

O/765/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003474100

BY LITTLE HARE GIN COMPANY LIMITED

TO REGISTER:



(SERIES OF SIX)

AS TRADE MARKS IN CLASSES 16, 25, 33, 40, 41 AND 43

AND

IN THE MATTER OF THE OPPOSITION THERETO

UNDER NO. 420637 BY

HARROGATE DISTILLERY LTD

T/A WHITTAKER'S GIN

## BACKGROUND AND PLEADINGS

1. On 11 March 2020, Little Hare Gin Company Limited (“the applicant”) applied to register the series of trade marks shown on the cover of this decision (“the application”) in the UK for the following goods and services:

Class 16: Paper; cardboard; printed matter; photographs; stationery; plastic materials for packaging; recipe books; printed recipe cards; drinks mats; paper gift bags; cardboard gift boxes; carrying cases made of paper; labels.

Class 25: Clothing; footwear; headgear.

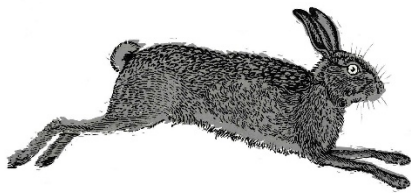
Class 33: Gin; alcoholic beverages except beers; spirits; distilled spirits; liqueurs; alcopops; alcoholic cocktails; alcoholic extracts; alcoholic essences; alcoholic beverages containing fruit.

Class 40: Spirits distillery services.

Class 41: Recreational, entertainment and educational services; conducting guided tours; arranging of exhibitions for cultural purposes; conducting of exhibitions for amusement purposes.

Class 43: Services for providing food and drink; bar services; serving of alcoholic beverages.

2. The application was published for opposition purposes on 27 March 2020 and, on 26 June 2020, it was partially opposed by Harrogate Distillery Ltd T/A Whittaker’s Gin (“the opponent”). The opposition is aimed at the applicant’s “gin” goods only and is based on sections 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”). In respect of the section 5(3) ground, the opponent relies on the following mark:



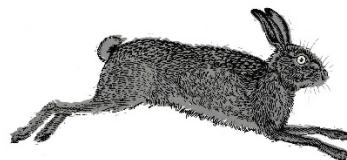
UK registration no. 3355257

Filing date 21 November 2018; registration date 22 February 2019

Relying on some goods, namely:

Class 33: Gin.  
("the opponent's mark").

3. Under the section 5(3) ground the opponent claims that it has obtained a first class reputation within the gin industry and that use of the application would take unfair advantage of, or be detrimental to the distinctive character and/or reputation of the opponent's mark.
4. In respect of its opposition under section 5(4)(a), the opponent alleges that it has been using the following unregistered right:



throughout the whole of the UK since 15 July 2015 in respect of "gin".

5. The opponent claims that it has acquired a reputation and a considerable amount of goodwill and that by using the application, the applicant would benefit from the public perception of the opponent's association with the device of a hare. The opponent claims that there is a risk the applicant's product would be of lower quality and, therefore, it would suffer damage in the form of a loss of sales as a result of the public thinking it was a product provided by the opponent.

6. In its counterstatement, the applicant sets out that while there is identity between its opposed goods and the opponent's goods, the application does not offend against sections 5(3) and 5(4)(a) of the Act.
7. The relevant date for my assessment under both the section 5(3) and 5(4)(a) grounds of this opposition is 11 March 2020, being the date of the application at issue.
8. The applicant is represented by Trainer Shepherd Phillips Melin Haynes LLP and the opponent is unrepresented. Both parties filed evidence in chief with the opponent filing further evidence in reply. Both parties filed written submission during the evidence rounds. No hearing was requested and only the applicant filed written submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.
9. Although the UK has left the EU, section 6(3)(a) of the European (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

## **PRELIMINARY ISSUES**

10. The applicant's evidence discusses the existence of different brands of gin in the marketplace that use a hare on their packaging.<sup>1</sup> It is my understanding that the applicant has taken no action against the opponent's mark. The applicant states that it does not see how the opponent's mark has distinctive character given the number of other gin brands that use a hare on their packaging. The applicant does not state whether these brands have registered these marks, neither does it explain or provide any evidence as to whether these are used in the marketplace, if at all. Even if evidence of the presence of trade marks on the register showing depictions of hares was provided, it would have no bearing on the outcome of this opposition.

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<sup>1</sup> Exhibit KH1 of the Witness Statement of Ms Karen Hehir

11. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

12. The fact that there may be a multitude of trade marks on the register with Class 33 protection for gin that contain depictions of hares is not a relevant factor to the distinctiveness of the opponent’s mark. The outcome of this opposition will be determined after assessing the opponent’s evidence of reputation and goodwill whilst taking into account all relevant factors; the state of the register is not relevant to that assessment.

13. I note that in its notice of opposition, the opponent claimed that its mark has a reputation for gin and that its unregistered right has goodwill in respect of “gin” only. Throughout the opponent’s evidence and submissions, there are references to the opponent’s mark/unregistered right being used on whisky and vodka products.<sup>2</sup> This evidence is of no assistance to the opponent as a result of the opponent limiting its opposition to a claim for a reputation and goodwill in “gin” only. I will, therefore, not consider such evidence.

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<sup>2</sup> Exhibits L, N and O of the Witness Statement of S. M. Tame

14. I also note that the opponent has filed submissions wherein it seeks to explain and/or expand upon the evidence filed. It also seeks to introduce additional statements of fact. For example, it claims that its gin has appeared on the TV shows The Apprentice and The Yorkshire Vet. Further, it claims that it operates tours of its distillery for members of the public. However, neither of these statements are supported by the evidence.

15. As my assessment of the opponent's mark's reputation and goodwill is an evidential one, I will only consider the opponent's evidence insofar as it is accompanied by a statement of truth i.e. I will only consider the first and second witness statements of S. M Tame and their accompanying exhibits. The opponent's submissions are not evidence.

16. In its submissions in lieu of a hearing, the applicant sought an award for off scale costs in the event that it was successful in these proceedings. I will address this issue below, if necessary. However, I note that upon receipt of this request, the Tribunal wrote to the opponent on 14 September 2021 stating the following:

"A copy of the written submissions filed are included with this letter to ensure receipt and a deadline of 14 days from the date of this letter, which is on or before **28 September 2021**, is now given for you to submit any comments in response to the request, which should also be copied to the representative of the applicant.

17. On 27 September 2021, the opponent filed a response wherein it addressed the off scale costs request. However, despite being directed by the Tribunal to submit comments only in response to this request, the opponent also sought to introduce further evidence into these proceedings. By way of response dated 30 September 2021, the Tribunal confirmed to the parties that,

"As advised in the letter dated 14 September 2021, the deadline of 28 September 2021 was solely for comments in response to the request made for

off scale costs, not an opportunity to file written submissions, the deadline for which expired on 9 September 2021.

Therefore, the comments on costs contained in the letter dated 27 September 2021 will be taken into consideration by the hearing officer when making his decision, however, all other content of that letter will not be taken into consideration.”

18. If the opponent wished to have the contents of its response taken into account in these proceedings, it should have been filed as evidence of fact during the evidence rounds or it should have submitted a request to file further evidence. Instead, the opponent has sought to introduce further evidence at a stage where the deadlines to file evidence or written submissions in lieu of a hearing had passed. As the letter referenced above states, I will only consider the opponent’s letter insofar as it addresses the matter of off scale costs.

## **EVIDENCE**

19. The opponent filed evidence in chief in the form of the witness statement of S. M. Tame dated 22 January 2021. S. M. Tame is the director of Tameseal Limited which is trading as ‘dare!’, being the company that created the brand for the opponent. It is not explained why S.M. Tame is filing witness evidence on behalf of the opponent.

20. S. M. Tame’s statement is accompanied by 17 exhibits. The opponent also filed evidence in reply in the form of the second witness statement of S. M. Tame dated 5 August 2021 which is accompanied by a further three exhibits. Of this evidence I note the following:

- a. A print-out from UK retailer Fortnum & Mason’s website is provided that shows a bottle of gin bearing the opponent’s mark for sale.<sup>3</sup> This print-out is dated 20 January 2021, some ten months after the relevant date. I also note that two

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<sup>3</sup> Exhibit A of the Witness Statement of S. M. Tame

additional print-outs dated 20 January 2021 are shown. One of these bears the opponent's mark for its 'Navy Strength Gin' but is a print-out from a Swiss website.<sup>4</sup> The other a second Fortnum & Mason listing that shows a product that does not bear the opponent's mark;<sup>5</sup>

b. The evidence shows five awards that have been awarded to the opponent. Of these awards, I note that:

- i. the first award is an international award and is awarded to the opponent for its product 'The Original Gin' from 2020<sup>6</sup> It is not clear that this was awarded prior to the relevant date but given that the relevant date was in early in 2020, it is unlikely that it was;
- ii. the second and third awards<sup>7</sup> are from 2018 and were awarded by the American Distilling Institute, indicating that they are American based awards. These awards are for the opponent's 'Gin Original' and its 'Navy Strength' gin;
- iii. the fourth award is a gold award for the opponent's 'Whittaker's Gin – Original' from the World Gin Awards.<sup>8</sup> This award is dated 2021, being after the relevant date; and
- iv. the final award is another international award that awarded the opponent a silver award in 2017 for its packaging.<sup>9</sup>

While the awards given to the opponent for its 'Original' gin or 'Navy Strength Gin' do not show the opponent's mark, I note that the Swiss website listing referred to at point a. above for 'Navy Strength Gin' does bear the opponent's mark. However, it is not clear whether the 'Original' gin refers to the gin listed for sale via the Fortnum & Mason website;

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<sup>4</sup> Exhibit B of the Witness Statement of S. M. Tame

<sup>5</sup> Exhibit C of the Witness Statement of S. M. Tame

<sup>6</sup> Exhibit D of the Witness Statement of S. M. Tame

<sup>7</sup> Exhibit E and Exhibit F of the Witness Statement of S. M. Tame

<sup>8</sup> Exhibit R of the Witness Statement of S. M. Tame

<sup>9</sup> Exhibit T of the Witness Statement of S. M. Tame



- c. The evidence then goes on to discuss the directors of the opponent having become members of the Gin Guild in 2016.<sup>10</sup> Further, there is evidence that shows that one director of the opponent has also been invited to become a member of the Worshipful Company of Distillers on 10 June 2020 and that he received the Freedom of the Company and the Freedom of the City of London<sup>11</sup>;
- d. An undated marketing label has been provided that shows an image of what appears to be a hare within a larger artistic scene. While the presentation of a hare is noted, it is a significantly different depiction of a hare and does not resemble the one found in the opponent's mark. Further, the evidence states that this label relates to a gin created for 'The Boutique-Y Gin Company';<sup>12</sup> and
- e. There is a photograph provided that shows three people, one of which is holding a box open showing two bottles that bear the opponent's mark.<sup>13</sup> The evidence sets out that this was from the opening of the opponent's new distillery building in 2019. A further three photographs are provided that the submissions filed with the opponent's evidence state as being from in and around the opponent's new distillery.<sup>14</sup> While the first photo shows the opponent's mark on what the accompanying submissions refer to as a 'landmark stone', the remaining two do not feature the opponent's mark.

21. Turning to the applicant's evidence in chief, this was filed in the form of the witness statement of Ms Karen Hehir dated 5 June 2021. Ms Hehir is the director of the applicant and her statement is accompanied by one exhibit. I do not propose to summarise Ms Hehir's evidence in full but note that it discusses the background of the applicant, the history behind the initial conception of the applicant's mark and other gins brands using a hare (which I have addressed above).

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

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<sup>10</sup> Exhibit G and Exhibit H of the Witness Statement of S. M. Tame

<sup>11</sup> Exhibit I of the Witness Statement of S. M. Tame

<sup>12</sup> Exhibit K of the Witness Statement of S. M. Tame

<sup>13</sup> Exhibit J of the Witness Statement of S. M. Tame

<sup>14</sup> Exhibits M, P and Q of the Witness Statement of S. M. Tame

22. Section 5(3) of the Act states:

“5(3) A trade mark which –

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 repute of the earlier trade mark.”

23. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(2) References in this Act to an earlier trade mark include a trade mark in respect of which an application for registration has been made and which, if registered, would be an earlier trade mark by virtue of subsection (1)(a) or (b), subject to its being so registered.”

24. The opponent’s mark qualifies as an earlier mark under the above provisions.

25. 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-Salomon*, Case C-487/07, *L’Oreal v Bellure*, Case C-323/09, *Marks and Spencer v Interflora*,

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 Salomon, 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* and *Environmental Manufacturing, paragraph 34*.

(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 holder 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*).

26. The conditions of section 5(3) are cumulative. Firstly, the opponent must show that its marks have achieved a level of knowledge, or reputation, amongst a significant part of the public. Secondly, the opponent must establish that the public will make a link between the marks, in the sense of the earlier mark being brought to mind by the later mark. Thirdly, assuming the first and second conditions have been met, section 5(3) requires that one or more of three types of damage claimed by the opponent will occur. It is unnecessary for the purposes of section 5(3) that the goods are similar, although the relative distance between them is one of the factors which must be assessed in deciding whether the public will make a link between the marks.

27. As I have set out above, the relevant date for the assessment under section 5(3) is the date of the application at issue, being 11 March 2020.

## **Reputation**

28. In *General Motors*, Case C-375/97, the CJEU held that:

“25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it.”

29. I have detailed submissions from the applicant wherein it has responded directly to each piece of the opponent's evidence and it sets out reasons why, in its view, this evidence is of no assistance to the opponent. I note that the opponent has also filed its own submissions addressing the points raised by the applicant. While I have considered both parties' submissions in full, I do not intend to reproduce them here but will address them below, if necessary.

30. In order to be successful under section 5(3), the opponent is required to demonstrate that it had a reputation amongst a significant part of the relevant UK public at the relevant date. In making this assessment, it is necessary for me to consider whether the opponent's mark will be known by a significant part of the public concerned with the goods. In reaching this decision, I must consider a number of factors which, as set out in the case law above, include the market share held by the mark, the intensity, geographical extent and duration of use, and the size of the investment made by the opponent in promoting it. I have summarised the evidence of use above.

31. While the evidence does show the opponent's mark on a bottle of gin listed for sale via Fortnum & Mason, albeit dated after the relevant date, I have no evidence whatsoever regarding any sales information or overall turnover figures for gin sold under the opponent's mark in the UK. Secondly, I have no evidence of advertising expenditure in relation to the opponent's mark or its goods. Further, I note that a significant amount of the evidence that I have been provided with is of no relevance to an assessment of reputation under the 5(3) ground. For example:

- a. the opponent's awards for its gin are not, in my view, evidence that is capable of demonstrating a reputation in its mark on the basis that I have no evidence or explanation as to the reach of these awards in the UK, their relevance to the UK public or whether they were decided upon by a panel of judges or by members of the public;
- b. the fact that the two directors of the opponent are members of the Gin Guild is not evidence of use of the mark, particularly given the fact that the opponent's own evidence points to it creating gin for other companies. It is, therefore, possible that such memberships arose as a result of the opponent's involvement with third party gin companies; and
- c. the existence of a distillery owned by the opponent that bears an image of the opponent's mark on a 'landmark stone' is not evidence of use of the mark on gin products. While I accept that the distillery may produce gin products, there is no evidence as to how much gin is produced or how many members of the general public would see the landmark stone bearing the opponent's mark. On

this point, I note that the opponent's submissions stated that "our craft distillery is open for distillery tours and we have an on site shop where the public comes to witness the simple fact that we are genuine craft distillers." While the claims made in the submissions are noted, there is no evidence supporting them.

32. Taking all of this into account, I am not satisfied that the opponent has established that it had a reputation in its mark at the relevant date. The opposition reliant upon section 5(3), therefore, fails.

**Section 5(4)(a)**

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

"(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, where the condition in subsection (4A) is met,

(aa) .....

(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."

34. Subsection (4A) of Section 5 states:

"(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application."

35. 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).”

36. Halsbury’s Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

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

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant’s use of a name, mark or other feature which is the same or sufficiently similar that the defendant’s goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot



be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

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

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.”

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

### Relevant Date

37. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether the position would have been any different at the later date when the application was made.’ ”

38. As the applicant’s mark does not have a priority date and there is no evidence that the applicant’s mark was used prior to the application date, the relevant date for assessment of the opponent’s claim under section 5(4)(a) of the Act is the date of the application for registration, being 11 March 2020.

## **Goodwill**

39. The first hurdle for the opponent is that they need to show that they had the necessary goodwill in the following sign:



at the relevant date. Goodwill was described in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), in the following terms:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

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

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

41. However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat) Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the

application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

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

“62. In my view the law of passing off does not protect a goodwill of trivial extent. Before trade mark registration was introduced in 1875 there was a right of property created merely by putting a mark into use for a short while. It was an unregistered trade mark right. But the action for its infringement is now barred by s.2(2) of the Trade Marks Act 1994. The provision goes back to the very first registration Act of 1875, s.1. Prior to then you had a property right on which you could sue, once you had put the mark into use. Even then a little time was needed, see per Upjohn L.J. in BALI Trade Mark [1969] R.P.C. 472. The whole point of that case turned on the difference between what was needed to establish a common law trade mark and passing off claim. If a trivial goodwill is enough for the latter, then the difference between the two is vanishingly small. That cannot be the case. It is also noteworthy that before the relevant date of registration of the BALI mark (1938) the BALI mark had been used “but had not acquired any significant reputation” (the trial judge's finding). Again that shows one is looking for more than a minimal reputation.”

43. Goodwill arises as a result of trading activities. I have addressed the opponent's evidence at paragraph 31 above and the deficiencies highlighted there, apply here also. Put simply, the opponent has not provided any evidence as to its trading activities. As a result, the opponent's evidence falls well short of what I consider to be necessary to establish sufficient goodwill to maintain a claim of passing off. As noted in the case law cited above, the burden is on the opponent to prove goodwill. I am not satisfied, based on the evidence filed, that it has done so.

44. As the establishment of goodwill is essential for the success of a section 5(4)(a) claim, the opposition reliant upon this ground, therefore, must fail.

## CONCLUSION

45. The opposition fails in its entirety and the application can proceed to registration.

## COSTS

46. The applicant has been successful and is entitled to a contribution towards its costs. In its written submissions in lieu, the applicant requested that off the scale costs be considered in favour of the applicant. The applicant has requested costs in the sum of £5,000 which it claims is approximately 60% of the total costs incurred. The applicant's reasons for a claim for off scale costs are that (1) the opposition was entirely unreasonable as the opponent's case relied on an entirely dissimilar mark and (2) the opponent's position became even more untenable when the evidence was filed in that it was never going to sustain a claim of reputation or goodwill. The opponent was provided an opportunity to respond to the request for off scale costs and did so on 27 September 2021. Within its response, the opponent did not expressly argue against an award of off scale costs but did confirm that it did not seek its own costs in the event it was successful.

47. Having considered the submissions, I find that the reasons set out by the applicant do not warrant an award of off scale costs. Cost awards within the Tribunal are, for the most, part contributory in nature. While the opposition was unsuccessful, I do not consider that the filing of it was unreasonable on the basis of the alleged dissimilarity between the marks, particularly given that the grounds relied upon do not necessarily rely on the marks being similar. For example, it is possible to find that the public would make a link between marks under section 5(3), even if the similarity between those marks was not sufficient to trigger a finding of likelihood of confusion under section 5(2)(b) of the Act<sup>15</sup>. In short, I do not consider the filing of such an opposition to be unreasonable in the circumstances. Further, if the applicant was of the view that the opponent's position was untenable based on the evidence filed, it could have opted not to file its own evidence and respond to each exhibit individually, thereby increasing its own costs.

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<sup>15</sup> *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P

48. The fact that the opponent was unsuccessful will be reflected in a contributory award based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,800 as a contribution towards the costs of proceedings. The sum is calculated as follows:

Reviewing the notice of opposition and preparing a counterstatement:	£500
Preparing and considering evidence:	£800
Preparing written submissions:	£500
<b>Total:</b>	<b>£1,800</b>

49. I therefore order Harrogate Distillery Ltd T/A Whittaker's Gin to pay Little Hare Gin Company Limited the sum of £1,800. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

**Dated this 13<sup>th</sup> day of October 2021**

**A COOPER**  
**For the Registrar**