

O-306-07

TRADE MARKS ACT 1994

**IN THE MATTER OF INTERNATIONAL REGISTRATION
No. 737715 AND A REQUEST BY LODESTAR ANSTALT
TO PROTECT THE TRADE MARK WILD GEESE
IN CLASSES 25, 32 AND 33**

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER No. 71307 BY AUSTIN NICHOLS & CO INCORPORATED
DBA PERNOD RICARD USA**

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**IN THE MATTER OF International Registration No. 737715
and a request by Lodestar Anstalt to protect the Trade Mark
WILD GEESE in Classes 25, 32 and 33**

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**IN THE MATTER OF Opposition thereto under No. 71307
by Austin Nichols & Co Incorporated dba Pernod Ricard USA**

BACKGROUND

1. On 21 June 2000 Lodestar Anstalt, on the basis of a (Benelux registration) requested protection in the United Kingdom under the terms of the Madrid Protocol for the mark WILD GEESE for the following goods:

Class 25:

Clothing, footwear, headgear.

Class 32:

Mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages.

Class 33

Whiskey; Irish whiskey; malt whiskey; whiskey based drinks in Class 33.

2. The request for protection claims a priority date of 22 December 1999.

3. The United Kingdom Trade Mark Registry considered that the request satisfied the requirements for protection in accordance with Article 3 of the Trade Marks (International Registration) Order 1996 and particulars of the international registration were published in accordance with Article 10.

4. On 9 March 2006 Austin Nichols & Co, Incorporated dba Pernod Ricard USA filed notice of opposition to the conferral of protection on this international registration. The opponent is the proprietor of registration no. 917193, WILD TURKEY, for wines, spirits (beverages) and liqueurs. This mark has a filing date of 14 November 1967 and achieved registration on 7 May 1968. It is thus both an earlier trade mark for the purposes of Section 6(1)(a) of the Act and subject to the Trade Marks (Proof of Use, etc.) Regulations 2004. In relation to the latter the notice of opposition indicated that the mark had been used on alcoholic beverages including bourbon whiskey. Objection is raised under Section 5(2)(b), 5(3) and 5(4)(a) against the goods in Class 33 of the international registration. Use is claimed since at least 1968.

5. The international registration holder (hereafter applicant for ease of reference) filed a counterstatement denying the above grounds and putting the opponent to proof of

use of the mark WILD TURKEY. Specifically the applicant admits that alcoholic beverages are identical and/or similar to “whiskey; Irish whiskey; malt whiskey; whiskey based drinks”. It denies that bourbon whiskey is identical to its own Class 33 goods and suggests that it is ‘questionable’ as to whether they are similar. In relation to the Section 5(3) case it admits that the respective goods (in so far as bourbon whiskey is concerned) can be considered dissimilar.

6. The counterstatement also contains a preview of issues that exercise the parties in the evidence rounds including the position in proceedings between the parties in other jurisdictions, the derivation of the applicant’s mark and state of the register evidence.

7. Both sides filed evidence. The matter came to be heard on 19 September 2007 when the applicant was represented by Mr Benet Brandreth of Counsel instructed by Saunders & Dolleymore and the opponent by Mr Tim Ludbrook of Counsel instructed by Withers & Rogers LLP.

Opponent’s evidence

8. Adam Tracy, the opponent’s intellectual property counsel has filed a witness statement. His evidence gives a brief history of the WILD TURKEY brand, details of his company’s trade mark registration and use in the UK, information on worldwide use and finally observations on the applicant’s mark.

9. In the early 1940s the company’s president, Thomas McCarthy, took a bottle of one of the company’s straight bourbon whiskeys to an annual wild turkey hunting trip. His guests were impressed and called for Mr McCarthy to bring it to the following year’s hunt. WILD TURKEY was subsequently introduced as a brand of bourbon whiskey in 1942 in homage to the yearly hunt for one of America’s indigenous game birds. Exhibited at AN1 and AN2 is a history of bourbon whiskey and the WILD TURKEY brand and a history of the Austin Nichols company.

10. Austin Nichols presently manufactures a range of full strength WILD TURKEY bourbon whiskeys, other alcoholic beverage products containing WILD TURKEY bourbon whiskey as an ingredient (including WILD TURKEY liqueur), as well as “ready to drink” products such as WILD TURKEY and Cola, a pre-mixed blend of WILD TURKEY bourbon whiskey and cola, and markets these products throughout the world. There is also a range of merchandised goods such as apparel, sporting equipment and drinking glasses. Exhibited at AN3 is an extract from The Book of Bourbon claiming that WILD TURKEY is “one of the best-known brands on the shelves”.

11. Exhibited at AN4 are details of the opponent’s UK registration. The mark was first used in the UK in November 1967 and products bearing the mark have been sold since that time. Sample labelling is at exhibit AN5. A range of WILD TURKEY products have been sold including bourbon and rye whiskey, premixes and liqueurs. A copy of the WILD TURKEY Worldwide Field Guide depicting examples of the range of products and dealing with brand issues is at AN6. A document aimed at training marketers, distributors and sellers about the brand is exhibited at AN7.

12. Annual sales in the UK are given as follows:

Year	Litres
2000	23,167
2001	26,880
2002	20,198
2003	37,842
2004	37,380
2005	25,049

13. The products are sold at a variety of outlets in the UK including bars, pubs, clubs and restaurants and off-premises such as liquor stores. It is sold at JD Wetherspoon's which is a leading pub chain with about 650 locations in the UK. Material from UK websites that offer the products is exhibited at AN8. Annual advertising expenditure in the UK has been approximately \$45,000 since 2000. Examples of print advertisements are given at Exhibit AN9 including from the UK publication Whisky Magazine. A feature article from the latter from 2001 is at Exhibit AN10 along with excerpts from the Whisky Magazine website (Exhibit AN11). A more recent feature, American Whiskey Special, is exhibited at AN12.

14. Exhibits AN13 and AN14 contain examples of WILD TURKEY advertisements published in internationally available publications such as Time Magazine and Newsweek in the 1970s, 1980s and 1990s along with other more specialist publications.

15. In further support of the international reputation of the brand Mr Tracy exhibits an extract from the Oxford English Dictionary acknowledging the proprietary nature of the words WILD TURKEY (AN15); information on awards won (AN16); Whisky Magazine Editor's Choice awards for the brand (AN17); a recipe containing WILD TURKEY from the BBC website (AN18); and an article from the Viewlondon.co.uk website featuring bourbon whiskeys including WILD TURKEY (AN19).

16. Mr Tracy goes on to record information on worldwide use of WILD TURKEY. Much of the information relates to periods well after the relevant date and is of tangential relevance to the UK market. Reference is made to UK citizens' exposure to the brand through international travel and encountering the mark in duty-free outlets. Excerpts from the WILD TURKEY website are exhibited at AN20 along with a list of countries where the mark is registered and used at AN21.

17. The remainder of Mr Tracy's statement consists largely of submissions. It will be sufficient for current purposes if I set out the main themes and claims which are picked up and responded to in the applicant's evidence.

18. These are:

- both marks have the word WILD as the leading element used in conjunction with the name of a bird
- both birds are types of fowl and are commonly known as 'game birds' hunted for sport

- the overall impression is derived from the marks as wholes not the separate elements
- the applicant's product would be seen as a line extension because consumers expect to see new and novel products from brand leaders
- contrary to the applicant's claim that WILD GEESE is a reference to a certain group of Irish soldiers of fortune, the labelling of its product contains images of flying birds (an internet example is at Exhibit AN22)
- bourbon whiskey and Irish whiskey are both types of whiskey and share the same channels of distribution and may be sold alongside one another
- exhibited at AN23 and AN24 are copies of decisions of the USPTO and the High Court of New Zealand finding in Austin Nichols' favour in proceedings between the parties.

19. A witness statement has also been filed by Dominic Roskrow, consultant editor to Whisky Magazine and the Managing Director of True Spirit, a spirits consultancy and writing business specialising in whiskey. He was editor of Whisky Magazine between September 2002 and September 2006 and specialises in American whiskeys.

20. He has been aware of WILD TURKEY for many years but first came across it in his professional capacity in 1991. He refers to it as an iconic brand in the UK and, with the exception of Jim Bean, the best known bourbon. He says that every professional barman in the UK would be aware of it. It is known as bourbon of the highest quality. No other bourbon uses the word WILD.

Applicant's evidence

21. The applicant has filed one witness statement and two statutory declarations in support of its case.

22. The witness statement is from Victoria Anne Cowland, a partner in the firm of Saunders & Dolleymore, the applicant's registered trade mark attorneys. Her evidence reports the findings of research she conducted to ascertain the characteristics and history of Irish whiskey and bourbon. There are eight exhibits in support of this part of her witness statement. I have read this material but do not propose to record it here. The main difference that emerges between the two products is that Irish whiskey is grain-based whereas bourbon is corn-based. There are differences too in the way the products are distilled and matured. I will consider these issues to the extent necessary when comparing the goods (below). Ms Cowland's final exhibit provides information on the wild turkey bird. I note that the range and numbers of the wild turkey decreased at the beginning of the 20th century due to hunting and loss of habitat but due to protection by game officials numbers rebounded and hunting has been legalised in 49 US States.

23. The first statutory declaration is from Stephen Anthony White, a Senior Investigator for Farncombe International. He was instructed by Saunders & Dolleymore to obtain information concerning the circulation figures for Whisky Magazine; how long WILD TURKEY brand had been available in JD Wetherspoon pubs; and how many retail outlets stock WILD TURKEY.

24. In relation to the first of these points Mr White established that Whisky Magazine was first published on 12 January 1999. He was initially told that the magazine had a UK circulation of “roughly 15000 plus”. That figure was later revised to 5000 supported by a breakdown of overall circulation of 21,250.

25. In relation to the J.D. Wetherspoon’s trade, telephone enquiries suggested that WILD TURKEY was available in at least 90% of the estate of 665 pubs. The person to whom the enquiry was directed could not be specific about the duration of the trade.

26. In relation to retail outlets, enquiries were made with Pernod Ricard UK. A lady in customer services advised that, as well as WILD TURKEY 101 proof 8 year old, the Rare Breed and the Rye were also available with these last two only being sold in specialist whisky and spirit shops and not by the pub trade. So far as the WILD TURKEY 101 proof 8 year old product was concerned the investigators were told that it was not sold in any supermarkets but was sold by a few cash and carry outlets, Oddbins, Matthew Clark (supplier to the on-trade and pub trade), Waverley, Bestway and Macro. Supplies were also sent to a mail order company and an internet sales company. The initial telephone enquiry was followed up by an e-mail to Jessica Gibbons, a Marketing Assistant. A copy of the e-mail response is included in the exhibits to Mr White’s statutory declaration. This does not appear to have yielded material new information and, not surprisingly, sales data were not disclosed.

27. Searches were also undertaken of the Oddbins, Matthew Clark and Waverley websites but without revealing any reference to WILD TURKEY. A telephone call to Tesco customer services indicated that WILD TURKEY Kentucky bourbon 70cl bottle had been discontinued in 2005 with no date of first sale given. After further checks it was found that WILD TURKEY 8 year old was available in 52 Tesco stores (out of the estate of some 1800 stores).

28. The second statutory declaration is from Kenneth David Griffin, a partner in Saunders & Dolleymore. The first part of his evidence explains that the inspiration behind the selection of the trade mark WILD GEESE stems from Irish folklore, specifically the name given to Irish soldiers of fortune. It is said that these soldiers left Ireland and went into Europe in organised units as far back as the 13th century. In approximately 1607, over 11,000 Wild Geese Soldiers left Ireland and went to France, where they joined the French army and were known as the “Irish Brigade”. The Wild Geese are said to have fought in every major conflict from the days of Louis XIV of France to the last World War, including the American Civil War.

29. In support of this Mr Griffin exhibits:

KDG1 - Copies of a selection of printouts from various websites providing a history of the WILD GEESE

KDG2 - printouts from the website of a US electronic publication which is a leading Irish history and heritage site. It is also possible to purchase merchandise from the site

KDG3 - printouts from the website of an organisation called Prince August which offers figurines of Irish Wild Geese soldiers

KDG4 - printouts from internet sites discussing two Wild Geese films from 1978 and 1985

KDG5 - examples of the applicant's packaging showing that it refers to the Wild Geese soldiers.

30. Mr Griffin goes on to deal with the opponent's claim to conceptual similarity between the marks. He exhibits at KDG6 printouts from www.birding.com website and notes that geese are classed as water fowl and turkeys as game birds. To similar effect is material at KDG7 showing that geese and turkeys possess very different characteristics and belong to different families.

31. Mr Griffin moves on to set out the position worldwide in proceedings between the parties. A schedule showing the state of play in over 20 countries is exhibited at KDG8. Oppositions by Austin Nichols have been unsuccessful in nine countries and have only succeeded so far in two (the USA and New Zealand decisions referred to in the opponent's evidence). Translations of two decisions (Singapore and Norway) are exhibited at KDG9. It is pointed out that the Norwegian decision makes it clear that 'confusion' and not 'association' is the test.

32. At exhibit KDG10 Mr Griffin gives details of UK registrations in the drinks classes to show that the opponent does not enjoy a monopoly in bird names. Also exhibited, at KDG11, is a printout showing marks in the drinks classes incorporating the prefix WILD.

33. Based on information lodged in proceedings in Hong Kong (the evidence is not itself filed) it is said that the parties appear to co-exist on trade marks registers in a large number of countries though it is acknowledged that the opponent is trying to invalidate a number of the applicant's registrations. The parties both have registrations in Ireland, details of which are at Exhibit KDG12, though again it is understood that the opponent has filed for invalidation. No instances of confusion have come to light.

34. Finally, Mr Griffin exhibits material at KDG13 to 15 to show that various GLEN prefixed marks exist on the register and are distinguishable from one another by the presence of other distinctive matter.

Opponent's evidence in reply

35. Mr Tracy has filed a further witness statement. No new documentary material has been filed. The witness statement consists primarily of submission on the applicant's evidence. To bring the picture in other jurisdictions up to date I will record that Mr Tracy says appeals have been lodged against decisions favourable to the applicant in certain countries and appeals are under consideration in others. Furthermore, it is said that the applicant's registrations in a number of countries are vulnerable as part of the opponent's central attack on the home (Benelux) registration that underpins the international registration. He also reiterates that the opponent does not seek a

monopoly in the use of marks with the name of a type of bird in respect of beverages. It is the conceptual association between the marks as wholes that is likely to give rise to confusion. Ms Cowland's evidence as to the different distillation processes of whisky and bourbon is considered irrelevant given that the products would be sold in the same retail outlets and on the same shelves.

36. That completes my review of the evidence.

Priority date and relevant date

37. As recorded above the applied for mark has a filing date of 21 June 2000 but claims an international priority date of 22 December 1999 based on a Benelux application. Mr Ludbrook suggested that it was the later of these dates that was relevant for these proceedings.

38. Section 35 provides in relevant part:

35. - (1) A person who has duly filed an application for protection of a trade mark in a Convention country (a "Convention application"), or his successor in title, has a right to priority, for the purposes of registering the same trade mark under this Act for some or all of the same goods or services, for a period of six months from the date of filing of the first such application.

(2) If the application for registration under this Act is made within that six-month period-

(a) the relevant date for the purposes of establishing which rights take precedence shall be the date of filing of the first Convention application, and

(b) the registrability of the trade mark shall not be affected by any use of the mark in the United Kingdom in the period between that date and the date of the application under this Act.

(3) Any filing which in a Convention country is equivalent to a regular national filing, under its domestic legislation or an international agreement, shall be treated as giving rise to the right of priority.

39. Section 6(1)(a) provides:-

6 - (1) In this Act an "earlier trade mark" means –

(a) a registered trade mark, international trade mark (UK), 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,

40. In the case of an international registration Article 8 of The Trade Marks (International Registration) Order 1996, SI 1996/714 provides:

8.—(1) The provisions of section 35 (claim to priority of Convention application) apply, subject as mentioned below, so as to confer a right to priority in relation to protection of an international registration designating the United Kingdom as they apply in relation to registering a trade mark under the Act.

(2) Subsection (5) of that section does not apply and the manner of claiming priority shall be determined in accordance with the Madrid Protocol and the Common Regulations.

41. The collective force of these provisions appears to me to be that I am required to take the applicant's priority claim into account, no challenge having been made to the validity of that claim. I have been referred to no authority that would support a different view of the matter.

Proof of use

42. The Trade Marks (Proof of Use, etc) Regulations 2004 apply in this case. The provision reads as follows:

“6A Raising of relative grounds in opposition proceedings in case of non-use

(1) This section applies where –

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark 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 period of five years ending with the date of publication.

(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 period of five years ending with the date of publication of the application 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 differing in elements which do not alter the distinctive character of the mark in the form in which it was registered, and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

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

(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.

(7) Nothing in this section affects –

(a) the refusal of registration on the grounds mentioned in section 3 (absolute grounds for refusal) or section 5(4) (relative grounds of refusal on the basis of an earlier right), or

(b) the making of an application for a declaration of invalidity under section 47(2) (application on relative grounds where no consent to registration).”

43. The earlier trade mark relied on by the opponent had been on the register for more than five years at the date of publication of the applied for mark (9 December 2005). The opponent was, therefore, required to make a statement of use. It claimed use in relation to “alcoholic beverages including bourbon whiskey”.

44. Mr Tracy’s evidence deals with use of the earlier trade mark. Sales figures are given (volume sales expressed in liters) for the years 2000 to 2005. The evidence supports the claim to use over that period in relation to bourbon whiskey. There is no evidence that the mark has been used in relation to alcoholic beverages at large as claimed in the statement of use (there may in any case be room for doubt as to whether that term goes wider than the goods of the registration).

45. Where, as here, a mark has been used for certain goods only within the scope of the specification it is to be treated as registered only in respect of those goods (6A(6) of the Regulations). For that purpose I need to arrive at a fair specification.

46. The Court of Appeal considered the approach to be adopted in *Thomson Holidays Ltd v Norwegian Cruise Lines Ltd*, [2003] R.P.C. 32 with *Aldous L.J.* holding that:

“29 I have no doubt that Pumfrey J. was correct to reject the approach advocated in the *Premier Brands* case. His reasoning in paras [22] and [24] of his judgment is correct. Because of s.10(2), fairness to the proprietor does not require a wide specification of goods or services nor the incentive to apply for a general description of goods and services. As Mr Bloch pointed out, to continue to allow a wide specification can impinge unfairly upon the rights of the public. Take, for instance, a registration for “motor vehicles” only used by the proprietor for motor cars. The registration would provide a right against a user of the trade mark for motor bikes under s.10(1). That might be understandable having regard to the similarity of goods. However, the vice of allowing such a wide specification becomes apparent when it is envisaged that the proprietor seeks to enforce his trade mark against use in relation to pedal cycles. His chances of success under s.10(2) would be considerably increased if the specification of goods included both motor cars and motor bicycles. That would be unfair when the only use was in relation to motor cars. In my view the court is required in the words of Jacob J. to “dig deeper”. But the crucial question is – how deep?”

30 Pumfrey J. was, I believe, correct that the starting point must be for the court to find as a fact what use has been made of the trade mark. The next task is to decide how the goods or services should be described. For example, if the trade mark has only been used in relation to a specific variety of apples, say Cox’s Orange Pippins, should the registration be for fruit, apples, eating apples, or Cox’s Orange Pippins?

31 Pumfrey J. in *Decon* suggested that the court’s task was to arrive at a fair specification of goods having regard to the use made. I agree, but the court still has the difficult task of deciding what is fair. In my view that task should be carried out so as to limit the specification so that it reflects the circumstances of the particular trade and the way that the public would perceive the use. The court, when deciding whether there is confusion under s.10(2), adopts the attitude of the average reasonably informed consumer of the products. If the test of infringement is to be applied by the court having adopted the attitude of such a person, then I believe it appropriate that the court should do the same when deciding what is the fair way to describe the use that a proprietor has made of his mark. Thus, the court should inform itself of the nature of trade and then decide how the notional consumer would describe such use.”

47. Accordingly, fairness to the proprietor does not require an overly broad specification. In deciding how to describe the use shown the tribunal must have regard to the nature of the trade and how the notional consumer would describe such use.

48. In *Reckitt Benckiser (España), SL v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)* Case T-126/03 the Court of First Instance considered how to approach the issue of use where a trade mark has been

registered for a broad category of goods that might itself contain a number of sub-categories. The Court held that:

“45 It follows from the provisions cited above that, if a trade mark has been registered for a category of goods or services which is sufficiently broad for it to be possible to identify within it a number of sub-categories capable of being viewed independently, proof that the mark has been put to genuine use in relation to a part of those goods or services affords protection, in opposition proceedings, only for the sub-category or sub-categories relating to which the goods or services for which the trade mark has actually been used belong. However, if a trade mark has been registered for goods or services defined so precisely and narrowly that it is not possible to make any significant sub-divisions within the category concerned, then the proof of genuine use of the mark for the goods or services necessarily covers the entire category for the purposes of the opposition.”

49. The earlier mark in that case was registered for a specification solely in respect of ‘polish for metals’. The Court noted that this description restricted the goods both as to function (polishing) and intended purpose (for metals) and considered that the OHIM Board of Appeal had been wrong to deem the earlier trade mark to be registered for a narrower specification of a “product for polishing metals consisting of cotton impregnated with a polishing agent (magic cotton)”. In short the sub-category of goods ‘polish for metals’ was sufficiently precise and narrowly defined.

50. Geoffrey Hobbs QC, sitting as the Appointed Person, considered these earlier authorities in *WISI Trade Mark*, [2006] R.P.C. 22 and concluded as follows:

“15... According to this approach, fair protection is to be achieved by identifying and defining not the particular examples of goods for which there has been genuine use, but the particular categories of goods they should realistically be taken to exemplify.

16 This I take to be entirely consistent with the listing process envisaged by Pumfrey J. in *Decon* and with normal trade mark practice. It is not necessary for the purposes of the Nice Agreement to refer to characteristics that may be present or absent without changing the nature, function or purpose of the specified goods. It is therefore normal for registered trade mark protection to be conferred without reference to such matters as the style or quality of the goods of interest to the proprietor of the trade mark....”

51. In this case I am satisfied that ‘bourbon whiskey’ is a fair description of the opponent’s goods. It is how the goods are described on labelling (with or without the word ‘whiskey’). It is how the opponent itself described the goods on its statement of use claim. It is how Mr Roskrow, the consultant editor of Whisky Magazine, describes it. Furthermore whisk(e)y drinkers can be expected to categorise bourbon as a distinct sub-category within the broad heading. Reference may also be made to Exhibit AN7 of Mr Tracy’s evidence where a page sub-headed ‘Let’s Talk About

Whiskey’ identifies four main sub-categories viz Irish, Scotch, Canadian and Bourbon.

Section 5(2)(b)

52. This reads:

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

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

(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.”

53. There is no disagreement as to the leading authorities and principles to be applied deriving from the following cases - *Sabel BV v Puma AG* [1998] E.T.M.R. 1, *Canon KabushikiKaisha v Metro-Goldwyn-Mayer Inc* [1999] R.P.C. 117, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* [2000] F.S.R. 77 and *Marca Mode CV v Adidas AG and Adidas Benelux BV* [2000] E.T.M.R. 723.

54. In essence I am required to consider whether there are similarities in the marks and goods which combine to create a likelihood of confusion.

The average consumer

55. The issues are to be considered from the perspective of the average consumer who is deemed to be reasonably well informed and reasonably circumspect and observant. The goods, bourbon and whiskey and whiskey based drinks may be purchased by anyone over the legal age and thus encompasses a broad swathe of the population. This end consumer group is of rather greater importance for present purposes than intermediaries (wholesalers, distributors, retailers) who will bring above-average knowledge and experience to bear. There was some debate before me in the margins as to whether the goods in question should be considered luxury items commanding greater attention in the purchasing process (the applicant’s view) or a lower level purchase that might not exercise the consumer’s attention to the same extent (the opponent’s view). I note that the opponent’s goods retails, depending on the precise product and quantity, between £20 and £30 per bottle. That, coupled with the fact that many drinkers will be making considered decisions as to type of whisky/whiskey (even down to brand level) suggests that these are goods that are likely to command at least a reasonable degree of attention.

Comparison of goods

56. To recap, the respective goods are “whiskey; Irish whiskey; malt whiskey; whiskey based drinks” on the one hand and “bourbon whiskey” on the other. The

goods of actual interest to the applicant appear to be somewhat narrower in scope focussing on Irish whiskey. However, I must consider the full notional breadth of the applied for specification. It is immediately clear that the term ‘whiskey’ if not qualified to different effect such as by the addition of ‘Irish’ must include ‘bourbon whiskey’. The latter is simply a sub-category of the broad term. To that extent identical goods are in play.

57. As to the balance of the applicant’s specification, Mr Brandreth suggested that the level of similarity was low. The well known tests for assessing similarities in goods are to be found in *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc* (supra) and *British Sugar Plc v James Robertson & Sons Limited (Treat)* [1996] R.P.C. 281. These require consideration of inter alia, nature, intended purpose, method of use, whether the goods are in competition with each other or are complementary as well as users and channels of trade.

58. Applying these considerations suggest a much closer level of similarity. The nature of the goods in broad terms, spirituous liquors, is the same though as Ms Cowland’s evidence demonstrates Irish whiskey has a very distinct content and production process that differs markedly from bourbon whiskey. However, intended purpose, method of use, users (in general terms) and channels of trade are likely to be the same. The goods do not complement one another but they are in competition in the sense that they represent alternative choices for someone wishing to purchase or consume whisk(e)y. In my view the goods in the balance of the applicant’s specification are closely similar to bourbon whiskey.

Comparison of marks

59. This is the nub of the case. The marks are WILD GEESE and WILD TURKEY. Marks are to be compared having regard to their visual, aural and conceptual characteristics, and their distinctive and dominant components. Furthermore, the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details (all from *Sabel v Puma*, paragraph 23).

60. Mr Ludbrook submitted that both marks started with the short four letter word WILD, followed in each case by the name of a bird. He noted that it is accepted that the first elements of marks are usually considered to be of particular importance. He referred me to *Deutsch v Credit Lyonnais SA* [2007] E.T.M.R. 4 as an example of the application of this principle (the marks were LION and LION EURO). Conceptual similarity was a key focal point of his submission. He characterised the marks as connoting “things wild” and “things avian”. He accepted, and indeed argued, that I must make a whole mark comparison but held to the submission advanced in his skeleton argument that WILD is the dominant element in both marks.

61. Mr Brandreth submitted that the message sent out by the marks was quite different. In his view WILD TURKEY highlighted the American nature of the product. Even without the iconography of the labelling and advertising material the wild turkey was evocative and emblematic of America. Consumers would not in his submission approach the matter on the basis of the generalised concepts (‘things wild/things avian’) advocated by Mr Ludbrook. In contrast his client’s mark evoked

the idea of Irish mercenary soldiers although he conceded that the association was not as strong and clear as the image associated with the opponent's mark.

62. As Lord Walker said in *Bud & Budwieser Budbräu Trade Marks* [2003] R.P.C. 25 (albeit in a different context) “[t]he distinctive character of a trade mark (what makes it in some degree striking and memorable) is not likely to be analysed by the average consumer, but is nevertheless capable of analysis”. It is not impermissible to deconstruct a mark to see how it works as it were providing it is always remembered that it needs to be put back together again and an overall view taken. Thus, some analysis of component elements is necessary but only to enable the Hearing Officer to put himself in the position of how the average consumer will approach the mark as a whole.

63. The first and most obvious thing to say about the marks here is that the elements require to be read together. They consist of adjective and noun combinations. The adjectives qualify the nouns (as adjectives do). It has the consequence that consumers will have no difficulty in seeing the marks as composite and meaningful expressions. It is not helpful and is in my view wrong to suggest that WILD is the dominant element in both marks. If I have understood Mr Ludbrook's argument properly part of his reason for coming to this view was because the word WILD is a 'lifestyle' word that was being played on in advertising to carry other connotations (he pointed to the outdoor imagery used in the advertising). I do not accept that the word is being used or would be seen as being used in this way. The word WILD is not an unexpected word to find associated with the name of a bird (even though the turkey is not wild in the UK). On the contrary it is a wholly usual word and idea resulting in the elements of the mark naturally hanging together. In short this is a case where no reminder is needed of the requirement for a whole mark comparison. The marks lend themselves to such an approach.

64. The visual and aural similarities and difference between the marks are plain to see and do not require elaboration on my part beyond the obvious points that both start with the word WILD. The words TURKEY and GEESE are clearly different visually and phonetically (in syllable count and pronunciation). Counsel were right to spend time on the conceptual aspect of the test for similarity. I will deal with the applied for mark first as I think the position is rather clearer. I accept that in choosing the mark the applicant was alluding to the so called Wild Geese soldiers. The labelling and packaging material at Exhibit KDG5 to Mr Griffin's statutory declaration bears testimony to the fact that anyone inspecting the packaging in detail would be alerted to the historical references. But, equally, I note that the arguably more prominent feature is the depiction of flying geese used above the words WILD GEESE. Those images serve to reinforce what for most will be the natural meaning of WILD GEESE. In any case there is a wider point here in that the application is not for packaging but for the plain words WILD GEESE. It may be that a few people will see those words alone as carrying two messages, birds and mercenary soldiers, or even simply the latter. I am not persuaded that anything like a significant number will make the historical connection. The position may be different in the Republic of Ireland but I have to consider the UK market. In my view the words WILD GEESE would be taken at face value without wider or alternative associations.

65. Turning to the earlier trade mark, WILD TURKEY, the suggestion is from the applicant that, beyond the natural meaning of the words, it is strongly evocative of America particularly when used in relation to an American product, namely bourbon. There is some evidence to this effect. It is said that Benjamin Franklin proposed the wild turkey as the national symbol of the United States of America instead of the bald eagle (see Exhibit AN6). The turkey has also long been associated with Thanksgiving Day where it is traditionally served as the main dish (again Exhibit AN6). It is also North America's largest, and one of its best known, game birds. But, the question is how much of this will have percolated through to a UK audience. It is not something that I feel sufficiently confident of to be able to take the point on judicial notice. Taking the mark at face value, therefore, I do not accept that the mark necessarily 'speaks America' to relevant UK consumers. It is true that the opponent's use does more to promote the 'Americanness' of the product but for reasons that I will elaborate on later the evidence does not allow me to evaluate the use position at the relevant date. It follows that I cannot be certain of what consumer reaction to and perception of the mark would have been at the relevant date based on the advertising and other promotional trappings associated with the brand. In short, like the applied for mark, the words will be taken purely at face value signifying a turkey that is wild as opposed to domesticated but without any automatic evocation of America.

66. Turning to my own view of the matter the points that an average consumer would be aware of or take from the marks are as follows:

- both marks consist of WILD along with the name of a bird or birds.
- TURKEY is singular whereas GEESE is plural.
- the turkey is an entirely domesticated bird in this country. Hence it is mildly unusual (but not surprising) to see it used in association with the word WILD.
- GEESE may be either wild or domesticated birds. It is not unexpected to see the word WILD used to describe GEESE.
- both are, or may be, table birds.
- the turkey is not hunted in this country (as it is in North America).
- geese are, or can be, hunted.
- geese are aquatic birds, the turkey is not.

67. I regard the above as being within the range of considerations that might be in consumers' minds. I do not suggest that individual consumers would have regard to them all. On the whole the position based on the above considerations points strongly away from rather than towards conceptual similarity.

68. It will be apparent from the obvious analysis of the visual, aural and conceptual similarities that the marks share a number of points of similarity on each account but also significant differences. I accept the applicant's position that it does not claim or

seek a monopoly in relation to WILD + [bird] combination marks and is simply objecting to this particular application for the reasons advanced by Mr Ludbrook. Nevertheless, it is a feature of its position that it requires some extrapolation from the marks themselves for consumers to fasten on to conceptual similarity. The ‘things wild’/‘things avian’ proposition seems to me to involve a somewhat artificial process of finding a common denominator that will reflect and influence consumer perception. That in turn entails a process of mental analysis that consumers are generally not credited with undertaking in their approach to trade marks.

69. Different conceptual considerations can play an important part in serving to distinguish between marks (see paragraph 54 of the CFI’s judgment in *Phillips-Van Heusen Corp v Pash Textilvertrieb und Einzelhandel GmbH*, Case T-292/01). The ECJ has also held that where conceptual dissimilarities are being relied on to counteract visual and/or aural similarities, it is necessary for one of the signs to have a clear and specific meaning so that the public is capable of grasping it immediately, Case C-361/04P *Ruiz Picasso and Others v OHIM* [2006] ECR I-0000, paragraph 20.

70. The position here is that both marks convey readily intelligible reference to birds. The average consumer is unlikely to engage in subconscious analysis and will not focus on the points of visual, aural and conceptual similarity identified above without also recognising the significant points of visual, aural and conceptual dissimilarity. My overall conclusion is that there is a low degree of similarity between the marks.

Use and distinctive character of the earlier trade mark

71. There is a greater likelihood of confusion where the earlier trade mark has a highly distinctive character either per se or because of the use made of it (*Sabel v Puma*, paragraph 24). Mr Brandreth sought to downplay the inherent distinctiveness of WILD TURKEY. In relation to bourbon whiskey it was in his submission an archetypical American bird/image used in relation to an American drink.

72. There are indeed words and images that represent or are strongly associated with the geographical provenance of goods (a Welsh dragon for goods from Wales say or a Swiss scene for Swiss chocolate). WILD TURKEY (words or image) may be in that category for North American consumers. I simply do not know. However, I am certainly not aware that WILD TURKEY is recognised in this country as an obvious piece of American iconography. The distinctiveness of the words should not be downplayed on this account. On the contrary I regard it as being a highly distinctive mark.

73. The consequence of that is that the opponent’s case is less reliant on establishing an enhanced level of distinctiveness (and hence penumbra of protection) through use. I indicated at the hearing that I did not consider the opponent’s evidence was well directed towards the relevant date for acquired distinctiveness purposes i.e. 22 December 1999 (though in reality even taking the later date of 21 June 2000 would not materially affect the position). I am not clear why there was such a long interval before the request for protection of the international registration was published for opposition purposes though it may have been because the international registration was proceeding by consent in relation to a third party registration. The upshot is that the evidence considered above in relation to proof of use is of marginal reliance only

in establishing the extent of public recognition of the mark at 22 December 1999. I can be relatively brief in stating the position as it existed at that date.

74. The main strands of Mr Ludbrook's submissions on the point were that the mark was first used in November 1967. Mr Tracy says that products have been sold under the mark "since that time" (paragraph 10 of his statement). Sales figures (in liters) are given for the years 2000 to 2005. Although there are a large number of exhibits showing labelling, advertisements in international magazines etc, he did not identify any particular exhibits that would clearly place the use in the relevant period in the UK.

75. Mr Brandreth, for the applicant, drew my attention to the differences in wording used in paragraphs 5 and 10 of Mr Tracy's witness statement. The first refers to goods being "sold continuously in commerce in the United States since May 29, 1942". The statement in relation to UK use makes no such reference to continuous use. Furthermore an e-mail exchange with a Pernod Ricard Marketing Assistant referred to WILD TURKEY being released in the UK shortly after Austin Nichols was acquired by Pernod Ricard in 1980. This latter piece of information was obtained during investigations by Farncombe International. The covert nature of the enquiry that gave rise to the statement may render it unreliable. The marketing assistant who gave the 1980 date would not have had cause to undertake full enquiries and the new owners may not have been in a position to comment authoritatively on pre-acquisition use.

76. There is, nevertheless, a fundamental problem in establishing the use position in the UK pre-December 1999. After a careful review of the evidence I have come to the view that there is insufficient material establishing use and recognition of the mark at the relevant date. The distinctive character of the mark, therefore, rests on its inherent characteristics.

77. Before going on to consider the likelihood of confusion there are two other general issues that have played a part in these proceedings both in terms of evidence and submissions and that I am being invited to factor into the decision I have to reach.

State of the register evidence

78. This is principally the material exhibited to Mr Griffin's evidence at KDG10 and 12 showing the incidence of 'bird' marks and WILD + (further element) marks in Class 33. The evidence does not deal with the extent to which (if any) all or any of these marks have been brought into use in the UK market or what the effect of such use has been on consumer perception. It was said in *British Sugar Plc v James Robertson & Son Ltd (Treat)* and has been referred to many times since that:

"Both sides invited me to have regard to the state of the Register. Some traders have registered marks consisting of or incorporating the word "treat". I do not think this assists the factual inquiry one way or the other, save perhaps to confirm that this is the sort of word in which traders would like a monopoly. In particular the state of the Register does not tell you what is actually happening out in the market and in any event one has no idea what

the circumstances were which led the Registrar to put the marks concerned on the Register.”

79. The state of the register material does not assist. Still less does the material in Exhibits KDG13 to 15 which claims to show the ‘by analogy’ position in relation to the co-existence of ‘GLEN’ marks.

Judgments in other jurisdictions

80. Both sides have pointed to outcomes favourable to their cause in various overseas jurisdictions. Mr Tracy’s evidence deals with the matter at Exhibits AN23 and 24 and Mr Griffin’s evidence deals with it in Exhibits KDG 8 and 9. Mr Tracy responded to this in his reply evidence of 27 April 2007. Mr Brandreth’s skeleton argument for the hearing dealt with three decisions/judgments, those in the Benelux, the U.S. and New Zealand, two of which stand in his client’s favour at this point in time. He invited me to note the Benelux position in particular because it is based on Directive law.

81. The general approach to decisions of other national office and courts was set out by the Appointed Person in *Zurich Private Banking*, BL O/021/04 referring to *Henkel KGaA v Deutsches Patent-und Markenamt*, Case C-218/01. Different national offices are not competent to adjudicate on the correctness of each other’s determinations and are not required to treat each other’s determinations as binding. The Appointed Person went on to say:

“That is not to say that each of them should or will simply ignore determinations of the others. The general principle is that each of them should give determinations of the others such weight (if any) as they might fairly and properly be said to bear in the decision-taking process they are required to undertake independently of one another.”

82. He added that:

“It is clearly recognised and accepted in Community Law that the meaning and significance of a designation may vary from one member state to another as a result of linguistic, cultural and social differences between their populations”.

83. I have considered the material placed before me in relation to the outcome of disputes between the parties around the world but decline to give significant weight to it for the following reasons:

- the U.S. and New Zealand decisions will have been decided under the laws of those countries. It may be that the New Zealand law was based on or followed UK law but judging from the case law quoted (Pianotist, Smith Hayden etc) it is more likely to have been the preceding UK Act.
- although it is true that the Benelux judgment is Directive based, different linguistic considerations apply and would render it unsafe to follow the finding there.

- both the New Zealand and Benelux cases may have further to run.
- the use position and hence the relative position between the parties is likely to be different in each market. For instance, Mr Brandreth drew my attention to the fact that the U.S. Trademark Trial and Appeal Board based its finding in part on the fame of the WILD TURKEY mark in that country.
- there are indications in the decisions that perception of the marks (and what they stand for) may differ, albeit subtly, from market to market. Thus, by way of example, page 26 of the US decision at AN23 indicates that both the goose and the turkey are considered to be game birds. The New Zealand Court of Appeal which reinstated the Commissioner's first instance decision notes that the contrary view of the High Court Judge was persuaded by the argument that the "contextual or idea similarity through the combination of words, conveying the idea of a wild hunted game bird, is likely to lead to confusion." I do not consider that the turkey would be thought of as a game bird in the UK so that claimed point of similarity would not run here.

84. Having given the matter careful consideration I do not propose to place reliance on the position in other jurisdictions.

Likelihood of confusion

85. This is a matter of global appreciation taking into account all relevant factors. I remind myself particularly of the interdependency principle whereby a lesser degree of similarity between the marks may be offset by a greater degree of similarity between the goods, and vice versa (*Sabel v Puma*, paragraph 22 and 24). Imperfect recollection must also be allowed for although I consider consumers will be somewhat less prone to it where marks are made up of well known words of the language. Whisk(e)y may be a regular purchase for some people and it is an area of trade where consumers often have strong brand loyalty. On the other hand, for others it may be an occasional/irregular purchase only. Allowing for identical and closely similar goods, a low degree of similarity between the marks and the high level of distinctiveness inherent in the earlier trade mark, I find that there is no likelihood of confusion.

86. It is the case that, even if there is no likelihood of direct confusion, an opponent can succeed if it can be shown that an association would be made by consumers causing them to think that goods sold under the respective marks emanate from the same or an economically linked undertaking. I can see no basis for such a finding here. There is no suggestion that the opponent uses variant forms of its word mark nor are there other circumstances that might lead consumers to think it was making itself responsible for products offered under the mark WILD GEESE. Accordingly, the opposition fails under Section 5(2)(b).

Section 5(3)

87. As amended this reads:

“(3) A trade mark which-

(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a Community trade mark or international trade mark (EC), in the European Community) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

88. A useful summary of the factors to be considered in relation to Section 5(3) can be found in *Mango Sport System S.R.L. Socio Unico Mangone Antonio Vincenzo v Diknah S.L.* [2005] E.T.M.R.5.

89. The relevant date at which the question of reputation must be assessed is the filing date of the application taking into account the priority claim (Section 6(1)(a) and see also Kerly’s Law of Trade Marks and Trade Names, Fourteenth edition at 9-104). The reputation that the opponent is required to show is set out in *General Motors Corporation v Yplon SA* [1999] E.T.M.R. 950:

“24. The public amongst which the earlier trade mark must have acquired a reputation is that concerned by that trade mark, that is to say, depending on the product or service marketed, either the public at large or a more specialised public, for example traders in a specific sector.

25. It cannot be inferred from either the letter or the spirit of Article 5(2) of the Directive that the trade mark must be known by a given percentage of the public so defined.

26. The degree of knowledge required must be considered to be reached when the earlier mark is known by a significant part of the public concerned by the products or services covered by that trade mark.

27. In examining whether this condition is fulfilled, the national court must take into consideration all the relevant facts of the case, in particular the market share held by the trade mark, the intensity, geographical extent and duration of its use, and the size of the investment made by the undertaking in promoting it.”

90. The difficulty for the opponent is in working from the generality of the claims made to a specific appreciation of the position at the relevant date in these proceedings. Although there are a substantial number of exhibits they suffer from the problem that they either relate to use outside the UK; are undated or carry dates well after the material date in these proceedings; or contain international marketing material or advertisements the impact of which in the UK market is uncertain. Mr Tracy gives sales in liters for the years 2000 to 2005. It is not unreasonable to infer

that, although these years are after the relevant date, this can be taken as the continuation of an existing trade bearing in mind also Mr Roskrow's comments. But it still leaves the precise impact of pre-December 1999 use as a matter of guess work and does not place the business into any sort of context. (For instance how significant is the sale of 20,000 + liters per annum within the whisk(e)y trade?). Even accepting that there had been sales by the relevant date there is insufficient evidence for me to be able to say that the earlier mark was known by a significant part of the public concerned. That finding is sufficient in itself to dispose of the objection under Section 5(3).

91. Beyond that, an objection under this head does not require a likelihood of confusion. The opponent is, however, required to show unfair advantage or detriment. Given the low level of similarity between the marks there is in my view no prospect of any of the adverse consequences provided for materialising even if the respective marks are used in relation to identical or closely similar goods. For all these reasons this objection also fails.

Section 5(4)(a)

92. The relevant part of the statute reads as follows:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b)

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of an “earlier right” in relation to the trade mark.”

93. The requirements for a passing off action can be summarised as being:

- (1) that the opponent's goods have acquired a goodwill or reputation in the market and are known by some distinguishing feature;
- (2) that there is a misrepresentation by the applicant (whether or not intentional) leading or likely to lead the public to believe that goods offered by the applicant are goods of the opponent; and
- (3) that the opponent has suffered or is likely to suffer damage as a result of the erroneous belief engendered by the applicant's misrepresentation.

94. In *Reef Trade Mark* [2002] R.P.C. 19 Mr Justice Pumfrey observed that:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of

reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under [s.11 of the 1938 Act](#) (see *Smith Hayden & Co. Ltd's Application (OVAX) (1946) 63 R.P.C. 97* as qualified by [BALI Trade Mark \[1969\] R.P.C. 472](#)). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28 Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

Relevant date

95. The above passage sets out the evidential burden on an opponent relying on a passing off claim and also refers to the necessity of establishing the claim at the relevant date. The Act is silent on the matter of the relevant date but Article 4.4(b) of First Council Directive 89/104 makes the position clear:

“(b) rights to a non-registered trade mark or to another sign used in the course of trade were acquired prior to the date of application for registration of the subsequent trade mark, or the date of the priority claimed for the application for registration of the subsequent trade mark and that non-registered trade mark or other sign confers on its proprietor the right to prohibit the use of a subsequent mark;”

96. In the event that an applicant is not shown to have used his mark in advance of the filing date of his trade mark application the relevant date will be the filing date.

97. Mr Ludbrook reminded me of the differences between a passing off case in the Courts as compared to one in the Registry. In the former it is the defendant's actual use that will be considered whereas in Registry proceedings it is a matter of considering notional and fair use of the mark applied for versus the earlier right. In other words I must consider what it will be open to the applicant to do within the scope of his specification and assuming normal and fair use of the mark and not just what it has done. His skeleton argument put it this way:

“..... there is a substantive difference between a tribunal determining passing off (ie making actual findings that a party enjoys goodwill under a mark, that there has been an operative misrepresentation that ‘impacts’ on that goodwill, and that damage or a threat of damage flows from those findings) and making a determination that a prospective mark, if used fairly in relation to the specification of goods applied for, would be liable (ie likely) to be prevented

by the owner of the earlier right via the law of passing off. In contrast, consideration of passing off necessitates consideration of all aspects of the defendant's trading activity."

98. It is well established that relatively small amounts of trade may be sufficient to establish a goodwill (see Wadlow's *The Law of Passing Off*, third Edition at 3-11 et seq and 8-12 et seq and the cases referred to).

99. The observations in the *Reef* case emphasise the nature of the evidence that is to be supplied and the fact that it must be directed to the relevant date if the opponent is to establish a prima facie case. For the reasons given earlier in this decision the evidence is not well directed to the relevant date in this case. I, therefore, find myself in some difficulty in assessing the opponent's goodwill. It is the sort of difficulty that the deputy judge found himself in in *Radio Taxicabs (London) Ltd v Owners Drivers Radio Taxi Services Ltd*, [2004] R.P.C. 19. He said:

"In preparing this judgment I have reflected carefully on the position in the light of all the relevant evidence, including the less specific parts (eg the largely unparticularised evidence on advertising spend) and of its limitations (eg the absence of survey or other evidence from members of the general public). Having done so I find myself still in a state of real uncertainty on the point, just as I was at the end of the trial in July. I consider it *possible* that the claimant may have built up a sufficient reputation in the ways relied, but I cannot conscientiously put it any higher in the claimant's favour than that. I am not satisfied that it is more likely than not that the claimant has done so. As is submitted in para. 3.22 of the defendant's skeleton closing, "thus one is left to speculate". Speculation is not enough. At the end of the day the burden of proving, on the balance of probabilities, the requisite reputation with the general public in the name "Radio Taxis" lies on the claimant, and I find that the claimant has not discharged it."

100. The evidence of actual trade prior to the relevant date is weak or at least poorly substantiated. There is an assertion of use from 1967 but it is not unambiguously said to have been continuous trade. The strongest argument in the opponent's favour is that the actual trade after the date is certainly suggestive of the continuation of an established trade. To that extent it should not be ignored though it must be said the opponent could have put the matter beyond peradventure by supplying details of sales, advertising expenditure, outlets, geographical spread of sales or other such indicators of trade prior to December 1999. Mr Roskrow says that he has known the brand for many years and first came across it in his professional capacity in 1991. Furthermore, he says that "every professional barman in the UK would be aware of Wild Turkey" and that "it is one of only three American whisky brands that can be ordered at a British bar by name without the need to explain what sort of drink it is". Clearly these are indications in the opponent's favour though again Mr Roskrow is writing well after the relevant date and it is not clear whether the relevant public share his view of the matter. It is with some hesitation that I find the opponent has met the first leg of the passing off test.

101. Although Mr Ludbrook rightly drew a distinction between Court proceedings and a Registry action, he accepted that the opponent still needed to show that a

misrepresentation was likely to occur. This is where the area of greatest difficulty lies for the opponent. My appraisal of the marks has left me with the clear view that the level of similarity between them is not such that the relevant public would believe that goods of the applicant offered for sale under the mark WILD GEESE would be taken to be goods of the opponent. No misrepresentation is, therefore, involved and the question of damage does not arise. The opposition fails on this final ground.

COSTS

102 . The applicant has succeeded and is entitled to a contribution towards its costs. I order the opponent to pay the applicant the sum of **£2500**. This sum is to be paid within seven days of the expiry of the appeal period or within seven days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 17th day of October 2007

M REYNOLDS
For the Registrar
the Comptroller-General