

O/588/20

TRADE MARKS ACT 1994

SUPPLEMENTARY DECISION

IN THE MATTER OF APPLICATION NOS. UK00003379484 AND
UK000003379488 BY SPIRIT STILL LTD
TO REGISTER THE FOLLOWING TRADE MARKS:

SPIRIT STILL

AND



(SERIES OF 2)

AS TRADE MARKS IN CLASSES 33, 35 AND 41

AND

IN THE MATTER OF CONSOLIDATED OPPOSITIONS THERETO
UNDER NOS. 417026 AND 417031 BY
TURL STREET VENTURES LTD

BACKGROUND

1. In my decision BL O/534/20, issued on 28 October 2020, I found that the opposition brought by Turl Street Ventures Ltd (“the opponent”) was successful against application nos. 3379484 (“the first application”) and 3379488 (“the second application”) by Spirit Still Ltd (“the applicant”) in respect of the majority of goods and services. However, in the course of my decision, I suggested that the term “organisation of entertainment events” in the applicant’s specifications could be amended to “organisation of entertainment events save for alcohol tasting events” in accordance with Tribunal Practice Notice 1/2012 to avoid a likelihood of confusion in respect of those services.
2. The relevant parts of my decision are reproduced below:

“69. “Organisation of entertainment events” in the applicant’s specifications is a broad service that can include the organization of various entertainment events, such as music concerts or theatre productions. It can also include events such as the tasting of whisky, whiskey or other spirits for entertainment reasons. “Entertainment services namely, whisky, whiskey and other spirit (drink) tasting services” in the opponent’s mark’s specification will fall within this broader category. Insofar as the applicant’s services will cover entertainment tasting events for whisky, whiskey or other spirits, these services will be identical under the principle outlined in *Meric*. However, in relation to services covered by the applicant’s term which are outside of the field of alcohol tasting events, I consider that the services will be dissimilar. I have given further consideration of this term in relation to the Tribunal Practice Notice [1]/2012¹ and will address this separately in my final remarks below.”

[...]

¹ <https://webarchive.nationalarchives.gov.uk/20140714074028/http://www.ipo.gov.uk/pro-types/pro-patent/p-law/p-tpn/p-tpn-2012/p-tpn-12012.htm>

115. At paragraph 69 above, I discussed the term “organisation of entertainment events” in the applicant’s specifications. While I have found these services to be identical based on the principle outlined in *Meric*, I have discussed that the applicant’s term is broad and can include organisation of entertainment events such as music concerts and theatre productions. I note that organisation of these events are entirely different from the services in the opponent’s specification. I have therefore given thought to whether the applicant’s term could be amended in accordance with the Tribunal Practice Notice 1/2012. I have concluded that the likelihood of confusion can be avoided if the applicant’s term is amended as follows: “organisation of entertainment events save for alcohol tasting events”. I therefore propose that the applicant’s specifications be amended accordingly before proceeding to registration as shown below. However, before doing so I will consider submissions from the parties.
116. Submissions on this issue must be filed within 14 days from the date of this decision. After expiration of the 14-day period, I will issue a supplemental decision whilst taking into account any submissions received. For the avoidance of doubt, the appeal period will not begin until the supplemental decision has been issued.”
3. Neither party has filed further submissions in respect of the proposed term. In the absence of any submissions from either party, I conclude that the proposed term of “organisation of entertainment events save for alcohol tasting events” in the applications’ specifications is accepted by the parties. In accordance with TPN 1/2012, the applicant does not need to amend its applications via form TM21B. The proposed amendment can, therefore, proceed to registration.

CONCLUSION

4. The amendment proposed to the applications' specifications in paragraph 115 of my decision (O/534/20) is confirmed and the applications may proceed as set out below.

The first application

5. The first application is refused in respect of the following goods and services:

Class 33: Alcoholic beverages; alcoholic cordials; alcoholic extracts; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic extracts containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; raspberry cocktails; grapefruit cocktails; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk; alcoholic cocktails in the form of chilled gelatines.

Class 35: Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials [...] alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, [...] alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, [...] alcoholic energy

drinks, alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

Class 41: Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks; education in the field of alcoholic drinks, particularly spirits; providing of training in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting and cultural activities in connection with alcoholic beverages; organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages.

6. The first application may proceed to registration for the following goods and services (as amended):

Class 33: Preparations for making alcoholic beverages

Class 35: Retail and online retail services in relation to the sale of alcoholic extracts, alcoholic extracts containing vodka and preparations for making alcoholic beverages; advertising; business management; business administration; office functions; online ordering services in the field of monthly subscription food packages; online retail store services featuring monthly subscription food packages; subscription services for the delivery of prepared and fresh food; organisation of entertainment events save for alcohol tasting events; organisation, operation, management and supervision of customer loyalty schemes; sales promotions through customer loyalty programmes (for others).

Class 41: Publishing of newsletters in relation to alcoholic and non-alcoholic beverages; organisation of entertainment events save for alcohol tasting events; publishing of reviews; publication of books on alcoholic beverages; editing of video tapes on alcoholic beverages; electronic publication of books and journals online on alcoholic beverages.

The second application

7. The second application is refused in respect of the following goods and services:

Class 33: Alcoholic beverages; alcoholic cordials; alcoholic bitters; vodka; vodka mixtures; mixed alcoholic drinks containing vodka; alcoholic beverages containing vodka; alcoholic cordials containing vodka; alcoholic bitters containing vodka; cider; gin; grappa; port; kirsch; arrack; brandy; calvados; cachaça; alcopops; arak; aperitifs; anisette; wine; red wine; white wine; rum; sake; sangria; malt whisky; sherry; schnapps; vermouth; cocktails; prepared wine cocktails; raspberry cocktails; grapefruit cocktails; alcoholic energy drinks; alcoholic energy drinks containing vodka; alcoholic beverages containing fruit and milk; alcoholic cocktails in the form of chilled gelatines.

Class 35: Retail and online retail services in relation to the sale of alcoholic beverages, alcoholic cordials, [...] alcoholic bitters, vodka, vodka mixtures, mixed alcoholic drinks containing vodka, alcoholic beverages containing vodka, alcoholic cordials containing vodka, [...] alcoholic bitters containing vodka, cider, gin, grappa, port, kirsch, arrack, brandy, calvados, cachaça, alcopops, arak, aperitifs, anisette, wine, red wine, white wine, rum, sake, sangria, malt whisky, sherry, schnapps, vermouth, cocktails, prepared wine cocktails, alcoholic cocktails in the form of chilled gelatines, raspberry cocktails, grapefruit cocktails, alcoholic energy drinks,

alcoholic energy drinks containing vodka, alcoholic beverages containing fruit and milk.

Class 41: Events relating to alcohol tastings; organising events relating to alcohol; education services relating to alcohol namely whiskey; implementation of entertainment events, with non-alcoholic cocktails and other non-alcoholic drinks, alcoholic cocktails and other alcoholic drinks; education in the field of alcoholic drinks, particularly spirits; organisation of alcohol tasting events; entertainment in connection with alcoholic beverages; sporting and cultural activities in connection with alcoholic beverages; organization of competitions (education or entertainment) on the subject of alcoholic beverages; organization of exhibitions for cultural or educational purposes on alcoholic beverages.

8. The second application may proceed to registration for the following goods and services (as amended):

Class 33: Alcoholic extracts; alcoholic extracts containing vodka; preparations for making alcoholic beverages

Class 35: Retail and online retail services in relation to the sale of alcoholic extracts, alcoholic extracts containing vodka and preparations for making alcoholic beverages; advertising; business management; business administration; office functions; online ordering services in the field of monthly subscription food packages; online retail store services featuring monthly subscription food packages; subscription services for the delivery of prepared and fresh food; organisation, operation, management and supervision of customer loyalty schemes; sales promotions through customer loyalty programmes (for others).

Class 41: Publishing of newsletters in relation to alcoholic and non-alcoholic beverages; organisation of entertainment events save for alcohol

tasting events; publishing of reviews; publication of books on alcoholic beverages; editing of video tapes on alcoholic beverages; electronic publication of books and journals online on alcoholic beverages.

COSTS

9. I will now consider the issue of costs.

10. The opponent has been successful in respect of the majority of goods and services against which the oppositions were aimed. As a result, it is entitled to a contribution towards its costs. The opponent is unrepresented and submitted a completed costs proforma to the Tribunal on 3 April 2020 outlining the number of hours spent on these proceedings.

11. I consider the time claimed for filing a notices of opposition (20.4 hours), considering the forms filed by the applicant (8.7 hours), filing its witness statement and submissions and reviewing the applicant's submissions (18.3 hours) to be high. The opponent's claim for "other expenses" is particularised as follows:

"Reviewing UK IPO documents received:	5.7 hours
Additional email and phone communications with attorney:	6.5 hours
Writing to Party B & their representative after TM7A set:	3.6 hours"

12. The activities surrounding the review of documents from the Tribunal and corresponding with the applicant's representative throughout the course of these proceedings are not costs that would be recoverable on the scale if the opponent was represented. I do not, therefore, consider that these costs are recoverable. Further, the opponent's claim for time spent seeking legal advice is not a cost that is recoverable in these proceedings. There is no legal representative on the record for the opponent and consequently, no costs can be recovered for any legal advice received.

13. I consider a costs award for the following number of hours to be reasonable:

Preparing Notice of Opposition (x2):	5 hours
Considering the forms filed by the applicant:	3 hours
Preparing evidence and written submissions:	10 hours
Reviewing the applicant's submissions:	1 hour
Total:	19 hours

14. The opponent has also claimed official fees of £200.

15. In relation to the hours expended, I note that the Litigants in Person (Costs and Expenses) Act 1975 (as amended) sets the minimum level of compensation for litigants in person in Court proceedings at £19.00 an hour. I see no reason to award anything other than this. I therefore award the opponent the sum of £361.00 (19 hours at £19 per hour) and an additional £200 for official fees, totalling **£561**.

16. I hereby order Spirit Still Ltd to pay Turl Street Ventures Ltd the sum of £561. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 24th day of November 2020

A Cooper
For the Registrar