

O-820-21

TRADE MARKS ACT 1994

**IN THE MATTER OF TRADE MARK APPLICATION NO. 3490735
BY EVELYN ROBERTS LIMITED IN RESPECT OF THE TRADE MARK**

THIRSTY JACK

IN CLASS 33

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 421380 BY JACK
DANIEL'S PROPERTIES, INC**

Background and pleadings

1. Evelyn Roberts Limited (“the applicant”) applied to register the trade mark THIRSTY JACK in the UK on 17 May 2020 (“the relevant date”). It was accepted and published in the Trade Marks Journal on 5 June 2020 in respect of the following goods:

Class 33: *Alcoholic beverages with fruit carbonated; Alcoholic beverages with fruit non-carbonated; Alcoholic beverages without fruit carbonated; Alcoholic beverages without fruit non-carbonated; Beverages and mixers for making alcoholic beverages; Alcoholic beverages containing milk ;Alcoholic beverages, except beer; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic preparations for making beverages; Alcoholic tea-based beverage; Alcoholic Slush.*

2. Jack Daniel’s Properties, Inc (“the opponent”) opposes the trade mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The first two grounds are based upon nine earlier marks (the last four relied upon for section 5(2)(b) only), the relevant details of which are:

<p>UK 2545430</p>  The image shows a black and white label for Jack Daniel's Old No. 7 Tennessee Sour Mash Whiskey. The label features the brand name 'JACK DANIEL'S' in a large, stylized font at the top. Below it, 'Old No. 7 BRAND' is written in a smaller font, with 'Old' and 'BRAND' in smaller letters. The word 'Tennessee' is written in a cursive font, followed by 'SOUR MASH' in a smaller font, and 'WHISKEY' in a large, bold font at the bottom. The entire label is framed by a decorative border.	<p>Filing date: 21 April 2010 Registration date: 23 July 2010</p>
<p>Class 33: <i>Alcoholic beverages; including distilled spirits.</i></p>	

EU 6329081	Filing date: 5 October 2007
GENTLEMAN JACK	Registration date: 29 August 2008
Class 33: <i>Alcoholic beverages; including, distilled spirits.</i>	

EU 0154211	Filing date: 1 April 1996
JACK DANIEL'S	Registration date: 29 September 1998
Class 32: <i>Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.</i>	
Class 33: <i>Alcoholic beverages (except beers).</i>	

EU 12179438	Filing date: 27 September 2013
JACK DANIEL	Registration date: 19 February 2014
Class 33: <i>Alcoholic beverages; including distilled spirits.</i>	

EU 010532984	Filing date: 29 December 2011
JACK	Registration date: 9 May 2012
Class 33: <i>Alcoholic beverages; including prepared alcoholic cocktails, and specially excluding cider and perry.</i>	

EU 011569886	Filing date: 13 February 2013
JACK HONEY	Registration date: 24 June 2013
Class 33: <i>Alcoholic beverages, including distilled spirits.</i>	

EU 013429121	Filing date: 4 November 2014
JACK ROCKS	Registration date: 18 May 2017
Class 33: <i>Alcoholic beverages, except beers.</i>	

EU 010221851	Filing date: 26 August 2011
WINTER JACK	Registration date: 8 January 2012
Class 33: <i>Alcoholic beverages, including pre-mixed alcoholic cocktails.</i>	

EU 05151535	Filing date: 21 June 2006
JACK LIVES HERE	Registration date: 18 May 2007
Class 33: <i>Alcoholic beverages, including distilled spirits.</i>	

3. In respect of the ground based upon section 5(2)(b), the opponent argues that the respective goods are mostly identical but where they are not, they are very highly similar. It claims that, taking account of this and the similarity of the respective marks, there is a likelihood of confusion. Additionally, the opponent relies upon a claim that its earlier marks share the common denominator “JACK” and together form a family of marks and, because the applicant’s mark also contains this name, there exists a likelihood of confusion.

4. In respect of the ground based upon section 5(3), the opponent claims that the earlier marks relied upon for this ground have developed a massive reputation and that this was established prior to the relevant date in these proceedings. It concludes that use of the applicant’s mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of its marks.

5. In respect of the ground based upon section 5(4)(a), the opponent relies upon its alleged earlier right in “JACK”. It claims to have been selling, throughout the UK, *alcoholic beverages, distilled spirits and whiskey* under this sign since at least as early as 2000 and has acquired goodwill under the sign. Use of the trade mark applied for

would therefore be a misrepresentation to the public and result in damage to the aforementioned goodwill.

6. The applicant filed a counterstatement denying the claims made and requesting that the opponent provides proof of use of all of its earlier marks relied upon. The opponent's earlier mark EU 013429121 JACK ROCKS is not subject to the proof of use provisions, however, at the hearing, the opponent has indicated that it is no longer relied upon this mark. The remaining earlier marks may only be relied upon to the extent in which use has been proven.

7. Only the opponent filed evidence in these proceedings. This will be referred to as considered necessary. The applicant filed written submissions with its counterstatement.

8. A Hearing took place on 9 September 2021, with the opponent represented by Mr Julius Stobbs of Stobbs. The applicant notified the Registry only late the evening before the hearing that Mr Robert Kaniu would attend on behalf of the applicant.

9. Although the UK has left the EU, section 6(3)(a) of the European Union (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 upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to EU trade mark law.

Evidence

10. The opponent's evidence is the witness statement of Justin P Welch, President of the opponent together with Exhibits JW1 – JW28.

DECISION

Proof of Use

11. The relevant statutory provisions are contained in section 6A of the Act:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) 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.

(5) In relation to a European Union trade mark or international trade mark (EC), any reference in subsection (3) or (4) to the United Kingdom shall be construed as a reference to the European Community.

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

12. Also relevant is Section 100 of the Act that states:

“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.”

13. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J (as he then was) 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 Bunderversammlung Kameradschaft ‘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 Merken 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].”

14. At the hearing, Mr Stobbs conceded that no genuine use has been shown in respect of the marks JACK HONEY and JACK LIVES HERE. Further, Mr Stobbs stated that the opponent’s case is no stronger in respect of its JACK DANIEL’S label mark as it is based upon the word mark JACK DANIEL’S. In light of these comments, I will consider the opponent’s evidence only in the context of the earlier marks that are subject to proof of use (except 2545430 JACK DANIEL’S label) and where Mr Stobbs submitted that there is sufficient evidence of use. The date of application of the contested mark is 20 May 2020, therefore, the five-year period in which use of the earlier marks must be proved is 21 May 2015 to 20 May 2020.

EU 0154211 JACK DANIEL’S

15. In February 1997, JACK DANIEL’S single barrel Tennessee whiskey was introduced” and “is currently sold [in] the United Kingdom and all Member States of the European Union except Finland”¹. Mr Welch identifies other products “in the JACK DANIEL’S line” and these include the following whiskey products:

- JACK DANIEL’S SINATRA SELECT;
- JACK DANIEL’S TENNESSEE FIRE;
- JACK DANIEL’S SINGLE BARREL RYE
- JACK DANIEL’S NO. 27 GOLD
- JACK DANIEL’S TENNESSEE APPLE

the following ready-to-drink mixed alcoholic cocktails:

¹ Ditto, para 13

- JACK DANIEL'S & COLA
- JACK DANIEL'S & LIGHT COLA
- JACK DANIEL'S LYNCHBURG LEMONADE
- JACK DANIEL'S HONEY & LEMONADE
- JACK DANIEL'S & GINGER

and JACK DANIEL'S TENNESSEE CIDER, "all of which are currently available or have been available in the United Kingdom and various Member States of the European Union"².

16. A spreadsheet supplied by The IWSR, which maintains the world's largest database on the alcohol beverage market, is provided³. This records the number of cases and retail value of various JACK DANIEL'S branded whiskeys in the UK and the largest (by retail value) three of the EU states. Figures for the whole of the EU are also shown:

Year	Territory	Volume (000s 9 litre cases)	Retail Value (000s of USD)
2011	UK	1054	381,134
	France	491	141,521
	Germany	552	151,254
	Poland	175	51,383
	EU*	3255	1,003,999
2012	UK	1052	400,077
	France	549	157,676
	Germany	628	186,698
	Poland	215	61,837
	EU*	3454	1,095,022
2013	UK	1142	441,854
	France	593	170,088
	Germany	665	203,462

² Ditto, para 16

³ At Exhibit JW7

	Poland	245	71,019
	EU*	3710	1,204,864
2014	UK	1185	459,381
	France	702	198,560
	Germany	659	196,011
	Poland	269	82,774
	EU*	3917	1,289,131
2015	UK	1343	511,398
	France	809	227,996
	Germany	670	199,035
	Poland	296	90,617
	EU*	4309	1,421,008
2016	UK	1392	537,534
	France	892	253,950
	Germany	722	219,267
	Poland	348	108,323
	EU*	4607	1,541,161
2017	UK	1503	613,674
	France	938	262,425
	Germany	733	222,891
	Poland	410	119,609
	EU*	4863	1,647,120

*Also includes figures for goods under the GENTLEMAN JACK mark

17. In addition, further figures are provided⁴ in respect of various ready-to-pour products, namely, JACK DANIELS & COLA, JACK DANIELS LEMONADE, JACK DANIELS AND GINGER, JACK DANIELS WINTER JACK, JACK DANIELS CIDER, JACK DANIELS HONEY & LEMONADE long drink. Various of these have been sold in various EU states but not all in all states. All have been sold in the UK. Figures are lower than for the opponent's whiskey products but, in the UK, for each of the same years, the retail value was still between USD 9,024,000 and USD 50,138,000.

⁴ At exhibit JW8

18. Market share figures are provided⁵ which illustrate that, in 2017, the JACK DANIEL'S line of products had reached 2.1% of sales volumes and 4% in terms of retail value across the entire spirits market in the opponent's key EU markets of the UK, Germany, France, Poland, Spain, Italy, Belgium, Luxemburg, Czech Republic, Romania and the Netherlands.

19. Mr Welch also details the following promotional activities:

- Print advertisements have appeared for many years in the UK and elsewhere in the EU⁶ and representative samples are provided⁷ for the period 2014 – 2018. These show numerous advertisements or promotional articles relating to JACK DANIEL'S WINTER JACK and JACK DANIEL'S TENNESSEE HONEY appearing in the METRO newspaper, The Huffintom Post, Daily Mail and magazines such as the NME and Esquire;
- Advertisements for JACK DANIEL'S Whiskey have appeared on billboards for many years⁸. A representative example of outdoor advertising in the UK and Germany, in 2016 and 2017, and billboard advertising in the UK between 2015 and 2019 are provided⁹. These all feature bottles of various JACK DANIEL'S whiskey on display in a number of locations including in London underground stations;
- Point of purchase materials distributed to and displayed by off-premise and on-premise trades.

20. At the hearing, Mr Stobbs pointed out that all of the opponent's products feature the mark JACK DANIEL'S and that the amount of sales in the UK and EU are huge with \$2.8 billion of sales in the UK market between 2015 and 2019¹⁰. In addition, Mr Stobbs pointed to the extensive advertising, celebrity endorsements and mentions in

⁵ Mr Welch's witness statement, para 25 and Exhibit JW10

⁶ Ditto, para 27

⁷ At Exhibit JW11

⁸ Mr Welch's witness statement, para 27

⁹ Exhibits JW12 and JW13

¹⁰ Mr Welch's witness statement, para 24

popular culture that support his submission that JACK DANIEL'S has a "very significant reputation and level of use".

21. It is established that genuine use of a mark can be where that mark is used with or as part of another mark as well as independently¹¹. Therefore, use of the word mark JACK DANIEL'S as part of a label device qualifies as genuine use of the word mark. I recognise that the font in which the word JACK DANIEL's appears within the label is slightly stylised, but this makes no material difference to my analysis. The majority of the evidence that shows use of JACK DANIEL'S is as part of a label device but this, therefore, is evidence of genuine use of the word mark.

22. It is evident from these large-scale sales that the JACK DANIEL'S mark has been used extensively in the UK and in a large proportion of the EU and I have little hesitation in concluding that genuine use has been demonstrated.

23. The mark is registered in respect of beers and various non-alcoholic drinks in Class 32 and alcoholic beverages at large in Class 33. The use shown relates predominantly to whiskey but also includes mixed drinks based upon whiskey and cider. These goods are proper to Class 33 and it follows that there is no use shown in respect of Class 32 goods. It is necessary that I consider whether this use justifies the opponent's reliance upon the whole of its Class 33 specification or whether it is appropriate to limit it to a fair specification reflecting the use shown.

24. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law, in respect of devising a fair specification, as being:

"In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned."

¹¹ See *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, paras 31 - 35

25. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand,

protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them;
Mundipharma AG v OHIM (Case T-256/04) ECR II-449; EU:T:2007:46.”

26. Keeping all of the above in mind, it is clear to me that the term *alcoholic beverages (except beers)* whilst being a category that would include all the goods for which use has been shown it is, nonetheless, a very broad category. Mr Stobbs submitted that use is shown in respect of *whiskey* and *ready-to-drink cocktails* thus supports use in respect of *alcoholic beverages* at large. I do not agree that the use supports the retention of such a broad term as *alcoholic beverages*, rather the terms *whiskey* and *ready-to-drink whiskey based cocktails* are, themselves, categories of goods suitable to reflect the use shown.

EUTM12179438 JACK DANIEL

27. No separate evidence is provided over and above that in respect of use of the opponent’s JACK DANIEL’S mark. Further, reliance upon this mark does not take the opponent’s case any further forward. Consequently, I will say no more in respect of this mark.

EU 6329081 Gentleman Jack

28. A rare Tennessee Whiskey was introduced in 1989 and “sold throughout the United States since its introduction and is currently sold in the United Kingdom and the European Union, except Ireland, Portugal, Malta and Finland”¹². An undated photograph of four bottles of the opponent’s whiskey bottles is provided¹³, one of which has a label showing the product name “GENTLEMAN JACK”

¹² Mr Welch’s witness statement, para 12

¹³ At Exhibit JW2

29. The IWSR also provides information regarding the GENTLEMAN JACK branded whiskey. The EU figure in the table at paragraph 14 includes figures relating to goods sold under the GENTLEMAN JACK mark. Again, I do not produce all the data provided but the following are the figures related to the largest EU markets and the UK:

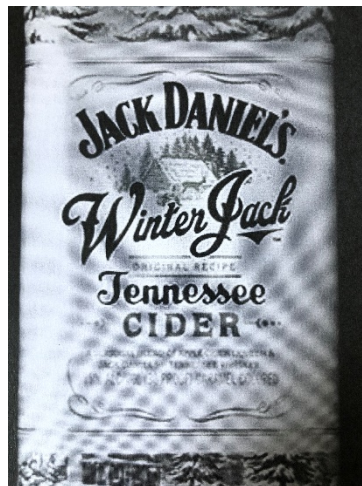
Year	Territory	Volume (000s 9 litre cases)	Retail Value (000s of USD)
2011	UK	9.4	4,764
	France	7.0	4,058
	Germany	6.0	2,521
	Poland	6.55	2,789
2012	UK	11.0	5,528
	France	8.5	3,373
	Germany	10.5	4,412
	Poland	6.25	2,042
2013	UK	13.75	7,468
	France	9.0	3,489
	Germany	10.4	4,514
	Poland	8.3	3,064
2014	UK	12.0	6,517
	France	9.4	2,737
	Germany	13.2	5,730
	Poland	9.15	3,571
2015	UK	16.2	7,997
	France	11.0	4,217
	Germany	13.0	5,687
	Poland	7.75	3,025
2016	UK	19.6	9,692
	France	13.0	6,444
	Germany	14.0	5,688
	Poland	12.5	4,879
2017	UK	21.7	10,730
	France	14.0	5,296

	Germany	14.9	6,045
	Poland	14.5	5,145

30. I conclude that this scale of use readily qualifies as genuine use for the purposes of section 6A of the Act. As Mr Stobbs pointed out, this mark is used in respect of a specific product, namely, Tennessee whiskey. The registration is registered in respect of *alcoholic beverages; including, distilled spirits*. Keeping in mind the requirements and my previous considerations regarding a fair specification, it is clear to me that the specification is too broad to reflect the use shown and I conclude that an appropriate specification is one limited to *Whiskey*.

EU 010221851 WINTER JACK

31. Mr Welch states that “[i]n 2011, [JACK DANIEL’S] WINTER JACK was introduced to the market” and is a ready-to-drink whiskey apple punch. It has been sold “as a limited/special edition product in ... the United Kingdom, Germany, Poland, Austria and Croatia”¹⁴ but not all of these territories feature sales during the relevant period. The following undated photograph is provided¹⁵:



¹⁴ Ditto, para 15

¹⁵ At Exhibit JW2

32. There is also evidence of WINTER JACK being used on an “apple whiskey punch”¹⁶. WINTER JACK has been promoted in UK newspapers and magazines as detailed in paragraph 17, above. Year on year sales have also been provided¹⁷ between 2011 and 2017 but numerous references including in the Metro Yorkshire¹⁸, dated 18 November 2014, states that “Jack Daniel’s is launching Winter Jack, an apple whiskey punch”. As the relevant period begins in May 2015 and it is not known what proportion of 2015 sales relate to after the start of the relevant period, it is the sales from 2016 and 2017 that are most relevant to my considerations here. These are recorded as being:

Territory	Retail Value (000s of US \$)	
	2016	2017
Germany	955	0
UK	3,780	2,112
Austria	188	470
Total	4,893	2,582

33. Similarly to the use of GENTLEMAN JACK, this mark is also used in respect of a single product and, whilst the sales are markedly smaller to that in respect of the house brand JACK DANIEL’S they represent a total sales in the region of \$7,5 million over the two years 2016/7 in three territories of the EU. I conclude that this represents sufficient volumes to support a finding of genuine use.

34. Mr Stobbs submitted that such use should allow the opponent to rely upon a specification of *pre-mixed alcoholic cocktails*. I consider this too broad a category and allow the opponent to rely upon the slightly narrower category of *pre-mixed whiskey cocktails*.

¹⁶ See, for example, at Exhibit JW11, page 4 that is an advert from The Huffingham Post, dated 12 December 2014

¹⁷ At Exhibit JW8

¹⁸ See, for example, Exhibit JW11, page 12

35. The Jack Daniel whiskey and associated marks have long been advertised and promoted by reference to “Mr Jack”, “Uncle Jack”, “Gentleman Jack” or simply “Jack”¹⁹. The following examples of print advertisements are provided:

- An undated promotional article (bearing a 2019 copyright notice) discussing Jack Daniels, a figure from 19th century Lynchburg, Tennessee This figure is referred to in the article as “Mr Jack” and “Jack”. There is no mention of any of the opponent’s products being referred to as “Jack”;
- A further undated promotional article (bearing a 2019 copyright notice) discussing Jack Daniel and his founding of the Jack Daniel Distillery. It is entitled “It’s hard to believe Jack’s gone”. Mr Daniel is referred to as “Jack” a number of times;
- A promotional article from 2018 documenting Frank Sinatra’s enjoyment of “Jack’s whiskey”;

36. Mr Stobbs directed me to further examples in Exhibits JW11 – 13, also consisting of promotional use of JACK solus, such as:

- An article from the NME referring to “Mr Jack” as being “one hell of a whiskey maker” being a reference to Jack Daniel, the founder of the first distillery producing whiskey under his name (24 March 2017);
- An advert from the Sunday Mirror’s Notebook promoting Christmas spirits including the opponent’s WINTER JACK where it is sated “Jack has been given a seasonal twist with cinnamon, apple and cloves” (12 December 2014);
- An undated campaign entitled “Kick Back With Jack” promoting the opponent’s JACK DANIEL’S TENNESSEE HONEY that appeared in the Metro newspaper²⁰;
- Another undated Metro advertisement entitled “A Little Bit of Honey. A Whole Lot of Jack”²¹;

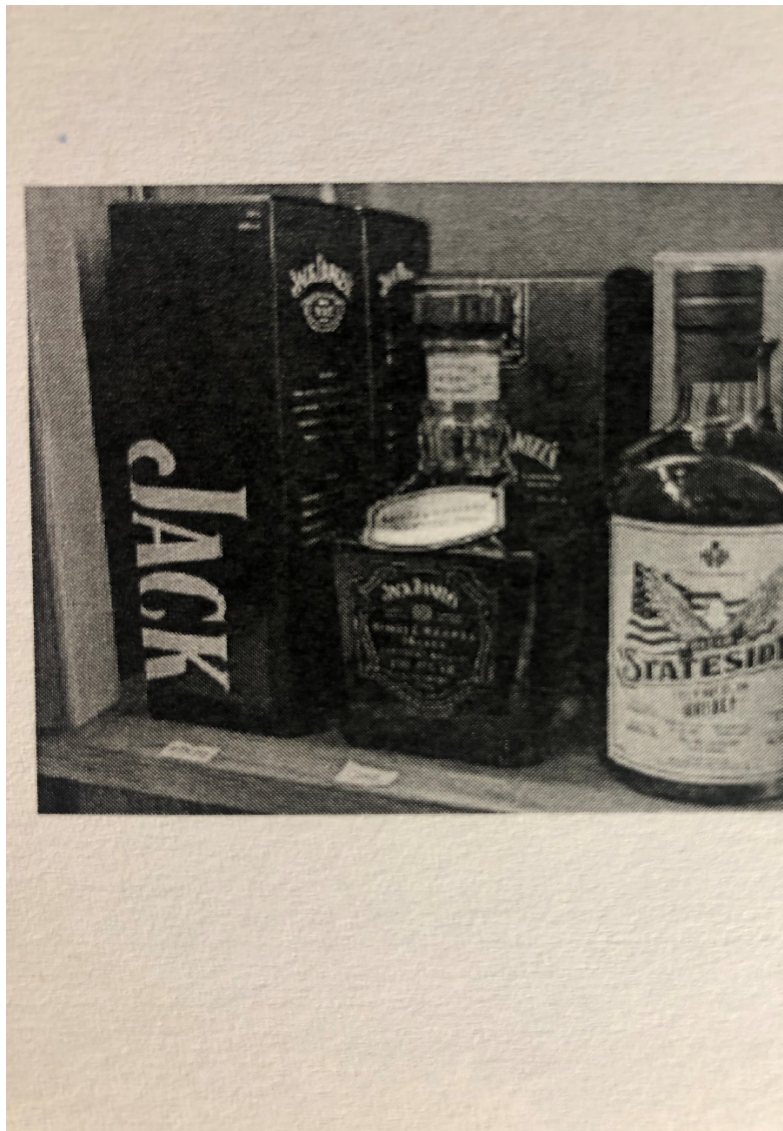
¹⁹ Mr Welch’s witness statement, para 18 and Exhibit JW3

²⁰ See Exhibit JW11, page 33

²¹ Ditto, page 50

- A draft advert, dated 12 December 2014, entitled “It’s Not Bourbon, It’s Not Scotch. It’s Jack.”
- There are also a number of articles referring to the history of JACK DANIEL’S whiskey where the founder is referred to merely as “Jack”²².

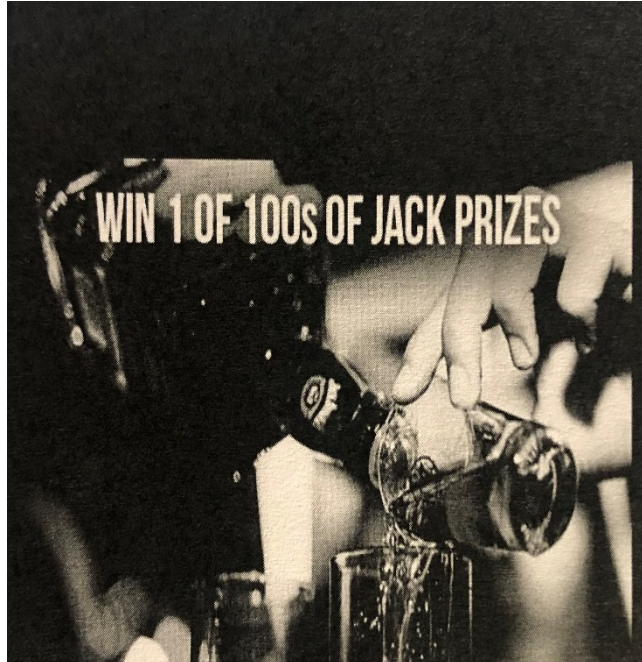
37. In addition, there are photographs of presentation boxes appearing on shelves of numerous UK retail outlets all bearing the name JACK²³. These are all attributed the date of 2020 and two examples are shown below:



²² See for example Exhibit JW11, page 53, dated 4 April 2018 but it is not clear that this advert ever appeared in the press

²³ See Exhibit JW14

38. Also, there are a number of advertisements posted by “Jack Daniel’s UK” on Facebook between July and September 2015²⁴. These show the opponent’s whiskey being poured into a promotional glass with the words “JACK LIVES HERE” appearing thereon as shown below:



39. These exhibits do illustrate that the opponent, on occasions, uses JACK solus to identify its main JACK DANIEL’S brand. It is not known to what extent this is done. However, the evidence detailed above shows that it sometimes appears on the packaging and it is used in promotional material when referring to JACK DANIEL’S whiskey. Further, Mr Welch stated that the public has long identified and referred to JACK DANIEL’S whiskey and related products by the name JACK e.g. by ordering a JACK and COKE²⁵. There is support for this on Wikipedia²⁶ and the Urban Dictionary²⁷. Taking all of this into account with the very extensive use of JACK DANIEL’S in respect of which JACK is used to refer, despite the shortcomings in the evidence, I conclude that there is genuine use of this EU mark.

40. In summary, I conclude that the opponent may rely upon the mark JACK in respect to whiskey for the purposes of section 5(2)(b) and section 5(3) of the Act.

²⁴ See Exhibit JW17

²⁵ Mr Welch’s witness statement, para 19

²⁶ See Exhibit JW4

²⁷ See Exhibit JW5

Section 5(2)(b)

41. 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”.

42. Section 5A states:

“5A. [...] Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only”.

43. The following principles are obtained from the decisions 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 C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

44. In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“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”.

45. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

46. The respective goods are as follows:

Opponent's Goods	Applicant's Goods
<u>EU 010532984 JACK</u> Class 33: Whiskey	Class 33: <i>Alcoholic beverages with fruit carbonated; Alcoholic beverages with fruit non-carbonated; Alcoholic beverages without fruit carbonated; Alcoholic beverages without fruit non-carbonated; Beverages and mixers for making alcoholic beverages; Alcoholic beverages containing milk ;Alcoholic beverages, except beer; Alcoholic coffee-based beverage; Alcoholic cordials; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic preparations for making beverages; Alcoholic tea-based beverage; Alcoholic Slush.</i>
<u>EU 0154211 JACK DANIEL'S</u> Class 33: Whiskey; ready-to-drink whiskey based cocktails	
<u>EU 6329081 Gentleman Jack</u> Class 33: Whiskey.	
<u>EU 010221851 WINTER JACK</u> Class 33: Pre-mixed whiskey cocktails	

47. Mr Stobbs submitted that all of the applicant's goods are either identical or very highly similar to those of the opponent. He added that reference to *mixers* in applicant's specification must be to *alcoholic mixers* because of the class in which they are filed. I agree with this latter point.

48. In respect of the applicant's *alcoholic beverages with fruit carbonated; Alcoholic beverages with fruit non-carbonated; ...Alcoholic beverages without fruit non-carbonated; ... Alcoholic beverages containing milk, ... alcoholic coffee-based beverage*, these terms all include *ready-to-drink cocktails* and *pre-mixed whiskey cocktails* and are self-evidently identical to those goods. Where the alcoholic beverages are in the form of whiskey, there is a high level of similarity to the opponent's whiskey because they will have an identical nature (both being alcoholic drinks), intended purpose (both being drunk for pleasure), method of use (both being consumed as a drink), trade channels (a whiskey provider may provide whiskey and whiskey-based drinks) and may also be in competition.

49. In respect of the applicant's *beverages*, this term is very broad term covers all of the opponent's goods and is self-evidently identical.

50. As I have already acknowledged, the applicant's *mixers for making alcoholic beverages* must be alcoholic mixers and I make my analysis with this in mind. Based on an analysis as applied in paragraph 49, above, such goods share the same nature, and intended purpose. In respect of methods of use, these goods are added to other alcoholic beverages to create a mixed drink such as the opponent's *ready-to-drink whiskey based cocktails* and *pre-mixed whiskey cocktails* and, therefore, share a very similar method of use. Where these mixers are whiskey based then they may share trade channels. Finally, these goods may have an element of competition with the opponent's goods in that the consumer may make a choice between purchasing a mixer to add to their own alcoholic beverage or to purchase *ready-to-drink* or *pre-mixed cocktails*. I conclude that these goods share a high level of similarity to the opponent's *ready-to-drink whiskey based cocktails* and *pre-mixed whiskey cocktails*. In respect of the similarity to the opponent's *whiskey*, the level of similarity is lower but because of the overlap in the respective goods' nature and intended purpose, I find that there is still a medium level of similarity.

51. In respect of the applicant's *Alcoholic beverages, except beer; ... Alcoholic beverages without fruit carbonated*, it is self-evident that these terms cover identical goods to the terms listed in the various registrations of the opponent.

52. Finally, in respect of the applicant's terms *Alcoholic cordials; Alcoholic energy drinks; Alcoholic essences; Alcoholic extracts; Alcoholic fruit extracts; Alcoholic jellies; Alcoholic preparations for making beverages; Alcoholic tea-based beverage; Alcoholic Slush*, these have no direct equivalent in the opponent's specifications. However, they are all alcoholic products that may be chosen in preference to the opponent's goods and, therefore, are in competition. Further, they share the same purpose in that they are all consumed to experience the flavour and pleasurable effect of alcohol. In respect of method of use, both parties' goods are consumed orally. In respect of trade channels, to the extent that the applicant's goods are whiskey based, there is an

overlap of trade channels. Taking all of this into account, I conclude that these goods share at least a medium level of similarity.

Average consumer and the purchasing act

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

54. 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.”

55. Mr Stobbs submitted that the average consumer for alcoholic beverages is an adult member of the public and would be expected to pay a low to moderate degree of attention when purchasing such goods. He directed me to *Sazerac Brands LLC et al v Liverpool Gin Distillery et al*²⁸ where the average consumer for bourbon was analysed in some detail. I accept that there is a significant mass market for such goods and that such goods are not solely for a high-end consumer. I would describe the level of care and attention as being of a medium level, neither particularly high nor low. Some of these goods may be higher end and these would attract greater care and

²⁸ [2020] EWHC 2424 at [47] – [56]

attention during the purchasing process. The purchasing process will be predominantly visual in nature, but I keep in mind that aural considerations may play a part especially in circumstances where the goods are ordered in a bar or club environment.

Comparison of marks

56. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

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

58. I consider similarity between the applicant’s mark and each of the opponent’s marks in turn.

THIRSTY JACK v. JACK

59. The opponent’s mark consists of the male forename JACK and its distinctive character obviously resides in this word. The applicant’s mark consists of the two words THIRSTY JACK. The first word is an adjective applying to the second word to

describe a person named Jack being in need of quenching his thirst. The distinctive character lies in the combination of these two words with no one word more dominant than the other.

60. Visually, the opponent's mark presents as the single word JACK. This word appears as the second word of the applicant's mark and is a point of similarity. The applicant's mark also includes the word THIRSTY that is absent from the opponent's mark. Taking this into account, I conclude that they share a medium level of visual similarity. Similarly, the aural similarity arises from the third syllable of the applicant's mark being identical to the sole syllable of the opponent's mark. They differ in that the applicant's mark has the additional syllables THIRST-EE at the start. I conclude that they share a medium level of aural similarity.

61. The concept of THIRSTY is absent from the opponent's mark, but both marks contain the common male forename JACK. As a forename, it can describe any number of individuals called JACK. This weakens the conceptual similarity because the respective marks may be perceived as a reference to different persons named JACK. Nevertheless, the common occurrence still creates some conceptual similarity and, when considering the marks as a whole, I find a low to medium level of conceptual similarity.

THIRSTY JACK v. JACK DANIEL'S

62. The opponent's mark consists of the possessive form of a full name. It's distinctive character results from the combination of the first name and surname to create an indicator of a specific person. As I have noted above, the distinctive character of the applicant's mark lies in the combination of its two words with no one word more dominant than the other.

63. Visually, Mr Stobbs submitted that the marks coincide in the element JACK that is an independent element in both marks. He also submitted that the THIRSTY element of the applicant's mark is descriptive (or at least has a relevant meaning in respect of drinks) results in it playing a lesser role in the comparison. I do not agree. Whilst I accept that the word THIRSTY has a meaning in respect of the act of drinking, when

combined with the name JACK it forms a unit with both elements playing a roughly equal part in its visual identity. The opponent's mark places the word JACK at the beginning of the mark and has the additional element DANIEL'S appearing after. Taking all of this, I conclude that the marks share only a low level of visual similarity.

64. Aurally, the applicant's mark consists of the three syllables THIRST-EE-JAK, whereas the opponent's mark consists of the four syllables JAK-DAN-EE-ELS. Whilst the marks coincide in that the first syllable of the opponent's mark is the same as the last syllable of the applicant's mark, in all other respects they are different. I conclude they share a low level of aural similarity.

65. Conceptually, Mr Stobbs submitted that the THIRSTY element of the applicant's mark plays a lesser part in the analysis because it is a relevant and descriptive concept in the context of drinks. I disagree for two reasons. Firstly, distinctive character must not be taken into account for the purposes of assessing the similarity of the marks²⁹. Secondly, the word THIRSTY makes a significant contribution to the conceptual identity of the mark. As I commented earlier, the words THIRSTY and JACK combine to form a unit with the concept of someone named Jack who is feeling in need of a drink. The opponent's mark presents as a person's full name and will be perceived as identifying a particular individual. On the other hand, the presence of the name JACK in the applicant's mark will be perceived as identifying any of numerous persons named Jack. Taking account of all of this, if there is any conceptual similarity it is only very low.

THIRSTY JACK v. GENTLEMAN JACK

66. As I have found with the mark THIRSTY JACK, the opponent's mark GENTLEMAN JACK consists of two words that form a unit to convey a message that somebody called Jack is a gentleman (i.e. is a chivalrous, courteous man). No one of the two words is more dominant than the other.

²⁹ See *Ravensburger AG v OHIM*, Case T-243/08, para 27

67. Visually, both marks coincide in that they share the same second word. They differ in that the respective first words are different. The word GENTLEMAN is longer than the word THIRSTY and these words share no similarity. Factoring this into my considerations, I conclude that the respective marks share a medium level of visual similarity.

68. Aurally, I have already noted that the applicant's mark consists of the three syllables THIRST-EE-JAK. The opponent's mark consists of the four syllables GENTEL-MAN-JACK. They coincide in respect of their final syllable but in all other respects they are different. I conclude that they share a low to medium level of aural similarity.

69. Conceptually, both marks form a unit to describe, on the one hand, the concept of someone named Jack who is feeling in need of a drink and, on the other, the concept of somebody called Jack who is a chivalrous and courteous man. There is some similarity in that both marks refer to an unknown person with the forename Jack, but in other respects they are dissimilar. I conclude that they share low to medium level of conceptual similarity.

THIRSTY JACK v. WINTER JACK

70. The words WINTER JACK form a unit with no one word dominating. Whilst the precise characteristics conveyed, on a person named Jack, by the word Winter are slightly nebulous this does not prevent the words being perceived as forming a unit describing a person named Jack with certain characteristics described by the word "Winter".

71. Visually, the considerations are very similar to that discussed in paragraph 62, above and I conclude that the respective marks share a medium level of visual similarity.

72. Aurally, the applicant's mark consists of the three syllables THIRST-EE-JAK. The opponent's mark consists of the three syllables WIN-TER-JAK. They coincide in respect of their final syllable but in all other respects they are different. I conclude that they share a low to medium level of aural similarity.

73. As with THIRSTY JACK, the opponent's mark WINTER JACK also consists of two words that form a unit to convey a message that somebody called Jack has some general characteristics relating to the season of winter. Again, there is some similarity in that both marks refer to an unknown person with the forename Jack, but in other respects they are dissimilar. I conclude that they share low to medium level of conceptual similarity.

Distinctive character of the earlier trade mark

74 *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).”

75. The opponent's JACK DANIEL'S mark consists of the possessive form of a whole name. It is endowed with a reasonable level of inherent distinctive character, being not particularly high or low. Mr Stobbs submitted that this mark has established a significant enhanced distinctive character through the extensive use made of the mark in respect of whiskey and related products. I agree that the evidence discussed earlier clearly shows that the mark has a very strong presence on the UK drinks market. I find that JACK DANIEL'S benefits from a high level of enhanced distinctive character in respect of whiskey and whiskey-based drinks.

76. The opponent's JACK mark consists of a common male forename and consequently is endowed with only a low level of inherent distinctive character. Whilst I have little doubt that it is used in marketing and occasionally on packaging to identify the opponent's JACK DANIEL'S brand of whiskey, I have no evidence before me to illustrate the scale of this use. However, as I have already noted, there is consumer awareness and use of the JACK mark and evidence that the consumer may refer to the mark when ordering a mixed drink e.g. asking for a JACK and COKE. This suggests that use has been such that the consumer has started to refer to the brand as JACK and suggests a degree of enhanced distinctive character. In the absence of further evidence, I conclude that this is relatively modest.

77. In respect of the opponent's GENTLEMAN JACK mark, this has a reasonable level of inherent distinctive character. Again, Mr Stobbs submitted that it has established a significant enhanced distinctive character through use. The level of use in the UK is significantly less than for the opponent's JACK DANIEL'S mark with the retail value being less than 20% of the corresponding values for JACK DANIEL'S in the years 2011 to 2017. However, figures beginning at \$4.76 million and rising to \$10.73 million during that period are still reasonable and show a rising trend. Consequently, I find that this mark also benefits from an enhanced level of distinctive character but to a moderate degree.

78. Finally, in respect of WINTER JACK, it too has a reasonable level of inherent distinctive character. The retail values provided in respect of goods sold under this mark range between \$3.8 million in 2016 and \$2.1 million in 2017. This is very roughly half the level disclosed in respect of GENTLEMAN JACK. Further, there is no

information regarding UK sales before or after these two years. Taking all of this into account, if it benefits from an enhanced level of distinctive character, it is only modestly.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

79. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. It is also necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between marks and must instead rely upon the imperfect picture of them retained in the mind.

80. Firstly, in respect of likelihood of confusion with the opponent's JACK DANIEL'S mark, I have found that:

- the respective goods are either identical or share between a medium and high level of similarity;
- the average consumer is an adult member of the general public who pays a medium level of attention (being neither high nor low) during the purchasing process;
- both marks form a unit with no one word dominating;
- they share a low level of visual and aural similarity and a very low level of conceptual similarity and;

- the opponent's mark is endowed with a reasonable level of inherent distinctive character but that this is enhanced to a high level because of the use made of the mark.

81. In respect of the likelihood of confusion with the opponent's WINTER JACK and GENTLEMAN JACK marks, I have found that:

- the respective goods are either identical or share between a medium and high level of similarity;
- the average consumer is a member of the general public who pays a medium level of attention (being neither high nor low) during the purchasing process;
- the respective marks all form a unit with no one word dominating;
- they share a medium level of visual similarity and a low to medium level of aural and conceptual similarity and;
- the opponent's marks are both endowed with a reasonable level of inherent distinctive character but GENTLEMAN JACK enjoys a moderate level of enhanced distinctive character. In respect of WINTER JACK, it benefits from a modest enhanced level of distinctive character.

82. In respect of the likelihood of confusion with the opponent's JACK mark, I found the same as in the previous paragraph but that the aural similarity was medium, the conceptual similarity was low to medium and that the level of enhanced distinctive character was relatively modest.

83. Mr Stobbs submitted that:

- (a) the opponent's earlier marks constitute a family of marks;
- (b) it is common in the drinks industry for there to be brand extensions of the kind used by the opponent;
- (c) there is a likelihood of indirect confusion.

84. In *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, Mr Iain Purvis Q.C., as the Appointed Person, 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.

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

- (a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).
- (b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub- brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).
- (c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”³. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., 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 to mind another mark. This is mere association not indirect confusion.

85. Mr Stobbs also reminded me of the following comments of the Appointed Person in *Sutaria v. Cheeky Italian Ltd*³⁰:

“16.1. First, a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion. It should be kept in mind that the differences which mean that one mark would not be mistaken for the other might well dispel indirect confusion as well.

16.2. Second, if (as here) the differences between the marks are such that there is no likelihood of direct confusion, one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion. This is what Mr Purvis was pointing out in those paragraphs in *LA Sugar*.

16.3. Third, when making a finding of a likelihood of indirect confusion, in my view it is necessary to be specific as to the mental process involved on the part of the average consumer. Whilst the categories of case where indirect confusion may be found is not closed, Mr Purvis' three categories are distinct, each reflecting a slightly different thought process on the part of the average consumer.”

86. There are two main thrusts to Mr Stobbs' submissions. Firstly, he submitted that the opponent's JACK DANIEL'S brand is highly distinctive and benefits from a significant enhanced level of distinctive character. He drew my attentions to the

³⁰ BL O-219-16 at [16]

American Eagle case³¹ where, at paras 13 and 15, the judge acknowledged the market position of JACK DANIEL'S. He also claimed that it is common in the drinks industry to "play with brands". Mr Stobbs also referred me to the judge's comments at para 69, where it was acknowledged that brands extensions were common in the drinks industry and, at para 71, that it's common to play with brands. Mr Stobbs concluded that a likelihood of confusion was found in a comparable factual situation.

87. In support of his submission that it is common place in the drinks industry to "play with brands", Mr Stobbs pointed me to *Sazerac Brands LLC v Liverpool Gin Distillery Ltd*³² where it was stated:

"I find that it is both common and well-known in the spirits market in the UK and the EU, including their respective bourbon sub-markets, for producers not only to have different expressions of brands (i.e. different age statements or special releases or "single cask" products, and the like) but also to release different products with different names, that may or may not allude directly or indirectly to another brand, which are made in the same distillery, by the same distiller or by a distiller in the same group as (or licensed by) the originating distiller. ..."

88. Whilst I have no direct evidence that it is, indeed, common practice, the finding of the court in that case do not contradict the evidence in the current case and is consistent with the type of use shown to be made by the opponent. The evidence in the current case does show what can be described as a family of marks built around the word JACK and including use in the UK of GENTLEMAN JACK, WINTER JACK and JACK solus.

89. I do not agree with Mr Stobbs' submissions that the word JACK plays an independent distinctive role in the applicant's mark. Rather, I have found that it forms a unit with the word THIRSTY. However, such a finding is not fatal to Mr Stobbs' argument. A mark can still constitute a "natural extension" in the sense referred to in

³¹ *Sazerac Brands LLC et al v. Liverpool Gin Distillery Ltd et al* [2020] EWHC 2424

³² [2020] EWHC 2424, [71]

Cheeky Italian. I take account of the opponent's use of GENTLEMAN JACK and WINTER JACK as sub-brands in its JACK DANIEL'S line up of products. In the context of the comments of Mr Purvis in *L.A. Sugar*, the applicant's mark appears to fall into category (c) of Mr Purvis' scenarios, namely, that the earlier marks comprise a number of elements, and a change of one element appears entirely logical and consistent with a brand extension. Whilst GENTLEMAN JACK and WINTER JACK enjoy less enhanced distinctive character than the opponent's main brand JACK DANIEL'S, the level of sales in the UK and the nature of that use (always linked to the primary mark JACK DANIEL'S) is sufficient to create a situation where the average consumer of the opponent's goods, upon encountering the applicant's mark for [drinks product], will assume that it is another variation of the opponent's "(something) + JACK" marks and identifies another product in the JACK DANIEL'S range of products.

90. Therefore, taking account of the enhanced distinctive character of the opponent's marks, the construction of the applicant's mark that is the same as in the opponent's GENTLEMAN JACK and WINTER JACK marks i.e. a word functioning as an adjective upon the name JACK is likely that it will be perceived by the average consumer as another "JACK" mark from the same stable as GENTLEMAN JACK and WINTER JACK.

91. The opponent also relies upon a "family of marks" argument. In *Il Ponte Finanziaria SpA v OHIM*, Case C-234/06, the Court of Justice of the European Union stated that:

"62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a 'family' or 'series' of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

92. As I commented in para 88, above, I have found that the opponent has a family of marks present on the UK market. The retail values provided in respect of GENTLEMAN JACK are for the period 2011 to 2017. In respect to WINTER JACK, as I noted earlier, the evidence illustrates that it was launched in the UK in 2014 and

figures are provided for the period between 2015 and 2017. There are numerous UK newspaper articles provided³³ dated from around November/December 2014 where the WINTER JACK product is featured. There is no evidence of use of these marks, as at the relevant date, but the evidence does show that in the years running up to the relevant date the opponent used a number different marks. With this in mind, the average consumer is likely to believe that, upon encountering THIRSTY JACK in respect of alcoholic beverages, that it is another of the family of the opponent's JACK marks.

93. Mr Kaniu submitted that if ordering a "JACK", the waiter or bartender will not know what is being requested and that JACK solus does not link to the opponent. I reject this. The evidence illustrates otherwise and I find that significant proportion of the average consumer will indeed make the connection to the whiskey products of the opponent.

94. Mr Kaniu also relied upon the guidance of Arnold J (as he then was) in JURA ORIGIN³⁴ and submitted JACK does not play an independent distinctive role. I have already found that JACK does not play an independent distinctive role in GENTLEMAN JACK or WINTER JACK, but also as I have noted this is not fatal to the opponent's case. For the reasons I have already set out, the fact that JACK does not play an independent role does not overcome my findings that there is a likelihood that the applicant's mark will be perceived as being one of a number of marks of the opponent's family of marks. The "family of marks" issue here was not a factor in the JURA ORIGIN case and as a result it is not on "all fours" with the current case.

95. Further, even absent the "family of marks" argument, there is a likelihood of indirect confusion arising because of the reasons I have set out in paragraph 89, above. Again, this is because this case is not on all fours with JURA ORIGIN where the common element of the respective marks in that case was the word ORIGIN which was found to be understood as meaning that the goods originated from a

³³ At Exhibit JW11

³⁴ *Whyte and Mackay Limited v Origin Wine UK Limited, Dolce Co Invest Inc* [2015] EWHC 1271 (Ch)

producer called JURA. The common element in the current case (JACK) does not contain such a non-distinctive message.

96. Mr Kaniu also relied on a number of other cases where a forename and a full name were being considered. These cases do not assist the applicant because here, my finding of indirect confusion relates, in part, to the opponent's GENTLEMAN JACK, WINTER JACK and my "family of marks" finding by reference to these two marks and also the opponent's JACK mark.

97. Mr Kaniu also submitted that a variation consisting of JACK alone or appearing either with another word before or after the word JACK is "far reaching" and is, in effect, "implying that [the opponent] has exclusive use/claim of any marks that have JACK Variations/Extensions." This approach, whilst understandable, does not take account that I must consider the factual matrix surrounding the use of the opponent's mark to reach a view on whether the applicant's mark is likely to be considered by the average consumer as identifying goods originating from the same or linked undertakings as the goods sold under the opponent's marks. I have found that the factual matrix is such that use of the applicant's mark is likely to result in indirect confusion occurring in the mind of the consumer. It is no more "far reaching" than that and my finding does not extend to use by third parties of other JACK variations or extensions. Each case would be dependent upon its own facts.

98. The applicant also relies upon the ordinary dictionary meanings of the word THIRSTY and the word JACK and makes the submission that the applicant's mark is conceptually different as well as being aurally and visually different to the opponent's marks and concludes that the overall impression created by the respect marks is such as that there is no likelihood of confusion. Again, I dismiss this. I have fully considered the level of similarity between the respective marks from a visual, aural and conceptual perspective and I have factored these findings into the global assessment that I must undertake. In taking all these factors into account, I have found that there is a likelihood of indirect confusion.

99. Finally, Mr Kaniu made submissions based upon the nature of the applicant's planned use of its mark, claiming that the nature of this use would not interfere with

the opponent's market. In *Devinlec Développement Innovation Leclerc SA v OHIM*, Case C-171/06P, the CJEU stated that:

“59. As regards the fact that the particular circumstances in which the goods in question were marketed were not taken into account, the Court of First Instance was fully entitled to hold that, since these may vary in time and depending on the wishes of the proprietors of the opposing marks, it is inappropriate to take those circumstances into account in the prospective analysis of the likelihood of confusion between those marks.”

100. Consequently, I dismiss this defence.

101. In summary, the section 5(2)(b) ground succeeds in its totality.

Section 5(4)(a)

102. Section 5(4)(a) states:

“(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”.

103. At hearing, Mr Stobbs stated that there was “no significant difference” to the opponent's case under section 5(2) and was of the view that the section 5(4)(a) ground is likely to follow the outcome of the section 5(2)(b) ground. I keep in mind that the only sign relied upon by the opponent is JACK solus and that the evidence relating to

this mark is not well marshalled but I accept that it is sufficient to illustrate that the opponent's undoubted extensive goodwill is sometimes identified by this sign. Therefore, I agree with Mr Stobbs. I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires "a substantial number of members of the public are deceived" rather than whether the "average consumer are confused". However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here and I find that members of the public are likely to be misled into purchasing the applicant's goods in the belief that they are the opponent's goods.

Section 5(3)

104. 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".

105. 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".

106. Mr Stobbs pointed to the significant reputation in JACK DANIEL'S, JACK and GENTLEMAN JACK and its position as a market leader for spirits. He expressed the view that the outcome of the section 5(3) ground will follow the section 5(2)(b) ground and only become relevant in circumstances where the section 5(2)(b) ground fails. The

opponent's position is that the requisite link would still be established leading to detriment and unfair advantage and that there is no due cause.

107. At the hearing, at my invitation, the parties indicated that they were content for me to not to consider the ground based on section 5(3) in circumstances where I find success for the opponent under section 5(2)(b). However, I agree with Mr Stobbs and that this ground would follow my findings in respect of section 5(2)(b) even though the opponent has relied upon a lesser number of earlier marks and doesn't rely upon WINTER JACK.

COSTS

108. The opponent has been successful and is entitled to a contribution towards its costs.

109. Mr Kaniu indicated at the hearing that he wished to claim costs despite not returning a completed costs proforma as requested by the Registry. I allowed 7 days for the applicant to do so. He duly provided a completed proforma. However, as the applicant has been unsuccessful, it is not necessary that I refer to this.

110. Mr Stobbs requested costs at the higher end of the scale because of the applicant's late filing of documents. The applicant did make a retrospective extension of time to file its evidence but this was refused at a case management conference (that itself was re-appointed at very short notice because of Mr Kaniu's unavailability) and a request for costs in respect to that was made at the time on behalf of the opponent. That together with the need for the opponent to file a response to the applicant's late filing of its costs claim, are the two elements that I take account of over and above an award of costs based on the usual scale. The opponent also cited the very late skeleton argument and the evidence this contained as a further reason for a higher cost award. This with dealt with at the hearing by Mr Stobbs and did not incur any additional costs for the opponent and I decline to take this into account.

111. In the circumstances, I award the opponent a contribution towards the cost of the proceedings. The sum is calculated as follows:

Official fee	£200
Filing statement and considering other side's counterstatement	£300
Preparing evidence	£700
Preparing for and attending the hearing	£700
Preparing for and attending CMC	£200
Considering and responding to the applicant's late request for costs	£50
TOTAL	£2150

112. I therefore order Evelyn Roberts Limited to pay Jack Daniel's Properties, Inc. the sum of £2150. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 5th day of November 2021

Mark Bryant
For the Registrar