

O-545-20

TRADE MARK ACT 1994

**IN THE MATTER OF APPLICATION NUMBER: 3459052
BY MICHAEL MACKENZIE
TO REGISTER THE FOLLOWING TRADE MARK IN CLASS 33:**

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Background

1. On 17 January 2020, Mr Michael MacKenzie ('the applicant') applied to register the above trade mark for the following goods:

Class 33: Whisky; Malt whisky; Scotch whisky; Whiskey [whisky].

2. On 22 January 2020, the Intellectual Property Office ('IPO') issued an examination report in response to the application. The examination report contained objections under Section 3(1)(b) and 3(3) (b) of the Trade Marks Act 1994 ('the Act').
3. The Section 3(1) (b) objection was raised on the basis that the mark was devoid of any distinctive character as the mark 'Invernes' would simply be seen as being the geographical name 'Inverness' when first viewed by the average consumer in relation to whisky and whisky products. The examiner noted that the second letter 's' was missing from the end of the mark, however it was considered that the omission would be insufficient to alter the likely perception of the average consumer of the geographical meaning of the word.
4. The Section 3(3)(b) objection was raised because the mark would be perceived as Inverness Scotland. Scotland has a reputation in relation to whisky and whisky based drinks and the average consumer would be deceived if the whisky was not produced in Scotland. It was suggested that this objection 3(3) (b) could be overcome by adding a limitation of ' ; but in so far as whisky is concerned, only Scotch whisky produced in Scotland.'
5. The applicant, Mr MacKenzie, contacted the office by telephone on 22 January 2020 to discuss the objection with the examiner. He said that the mark should be Inverness and not Invernes but was told that a mark could not be changed after the application had been filed. In the applicant's written reply of 24 January 2020, Mr MacKenzie further explained that the misspelling of the mark was a mistake caused by autocorrect software that removed the second letter 's' in the mark as if it were a keying in error. It was his intention to file for the word 'Inverness' as he and his family had been involved in the distilling of whisky in Inverness and surrounding area for more than 37 years. The examiner's reply of 5 February 2020 he confirmed that:

"I have not raised the Section 3(1)(b) objection because you would be misleading people by using Invernes in relation to whisky. I have raised the objection because it is my view that Invernes would simply be seen as Inverness and consumers would not recognise it as a trade mark.

I note that your mark is missing the S at the end, however it is similar to Inverness and at first glance it isn't obvious that it is missing an S. The goods applied for are whisky, which has a strong association with Scotland and in relation to whisky it is likely that the average consumer would interpret the mark as Inverness.

As this is such a subtle visual and aural difference I am of the opinion that it is unable to perform the function of a trade mark in relation to whisky."

6. In his submission of 24 January 2020 Mr MacKenzie stated that he had intended to file for the word Inverness. By way of reply to this point I indicated that an error in filing an application can only be corrected in the circumstances listed in Section 39(2) of the Act where it states:

(2) In other respects, an application may be amended, at the request of the applicant, only by correcting—

- (a) the name or address of the applicant,*
- (b) errors of wording or of copying, or*
- (c) obvious mistakes, and then only where the correction does not substantially affect the identity of the trade mark or extend the goods or services covered by the application.*

7. In this case, the requested amendment is not in respect of the name or address of the applicant, nor is it an error of wording or copying as covered by 39(2)(b). It is not, in my view, an obvious mistake as covered by 39(2)(c). An obvious error is one which is clear to the IPO examiner from just the papers on file. What should be clear is (a) a mistake has been made and (b) what was intended. The mark Invernes is a sign that fully meets the requirements of Section 1(1) of the Act in that it is presented as a word in plain text. An amendment to add an additional letter 's' to this text would not fall under an 'obvious mistake' and the correction may affect the identity of the mark. The request to amend the mark was refused because the type of amendment was not covered by any of the specified circumstances stated in Section 39 of the Act.
8. A request for a hearing was filed by Mr MacKenzie on 5 February 2020. At the hearing, which was held on 3 March 2020, Mr MacKenzie explained that he was the third generation of his family to be involved in the Scotch Whisky industry as a distiller. He was born and raised in Inverness and he had been involved with distilling since 1983. He intended to bring a new blended single malt whisky to market under this brand. The product is blended from whisky distilled in the Inverness and Inverness Shire area and is bottled in Inverness. He was aware of the geographical significance of the name, but he submitted that other Scottish place names had been registered. He had previously applied for Old Inverness which had been published in the Trade Marks Journal but had been withdrawn following publication because of a threatened opposition by an earlier rights holder. The earlier rights holder had indicated that they would not oppose an application for Inverness.

9. In my decision, I maintained the objection under Sections 3(1)(b) as the mark was deemed to be non-distinctive and would not be seen by the average consumer as being capable of performing the role of a trade mark. However, it was my view, that because the mark was likely to be seen as relating to the geographical name Inverness, an objection under Section 3(1) (c) would also be appropriate because it is a sign which may serve in trade to designate the geographical origin of the goods e.g. goods produced in Inverness. But a 3(1) (c) objection was not formally raised at the hearing. The mark Invernes is not a common misspelling, but it is extremely likely that the average consumer would see it as referring to the geographical name Inverness which is the capital city of the Highland region of Scotland. Scotland has a significant reputation in the distilling of whisky and there are a number of distilleries operating in the Inverness area. There is a need to keep the name Inverness free for other traders to legitimately use in the course of trade as an indication of the origin of their goods. In respect of the objection under Section 3(3)(b), Mr MacKenzie agreed to add the limitation to the specification as his goods were Scotch whisky produced in Scotland. The Section 3(3)(b) objection was waived for the agreed limitation but the Section 3(1) (b) was maintained. The mark had not been used prior to the date of filing and Mr MacKenzie would not be able to demonstrate any acquired distinctiveness through the use made of the mark. As the Section 3(1) (b) objection was maintained in the *prima facie* case the application was refused.
10. Mr MacKenzie posted the form TM5 requesting a full statement of reasons for the Registrar's decision at the beginning of April 2020. This was within the period allowed in which to file an appeal against my decision, but the form was not received by the office. By way of explanation, this was at the beginning of the lock down period which saw the office closed for all incoming post. A period of interrupted days had been declared due to the COVID 19 pandemic. The form TM5 is a paper form that can only be filed by post and despite a thorough search of all pending mail when staff returned to the office, the form could not be traced. On 29 June 2020 I confirmed the non-receipt of the form and asked for the form to be refiled. Mr MacKenzie was allowed a period of two months in which to file a further form. The new form TM5 was received on 25 August 2020 and as a result I am required under Section 76 of the Act and Rule 69 of the Trade Marks Rules 2008, to state the grounds of my decision and the material used in arriving at it.

Decision

11. The relevant parts of Section 3 of the Act read as follows:

“3.-(1) The following shall not be registered –

(a) ...

(b) trade marks which are devoid of any distinctive character,

(c) *trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of production of goods or of rendering of services, or other characteristics of goods or services,*

(d) ...

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

The relevant legal principles – Section 3(1) (b)

12. There are a number of judgments of the Court of Justice of the European Union (“CJEU”) which deal with the scope of article 3(1)(b) of the Directive and Article 7(1)(b) of the Regulation, whose provisions correspond to Section 3(1)(b) of the UK Act. I derive the following main guiding principles from the cases notes below:

- *An objection under Section 3(1)(b) operates independently of objections under section 3(1)(c) – (Linde AG (and others) v Deutsches Patent-und Markenamt, Joined Cases C-53/01 to C-55/01, paragraphs 67 to 68);*
- *For a mark to possess a distinctive character it must identify the product (or service) in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product (or service) from the products (or services) of other undertakings (Linde paragraphs 40-41 and 47);*
- *A mark may be devoid of distinctive character in relation to goods or services for reasons other than the fact that it may be descriptive (Postkantoor paragraph 86);*
- *A trade mark’s distinctiveness is not to be considered in the abstract but rather by reference to the goods or services in respect of which registration is sought and by reference to the relevant public’s perception of that mark (Libertel Group BV v Benelux Merkenbureau, Case C-104/01 paragraphs 7277);*
- *The relevant public must be deemed to be composed of the average consumer who is reasonably well-informed and reasonably observant and circumspect (Libertel paragraph 46 referring to Case C-342/97 Lloyd Schuhfabrik Meyer).*

13. In Postkantoor case C-363/99 in relation to section 3(1)(b) it stated that:

“86. In particular, a word mark which is descriptive of characteristics of the goods or services for the purposes of Article 3(1)(c) of the Directive is, on that account, necessarily devoid of any distinctive character with regard to the same goods or services within the meaning of Article 3(1)(b) of the Directive.

A mark may nonetheless be devoid of any distinctive character in relation to goods or service for reasons other than the fact that it may be descriptive.”

14. When considering whether a sign can function as a trade mark, it is important to consider the average consumers first impression of the sign when it is used in relation to the goods and services covered by the application. The test is one of immediacy or first impression, as confirmed in the decision *Sykes Enterprises v OHIM (Real People Real Solutions)* [2002] ECR II-5179, where it states:

“a sign which fulfils functions other than that of a trade mark is only distinctive for the purposes of Article 7(1)(b) of Regulation No 40/94 if it may be perceived immediately as an indication of the commercial origin of the goods or services in question, so as to enable the relevant public to distinguish, without any possibility of confusion, the goods or services of the owner of the mark from those of a different commercial origin.”

It is clear from the aforementioned case law that assuming notional and fair use, I must determine whether or not the mark applied for will be viewed by the average consumer as a sign capable of denoting a single source of trade origin when used in relation to the goods included in the application. I therefore must consider who the average consumer of the goods covered by the application is. The goods contained in this application are Whisky, Malt whisky, Scotch whisky, Whiskey [whisky]. The sale of alcoholic products including whisky is restricted by law to consumers over the age of 18 and whilst the products are available through a number of retail and wholesale outlets such as supermarkets, off-licenses, general stores, pubs, social clubs, wholesalers and on-line outlets, all sellers are required to be licensed and to ensure that the purchaser is over 18 years old by checking identity, if necessary, before the sale is completed. This additional level of confirmation of the consumer's age ensures that the relevant consumer of these products would be over the age of 18, reasonably well-informed and reasonably observant and circumspect. It should also be noted that such goods are also requested orally in pubs or bars where visual and aural differences in spelling would be reduced or go un-noticed. Whilst I have identified that the relevant consumer could be both the trade and the average consumer at point of sale, I do not believe that the goods are exclusively sold through specialist networks or are only purchased by a specialist consumer whereby the consumer perception may be different to that of the average consumer. It is my view that whether the consumer is the trade or the public, their levels of perception are likely to be normal or reasonable.

15. Having considered the relevant consumer and established the likely level of attention, I must now determine how the average consumer will perceive the sign when used in respect of the goods claimed. The mark consists of the word 'Invernes'. The word 'Invernes' is not in the dictionary but it is the phonetic equivalent of the geographical

place name Inverness. A Google search of the word Invernes would prompt the user 'do you mean Inverness' (See Annex A).

16. If it were the case that the application had been filed in respect of the word Inverness an objection under Section 3(1) (c) of the Act would have been appropriate for the reasons given in the Court of Justice of the European Union ('CJEU') in its judgments on cases *Windsurfing Chiemsee v Boots Attenberger* ('Chiemsee') C-108/97 and C-109-97:

“31 Thus, under Article 3(1)(c) of the Directive [equivalent to section 3(1)(c) of the UK Trade Marks Act 1994 or 'UKTMA'], the competent authority must assess whether a geographical name in respect of which an application for registration as a trade mark is made designates a place which is currently associated in the mind of the relevant class of persons with the category of goods concerned, or whether it is reasonable to assume that such an association may be established in the future.

32 In the latter case, when assessing whether the geographical name is capable, in the mind of the relevant class of persons, of designating the origin of the category of goods in question, regards must be had more particularly to the degree of familiarity amongst such persons with that name, with the characteristics of the place designated by the name, and with the category of goods concerned.

33 In that connection, Article 3(1)(c) of the Directive [section 3(1)(c) UKTMA] does not in principle preclude the registration of geographical names which are unknown to the relevant class of persons or at least unknown as the designation of a geographical location or of names in respect of which, because of the type of place they designate (say, a mountain or lake), such persons are unlikely to believe that the category of goods concerned originates there.

34 However, it cannot be ruled out that the name may serve to designate geographical origin within the meaning of Article 3(1)(c) [section 3(1)(c) UKTMA], even for goods such as those in the main proceedings [being, in that particular case, items of sports clothing], provided that the name could be understood by the relevant class of persons [to include the shores of the lake or the surrounding area].

35 It follows from the foregoing that the application of Article 3(1)(c) [section 3(1)(c) UKTMA] does not depend on there being a real, current or serious need to leave a sign or indication free.

36 Finally, it is important to note that, whilst an indication of the geographical origin of goods to which Article 3(1)(c) [section 3(1)(c) UKTMA] applies usually indicates the place where the goods were or could be manufactured, the connection between a category of goods and a geographical location

might depend on other ties, such as the fact that the goods were conceived and designed in the geographical location concerned.”

17. The Internet reference at Annex A shows that the Scottish city of Inverness, is the capital city of the Scottish Highlands with a population of 80,718 in 2019. As a city with a significant population and a wider country wide reputation for the production of Scotch Whisky the sign would be lacking in distinctive character as there is a real need to keep the term free for use by other traders to legitimately use to describe the geographical origin of their goods.
18. However, as a late Section 3(1) (c) was not raised, I have only a Section 3(1) (b) objection to consider. The term Invernes is just one letter ‘s’ short, at the end of a long word, of the geographical place name Inverness. The pronunciation of a single letter ‘s’ which when viewed and pronounced by the average consumer will have no aural difference to the geographical place name and very little visual difference to the common geographical name Inverness. Although not a prescriptive rule, misspelling of words is less likely to be determinative if it occurs at the end of a word and does not create a new or conceptually different meaning. For example, in the decision BLO/560/14 for the mark Skimpie, the Hearing Officer, Mr Morris, stated at paragraphs 21-22

“21. However, as Mr Martin has pointed out, the mark is for the word skimpie, not skimpy. There is nothing to suggest that skimpie is an alternative spelling for the word skimpy. The matter must, though, be judged upon the impact that the sign would have on the relevant public. To this extent, I note that in the judgment of the General Court in En Route International Ltd v OHIM, Case T-147/06, it was found that the word FRESHHH was descriptive of a characteristic of foodstuffs, and that notwithstanding the visual distinction between FRESH and FRESHHH, that mark was caught by the equivalent of 3(1)(c) of the Act; FRESHHH was, effectively, held to be variant spelling and that it would still be perceived merely as a description.

22. Each case must be considered on its own merits. I come to the view that skimpie has its own look and feel separate from the word skimpy. To suggest that they are alternative spellings creates something of a jar. I see no reason why skimpy would be lengthened to skimpie. This would be an unusual move. I bear in mind that, in the above case, FRESH was lengthened to FRESHHH. However that merely intensifies a recognised word. I consider there to be distinctiveness in the way in which the word skimpie has been spelt and presented and it would not be seen merely as a (variant) description of the goods. I also bear in mind that in the judgment of the General Court in Avon Products, Inc. v OHIM, Case T-184/07 the mark ANEW ALTERNATIVE lacked distinctiveness on an aural basis even if it was visually distinctive, and that this was enough for the mark to be refused. However, it is important in this case to bear in mind that the goods in question are predominantly selected by the eye (as per paragraph 32 below) so the visual distinctiveness of the mark takes on much greater weight and

significance. In any event, whilst I accept that some average consumers would pronounce the mark as SKIM-PEA, some could pronounce it as SKIM-PIE.”

19. The above decision acknowledged that where there was found to be a conceptual and pronounceable difference between the word Skimpy and Skimpie, a misspelling could be found to be distinctive. However, that is not the case when considering the difference between Invernes and Inverness. It is my view that aurally the word Invernes and Inverness would be pronounced and perceived as being or relating to the same place, especially when applied to goods for which the Scottish city has a reputation. Section 103(2) of the Act provides that use of a mark, or a sign identical with, similar to, or likely to be mistaken for a trade mark includes use other than by means of graphic representation. This covers aural use of the sign Invernes which would be taken by the average consumer to be similar to or mistaken for the geographical name Inverness. The distinctiveness of the mark must be assessed at first impression and without the average consumer performing any kind of mental agility to look for a difference between the two words. The difference is so small that it is unlikely to be perceived at first glance and would likely to go unnoticed by the average consumer when used in relation to a product that is associated with the Scottish Highlands and Scotland at large. The mark would be perceived as being non-distinctive and incapable of indicating trade origin.

20. Mr MacKenzie referred to registrations of other Scottish place names in his submissions. I would state that I am not aware of the circumstances surrounding the acceptance of any earlier marks and I am not bound by those earlier decisions. In this respect I refer to the comments of *Mr James Mellor in Bexit BL-O-262-18*

“ Mr Brewster accused the UK IPO of acting in ‘a somewhat arbitrary fashion’. He drew my attention to a list of ten UK registrations which have been approved by the UK IPO. His point was that if the UK IPO had approved those 10 registrations, it must have been inconsistent and wrong to refuse his application.

10. It has long been the law that this type of ‘state of the register’ evidence is irrelevant – that was the law under the Trade Marks Act 1938 (see Madame Trade Mark [1966] RPC 541) – and the same is true under the Trade Marks Act 1994. Jacob J. explained why in TREAT [1996] RPC 25: In particular, the state of the Register does not tell you what is actually happening out in the market, and in any event one has no idea what the circumstances were which led the Registrar to put the marks concerned on the Register. It has long been held under the old Act that comparison with other marks on the Register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. Madame TM, and the same must be true under the new Act.’

11. There are additional sound reasons for this principle. Frequently, the marks identified on the Register are different in some respect. (Indeed, an identical earlier mark for identical goods or services would pose a different

(relative grounds) obstacle). The mark itself may be different or the goods or services for which it is registered may be different or the applicant may have been able to rely on evidence of distinctiveness acquired through use. In addition, just because a mark is on the Register does not mean it will be held valid when challenged. Furthermore, if the touchstone for registration was to be a comparison with marks already on the register, then registration would come to depend on the lowest common denominator. In any event, it is quite clear that the application of the section 3(1)(b) ground requires an assessment not against other marks on the register, but against the standard laid down in that provision, as interpreted in the case law.

21. In any event I do not find that acceptances of different marks which happen to contain the name of a place in Scotland, to be of any assistance in the progress of this application. I would simply add the marks are not the same, they merely include a geographical element in those marks.
22. I take on judicial notice that Scotland has a well-known reputation for the distillation of Scotch whisky and Scotch whisky is a term protected as Geographical Indication. Inverness is also known as a place where a number of distilleries are based and there is a need to keep the term free for use by other traders to describe the place of production of their goods. It is acknowledged that the mark Invernes is not the geographical name Inverness, but it is likely to be taken as being the name when used aurally to request the goods. Visually I consider that the average consumer would perceive the sign as nothing more than a readily comprehensible non-distinctive sign indicating the goods are produced in Scotland. The mark would be seen as being non-distinctive and unable to perform the role of a trade mark, namely, to identify the goods as originating from a particular undertaking and thus distinguish the goods from those of other undertaking.

Conclusion

23. I have concluded that the mark applied for will not be identified as a trade mark without first educating the public that it is an indication of trade origin. In this decision I have considered all the documents and arguments submitted in relation to the application. Having done so, and for the reasons given above, the application is refused under Section 3(1)(b) of the Act for all of the goods applied for in Class 33.

Dated this 3rd day of November 2020

Carol Bennett

For the Registrar

Comptroller General

Annex A

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invernes

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Did you mean: **inverness**

en.wikipedia.org › wiki › Inverness


Inverness - Wikipedia

Inverness is a city in the Scottish Highlands. It is the administrative centre for The Highland Council and is regarded as the capital of the Highlands. Historically it ...

Population: 80,718 (2019) Council area: Highland
Scottish Parliament: Inverness and Nairn Lieutenantancy area: Inverness-shire
History · Climate · Transport · Government

Images for invernes

holiday inn lives matter inn express golf club inverness airport



Report images

Inverness

City in Scotland

Inverness is a city on Scotland's northeast coast, where the River Ness meets the Moray Firth. It's the largest city and the cultural capital of the Scottish Highlands. Its Old Town features 19th-century Inverness Cathedral, the mostly 18th-century Old High Church and an indoor Victorian Market selling food, clothing and crafts. The contemporary Inverness Museum and Art Gallery traces local and Highland history. — Google

Area: 28.8 km²

Weather: 8 °C, Wind SW at 10 mph (16 km/h), 79% Humidity

Population: 46,870 (2012)

UK Parliament: Inverness, Nairn, Badenoch and Strathspey

Local time: Monday 16:16

Dialing code: 01463

Plan a trip

Inverness travel guide

3-star hotel averaging £50, 5-star averaging £117