) capacity as a landlord; I am not convinced that it would also be associated with the sign 'CROSSKEYS INN'.

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<sup>1</sup> VH6 page 59

32. Secondly, there is the goodwill associated with the business. However, there is no evidence that the sign 'CROSSKEYS INN' was distinctive of the goodwill generated by reason of the trading activities formerly carried on by Mr Hurl's alleged predecessors in title since 1654 and, if that goodwill existed, that the rights to it were assigned to Mr Hurl. Although Mr Hurl claimed to be the owner of the pub and stated that *"the mark "CROSSKEYS INN" has been used by [himself] or his predecessors in title, since, at least, the 18th century (possibly the 17th century) in respect of services of provision of alcoholic beverages, in particular whiskey"* he did not claim that the goodwill of the business in relation to which the sign 'CROSSKEYS INN' has been used was ever assigned to him. I am sure that if an assignment had been made, it would not have been difficult for Mr Hurl to provide or submit the documentary evidence to show that.

33. Section 5(4)(a) of the Act provides (with emphasis added) that: *"A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented- (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; [...]* **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.**"

34. To be entitled to bring a passing off claim on the basis the goodwill generated by the trading activities of other companies which had previously carried on business at the 'CROSSKEYS INN', Mr Hurl must establish that it had a proprietary interest in the goodwill it is seeking to protect by means of his claim for invalidity under Section 5(4)(a) by showing that it had become the successor in title to that goodwill. He has not done so. Nonetheless, the question remains whether Mr Hurl has personally acquired an independent goodwill associated with the sign 'CROSSKEYS INN' in relation to the goods and services claimed.

#### *Alleged use of the sign in relation to whiskey*

35. The only reference to the sale of whiskey is at paragraphs 16-17 of Mr Hurl's witness statement, where he states:

16. Whiskey being especially bottled for and bearing the trade mark "The Crosskeys Inn" on the label as well as an image of the inn itself was released onto the market in 2010. The whiskey was produced for us by Cooley Distillery which was sold to Beam Inc. in 2011. A photograph of a bottle of the whiskey showing the label used and a post from social media promoting the whiskey is attached hereto under **Exhibit VH12**.
17. Sales of the whiskey were made throughout the United Kingdom. We attach hereto a till report showing sales of shots of the Crosskeys Tyrconnell whiskey through one of the Crosskeys Inn bar dated the 31<sup>st</sup> March 2017 which shows sales of the whiskey during a period of approximately 6 weeks under **Exhibit VH13**. 700ml bottles were also sold and we attach an e-mail from October 2014 discussing one such sale in the aforementioned Exhibit VH12.

36. Exhibit VH12 shows the following images:



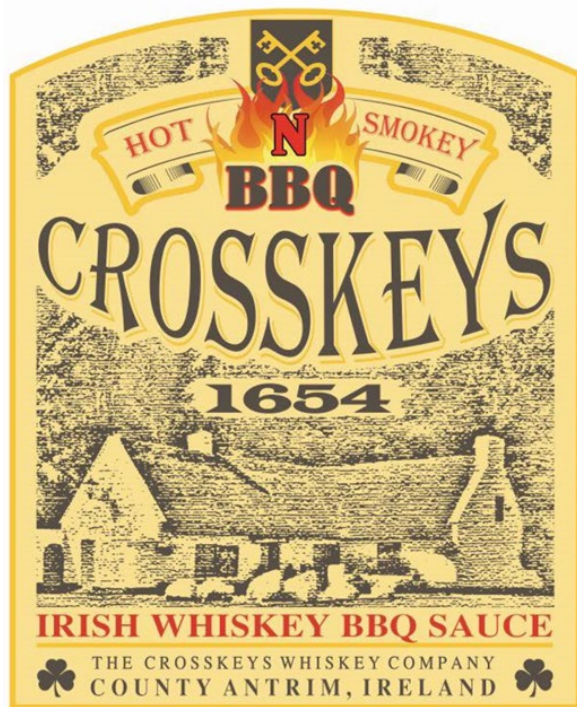
37. The holder contends that the sign 'CROSSKEYS INN' is not used as a trade mark in order to indicate trade origin and says that this evidence does not show that the sign 'CROSSKEYS INN' has become well-known for whiskeys. I agree with the holder that a consumer faced with goods bearing the above label would identify the trade mark 'THE TYRCONNELL' as the only indication of trade origin.

38. Even if consumers had come to want the product because of the place where it is sold, the label clearly identifies 'THE TYRCONNELL' as the brand indicating trade origin. Mr Hurl himself says that the whiskey was produced by the Cooley distillery and there is no claim on the label that the whiskey contained in the bottles is made by the 'CROSSKEYS INN'. Further, given the nature of the trade, and in particular the fact that whiskeys are produced by distilleries, consumers will take the words "*Specially Bottled for the 'Crosskeys Inn Irelands Oldest Thatched Pub'*" as an indication that the 'CROSSKEYS INN' has commissioned its own limited runs of whisky. What both the sign and circumstances of the trading say to the customers, is that the goods come from the trader using the trade mark 'THE TYRCONNELL'. It is the latter, not the sign 'CROSSKEYS INN', that consumers will perceive as indicating the trader who is responsible for manufacturing and bottling the whisky.

39. For use of a sign to be protected by the law of passing off, that use must be shown to have become distinctive of the claimant, otherwise there can be no misrepresentation. Although the words 'CROSSWAYS INN' are not on their face descriptive, they have not been used on the goods as a signifier of origin but in a descriptive sense – as part of a descriptive phrase which states that the goods were specially bottled for the 'CROSSKEYS INN'. As such, use of the sign 'CROSSKEYS INN' on the label described above did not give rise to any goodwill in the sense that was not distinctive and was not capable of distinguishing trade origin.

40. In his evidence Mr Hurl also says: "*the development of the CROSSKEYS whiskey brand has been promoted on our social media platform since 2017 with the aim of creating a market for own branded whiskeys with an anticipated growth into corresponding gin and poteen offerings*". According to Mr Hurl "*development of labels for bottles of Irish whiskey to be sold under the 'CROSSKEYS' trade mark was commenced in 2017*" and "*glasses of 'CROSSKEYS' whiskeys were first served to the public of the Crosskeys Inn from November 2017 and later became available to purchase as individual bottles*".

41. Example of bottles and labels are shown below:



42. Although this is use of the sign 'CROSSKEYS' as a trade mark, there are a number of issues with this evidence.

43. Firstly, as the holder correctly pointed out, Mr Hurl has failed to provide any turnover figures relating to the sale of the 'CROSSKEYS 1654' whiskeys. Although Mr Hurl states that the whiskey became available to purchase as individual bottles after November 2017, he did not specify when, and therefore it is impossible to tell whether this was prior to 6 March 2018, which is the relevant date. The fact that "*glasses of 'CROSSKEYS' whiskeys were first served to the public of the Crosskeys Inn from November 2017*" is also insufficient to establish that consumers were actually exposed to the mark. In any event, I have noted that a Facebook post from 6 May 2018 (which is after the relevant date) states as follows:



The Crosskeys Inn

6 May 2018 · 🌐



CROSSKEYS IRISH WHISKEY

It's been no secret that we have been working on launching our own Whiskey.

It's been a long road since 2014 but we are pleased to announce that it will be available soon and we are now taking orders for the first release of:

CROSSKEYS 1654  
IRISH WHISKEY.

44. If I have any doubt, this post confirms that the whiskey branded 'CROSSKEYS 1654' became available only after the relevant date. As such, that use does not assist Mr Hurl.

45. Likewise, although there is some evidence of pre-launch publicity on social media, it is after the relevant date. Further, the traditional position is that advertising alone does not create goodwill.<sup>2</sup> Although some judgments have left open the possibility of pre-launch publicity being accepted as sufficient to create an actionable goodwill,<sup>3</sup> for such an argument to succeed one would expect details of extensive advertising to be provided, which has not been done in this case.

46. Lastly, the sign used on the bottles is 'CROSSKEYS 1654' which is also how the mark is referred to on social media; this is not the same as the sign that is relied upon in these proceedings. However, given what I have said above about the evidence being insufficient to establish that the use made gave rise to any protectable goodwill before the relevant date, I do not need to deal with the question of whether use of the sign 'CROSSKEYS' or 'CROSSKEYS 1654' could have generated goodwill in the sign 'CROSSKEYS INN'.

47. Taking all of the above into account, my conclusion is that the evidence is insufficient to establish that, at the relevant date, Mr Hurl had generated (and was the

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<sup>2</sup> BL-O-606-18

<sup>3</sup> See for example *Allen v Brown Watson* [1965] RPC 191 and *BBC v Talbot* [1981] FSR 228

proprietor of) any protectable goodwill in the sign 'CROSSKEYS INN' in relation to selling whiskeys.

*Alleged use of the sign in relation to services relating to the provision of alcoholic beverages, in particular whiskeys*

48. As regards the alleged use of the sign 'CROSSWAYS INN' in relation to *services relating to the provision of alcoholic beverages, in particular whiskeys*, whilst I accept that pubs and inns sell whiskeys and that the selling of whiskeys at the property would fall within the services claimed, there are two fundamental issues that go to the heart of this case.

*First issue: is the use shown use in relation to the services?*

49. The evidence shows that 'CROSSWAYS INN' is the name of a pub. The pub is known for being the oldest pub in Northern Ireland. An article exhibited by Mr Hurl<sup>4</sup> says that the pub is situated in a remote location where there is no village and that the closest villages are about 5 miles away. The article talks about the pub being more than 300 years old and says that for many years it served as a coaching stop. Another article from 2008<sup>5</sup> describes the 'CROSSKEYS INN' as *"the oldest thatched pub in Ireland and one of thousands of little out-of-the-way places that are well worth stopping at for an extended long lunch"*.

50. An article posted on the 'CROSSKEYS INN's Facebook page in October 2018 describes the pub as follows:

*"Ducking under the lower level door, you immediately enter the incredible atmosphere of a 1650s pub stacked with all sort of memorabilia, old photographs of past customers and a few live-in ghosts [...] the Crosskeys Inn is the real thing – little has changed for centuries. It is a truly authentic experience which is worth making the drive for the atmosphere alone"*.

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<sup>4</sup> VH6 page 59

<sup>5</sup> VH6 page 61

51. Another article posted on the 'CROSSKEYS INN's Facebook page in January 2019 refers to the pub winning the BBC Countryfile's Country Pub of the Year award and states:

*“Found close to the shores of Lough Neagh, their aforementioned exterior is simply stunning (and great for a selfie) but it is the interior that ensures you will want to pay return visits. The Crosskeys Inn's bread and butter are tourists and local couples, but history buffs and those who adore classic bars keep the business thriving too. The traditional music sessions are the [illegible] of local legend for a reason as their pint of Guinness. On the subject of drinks if you can get your hands on their very own Crosskeys single malt whiskey you simply must sample it. Service during the evening of my stay was first class and staff were witty, warm and attentive”*

52. As it can be seen, the pub name is used to designate the actual building, its character, its location and its history.

53. Whilst the 'CROSSKEYS INN' might enjoy a reputation as the oldest thatched pub in Northern Ireland, it seems to me that that reputation is associated with the building in itself and its history. I am not satisfied that consumers will think that there is a link between the pub name 'CROSSKEYS INN' and the services provided at the property. This is because the 'CROSSKEYS INN' is a 300-year-old small independent pub and consumers will expect that, over time, it has been bought, leased, tenanted or managed by different companies and has undergone numerous changes of hands. Consequently, they will also be aware of the fact that the current business is not a continuation of the business which has originally or successively provided the services at the property. If there is a link between the pub name 'CROSSKEYS INN' and the services, it is only to the extent that consumers will associate the pub name with the property where the trading activities are carried on, however, they will not link the name 'CROSSKEYS INN' with the business and/or services themselves.

54. The situation would be different, if, for example, there was evidence that the pub name 'CROSSKEYS INN' was used by a large pub company in relation to a large number of pubs opened throughout the country, in which case I would be more willing

to accept the argument that, in those circumstances, consumers are likely to understand the pub name to convey a message about the business source of the services and link the pub name with the services.

55. In conclusion, my finding is that the pub name 'CROSSKEYS INN' is not distinctive of the services provided at the property and consumers will not take it to denote the business source where the services come from.

*Second issue: Absence of turnover and marketing spend*

56. I will say this for the sake of completeness, even though I have already touched upon these matters. Even if my actual findings about the sign not being distinctive of the goods and services was wrong, there is another fundamental reason why I would find Mr Hurl's evidence to be insufficient to establish that he had more than a trivial goodwill at the relevant date. This is because Mr Hurl has not provided any evidence of turnover.

57. The only evidence of sales provided by Mr Hurl is a till report dated 31 March 2017<sup>6</sup> showing sales of shots of whiskeys. It includes the following (the list includes alcoholic drinks other than whiskeys):

- Jack Daniels: 113 shots for a total of £355.90
- Jameson: 942 shots for a total of £2740
- Grouse: 60 shots for a total of £174.70
- Haig: 1 shot for a total of £2.90
- Hot whiskey: 115 shots for a total of £360.20
- Port: 5 shots for a total of £15.70
- Brandy: 194 shots for a total of £601
- Martini: 5 shots for a total of £15.90
- Sherry: 1 shot for a total of £3.30
- Liqueurs: 153 shots for a total of £475.80
- Vodka: 2217 shots for a total of £6254.40

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<sup>6</sup> VH13

- VAT19: 1 shot for a total of £2.90
- Can Club: 1 shot for a total of £2.80
- Paddy: 1 shot for a total of 3.10
- Honey Bush: 5 shots for a total of £15.50
- CKEYS TYR Whiskey: 191 shots for a total of £553.50
- Black Bush: 60 shots for a total of £179.80
- Bush: 244 shots for a total of £708.40
- Redbreast: 268 shots for a total of £789.70

58. The above amounts to a total of £13,234.60 worth of goods sold in one day, £553.50 of which is the value of the TYRCONNELL branded whiskey.

59. There is nothing else in the evidence to indicate the amount of turnover generated by the provision of the goods and services concerned and it is not for me to fill the gaps in Mr Hurl's evidence. The onus was on Mr Hurl to obtain and file evidence to show basic facts, such as, for example, turnover figures and advertising spend. None of this has been done. Accordingly, I would find that evidence of a one-off sale (or of the revenue generated in one day) is not sufficient to establish that Mr Hurl had generated more than a trivial goodwill in relation to the goods and services claimed.

*Use of the sign "CROSSKEYS INN" to advertise whiskey*

60. Finally, Mr Hurl claims to be an expert in the field of Irish whiskeys and that by association with him, the 'CROSSKEYS INN' has become well-known within the field.

61. Mr Hurl says that he has written academically on the subject and that his dissertation was published in 2015. He also says that he has been involved in developing the whiskey tourism offering in Northern Ireland with his research leading to the design and development of the first whiskey tourist trails in Northern Ireland. According to Mr Hurl, these trails promote the Irish whiskey distilleries in Northern Ireland, as well *"those pubs and hotels in Northern Ireland, including the Crosskeys Inn, with a special emphasis on Irish whiskeys"*. These facts are corroborated by documentary evidence, including copies of tourist publications and copies of UK

publications such as the Marks and Spencer magazine, the Daily Mail and the Sunday Times.<sup>7</sup> Mr Hurl also says that in the last 10 years the sign 'CROSSKEYS INN' has been used on merchandising, including glasses for spirits, coasters, t-shirts etc (examples of which are provided).

62. According to Mr Hurl *“the Crosskeys Inn falls into the category of an iconic image, not just in Northern Ireland but the whole of Ireland and internationally. The Crosskeys Inn is known, and has been recognised for, our services of alcohol beverages, particularly Irish whiskeys and Irish stout”*.

63. Although Mr Hurl might have acquired a reputation deriving in part from having been the landlord of the 'CROSSKEYS INN' pub, there is an important difference between the role played by Mr Hurl in the pub business, the attraction that he potentially brought to that business and the reputation that he generated for that business, and his actual ownership of the goodwill. Mr Hurl's evidence comes largely from his witness statement and even though he claimed to be the owner of the pub, he did not explain how the business carried on at the property operates - for example it is not clear whether any company (or Mr Hurl) has filed any accounts and so it is not possible to conclude that, if any goodwill in the business existed, it belonged to Mr Hurl. Further, there is nothing to suggest that anyone, including the pub's customers or staff, understood the goodwill associated to the sign 'CROSSKEYS INN' to be his. Even if Mr Hurl's role may potentially have led to some form of association in the public perception, I am not satisfied that, at the relevant date, the sign connoted a personal connection with Mr Hurl and/or that it was associated in the eyes of the public with Mr Hurl personally. For all of these reasons I reject the claim that Mr Hurl was the proprietor of any goodwill in the 'CROSSKEYS INN' at the relevant date. Mr Hurl's claim fails at the first hurdle.

## **Final remarks**

64. In its submissions in lieu the holder states:

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<sup>7</sup> VH4-VH6

Whilst the Proprietor denies that any goodwill existed, the Proprietor submits that, at best, goodwill existed only in connection with services relating to the provision of alcoholic beverages, in particular whiskey, and not all of the CROSSKEYS INN Goods and Services.

65. It is clear enough from the holder's submission that its primary position is that there was no goodwill at the relevant date. I do not take the sentence that "*at best goodwill existed only in connection with services relating to the provision of alcoholic beverages, in particular whiskeys*", as an admission that such goodwill existed. However, for the sake of completeness, I will also address that scenario.

66. I agree with the holder that *services relating to the provision of alcoholic beverages, in particular whiskeys* are not similar to gin. Whilst pubs and inns might serve whiskeys, they do not manufacture the goods and consumers do not expect the goods to be produced by the same business that serves them. I therefore consider that based on the goods and services at issue, there is no common field of activity; alternatively, if there is a common field of activity, it is very tenuous.

67. In *Harrods Limited v Harrodian School Limited* [1996] RPC 697 (CA), Millet L.J. made the following findings about the lack of a requirement for the parties to operate in a common field of activity, and about the additional burden of establishing misrepresentation and damage when they do not:

"There is no requirement that the defendant should be carrying on a business which competes with that of the plaintiff or which would compete with any natural extension of the plaintiff's business. The expression "common field of activity" was coined by *Wynn-Parry J. in McCulloch v. May* (1948) 65 R.P.C. 58, when he dismissed the plaintiff's claim for want of this factor. This was contrary to numerous previous authorities (see, for example, *Eastman Photographic Materials Co. Ltd. v. John Griffiths Cycle Corporation Ltd.* (1898) 15 R.P.C. 105 (cameras and bicycles); *Walter v. Ashton* [1902] 2 Ch. 282 (The Times newspaper and bicycles) and is now discredited. In the *Advocaat* case Lord Diplock expressly recognised that an action for passing off would lie although "the plaintiff and the defendant were not competing traders in the

same line of business". In the *Lego case Falconer J.* acted on evidence that the public had been deceived into thinking that the plaintiffs, who were manufacturers of plastic toy construction kits, had diversified into the manufacture of plastic irrigation equipment for the domestic garden. What the plaintiff in an action for passing off must prove is not the existence of a common field of activity but likely confusion among the common customers of the parties.

The absence of a common field of activity, therefore, is not fatal; but it is not irrelevant either. In deciding whether there is a likelihood of confusion, it is an important and highly relevant consideration

‘...whether there is any kind of association, or could be in the minds of the public any kind of association, between the field of activities of the plaintiff and the field of activities of the defendant’:

*Annabel's (Berkeley Square) Ltd. v. G. Schock (trading as Annabel's Escort Agency)* [1972] R.P.C. 838 at page 844 per Russell L.J.

In the *Lego case Falconer J.* likewise held that the proximity of the defendant's field of activity to that of the plaintiff was a factor to be taken into account when deciding whether the defendant's conduct would cause the necessary confusion.

Where the plaintiff's business name is a household name the degree of overlap between the fields of activity of the parties' respective businesses may often be a less important consideration in assessing whether there is likely to be confusion, but in my opinion it is always a relevant factor to be taken into account.

Where there is no or only a tenuous degree of overlap between the parties' respective fields of activity the burden of proving the likelihood of confusion and resulting damage is a heavy one. In *Stringfellow v. McCain Foods (G.B.) Ltd.* [1984] R.P.C. 501 Slade L.J. said (at page 535) that the further removed from one another the respective fields of activities, the less likely was it that any

member of the public could reasonably be confused into thinking that the one business was connected with the other; and he added (at page 545) that

‘even if it considers that there is a limited risk of confusion of this nature, the court should not, in my opinion, readily infer the likelihood of resulting damage to the plaintiffs as against an innocent defendant in a completely different line of business. In such a case the onus falling on plaintiffs to show that damage to their business reputation is in truth likely to ensue and to cause them more than minimal loss is in my opinion a heavy one.’

In the same case Stephenson L.J. said at page 547:

‘...in a case such as the present the burden of satisfying Lord Diplock's requirements in the *Advocaat* case, in particular the fourth and fifth requirements, is a heavy burden; how heavy I am not sure the judge fully appreciated. If he had, he might not have granted the respondents relief. When the alleged “passer off” seeks and gets no benefit from using another trader's name and trades in a field far removed from competing with him, there must, in my judgment, be clear and cogent proof of actual or possible confusion or connection, and of actual damage or real likelihood of damage to the respondents' property in their goodwill, which must, as Lord Fraser said in the *Advocaat* case, be substantial.”

68. The signs at issue are not identical, the comparison being between the ‘CROSSKEYS INN’ and the ‘CROSS KEYS GIN’. Whilst the first nine letters of the signs are identical, they are presented as one word and two words respectively, and the words ‘INN’ and ‘GIN’ convey different concepts. Overall, I consider the signs to be similar to a medium degree. As regard the nature and extent of the reputation relied upon, in the absence of any information about turnover or marketing figures, it would be a very generous view indeed that the reputation relied upon is tiny. Finally, the shared element ‘CROSSKEYS’/‘CROSS KEYS’ is made up of two dictionary words and it is distinctive to no more than a medium degree.

69. Taking all of the above into account, I would conclude that even if Mr Hurl was entitled to bring the action (on the basis that he was the proprietor of a protectable goodwill), I would not be persuaded that a substantial number of Mr Hurl's actual or potential customers will be misled into purchasing the holder's gin in the belief that it is Mr Hurl's product. In the submissions filed on behalf of Mr Hurl, his representatives state:

The use by a third party of a mark containing the dominant and distinctive word CROSS KEYS alongside a descriptor in respect of a distilled spirits, a mark which has been associated with the Applicant, or their predecessors in title, for over three centuries is likely to misrepresent that the goods are commercially connected to, or originate from the Applicant, particularly since alcoholic beverages are frequently brewed or distilled by undertakings who also offer the services of provision of alcoholic beverages.

70. I reject the submission. The evidence shows that interest in whiskey tourism is growing and that a number of distilleries have been developed to accommodate visitors and offer tour services including spirits tasting experiences; these, of course, include the provision of alcoholic beverages. However, this is not the scenario which would arise in this case. In considering the question of whether deception is likely to occur, one must consider 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. The 'CROSSKEYS INN' is not a distillery but a pub, and there is no evidence that consumers would expect pubs to be also manufacturers of gin.

71. The claim would also fail on misrepresentation.

## **OUTCOME**

72. The application for invalidation has failed. The mark will remain registered.

## **COSTS**

73. The holder has been successful and is entitled to a contribution towards its costs. In the circumstances I award the holder the sum of £700 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Preparing and filing a counterstatement	£250
Commenting on the evidence:	£500
Submissions in lieu	£250
Total	£1,000

74. I therefore order Vincent Hurl to pay AMBER BEVERAGE GROUP, SIA the sum of £1,000. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 10th day of June 2022**

**Teresa Perks**  
**For the Registrar**