

O/355/19

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK APPLICATION NO. 3286396

BY BUCKINGTONS LTD

TO REGISTER THE TRADE MARK

MonkeyFace

FOR GOODS IN CLASS 33

AND

IN THE MATTER OF THE OPPOSITION THERETO UNDER NO. 412541

BY WILLIAM GRANT & SONS LIMITED

BACKGROUND AND PLEADINGS

1. On 30 January 2018, Buckingtons Ltd (“**the Applicant**”) applied to register as a trade mark the word(s) “MonkeyFace”, in respect of “*High strength, spirit based, alcoholic beverage*” in Class 33. The application was published for opposition purposes in the Trade Marks Journal on 23 February 2018.
2. Registration of the mark is opposed by William Grant & Sons Limited (“**the Opponent**”). Wildbore & Gibbons LLP acts as the Opponent’s representative. The opposition is based on **sections 5(2)(b), 5(3), 5(4)(a) and 3(3)(a)** of the Trade Marks Act 1994 (“**the Act**”). For its claims under sections 5(2)(b) and 5(3) of the Act, the Opponent relies on its ownership of the following UK registered trade mark:

Opponent’s earlier registered trade mark	
Registration No. 2366898 for word mark: “MONKEY SHOULDER” in respect of goods in Class 33: <i>Alcoholic beverages</i>	
Filing date of application:	28 June 2004
Date of entry in the register:	10 December 2004

Section 5(2)(b) claim

3. Under the **section 5(2)(b)** ground the Opponent claims that the mark applied for is similar to its earlier trade mark and that the respective goods are identical or similar, such that there is a likelihood of confusion on the part of the relevant public. The Opponent states that it has **used** its earlier mark **in respect of whisky**.

Section 5(3) claim

4. CLAIMED REPUTATION: In respect of its claim under **section 5(3)** of the Act, the Opponent claims to have acquired a **reputation** for **whisky** among UK consumers having extensively used its registered trade mark since at least 2004 including widespread sales and marketing activities.

5. ASSOCIATION AND UNFAIR ADVANTAGE: It claims that its long-standing use is likely to lead consumers to **associate** the MonkeyFace mark with the Opponent's well-established brand and that the Applicant would enjoy an **advantage** in the promotion of its new brand of alcoholic beverages to consumers who will already be familiar with MONKEY SHOULDER. The Opponent claims to have invested significant time and effort in marketing and promotional activities to build a good reputation for its MONKEY SHOULDER brand and that the Applicant would gain an **unfair benefit** as a result of being associated with the Opponent's widely known and highly regarded brand.
6. REPUTE: As the Opponent has no economic relationship with the Applicant, and cannot exercise **quality control** over the Applicant's activities, it claims that this is likely to cause **detriment to its reputation**, particularly if the goods offered by the Applicant are of lower quality than the Opponent's goods. It also refers to the risk of detriment to its brand, arising from the same **offensive significance** alleged to attach to the Applicant's brand, as forms the basis of its section 3(3) claim (below), which meaning, the Opponent claims, will be familiar to a "not insubstantial part of the relevant public" since the Opponent's brand is targeted at a young adult audience.
7. DISTINCTIVE CHARACTER: The Opponent claims that there is a risk of detriment to the distinctive character of the Opponent's earlier mark as a result of an association with the Applicant's MonkeyFace mark, which has the potential to reduce the value of the trade mark and to **affect the purchasing decisions** of consumers in the market place.

Section 5(4)(a) claim

8. Under the **section 5(4)(a)** ground the Opponent claims that use of the Applicant's mark was liable at its filing date to have been prevented by the law of **passing off**. The Opponent claims to have acquired substantial **goodwill** in the sign MONKEY SHOULDER in relation to **Scotch whisky**, having traded throughout the UK since at least 2004, such that use of the mark MonkeyFace in relation to the identical goods would constitute a **misrepresentation** to the public that is likely to cause **damage** to the Opponent's business.

Section 3(3)(a) claim

9. The Opponent also claims that the trade mark application must be refused on the basis of **section 3(3)(a)** of the Act, which prevents registration of trade mark where it would be

contrary to public policy or accepted principles of morality. This claim is based on a offensive and derogatory purported meaning of the phrase “monkey face” in urban slang, relating to what the Opponent describes as a deviant sexual act.

10. During the evidence rounds, the Opponent filed written submissions, dated 24 October 2018 (as amended 27 October 2018). The Opponent also filed evidence, which I summarise below. I shall refer to points submitted by the Opponent, in its statement of grounds and elsewhere, so far as I consider appropriate in this decision.

The Applicant’s defence and counterstatement

11. The Applicant is self-represented in these proceedings and filed a notice of defence and a **counterstatement** in which it contests all the grounds of the opposition. The Applicant filed no other submissions nor any evidence, and to give the Applicant its fullest voice in this decision, I here note the following points from its counterstatement:

- (i) The Applicant does not believe that MonkeyFace is “noticeably visually, conceptually and phonetically similar to Monkey Shoulder”;
- (ii) The Applicant states that “in Class 33, the word ‘monkey’ has been coined in over 60 alcohol trademarks; including ‘Monkey Fist’ and ‘Monkey Balls’”;
- (iii) In response both to the section 5(2)(b) and 5(4)(a) grounds, the Applicant states that it does not believe that the relevant public “*will be confused into thinking that [its] brand ‘MonkeyFace’ is actually the brand ‘Monkey Shoulder’, a Scotch whisky.*” The Applicant explains that ‘MonkeyFace’ is “*a shooter / shots alcoholic drink, made from molasses spirit, sugar syrup and artificial flavourings. It comes in three flavours Banana, Ice Coconut, and Passionfruit. It also contains an added stimulant, which is guarana. The three flavours are also uniquely identified by their 3 different colours: pink, yellow and blue. The appearance of MonkeyFace, including the branding, the label, the colours, and the bottle, are all totally different to the appearance of Monkey Shoulder. Even their websites are wholly dissimilar to each other.*”
- (iv) In response to the allegation of detriment to the Opponent’s brand arising from the claimed offensive meaning, the Applicant states that “*in previous correspondence received from Wildbore & Giibbons attorneys for the Opponent, they have quoted “The Urban Dictionary” as their source for this offensive meaning*”. The Applicant dismisses that allegation, contending that “*The Urban Dictionary” is a website created by silly*

teenagers for silly teenagers” and the Applicant does not “*believe that it holds any genuine influence or clout.*” The Applicant also points out that the same source (Urban Dictionary) provides a comparably “*derogatory and detrimental meaning*” in respect of the phrase ‘monkey shoulder’.

12. Neither party requested a hearing and submissions in lieu of a hearing were filed only on behalf of the Opponent (largely repeating the submissions it made during the evidence rounds). I take this decision based on a careful reading of the papers filed.

RELEVANT DATE

13. The Opponent must establish its claims under sections 5(2)(b), 5(3) and 5(4)(a) (regarding, respectively, likelihood of confusion, reputation and passing off¹) as at 30 January 2018, when the Applicant applied to register its mark (“the relevant date”).

EVIDENCE SUMMARY

14. The evidence, filed by the Opponent, comprises a **witness statement** of **Sarah Talland**, dated 24th October 2018, together with **Exhibits ST1 - ST7**. Ms Talland is a chartered trade mark attorney at the firm representing the Opponent, and her witness statement gives a brief account of each of the exhibits.
15. **Exhibit ST1** is a print-out of an article from www.scotchwhisky.com, dated 24 September 2018, entitled 'Top 10 Best Selling Scotch Malt Whiskies'. This evidence dates from after the relevant date, but reports back on relevant information from before that date. Having referred to the success of two “millionaire’ malts on the market, namely *Glenfiddich* and *The Glenlivet* (which both sell more than 1 million nine-litre cases a year), the article states² that “*the biggest mover*” (in the top ten) “*is not a single malt at all, but blended malt Monkey Shoulder, which enjoyed remarkable growth of more than 30% last year.*” The article shows MONKEY SHOULDER as number 7 in the 'top 10' listing (up from a ranking of number 10 in 2016), listing sales of 311,000 cases in 2017. (Ms Talland states that 'cases' in this context refers to equivalent 9 litre cases of whisky, being 12 x 70cl bottles.) The same profile states³ that the brand is popular in France, USA and duty free, but I note that it is not clear

¹ See for example, *Advanced Perimeter Systems Limited v Multisys Computers Limited* (Case BL O-410-11)

² Page 2, paragraph 5

³ Page 9 and 10 of the Exhibit

from the article to what extent there have been sales in the UK (nor is it clear to what extent the website targets or concerns a UK audience). The article states that the brand was “launched in 2005” and originally took all its whisky from three William Grant-owned distilleries, including Glenfiddich and Balvenie. The article states the name derives from a painful ailment suffered by malt men, who were sometimes left with one arm hanging down after long shifts of turning barley by hand. It states that the brand “*pushes mixing more than sipping*” and that “*as a brand, Monkey Shoulder is currently on fire, enjoying rapidly rising sales in the US, and has been named “trendiest Scotch whisky” by trade magazine Drinks International four years running.*”

16. **Exhibit ST2** shows an article from www.thespiritsbusiness.com dated 25 May 2018 entitled 'Monkey Shoulder's Monkey Mixer arrives in UK'. The article details a promotional tour – taking in London, Birmingham, Edinburgh and Oxford - focused on a “pimped out cement mixer truck”, branded with the Opponent mark, which serves as a cocktail shaker with capacity for 11,000 litres. This evidence relates to several months after the relevant date.
17. **Exhibit ST3** is an article from www.imbibe.com produced on 15 March 2017. The website is sub-titled as “for UK on-trade professionals”.⁴ The article details the “Monkey Shoulder Ultimate Bartender Championship’, a ten-week competition across the UK which is referenced as being “back for a fourth year”.
18. **Exhibit ST4** are (undated) printed extracts from the website www.monkeyshoulder.com which, Ms Talland highlights, show that the Opponent deploys the word 'monkey' as part of its advertising features. The extracts emphasise the mixing role of MONKEY SHOULDER in various cocktails, with recipe names such as 'Ginger Monkey' and 'Monkey Colada’.
19. **Exhibit ST5** shows two articles relating to a limited edition version of Monkey Shoulder called "SMOKEY MONKEY". The first article was produced on 2 August 2017 and is from www.thespiritsbusiness.com. The article refers to the product being 40% alcohol by volume and that it was about to be launched that month in the UK. (The second article was produced on 15 August 2018, after the relevant date, and is from www.whisky.com and focuses on the smokey version being launched in Germany. It shows the product and the label shows the Smokey Monkey name appearing as a sub-brand beneath MONKEY SHOULDER.)

⁴ I understand the term “on-trade” to refer to the selling of drinks on the premises of a bar or restaurant, as distinct from selling through a shop (which is off-trade).

20. **Exhibit ST6** is a marketing brochure, produced by ACA Live (seemingly an advertising agency) detailing several marketing campaigns said to have been used to promote the MONKEY SHOULDER product between 2009 and 2017. I glean the following information the exhibit: page 2: in 2014, 2015, 2016 and 2017 *“Monkey Shoulder has been voted the world’s top trending scotch by drinks international reports”*; page 3: that the brand *“was born”* in 2005; page 4: the promoters’ target demographic for the brand was *“men and women 25-35 ... a free-thinking group of adventurous new adults looking to explore the whisky category, but tired of the fustiness and inaccessibility of traditional Scotch brands”*; page 6: the brand’s fourth birthday was celebrated by a party for 500 guests in London in 2009; page 8: in 2010 the brand featured as a ‘tree-house’ installation at *“some of the UK’s major festivals including The Big Chill”* (and Bestival in 2011 – page 9); page 13: a pop-up branded bar in Shoreditch, East London in 2015; page 15 states that the brand featured at London Cocktail Week in 2016, hitting 50,000 samples in the year; page 17 refers to the brand’s presence at the Taste of London festival in 2017, in which year it achieved over 100,000 samples. Ms Talland’s witness statement refers specifically to a summer camp for bartenders, billed as ‘CAMP MONKEY’, but it is not apparent from the evidence where that camp has been held⁵ or who attended, so the reference has no relevance. Similarly, Ms Talland’s witness statement refers specifically to what is described as an educational podcast on iTunes under the title *“This one time at Camp Monkey”*. The free podcast is shown to have been released on 14 March 2018, after the relevant date, and there is no indication of its take-up, so again the reference has no relevance.
21. **Exhibit ST7** is an article from www.thespiritsbusiness.com produced on 23 July 2018 concerning a marketing campaign, said to have been called *“Make it Monkey”* that ran in airports around the world, including Hong Kong, Heathrow and JFK. Although this evidence relates to a time after the relevant date, the article states that as of May 2018, global travel retail of Monkey Shoulder had risen by 38% over the previous year.
22. That completes my summary of the evidence filed.

⁵ There is a reference to Sweden, but I noted no reference to the UK.

DECISION

The claim under section 5(2)(b) of the Act

23. The Opponent's claim is based on section 5(2)(b) of the Act, which states:

"... 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."

24. Section 6(1)(a) of the Act defines an "earlier trade mark", as including "a *registered trade mark ... which has a date of application for registration earlier than that of the trade mark in question ...*". The Opponent's mark was filed in June 2004, so is clearly an earlier trade mark under the Act. Since the mark relied on had been registered for five years or more when the Applicant's mark was published for opposition, it is potentially subject to the proof of use provisions under section 6A of the Act. Section 6A(6) provides as follows:

(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.

25. The Opponent's notice of opposition included a statement of use of the mark in respect of some of its goods, namely "whisky". The Applicant, in its response to Question 7 in its notice of defence, accepted the statement of use and did not require the Opponent to provide evidence of use. Consequently, for the purposes of its section 5(2)(b) claim, the Opponent is able to rely on its mark for the goods identified in its statement of use, namely whisky. (The Opponent is not able to rely on the full range of registered goods in its specification: *Alcoholic beverages.*)

26. The following decisions of the EU courts provide the principles to be borne in mind when considering section 5(2)(b) of the Act:

Sabel BV v Puma AG, Case C-251/95;
Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc, Case C-39/97;
Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V. Case C-342/97;
Marca Mode CV v Adidas AG & Adidas Benelux BV, Case C-425/98;
Matratzen Concord GmbH v OHIM, Case C-3/03;
Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH, Case C-120/04;
Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P; and
Bimbo SA v OHIM, Case C-591/12P.

27. The principles are that:

- (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 the goods

The goods to be compared are both in Class 33:

Opponent’s goods	Applicant’s goods
<i>Whisky</i>	<i>High strength, spirit based, alcoholic beverage</i>

28. In *Gérard Meric v Office for Harmonisation in the Internal Market (OHIM)*, the General Court stated⁶ that goods can be considered as identical when the goods designated by the earlier mark are included in a more general category designated by the trade mark application (and vice versa). The Opponent’s relies only on “whisky”; the Applicant has applied to register its mark for “*High strength, spirit based, alcoholic beverage*”. Whisky is a high strength spirit and alcoholic beverage and so, based on *Merica*, those goods may be considered as **identical**. If there is any doubt as to identity arising from the implication of “spirit-based” beverages – then I find the goods **at least very highly similar** taking into account factors identified by the Court of Justice of the European Union (“the CJEU”) in *Canon*⁷ such as their nature, intended purpose, method of use and whether they are in competition with each

⁶ Case T- 133/05 at paragraph 29 of that judgment.

⁷ Case C-39/97, at paragraph 23.

other or are complementary, and the factors identified by Jacob J. (as he then was) in the Treat case,⁸ including the respective users, trade channels and likely shared locations in supermarkets.

The average consumer and the purchasing process

29. It is necessary to determine who is the average consumer for the respective goods and how the consumer is likely to select the goods. It must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods in question.⁹ In *Hearst Holdings Inc*,¹⁰ Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect ... the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The word “average” denotes that the person is typical... [it] does not denote some form of numerical mean, mode or median.”

30. The average consumer in this case will be drawn from the adult general public. Alcoholic drinks such as the goods at issue may be bought in supermarkets, off-licences, department stores, at duty-free outlets and so on. The online equivalents of such businesses are also relevant. This all suggests a more visual selection process, where a consumer will peruse shelves and browse the internet to select the goods. While the goods may also be purchased in bars and similar establishments, where they may be requested orally, the goods will still, ordinarily, be on display so that they can be seen.¹¹ Therefore, overall, I consider the purchase to be a primarily visual one, but aural considerations may also play a part, such as on the basis of word of mouth recommendations and requests, so I also take into account the aural impact of the marks in the assessment. I find that in buying the goods at issue in this case a medium or average level of care will be taken by the average consumer.

⁸ *British Sugar PLC v James Robertson & Sons Ltd* [1996] R.P.C. 281

⁹ *Lloyd Schuhfabrik*, cited above

¹⁰ *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch),

¹¹ See *Simonds Farsons Cisk plc v OHIM* Case T-3/04

31. In the pleadings section of this decision, I noted the reference in the Applicant’s counterstatement as to the parties having dissimilar websites. Within its counterstatement, the Applicant provides “in evidence”, the URL of its own website. It should be noted that the provision of that website address does not constitute ‘evidence’ for legal proceedings because it lacks the formalities required to that end (such as a statement of truth and relevantly dated print-outs from the site, not simply an electronic link wherein the content might be subject to change as at different dates of viewing). Moreover, those marketing considerations are not relevant in deciding these opposition proceedings, because marketing approaches are open to change and are not the subject of protection of the Opponent’s earlier rights.

Comparison of the marks

32. It is clear from *Sabel* that the average consumer normally perceives a 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 marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated in *Bimbo* 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.”

33. It would therefore be wrong to dissect the trade marks artificially, but it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features that are not negligible and therefore contribute to the overall impressions created by the marks. The marks to be compared are shown below:

Opponent’s earlier registered trade mark:	MONKEY SHOULDER
Applicant’s contested trade mark:	MonkeyFace

34. The overall impression of the Opponent's mark arises from the combination of the words "monkey" and "shoulder". The overall impression of the Applicant's mark arises from the combination of the words "monkey" and "face".

Visual similarity

35. Both marks are visually similar to the extent that they share the same opening word. However, they plainly differ in their second words – and the words 'face' and 'shoulder' have no visual similarity. The word 'shoulder' is slightly longer than the word 'monkey', whereas the word 'face' is shorter than the word 'monkey' – this differential contributes a further visual difference overall. The Applicant's mark presents its two component words as a single conjoined word, but the two words are immediately apparent – and would be so even without the retained capital F (which possibility would be permitted by fair and ordinary use of the applied-for word mark, just as the Opponent's mark may be presented in title case). I find that the marks may be considered visually similar - at most - to a medium degree.

Aural similarity

36. Both marks are aurally similar to the extent that they share the same opening word, but plainly differ in their second words – and the word single-syllable word 'face' has no aural similarity with the two-syllable word 'shoulder'. I find that the marks may be considered aurally similar - at most - to a medium degree.

Conceptual similarity

37. The Opponent's submissions refer to the coincidence of "*the word 'monkey' followed by a word which represents a part of the human or animal anatomy*". I acknowledge some conceptual similarity in those broad terms, but I find that the marks also involve notable conceptual differences. The differences arise from the distinctly different parts of a body referenced in the marks and from the impressions the marks will likely make on the average consumer. The Opponent's evidence (**Exhibit ST1**) reveals a possible origin for the phrase 'monkey shoulder', referring to an ailment of malt men, but the average consumer will be unaware of that somewhat obscure derivation. I find that the earlier mark will strike the average consumer as very unusual combination of words with no readily graspable familiar resonance. This is largely attributable to the unusual inclusion of the word 'shoulder'. By contrast, I find the selection of "face" to be rather less fanciful or obscure, such that the

chosen combination of words in the Applicant's mark will create a different conceptual impression on the average consumer; for example, the phrase might may evoke a notion of cheekiness. At any rate, the overall conceptual impact of the marks is different, and I find the marks conceptually similar to a low degree. I note the Opponent's suggestion that one meaning of 'monkey face' refers to a sexual act. I do not consider such a reference to be widely known and I exclude that meaning of the phrase from my conceptual comparison; however, if that meaning were accepted then it would point to a different concept from monkey shoulder, suggesting conceptual dissimilar between the marks.

38. Taking account of the degrees of similarity from visual, aural and conceptual perspectives, I find the marks similar overall to a degree between low and medium.

Distinctive character of earlier trade mark

39. The distinctive character of the earlier mark must be considered. In *Lloyd Schuhfabrik*¹² 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

*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).”*

¹² *Lloyd Schuhfabrik*

40. Neither word of the earlier mark is invented; each is an ordinary English word. Notwithstanding the obscure association with malt men identified in Exhibit ST1, the phrase “Monkey Shoulder” is not at all descriptive or suggestive of the goods (whisky). On an inherent basis, the mark has a normal or average level of distinctiveness. The level of distinctiveness of a mark may be enhanced through use, although it is primarily UK use that counts for enhanced distinctiveness because the issue is the effect that any use has on the perception of the UK consumer. The Opponent has filed evidence that shows use of its mark in various promotional campaigns in the UK over a number of years (for example **Exhibit ST6**) and that the brand has made sales on a global scale that place it in the top ten scotch whisky brands (**Exhibit ST1**). There are shortcomings in the evidence – for example, in terms of identifying market share or levels of sales in the UK and the absence of figures on amounts spent on advertising and promotion. However, on the indicative scale and duration of the brand’s promotion and global sales, which include the UK, I find on balance that the mark may have achieved an enhanced level of distinctiveness in relation to whisky. Since much of the evidence is not specific to the UK, I do not consider the mark shown to be very highly distinctive, but I allow that it may be considered highly distinctive (for whisky).

Conclusion as to likelihood of confusion

41. Confusion can be either direct (which in effect occurs when the average consumer mistakes one mark for the other) or indirect (where the average consumer realises the marks are not the same, but puts the similarity that exists between the marks/goods down to the responsible undertakings being the same or related). Indirect confusion (and the difference between direct confusion), was considered by Iain Purvis QC, sitting as the Appointed Person¹³, in *L.A. Sugar Limited v By Back Beat Inc*,¹⁴ where he noted that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognised that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees

¹³ An Appointed Person is a senior lawyer, expert in intellectual property law, who hears appeals against decisions of the trade mark tribunal.

¹⁴ Case BL-O/375/10

the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case)

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

42. No likelihood of confusion arises where a later mark merely calls to mind the earlier mark (mere association). Sitting as the Appointed Person in *Eden Chocolat*¹⁵, James Mellor QC stated as follows:

“81.4 ... I think it is important to stress that a finding of indirect confusion should not be made merely because the two marks share a common element. When Mr Purvis was explaining¹⁶ in more formal terms the sort of mental process involved at the end of his [16], he made it clear that the mental process did not depend on the common element alone: ‘Taking account of the common element in the context of the later mark as a whole.’ (my emphasis).”

¹⁵ Case BL O-547-17 *Eden Chocolat be more chocstanza (word & device) v Heirler Cenovis GmbH* (27 October 2017)

¹⁶ In *L.A. Sugar* – above.

43. Deciding whether there is a likelihood of confusion is not scientific; it is a matter of taking account of my findings set out in the foregoing sections of this decision in light of relevant case law, including the principles set out at paragraph 26 above. The factors have a degree of interdependency and must be weighed against one another in a global assessment;¹⁷ they must be considered in light of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect and a determination made as to whether such a person is likely to be confused (whether directly or indirectly).
44. In assessing similarity between the goods in this case, I have found that the Opponent's goods – whisky – might be considered identical to the goods specified by the Applicant, or else that there is at least a very high degree of similarity between whisky and *high strength, spirit based, alcoholic beverage*. In assessing similarity between the marks, I have found that overall, the marks are similar to a degree between low and medium, with the degree of similarity from a visual and aural perspective no higher than medium.
45. I have found that the earlier mark benefits from an average degree of inherent distinctiveness and I am allowing that the evidence of use of the mark in the UK is sufficient to enhance its distinctiveness, such that the earlier mark is highly distinctive in relation to whisky. I note that in *Kurt Geiger v A-List Corporate Limited*,¹⁸ Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar. He said:
- “38. The Hearing Officer cited *Sabel v Puma* at paragraph 50 of her decision for the proposition that 'the more distinctive it is, either by inherent nature or by use, the greater the likelihood of confusion'. This is indeed what was said in *Sabel*. However, it is a far from complete statement which can lead to error if applied simplistically.
39. It is always important to bear in mind what it is about the earlier mark which gives it distinctive character. In particular, if distinctiveness is provided by an aspect of the mark which has no counterpart in the mark alleged to be confusingly similar, then the distinctiveness will not increase the likelihood of confusion at all. If anything it will reduce it.”

¹⁷ *Canon* at [17]; *Sabel* at [22].

¹⁸ BL O-075-13

46. In other words, simply considering the level of distinctive character possessed by the earlier mark is not enough. It is important to ask 'in what does the distinctive character of the earlier mark lie?' Only after that has been done can a proper assessment of the likelihood of confusion be carried out. In this case, I have found that the distinctive character of the earlier mark lies in the combination of the two words "monkey" and "shoulder". That distinctive combination is not replicated in the Applicant's mark. Despite the references in the evidence to 'monkey' without the word 'shoulder' – as in monkey mixer, ginger monkey, camp monkey, smokey monkey - the evidence falls far short of demonstrating distinctiveness of the Opponent's mark in relation to its goods on the basis of use of that one word only.
47. I take into account my earlier findings on the visual and aural considerations in the purchasing process and that the visual and aural similarities might be assessed as medium (at most); I also bear in mind that the average consumer rarely has the chance to make direct comparisons between marks and must instead rely upon their imperfect mental picture of them. Nonetheless, in my global assessment, I do not find that the great degree of similarity between the goods at issue offsets the lesser degree of similarity between the parties' marks in such a way that would lead to a likelihood of *direct* confusion. The average consumer, on encountering the marks, paying an average degree of attention (or even a low degree) will not mistake one mark for the other. The average consumer will notice the absence of the word 'shoulder', a key ingredient in the distinctiveness of the combination of the words of the earlier mark. For the avoidance of doubt, although the Applicant has referred to the existence of other marks for goods in Class 33 containing "monkey", this is not a factor in my decision. The Applicant has put forward no evidence of use of such marks or of whether the average consumer will more readily distinguish between monkey-based marks.
48. As to indirect confusion, the average consumer may notice that the marks have something in common in that they share the same opening word, which is coupled with the name of part of the body. However, when I bear in mind the guidance at paragraph 17(a) of the *LA Sugar* case cited above, I do not find that the common element is so strikingly distinctive that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. Firstly, I note that in contrast to "Tesco" in Mr Purvis's example, 'monkey' is not an invented word, and secondly, it is the combination of 'monkey' with the particular word 'shoulder' that is strikingly distinctive, and that combination is not the common element.

49. I also give consideration to the brand extension scenarios envisaged in LA Sugar. The paragraph 17(b) scenario is clearly inapplicable; paragraph 17(c) envisages *a change of one element of the earlier mark that appears such that it is entirely logical and consistent with a brand extension*. Since I find that it is the combination of ‘monkey’ with the particular word ‘shoulder’ that is strikingly distinctive, there seems to me no natural brand extension suggested by the formulation that is the Applicant’s mark. There is no suggestion that the Opponent has a family of marks based on ‘monkey’ plus a part of the body. However, even though MonkeyFace may not be a natural brand extension, I bear in mind that the Monkey Shoulder mark is highly distinctive for whisky. In that context, I find that at least a substantial portion of the adult general public (being the average consumer in this case) may find the possibility that the Opponent has brought out a variant product under the mark MonkeyFace more likely than there being two “MONKEY + human body reference” marks in use in relation to whisky. This reasoning depends heavily on the reputation and distinctiveness of the earlier mark for whisky; therefore it would not apply to alcoholic beverages other than whisky or those based on whisky.
50. Although the goods may be considered as identical on the inclusion principle expressed in *Meric*, if the Applicant’s broad category of goods were limited to exclude the goods on which the Opponent relies, a likelihood of confusion would be avoided. In this context I take account of the guidance provided by Tribunal Practice Notice (1/2012), which deals with partial refusals of applications to register a trade mark. In the present case the Applicant has offered no fall-back position in the form of a limited specification, although it was invited to do so by the official letter from the registry at the conclusion of the evidence rounds. Nonetheless, since the Applicant’s counterstatement makes clear that its defence lies in part on the Applicant’s belief that *“the public will not be confused into thinking that [its] brand ‘MonkeyFace’ is actually the brand ‘Monkey Shoulder’, a Scotch whisky”* I consider it both practical and proportionate, in line with my findings on indirect confusion, to add to the Applicant’s specification a “save for” provision that expressly excludes the goods relied on by the Opponent.
51. **Consequently, the section 5(2)(b) claim partially succeeds on the basis of indirect confusion, such that - subject of course to this decision’s consideration of the other grounds of the opposition - the application may proceed only on the basis of the**

following reformulation of its specification of goods in Class 33: *High strength, spirit based, alcoholic beverages excluding whisky and goods containing whisky.*

The claim under section 5(3) of the Act

52. Section 5(3) of the Act states that a trade mark that is similar to an earlier trade mark shall not be registered to the extent that the earlier trade mark has a reputation in the United Kingdom and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.
53. The relevant case law for section 5(3) can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel Corporation*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L'Oreal v Bellure*, Case C-487/07 and Case C-323/09, *Marks and Spencer v Interflora*. 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; *General 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 Saloman, 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*.
- (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 proprietor 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*).

54. The function and value of a trade mark are not confined to its being an indicator of origin of goods or services (which section 5(2)(b) safeguards); a trade mark can also convey messages, such as a promise or reassurance of quality or a certain image of, for example, lifestyle or exclusivity ('advertising function').¹⁹ Section 5(3) aims at protecting this

¹⁹ (judgment of 18/06/2009, C-487/07, L'Oréal, EU:C:2009:378)

advertising function and the investment made in creating a certain brand image by granting protection to reputed trade marks, irrespective of the similarity of the goods or services or of a likelihood of confusion, provided that it can be demonstrated that the use of the contested application without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark. Thus, for a claim under section 5(3) of the Act to succeed, requires (i) **identity or similarity** between the contested application and the earlier mark; (ii) evidence that the earlier **registered mark has a reputation** in the relevant territory (in this case, the UK); (iii) that use of the sign applied for must be capable of taking an unfair advantage of, or being detrimental to, the distinctiveness or the repute of the earlier mark; and (iv) that such use must be **without due cause**. These conditions are **cumulative** and failure to satisfy any one of them is sufficient to defeat the claim.

55. *Similarity*: As to criterion (i) above, in my assessment under the section 5(2)(b) claim, I have found, overall, the parties' marks are similar to a degree between low and medium. For the purposes of section 5(3), the Opponent's mark satisfies the requirement of being "similar" to the Applicant's mark.
56. *Reputation*: In respect of its claim under **section 5(3)** of the Act, the Opponent claims to have acquired a **reputation** for **whisky** among UK consumers having extensively used its registered trade mark over a number of years. The statement of grounds refers to use since at least 2004; the evidence refers to launch of the brand in 2005 (**Exhibits ST1 and ST6**); and the Opponent's submissions in lieu refer to the evidence demonstrating use of its mark since 2009, such that the mark has "acquired a reputation owing to the longstanding and extensive use of the mark MONKEY SHOULDER in the UK for over 9 years in relation to alcoholic beverages, namely whisky."
57. To show that an earlier mark has acquired a reputation there must be clear and convincing evidence to establish all the facts necessary for a tribunal to conclude safely that the mark is known by a significant part of the public. Reputation cannot be merely assumed and must be evaluated by making an overall assessment of all factors relevant to the case.
58. The CJEU in *General Motors* gives guidance on assessing the existence of a reputation. Paragraph 27 of that judgment requires that I "*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.” Those factors also arose in the assessment of enhancement of distinctive character²⁰ where I allowed for a finding that the Opponent’s evidence of use of its mark was sufficient to enhance its distinctiveness. However, that was a different context, so I proceed to consider to an assessment of those factors as part of an overall assessment reputation.

59. In *Enterprise Holdings Inc. v Europcar Group UK Ltd*,²¹ Arnold J. stated that proving a reputation “*is not a particularly onerous requirement.*” However, the evidence before Arnold J. in that case showed that the claimant was in fact the market leading car hire company in the UK with a 30% share of the UK market. It was in that context that the judge said that proving a reputation “*is not a particularly onerous requirement.*” He had no reason to turn his mind to situations where the claimant had only a small and/or unquantified share of the relevant market.
60. In the present case, it is clear that the earlier mark has enjoyed at least two years in the top ten best-selling scotch whiskies (**Exhibit ST1**), and whereas its distillery stable-mate (Glenfiddich) is named-checked as one of the outlying million-case malts, Monkey Shoulder sold over 300,000 cases in 2017 (over 3.5 million bottles of whisky). I consider those impressive sales volumes (the number of units sold), but the evidence is not clear how this bears on the UK market (as opposed to around the world). The evidence filed does not give clear information on the size of the UK whisky market, nor the earlier mark’s share of it. Nor are figures given on UK turnover (the total value of those sales) for goods bearing the Opponent’s mark.
61. Nonetheless, I take note of the comments of the General Court in *Farmeco AE Dermokallyntika v OHIM*,²² where it stated that a finding that an earlier mark had a reputation “*... is not called into question by the applicant’s argument that the turnover figures for sales and the amount spent on promoting the goods covered by the earlier marks ... have not been proved. It should be pointed out that the absence of figures is not, in itself, capable of calling into question the finding as to reputation. First, the list of factors to be taken into consideration in order to ascertain the reputation of an earlier mark only serve as examples, as all the relevant evidence in the case must be taken into consideration and, second, the*

20 See extract from *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 above

21 [2015] EWHC 17 (Ch)

22 Case T-131/09 at paragraph 59

other detailed and verifiable evidence produced by the opposing party is already sufficient in itself to prove the reputation of its mark ...”.

62. Therefore, the concerns about the clarity of the Opponent’s evidence on UK market share and the lack of figures on turnover are not necessarily fatal; it depends on what else the Opponent has been able to prove to contribute towards establishing its claim of reputation. There are references (**Exhibits ST1** and **ST6**) to the brand attracting accolades in four consecutive years as a high-trending whisky by trade magazine Drinks International, but again the implications for the UK market are unclear. There is little evidence from UK trade bodies, although I note the brand’s sponsorship of the bartender competition (**Exhibit ST3**). Again, no figures are provided in evidence on amounts spent on promotion and advertising in the UK, although I do note the evidence of year-on-year installations at UK music and food festivals. Case law has made clear that reputation constitutes a knowledge threshold.²³ The evidence does not indicate numbers of attendees who may have encountered the Opponent’s mark in the context of the festivals mentioned (**Exhibit ST6**) although it does indicate the distribution of over 100,000 samples in 2017. Taking the evidence overall, I am prepared to find that at the relevant date the mark enjoyed a qualifying reputation for whisky in the UK, although the evidence is insufficient for me to gauge the true strength of that reputation.
63. Having found that the mark was known by and enjoyed a reputation for whisky among a significant part of the relevant public, I proceed to consider whether or not a link will be made between the earlier mark and the Applicant’s mark, bearing in mind all relevant factors as required by *Intel, paragraph 42*. I take account of the level of similarity between the marks (between low and medium) and the inconclusive strength of the earlier mark’s reputation; just as I comparably found a limited scope for indirect confusion under section 5(2)(b) I find that, on encountering the later mark, a significant part of the relevant public, familiar with the Opponent’s whisky, is likely to make a link or call to mind the Opponent’s earlier mark, only if the goods under the Applicant’s mark were to comprise or contain whisky. For such whisky/whisky-based goods, that link would cause damage (at least) in terms of detriment to the distinctive character of the earlier mark if it causes confusion as to the source of the Applicant’s goods. **The claim under section 5(3) succeeds to that extent.** However, I

²³ See for example para 69 of judgment of Judge Hacon in *Burgerista Operations GmbH v Burgista Bros Limited* Case No: IP-2015-000175 [2018] EWHC 35 (IPEC)

also find that use in relation to non-whisky based goods would not cause a link to be made, in which case there can be no detriment or unfair advantage. Therefore **the claim under section 5(3) fails in relation to same exclusion that has been achieved in light of my findings under the section 5(2)(b) ground.**

The claim under section 5(4)(a) of the Act

64. Under the section 5(4)(a) ground the Opponent claims that use of the Applicant's mark was liable at its filing date to have been prevented by the law of passing off. The Opponent claims to have acquired substantial goodwill in the sign MONKEY SHOULDER in relation to Scotch whisky, having traded throughout the UK since at least 2004, such that use of the mark MonkeyFace in relation to the identical goods would constitute a misrepresentation to the public that is likely to cause damage to the Opponent's business.
65. In light of my consideration of related issues earlier in this decision, I shall deal with ground relatively briefly. I note that the evidence does not actually demonstrate sales in the UK – the Monkey Mixer UK promotional tours (**Exhibit ST2**), and the Make it Monkey marketing campaign taking in Heathrow (**Exhibit ST7**) relate to after the relevant period. However, in light of the evidence of the brand's significant presence at the major festivals over several years, I accept that the Opponent has goodwill in the sign Monkey Shoulder in relation to whisky.
66. Passing off also requires a misrepresentation likely to lead to deceive the public into believing that the goods offered by the defendant are those of the claimant. While the seminal case of passing off might have required direct misrepresentation by the defendant to the effect that the goods or services it is offering are the goods or services of the claimant, the tort has expanded subsequently to include representations that merely suggest a commercial connection between both parties. Paragraph 184 of Halsbury's Laws of England (4th Edition) Vol. 48 (1995 reissue) provides the following guidance (with footnotes omitted):

“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."

67. There is no need for the representation to be made by the defendant with the intention that confusion will result; the real issue is the effect on the consumer and whether they would believe that there is an association between the defendant's goods/services and the reputation of the claimant. Thus, again on a comparable basis as for my above findings of indirect confusion and/or of a link, I find scope for misrepresentation and consequent damage, but only if the goods under the Applicant's mark were to comprise or contain whisky. **The claim under section 5(4)(a) succeeds only to the same extent as the other grounds.**

The claim under section 3(3)(a) of the Act

68. Section 3(3)(a) of the Act provides that a trade mark shall not be registered if it is contrary to public policy or to accepted principles of morality. I note the Applicant's reference in its counterstatement to correspondence between the parties in which the Opponent's legal

representatives are said to have “*The Urban Dictionary*” as their source for the claimed *offensive meaning*. However, no evidence has been filed to support the Opponent’s claim that the phrase “monkey face” will be perceived to carry an offensive and derogatory meaning. I anyway consider the reference unreliable and unsupported by other evidential sources. In the absence of evidence, I reject the submission that the average consumer would perceive the claimed meaning; **the claim under section 3(3)(a) of the Act fails.**

OVERALL OUTCOME:

In light of the findings in this decision, the opposition succeeds only partially - insofar as it results in the following reformulation of the Applicant’s specification of goods:

Class 33: *High strength, spirit based, alcoholic beverage* excluding whisky and goods containing whisky

COSTS

69. The Opponent has achieved a measure of success in these proceedings, but so too has the Applicant. In the circumstances, I make no costs award in favour of either party - each shall bear its own costs.

Dated this 25th day of June 2019

Matthew Williams
**For the Registrar,
the Comptroller-General**
