

**O/0145/23**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. UK00003638153  
IN THE NAME OF ANGUS DUNDEE DISTILLERS PLC  
FOR THE TRADE MARK**

**POWDER MONKEY**

**IN CLASS 33**

**AND**

**THE OPPOSITION THERETO UNDER NO. 428659  
BY WILLIAM GRANT & SONS LIMITED**

## Background and pleadings

1. On 07 May 2021, Angus Dundee Distillers Plc (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK.
2. The application was accepted and published in the Trade Marks Journal on 10 September 2021 in respect of *rum* in class 33.
3. On 1 December 2021, William Grant & Sons Limited (“the opponent”) opposed the application under Sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”).
4. Under Sections 5(2)(b) and 5(3), the opponent relies on the four trade marks set out below:<sup>1</sup>

UK00002366898 (“the first earlier mark”)

MONKEY SHOULDER

Filing date: 28 June 2004; Registration date: 10 December 2004

**Class 33:** *Alcoholic beverages.*

UK00904575486 (“the second earlier mark”)

MONKEY SHOULDER

Filing date: 29 July 2005; Registration date: 21 August 2006

**Class 33:** *Alcoholic beverages.*

UK00918248107 (“the third earlier mark”)

SMOKEY MONKEY

Filing date: 03 June 2020; Registration date: 16 September 2020

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<sup>1</sup> The second, third and fourth marks are comparable marks based on pre-existing EUTMs

**Class 33: Alcoholic beverages (except beers).**

UK00918248114 (“the fourth earlier mark”)

GINGER MONKEY

Filing date: 03 June 2020: Registration date: 16 September 2020

**Class 33: Alcoholic beverages (except beers).**

5. By virtue of their earlier filing dates, the above registrations constitute earlier marks within the meaning of Section 6 of the Act. The first and the second earlier mark had completed their registration processes more than five years before the application date of the contested mark and are therefore subject to the proof of use provisions contained in Section 6A of the Act. The third and the fourth earlier mark, however, had been registered for less than five years at the filing date of the application in issue and are therefore not subject to proof of use pursuant to Section 6A of the Act. Consequently, the opponent can rely upon all of the goods it has identified for its third and fourth earlier mark.

6. Under Section 5(2)(b), the opponent claims that there is a likelihood of confusion because the goods are identical, and the contested mark is visually, aurally and conceptually similar to the earlier marks. The opponent also claims that the earlier marks enjoy an extensive reputation throughout the UK and internationally and possess an enhanced level of distinctive character. Finally, the opponent submits that all the marks at issue contain the distinctive and dominant word element ‘MONKEY’ and that it wishes to rely on a family of marks.

7. Under Section 5(3), the opponent states that its ‘MONEKY SHOULDER’ mark has acquired a substantial reputation in the UK and internationally in relation to whisky. The opponent therefore identifies this mark as its primary mark for the purpose of Section 5(3), but it also refers to the existence of a family of marks as one of the factors contributing to the creation of a link. The opponent claims that use of the contested

mark would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier mark.

8. Lastly, under the Section 5(4)(a) ground, the opponent relies on the sign 'MONKEY SHOULDER' and claims to have used it throughout the UK since at least January 2005 for *whisky*. The opponent claims to have accrued goodwill in the sign and claims that its goodwill entitles it to prevent the use of the contested mark under the law of passing off.

9. The applicant filed a counterstatement in which it denies the grounds of opposition and put the opponent to proof of use in relation to the first and the second earlier marks.

10. Only the opponent filed evidence during the evidence rounds. The applicant filed nothing beyond the counterstatement. I shall refer to the evidence to the extent that I consider necessary.

11. The opponent is represented by Taylor Wessing LLP and the applicant by Bailey Walsh & Co LLP. Neither party asked to be heard but the opponent filed submissions in lieu.

## **EU Law**

12. 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 Trade Marks 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.

## **The evidence**

13. The opponent's evidence consists of a witness statement by Lisa Fitzsimons, the associate global brand director for, amongst others, the 'MONKEY SHOULDER' brand

at the opponent's company. Ms Fitzsimons's witness statement is dated 11 July 2022 and is accompanied by 47 exhibits (LF-01 - LF47).

## **DECISION**

### **Proof of use**

14. The proof of use provisions are at Section 6A of the Act, which at the relevant date reads:

“(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)-(5A) [Repealed]

(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.”

15. As the second earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

16. Section 100 of the Act is also relevant and states that:

“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.”

17. 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 Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)*

[EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].



(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

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

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

18. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander Q.C. as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

and further at paragraph 28:

“28. .... I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification. Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

## The evidence of use

19. At the beginning of her witness statement, Ms Fitzsimons sets out the background history of the opponent's company. The opponent is an independent, family-owned Scottish company that was established back in 1886 by William Grant, his wife Elizabeth and their eldest son John Grant. The original business was to sell new malt whiskies as filling to others for blending. In 1892, the opponent purchased a second distillery called Balvenie Distillery, and in 1898 the two distilleries began blending their whiskies creating what Ms Fitzsimons describes as "*the world-famous Grant's Whisky*". By 1914, the opponent had a thriving international business, with more than 60 sales offices supporting export to 30 countries worldwide, and by 1960, it was trading in some 143 countries, and sales worldwide amounted to some 500,000 cases a year. By 1995, following a company restructure, the family business was selling 3.5 million cases a year, and it had reached 170 countries around the world.

20. Ms Fitzsimons says that the opponent has become one of the world's largest and most successful distilleries and producers of whisky. Although whisky is the opponent's primary product, it also enjoys success in the production of other selected spirits. According to Ms Fitzsimons, Monkey Shoulder Scotch whiskies is one of the opponent's flagship products, along with other brands including Glenfiddich, Grant's, The Balvenie, Tullamore D.E.W. Irish whiskey, Hendrick's Gin, Sailor Jerry rum and Drambuie liqueur.

21. Ms Fitzsimons says that in her opinion "*it is really no exaggeration [...] to say that [the opponent] is responsible for some of the most widely known and recognized whiskies ever created*" and that "*this strong heritage is key to how all [the opponent]'s products have maintained and strengthened their attractiveness over the years: purchasers know and trust the [opponent]'s brands, and this sense of familiarity has sustained and bolstered the reputation of each brand as the opponent has diversified, including MONKEY SHOULDER*". In support of these statements, Ms Fitzsimons produces, inter alia, copy of an online article<sup>2</sup> dated 28 September 2016 which lists the opponent as one of the four companies "*behind ¾ of all scotch whisky production*"

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<sup>2</sup> LF-05

and refers to the opponent having 7% of the market share. I reproduce the relevant extract below:

#### **William Grant and Sons**

The only independent, Scottish and family-owned company on this list, William Grant and Sons have been around since 1887. It's the distiller and entrepreneur William Grant who established the world's first distillery dedicated to producing single-malt whisky, [Glenfiddich](#), which is now the best-selling single malt in the world. Beyond Glenfiddich, the company also own a few other Scotch (as well as gin, vodka, and American whiskey) distilleries. These are [Balvenie](#) and the grain distillery [Girvan](#), and the newer distilleries [Kininvie](#) and [Ailsa Bay](#). However, it's also dipped into the blended whisky market, with products such as [Grant's](#), [Monkey Shoulder](#), and others.

*Market Share: 7%*

22. As regards specifically the brand 'MONKEY SHOULDER', Ms Fitzsimons says that it was launched in 2005, as a new blend of whisky designed to be mixed in cocktails and targeting younger audience. She says that since its launch, Monkey Shoulder *"has lived up to this message and filled a gap in the whisky market for an affordable yet premium whisky: cheeky yet approachable and making whisky more fun and playful"* as opposed to the traditional concept of whisky as a *"typically "serious" category of spirits"*. An article titled *"Monkey Shoulder named best-selling Scotch"* from 04 January 2019<sup>3</sup> states that *"According to the 2019 Brands Report, compiled by industry magazine Drinks International, bartenders named Monkey Shoulder the best-selling and trendiest Scotch whisky"*. The article says that Drinks International surveyed 127 high-end bars from 38 countries around the world, with a high number of respondents from the US, England, Australia and Singapore.

23. Global revenue of 'MONKEY SHOULDER' whisky increased from £38million in 2017 to £81million in 2021 (May - YTD) for a total of nearly £300million in the period 2017-2021. 'MONKEY SHOULDER's top three performing EU countries in 2019 were the UK, Germany and France.<sup>4</sup>

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<sup>3</sup> LF-05

<sup>4</sup> Ms Fitzsimons' witness statement paragraphs 28-29

24. The total value of the UK sales for the five-year period 2017-2021 amounts to approximately £83million, with 1.7million bottles sold. Annual figures are as follows:

| <b>Year</b>   | <b>Value (£)</b> | <b>Volume of 9 Litre Cases</b> | <b>Bottles sold across the UK</b> |
|---------------|------------------|--------------------------------|-----------------------------------|
| 2017          | £12,700,000      | 20,386                         | 244,632                           |
| 2018          | £16,700,000      | 23,983                         | 287,796                           |
| 2019          | £20,400,000      | 30,061                         | 360,732                           |
| 2020          | £22,400,000      | 34,095                         | 409,140                           |
| 2021 (to May) | £13,400,000      | 34,330                         | 411,960                           |

25. Ms Fitzsimons explains that of the goods sold, approximately 20% of sales tend to go to licensed premises (i.e. cafés, bars, clubs, pubs and restaurants) and that these establishments typically sell the whisky to consumers in 25ml measures and that each 75cl bottle sold through such channels equates to 30 separate consumer transactions made by reference to the brand. According to Ms Fitzsimons, that means that the 1.7 million bottles sold will have involved approximately 51 million consumer transactions by reference to the brand throughout the UK.

26. The UK market share of 'MONKEY SHOULDER' whisky grew from 3.1% in 2010, to 5% in 2015, to 7.3% in 2020 and is set to reach 11.1% in 2024.<sup>5</sup>

27. Global advertising and promotional spend was approximately £14million in 2018 and £17million in 2019. The global advertising spend in 2020 was lower, due to coronavirus, amounting to £12.5million, but increased again with the reopening of the global economy in 2021 when it reached £23.1million. The figures for advertising and promotion in the UK were almost £1.3million in 2018, £1.5million in 2019, £631,000 in 2020 and £421,000 in 2021.

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<sup>5</sup> Witness statement at paragraph 29 and LF-08

28. There is plenty of evidence of advertising carried out in the UK since 2009 through 'MONKEY SHOULDER' branded events,<sup>6</sup> including mobile sampling, trolley and mixer truck campaigns, retail launches, distilleries tours, whisky tasting, organisation of parties, competitions and other events, attendance at drinks festivals and events and use of brand ambassadors. This evidence clearly shows a significant amount of effort involved in creating and strengthening the brand 'MONKEY SHOULDER' and building the image of a trendy product.

29. Evidence of awards won by 'MONKEY SHOULDER' whisky is also provided, including various quality awards given by international bodies such as the International Wine and Spirit Competition (2014-2016-2018) and the World Whiskies Awards (2017). Further, as I mentioned above, in the 2019 survey from Drinks International, 'MONKEY SHOULDER' was named the world's trendiest Scotch, and in 2018 'MONKEY SHOULDER' was awarded best-selling Scotch for the year among the world's leading high-end bars.<sup>7</sup> Evidence of media coverage include 'MONKEY SHOULDER' being rated by the magazine Forbes as the third best value blended whisky on the market.<sup>8</sup>

### **Conclusions of genuine use**

30. Since the two earlier marks that are subject to proof of use are identical (both in terms of marks and registered goods) and the evidence focuses on use of the mark in the UK, I will only consider the first earlier mark which is a UK mark.

31. The opponent's evidence is very detailed, precise and abundantly supported by exhibits. It clearly shows that although 'MONKEY SHOULDER' whisky is a relatively new product launched in 2005, it is a well-established brand both in the UK and beyond. This is likely to have been assisted by the fact that the opponent had already a very established business in the UK and that the new brand was an expansion of its product range. The evidence shows huge global and UK sales between 2017 and May 2021; these fall within the relevant period for proof of use which is the 5 year-period

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<sup>6</sup> LF11

<sup>7</sup> LF-09 and LF-29

<sup>8</sup> LF-31

ending with the filing date of the contested application, namely 6 May 2016 - 07 May 2021. During the years 2017-2021, the opponent sold a total of 1.7million bottles of whisky and generated a total of £83million turnover in the UK. By 2020, the opponent had also acquired a good chunk of the UK market, holding a market share of 7.3%. In 2019, the brand was named the best-selling and trendiest Scotch whisky among the world's best bars, including in the UK. All of this clearly shows, in my view, that the huge marketing efforts - amounting to nearly £4million - expended by the opponent in the UK in the four years preceding the filing date of the contested application in order to create and maintain the image of the mark, had rapidly paid off.

32. Finally, the issue relating to how the mark has been used appears to be straightforward as there are plenty of examples of use of the mark 'MONKEY SHOULDER' on marketing material and on the website. Use of the mark on bottles is in a different form from that registered, namely with the word 'MONKEY' placed above the word 'SHOULDER':



33. However, I consider that the position of the word 'MONKEY' above the word 'SHOULDER' does not alter the way the mark is understood, because the relevant public will still read it as 'MONKEY SHOULDER'. As the distinctiveness of the mark resides in the combination of the words 'MONKEY SHOULDER' in that order, I consider that use of the mark in the above form does not alter the distinctive character

of the mark in the form in which it is registered and is to be regarded as an acceptable variant for the purpose of establishing genuine use.<sup>9</sup>

34. Having regard to all of the foregoing considerations, I am therefore satisfied that the opponent's first earlier mark has been effectively and sufficiently used, in quantitative and geographic terms, and that the proof of genuine use has been made out.

35. The final issue to be determined is whether the use shown establishes a specification that is as broad as the registered one, i.e. *Alcoholic beverages* generally, or whether it would be more appropriate to frame a fair specification that is narrower than the actual registration.<sup>10</sup> The evidence establishes that the mark 'MONKEY SHOULDER' has only ever been used in relation to whisky. Whisky is a specific category of alcoholic beverages. Although as a sub-category whisky is within the broad category of *Alcoholic beverages*, it cannot realistically be taken to exemplify the broad category.<sup>11</sup> Having regard to this, I conclude that a fair specification to reflect the use established is "whisky".

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

36. Section 5(2)(b) of the Act is as follows:

"A trade mark shall not be registered if because-

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark".

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<sup>9</sup> *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22

<sup>10</sup> *Property Renaissance (t/a Titanic Spa) v Stanley Dock Hotel (t/a Titanic Hotel Liverpool)* [2017] RPC 12 at [47].

<sup>11</sup> *STICHTING BDO (and others) v BDO UNIBANK, INC. (and others)* [2013] EWHC 418 (Ch)



37. Section 5A of the Act is as follows:

“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.”

38. The following principles are gleaned 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**

39. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In *Canon Kabushiki Kaisha*, the Court of Justice of the European Union (CJEU) stated that:

“23. 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 complementary.”

40. Guidance on this issue was also given by Jacob J (as he then was) in *British Sugar Plc v James Robertson & Sons Limited (“Treat”)* [1996] RPC 281. At [296], he identified the following relevant factors:

- (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.

41. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU held that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods or services. The GC clarified the meaning of “complementary” goods or services in *Boston Scientific Ltd v OHIM*, Case T-325/06, at paragraph 82:

“[...] there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers

may think that the responsibility for those goods lies with the same undertaking.”

42. The General Court (GC) confirmed in *Gérard Meric v OHIM*, Case T-133/05, paragraph 29, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another, or vice versa:

“In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut für Lernsysteme v OHIM- Educational Services (ELS)* [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

43. The goods to be compared are as follows:

| The applicant’s goods       | The opponent’s goods  |
|-----------------------------|---|
| <p><b>Class 33: rum</b></p> | <p><b>Class 33: Whisky</b><br/>(The first earlier mark)</p> <p><b>Class 33: Alcoholic beverages (except beers).</b><br/>(The third and the fourth earlier mark)</p> |

44. The applicant’s *rum* falls within the opponent’s *Alcoholic beverages (except beers)*. These goods are identical on the principle outlined in *Meric*.

45. Comparing the applicant’s *rum* with the opponent’s *whisky*, the respective goods are both distilled alcoholic spirits. Although the goods may appeal to different tastes, they have a similar nature, purpose and methods of use as they are both strong alcoholic drinks. While it might be true that scotch whisky and rum are not usually produced by the same manufacturers of alcoholic beverages or would not normally emanate from the same geographic areas, they would be handled by the same

distributors and would be sold through the identical retail outlets to the same class of ultimate users. In my view the goods are similar to a low to medium degree.

### **Average consumer**

46. 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. 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. (as he then was) 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.”

47. The average consumer of the goods at issue is the adult general public. The goods may be bought in supermarkets, off-licences and their online equivalents. This all suggests a more visual selection process. The goods are also sold in restaurants, bars and public houses, where they may be requested orally, although this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount aural considerations.

48. The goods are not everyday beverage products but are likely to be purchased on a semi-regular basis. The goods are not inexpensive and when selecting them the average consumer is likely to consider factors such as flavour and alcoholic content.

The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the goods.

### **Comparison of marks**

49. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

| <b>The applicant's mark</b> | <b>The opponent's marks</b>                               |
|-----------------------------|---|
| POWDER MONKEY               | MONKEY SHOULDER<br><br>GINGER MONKEY<br><br>SMOKEY MONKEY |

## **Overall impression**

51. The applicant's mark consists of the two words 'POWDER' and 'MONKEY' presented in capital letters, neither of which is clearly more dominant than the other. The overall impression of the mark resides in its entirety.

52. The opponent's earlier marks are as follows: the first mark consists of the words 'MONKEY' and 'SHOULDER', the third earlier mark consists of the words 'GINGER' and 'MONKEY' and the fourth earlier mark consists of the words 'SMOKEY' and 'MONKEY'. The marks are all presented in capital letters. Each mark has two identifiable word elements neither of which is visually outstanding. Since no element is more dominant than the other, both words play equal roles in the overall impression of each mark.

53. In its submissions in lieu the opponent made a number of comments about the distinctiveness of the word 'MONKEY' within the marks 'MONKEY SHOULDER' and 'POWDER MONKEY' by referring to the meaning of the marks as wholes. I will address these comments when I come to deal with the conceptual aspect of the marks.

## **Visual and aural similarity**

54. The only comment the applicant made as regards the similarity between the marks is that the marks are visually, aurally and conceptually different *"not least because of the presence of the different first word POWDER which is distinctive over [the] earlier marks which all contain a different first word"*.

55. The opponent submits that the marks are similar to a high degree, because they coincide in the distinctive element 'MONKEY', although this is positioned in a different order in the first earlier mark. Further, the opponent submits that there are additional similarities between the marks namely (a) that the word 'SHOULDER' and the word 'POWDER' coincide in the last three letters 'D', 'E', 'R' and (b) that the words 'POWDER', 'SMOKEY' and 'GINGER' are all made up of six letters.

56. Comparing the applicant's 'POWDER MONKEY' mark and the earlier 'MONKEY SHOULDER' mark, they coincide in the fact that both marks are word marks made up of two words, one of which is identical and plays an independent role, i.e. the word 'MONKEY'. However, they differ in that the identical element appears in the first position in the applicant's mark and in the second position in the earlier mark, as well as in the other verbal elements of the marks, namely the words 'POWDER' and 'SHOULDER'. I bear in mind that although the marks begin with different words and consumers normally pay more attention to the beginnings of marks, this rule does not apply in all cases and has to be balanced with the general principle, according to which the overall impression caused by the marks has to be taken into account when examining their similarities. Consequently, it is the overall impression produced by the marks that should be taken into consideration and not any individual parts in isolation. In the present case, both signs have a similar structure as they consist of two separate words where the common element 'MONKEY' is inherently distinctive, and it plays an independent distinctive role in both marks. Taking the above into account, I consider the marks to be visually and aurally similar to a medium degree.

57. Comparing the applicant's 'POWDER MONKEY' mark and the earlier "SMOKEY MONEKY" and 'GINGER MONKEY' marks, there are some additional similarities in that the coinciding distinctive term 'MONKEY' is located in the same position in all marks and is preceded by a six-letter word, although made up of different letters. I consider the marks to be visually and aurally similar to a medium to high degree.

### **Conceptual similarity**

58. In its submissions in lieu the opponent stated:

"The expression 'MONKEY SHOULDER' may be known to some of the English-speaking consumers as an unconventional name for an ailment of malt men, whereby shovelling tons of barley for hours would usually result in hanging down of the arm, which resembled a chimpanzee's arm. However, the average consumer will be unaware of that somewhat obscure derivation. Therefore, the Opponent respectfully submits that the Earlier Mark will strike the average



consumer as an unusual combination of two nouns. Whilst it implies a connection with a part of a monkey's anatomy, the fact that the word MONKEY is not in the possessive (ending 'S) means the combination is syntactically nonsensical. Each word is distinctive of the relevant goods and the combination even more so. However, the word MONKEY is the most distinctive element since it has even less connection with the goods than SHOULDER. Conceivably one might associate SHOULDER in the context of a beverage with the shoulder of a bottle.

The expression 'POWDER MONKEY' has an equally obscure historic meaning, referring to the member of a warship's crew whose chief role was to ferry gunpowder from the powder magazine in the ship's hold to the artillery pieces, either in bulk or as cartridges, to minimize the risk of fires and explosions. This will also not be appreciated by an average consumer and the two nouns have no relevance to the goods in question. The word combination 'POWDER MONKEY' literally means a monkey made of powder but as there is no such thing (at least in nature), this word combination carries no meaning. Therefore, the vast majority of the relevant public is likely to perceive the Contested Mark as a purely fanciful term referring to a type of monkey, namely one made of powder. Taking into account that the word combination refers to a type or kind of monkey, albeit of a purely fanciful nature, the relevant public will easily remember the concept of a monkey within the Contested Mark. Again, the word MONKEY is the most distinctive element since it has even less connection with the goods than POWDER. Conceivably one might associate POWDER in the context of a beverage with a residue at the bottom of a consumed bottle. So, it is submitted that, for all the marks, the most distinctive element is the word 'MONKEY', with the additional words 'SHOULDER' and 'POWDER' being nouns that qualify the particular concept that is being connected with a monkey. As such, the marks coincide in their key distinctive element.

[...]

Further, the expression 'SMOKEY MONKEY' consists of the adjective 'SMOKEY' and the noun 'MONKEY'. In this context the term 'SMOKEY' refers to the 'MONKEY' itself thus rendering the word MONKEY the distinctive element of the Opponent's mark. In addition, the adjective 'SMOKEY' might be

considered as referring to 'MONKEY' which has been exposed to burning materials and has been left smelling of smoke. For completeness, the same considerations apply to the Opponent's GINGER MONKEY as it is merely an adjective referring to the concept of a monkey”.

59. The opponent also referred to a decision of the EUIPO in a parallel dispute between the parties in relation to marks that are identical to the ones at issue in these proceedings.<sup>12</sup> The relevant parts of the decision reads:

"Although not grammatically correct English, the vast majority of the relevant public is likely to perceive the earlier mark as referring to the concept of the shoulder of a monkey.”

[...]

"Nevertheless, the vast majority of the relevant public is likely to perceive the contested sign as a purely fanciful term referring to a type of monkey, namely one made of powder. Taking into account that the word combination refers to a type or kind of monkey, albeit of a purely fanciful nature, the relevant public will easily remember the concept of a monkey within the contested sign. As neither of the words comprising the contested sign nor the word combination bears a direct reference to the relevant goods, they are distinctive.”

60. The opponent stated that the same logic applies in the present case – consumers will remember the concept of a monkey present in both marks.

61. I agree with the opponent that the relevant public is unlikely to be aware of the expressions “monkey shoulder” and “powder monkey” and their meanings. I also agree with the opponent that all marks will be associated with the same meaning in relation to the component ‘MONKEY’ whilst the additional words ‘POWDER’, ‘SHOULDER’, ‘SMOKEY’ and ‘GINGER’ will all be perceived as denoting something which refers to the word ‘MONKEY’, namely, a monkey made of powder, the shoulder of a monkey, a monkey that smells of smoke and a monkey that is of ginger colour.

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<sup>12</sup> EUIPO decision no. B 3 089 676 dated 17 November 2020, *POWDER MONKEY v MONKEY SHOULDER*

62. Given that the concept in which the marks coincide is more distinctive than the concepts in which the marks differ, and that all the marks create odd combinations revolved around the concept of a monkey, rather than meaningful units, I consider the marks to be similar to a medium to high degree.

### **Distinctive character of earlier mark**

63. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

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

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

64. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as

invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use made of it.

65. Inherently, the opponent's earlier marks 'MONKEY SHOULDER', 'GINGER MONKEY' and 'SMOKEY MONKEY' are word marks made up of two dictionary words, that have no descriptive or allusive qualities to the goods in question. In my view these marks are inherently distinctive to a medium degree.

66. As I have mentioned above, the opponent has filed evidence of use, which I have already, in part, assessed. Given my previous observations in relation to the earlier mark 'MONKEY SHOULDER', and taking into account the length of use (since 2005), the huge turnover and marketing figures (£83million and £5million in the 5 years preceding the relevant date, respectively), the evidence of promotional activities and the 7.3% market share held by the mark, I am satisfied that, by the relevant date, the distinctive character of the mark had been enhanced through use to high.

67. As regards the other marks, Ms Fitzsimons simply says that they have already used different variants of the name 'MONKEY SHOULDER', including 'SPICE MONKEY' and 'GINGER MONKEY' and that she *"tried not to put in too much evidence"* in her witness statement, whilst reserving the right to provide more to prove this point depending on the applicant's comments on the evidence. Whilst there is some evidence of use of the marks 'GINGER MONKEY' and 'SMOKEY MONKEY', as the names of two signature serves of 'MONKEY SHOULDER', there are no detailed turnover or marketing figures or any indication of market share held by the opponent under these marks. Consequently, whilst the evidence establishes that these marks have been used, it is not sufficient to establish that their distinctiveness has been enhanced through use.

### **Likelihood of confusion**

68. 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 marks may be offset by a greater degree of similarity

between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for goods and services 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 that they have retained in their mind.

69. Confusion can be direct or indirect. The difference between these two types of confusion was explained in *L.A. Sugar Trade Mark*, BL O/375/10, where 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).”

70. Earlier in this decision I found that:

- the contested goods are identical to the goods covered by the earlier ‘GINGER MONKEY’ and ‘SMOKEY MONKEY’ marks;
- the contested goods are similar to a low to medium degree to the goods covered by the earlier ‘MONKEY SHOULDER’ mark;
- The average consumer of the goods at issue will be a member of the general public over the age of 18;
- the purchasing process will be predominantly visual although I do not discount aural considerations and the goods will be purchased with a medium degree of attention;
- the earlier ‘MONKEY SHOULDER’ mark and the contested mark are visually and aurally similar to a medium degree and conceptually similar to a high degree;
- the earlier ‘GINGER MONKEY’ and ‘SMOKEY MONKEY’ marks and the contested mark are visually and aurally similar to a medium to high degree and conceptually similar to a high degree;
- the earlier marks are inherently distinctive to a medium degree and the distinctiveness of the mark ‘MONKEY SHOULDER’ has been enhanced to a high degree through use.

71. In support of the family of marks argument, the opponent relies on the following evidence:

- (a) the mark 'MONKEY SHOULDER' is used as a name of a blended malt whisky, as outlined in paragraph 20 of Ms Fitzsimons's witness statement and shown in the exhibits to that statement;
- (b) the mark 'GINGER MONKEY' is used as a name of one of the Monkey Shoulder 'signature serves', as explained in paragraph 36 and elaborated further on at paragraph 75 of Ms Fitzsimons's witness statement and shown in Exhibit LF-33; and
- (c) the mark 'SMOKEY MONKEY' is a twist on the original Monkey Shoulder Blend that provides a smokier, sweeter taste, as explained in paragraph 44 of Ms Fitzsimons's witness statement and shown in Exhibit LF-18 and 19.

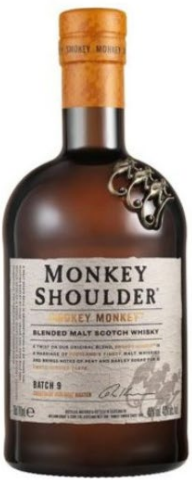
72. In the evidence referred to at point (b) Ms Fitzsimons states:

"The company has distilled the Monkey Shoulder message into three 'signature serves' – the Ginger Monkey, the Lazy Old Fashioned and the Monkey Splash. These are used at numerous events to promote and showcase Monkey Shoulder's use as a whisky made for mixing. These signature serves have been key in fostering the brand's growth throughout the UK, particularly reaching out to its expanding, younger consumer audience who enjoys the brand's playful, 'young at heart' attitude. These innovative steps, showcased throughout the UK, have played a key role in its impressive and growing market share".

73. She also produces copy of an online article dated November 2019 which states that the London agency Space had developed a new Monkey Shoulder advertising and communications campaign and that the campaign highlights the iconic Monkey Shoulder bottle and the whisky's signature cocktails **Ginger Monkey**, Lazy Old Fashioned and Monkey Splash, and features the headline "Shake Your Monkey Shoulder".

74. The evidence referred to at point (c) includes the image of 'SMOKEY MONKEY' bottle of whisky from a third-party website (as shown below) with a price in sterling and an online article dated August 2017 from [www.scotchwhisky.com](http://www.scotchwhisky.com) saying that "*Monkey Shoulder has released a new peated variant – Smokey Monkey – after repeated calls from bartenders for a smoky, mixable blended malt*".

Home > Scotch Whisky > Blended Whisky > Smokey Monkey Peated Monkey Shoulder Blended Malt Scotch Whisky



## Smokey Monkey

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75. 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'."

76. Based on the above evidence (which is unchallenged) I am satisfied that the opponent has demonstrated that the marks 'MONKEY SHOULDER', 'GINGER MONKEY' and 'SMOKEY MONKEY' were present on the market prior to the relevant date. Further, given the structural and semantic similarities between the marks, all of which consists of the word 'MONKEY' combined with another word, I am satisfied that they will be viewed as belonging to a family of marks.

77. For the sake of completeness (and in case I am wrong about the family of marks argument), I will first consider the likelihood of confusion based on the earlier marks taken in isolation.

78. I shall start with the earlier 'GINGER MONKEY' and 'SMOKEY MONKEY' marks. In relation to those marks, I found that the goods are identical, a factor which weighs in favour of the opponent in the assessment of the likelihood of confusion. The contested 'POWDER MONKEY' mark presents the same structure as that of the earlier marks, consisting of a six-letter word element followed by the distinctive word 'MONKEY'. The marks are visually and aurally similar to a medium to high degree and conceptually similar to a high degree. Admittedly, there is not enough evidence to conclude that the inherent distinctiveness of the marks 'GINGER MONKEY' and 'SMOKEY MONKEY' has been enhanced through use. Nevertheless, the marks are inherently distinctive to a good degree (i.e. medium). I accept that the beginnings of the marks are different and that beginnings of marks are, generally, more focused upon, however, a number of cases have stressed that this is not always the case, and this must, therefore, be only a rule of thumb.<sup>13</sup>

79. Overall, taking into account the following: (i) the fact that the goods covered by the marks are identical, (ii) the degree of similarity between the marks, (iii) the fact that the marks share a substantial structural similarity which creates a similar overall impression; (iv) the fact that the identical distinctive element 'MONKEY' has the strongest conceptual impact on the average consumer's perception and recollection of the marks and is the element that will leave the strongest impression, and (iv) the principle of imperfect recollection, my conclusion is that use of the contested mark on identical goods will give rise to a likelihood of direct confusion. Consumers only rarely have a chance to compare the marks directly, so they must rely on their imperfect recollection of them, and, in this case, the average consumer's level of attention is only medium. But even if the average consumer were to notice and recollect the differences between the marks, their overall impression is sufficiently similar to give rise to a likelihood of indirect confusion, i.e. the average consumer would assume that the contested mark is another brand of the owner of the earlier mark.

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<sup>13</sup> BL-O/167/11- SWEETELA

80. Turning to the 'MONKEY SHOULDER' mark, the goods are similar only to a low to medium degree and the marks are visually and aurally similar to a medium degree, whilst conceptually similar to a high degree. However, the lesser similarity of the goods and the slightly lesser similarity of the marks, is in my view offset by the greater distinctiveness of the earlier mark which has become distinctive to a high degree as a result of the use made. Although there are additional points of difference between this earlier mark and the contested mark, the earlier mark has become strikingly distinctive, and the marks share the common word 'MONKEY' which is conceptually the most distinctive element of the marks. Consequently, I find that the marks are still sufficiently similar from a conceptual point of view to give rise to the existence of a likelihood of indirect confusion. I consider that there is a likelihood of a significant proportion of the average consumers assuming that the marks are connected brands.

81. Lastly, as the opponent's case has succeeded based on the earlier marks considered individually, the only additional comment I should make is that if I am right that the opponent has demonstrated the existence of a family of marks, the similar structure of the contested mark and the presence in the contested mark of the word 'MONKEY' are elements that will enable the contested mark to be associated with the opponent's family of marks and to perceive it as a new member of the opponent's family of marks.

82. I should also make a final remark. The evidence indicates that the opponent produces whisky and other spirits under different brands. Although there is no evidence on the patterns of brands used in the whisky and spirits market in the UK, the opponent's evidence accords with the evidence given in other proceedings where the UK courts<sup>14</sup> found that that brands in the whisky market have different expressions and connected products, and that distillers can make more than one brand, which fortifies my conclusions about the likelihood of indirect confusion.

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

83. Section 5(3) states:

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<sup>14</sup> *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207 (05 August 2021)

“(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 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”.

84. 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”.

85. 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* and Case C-323/09, *Marks and Spencer v Interflora* and Case C383/12P, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows.

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant

consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77* 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 proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases

where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

86. The relevant date for the assessment under Section 5(3) is the filing date of the application at issue, being 07 May 2021.

## **Reputation**

87. 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.”

88. Under its Section 5(3) ground, the opponent relies on the mark ‘MONKEY SHOULDER’. For the same reasons which I have discussed above in relation to the

distinctiveness of the 'MONKEY SHOULDER' mark, I am satisfied that the mark had a strong reputation for whisky at the relevant date.

## Link

89. As noted above, my assessment of whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

*The degree of similarity between the conflicting marks.* The earlier 'MONKEY SHOULDER' mark and the contested mark are visually and aurally similar to a medium degree and conceptually similar to a high degree;

*The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public.* The competing goods, namely rum and whisky, are similar to a low to medium degree.

*The strength of the earlier mark's reputation.* The earlier mark has a strong reputation for whisky.

*The degree of the earlier mark's distinctive character, whether inherent or acquired through use.* The earlier mark is distinctive to a high degree as a result of the use made of it.

*Whether there is a likelihood of confusion.* I found that there is a likelihood of confusion.

90. I am now required to determine whether, in this particular case, the relevant public would bring the opponent's registration to mind when confronted with the applicant's mark, thereby creating the necessary link.

91. Taking all of the above into account, I am of the view that the relevant public will make a link between the parties' marks. I am also of the view that the link made will result in the contested mark taking unfair advantage of the earlier mark. This is because, given my finding that there is a likelihood of confusion, the consumers' reliance on the reputation of the earlier mark will result in increased sales for the applicant who will benefit from the opponent's marketing efforts. This is unfair advantage. As the opposition has been successful under this ahead of damage, I do not need to consider the other claims.

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

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

(aa) [...]

(b) [...]

(c) [...]

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.”

93. 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.”



94. 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).”

95. I can deal with this ground very briefly. Under this ground the opponent relies on use of the sign ‘MONKEY SHOULDER’ in relation to whisky. My findings about reputation also apply to goodwill, and the case-law suggests that the outcome under Section 5(2)(b) is likely to also apply to a claim under Section 5(4)(a). Hence, for similar reasons to those which I set out above, the opposition also succeeds under this ground.

## **OUTCOME**

96. The opposition has been successful. The application will be refused.

## **COSTS**

97. As the opponent has been successful, it is entitled to a contribution towards its costs. Based upon the scale in Tribunal Practice Notice 2/2016, I award the opponent the sum of £1,300 as a contribution towards the cost of the proceedings. This sum is calculated as follows:

|  |        |
|--|--------|
| Preparing the notice of opposition               |        |
| And considering the applicant's counterstatement | £300   |
| Preparing evidence:                              | £1,200 |
| Submission in lieu:                              | £300   |
| Official fees:                                   | £200   |
| Total  | £2000  |

98. I therefore order Angus Dundee Distillers Plc to pay William Grant & Sons Limited the sum of £2,000. This 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 (subject to any order made by the appellate tribunal)

**Dated this 9<sup>th</sup> day of February 2023**

**Teresa Perks**  
**For the Registrar**