

O-576-15

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO 3050859
BY DUNCAN TAYLOR SCOTCH WHISKY LIMITED
TO REGISTER THE TRADE MARK**

NO BULL

IN CLASSES 25 & 33

**AND OPPOSITION THERETO BY
MOLE VALLEY FARMERS LTD UNDER NO 402762**

**& APPLICATION NO 3062630
BY MOLE VALLEY FARMERS LIMITED
TO REGISTER THE SERIES OF TWO TRADE MARKS**



AND



IN CLASSES 9 & 25

**AND OPPOSITION THERETO BY DUNCAN TAYLOR SCOTCH WHISKY LIMITED
UNDER NO 403684**

Background

1. These consolidated opposition proceedings essentially involve two parties each relying upon two trade mark applications/registrations and one of the parties also relies upon its alleged earlier rights in the sign NO BULL because it has been selling clothing, t-shirts, footwear and headgear throughout the UK since 1 August 2009. The dates of the respective earlier rights claimed intertwine and have an impact on one another.


Pleadings: opposition no. 402762

2. On 10 April 2014, Duncan Taylor Scotch Whisky Limited (“Duncan Taylor”) applied to register the mark NO BULL. Under application no. 3050859 it was accepted and published in the Trade Marks Journal on 30 May 2014 in respect of the following goods:

Class 25: Clothing; footwear; headgear; parts, fittings and accessories for the aforesaid goods

Class 33: Whisky

3. On 29 August 2014, Mole Valley Farmers Ltd (“Mole Valley”) opposed class 25 of the trade mark (under no. 402762) on the basis of section 5(1), 5(2)(a) and (b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier UK trade mark registrations, pertinent details of which are below:

Mark	Number	Filing date	Date of entry in register	Class 25 Goods
NO BULL ¹	2552846	14 July 2010	26 Nov' 2010	Clothing; footwear; headgear for wear; articles of casual clothing; articles of casual wear; leisure wear; articles of leisure wear; work wear, other than to protect against accident or injury; articles of work wear, other than to protect against accident or injury; jeans; jackets; jackets for casual wear; waterproof jackets; water-resistant clothing; boots; wellington boots; waterproof boots; working shoes, other than to protect against accident or injury; walking boots; casual shirts; cotton shirts; short-sleeved shirts; shirts; polo shirts; rugby shirts; tee shirts; sweatshirts; hooded sweatshirts; socks.
 ²	2553200	15 July 2010	26 Nov' 2010	As above

¹ This earlier registration is used as a basis to oppose the application under section 5(1) and 5(2)(a) of the Act

² This earlier registration is used as a basis to oppose the application under section 5(1), 5(2)(a) and 5(2)(b) of the Act

4. Duncan Taylor filed a counterstatement whereby it denies a likelihood of confusion. Further, it claims to have used the mark since at least as early as 2009 and has acquired a significant goodwill and reputation. The applicant argues that it was using its mark prior to the launch of the opponent's products. Whilst this may be a sustainable basis for an opposition and indeed a cross opposition has been filed it is not considered to be a sufficient defence. In this regard, the applicant's attention is directed towards Tribunal Practice Notice 4/2009 "Trade mark opposition and invalidation proceedings – defences", particularly the following:

"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."

Pleadings: opposition no. 403684

5. On 3 July 2014, Mole Valley applied to register the following series of two trade mark application:



and



6. Under application no. 3062630 it was accepted and published in the Trade Marks Journal on 28 November 2014 in respect of the following goods:

Class 9: Protective clothing, footwear and headgear for protection against accident or injury; safety clothing, footwear and headgear for protection against accident or injury; reflective clothing, footwear and headgear for the prevention of accidents; high visibility clothing, footwear and headgear for the prevention of accidents; protective goggles; protective glasses.

Class 25: Clothing; footwear; headgear; casual clothing; leisurewear; workwear, other than to protect against accident or injury; trousers; jeans;

cargo pants; sweatpants; shorts; jackets; shirts; polo shirts; rugby shirts; tee shirts; sweatshirts; body-warmers; outerwear; waterproof clothing; water-resistant clothing; over-trousers; overalls; boiler suits; coveralls; thermal clothing; thermal outer-clothing; thermal underwear; boots; wellington boots; waterproof boots: work shoes and boots, other than to protect against accident or injury; walking boots; socks; gaiters; undergarments; sweat-absorbent and anti-sweat undergarments hats; caps; scarves; balaclavas; gloves.

7. On 28 January 2015, Duncan Taylor opposed the entire trade mark application (under no. 403684) on the basis of section 5(1), 5(2)(a),(b) and 5(4)(a) of the Act. The section 5(1), 5(2)(a) and (b) claims are on the basis of its earlier UK trade mark registration no. 3050859 which is the subject of opposition no. 402762 detailed above.

8. The section 5(4)(a) claim is on basis of its alleged earlier rights in NO BULL. It claims to have been selling clothing, t-shirts, footwear and headgear since at least as early as August 2009 and has acquired goodwill under the sign. Use of the trade mark applied for would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

9. Mole Valley filed a counterstatement denying the claims made and requested that Duncan Taylor substantiates its claim to protection under the law of passing off.

10. Both sides filed evidence in these proceedings. This will be summarised to the extent that it is considered appropriate/necessary. Both sides filed written submissions which will not be summarised but will be referred to as and where appropriate during this decision. No hearing was requested and so this decision is taken following a careful consideration of the papers.

EVIDENCE

Mole Valley

Witness Statement of Andrew Chapple and exhibits AC1-AC8

11. Mr Chapple is the Company Secretary of Mole Valley Farmers Limited. This is a position he has held since 3 November 1995. He states that the NO BULL mark was created and used on men's jeans in March 2010. He states that the mark is used as word only NO BULL but also in the stylised format as applied for under no. 3062630.

12. Mr Chapple provides the following turnover figures which relate to sales of clothing and footwear which bear the mark NO BULL.

Year	Turnover
2014/15	£850,000
2013/14	£1,027,031
2012/13	£754,064
2011/12	£365,000
2010/11	£210,000

2009/10	£80,000
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13. The annual expenditure on promotion of goods under the mark NO BULL are as follows:

Year	Promotional expenditure
2014/15	£24,000
2013/14	£16,500
2012/13	£3,260
2011/12	£2,700
2010/11	£13,138

Duncan Taylor evidence

Witness Statement of Euan C Shand and exhibits ECS1-ECS17

14. Mr Shand is the Chairman of Duncan Taylor, a position he has held since February 2001. Mr Shand states that Duncan Taylor has used its mark NO BULL for clothing, including t-shirts, in the UK since at least as early as 2009. He states at paragraph 2:

“The mark NO BULL is often used on its own, but is sometime used in the composite mark NO BULL, JUST WHISKY. The mark NO BULL is predominantly used to promote Duncan Taylor’s multi-award winning BLACK BULL whisky.”

15. Attached to the witness statement are a number of exhibits which are summarised below:

- Exhibits ECS01 – ECS04 consists of copies of marketing and advertising material for Duncan Taylor’s BLACK BULL whisky. Mr Shand states “Approximately thousands of copies of this promotional material have been circulated to the public since April 2009”³. It is noted that “No bull” does not appear on the bottle and is used as follows (“No bull, just whisky format”):



- Exhibit ECS05 appears to be a selection of banners or posters which Mr Shand states are used at events including, but not limited to, tradeshow, whisky tasting events held by customers, shops and retailers. Specific details of such events have not been provided and, as per exhibits ECS01 to ECS04, the mark is used in the No bull, just whisky format.

³ Paragraph 7 of the witness statement

- Exhibits ECS06 to ECS09 are images of a t-shirt. Mr Shand states that these have been sold to the public since at least as early as April 2009 and that they are available at various retailers, including its own website. He does not confirm when the goods were sold at these retailers. Once again the mark is used in the No bull, just whisky format with the website blackbullwhisky.com below:



- Exhibit ECS10 consists of a selection of photographs taken at various events which were “held at various whisky tasting shows and events, including but not limited to New York Whisky Fest Speyside Whisky Festival, Whisky tasting at a shop in Denmark, Whisky tasting at a shop in Duffton, Ecurie Eccose Black Bull Race at Spa.”⁴ All of the t-shirts include the No bull, just whisky format with the website below. Two of the pictures are dated 17 April 2009 and are headed “Black Bull Crew New York”. The only other dated picture was taken on 18 May 2009 and headed “Miss-Black-Bull-China” (see below). It is noted that the banner behind the lady holding the Blackbull whisky is in Chinese with an English transliteration. Accordingly, it appears that this picture was taken in China.



Miss-Black-Bull-China.jpg

JPEG image - 27 KB
 Created Monday, May 18, 2009 at 11:50 AM
 Modified Monday, May 18, 2009 at 11:50 AM
 Last opened Monday, May 18, 2009 at 11:50 AM
 Dimensions 355 x 500

⁴ Paragraph 13 of the witness statement

- Exhibit ECS12 consists of a number of promotional stickers. The stickers are not dated and there is no indication as to where they are used. The stickers show the mark in the No bull, just whisky format.
- Exhibit ECS13 consists of photographs of whisky glasses which bear the No bull, just whisky format on the side with the blackbull.com website address below. Mr Shand states that “Approximately hundreds of glasses of this type have been circulated to the public since 2013, and are made available to the public by shops and whisky tasting events”⁵.
- Mr Shand states that since 2013 Duncan Taylor has sponsored a racing team who compete in the British GT Championship. This has cost Duncan Taylor in the region of £235,000. Exhibit ECS14 is a collection of photographs of the team which includes team members wearing t-shirts as per exhibits ECS06 to ECS09. The bonnet of the car bears the words BLACK BULL in large font.
- Exhibit ECS15 consists of a selection of screenshots from Facebook dated 13 April 2009, 10 May 2009 and 27 May 2009. The members of staff pictured are wearing t-shirts as per exhibits ECS06 to ECS09.
- Exhibit ECS16 includes various internet archive pages which, again, show staff wearing t-shirts bearing the No bull, just whisky format together with the blackcull.com website address.
- Exhibit ECS17 consists of a number of what appear to be till receipts of various transactions between 12 May 2011 and 6 June 2014. They include references to “BLACK BULL” t-shirts. There is no reference to “NO BULL” though Mr Shand states that they relate to t-shirts which the NO BULL mark has been applied. The receipts show that, between the aforementioned period, Duncan Taylor sold 20 t-shirts which equates to approximately £400. At the bottom of the till receipts it states “Thank you for shopping at Whiskies of Scotland.”

Mole Valley evidence in reply



Witness Statement of Andrew Chapple

16. Mr Chapple’s second witness statement consists of submission and comments on the evidence filed by Mr Shand. I shall not summarise Mr Chapple’s comments here but will refer to them where necessary later in the decision.

Decision

17. To clarify how these consolidated opposition proceedings intertwine I shall begin with a chronology of the various trade mark applications, registrations and the date on which Duncan Taylor claims to have begun using the sign NO BULL :

⁵ Paragraph 16 of the witness statement

Item	Filing date or date of first use for passing off claim	Number	Mark	Goods	Owner
1	3 July 2014	3062630		Classes 9 and 25	Mole Valley
2	10 April 2014	3050859	NO BULL	Classes 25 and 33	Duncan Taylor
3	15 July 2010	2553200		Class 25	Mole Valley
4	14 July 2010	2552846	NO BULL	Class 25	Mole Valley
5	1 August 2009	First use	NO BULL	Clothing, t-shirts, footwear and headgear	Duncan Taylor

18. In essence, opposition number 403684 involves Duncan Taylor relying upon items 5 and 2 to oppose item 1. Opposition number 402762 involves Mole Valley relying upon items 3 and 4 to oppose item 2.

19. I shall begin with the section 5(4)(a) claim since this is the earliest and may have a direct impact on the remaining opposition claims for each party.

OPPOSITION NO. 403684 – section 5(4)(a) claim

Legislation and case law

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

“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, or

(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.”

21. Halsbury’s Laws of England (4th Edition) Vol. 48 (1995 reissue) at paragraph 165 provides the following analysis of the law of passing off. The analysis is based on guidance given in the speeches in the House of Lords in *Reckitt & Colman*

Products Ltd v. Borden Inc. [1990] R.P.C. 341 and *Erven Warnink BV v. J. Townend & Sons (Hull) Ltd* [1979] AC 731. It is (with footnotes omitted) as follows:

“The necessary elements of the action for passing off have been restated by the House of Lords as being three in number:

(1) that the plaintiff’s goods or services have acquired a goodwill or reputation in the market and are known by some distinguishing feature;

(2) that there is a misrepresentation by the defendant (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by the defendant are goods or services of the plaintiff; and

(3) that the plaintiff has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the defendant’s misrepresentation.

The restatement of the elements of passing off in the form of this classical trinity has been preferred as providing greater assistance in analysis and decision than the formulation of the elements of the action previously expressed by the House. This latest statement, like the House’s previous statement, should not, however, be treated as akin to a statutory definition or as if the words used by the House constitute an exhaustive, literal definition of passing off, and in particular should not be used to exclude from the ambit of the tort recognised forms of the action for passing off which were not under consideration on the facts before the House.”

22. Further guidance is given in paragraphs 184 to 188 of the same volume with regard to establishing the likelihood of deception or confusion. In paragraph 184 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation 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 feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court 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 plaintiff and the defendant carry on business;

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

(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 confusion or 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.”

23. The earlier use by the claimant must relate to the use of the sign for the purposes of distinguishing goods or services. For example, merely decorative use of a sign on a T-shirt cannot found a passing off claim: *Wild Child Trade Mark* [1998] RPC 455 (Appointed Person).

The relevant date

24. The Court of Appeal recently considered the relevant date in a case such as this one under the analogous article of the Community Trade Mark Regulations⁶. Kitchen L.J. stated that:

“Under the English law of passing off, the relevant date for determining whether a claimant has established the necessary reputation or goodwill is the date of the commencement of the conduct complained of (see, for example, *Cadbury-Schweppes Pty Ltd v The Pub Squash Co Ltd* [1981] RPC 429). The jurisprudence of the General Court and that of OHIM is not entirely clear as to how this should be taken into consideration under Article 8(4) (compare, for example, T-114/07 and T-115/07 *Last Minute Network Ltd* and Case R 784/2010-2 *Sun Capital Partners Inc.*). In my judgment the matter should be addressed in the following way. The party opposing the application or the registration must show that, as at the date of application (or the priority date, if earlier), a normal and fair use of the Community trade mark would have amounted to passing off. But if the Community trade mark has in fact been used from an earlier date then that is a matter which must be taken into account, for the opponent must show that he had the necessary goodwill and reputation to render that use actionable on the date that it began.”

25. Accordingly, the relevant date for determining the section 5(4)(a) claim is the date of application for registration 3 July 2014.

⁶ Roger Maier v ASOS [2015] EWCA Civ. 220 at paragraph 165

Meaning of goodwill

26. *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.”

Proof of goodwill

27. In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated at paragraphs 27 and 28 that:

“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.

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.”

28. 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.”

Was there goodwill at the relevant date?

29. In order for Duncan Taylor to succeed under a claim for passing off, the first issue to address is whether it has a protectable goodwill under the sign NO BULL by the relevant date so as to be protectable under the law of passing off.

30. Duncan Taylor has not filed any evidence or examples of use of the sign NO BULL on footwear, headgear or clothing *per se*. Therefore, it has not established that it had, at the relevant date, a protectable goodwill in the aforementioned goods. With regard to t-shirts, I find as follows.

31. It is clear from the evidence that the sign NO BULL has only been used in the No Bull, just whisky format often with the website address blackbullwhisky.com below. Since the use demonstrated includes the additional words “just whisky” and often in conjunction with the website address, I do not consider this to be use of NO BULL *solus*. The term No Bull is a well known slang term for someone who is telling the truth. In this instance, it is intended to be a fanciful promotional statement to project that the product is purely whisky. I consider such use to be promotional and/or decorative and any use of NO BULL is lost in the overall context of the slogan No bull, just whisky. This conclusion is supported by Mr Shand’s statement whereby he said “The mark NO BULL is predominantly used to promote Duncan Taylor’s multi-award winning BLACK BULL whisky”⁷.

32. In *Wild Child Trade Mark* [1998] RPC 455 (AP) the opponent’s earlier use was considered to be decorative use of a sign on a t-shirt and was therefore not found to be a sufficient basis to support a passing off claim. As with this case, the goods in the *Wild Child* case were clothing *per se* and the use made was not sufficient to demonstrate a protectable goodwill. Accordingly, I consider the circumstances of this case to be akin to that of *Wild Child* and therefore the passing off claim is dismissed.

33. Even if the use made of the sign had been sufficient, it is noted that Duncan Taylor has not provided any turnover figures or marketing spend. There is only a very small amount of evidence which is dated, but much of this relate to promotional use outside of the UK, e.g. promotional events in New York and China. Further, the till receipts show that between 12 May 2011 and 6 June 2014 Duncan Taylor sold 20 t-shirts amounting to around £400.

34. In *Hart v Relentless Records* [2002] EWHC 1984 (Ch), Jacob J. (as he then was) it was stated at paragraph 62 that:

“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

⁷ Paragraph 2 of Mr Shand’s witness statement dated 26 June 2015

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.”

35. I am mindful that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications* [1991] FSR 49, Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

36. In this instance, even if I had not found that use was made of the sign in the No bull, just whisky format I would still have found that the extent of use is no more than trivial. Therefore, there would not have been a protectable goodwill.

37. The section 5(4)(a) claim fails in its entirety.

38. Duncan Taylor also opposes trade mark application no. 3062630 under section 5(1), 5(2)(a) and 5(2)(b) since it considers the mark to be confusingly similar to its earlier trade mark application no. 3050859, which has been opposed by Mole Valley under opposition no. 402762. If the opposition succeeds it follows that Duncan Taylor (in light of the passing off claim failing) may only rely upon their class 33 to oppose Mole Valley's application. In view of this, it appears prudent to consider opposition no. 402762 against 3050859.

OPPOSITION NO. 402762

39. Mole Valley oppose the NO BULL application (no. 3050859) on the basis of section 5(1), 5(2)(a) and 5(2)(b) of the Act. The relevant section states:

Section 5(1)

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

Section 5(2)(a)

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

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the trade mark is protected...there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Section 5(2)(b)


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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of marks

40. The respective trade marks are shown below:

Applicant’s mark (Duncan Taylor)	Earlier mark (Mole Valley)
3050859	2552846
NO BULL	NO BULL
	2553200
	

41. It is clear that Mole Valley’s earlier trade mark registration no. 2552846 is identical to Duncan Taylor’s application. Since the goods covered by 2552846 are identical to 2553200 I shall proceed with the opposition based on 2552846 since it represents Mole Valley’s strongest position.

Comparison of goods and services

Application no. 3050859⁸	Earlier mark (no. 2552846)
Class 25: Clothing; footwear; headgear; parts, fittings and accessories for the aforesaid	Clothing; footwear; headgear for wear; articles of casual clothing; articles of casual wear; leisure wear; articles of leisure wear; work wear, other than to protect against accident or injury; articles of work

⁸ The application also covers class 33 “whisky” though this has not been opposed.

goods.	wear, other than to protect against accident or injury; jeans; jackets; jackets for casual wear; waterproof jackets; water-resistant clothing; boots; wellington boots; waterproof boots; working shoes, other than to protect against accident or injury; walking boots; casual shirts; cotton shirts; short-sleeved shirts; shirts; polo shirts; rugby shirts; tee shirts; sweatshirts; hooded sweatshirts; socks.
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42. It is clear that the applied for clothing, footwear and headgear are identical to those covered by the earlier mark. It is noted that the application also includes parts, fittings and accessories for the aforementioned goods. It is difficult to envisage exactly what these terms cover but since they would all fall within the scope of class 25 and would be directly related to clothing, footwear and headgear. Therefore, I find that they are at least) highly similar.

Proposed limitation

43. Prior to these proceedings being ready for a substantive decision, Duncan Taylor’s representatives wrote to the Registry proposing that their class 25 goods are limited to read as follows:

“Clothing; footwear; headgear; parts, fittings and accessories for the aforesaid goods; all for the promotion of Scotch whisky”

44. The request was refused so the applicant filed further comments. On 20 October 2015 the case work examiner subsequently responded to the applicant as follows:

“It is noted that you disagree with our refusal to implement the following proposed exclusion:

“Clothing; footwear; headgear; parts, fittings and accessories for the aforesaid goods; all for the promotion of Scotch whisky”

In view of your most recent correspondence, a hearing officer has reviewed your proposal and agrees with my refusal of the limitation. I further refer you to the guidance provided in *Postkantoor* and the Trade Marks Work Manual. In particular, paragraph 2.20 at page 18 of the “Classification desk instructions” which state:

“2.20 Exclusions

Exclusions are the opposite of positive limits in that they define what the goods or services are not, starting with the wording “but not including...” Following the judgment of the ECJ in the *Postkantoor* case, C-363/99, there is reduced scope for overcoming section 3(1) objections using exclusions. Previously known as the “penguin practice”, because of its inception as a result of Penguin Book’s trade mark application, it was the registrar’s practice to allow exclusions in respect of marks which are descriptive of goods in the specification having certain characteristics, but acceptable for the same goods without that characteristic.

However, *Postkantoor* makes it clear that the Trade Mark Directive, from which the UK Act is derived, “prevents a trade mark registration authority from registering a mark for certain goods or services on condition that they do not possess a particular characteristic”. In other words, excluding the particular characteristic that the mark describes is not an option. The reasoning that the Court gave for this ruling is underpinned by the legitimate interest of other traders; an exclusion in relation to particular characteristics might cause other traders to refrain from using that sign in trade, because it would be unclear that the mark’s protection did not actually extend to those goods or services for which it was descriptive. They would not know, as a general rule, about the exclusion and there might be legal uncertainty, which is what the Directive is intended to prevent.

Characteristics versus sub-categories

However, there is still a place for exclusions provided they are in respect of categories or sub-categories of goods or services and not in respect merely of their characteristics. A characteristic is a specific quality, attribute or trait, whilst a category is a group or sub-group of the item. The term “characteristic” includes not only obvious descriptions, such as “pink” for shirts, but also covers when, where, why and how the goods or service may be supplied and their intended purpose. It would not therefore be acceptable to exclude, for the mark “Post Office”, postage stamps provided they are not connected with a post office.

When considering employing exclusions, regard must be had to whether the exclusion will render the mark deceptive or whether it is likely that the applicant intends to use the mark on goods or services for which it is not descriptive (otherwise, it may be open to a bad faith objection (section 3(6)).”

Your proposal limits the goods to the promotion of Scotch whisky. It is our view that this outlines why the goods are supplied, i.e. a characteristic thereof. As outlined above, limitations with respect to a characteristic of the goods are not acceptable and will not be actioned. We are willing to limit specifications of goods and services which relate to a sub-category of what has already been applied for, but not characteristics such as the proposal you have provided.

In addition to *Postkantoor*, we would also refer you to the conclusions reached in *Silberquelle GmbH v Maselli-Strickmode GmbH* (C-495/07) [2009] E.C.R. I-2759.

In view of the above, the proposed limitation is not acceptable and will not be actioned.

If either party disagrees with the preliminary view they should request a hearing within 14 days from the date of this letter; that is on or before 3 November 2015.”

45. No hearing was requested and so no further action was taken and the specification remained as per paragraph 2 of this decision.

46. For the avoidance of doubt, I am in agreement with the decision taken by the case work examiner for the reasons set out in their letter, i.e. it would be contrary to the principles set out in *Postkantoor* since it relates to a characteristic rather than a sub-category of what has been applied for. Notwithstanding this, even the proposed limitation was accepted and actioned it would not overcome the respective class 25 goods being identical. In *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220, Kitchen L.J. stated at paragraph 78 that:

“.....the court must.... consider a notional and fair use of that mark in relation to all of the goods or services in respect of which it is registered. Of course it may have become more distinctive as a result of the use which has been made of it. If so, that is a matter to be taken into account for, as the Court of Justice reiterated in *Canon* at paragraph [18], the more distinctive the earlier mark, the greater the risk of confusion. But it may not have been used at all, or it may only have been used in relation to some of the goods or services falling within the specification, and such use may have been on a small scale. In such a case the proprietor is still entitled to protection against the use of a similar sign in relation to similar goods if the use is such as to give rise to a likelihood of confusion.”


47. In this instance, even if the application was limited to “all for the promotion of Scotch whisky”, notional and fair use of Mole Valley’s earlier registrations still covers the identical class 25 goods all for the promotion of Scotch whisky. Accordingly, the proposed limitation would not have assisted the applicant, even if it had been accepted.



Likelihood of confusion

48. Since I have already found that the respective marks and goods are identical to one another it must follow that the average consumer of the goods and distinctive character of the each mark must be the same. Therefore, I am not required to conduct an analysis.

49. In view of the above, the opposition succeeds under section 5(1) of the Act in respect of clothing, footwear and headgear and succeeds under section 5(2)(a) against parts, fittings and accessories. Therefore, trade mark application no. 3050859 should be refused for all the applied for class 25 goods. There is no need to assess the position with regard to the section 5(2)(a) and (b) claims.

The position so far

Item	Filing date or date of first use for passing off claim	Number	Mark	Goods	Owner
1	3 July 2014	3062630		Classes 9 and 25	Mole Valley

					
2	10 April 2014	3050859	NO BULL	Classes 25 and 33	Duncan Taylor
3	15 July 2010	2553200		Class 25	Mole Valley
4	14 July 2010	2552846	NO BULL	Class 25	Mole Valley
5	1 August 2009	First use	NO BULL	Clothing, t-shirts, footwear and headgear	Duncan Taylor

50. For ease of reference, I duplicate the table above in order to assess the current position so far. As previously stated the various oppositions are as follows. Opposition number 403684 involves Duncan Taylor relying upon items 5 and 2 to oppose item 1. Opposition number 402762 involves Mole Valley relying upon items 3 and 4 to oppose item 2.

51. So far it has been concluded that:

- Item 5 has failed under its section 5(4)(a) claim against item 1.
- Items 3 and 4 have been successful under section 5(2)(b) against class 25 of item 2. Therefore class 25 of item 2 cannot be relied upon against item 1.
- Since class 33 of item 2 was not opposed by items 3 and 4, I shall now consider the section 5(2)(b) claim by Duncan Taylor based on class 33 of item 1.

OPPOSITION NO. 403684 – section 5(1), 5(2)(a) and 5(2)(b)

52. For the sake of procedural economy, I shall begin with a comparison of goods. The respective goods are as follows:

Duncan Taylor (opponent)	Mole Valley (applicant)
Class 33: whisky	<p>Class 9: Protective clothing, footwear and headgear for protection against accident or injury; safety clothing, footwear and headgear for protection against accident or injury; reflective clothing, footwear and headgear for the prevention of accidents; high visibility clothing, footwear and headgear for the prevention of accidents; protective goggles; protective glasses.</p> <p>Class 25: Clothing; footwear; headgear; casual clothing; leisurewear; workwear, other than to protect against accident or injury; trousers; jeans; cargo pants; sweatpants; shorts; jackets; shirts; polo shirts; rugby shirts; tee shirts; sweatshirts; body-warmers; outerwear; waterproof clothing; water-resistant clothing; over-trousers; overalls; boiler suits; coveralls; thermal clothing; thermal outer-clothing; thermal underwear; boots; wellington boots; waterproof boots: work shoes and boots, other than to protect against accident or injury; walking boots; socks; gaiters;</p>

	undergarments; sweat-absorbent and anti-sweat undergarments hats; caps; scarves; balaclavas; gloves.
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53. In the judgment of the Court of Justice of the European Union in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment 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”.

54. 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 users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market
- d) 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;
- e) 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.

55. Duncan Taylor’s goods are class 33 whisky. These are goods which will be purchased and consumed by adults for enjoyment at social events or at home, or as a preparation with another drink. They will be sold in supermarkets, off-licences, bars and restaurants to adults. Mole Valley’s class 9 and 25 goods are, in essence, clothing, footwear and headgear for general wear which will be purchased by the general public in clothing shops and supermarkets. They are purchased to adorn one’s body usually based on aesthetic, comfort and fit. Whilst whisky is also purchased from supermarkets it would be in a different area of the store, via different distribution channels and they are not complementary. Therefore, given the clear differences in nature, use, distribution channels there is no degree of similarity. The position is starker in respect of protective clothing since goods of this nature would be purchased in specialist shops.

56. It is noted that Mole Valley’s application also includes protective goggles and glasses. These goods are specialist and for the sake of completeness I confirm that they these goods are not similar to class 33 whisky.

57. Where there is no similarity between the goods, there cannot be a likelihood of confusion. Therefore, I find that the opposition by Duncan Taylor against trade mark application no. 3062630 under section 5(2)(b) of the Act fails.

OUTCOME

58. *Opposition no. 402762*

- The section 5(1) and 5(2)(a) claim against class 25 of Duncan Taylor’s trade mark application no. 3050859 (NO BULL) succeeds.
- Class 33 of trade mark application no. 3050859 was not opposed and shall proceed to registration.

59. *Opposition no. 403684*

- The section 5(4)(a) claim fails in its entirety.
- Due to the outcome of opposition number 402762, Duncan Taylor can no longer rely upon class 25 of 3050859 to oppose 3062630.
- The opposition against application no. 3062630 fails. The application shall proceed for all of the applied for goods as follows:

Summary

60. Subject to appeal, trade mark application no. 3062630 shall proceed for all of the applied for goods.

61. Subject to appeal, trade mark application no. 3050859 shall be refused for all of the applied for class 25 goods, but will proceed to registration for the applied for class 33 goods, namely: “whisky”.

COSTS

62. Mole Valley has been successful and is entitled to a contribution towards its costs. In the circumstances I award the Mole Valley the sum of £2300 as a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£100
Preparing a statement and considering the other side’s statement (opposition no. 402762); considering the other side’s statement (opposition no. 403684)	£700
Preparing evidence and considering and commenting on the other side’s evidence	£1500
Total	£2300

63. I therefore order Duncan Taylor Scotch Whisky to pay Mole Valley Farmers Limited the sum of £2300. The above sum should be paid within fourteen days of the expiry of the appeal period or within fourteen days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 7th day of December 2015

MARK KING
For the Registrar,
The Comptroller-General