

**TRADE MARKS ACT 1994**  
**IN THE MATTER OF**  
**TRADE MARK REGISTRATION NO. 3444160**

**Dràm Mòr**

**IN THE NAME OF DRÀM MÒR GROUP LTD.**

**AND**

**AN APPLICATION FOR INVALIDATION**  
**UNDER NO. 503169**  
**BY MORRISON & MACKAY LIMITED**

## Background and pleadings

1. Dràm Mòr Group Ltd ("the proprietor") owns the following trade mark registration with no. 3444160 for the following goods:

Class 33            Scotch whisky; beverages containing whisky; Whisky; Blended whisky; Malt whisky; Scotch whisky; Whiskey [whisky]; but in so far as whisky products and beverages containing whisky are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.

2. The application to register the mark was filed on 14 November 2019, and it entered in the register on 28 February 2020.
3. On 11 June 2020, Morrison & Mackay Limited ("the applicant") applied for a declaration of invalidity against all the goods in the registration by filing a form TM26(l) based on sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act"). The applicant relies upon the following United Kingdom ("UK") trade mark:

Registration No. 2339089: càrn mòr

Filing date: 28 July 2003

Registration date: 26 December 2003

Goods:

Class 33            Single malt scotch whisky

4. Given its filing date, the above mark is an earlier trade mark in accordance with section 6 of the Act.
5. The applicant claims that the competing goods are identical or highly similar and the marks are highly similar. As a consequence, the applicant claims that there is a likelihood of confusion including a likelihood of association under section 5(2)(b).

6. Under section 5(3), the claim is that the use of the proprietor's mark would, without due cause, will tarnish the reputation of the earlier mark, erode its distinctiveness, and give an unfair advantage to the proprietor by virtue of the reputation of the earlier mark.
7. Under section 5(4)(a), the applicant claims goodwill in the sign CÀRN MÒR. The applicant further claims that it first used the sign as early as 2008 throughout the UK in relation to single malt whisky. Consequently, the applicant submits that it is entitled to prevent the use of the proprietor's mark under the law of passing off.
8. The proprietor filed a counterstatement denying the grounds of cancellation application and has put the applicant to proof of use of its mark in relation to all the goods covered by the earlier mark.
9. The applicant is represented by Murgitroyd & Company and the proprietor is represented by Lawrie IP Limited. Both parties filed evidence, which I will summarise to the extent it is necessary. A hearing was held on 11 June 2021. Ms Eleanor Coates, of Murgitroyd & Company, appeared for the applicant and Ms Rachel Denholm, of Lawrie IP, appeared for the proprietor.

## **Evidence**

10. The applicant's evidence-in-chief consists of the witness statement of Douglas Crawford dated 27 October 2020 with eleven exhibits. Mr Crawford is the Managing Director of Morrison Scotch Whisky Distillers Ltd.<sup>1</sup>
11. Mr Crawford states that the proprietor company was incorporated in 1962. He further states that in 2005 when the company came into the ownership of Mr Crawford's co-directors, càrn mòr was already in use as a single malt whisky name and that the company has used the mark on scotch whisky since at least 2003.

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<sup>1</sup> According to Mr Crawford, the change in the company name from Morrison & Mackay Limited (the proprietor's name as recorded in the trade mark register) to Morrison Scotch Whisky Distillers Ltd was recorded with the Companies House on 19 January 2019.

12. Images of bottles of whisky and samples of labels are in evidence as Exhibit DC1. The mark as shown on the labels is CÀRN MÒR.

13. Several whisky reviews on càrn mòr and media coverage of the product in The Herald and The Times are in evidence. The documents are dated between the 2013 – 2020.<sup>2</sup>

14. According to Mr Crawford, advertising and promotion are generally done through participation in whisky events, such as festivals or testing. Mr Crawford further states that the company has spent approximately 1.5 million pounds in the last three years in advertising and promotion and has recorded the following turnover in the past years under the brand:

Year	Turnover (£'million)
2015	709,428
2016	891,838
2017	923,531
2018	1,409,791
2019	1,066,741

15. Sample invoices for 2016 - 2019 are in evidence. Although most of the details on the invoices are redacted, postcodes, item name/code and dates are visible.

16. The proprietor's evidence consists of the witness statement of Kenneth Macdonald, Director of the proprietor company dated 22 December 2020 with eleven exhibits.

17. Most of the evidence relates to the history, reviews and the use of the proprietor's mark.

18. Mr Macdonald states that the term Mòr within the whisky industry is commonplace. Exhibits KM05 contains extracts of webpages and online sales

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<sup>2</sup> DC4 and 5.

websites showing different whisky marks that incorporate the word “Mòr”. Extracts from the UK Trade Mark Register showing third-party marks containing the term Mòr registered for goods in Class 33 are provided as Exhibit KM06. I will discuss this evidence in more detail later.

19. The applicant’s evidence-in-reply consists of a second witness statement from Mr Crawford dated 22 February 2021. This evidence largely seeks to answer the proprietor’s criticism of the applicant’s evidence-in-chief.

20. I have read all the evidence. The summary of the evidence sets out what I consider to be the most relevant.

## **Proof of Use**

### Applicable law

21. As the applicant’s mark had completed its registration process more than five years before the date of application for invalidation and the date of application of the contested registration, it is subject to proof of use pursuant to section 47(2A) of the Act. The proprietor has requested that the applicant provide proof of use of its mark.

22. The relevant statutory provisions under section 47 are as follows:

(2A) The registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark unless—

(a) the registration procedure for the earlier trade mark was completed within the period of five years ending with the date of the application for the declaration,

(b) the registration procedure for the earlier trade mark was not completed before that date, or

(c) the use conditions are met.

(2B) The use conditions are met if—

(a) the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with their consent in relation to the goods or services for which it is registered—

(i) within the period of 5 years ending with the date of application for the declaration, and

(ii) within the period of 5 years ending with the date of filing of the application for registration of the later trade mark [...] or

(b) it has not been so used, but there are proper reasons for non-use.

(2C) For these purposes—

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(2D) [...]

(2DA) [...]

(2E) 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.

23. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

24. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J summarised the law relating to genuine use as follows:

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

- (1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].
- (2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

- (3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].
- (4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].
- (5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].
- (6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the



goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

25. In *Awareness Limited v Plymouth City Council*,<sup>7</sup> Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the

material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

### Relevant period

26. Pursuant to section 47(2B) of the Act, the relevant periods for assessing whether there had been genuine use of the earlier mark are the five year period ending with the date of application for invalidation, i.e. 10 June 2015 to 11 June 2020 and the five-year period ending with the date of application for registration of the contested mark, i.e. 13 November 2014 – 14 November 2019.

### Assessment of the evidence of use

27. Throughout the evidence, the applicant has shown the use of the mark as Càrn Mòr or CÀRN MÒR. As the applicant's mark is registered as a word only mark, I consider that the use as shown constitutes the normal and fair use of the mark in the registered form. There is evidence of use in the form of labels applied to bottles of scotch whisky that contain information, including the mark and its sub-brands, namely, Strictly Limited, Vintage and Celebration of the Cask. The applicant also has provided sample invoices from the years 2016 - 2019. As these are redacted, it is not possible to ascertain to whom the invoices are addressed. However, it is clear from the postcodes that most of the recipients are based in various locations in Scotland. The proprietor has raised concerns that the invoices do not show the use of the mark càrn mòr. I agree to the extent that the invoices do not directly refer to càrn mòr. However, I note that the invoices show the sale of items marked as “CMSL” and “celebration of cask”. In this regard, I bear in mind that it is not uncommon to refer to the items on the invoices by reference codes or sub-brands. Moreover, an assessment of

genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each piece of evidence shows use by itself.<sup>3</sup> It is clear from the labels and Mr Crawford's explanation that CMSL refers to Càrn Mòr Strictly Limited, one of the sub-brands of càrn mòr. I also note that another entry in the invoice, namely, Celebration of the Cask is another sub brand of càrn mòr.

28. According to Mr Crawford, the applicant has also recorded a turnover that has increased from over seven million pounds to over one billion pounds during 2015 - 2019. Although it is unclear how much of the figures provided relates to the sale of the products in the UK, there is evidence that the products sold under the mark are relatively expensive - price range varies from £50 to £250. There is also evidence that the products are sold through at least 70 distributors in the UK. I also note that reviews on the mark consistently appeared in articles published during the relevant periods and the mark received media coverage in leading newspapers. Considering the evidence as a whole, I am satisfied that the use of the applicant's earlier mark is sufficient to create and maintain a market for single malt scotch whisky in the UK during the relevant five-year periods.

### **Section 5(2)(b)**

29. Section 5(2)(b) of the Act is 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”.

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<sup>3</sup> *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

## Case law

30. The following principles are gleaned from the judgments of the EU courts 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 C3/03, *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.

The principles:

(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 the 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 greater 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 to mind the earlier mark, 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.

### **Comparison of goods**

31. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In *Canon*, the Court of Justice of the European Union (“CJEU”) stated at paragraph 23 of its judgment:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or

services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

32. In *Gérard Meric v OHIM*, the General Court held 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.<sup>4</sup>

Proprietor's goods	Applicant's goods
Scotch whisky; beverages containing whisky; Whisky; Blended whisky; Malt whisky; Scotch whisky; Whiskey [whisky]; but in so far as whisky products and beverages containing whisky are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.	Single malt scotch whisky.

33. At the hearing, Ms Denholm conceded that the proprietor's goods are identical or similar to the applicant's goods. I agree. The proprietor's *beverages containing whisky*, to my mind, are whisky-based drinks such as whiskey cocktails, while *blended whisky* is a blend of several whiskies. According to the limitation applied to the proprietor's specification, those goods concern only scotch whisky. Accordingly, I find that beverages containing whisky and blended whisky in the proprietor's specification are highly similar to the applicant's single malt scotch whisky due to the shared nature, purpose, method of use, users, and trade channels. I also find that the remaining goods in the proprietor's specification are either identically contained in the applicant's specification or identical under the *Meric* principle.

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<sup>4</sup> case T-133/05

## **The average consumer and the nature of the purchasing act**

34. It is necessary for me to determine who the average consumer is for the respective parties' goods.

35. 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”.

36. Ms Coates argued that there are a range of average consumers such as those who have some knowledge of whisky, those who are whisky experts or those who turn up at whisky festivals just to try some whiskies. Ms Coates further argued that the average consumer may focus on factors such as where the whisky comes from, what distillery, or how old the whisky is.

37. I consider that the average consumers of the competing goods are members of the general public over the age of eighteen. I agree with Ms Coates that there will be a range of consumers and their level of attentions during the purchase process are likely to vary. For example, a whisky expert is likely to pay a higher than a medium degree of attention than someone who wants to taste different flavours of whisky at a whisky festival. The level of attention is, therefore, likely to vary between medium and higher than medium depending on the consumers. The purchasing act is more likely to be visual, where the consumer will select the goods after having reviewed the labels on bottles or images on

website. However, I do not discount the possibility of aural considerations during the purchase process.

### **Distinctiveness of the earlier mark**

38. The distinctive character of the earlier mark must be considered. The more distinctive it is, either inherently or through use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). 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).”

39. The applicant claims that its mark càrn mòr is inherently highly distinctive and that the distinctiveness has also been enhanced through the use of the mark. At the hearing, representatives of both parties conceded that the respective



marks are in Scots Gaelic, a language not widely spoken or understood by the average UK consumer.

40. Ms Denholm further argued that as the word "Mòr" is commonplace in relation to whisky, the applicant's mark possesses only an average degree of distinctive character. To substantiate her claim, Ms Denholm directed me to the evidence of other whisky brands that incorporate the word "Mòr". The evidence consists of screenshots of online sales websites and printed extracts from web pages on the description of different whisky products. Out of six marks, Ms Denholm referred me to; three marks do not have the "mòr" element in any prominent position on the label. It is also unclear when the products referred to in the evidence was offered for sale, on what scale or what significance the word "mòr" would have upon the relevant public for the goods in question. Such evidence does not assist me in concluding that the word "mòr" is commonly used as a part of the brand name in the whisky sector. The proprietor also filed extracts from the trade mark register of third party registrations containing the word mòr. As held in *Zero Industry Srl v OHIM*, the state of register evidence is irrelevant because evidence does not show how many of such trade marks are effectively used on the market.<sup>5</sup> It also does not establish that the distinctiveness of the word "mòr" has been weakened by its frequent use in the whisky sector. The applicant's argument on the impact of the term mòr on the distinctiveness of the mark cannot, therefore, be accepted.

41. The parties concede that the words càrn mòr are in Scots Gaelic and that Mòr in Gaelic means big. According to *Collins English Dictionary*, càrn is another word for cairn, meaning a pile of stones that marks a boundary.<sup>6</sup> While some consumers may know the meaning of these terms, I agree with the parties that a significant proportion of the average UK consumers of the category of goods in question would not understand Gaelic and would not know the meaning of càrn mòr. In my view, the earlier mark is likely to be treated as invented words. Due to accents, it is also plausible that the average consumers may consider

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<sup>5</sup> Case T-400/06

<sup>6</sup> See <https://www.collinsdictionary.com/dictionary/english/carn> (accessed 22 July 2021)

that the words are in a foreign language, the meaning of which is unknown to them. In either situation, I find that the mark possesses a high degree of inherent distinctive character.

42. The opponent has provided evidence in support of its claim to enhanced distinctive character. According to Mr Crawford, the sales of goods between 2015 -2019 amounted to over 5 billion pounds. Mr Crawford also claims that 1.5 million pounds were spent in advertising and promoting the mark in the last three years. However, the proprietor has criticised the sales figures citing that those figures are not supported by evidence. In the absence of cross-examination, I accept Mr Crawford's statement on the point. As mentioned, there is some doubt about how much of the figures relate to the sale of products in the UK. However, considering the evidence that the opponent has at least 70 distributors in the UK being independent whisky retailers and that the products are relatively expensive, it appears that a reasonable proportion of the turnover figures are likely to be attributable to the sale of products bearing the mark in the UK. There is also evidence of published articles on the product reviews from 2013 and media coverage on the product in leading newspapers such as The Times and The Herald. Taking the evidence in the round, I am prepared to accept that the earlier mark's already high degree of inherent distinctiveness has been enhanced through use.

### **Comparison of marks**

43. It is clear from *Sabel BV v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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.”

44. It would be wrong, therefore, artificially to dissect the trade marks, 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.

45. The trade marks to be compared are as follows:

Proprietor's trade mark	Applicant's trade mark
<b>Dràm Mòr</b>	<b>càrn mòr</b>

46. The respective marks contain two words with grave accents above the letters a and o. The overall impression of the respective marks rests in the combination of the words they are composed of.

47. Visually, both marks contain two words with four and three letters each and share five out of seven letters. The marks have grave accents above the letters a and o and end with the same word mòr. In terms of differences, the marks begin with two different words, càrn and Dràm. The opening and ending letters in those words are different, and the letters a and r are not present in the same order. Considering all these factors, I find that the marks are visually similar to a medium degree.

48. Turning to aural comparison, Ms Denholm argued that the average consumer is likely to elude the pronunciation of two "m"s in the proprietor's mark, resulting in an articulating the mark as one word - "Dràmòr". While I acknowledge that some average consumers are likely to pronounce the proprietor's mark in the manner described by Ms Denholm, I do not consider that that would be the case

with a significant proportion of the consumers. Given that the marks are presented as two separate words - Dràm and Mòr, the average consumer, in ordinary speech, is likely to take a pause between the words and read it as two words. Accordingly, the respective marks consist of two one-syllable words and coincide in the pronunciation of the second syllable. The aural difference between the marks is introduced by the words at the beginning - càrn and Dràm - pronounced entirely differently. In relation to the presence of grave accents in the marks, Ms Coates argued that as English-speaking consumers will not know if the accents are supposed to change the pronunciation, the consumer may make various attempts at pronouncing the marks. I disagree. I do not consider that grave accents will affect how the average consumer in the UK would pronounce the respective marks. As there are no accents in English, the accents in the respective marks are likely to be ignored during articulation. Considering these factors, I find that the marks are aurally similar to a medium degree.

49. In terms of conceptual similarity, Ms Denholm submitted that the conceptual position is neutral. She also argued that although Dràm Mòr means big Dràm or big drink, the meaning would not be known to a large proportion of the UK average consumer. However, Ms Coates argued that there is some degree of conceptual similarity between the marks because both marks are in Scots Gaelic. As the percentage of people who speak or understand Scots Gaelic is very small (Ms Coates thinks it is less than one per cent), I doubt if the average consumer would even recognise that the words are in Scots Gaelic. Even if they recognise, I do not consider that the number will represent a significant enough number to warrant the intervention of the Tribunal. Moreover, for a conceptual meaning to be relevant, it must be one capable of immediate grasp.<sup>7</sup> In my view, a significant proportion of the average consumers will see the competing marks as invented words or unknown foreign language words. On that basis, in comparing the marks from a conceptual perspective, I find the position to be neutral.

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<sup>7</sup> Case C-361/04 *P Ruiz-Picasso and Others v OHIM* [2006] ECR I-00643; [2006] E.T.M.R. 29.

## Likelihood of confusion

50. In determining whether there is a likelihood of confusion, I need to bear in mind several factors. The first is the interdependency principle, i.e. a lesser degree of similarity between the respective goods may be offset by a greater degree of similarity between the trade marks (*Canon* at [17]). It is also necessary for me to bear in mind the distinctive character of the opponent's trade mark, as the more distinctive the trade mark is, the greater the likelihood of confusion (*Sabel* at [24]). I must also keep in mind the average consumer for the goods, the nature of the purchasing process and the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks, relying instead upon the imperfect picture of them they have retained in mind (*Lloyd Schuhfabrik* at [26]).

51. Confusion can be direct (which 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/services down to the responsible undertaking being the same or related).

52. The difference between direct and indirect confusion was explained in *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, by Iain Purvis Q.C., sitting as the Appointed Person, where he explained 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 recognized 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”.

53. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. In this connection, he pointed out that it is not sufficient that a mark merely calls another mark to mind. This is mere association not indirect confusion.

54. Earlier in this decision, I concluded that the contested goods are either identical or similar to a high degree. I also concluded that the goods will be selected primarily by visual means, with a medium to higher than a medium degree of attention paid by the general public. I found that the marks are visually and aurally similar to a medium degree, and the conceptual position is neutral. I also found that the applicant’s mark is inherently distinctive to a high degree and has built up on the inherent distinctiveness through use.

55. On likelihood of confusion, the applicant made the following submissions:

“Accents are unusual to English speaking consumers, who would note and recall their presence in words. The accents are over the same letters and consumers, with an imperfect recollection, would remember the visual format of the name, the accents, the suffix of “mòr” and assume on sight of Dràm Mòr, that it is the product they recalled as originating from the Applicant.”

56. In my view, visual and aural difference introduced by the words càrn and Dràm are prominent enough to dispel a likelihood of direct confusion.

57. Turning to the assessment of indirect confusion, I note that the degree of similarity arises from the presence of the word mòr and the grave accents. As Mr James Mellor QC, as the Appointed Person, stressed in *Duebros Limited*, “a finding of indirect confusion should not be made merely because the two marks share a common element”. Although there is “something in common” in

this case, in the respective marks, the word mòr is preceded by the words – càrn and Dràm. Although four-letter words, they are visually and aurally different. The average consumer is likely to perceive and remember those words as invented and meaningless. Moreover, as these differences are at the beginning of the marks, the average consumer's view and attention are likely to be directed towards those elements first. Although the earlier mark possesses a high degree of distinctiveness, the distinctiveness rests in the combination of the words "cràm mòr". It does not appear, nor there is evidence that the common elements - the accents and the word "mòr" - guarantee the applicant's trade origin in their own right. Taking account of the common element in the context of the later mark as a whole, I find that there is no likelihood of indirect confusion. I take the view that the differences introduced by the words càrn and Dràm are far more significant than the similarity arising from the common elements. Even when encountered with identical goods or goods that are similar to a high degree, the average consumer paying a medium degree of attention is unlikely to put the similarities down to economic connection. Confusion is even less likely when a higher than a medium degree of attention is paid during the purchase process. Accordingly, I do not consider that there is a likelihood of confusion, either direct or indirect.

58. The opposition, therefore, fails under section 5(2)(b).

### **Section 5(3)**

59. Section 5(3) states:

"(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) 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.

60. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

61. The relevant case law can be found in the following judgments of the CJEU:

*Case C-375/97, General Motors, Case 252/07, Intel, Case C-408/01, Adidas Saloman, Case C-487/07, L’Oreal v Bellure, Case C-323/09, Marks and Spencer v Interflora and Case C383/12P, Environmental Manufacturing LLP v OHIM.* 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*).

### Reputation

62. The proprietor disputes that the applicant has established that the earlier mark had a qualifying reputation at the relevant date.

63. For the reasons given in paragraph 42, I am prepared to accept that the applicant's mark had a qualifying reputation in the UK at the relevant date.

### Link

64. The next step is to assess whether the public will make a link between the competing marks. This is a multi-factorial assessment taking into account the strength of reputation of the earlier mark, the degree of distinctiveness of the earlier mark, the extent of the overlap between the relevant consumers for those goods and the degree of similarity between the respective marks and the goods.

65. I have already concluded that the goods are either identical or highly similar. I have also found that the earlier mark enjoys a high degree of distinctive character. Although I accepted that there is a certain degree of similarity between the marks, bearing in mind the impact of the differences introduced by the words càrn and Dràm at the beginning of the marks, I am of the view that the degree of similarity is not great. Therefore, considering the distance between the marks, I find that a significant proportion of consumers are unlikely to make a link between the competing trade marks.

66. The conditions of section 5(3) are cumulative. As I have found that there is no link, it is not necessary to consider the applicant's submissions regarding various heads of damages.

67. The section 5(3) ground is rejected accordingly.

## Section 5(4)(a)

68. Section 5(4)(a) of the Act reads as follows:

“5(4) A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

b) [...]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark”.

69. In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial number” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

70. There is no evidence that the contested mark was used in the UK prior to the date of application. That being the case, the matter must be assessed only as at the application date of the contested mark (14 November 2019).<sup>8</sup>

71. Reputation constitutes a knowledge threshold and, therefore, reputation of the earlier mark in the UK is helpful in establishing goodwill. I have already found that the earlier mark has a qualifying reputation in the UK. The same evidence also leads me to conclude that the applicant's mark enjoys a protectable goodwill in the UK at the relevant date.

72. For the reasons given in my findings under section 5(2)(b) ground, even though the competing goods are identical or similar to a high degree, the distance between the competing trade marks is such that I conclude that there would be no misrepresentation. The use of the contested mark is not likely to deceive a substantial number of the applicant's customers or potential customers. I recognise that there is a difference between the test for misrepresentation and the test for likelihood of confusion. However, both tests are intended to be normative measures to exclude those who are unusually careful or careless (as per Jacob L.J. in *Reed Executive Plc v Reed Business Information Ltd* [2004] RPC 40). Therefore, there are parallels between the two.

73. Section 5(4)(a) ground of opposition is dismissed.

## **Conclusion**

74. The cancellation application is unsuccessful. Subject to any successful appeal, the proprietor's trade mark will remain registered.

## **Costs**

75. The proprietor has been successful and is entitled to a contribution towards its costs.

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<sup>8</sup> See *SWORDERS TM O-212-06*

76. Awards of costs are governed by Tribunal Practice Notice (“TPN”) 2/2016. I award costs to the proprietor on the following basis:

Considering the statement of case and filing the counterstatement:	£200
Considering the other party’s evidence:	£500
Preparing for and attending hearing:	£600
Total:	£1,300

77. I order Morrison & Mackay Limited to pay Dràm Mòr Group Ltd. the sum of £1,300. This sum is to be paid within two months 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 27<sup>th</sup> day of July 2021**

**Karol Thomas  
For the Registrar  
The Comptroller-General**