

O/383/17

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATION NO. 3090564**

**BY MORRISON GLASGOW DISTILLERS LIMITED  
TO REGISTER THE TRADE MARK:**

**THE GLASGOW  
DISTILLERY**  
PUMPHOUSE | CLYDESIDE

**IN CLASSES 33, 35, 40, 41 AND 43**

**AND**

**IN THE MATTER OF OPPOSITION THERETO  
UNDER NO. 404080  
BY GLASGOW DISTILLERY COMPANY LIMITED**

## BACKGROUND

1. On 22 January 2015 Morrison Glasgow Distillers Limited<sup>1</sup> (“the applicant”) applied to register the mark shown on the cover page of this decision in respect of a range of goods and services in classes 33, 35, 40, 41 and 43.

2. Following examination, the application was accepted and published for opposition purposes on 6 February 2015. On 8 January 2016, Glasgow Distillery Company Limited (“the opponent”) filed a notice of opposition against the application. The opposition is based upon Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods and services in the application. At the time when the present opposition was filed the opponent relied upon its European Union Trade Mark (EUTM) application no. 12727079 for the mark shown below, which was filed on 25 March 2014 for a range of goods and services in classes 33, 35 and 40:



3. By way of background, the opponent’s application for EUTM 12727079, i.e. the same mark as is relied upon as the earlier mark in these proceedings, was also subject to an opposition at the European Union Intellectual Property Office (EUIPO) (B2410671) brought by the applicant on the basis of its earlier UK registration no.

### THE GLASGOW DISTILLERY

3020359 for the mark

— THE PUMP HOUSE - CLYDESIDE —

. To the extent

that it is relevant to this decision, on 16 February 2017 the EUIPO partially upheld that opposition in respect of:

---

<sup>1</sup> The application was filed by The Glasgow Distilling Company Limited, which changed its name during the course of these proceedings to Morrison Glasgow Distillers Limited.

**Class 35:** Retail services all connected with the sale of alcoholic beverages, whisky, gin, vodka, absinthe, rum, wines, spirits and liqueurs; advisory, consultancy and information services relating to the aforesaid.

4. Consequently, these services (which were initially relied upon by the opponent) did not proceed to registration. On 19 May 2017 the opponent's mark was registered for the following goods and services:

**Class 33:** Alcoholic beverages (except beers); whisky; gin; vodka; absinthe; rum; wines; spirits; liqueurs.

**Class 40:** Distillery and brewing services; spirits distillery services; distillery services relating to alcoholic beverages, whisky, gin, vodka, absinthe, rum, wines, spirits and liqueurs; advisory, consultancy and information services relating to the aforesaid services.

5. Accordingly, this is the specification upon which the present opposition must be decided.

6. The opponent argues that the respective goods and services are identical or similar and that the marks are similar, as they coincide in the words 'THE GLASGOW DISTILLERY', which is the dominant element in both marks.

7. The applicant filed a counterstatement, in which it denies the claims made.

8. No hearing was requested and neither party filed evidence or written submissions during the evidence rounds, although the applicant opted to file written submissions in lieu of attendance at a hearing. I will bear these submissions in mind and refer to them as necessary below.

## **DECISION**

9. The opposition is based upon Section 5(2)(b) of the Act, which reads as follows:

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

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

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

10. An earlier mark is defined in Section 6(1) of the Act, the relevant parts of which state:

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

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

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

11. Given its date of filing, the opponent’s mark is an earlier mark in accordance with Section 6 of the Act. As this mark had not been registered for five years or more at the publication date of the opposed application, it is not subject to the proof of use provisions under section 6A of the Act. Consequently, the earlier mark may be relied upon for all of the goods and services for which it is registered without having to prove use.

## Section 5(2)(b) - case-law

12. 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 greater degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings 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 and services**

13. In comparing the respective specifications, all the relevant factors 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:

“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”.

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;
- c) The respective trade channels through which the goods or services reach the market;
- d) 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;
- e) 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.

15. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

"... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. *Treat* was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question."

16. In *Beautimatic International Ltd v Mitchell International Pharmaceuticals Ltd and Another*, [2000] F.S.R. 267 (HC), Neuberger J. (as he then was) stated that:

“I should add that I see no reason to give the word “cosmetics” and “toilet preparations”... anything other than their natural meaning, subject, of course, to the normal and necessary principle that the words must be construed by reference to their context.”

17. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

18. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criteria capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v OHIM*, Case T-325/06, the General Court (GC) stated that “complementary” means:

“...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”.

19. In *Sanco SA v OHIM*, Case T-249/11, the GC indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:



“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.

20. In *Gérard Meric v OHIM*, Case T- 133/05, the GC stated:

“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”.

21. The applicant made some admissions in its counterstatement and submissions as to the similarity of the respective goods and services. However, its position is far from clear. For example, in its written submissions the applicant seems to agree that all of the competing goods and services are similar/identical. It states:

“In terms of the goods and services, it is clear that there is overlap and there is at least similarity if not identity. This reduces the matter to a comparison of the marks”.

22. On the other hand, in its counterstatement it states:

“It is admitted that there is identity/similarity in the goods in Class 33 and retail services in Class 35 and distilling services in class 40. [...] It is denied that the remaining services of the application are similar to the goods and services of the Opponent’s Mark and the Opponent is put to strict proof thereof”.

23. Given that i) the opponent can no longer rely on the services initially applied for in class 35 and ii) the applicant's position in relation to the applied for services in classes 41 and 43 is ambiguous, I will proceed to my own assessment of the similarity between the classes 35, 41 and 43 services of the application and the opponent's goods and services. Indeed, where the applicant has unequivocally accepted that identity or similarity exists, i.e. goods in class 33 and services in class 40, I will proceed on that basis.

24. The goods and services to be compared, including those in class 33 and 40 (shown below in bold), are as follows:

Applicant's goods and services	Opponent's goods and services
<p><b>Class 33: Alcoholic beverages; spirits; liqueurs; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based, all being produced in Scotland; Scotch whisky; gin.</b></p> <p><b>Class 35:</b> Retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs, waters [beverages], mineral water, aerated water, non-alcoholic beverages, printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and packaging materials, plastic materials for packaging, signs</p>	<p><b>Class 33:</b> Alcoholic beverages (except beers); whisky; gin; vodka; absinthe; rum; wines; spirits; liqueurs.</p> <p><b>Class 40:</b> Distillery and brewing services; spirits distillery services; distillery services relating to alcoholic beverages, whisky, gin, vodka, absinthe, rum, wines, spirits and liqueurs; advisory, consultancy and information services relating to the aforesaid services.</p>

and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses, tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear, aprons, caps, visors, belts, foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and

covers, mouse mats and computer hardware accessories; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.

**Class 40: Distilling services.**

**Class 41:** Education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky; arranging and conducting conferences and seminars; arranging of courses of instruction for tourists; corporate hospitality (entertainment); whisky tasting services; provision of club recreation services; publication of texts and newsletters; arranging and conducting talks, tastings, conferences and exhibitions; publication of tasting notes and bottling lists; arranging of competitions for educational, entertainment and cultural purposes; organisation of competitions and prize giving; provision of courses of instruction for tourists; cultural facilities; presentation of live performances; publication of books; information and advisory services relating to the foregoing services.

<p><b>Class 43:</b> Provision of museum, presentation and exhibition facilities; restaurant and bar services; services for providing food and drink; temporary accommodation; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding receptions (food and drink); restaurants; corporate hospitality (provision of food and drink); whisky tasting services (provision of beverages); cafes; cafeterias.</p>	
---	--

25. In the absence of any evidence to assist me, I must form my own view on the similarity or otherwise in the respective goods and services. In deciding whether the respective goods and services are similar, I must consider the factors set out in the case law outlined above and am able to draw upon commonly known facts. Mr Geoffrey Hobbs QC sitting as the Appointed Person said in *Raleigh International trade mark* [2001] R.P.C. 11 at paragraph 20, that evidence of similarity will be required if the goods or services specified in the opposed application for registration are not identical or self-evidently similar to those for which the earlier trade mark is registered. But where there is self-evident similarity, and especially in relation to everyday items, evidence may not be necessary. In making the comparison, I will do so with reference to the applied for goods and services, on a term-by-term basis, albeit grouping them together when it is reasonable to do so.

#### Class 35

26. **Retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs.** In *Oakley, Inc. v OHIM* – case T-116/06 the GC held that:

“services consisting of ‘retail and wholesale of clothing, headwear, footwear, athletic bags, backpacks and knapsacks and wallets’, and ‘retail and wholesale services, including on-line retail store services”

were similar to goods in classes 18 and 25:

“having regard to the fact that they are complementary and that those services are generally offered in the same places as those where the goods are offered for sale.”

27. In *Tony Van Gulck v Wasabi Frog Ltd*, Case BL O/391/14, Mr Geoffrey Hobbs Q.C. as the Appointed Person reviewed the law concerning retail services v goods. He said (at paragraph 9 of his judgment) that:

“9. The position with regard to the question of conflict between use of **BOO!** for handbags in Class 18 and shoes for women in Class 25 and use of **MissBoo** for the Listed Services is considerably more complex. There are four main reasons for that: (i) selling and offering to sell goods does not, in itself, amount to providing retail services in Class 35; (ii) an application for registration of a trade mark for retail services in Class 35 can validly describe the retail services for which protection is requested in general terms; (iii) for the purpose of determining whether such an application is objectionable under Section 5(2)(b), it is necessary to ascertain whether there is a likelihood of confusion with the opponent’s earlier trade mark in all the circumstances in which the trade mark applied for might be used if it were to be registered; (iv) the criteria for determining whether, when and to what degree services are ‘*similar*’ to goods are not clear cut.”

28. However, on the basis of the European courts’ judgments in *Sanco SA v OHIM*<sup>2</sup>, and *Assembled Investments (Proprietary) Ltd v. OHIM*<sup>3</sup>, upheld on appeal in

---

<sup>2</sup> Case C-411/13P

<sup>3</sup> Case T-105/05, at paragraphs [30] to [35] of the judgment

*Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd*<sup>4</sup>, Mr Hobbs concluded that:

- i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;
- ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;
- iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;
- iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

29. The contested retail services in Class 35 relate to the goods in Class 33 covered by the earlier mark. Consequently, applying the principle established in *Oakley*, there is a similarity between the *retail services and on-line retail services connected with the sale of alcoholic beverages*<sup>5</sup>, *spirits, whisky, gin, liqueurs* of the application and the *alcoholic beverages (except beers), whisky, gin, spirits and liqueurs* of the earlier mark. Further, the manufacturer of the goods in class 33 may, either directly or by means of the intervention of other companies, render the related retail services. Accordingly, I find that there is a low degree of similarity between the respective goods and services.

---

<sup>4</sup> Case C-398/07P

<sup>5</sup> Although the term "alcoholic beverages" in the application is not followed by the limitation (except beers), it must be so limited since the term "beers" belongs to class 32 not 33.

**30. Retail services and on-line retail services connected with the sale of waters [beverages], mineral water, aerated water, non-alcoholic beverages.** Here the contested retail services concern the sale of goods which are not identical to the opponent's goods. Applying the above guidance, I find that any complementarity between the opponent's goods and the contested services is insufficiently pronounced that from the consumer's point of view, they are unlikely to be offered by one and the same undertaking. Accordingly, I find that there is no similarity between *retail services and on-line retail services connected with the sale of waters [beverages], mineral water, aerated water, non-alcoholic beverages* of the application and any of the opponent's goods and services.

**31. Retail services and on-line retail services connected with the sale of printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and packaging materials, plastic materials for packaging, signs and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses, tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear, aprons, caps, visors, belts, foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories.** Similar considerations to those expressed in the previous paragraph apply to these services. There is no similarity here.



**32. Arranging and conducting of talks and tastings for promotional and advertising purposes.** The contested services consist essentially of arranging and conducting product demonstrations for others, e.g. tasting of food and beverages in supermarkets and/or at promotional events. The services are provided by advertising agencies to, for example, manufacturers who seek to promote their products in order to attract sales. Even if companies producing the class 33 goods covered by the earlier mark might use the contested *arranging and conducting of talks and tastings for promotional and advertising purposes* services in order to promote their own products, this does not create a complementary relationship in the sense described by the case-law. The earlier mark covers a range of alcoholic beverages and distilling services (and related advisory, consultancy and information services), whereas the contested services are marketing services. The users, nature, intended purposes, methods of use and trade channels are clearly different and there is no competition or complementarity. There is no similarity here.

**33. Arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.** Similar considerations to those expressed in the previous paragraph apply to these services. The contested services are marketing services intended to provide other businesses with assistance in designing and arranging competitions for commercial and promotional purposes, e.g. advertising campaigns, and in disseminating advertising material. The services are likely to be offered by prize management agencies and advertising agencies. Once again, the users, nature, intended purposes, methods of use and trade channels are clearly different and the services are neither competitive nor complementary to one another. There is no similarity here.

#### Class 41

**34. Education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky.** These services might involve visits to distilleries where users would, for example, learn about the site and equipment, see how the whisky is made and taste and purchase a selection of whiskies. The earlier mark covers whisky and distillery services relating to the production of whisky. The respective goods and services have different nature and purpose, given that the

contested services are aimed to teach and entertain people whereas the services of the earlier mark relate to whisky production. Nonetheless, the fact that the contested education and entertainment services might take place in the same premises where the opponent's whisky goods are manufactured and where the distillation of whisky is being carried out, creates a link and I find that there is a degree of complementarity in the sense that customers may think that the responsibility for those services lies with the same undertaking. Further, the opponent's *whisky* in class 33 are indispensable for the provision of the education and entertainment services relating to sale and consumption of whisky. There is a medium degree of similarity with the goods and services of the earlier mark.

**35. Arranging of courses of instruction for tourists; provision of courses of instruction for tourists.** As these services are not limited in any way, they would also cover *education services relating to the manufacture, production, sale and consumption of whisky*. For similar reasons to those expressed in the previous paragraph, I find that there is a medium degree of similarity.

**36. Corporate hospitality (entertainment).** These services consist of the entertainment of clients and/or staff by businesses. Insofar as the aforementioned *education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky* might be provided to groups of people, they would be a form of *corporate hospitality (entertainment)* in which case similar considerations to those expressed in the previous paragraph apply.

**37. Cultural facilities.** A cultural facility might be a theatre, a gallery, a museum or a concert hall. The earlier mark covers distillery services. The respective services target different consumers, i.e. manufacturers of spirits and tourists/visitors, have different nature, purpose and methods of use and are not in competition. However, it is well known that distilleries might be open to the public and attract visitors, in which case they would provide a cultural facility. This creates a link and a degree of complementarity in the sense that consumers might think that the responsibility for those services lies with the same undertaking. There is a low degree of similarity between *cultural facilities* services of the application and *distillery services* of the earlier mark.

**38. Arranging of competitions for educational, entertainment and cultural purposes; organisation of competitions and prize giving.** These services have the basic aim of education and amusement of people and could therefore be provided as part of the contested *education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky*, e.g. tasting competition. For similar reasons to those expressed in paragraph 34, I find that there is a medium degree of similarity.

**39. Whisky tasting services; arranging and conducting talk and tasting.**

Contrary to what I found in paragraph 32 in relation to *arranging and conducting of talks and tastings for promotional and advertising purposes*, here the services are provided directly to the public. The services might therefore be supplied by the same undertakings as the opponent's whisky in class 33 given that I would expect whisky producers to offer whisky tastings. Whilst, therefore, the nature of the respective goods and services is different, they target the same consumers and are likely to be distributed through the same trade channels. Finally, there is a degree of complementarity since the goods of the earlier mark are indispensable for the provision of the contested services and consumers may think that the responsibility for these services lies with the same undertaking. I find that there is a medium degree of similarity.

**40. Arranging and conducting conferences and seminars; arranging and conducting conferences and exhibitions.** The earlier mark covers a range of *distillery services and related advisory, consultancy and information services*. The contested *arranging and conducting conferences and seminars; arranging and conducting conferences and exhibitions* could be provided in the opponent's field of activity, i.e. distilled spirits, so users might be the same, i.e. those seeking information in relation to spirits production. In this sense there is some degree of competition. However, the opponent's information and advisory services are classified in the same class of its distillery services, i.e. class 40, which means that they are likely to be provided in connection with the provision of these services; so competition has limits. The nature, purpose, methods of use and trade channels of the respective services is different. Overall I find that there is a low degree of similarity.

**41. Provision of club recreation services.** In accordance with *Avnet* I must consider the core meaning of the services. A club is essentially a group of people with common aims or interests; as the purpose of the club is recreational, I understand the *provision of club recreation services* as the bringing together of individuals to participate in a shared activity for enjoyment and entertainment, i.e. sports and social clubs. Whilst it is possible that manufacturers of class 33 goods might offer membership schemes, e.g. wine clubs in relation to the purchase of bottles of wines, I would not describe this type of service as a club recreation service as it does not involve, by itself, the provision of a recreational activity. In the absence of any submissions from the opponent to explain why it considers these services to be similar to its own goods and services, I can find no meaningful areas in which the competing goods and services coincide. Accordingly, I find there is no similarity here.

**42. Publication of text and newsletters; publication of tasting notes and bottling lists; publication of books.** So far as these services are concerned, it should be noted that they are publishing services which involve the provision of publication for third parties. The services are therefore provided by publishing companies whereas the goods and services of the earlier mark are provided by manufacturers of spirits. The users, nature, intended purposes, methods of use and trade channels are clearly different and there is no competition or complementary. There is no similarity here.

**43. Presentation of live performances.** Live performances would include theatre performances, concerts and dance performances. Once again, in the absence of any submissions from the opponent to explain why it considers these services to be similar to its own goods and services I can find no meaningful areas in which the competing goods and services coincide. There is no similarity here.

**44. Information and advisory services relating to the foregoing services.** My findings above apply to the related information and advisory services.

## Class 43

**45. Provision of museum, presentation and exhibition facilities.** A museum is a building in which objects of historical, scientific, artistic, or cultural interest are stored and exhibited. Whilst I found that distilleries might be open to the public and, as such, provide a cultural facility, there is no evidence that working distilleries also provide those type of services. There is no similarity here.

**46. Bar services; whisky tasting services (provision of beverages).** These services are similar to the opponent's goods in class 33 as they can coincide in their suppliers and distribution channels. There is also a degree of complementarity as the opponent's goods are indispensable for the provision of the services and consumers might think that the responsibility for those e services lies with the same undertakings. There is a medium degree of similarity.

**47. Restaurant services; restaurants; services for providing food and drink.** The closest of the opponent's goods is wine which is normally served in restaurants. Wine is different in nature to restaurant services and the method of use of the respective goods and services is also different. There is a degree of competition between the goods and services, although this is limited as you would not go to a restaurant merely to drink wine and the dining experience is the motivating factor. However, it is well known that restaurants often offer house wines so there is a degree of complementarity. Overall, I find that there is a low degree of similarity between the contested *wines* and the *restaurant services* of the earlier mark.

**48. Cafes; cafeterias.** These establishments do not usually provide wine (or indeed any of the other class 33 goods of the earlier mark) and there is no evidence to the contrary. Consequently, I find that there is no similarity.

**49. Catering services; arranging of wedding receptions (food and drink); corporate hospitality (provision of food and drink).** All those services are essentially catering services. The services consist of preparing and serving food and drinks for the public at a social/business event, e.g. weddings, business receptions. The services are normally provided at a remote site, e.g. hotel, or other locations.

There is no similarity between the alcoholic beverages and distillery services of the earlier mark and these services in term of users, nature, purpose and method of use. Whilst providers of catering services may perhaps serve beverages, i.e. bottles of water and wine, to their customers, the service would not include the serving of alcoholic drinks through a bar, as this would effectively be a bar service. If the catering provider offered a bar service, this would be a distinct and additional service. The average consumer will be the event organiser, not the one consuming the goods at the event, so users are not shared and there is no competition. Further, catering enterprises, even if they prepare the meals they provide, do not themselves manufacture the drinks that they serve to their customers. There is no similarity here.

**50. Temporary accommodation; hiring of rooms for social functions; arranging of wedding receptions (venues).** The main purpose of these services is to provide hospitality and accommodation services. Consequently, they do not have the same nature, purpose, method of use or trade channels of the opponent's goods and services and target different users. Further, there is no competition or complementarity. There is no similarity here.

51. In *eSure Insurance v Direct Line Insurance*, [2008] ETMR 77 CA, Lady Justice Arden stated that:

“49..... I do not find any threshold condition in the jurisprudence of the Court of Justice cited to us. Moreover I consider that no useful purpose is served by holding that there is some minimum threshold level of similarity that has to be shown. If there is no similarity at all, there is no likelihood of confusion to be considered. If there is some similarity, then the likelihood of confusion has to be considered but it is unnecessary to interpose a need to find a minimum level of similarity.

52. Having concluded that there is no meaningful similarity between the opponent's goods and services and:

**Class 35:** Retail services and on-line retail services connected with the sale of waters [beverages], mineral water, aerated water, non-alcoholic beverages,

printed matter, publications, photographs, stationery, adhesives for stationery or household purposes, artists' materials, office requisites (except furniture), instructional and teaching material, wrapping and packaging materials, plastic materials for packaging, signs and signboards of paper or cardboard, flags, posters, labels, stickers, transfers, decalcomanias. glassware, porcelain, earthenware, household or kitchen utensils and containers, brushes, unworked or semi-worked glass, non-precious metalware, coolers, cool bags, beverage coolers, bottle coolers, ice buckets, trays, drinking flasks, drinking vessels, drinking glasses, tumblers, shot glasses, signs, signboards, jewellery, cufflinks, bracelets, pendants, necklaces, earrings, cooling stones for drinks, pastries, confectionery, biscuits, shortbread, chocolate, gift boxes, hip flasks, drinks measures, textiles and textile goods, table covers, towels, bar towels, bar cloths, flags, bunting, banners, tea towels, books, clothing, footwear, headwear, t-shirts, sweatshirts, jackets, rainwear, waterproof jackets, fleeces, shirts, underwear, aprons, caps, visors, belts, foodstuffs, confectionery, biscuits, cakes, pastries, pies, puddings, flavourings, sauces, vinegars, essences, ice-cream, ice-cream confections, honey, mustard, tea and coffee, key rings, magnets, notebooks, tiepins, cuff links, toys, games and playthings, cards, postcards, CDs, DVDs, audio and video recordings, software, phone accessories and covers, mouse mats and computer hardware accessories; arranging and conducting of talks and tastings for promotional and advertising purposes; arranging of competitions for trade, commercial and business purposes; distribution and dissemination of advertising matter and information.

**Class 41:** Provision of club recreation services; publication of texts and newsletters; publication of tasting notes and bottling lists; presentation of live performances; publication of books; information and advisory services relating to the foregoing services.

**Class 43:** Provision of museum, presentation and exhibition facilities; temporary accommodation; hiring of rooms for social functions; catering services; arranging of wedding receptions (venues); arranging of wedding

receptions (food and drink); corporate hospitality (provision of food and drink); cafes; cafeterias.

in the application, there can be no likelihood of confusion and the opposition to these services fails accordingly.

### **Average consumer**

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

54. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

55. The average consumer of the parties' class 33 goods is a member of the general public over the age of 18. In my experience these goods are sold through a range of channels including supermarkets, off-licences and their online equivalents, where the goods are likely to be viewed and self-selected by the consumer. Whilst the goods may also be purchased in bars and similar establishments, where they may be requested orally, the goods will still, ordinarily, be on display so that they can be



seen<sup>6</sup>. Accordingly, the selection of the goods will be primarily visual, although aural considerations will play a part. The level of attention in buying the goods themselves will be average, given that these goods are, in general, not expensive but bearing in mind that the average consumer will wish to ensure a particular type, flavour or strength etc.

56. The average consumer of the parties' class 40 distillery services is a business seeking a supplier and or manufacturer of spirits. Either will take an above average degree of attention in selecting the service provider owing to the importance of ensuring that the service meets the business requirements, taking into account, for example, cost and characteristics of the product, i.e. aroma, taste. The purchasing process will primarily be visual with the services being selected from brochures and the like and also the online equivalents, or from specific tender submissions. There may also be word-of-mouth recommendations and bookings by telephone where aural considerations will play a part.

57. The average consumer of the applied for class 41 services (which I found to be similar to the extent that they relate to education and entertainment activities all relating to the manufacture, production, sale and consumption of whisky) would be a business user or the adult general public. Primarily, the average consumer's encounter with the applied for mark will be on a visual level, such as use on advertising material and website use, although aural consideration in the form of phone bookings and word-of-mouth recommendations can play a part. As to the level of attention paid during the selection process, it would be slightly above average given the importance of ensuring the availability and suitability of the content, time, date, location and cost of the course/event.

58. As to the applied for services in class 43, they include bar and restaurant services and whisky tasting services. Once again, the average consumer is the adult public. The services will be selected primarily visually, having encountered the mark on, for example, signage in street, advertisements or websites. The level of attention paid to the selection of the services will be at least average.

---

<sup>6</sup>*Simonds Farsons Cisk plc v OHIM*, Case T-3/04



## Comparison of marks

59. 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.”

60. It would be wrong, therefore, artificially to dissect the 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.

61. The marks to be compared are:

Applied for mark	Earlier mark
	

## Overall impression

62. The opponent submits that the dominant element of the applied for mark is 'THE GLASGOW DISTILLERY' and that the presence of the words 'PUMPHOUSE CLYDESIDE' merely denotes an address, whereas the suffix 'Co.' in the earlier mark is an abbreviation for the generic word 'Company'.

63. The applicant argues that the opponent is seeking artificially to dissect the mark disregarding other distinctive matter and that the marks must be compared as wholes. It contends that it is incompatible for the component 'THE GLASGOW DISTILLERY' to be both dominant and descriptive and submits that the marks are sufficiently different owing to the different stylisation and the inclusion of other elements. It states that the distinctive matter of its mark is the stylisation of the font, which it wished to secure registration for in order to prevent third parties from using a similar font for similar words. Likewise, it states that the only distinctive component of the opponent's mark, is the device of a still, although it points out, this is equally descriptive of goods and services covered by the mark. In this connection, the applicant seeks to rely upon the findings of the hearing officer in *BL-O-159-16* where registration number no. 3020359 for the mark

**THE GLASGOW DISTILLERY**  
— THE PUMP HOUSE - CLYDESIDE —

(which is a different mark from the ones at issues in these proceedings) was partially revoked. There, the hearing officer found that the component 'THE GLASGOW DISTILLERY' of that mark was descriptive within the meaning of section 3(1)(c) and devoid of distinctiveness within the meaning of section 3(1)(b) in respect of a number of goods and services in classes 33, 35, 41 and 43. Whilst I note that decision, it refers to a different mark and there is no need for me to examine the inherent registrability of the earlier mark in these proceedings. In *C-182/14, MEGA Brands International v OHIM* the CJEU state:

"33. In the present case, at the stage of the assessment of the phonetic and visual similarity of the signs at issue, the General Court held, in paragraph 25 of the judgment under appeal, that the word 'magnet' must be considered to be the dominant element in the earlier mark MAGNET 4.

34. In so far as the appellant submits that such a categorisation is incompatible with the descriptive character that the General Court conferred on that word in paragraph 26 of the judgment under appeal, suffice it to note that, even if a verbal element should be considered to have a purely descriptive character, that character does not preclude that element from being acknowledged as dominant for the purposes of assessing the similarity of the signs at issue (see, to that effect, order in *Muñoz Arraiza v OHIM*, C-388/10 P, EU:C:2011:185, paragraph 65).”

64. In this connection, I also note that it is well established that distinctiveness is not a factor that is relevant to the assessment of the similarity of the marks<sup>7</sup>.

65. The applied for mark consists of the words ‘THE GLASGOW’ positioned above the word ‘DISTILLERY’ in double line script. Both elements are set to the left and the phrase ‘THE GLASGOW DISTILLERY’ hangs together as a unit. The other words ‘PUMPHOUSE’ and ‘CLYDESIDE’, which appear below the word ‘DISTILLERY’, are in a significantly smaller size. Whilst I accept that the phrase ‘THE GLASGOW DISTILLERY’ is highly allusive in respect of a number of goods and services in the application, as it will be associated with a company based in Glasgow where spirits are being manufactured, the words ‘PUMPHOUSE’ and ‘CLYDESIDE’ incorporate suffixes, i.e. –HOUSE and –SIDE, commonly used in building names and names of locations so they also carry geographical connotations. Due to the size of the words, ‘THE GLASGOW DISTILLERY’ is the most eye-catching element of the mark and dominates its overall impression.

66. The earlier mark consists of the device of a still, i.e. an apparatus used by distilleries to distil alcohol, and the phrase ‘THE GLASGOW DISTILLERY Co.’. The words ‘THE’, ‘GLASGOW’ and ‘DISTILLERY Co.’, are in capital letters, in different sizes and presented one above the other. Due to the relative larger size and bold typeface, ‘GLASGOW’ stands out, however, the words ‘THE GLASGOW DISTILLERY Co.’ forms as a unit in themselves. Once again, the words ‘THE GLASGOW DISTILLERY Co.’ are highly allusive in respect of all the goods and

---

<sup>7</sup> *Ravensburger AG v OHIM*, case T-243/08

services of the earlier mark; further this is emphasised by the device, which merely reinforces the words and is likely to be perceived as background. In my view, the stylisation of the device and the word 'GLASGOW' make a roughly equal contribution to the overall impression of the mark, with the words 'THE' and 'DISTILLERY Co.' carrying less weight due to their size.

### **Visual similarity**

67. On a visual comparison, there is a degree of similarity between the respective marks given that both contain the words 'THE GLASGOW DISTILLERY'. There are also visual differences in that the words 'THE GLASGOW DISTILLERY' in the application are slightly stylised (although the stylisation is not too elaborated and is far less noticeable when the mark is reproduced on a smaller size) and the earlier mark also contains a device element. Although the words 'Co.' of the earlier mark and 'PUMPHOUSE' and 'CLYDESIDE' of the contested mark are also points of difference, their visual impact is limited because of their size and descriptive nature. So, whilst there are differences between the marks, none of these are remarkable and would not form much of an impression upon the average consumer. In my view there is, at least, a medium degree of visual similarity.

### **Aural similarity**

68. From an aural perspective, the device element will not be articulated. The only difference between the marks is the additional word 'Co.' in the earlier mark, and the words 'PUMPHOUSE' and 'CLYDESIDE' in the applied for mark, neither of which is, in my view, likely to be articulated. Aurally, the marks are identical. In the unlikely event that the words 'Co.', 'PUMPHOUSE' and 'CLYDESIDE' were to be articulated, there would be at least a medium degree of aural similarity.

### **Conceptual similarity**

69. As both marks contain the phrase 'THE GLASGOW DISTILLERY', they are likely to be understood as indicating a distillery located in Glasgow. In relation to the applied for mark, the words 'PUMPHOUSE' and 'CLYDESIDE' are likely to be seen

as a reference to a building/location and I agree with the opponent that they will be perceived as an address. Whilst the applicant takes issue with this submission, it offers no alternative interpretations. Insofar as the earlier mark is concerned, again, I agree with the opponent that the word ‘Co.’ will be understood as an abbreviation of the word ‘Company’. The inclusion of the device adds very little from a conceptual perspective, as it merely reinforces the idea of a distillery. Overall, I find that the marks are conceptually identical.

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

70. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated at paragraphs 22 and 23 that:

“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).

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).”

71. I have no evidence of use to consider, so I only need to make a finding in respect of the inherent distinctiveness of the earlier mark. In assessing the distinctiveness of the earlier mark I bear in mind that it is the distinctiveness of the shared component that is the key<sup>8</sup> and that the mark must be assumed to have ‘at least some distinctive character’<sup>9</sup>. In this connection, I note that in *Westermann Lernspielverlag GmbH v OHIM*, Case T-333/13, the GC stated:

“49. First, in so far as the applicant claims that the descriptive character of the element ‘bambino’ in the earlier trade mark is emphasised by the figurative element representing a stylised child that accompanies it (see paragraph 42 above), the applicant calls into question, even if only indirectly, the distinctive character of the earlier trade mark.

50. The fact that a mark has been registered means that that mark has a minimum of inherent distinctiveness, since Article 7(1)(b) of Regulation No 207/2009 precludes registration of a mark which is devoid of distinctive character. A dispute as to the earlier mark’s minimum distinctive character cannot form the subject-matter of opposition proceedings under Article 8(1)(b) of Regulation No 207/2009. As is apparent from Articles 41 and 42 of Regulation No 207/2009, there is no need to examine the absolute grounds for refusal referred to in Article 7 of that regulation in the context of opposition proceedings (judgment of 16 January 2014 in *Ferienhäuser zum See v OHIM — Sunparks Groep (Sun Park Holidays)*, T-383/12, EU:T:2014:12, paragraph 47).

72. I have already found that the words THE GLASGOW DISTILLERY are highly allusive for the goods and services covered by the earlier mark. Although the mark incorporates a device element, I have already found that the device merely reinforces the words. Further, as the words are the only element which shares any counterpart in the later mark, it is in relation to this element that the distinctiveness of the mark must be assessed. Accordingly, in the absence of a challenge to the

---

<sup>8</sup> See the comments of Mr Iain Purvis Q.C., sitting as the Appointed Person, in *Kurt Geiger v A-List Corporate Limited*, BL O-075-13

<sup>9</sup> See by analogy *Formula One Licensing BV v OHIM*, Case C-196/11P

validity of the earlier mark, I find that it is possessed of only a low degree of inherent distinctive character in relation to all the goods and services covered by the specification.

### **Likelihood of confusion**

73. In determining whether there is a likelihood of confusion, 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. I must also keep in mind the average consumer for the goods and services, the nature of the purchasing process and 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 he has retained in his mind.

74. There are two types of relevant confusion to consider: direct confusion (where one mark is mistaken for the other) and indirect confusion (where the respective similarities lead the consumer to believe that the respective goods and services come from the same or a related trade source). This distinction was summed up by Mr Iain Purvis Q.C. 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.



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).”

75. Turning to the facts of the present case, some of the goods and services are identical whereas in relation to others there is a medium to low degree of similarity. The competing marks are visually similar to a medium degree, aurally identical (or at least aurally similar to a medium degree) and conceptually identical. I also consider that the level of attention paid will range from average to above average and that the selection process is likely to be predominantly visual, although aural considerations may play a part. Whilst I note that the earlier mark has a low degree of distinctive character, I bear in mind that in *L’Oréal SA v OHIM* Case C-235/05 P, the CJEU stated:

“ 45. The applicant’s approach would have the effect of disregarding the notion of the similarity of the marks in favour of one based on the distinctive character of the earlier mark, which would then be given undue importance. The result would be that where the earlier mark is only of weak distinctive character a likelihood of confusion would exist only where there was a complete reproduction of that mark by the mark applied for, whatever the

degree of similarity between the marks in question. If that were the case, it would be possible to register a complex mark, one of the elements of which was identical with or similar to those of an earlier mark with a weak distinctive character, even where the other elements of that complex mark were still less distinctive than the common element and notwithstanding a likelihood that consumers would believe that the slight difference between the signs reflected a variation in the nature of the products or stemmed from marketing considerations and not that that difference denoted goods from different traders.”

76. Accordingly, even if the distinctive character of the earlier mark is weak, that does not preclude a finding that there is a likelihood of confusion. Weighing the various factors I come to the conclusion that, even where the level of attention paid is above average and the visual differences between the marks are noticed, effectively it is the phrase ‘THE GLASGOW DISTILLERY’ that will be seen as an indication of origin in both marks. Even if the common component, i.e. ‘THE GLASGOW DISTILLERY’ is weak in distinctiveness, the other elements of the marks, namely the words ‘PUMPHOUSE’, ‘CLYDESIDE’ and ‘Co.’, the stylisation of the letters and the device element, are even less distinctive and of little distinguishing value and their impact could be reduced through imperfect recollection. For this reason, it seems to me an inescapable conclusion that consumers will assume that the goods and services are the responsibility of the same undertaking or of undertakings with economic connections. There is a likelihood of both direct and indirect confusion. That is even in respect of the goods and services in relation to which I found that any similarity is of a low degree.

## **CONCLUSION**

77. The opposition succeeds in relation to the following goods and services:

**Class 33:** Alcoholic beverages; spirits; liqueurs; in so far as whisky and whisky based drinks are concerned such products being Scotch and/or Scotch based, all being produced in Scotland; Scotch whisky; gin.

**Class 35:** Retail services and on-line retail services connected with the sale of alcoholic beverages, spirits, whisky, gin, liqueurs.

**Class 40:** Distilling services.

**Class 41:** Education and entertainment services, all relating to the manufacture, production, sale and consumption of whisky; arranging and conducting conferences and seminars; arranging of courses of instruction for tourists; corporate hospitality (entertainment); whisky tasting services; arranging and conducting talks, tastings, conferences and exhibitions; arranging of competitions for educational, entertainment and cultural purposes; organisation of competitions and prize giving; provision of courses of instruction for tourists; cultural facilities; information and advisory services relating to the foregoing services.

**Class 43:** Restaurant and bar services; services for providing food and drink; restaurants; whisky tasting services (provision of beverages).

## **Costs**

78. Each side has achieved a roughly equal measure of success. I direct that each side should bear its own costs.

**Dated this 15<sup>th</sup> day of August 2017**

**Teresa Perks**

**For the Registrar**

**The Comptroller – General**