

BL O/0239/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003649151

BY CORRY DISTILLERY LIMITED

TO REGISTER THE TRADE MARK:

Irishman's Point Whisky

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 427933

BY WW EQUITY HOUSE TRADING LIMITED

BACKGROUND AND PLEADINGS

1. On 31 May 2021, Corry Distillery Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 6 August 2021. The applicant seeks registration for the following goods:

Class 33 Scotch Whisky.

2. The application was opposed by WW Equity House Trading Limited (“the opponent”) on the 4 November 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade mark:

The Irishman Superior Irish Whiskey

UK registration no. UK00905619168

Filing date 17 January 2007; Registration date 28 April 2008.

Relying upon all of the goods for which the mark is registered, namely:

Class 33 Irish Whiskey.

3. On 1 January 2021, the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable UK trade marks for all right holders with an existing EUTM. As a result, the opponent’s earlier mark was automatically converted into a comparable UK trade mark. Comparable UK marks are now recorded on the UK trade mark register, have the same legal status as if they had been applied for and registered under UK law, and the original filing dates remain the same.

4. The opponent claims that there is a likelihood of confusion because the marks are visually, phonetically and conceptually similar and the goods are similar if not identical.

5. The applicant filed a counterstatement denying the similarity of the marks, but admits that the parties’ goods are similar.

6. The opponent is represented by Addleshaw Goddard LLP and the applicant is represented by Keltie LLP. A hearing was neither requested nor considered necessary, however, the opponent filed evidence in chief and submissions. The applicant filed evidence in chief and the opponent filed evidence in reply. Both parties also filed written submissions in lieu of a hearing. I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

7. 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 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.

EVIDENCE

8. The opponent's evidence consists of the witness statement of Bernard Walsh dated 14 April 2022. Mr Walsh is the Managing Director of the opponent, a position which they have held since 2018. Mr Walsh's witness statement was accompanied by 2 exhibits (BW1-BW2).

9. The applicant's evidence consists of the first witness statement of Benjamin Britter dated 5 July 2022. Mr Britter is a Chartered Trade Mark Attorney and Partner at Keltie LLP, who are the applicant's representatives in this matter. Mr Britter's statement was accompanied by 4 exhibits (Annex 1-4).

10. The applicant's evidence also consists of the second witness statement of Benjamin Britter dated 26 July 2022. Mr Britter's statement was accompanied by 2 exhibits (Annex 1-2).

11. On 24 October 2022, the opponent filed evidence in reply to Mr Britter's witness statements. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to it where necessary below.

The opponent's evidence

12. The opponent company was incorporated on 16 August 2018. In 2019, the registered trade marks which were used by a company called Walsh Whiskey Distillery Ltd, which was created in 2012, and owned THE IRISHMAN brand, were transferred to the opponent, along with the ownership of the company.

13. Mr Walsh has provided the following approximate annual turnover figures for Irish Whiskey sold in the UK under the opponent's mark:

Year	Turnover
2017	€238,417 (£199,070)
2018	€100,381 (£83,582)
2019	€168,547 (£140,340)
2020	€142,053 (£118,280)
2021	€375,607 (£312,750)
Total	€1,263,422 (£854,022)

14. **Exhibit BW1** consists of a selection of webpages from online retailers that show use of the opponents mark in relation to the sale of Irish whiskey products. I note the following from this exhibit:

- 3 printouts from www.houseofmalt.co.uk listing “The Irishman Founders Reserve Irish Whiskey” (70cl bottle) which appears to be priced at £33.99, however, the price is cut off. It has one 5 star customer review. I also note that “The Irishman 12 Year Old” Irish whisky is being sold for £63.45 and “The Irishman 17 Year Old 2004” Irish whisky being sold for £229.95.
- 6 printouts from HARD TO FIND WHISKY (www.htfw.com). “The Irishman – Founders Reserve Irish Whiskey” 70cl bottle is being sold, and is in stock, for

£35.95. Another 5 “The Irishman” Irish whiskeys are also being sold, priced between £34.95 to £249.95.

- 7 printouts from www.masterofmalt.com listing 21 “The Irishman” Irish whiskeys. I note that 11 of these are “sold out” and 4 are “discontinued”. They again range in price from £28.50 to £225.
- 1 printout from www.oldandrarewhisky.co.uk listing “The Irishman Founder’s Reserve Small Batch Irish Whiskey 70cl, 40% ABV” which is priced at £34.99. I note that there are only “5 left in stock”.
- 3 printouts from www.thebottleclub.com listing “WALSH’S DISTILLERY THE IRISHMAN FOUNDER’S RESERVE BLENDED WHISKEY, 70CL” priced at £37.99.
- 4 printouts from www.thewhiskyexchange.com listing “The Irishman Cask Strength Bot.2021 Blended Irish Whiskey” for £97.95, “The Irishman 12 Year Old Single Malt” for £63.45, “The Irishman Single Malt” for £42.25 and “The Irishman The Harvest” for £35.25.
- 2 printouts from www.winebuyers.com listing “The Irishman Founder, S Reserve Small Batch Irish Whiskey 40% 0,70 Liter” priced at £41.44 and “The Irishman SINGLE MALT Small Batch Irish Whiskey 40,00 % 0,70 Liter” for £41.19.
- 3 printouts from prestige.com listing “The Irishman Cask Strength Irish Whiskey 70cl” for £93.99.

15. All of the above have print out dates of 11 April 2022. I also note that the above print outs shows bottles of the opponent goods, including the following:



16. Lastly, **exhibit BW2** consists of selection of invoices showing sales of products sold under the opponent's mark from 2019 to 2021. I note the following:

Date	Client and Location	Goods and quantity	Total
07/03/2019	Drinksology, Belfast	5 cases of Irishman founders RSV 50 cases of Irishman 6x700ml 20 cases of Irishman cask strength 5 cases of Irishman 17YO malt	€6,860.00
26/03/2019	Marks&Spencer Bradford, UK	240 cases of Irishman 6x700ml	€13,003.20
17/05/2019	Drinksology, Belfast	10 cases of Irishman cask strength 40 cases of Irishman 6x700ml 3 cases of Irishman single malt	€3,982.00
23/05/2019	Law Distribution St Helens, UK	30 cases of Irishman cask strength 15 cases of Irishman founders RSV 50 cases of Irishman single malt 20 cases of Irishman double oak 40 cases of Irishman marsala 20 cases of Irishman copper pot 5 cases of Irishman cask strength	€17,450.00
26/06/2019	Marks&Spencer Bradford, UK	480 cases of Irishman 6x700ml	€26,006.40
18/07/2019	Drinksology, Belfast	12 cases of Irishman single malt cognac 20 cases of Irishman double oak 20 cases of Irishman 6x700ml 40 cases of Irishman 6x700ml	€9,320.00
06/09/2019	Law Distribution St Helens, UK	5 cases of Irishman founders RSV 20 cases of Irishman single malt 55 cases of Irishman copper pot 9 cases of Irishman cask strength	€7,640.00
18/09/2019	Drinksology, Belfast	5 cases of Irishman 12YO malt 10 cases of Irishman single malt 5 cases of Irishman cask strength	€2,590.00
19/11/2019	Marks&Spencer Bradford, UK	480 cases of Irishman copper pot	€26,006.40
02/12/2019	Drinksology, Belfast	5 cases of Irishman 17YO malt 20 cases Irishman 20YO malt 10 Irishman cask strength	€5,000.00
05/12/2019	Law Distribution St Helens, UK	5 cases of Irishman cask strength 30 Irishman single malt 70 cases of Irishman copper pot	€7,470.00
11/03/2020	Law Distribution St Helens, UK	15 cases of Irishman founders RSV 5 cases of Irishman single malt 80 cases of Irishman copper pot	€6,590.00
19/04/2020	Law Distribution St Helens, UK	25 cases of Irishman single malt 5 cases of Irishman double oak	€8,185.00

		90 cases of Irishman copper pot	
29/06/2020	Law Distribution St Helens, UK	15 cases of Irishman founders RSV 40 cases of Irishman single malt 8 cases of Irishman double oak 60 cases of Irishman copper pot	€8,545.00
05/08/2020	Drinksology, Belfast	10 cases of Irishman 6x700ml 26 cases of Irishman 6x700ml 5 cases of Irishman cask strength	€3,580.00
06/08/2020	Law Distribution St Helens, UK	24 cases of Irishman founders RSV 35 cases of Irishman single malt 5 cases of Irishman double oak 55 cases of Irishman copper pot	€8,173.00
22/09/2020	Marks&Spencer Bradford, UK	480 cases of Irishman copper pot	€26,006.40
05/11/2020	Marks&Spencer Bradford, UK	245 cases of Irishman copper pot	€13,274.10
19/11/2020	Marks&Spencer Bradford, UK	480 cases of Irishman copper pot	€27,072.00
10/12/2020	Law Distribution St Helens, UK	25 cases of Irishman founders RSV 5 cases of Irishman double oak 90 cases of Irishman 6x700ml	€8,170.00
25/03/2021	BB&R Hampshire, UK	480 cases of Irishman 6x700ml 20 cases of Irishman 6x700ml 120 cases of Irishman 6x700ml 32 cases of Irishman 6x700ml 10 cases of Irishman cask strength 288 cases of Irishman founders RSV 192 Irishman single malt 15 cases of Irishman 12YO malt 2 cases of Irishman founders RSV 2 cases of Irishman 120x50ml 2 cases of Irishman single malt 2 cases of Irishman double oak	€88,909.00

Proof of use

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

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

(a) a registered trade mark ... or international trade mark (UK) ... which has a date of application for registration earlier than that of the trade

mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

18. Section 6A of the Act states:

“(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),
(aa) 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.”

19. As the 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”.

20. The opponent’s mark qualifies as an earlier mark in accordance with section 6(1)(a) and 6(1)(ab) as its filing date is earlier than the filing date of the applicant’s mark. The opponent’s mark completed its registration process more than five years before the relevant date (the filing date of the mark in issue); therefore it is subject to proof of use pursuant to section 6A of the Act.

21. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its mark in relation to the class 33 goods it relies upon/for which it is registered. The relevant period for this purpose is the five years ending on the filing date of the applicant’s mark, i.e. 1 June 2016 to 31 May 2021.

22. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have highlighted above. Section 100 of the Act is also relevant, which reads:

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

23. 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 I9223, 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].”

Form of the mark/how the marks are used

24. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in Nestle, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term ‘genuine use’ within the meaning of Article 15(1)”. (emphasis added)

25. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the

mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA

were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

26. As established by the evidence above, the opponent’s goods have been sold under the marks “The Irishman” or “Irishman”. The mark has also been used on the opponent’s bottles and its packaging in the following way:



27. The mark upon which the opponent is relying is the mark “The Irishman Superior Irish Whiskey”. I consider that the word “Superior” is a descriptive indicator of the quality of the opponent’s goods, and the words “Irish Whiskey” are descriptive of its goods. Therefore, the distinctive character of the opponent’s mark lies in the word IRISHMAN. I note that this word is present in the above variants. I also note that the typeface used on the bottle’s labels and boxes are slightly stylised, however, this does not alter the distinctive character of the mark. Consequently, I consider that the above variants are acceptable use of the opponent’s mark.

Conclusions from the evidence on genuine use

28. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.¹

¹ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

29. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

30. As the opponent’s mark is a comparable mark, and the relevant period in which to prove use ended on 31 May 2021 i.e. before the IP Completion Day (31 December 2022), the relevant territory to assess use is the EU, which included the UK at that time.

31. Clearly, there are some issues with the opponent’s evidence. For example, no evidence of advertising, nor advertising figures, have been provided. Furthermore, all of the website print out evidence in **BW1** is dated 11 April 2022 and therefore falls after the relevant period. However, the total revenue made by the opponent from 2017 to 2021 in the UK amounts to €1,263,422. This is supported by example invoices which shows that Irish Whiskey goods were all sold under the IRISHMAN sign to St Helens, Bradford, Hampshire and Belfast. Therefore these sales are not geographically limited. Further, I have given consideration to the fact that whiskey is a drink that has a long manufacturing process, where it has to be distilled and then aged for a certain period of time before it can be distributed and sold and that, for many producers of whiskey, it is not likely to be mass produced.

32. I note that the applicant submits in its submissions in lieu that compared to the size of the whiskey market in the UK, the above claimed turnover figures are unlikely to reflect a real commercial exploitation of the mark because when compared to the average sales of whiskey manufactured in the UK from 2017 to 2021, it means that the “level of sales by the Opponent over the same period would represent just 0.0045% of that volume”. However, I consider that the market for whiskey across the EU, and UK, is likely to be extremely competitive with a vast number of producers competing with one another. Therefore, albeit a smaller percentage, compared to the “whiskey giants” which will exist within that industry, the opponent has produced enough whiskey to make its mark within the market. I also note that to reflect that there has

been a real commercial exploitation of the mark, the sales and market share figures do not need to be extraordinary (it just has to be more than trivial) as this would stop small businesses from being able to establish genuine use of their marks within any industry.

33. Therefore, taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of its mark, in the EU and UK, during the relevant period, for its class 33 Irish Whiskey goods.

Section 5(2)(b)

34. Section 5(2)(b) reads as follows:

“5(2) A trade mark shall not be registered if because –

(a)...

(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.”

35. In making this decision, I bear in mind the following principles 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

36. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 33</u> Irish Whiskey.	<u>Class 33</u> Scotch Whisky.

37. When making the comparison, all relevant factors relating to the goods in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union ("CJEU") in *Canon*, Case C-39/97, the court stated at paragraph 23 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."

38. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (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

39. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. 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.”

40. I note that in its Form TM8 the applicant has admitted that the goods are similar, but there is a distinction between them. Furthermore, in its submissions in lieu they state that “in order to gain authorisation to use the GIs [Geographical Indications] Irish Whiskey or Scotch Whisky, the products themselves need to satisfy a range of stringent criteria, much of which relates to their respective unique production methods

in the territories of Ireland and Scotland respectively. The Technical Files setting out these criteria are referenced at paragraphs 4 and 5 of Benjamin Britter's Witness statement", which is also supported by **annex 3** and **4**.

41. I consider that the opponent's "Irish Whiskey" is highly similar to the applicant's "Scotch Whisky". As highlighted by **annex 3** and **4**, while both goods are produced using different methods, and some different raw ingredients (albeit they both are made from malted barley), they are both considered as types of spirits, which are strong alcoholic drinks. Therefore, they overlap in nature. The goods can be consumed neat, as a short drink, or combined with a soft drink (such as tonic water or soda) or other types of mixers (as ingredients in cocktails), meaning that they will overlap in method of use. The goods are commonly consumed for pleasure whilst socialising, or with the intention of becoming intoxicated, and as a result, overlap in purpose. The goods also overlap in user, being consumed by adults over the age of 18. Taking the above into account, I also consider that the goods are likely to be in competition and they will also overlap in distribution channels as they are likely to be sold by the same retailers, being displayed in the same aisle/on the same shelves in close proximity. Furthermore, the goods are likely to be displayed near each other behind a bar. Taking all of the above into account, I consider that the goods are similar to a high degree.

The average consumer and the nature of the purchasing act

42. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

43. The average consumer of the goods will be adult members of the general public over the age of 18. However, I also consider that there will be a proportion of average consumers who are whisky enthusiasts/connoisseurs. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the origin and age of the goods, the cost, flavour, ingredients and alcohol percentage. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process. However, for those average consumers who are whisky enthusiasts or connoisseurs, I consider that above a medium degree of attention will be paid during the purchasing process.

44. Irish Whiskey and Scotch Whisky are likely to be purchased by self-selection from the shelves of a range of retail outlets such as supermarkets and off-licences, and their online equivalents. Such goods are also sold in public houses, bars, and restaurants where they will be publicly displayed behind the counter or on a drinks menu. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be verbally ordered at a bar, or if stocked behind a counter, the average consumer may have to ask the sales assistant for them.

Comparison of the trade marks

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

46. 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.

47. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
The Irishman Superior Irish Whiskey	Irishman's Point Whisky

48. The opponent's mark consists of the words “The Irishman Superior Irish Whiskey”. The word “Superior” is laudatory, and the words “Irish Whiskey” are descriptive of the goods. Therefore I consider that the word “Irishman” is the most dominant and distinctive element of the mark, and plays a greater role in the overall impression, with the words “The”, “Superior” and “Irish Whiskey” playing a lesser role.

49. The applicant's mark consists of the words “Irishman's Point Whisky”. I consider that, for reasons I will come to discuss in the conceptual comparison, the words “Irishman's Point” forms a unit, that the average consumer will recognise as a geographical location. Therefore, as the word “Whisky” is descriptive of the applicant's goods, I consider that “Irishman's Point” plays a greater role in the overall impression.

50. Visually, the marks overlap in the word “Irishman”, albeit possessive in the applicant’s mark (with the apostrophe S). They also both end with the word Whiskey/Whisky, with an additional “e” present in the opponent’s mark. This is a point of visual similarity. However, the opponent’s mark starts with the word “The” and in the middle of the mark contains the words “Superior Irish”. The middle of the applicant’s mark contains the word “Point”. These act as visual points of difference. I therefore consider that the marks are visually similar to between a low and medium degree.

51. Aurally, the opponent’s mark will be pronounced as THE EYE-RISH-MAN SUE-PEER-RE-OR WHISK-EE. The applicant’s mark will be pronounced as EYE-RISH-MANZ POYNT WHISK-EE. Therefore, the beginning of the marks differ aurally. However, as the marks overlap in the pronunciation of the word “Irishman” and “whiskey/whisky”, I consider that they are aurally similar to a medium degree.

52. Conceptually, the opponent’s mark conveys the concept of “Superior Irish Whiskey” called “The Irishman”.

53. The applicant has provided evidence that “Irishman’s Point” is a geographical location based in Scotland,² but there is no evidence to support the notion that the average consumer would know and be educated of such a location. However, the applicant has also provided dictionary definitions of “Point” which relates to a geographical feature of a projecting part of land (a long, thin area of land that stretches out into the sea).³ I consider that this is a recognisable concept to the average consumer. I, therefore, consider that as the average consumer will perceive “Irishman’s Point” as a unit, it will most likely be understood as denoting a geographical location being a Point. However, I do not consider that they would know it was located in Scotland.

54. Due to its name, the average consumer may make the logical assumption that “Irishman’s Point” is a place in Ireland. However, for those average consumers who are whisky enthusiasts/connoisseurs, they will recognise that as the word “Whisky” in

² Annex 2

³ Annex 1, (Cambridge Dictionary Definition)

the applicant's mark is spelt without the letter "e" it is most likely a Scotch whisky (as only Irish Whiskey is spelt with the letter "e"). Consequently, they may come to the conclusion that "Irishman's Point" is a location within Scotland, where the Scotch Whisky derives from. However, regardless of this possible perception/understanding, as the marks overlap in the concepts of "Irishman" and "Whisky/Whiskey", the marks are conceptually similar to at least a low degree.

Distinctive character of the earlier trade mark

55. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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)."

56. I also find the guidance set out in *Formula One Licensing BV v OHIM*⁴ to be useful in this case:

“41.it is not possible to find, with regard to a sign identical to a trade mark protected in a Member State, an absolute ground for refusal, such as the lack of distinctive character, provided by Article 7(1)(b) of Regulation No 40/94 and Article 3(1)(b) of Directives 89/104 and 2008/95. In this respect, it should be noted that the characterisation of a sign as descriptive or generic is equivalent to denying its distinctive character.

42. It is true that, as is clear from paragraph 48 of the judgment under appeal, where an opposition, based on the existence of an earlier national trade mark, is filed against the registration of a Community trade mark, OHIM and, consequently, the General Court, must verify the way in which the relevant public perceives the sign which is identical to the national trade mark in the mark applied for and evaluate, if necessary, the degree of distinctiveness of that sign.

43. However, as the appellant rightly points out, their verification has limits.

44. Their verification may not culminate in a finding of the lack of distinctive character of a sign identical to a registered and protected national trade mark, since such a finding would not be compatible with the coexistence of Community trade marks and national trade marks or with Article 8(1)(b) of Regulation No 40/94, read in conjunction with Article 8(2)(a)(ii).”

57. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, 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 that has been made of it.

58. I will begin by assessing the inherent distinctive character of the opponent’s mark.

⁴ Case C-196/11P

59. As highlighted above, the opponent's mark is comprised of the words "The Irishman Superior Irish Whiskey", a concept which will be understood as it is presented; superior Irish Whiskey called "The Irishman".

60. As per *Formula One*, the earlier mark must be considered to have at least some distinctive character. The word "Superior" is laudatory, and the words "Irish Whiskey" are descriptive of the goods. However, I also consider that the words "The Irishman" allude, to some extent, that the goods would be made, produced and therefore distributed by Irishmen. Consequently, I consider that the opponent's mark is inherently distinctive to between a low and medium degree.

61. Although the opponent has not specifically pleaded enhanced distinctiveness, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

62. The opponent has provided UK sales figures, for the years 2017 to 2021, to enable me to assess the extent of use that has been made of the opponent's mark. This amounts to €1,263,422. This is supported by example invoices which shows that Irish Whiskey goods were all sold under the IRISHMAN sign to St Helens, Bradford, Hampshire and Belfast. As highlighted above, the applicant has also submitted that the opponent's approximate market share figure represents 0.0045% of the Whiskey market for the years 2017 to 2021. However, I note that this is a small market share. I also note that the opponent has not provided any UK advertising figures, nor any evidence of its advertising. Therefore, taking the above into account, I do not consider that the evidence is sufficient to establish enhanced distinctiveness.

Likelihood of confusion

63. 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 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 vice versa. It is necessary for me to keep in mind the distinctive character of the earlier mark, 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 trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

64. The following factors must be considered to determine if a likelihood of confusion can be established:

- I have found the marks to be visually similar to between a low and medium degree.
- I have found the marks to be aurally similar to medium degree.
- I have found the marks to be conceptually similar to at least a low degree.
- I have found the opponent's mark to be inherently distinctive to between a low and medium degree.
- I have identified the average consumer to be members of the general public and whisky enthusiasts/connoisseurs who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods, however, I recognise that the level of attention may be above medium for whisky enthusiasts/connoisseurs.
- I have found the parties' goods to be similar to a high degree.

65. Taking all of the factors listed in paragraph 64 into account, and even bearing in mind the principle of imperfect recollection, I am satisfied that the marks are unlikely to be mistakenly recalled or misremembered as each other. This is particularly the case given the lower visual similarity (to between a low and medium degree) between the marks, and the predominantly visual purchasing process. I also do not consider that the average consumer would overlook the words "The" and "Superior Irish

Whiskey” in the opponent’s mark. However, in the event that the average consumer were to overlook these words, due to their laudatory and descriptive nature, I do not consider that they would overlook the apostrophe S and the word “Point” in the applicant’s mark because this creates a clear conceptual hook in order to differentiate the two marks (The Irishman vs a geographical area). I therefore consider that the conceptual differences between the marks counteracts the visual and phonetic similarities between them.⁵ Consequently, I do not consider there to be a likelihood of direct confusion.

66. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C. (as he then was), sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

“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.”

67. I also bear in mind the comments made in *Bimbo*. The CJEU stated (my emphasis):

“19. As to the merits, according to settled case-law, 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

⁵ *Picasso Estate v OHIM*, Case C-361/04 P, CJEU

40/94 (see Case C-334/05 P *OHIM v Shaker* EU:C:2007:333, paragraph 33, and Case C-193/06 P *Nestlé v OHIM* EU:C:2007:539, paragraph 32).

20. The existence of a likelihood of confusion on the part of the public must be assessed globally, account being taken of all factors relevant to the circumstances of the case (see, to that effect, Case C-251/95 *SABEL* EU:C:1997:528, paragraph 22; *OHIM v Shaker* EU:C:2007:333, paragraph 34; and *Nestlé v OHIM* EU:C:2007:539, paragraph 33).

21. The global assessment of the likelihood of confusion, in relation to the visual, aural or conceptual similarity of the marks at issue, must be based on the overall impression given by the marks, account being taken, in particular, of their distinctive and dominant components. The perception of the marks by the average consumer of the goods or services in question plays a decisive role in the global assessment of that likelihood of confusion. In this regard, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (see, to that effect, *SABEL* EU:C:1997:528, paragraph 23; *OHIM v Shaker* EU:C:2007:333, paragraph 35; and *Nestlé v OHIM* EU:C:2007:539, paragraph 34).

22. The assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole (*OHIM v Shaker* EU:C:2007:333, paragraph 41).

23. The overall impression conveyed to the relevant public by a composite trade mark may, in certain circumstances, be dominated by one or more of its components. However, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element (*OHIM v Shaker* EU:C:2007:333, paragraphs 41 and 42, and *Nestlé v OHIM* EU:C:2007:539, paragraphs 42 and 43 and the caselaw cited).

24. In this connection, the Court of Justice has stated that it is possible that an earlier mark used by a third party in a composite sign that includes the name of the company of the third party retains an independent distinctive role in the composite sign. Accordingly, in order to establish the likelihood of confusion, it suffices that, on account of the earlier mark still having an independent distinctive role, the public attributes the origin of the goods or services covered by the composite sign to the owner of that mark (Case C-120/04 *Medion* EU:C:2005:594, paragraphs 30 and 36, and order in Case C-353/09 P *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraph 36).

25. None the less, a component of a composite sign does not retain such an independent distinctive role if, together with the other component or components of the sign, that component forms a unit having a different meaning as compared with the meaning of those components taken separately (see, to that effect, order in Case C-23/09 P *ecoblue v OHIM and Banco Bilbao Vizcaya Argentaria* EU:C:2010:35, paragraph 47; *Becker v Harman International Industries* EU:C:2010:368, paragraphs 37 and 38; and order in *Perfetti Van Melle v OHIM* EU:C:2011:73, paragraphs 36 and 37)."

68. In *Deakins*, BL O/421/14, Mr Geoffrey Hobbs KC, sitting as the Appointed Person, stated:

"24. It is not correct to proceed on the basis that an element of a composite mark retains an independent distinctive role if, together with the other component or components of the mark, it '*forms a unit having a different meaning as compared with the meaning of those components taken separately*': *Bimbo SA v. OHIM* C-591/12P, EU:C:2014:305 at paragraph [25]. And even if a component of a composite mark is found to be sufficiently 'unitary' to retain an independent distinctive role, it still remains necessary for any assessment of '*similarity*' to be made by reference to the composite mark as a whole in the manner summarised in *Bimbo SA* at paragraphs [34] and [35]:

[34] Indeed, as the Advocate General observed in points 25 and 26 of his Opinion, 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.

[35] The determination of which components of a composite sign contribute to the overall impression made on the target public by that sign is to be undertaken before the global assessment of the likelihood of confusion of the signs at issue. Such an assessment must be based on the overall impression produced by the trade marks at issue, since the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details, as has been stated in paragraph 21 above. Therefore, this does not involve an exception, that must be duly substantiated, to that general rule.”

69. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also

perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

70. In that case, Arnold J. considered the registrability of a composite word mark - JURA ORIGIN - which included the opponent's earlier trade mark – ORIGIN. The judge found that the mark JURA ORIGIN formed a unit having a different meaning to those of the individual components. I have found the same in these proceedings.

71. The wording “Irishman's Point” in the applicant's mark forms a unit, to create a new conceptual meaning; a geographical location. The opponent's mark, “The Irishman Superior Irish Whiskey”, evokes a meaning of a superior Irish Whiskey called “The Irishman”. These marks are, therefore, not a logical nor obvious brand extension because of their different conceptual meanings (a whiskey called The Irishman vs a whisky from the geographical area Irishman's Point). I also note that in the event the average consumer was to overlook the words “Superior Irish Whiskey” in the opponent's mark, due to their laudatory and descriptive nature, again I do not consider that “The Irishman” to “Irishman's Point” would be a logical nor obvious brand

extension for the average consumer to make a connection between them. This is because of the clear conceptual hook between the marks (The Irishman vs a geographical area). Consequently, I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent, and vice versa.

72. Even if the opponent's mark is brought to mind, this is mere association, not confusion: see *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, paragraph 81. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

73. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

74. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£1,050** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filing evidence	£500
Preparing and filling submissions in lieu	£350
Total	£1,050

75. I therefore order WW Equity House Trading Limited to pay Corry Distillery Limited the sum of £1,050. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 6th day of March 2023

L FAYTER

For the Registrar