

O-645-19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3315131 BY
ABHISHEK BAGCHI**

TO REGISTER THE TRADE MARK:



FOR GOODS IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION TO ITS REGISTRATION
UNDER NO. 413567
BY
CHIVAS HOLDINGS (IP) LIMITED**

Background and pleadings

1) On 3 June 2018 Mr. Abhishek Bagchi applied to register the following trade mark for the following goods:



Class 33: *Scotch whisky.*

The application was published for opposition purposes on 29 June 2018.

2) The application is opposed by Chivas Holdings (IP) Limited (“the Opponent”). The opposition, which is directed against all the goods applied for, is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”), for the purposes of which the Opponent relies upon UK trade mark registration 3249712 for the following mark and goods:

AN REIDHE

Class 33: *Scotch whisky.*

The Opponent’s mark was filed on 11 August 2017 and completed its registration procedure on 01 December 2017.

3) The significance of the respective dates given above is that (1) the Opponent’s mark constitutes an earlier mark in accordance with section 6 of the Act, and (2) it is not subject to the proof of use conditions contained in section 6A of the Act, its registration procedure having been completed within five years before the publication of Mr Bagchi’s mark.

4) The Opponent is represented by Marks & Clerk LLP. Mr. Bagchi’s counterstatement was filed by Shazaib Amin Malik, but United Legal Experts were

appointed as Mr Bagchi's representatives during the course of these proceedings. The Opponent's claim is that the strong overall similarity of the respective marks and the identical goods covered by them will give rise to a likelihood of confusion on the part of the consumers, including a likelihood of association. Mr. Bagchi filed a notice of defence and counterstatement, denying the grounds of opposition. During the evidence rounds the Opponent filed submissions, Mr Bagchi filed a witness statement, and the Opponent filed submissions in reply. I therefore give this decision after a careful review of all the papers before me.

Evidence and submissions

5) The Opponent's statement of grounds of opposition contained what amount to submissions, and appended to these were two exhibits (Exhibits 1 and 2) intended to show the frequent use of the word "Glen" in the names of Scotch whisky. In a letter from the Registry the Opponent was advised that these exhibits were considered evidential, and not required at the pleadings stage, but that they could be admitted during the evidence rounds later. During the evidence rounds the Opponent then submitted "observations in reply to the Applicant's Defence and counter-statement", dated 9 January 2019; these consisted of submissions, and referred to the exhibits originally appended to the Opponent's statement of grounds. The Opponent was asked by the Registry to confirm that Exhibits 1 and 2 were "to be admitted into the proceedings alongside your submissions", and the Opponent did so in an email of 28 January 2019. A copy of the original form TM7 including the exhibits was sent to Mr. Bagchi. It was not explained that, since Exhibits 1 and 2 had not been filed in proper evidential format, they could not be admitted *as evidence*.

6) As a result, Exhibits 1 and 2 to the Opponent's statement of grounds have not been admitted as evidence in these proceedings. I have considered whether this omission should be rectified by asking the Opponent to resubmit them in proper evidential format, but have decided that, in the circumstances of this case, this would be inappropriate and unnecessary. I begin by noting that the Opponent's Exhibits 1 and 2 were communicated to Mr Bagchi and that he responded to them in his witness statement in a rather disjointed sentence in which, while seeming to admit that "Glen" is used by others, he disputes that it is common (*Even the word GLEN is used by so*

many user which does not mean that it lead as common word which opponent tried to portray”). Exhibit 1 (consisting of a list of trade marks registered for Class 33 and beginning with the word “Glen” on the UK trade marks register) would in any case have been problematical as evidence. This is principally because it is well established in the case law that that the relevant factor for the purposes of disputing the distinctive character of an element is its actual presence on the market (so as to influence consumer perceptions) and not its presence in registers or databases¹. That objection, however, does not apply to Exhibit 2, which consists of a print-out from the website of the on-line specialist retailer *The Whisky Exchange*, showing many Scotch whisky brands beginning with GLEN.

7) Consumers seeking to purchase spirits in bars and restaurants or in retail outlets such as supermarkets in the UK can scarcely fail to be aware that it is not unusual for Scotch whisky brands to consist of Scottish place names beginning with the word “Glen”. The evidence which would become available by admitting the Opponent’s Exhibit 2 is therefore not necessary to persuade me that the average consumer in the UK would accord the element “Glen” relatively limited weight in distinguishing Scotch whisky brands from one another. I therefore consider it would serve no practical purpose to delay these proceedings further, and to add unnecessarily to costs, by affording an opportunity at this late stage of admitting Exhibits 1 and 2 in evidence, particularly in view of the fact that Mr Bagchi has in any case responded to the content of the those exhibits in his witness statement.

8) Mr. Bagchi was granted an extension of time to allow him to put into an acceptable format evidence which had been filed late on 11 April. His evidence, dated 23 May 2019, was finally accepted and sent to the Opponent on 30 May 2019. Following some confusion, occasioned when the Opponent filed what were in fact submissions under the heading “Opponent’s further evidence of fact in reply”, these submissions, dated 31 July 2019, were accepted and communicated to Mr Bagchi on 22 August 2019.

¹ See, for example, the General Court’s judgments of 25 May 2016, *Ice Mountain Ibiza v EUIPO — Marbella Atlantic Ocean Club (ocean beach club ibiza)*, T 5/15, paragraph 35 and the case-law cited, and of 8 November 2017, *Pempe v EUIPO — Marshall Amplification (THOMAS MARSHALL GARMENTS OF LEGENDS)*, T 271/16, paragraph 98 and the case-law cited

9) In his witness statement Mr. Bagchi states: that the opposed mark was first used in the UK in 2018 by Glenreidh Liquor Ltd; that “the annual sale is around £1 million before the filing of the application”; that “£2 million globally” was spent on promoting “the goods/services before the date of application; and that “Applicant invested around £2 million in preparation to export the products to UK which we stopped because of this matter and until the resolution of this matter”. Mr Bagchi continues:

“The applicant is manufacturing its brand which is already in the market, however, no such evidence is shown the existence of AN REIDHE physically as well as online. Please see Exhibit AB2 and AB3 which shows google search reports of both marks. However, the applicant has much more existence of its brand in the market as well as online and globally as well, which the examiner can cross check and verify.”

10) Exhibit AB2 consists of an extract from a Google search for “AN REIDHE”. Below the indication “about 225,00 results” three result are shown, one of which provides links to three YouTube videos with no immediately apparent connection to the term AN REIDHE, and two of which provide links relating to Irish grammar. Exhibit AB3 consists of an extract from a Google search for “GLENREIDH”. Below the indication “about 2,290 results” four results are shown: a link to: “Glenreidh Corporation: Home” at <https://glenreidh.com>; links to “Glenreidh Corporation” on LinkedIn and Glenreidh (@glenreidh) on Twitter; and a link “Glenreidh Blended Malt Scotch Whisky – Buy Whisky, Scotch, Premium ...” at www.alibaba.com, the latter, rather oddly, also including the rather oddly contextually isolated indication “US \$ 1.00”.

11) As noted above, since the registration procedure of the Opponent’s mark was completed less than five years before the publication of Mr Bagchi’s mark, the Opponent is under no obligation under section 6A of the Act to show that its mark has been used. With regard to the use of Mr Bagchi’s mark: he has not pleaded or explicitly claimed goodwill giving rise to an earlier right, or acquiescence, or lack of confusion in the marketplace; but even if he had raised such claims, much clearer and more specific and detailed evidence of the extent of his use of the opposed mark in the UK would be required to establish them. In view of the fact that the earlier mark was filed on 11

August 2017 the existence of goodwill giving rise an earlier right is in any case excluded by Mr Bagchi's statement that the opposed mark was first used in the UK in 2018². Nor, in the light of Mr. Bagchi's assumption that the Opponent's mark has not been used, could evidence of use of Mr. Bagchi's mark possibly establish actual lack of confusion in the marketplace. My assessment of the likelihood of confusion must in these proceedings be based on a notional comparison of the marks. Whether Mr Bagchi's or the Opponent's mark has yet been used on the UK market is irrelevant in the present case.

12) Other points arising from the evidence and submissions of the parties can be discussed more conveniently during my examination of the issues below.

Section 5(2)(b)

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

“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”.

14) The following principles are gleaned from the decisions of the Court of Justice of the European Union (“CJEU”) in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v 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:

² Moreover, even if an earlier right could be established, it would not constitute a valid defence in the context of the present proceedings. This is explained in the Tribunal Practice Notice TPN 4/2009 at paragraphs 4-5.

(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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

The average consumer and the purchasing process

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

16) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

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

17) The average consumer of whisky will be an adult member of the general public. The goods will be sold in retail outlets such as supermarkets and off-licences (where the mode of selection will be primarily visual, though the goods may be requested

orally) or online (where the mode of selection will be primarily visual) or in licensed premises such as pubs, bars and restaurants (where they will be ordered verbally, but may be visible on optics or otherwise displayed behind the bar on on menus). The purchasing process is therefore largely a visual one, but I shall not ignore the potential for oral use of the mark in my assessment.

18) In his counterstatement Mr Bagchi submits that people who drink Scotch whisky “must always choose the brand of their own choice”, will exercise an above average degree of care and attention, and “can differentiate the marks easily”. While I agree that some expensive whiskies may involve relatively careful selection by whisky connoisseurs, Scotch whisky is available in a range of prices, and would usually be regarded as a normal everyday consumer product rather than a luxury item. The degree of care and attention paid in the selection process will vary between the more discerning purchaser and the less careful purchaser who makes a snap decision at the bar or in the shop. Generally speaking, given the cost and frequency of purchase, I consider the degree of care and attention which will be paid overall to the purchase of Scotch whisky to be average: neither higher nor lower than the norm.

Comparison of goods

19) The goods are identical.

Comparison of the marks

20) It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) 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 at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means

of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

21) It would be wrong, therefore, to dissect the trade marks artificially, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

22) The marks to be compared are shown below:

The opposed mark	The earlier mark
	<p data-bbox="938 1104 1353 1167">AN REIDHE</p>

Mr Bagchi’s counterstatement and the Opponent’s submissions Of 9 January 2019 contain conflicting statements about the etymology or meaning of “reidh” and “an reidhe”, but these brief, bald statements are in neither case supported by evidence from authoritative sources. In the absence of such authoritative evidence, I am unable to reach any conclusion on the significance of these words for modern Gaelic-speakers in the UK. The overwhelming majority of UK consumers, however, are English-speakers with no knowledge of Gaelic. For them, the REIDH of Mr Bagchi’s mark and the earlier mark’s AN REIDHE will have no meaning.

23) The opposed mark consists of the word GLENREIDH in stylised lettering against a plain, dark, rectangular background. These graphic elements of the opposed mark are not negligible, but the word element is heavily predominant in the mark’s distinctive

character and overall impression. For the average UK consumer the words “an reidhe” in the earlier mark will have no meaning and, being neither descriptive nor allusive, will have distinctive character. I think, however, that the brevity of the initial AN will result in the more substantial REIDHE tending to predominate in the overall impression of the mark.

24) Visually, the graphic elements of the opposed mark described above are missing from the earlier mark, thus providing an element of difference; but I must also bear in mind that notional and fair use of the earlier word mark would cover its use in any font³ and that, not being limited to colour, the earlier mark is registered in respect of all colours⁴. Although GLENREIDH is written as one word in the opposed mark, GLEN is presented in white, whereas REIDH appears in a light orange-brown colour, so that the eye very clearly distinguishes them; indeed, they stand out as quite distinct elements.

25) There is a rough rule of thumb that the consumer normally attaches more importance to the beginnings of word marks. However, this is no more than a rule of thumb. Each case must be considered on its merits. My assessment must take account of the overall impression created by the marks⁵. I do not find this rule of thumb a helpful guide in the present case. I have explained at paragraph 7 above why I find that the average consumer in the UK would accord the element GLEN relatively limited weight in distinguishing Scotch whisky brands from one another. It will therefore receive more limited attention from the average consumer when the mark is encountered visually, the focus lying on the (visually conspicuous) element REIDH

³ See *Peek & Cloppenburg v OHIM* T-386/07 at paragraph 47 and *S.A. Société LTJ Diffusion v. Sadas Vertbaudet SA*, Case C-291/0 at paragraph 54.

⁴ See *Specsavers International Healthcare Ltd v Asda Stores Ltd* [2014] EWCA Civ 1294 at paragraph 5 and *Starbucks v EUIPO* T-398/16 at paragraphs 53-54.

⁵ Cf. *Spa Monopole, compagnie fermière de Spa SA/NV v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM) Case T-438/07:

“23 Admittedly, the consumer normally attaches more importance to the first part of words (Joined Cases T-183/02 and T-184/02 *El Corte Inglés v OHIM – González Cabello and Iberia Líneas Aéreas de España (MUNDICOR)* [2004] ECR II-965, paragraph 81). However, that argument cannot hold in all cases (see judgment of 16 May 2007 in Case T-158/05 *Trek Bicycle v OHIM – Audi (ALL TREK)*, not published in the ECR, paragraph 70 and the case-law cited) and does not, in any event, cast doubt on the principle that the assessment of the similarity of marks must take account of the overall impression created by them.”

which, since it conveys no meaning to the great majority of UK consumers, has a high degree of distinctive character for them.

26) The initial AN and GLEN of the respective marks are obvious elements of difference. REIDH and REIDHE, on the other hand, are almost the same, the final E being the only difference between them. Although the initial AN of the earlier mark is a distinctive part of it, I have already observed that I think its brevity will result in the more substantial REIDHE tending to predominate in the overall impression. Moreover, an E at the end of a word is usually silent in English, so that English-speakers, of whom the great majority of UK consumers consist, will easily disregard it. Viewed overall, there is a medium degree of visual similarity between the marks.

27) The familiar word GLEN will be immediately recognized and pronounced in the normal way by UK consumers. Since most UK consumers are English-speakers with no knowledge of Gaelic they will pronounce the earlier mark's initial AN like the English indefinite article. They may experience a little initial hesitancy in pronouncing the REIDH element of the opposed mark. I think most will pronounce it simply like the English word "reed", though some may pronounce it like the English word "raid". They will adopt the same approach when pronouncing the second element of the earlier mark. As indicated above, the final E of the earlier mark's REIDHE is unlikely to be pronounced, so that REIDH and REIDHE will be pronounced in the same way, whereas the initial GLEN and AN are obvious elements of difference. Viewed overall, there is a medium degree of aural similarity between the marks.

28) "Glen" will be familiar to the average consumer as the well-known Scots word for a Scottish valley. Neither REIDH nor AN REIDHE, on the other hand, will convey any meaning to the overwhelming majority of UK consumers, whatever their significance may be for modern Gaelic-speakers in the UK. GLEN therefore represents a conceptual difference between the marks – though I have found that the consumer would accord it relatively limited weight in distinguishing Scotch whisky brands from one another. I think it fair to say that, though there is some conceptual difference between the marks, the difference is not a strong one.

The distinctiveness of the earlier mark

29) The degree of distinctiveness of the earlier mark must be assessed. This is because the more distinctive the earlier mark, either on the basis of inherent qualities or because of use made, the greater the likelihood of confusion (see *Sabel BV v. Puma AG*, paragraph 24). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97, the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

30) I have no evidence of acquired distinctiveness to consider. This leaves the question of inherent distinctive character. I have already found that the earlier mark will have no meaning for the overwhelming majority of UK consumers. Being neither descriptive nor allusive for them, it has a high degree of distinctive character.

Likelihood of Confusion

31) The factors assessed so far have a degree of interdependency (*Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer Inc*, paragraph 17), a global assessment of them must be made when determining whether there exists a likelihood of confusion (*Sabel BV v. Puma AG*, paragraph 22). However, there is no scientific formula to apply. It is a matter of considering the relevant factors from the viewpoint of the average consumer and determining whether they are likely to be confused.

32) In his witness statement Mr Baghi relied on the decision in Case O/183/19 in which the Hearing Officer found no likelihood of confusion between the figurative mark GLENFIELD and the word mark GLENFIDDICH. I begin by noting that in that case both marks began with GLEN, whereas in the present proceedings GLEN only appears in the opposed mark, and thus constitutes an element of difference between the marks. However, the decision in O/183/19 is in no way inconsistent with my finding regarding the weak distinctive character of the GLEN element of Mr. Bagchi's mark as used on Scotch whisky. On the contrary, it supports my finding that the average consumer in the UK would accord the element GLEN relatively limited weight in distinguishing Scotch whisky brands from one another. Despite the identity of the initial GLEN elements of the marks considered in Case O/183/19, apart from the figurative differences their respective second elements in that case were quite different. That is the reverse of the case in the present proceedings, where I find the second elements of the respective marks to be both distinctive and highly similar (in fact, in effect virtually identical).

33) I have found:

- that there is a medium degree of both visual and aural similarity between the marks, and that, though there is some conceptual difference between the marks the difference is not a strong one;
- that the consumer of Scotch whisky will pay an average degree of care and attention to its purchase;

- that, though there is considerable potential for oral use, the purchasing process will largely be a visual one;
- that the word element is heavily predominant in the opposed mark's distinctive character and overall impression;
- that for the average UK consumer the words "an reidhe" in the earlier mark will have no meaning, thus, being neither descriptive nor allusive, lending the earlier mark a high degree of distinctive character; but that the brevity of the initial AN will result in the more substantial REIDHE tending to predominate in the overall impression of the mark.
- that the average consumer in the UK will accord the element GLEN relatively limited weight in distinguishing Scotch whisky brands;
- that the respective elements REIDH and REIDHE in the marks have a high degree of distinctiveness, and that the consumer will easily overlook the presence or absence of a final E.

34) In making my assessment I must bear in mind that, though deemed reasonably circumspect and observant, the average consumer rarely has the opportunity to make a direct comparison between the marks and must instead rely on the imperfect picture of them he has kept in his mind. Given that I have found that the consumer's attention will tend to focus on the REIDH and REIDHE elements of the competing marks (easily overlooking the presence or absence of a final E), taking into account the relative weight of the marks' other elements in the perception of the consumer, bearing in mind the principle of imperfect recollection and the overall impression created by the marks, and having factored in to my global assessment the other considerations discussed above, I consider that when the marks are used on Scotch whisky there is a likelihood that at least a significant proportion of the relevant public will directly confuse them (i.e. mistake them for one another). Even if I am wrong about that, however, there will in any case be indirect confusion.

35) Sitting as the Appointed Person in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis, QC, explained (at paragraph 16) that indirect confusion can occur 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 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”. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 (at paragraph 81), Mr James Mellor, QC, sitting as the Appointed Person, warned that the tribunal should guard against undertaking too detailed an analysis of what should be an emulation of an instinctive reaction in the mind of the average consumer when encountering the later mark with an imperfect recollection of the earlier mark in mind.

36) I have found that the word element, rather than the graphical treatment, is heavily predominant in the opposed mark’s distinctive character and overall impression, but that the way in which the GLEN and REIDH parts of the mark are graphically presented makes them stand out as clearly distinct elements. I have explained why I find that the average consumer in the UK would accord the element GLEN relatively limited weight in distinguishing Scotch whisky brands from one another, and that the consumer’s attention will tend to focus on REIDH. I have found that though AN is a distinctive part of the earlier mark, its brevity will result in the more substantial REIDHE tending to predominate in the overall impression of the earlier mark.

37) A finding of indirect confusion should not be made merely because the two marks share a common element; I must take account of the common element in the context of the marks as a whole⁶. Even if accurately recalled, however, I do not think that the presence of AN in the earlier mark or GLEN in the opposed mark will be sufficient to cause the consumer to regard the use of REIDH and REIDHE on Scotch whisky as a mere coincidence in this case (especially since the presence or absence of a final E

⁶ See *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17 (at paragraph 81.4).

is in any case not likely to be remembered). He or she will simply assume that a variant mark or sub-brand is being used, and that the goods originate from the same or a related undertaking. There will be indirect confusion.

Outcome

38) I have found that there will be either direct or indirect confusion where the opposed mark is used on the goods of its specification. **The opposition has therefore succeeded and the opposed mark may not proceed to registration.**

Costs

39) The Opponent has been successful and is entitled to a contribution towards its costs. Costs are awarded on the basis of the scale published in Tribunal Practice Notice 2/2016. Although, as explained above, the exhibits to the Opponent's statement of grounds were not admitted as evidence in these proceedings, and although I found in the end that their admission was not necessary to my decision, they were submitted to address a relevant point, and I have included a sum to reflect the Opponent's time in collating this evidence. I hereby order Mr. Abishek Bagchi to pay Chivas Holdings (IP) Limited the sum of £ 1,300. This sum is calculated as follows:

Opposition fee	£100
Preparing a statement and considering the other side's statement	£300
Preparing evidence and considering the other side's evidence	£500
Written submissions	£400

This sum should be paid within twenty-one days of the expiry of the appeal period or within twenty-one days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 24th day of October 2019

Martin Boyle

**For the Registrar,
The Comptroller-General**