

O/062/19

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. UK00003268190 BY
INVER HOUSE DISTILLERS LTD
TO REGISTER:**

COMPANION CASK

AS A TRADE MARK IN CLASS 33

AND

**IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 411761 BY
IRISH DISTILLERS LIMITED**

BACKGROUND AND PLEADINGS

1. On 3 November 2017, Inver House Distillers Limited (“the applicant”) applied to register the trade mark **COMPANION CASK** in the UK. A priority date of 19 May 2017 is claimed. The application was published for opposition purposes on 24 November 2017. The applicant seeks to register the mark for the following goods:

Class 33 Alcoholic beverages (except beers); Scotch whisky.

2. The application was opposed by Irish Distillers Limited (“the opponent”). The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the earlier EU Trade Mark (registration no. 12955241) for the mark **CASKMATES**. The opponent relies on all goods for which the earlier mark is registered, namely:

Class 33 Distilled spirits; Whiskey; Liqueurs; Wine.

3. The opponent’s mark was applied for on 10 June 2014 and was registered on 21 October 2014. The opponent claims a priority date of 27 May 2014.

4. The opponent argues that the respective goods are identical or similar and that the marks are similar.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Marks & Clerk LLP and the applicant is represented by Sipara Limited. The opponent filed evidence in chief in the form of the witness statement of Eve-Marie Wilmann-Courteau dated 19 June 2018. The applicant filed evidence in the form of the witness statement of Malcolm Leask dated 10 October 2018. The opponent filed evidence in reply in the form of the second witness statement of Ms Wilmann-Courteau dated 6 December 2018. No hearing was requested and both parties filed written submissions in lieu. This decision is taken following a careful perusal of the papers.

EVIDENCE

Opponent's Evidence in Chief

7. As noted above, the opponent's evidence in chief consists of the witness statement of Ms Wilmann-Courteau dated 19 June 2018. The witness statement was originally accompanied by 19 exhibits, however, Exhibit EMW 8 has since been withdrawn. Ms Wilmann-Courteau is "Legal Manager, Intellectual Property" within the Group Intellectual Property Hub of Pernod Ricard SA ("Pernod"). Pernod is the ultimate parent company of the opponent¹. Ms Wilmann-Courteau confirms that she has held this position since November 2014, but has been involved with the activities of the opponent since 2009.

8. Ms Wilmann-Courteau states that the opponent is Ireland's leading supplier of spirits and wines and the producer of "the No. 1 Irish whiskey in the world²". The opponent's brands include JAMESON, as well as the CASKMATES range of premium whiskeys. The opponent's whiskeys are sold to over 130 markets around the world and it employs over 600 people.

9. The idea behind CASKMATES started in 2013, when the opponent decided to finish JAMESON whiskey in craft beer-seasoned barrels. The first edition of the CASKMATES whiskey was trialled in Ireland in 2014 and subsequently released into other markets including the UK, European Union and South Africa in 2015. A second edition was trialled in 2017 and "by June 2017, the CASKMATES range of whiskey had been sold into 40 markets and experienced 110% volume growth and 103% value sales growth³". This success was documented on the opponent's website on 31 August 2017 and on 30 November 2017⁴. Ms Wilmann-Courteau has provided examples of the CASKMATES bottles displayed in the opponent's press releases at Exhibit EMW1.

¹ Exhibit EMW18

² Witness statement of Eve-Marie Wilmann-Courteau, para. 3

³ Witness statement of Eve-Marie Wilmann-Courteau, para. 4

⁴ Exhibit EMW1.

10. Ms Wilmann-Courteau confirms that the CASKMATES range is supplied by UK supermarkets including Sainsbury's, Tesco, Waitrose, Morrisons and The Cooperative. It is also supplied by on-line retailers including Ocado, Amazon, The Whiskey Exchange and Master of Malt⁵. Exhibit EMW2 consists of screenshots from a variety of these retailers showing CASKMATES whiskey for sale, listing the price in pounds sterling. The pages are all undated save for the print dates in June 2018. Ms Wilmann-Courteau also provides a list of 11 additional UK based retailers⁶.

11. Exhibit EMW3 and Exhibit EMW4 to Ms Wilmann-Courteau's statement consist of two spreadsheets showing the number of sales of CASKMATES to customers in France (between 2016 and 2017) and in Germany (between 2016 and 2018) respectively. These show 58,756 and 89,161 bottles sold in France in 2016 and 2017 respectively, and 2,178, 4,440 and 2,112 bottles in Germany in 2016, 2017 and 2018 respectively. Exhibit EMW5 to Ms Wilmann-Courteau's statement is a list of retail and wholesale customers, as well as distributors, of the CASKMATES products in Portugal (74 businesses in total). As part of the launch in Portugal, the opponent partnered with barbershops to provide products and decoration. It also sold its products at music festivals in Portugal such as DUDE's Music Festival in 2016 to 2018 and Indie Lisboa in 2018 at which it appears CASKMATES products were sold. The opponent also used 'Movember' to promote its CASKMATES products in 2017 and 2018⁷.

12. Ms Wilmann-Courteau has provided the total volume of litres of the CASKMATES range sold from July 2015 to February 2018 in each EU Member State⁸:

Country	1/7/15- 30/6/16	1/7/17- 30/6/17	1/7/17- 28/2/18	Total (Litres)
France	0	46,307	28,259	74,566
Austria	0	0	2,868	2,868
Belgium	0	339	996	1,335
Cyprus	0	240	816	1,056

⁵ Witness statement of Eve-Marie Wilmann-Courteau, para. 6

⁶ Witness statement of Eve-Marie Wilmann-Courteau, para. 7

⁷ Exhibit EMW6

⁸ Witness statement of Eve-Marie Wilmann-Courteau, para. 10

Denmark	0	112	127	239
Finland	243	5,473	5,632	11,348
Germany	0	3,393	1,967	5,360
Greece	0	4,681	2,399	7,080
Ireland	20,194	39,265	28,273	87,732
Italy	0	0	0	0
Luxembourg	0	126	134	260
Malta	0	210	462	672
Netherlands	0	3,280	13,421	16,701
Portugal	2,408	21,244	19,715	43,367
Spain	0	0	0	0
Sweden	0	0	90	90
UK	0	9,581	23,488	33,069
Bulgaria	1,424	5,700	4,451	11,575
Croatia	0	0	0	0
Czech Republic	1,374	5,063	4,931	11,368
Estonia	0	2,460	529	2,988
Hungary	0	0	1,735	1,735
Latvia	0	1,240	1,737	2,977
Lithuania	0	1,034	837	1,870
Poland	0	1,411	24,690	26,101
Romania	0	296	546	842
Slovenia	0	0	748	748
Slovakia	0	3,956	6,075	10,032
Total	25,643	155,411	174,925	355,979

13. Exhibit EMW7 to Ms Wilmann-Courteau's statement consists of a selection of invoices issued by the opponent and by Pernod Ricard UK, which is part of the Pernod Ricard Group and responsible for wholesale business in the UK. The invoices issued by Pernod Ricard UK are dated between 19 October 2015 and 7 September 2017 and related to CASKMATES goods. These are addressed to businesses located in the UK and Poland. The invoices have been redacted and so the amounts for which they are issued are not known. The invoices issued by the opponent are dated between 9

September 2015 and 29 September 2017 and are related to CASKMATES goods. They are addressed to businesses located in the UK, Greece, Lithuania, France, Denmark, Finland and the Czech Republic. The invoices have been redacted and so the amounts for which they are issued are not known.

14. CASKMATES whiskey has been referenced in various articles between September 2015 and December 2017⁹. These articles confirm that CASKMATES won Gold in the Irish Whiskey Masters 2016 and describe CASKMATES as Market Watch Best New Spirits Brand 2016. An article dated 23 May 2017 also confirms that CASKMATES won Gold in the International Spirits Challenge.

15. Exhibit EMW10 consists of extracts from a report from the opponent's PR agency in the Netherlands dated December 2017, which provides details of promotions of CASKMATES in the Netherlands. This report states that it relates to the JAMESON brand and, although some of the pictures display CASKMATES products, it is not clear what proportion of this information relates to CASKMATES and what proportion relates to JAMESON itself. The articles displayed in the report are not in English and no translation is provided.

16. CASKMATES has won silver medal in the San Francisco World Spirits Competition 2016, International Spirits Challenge 2016 and International Wine & Spirits Competition 2016. It also won gold medal in the Irish Spirits Masters 2016. It won silver medal in the International Wine & Spirits Competition 2017 and The Irish Spirits Masters 2017. It also won gold medal in the San Francisco World Spirit Competition 2017 and International Spirits Challenge 2017¹⁰. Ms Wilmann-Courteau states that all of these awards were won in or prior to November 2017¹¹. CASKMATES has also been scored highly in the Ultimate Spirits Challenge (a competition based in the USA) in 2016 and 2017¹². Ms Wilmann-Courteau states that the results of this competition and the San Francisco World Spirits Competition, although based in the USA, can be featured in publications in the UK and EU. CASKMATES also received a high rating

⁹ Exhibit EMW9

¹⁰ Exhibit EMW11

¹¹ Witness statement of Eve-Marie Wilmann-Courteau, para. 15

¹² Witness statement of Eve-Marie Wilmann-Courteau, para. 16 and EMW12

in the Whiskey Bible which is a publication sold in the UK¹³. Exhibit EMW13 provides information about this 2017 award, although the exhibit is not dated.

17. Exhibits EMW14 to EMW17 provide further information about the awards won. Of note, the Spirits Business (which runs the Irish Whiskey Masters) publish the results on their website¹⁴. The website is viewed by over 300,000 unique viewers each month and Europe accounts for 40% of these figures¹⁵.

18. Exhibit EMW19 consists of extracts from dictionaries which provide definitions for the words CASK, MATES and COMPANION, specifically:

a) Oxford English Dictionary states that the word MATE in informal language is “a friend or companion”.

b) Oxford English Dictionary states that the word CASK means “a large container like a barrel, made of wood, metal or plastic and used for storing liquids, typically alcoholic drinks”.

c) Cambridge English Dictionary states that the word COMPANION means “a person you spend a lot of time with often because you are friends or because you are travelling together”.

Applicant’s Evidence

19. The applicant’s evidence consists of the witness statement of Malcolm Leask dated 10 October 2018, with 4 exhibits. Mr Leask is the Vice President of Sales for the applicant; a position he has held since June 2016. He has previously been employed by the applicant since 1994 in the roles of Regional Sales Director, Sales & Marketing Director and Vice President Sales, UK & International.

20. Mr Leask states:

¹³ Witness statement of Eve-Marie Wilmann-Courteau, para. 17

¹⁴ Exhibit EMW16

¹⁵ Witness statement of Eve-Marie Wilmann-Courteau, para. 21

“5. The word ‘CASK’ is widely used in the context of alcoholic beverages, particularly certain spirits, where maturation generally takes place in wooden casks. Indeed, **Regulation (EC) No 110/2008 Annex II Part 2** states that *“whisky or whiskey is a spirit drink produced exclusively by... the maturation of the final distillate for at least three years in wooden casks.”* Therefore the word by itself represents a common description of the process in which various whisky/whiskey products are produced.” (original emphasis)

21. Mr Leask states that the COMPANION CASK mark was first used by the applicant in relation to its SPEYBURN range of whisky in or around May 2017 and has been used by the applicant ever since. Exhibit 1 shows an example of the product packaging used on the applicant’s COMPANION CASK product. The use of the word companion is intended to celebrate the long tradition of SPEYBURN whisky being aged in Kentucky Bourbon whisky casks and the relationship with Kentucky distillers¹⁶.

22. Mr Leask states that there are various trade marks registered in class 33 which use the word CASK as part of a composite mark and provides examples of these both in his statement and at Exhibit 2. Mr Leask goes on to state:

“8.... The relevant consumer of the JAMESON CASKMATES range is likely to be already aware of the renowned JAMESON Irish whiskey and will see the CASKMATES editions as interesting variations of the basic product.

9. Whisky and Whiskey drinkers are a discerning customer base. They are likely to know and appreciate the differences between Irish whiskey and Scotch whisky. As far as I know, no whisky producers offer Irish whiskey and Scotch whisky under the same trade marks. It is unlikely that actual or potential customers will confuse the JAMESON CASKMATES Irish whiskey range with the SPEYBURN COMPANION CASK Scotch whisky range.”

¹⁶ Witness statement of Malcolm Leask, para. 7

23. Mr Leask notes that there is a “significant increase” in price between standard JAMESON whiskey and CASKMATES whiskey. JAMESON is sold at around £17 whereas the price of CASKMATES ranges from €38 to £49.99¹⁷. Mr Leask states that this increase in price will lead to consumers paying more attention to the conflicting marks before making their purchase¹⁸.

24. The words MATE and COMPANION have different meanings as the word MATE is far more colloquial whereas the word COMPANION is more formal¹⁹. Exhibit 4 consists of extracts from the Oxford Dictionary and Mr Leask refers to the following definitions:

a) MATE – “used as a friendly form of address between men or boys”.

b) COMPANION – “each a pair of things intended to complement or match each other”.

c) COMPANION – “a person or animal with whom one spends a lot of time or with whom one travels”.

25. The applicant filed written submissions in lieu of a hearing and, whilst I do not propose to reproduce those here, I have taken them into account and will refer to them below where appropriate.

Opponent’s Evidence in Reply

26. The opponent’s evidence in reply consists of the second witness statement of Ms Wilmann-Courteau dated 6 December 2018, with three exhibits.

27. Ms Wilmann-Courteau disputes Mr Leask’s contention that the word CASK is widely used in relation to alcoholic beverages and argues that this is

¹⁷ Exhibit 3 to Mr Leask’s statement

¹⁸ Witness statement of Malcolm Leask, para. 10

¹⁹ Witness statement of Malcolm Leask, para. 11

unsubstantiated²⁰. It is disputed that the word CASK is descriptive of the process in which whiskey/whisky is made as this is a complex process which involves much more than just the process of aging the spirit in casks. It is also not descriptive of the product itself. Ms Wilmann-Courteau accepts that the term CASK may not have a high level of distinctiveness in respect of alcoholic beverages but argues that this does not mean that it has no distinctive character at all²¹.

28. Ms Wilmann-Courteau states:

“8.... I am advised by our trade mark attorneys that the existence of a handful of marks which include CASK as the latter part of the mark do not satisfactorily establish that rights in CASK have been diluted without sufficient evidence that the marks are in use in the market place and have established a significant level of recognition on the part of the relevant consumer. The Applicant has failed to establish this in the evidence.”

29. There are no other trade marks which comprise of or wholly contain CASKMATES in class 33²². Mr Leask's claim that the mark will not be referred to independently of the JAMESON mark is disputed²³ and Ms Wilmann-Courteau refers to Exhibit EMW9 as evidence of the CASKMATES mark being referred to independently of the JAMESON mark.

30. The price of CASKMATES products is approximately £25 and the price of JAMESON whiskey varies from around £17 to £30. The COMPANION CASK products are available for \$39.99²⁴. Ms Wilmann-Courteau states that, taking into account the conversion rate, this equates to approximately £30²⁵. There are other whiskey products which cost in excess of £700 and it is therefore disputed that more attention

²⁰ Second witness statement of Eve-Marie Wilmann-Courteau, para. 5

²¹ Second witness statement of Eve-Marie Wilmann-Courteau, para. 6

²² Exhibit EMW20

²³ Second witness statement of Ms Wilmann-Courteau, para. 11

²⁴ Exhibit EMW21

²⁵ Second witness statement of Ms Wilmann-Courteau, para. 12

will be paid when purchasing the parties' respective goods²⁶. Ms Wilmann-Courteau claims that a normal degree of attention will be paid during the purchasing process²⁷.

31. The definitions provided by Mr Leask for the meaning of the words MATE and COMPANION do not show the full range of results. Exhibit EMW22 shows extracts also taken from the Oxford English dictionary which provide as follows:

a) MATE – “A friend or companion”.

b) COMPANION – “A person or animal with whom one spends a lot of time”.

32. The opponent filed written submissions in lieu of a hearing and, whilst I do not propose to reproduce those here, I have taken them into account and will refer to them below where appropriate.

PRELIMINARY ISSUES

33. In evidence, the applicant made various references to other trade marks already on the register which contain the word CASK. In *Zero Industry Srl v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-400/06, the General Court (“GC”) stated that:

“73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word ‘zero’, it should be pointed out that the Opposition Division found, in that regard, that ‘... there are no indications as to how many of such trade marks are effectively used in the market’. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word ‘zero’ is not enough to establish that the distinctive character of that element

²⁶ Second witness statement of Ms Wilmann-Courteau, para. 12

²⁷ Second witness statement of Ms Wilmann-Courteau, para. 13

has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71).”

34. In *British Sugar Plc v James Robertson & Sons Ltd* [1996], RPC 281, Mr Justice Jacob said:

“Both sides invite 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. It has long been held under the old Act that comparison with other marks on the register is on principle irrelevant when considering a particular mark tendered for registration, see eg *Madam Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence.

35. The existence of other trade marks on the register is, therefore, not relevant to the decision I must make.

36. Similarly, the applicant refers to use of the marks in combination with other words (JAMESON in the case of the opponent and SPEYBURN in the case of the applicant) and submits that this will assist in distinguishing between the marks. However, my assessment must take into account only the applied-for mark and any potential conflict with the earlier trade mark²⁸. The way in which the marks are presented in practice is irrelevant unless those differences are apparent from the applied-for and earlier marks. I do not, therefore, consider that these arguments are of assistance to the applicant.

²⁸ *O2 Holdings Limited, O2 (UK) Limited v Hutchinson 3G UK Limited*, Case C-533/06

DECISION

37. Section 5(2)(b) of the Act reads as follows:

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

(a)...

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

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

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

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

(a) a registered trade mark, 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) References 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 subsection (1)(a) or (b) subject to its being so registered.”

39. The trade mark upon which the opponent relies qualifies as an earlier trade mark under the above provisions. As this trade mark had not completed its registration process more than 5 years before the publication date for the application in issue in

these proceedings, it is not subject to proof of use pursuant to section 6A of the Act. The opponent can, therefore, rely upon all of the goods it has identified.

Section 5(2)(b) – case law

40. 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.

The principles:

(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 to mind the earlier mark, 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 will wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

41. The competing goods are as follows:

Opponent's goods	Applicant's goods
<u>Class 33</u> Distilled spirits; Whiskey; Liqueurs; Wine.	<u>Class 33</u> Alcoholic beverages (except beers); Scotch whisky.

42. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the GC stated that:

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

43. I have lengthy submissions from both parties on the similarity of the goods. Whilst I do not propose to reproduce those here, I have taken them into account in reaching my decision.

44. “Distilled spirits”, “whiskey”, “liqueurs” and “wine” in the opponent’s specification all fall within the broader category of “alcoholic beverages (except beers)” in the applicant’s specification. “Scotch whisky” in the applicant’s specification will fall within the broader category of “distilled spirits” in the opponent’s specification. These goods can, therefore, be considered identical on the principle outlined in *Meric*.

The average consumer and the nature of the purchasing act

45. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties’ goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J 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.”

46. In its written submissions in lieu, the applicant states:

“24.... The Applicant submits that the relevant consumer in relation to the goods applied for is the adult general public and specialised business customers with special professional knowledge or expertise. As held by *Speciality Drinks v EUIPO (Case T-250/15 Speciality Drinks Ltd v European Union Intellectual Property Office (2016))*,

“certain categories of Scotch whisky can, due to their rarity or high price, target a limited number of connoisseurs or even collectors who would show a high degree of attention”.

25. There is a significant increase in price between entry level JAMESON whiskey and the premium CASKMATES editions... This premium pricing will constitute an important factor in a consumer’s decision to buy a particular whisky/whiskey making it likely they will pay a high degree of attention to the conflicting marks before making their final purchasing decision.

26. It is submitted that the Opponent’s CASKMATES whiskey is a premium product exclusively targeted at a specific category of consumers. The Opponent’s evidence explains that the produce is aged in beer barrels/casks. The type of cask in which whisky is aged has an important effect on its final taste. Although most Scotch whisky is still aged in American Bourbon casks, there is also widespread use of sherry, port, beer or red wine casks. The relevant consumer is likely to pay a high degree of attention to ensure they purchase a product which has been finished in a cask that produces their desired taste. It is therefore highly unlikely that a consumer would mistakenly choose one party’s goods over the other’s.”

47. In its written submissions in lieu, the opponent states:

49. The Applicant has alleged that there is a significant increase in price between the JAMESON entry level whiskey and the CASKMATES edition. This is disputed by the Opponent and evidence to the contrary has been provided in the second Witness Statement of Eve-Marie Wilmann-Courteau at Exhibit EMW-21. As established by the evidence, the Opponent and the Applicant's respective products are sold at similar price points (albeit that the Applicant's product does not appear to be available for sale in the UK to-date and no evidence of such has been filed by the Applicant... Consequently, the level of attention paid by the relevant consumer, namely the general public over the age of 18 and business customers is likely to be average. The average consumer would not be limited to whisky/whiskey connoisseurs but would also include novices drawn to the produce on account of the new variety of whisky/whiskey products under the respective brands.

[...]

51. The Earlier Goods are ordered orally or visually in bars, restaurants and retail stores, amongst others. Taking into account the similar prices of the respective parties' product, the relevant consumer and imperfect recollection, the likelihood that a consumer could select the Applicant's product believing it to be the Opponent's product or a sub-brand thereof is increased. In the context of bars and restaurants, at the point of sale, there is typically an increased noise factors and pressure to order quickly. Accordingly, phonetic differences between the marks may have less of an impact. The Opponent's goods are of a high quality band are intended to provide the consumer with a drinking experience and as such the conceptual meaning of the mark has an even greater role to play in the assessment of the similarity of the marks. In such a scenario, there is a real likelihood that a consumer will confuse the Applicant's goods with those of the Opponent given the conceptual identity, particularly since it is the unique and distinctive concept of the mark in the context of the goods covered that will create a lasting and memorable impression on the relevant consumer."

48. Both parties have made reference to the price and type of the products sold under their respective trade marks. However, as noted above, it is the marks as registered and their respective specifications which are relevant to the decision I must make. The differing price points (or not as the case may be) are not relevant. The specifications for which the parties' marks are applied for/registered cover the full range of prices from the very low to the very high. Similarly, they would cover a wide range of types of beverages, produced through a variety of methods. It is in this context that the average consumer must be identified not in the context of the specific products sold by each party. I will, therefore, disregard the parties' arguments in so far as they relate to this point.

49. The average consumer for the goods will be a member of the general public who is over the legal drinking age of 18. I acknowledge that such goods may also be purchased by businesses for the purposes of selling them on to paying customers. I recognise that there will be some goods that fall within these broader categories that are particularly expensive and that will be purchased by connoisseurs of the products. However, that is not the average transaction upon which my assessment must focus. There will be various factors taken into consideration in deciding which goods to purchase such as price, flavour, age and quality. I therefore consider that an average degree of attention will be paid during the purchasing process.

50. The goods are, in my experience, most likely to be obtained by self-selection from the shelves of a retail outlet or from an online or catalogue equivalent. I acknowledge that verbal advice may be sought from a sales assistant or representative. Alternatively, the goods may be purchased in bars or restaurants. I note the opponent's argument (set out in its Notice of Opposition) that in these circumstances, aural differences between the marks have less of an impact because orders will be placed in noisy environments such as bars or cafes. However, even in these circumstances, orders are likely to be placed following perusal of a drinks/wine list or following perusal of the products themselves on a shelf behind a bar. Consequently, visual considerations will dominate the selection process, although I do not discount that there will also be an aural component to the purchase of the goods.

Comparison of trade marks

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

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

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

53. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
CASKMATES	COMPANION CASK

54. I have lengthy submissions from the parties on the similarity of the marks which I do not propose to reproduce here. However, I have taken them all into account in reaching my decision.

55. The opponent's mark consists of the 9-letter conjoined words CASKMATES. Whilst this will be recognised by consumers as being made up of the two ordinary dictionary words CASK and MATES, the overall impression of the mark lies in the combination of the words to create a unit. The applicant's mark consists of the 9-letter word COMPANION followed by the 4-letter word CASK. I consider that the overall impression of the mark is as a unit.

56. Visually, both marks contain the 4-letter ordinary dictionary word CASK. However, this appears at the start of the opponent's mark and at the end of the applicant's mark. In the opponent's mark the word CASK is conjoined with the ordinary dictionary word MATES and in the applicant's mark it is preceded by the ordinary dictionary word COMPANION. As a general rule, the beginnings of marks tend to make more of an impact than the ends²⁹. The conjoining of the words in the opponent's mark gives the visual impression of a single word, whereas the applicant's mark consists of two separate words. Whilst I recognise that there is some visual similarity created by the presence of the common word CASK in both marks, there are clearly significant differences. In my view, there is a low degree of visual similarity between the marks.

57. Aurally, the opponent's mark consists of two one-syllable words – CASK and MATES – which will be given their ordinary English pronunciation. The applicant's mark consists of four syllables – COM-PAN-YUN-CASK. The first syllable in the opponent's mark and the last syllable in the applicant's mark will be pronounced identically. However, the rest of the marks will be pronounced entirely differently. In my view, there is a low degree of aural similarity between the marks.

58. Conceptually, the word CASK itself will be given an identical meaning in both marks. That is, a barrel or container of some kind. Consumers are likely to recognise this as something that is used during the production process for different types of alcohol but, even if they do not, this will be the same for both marks. In my view, the words MATES and COMPANION clearly share some degree of similarity in meaning as they both refer to individuals who would be considered as friends (albeit the word MATES is more of a casual term and the word COMPANION is more of a formal term).

²⁹ *El Corte Ingles, SA v OHIM* Cases T-183/02 and T184/02

However, it is not the meaning conveyed by the individual words within the marks which is relevant for the purposes of this comparison, but the meaning conveyed by the marks as a whole. Neither mark as a whole conveys a meaning which is immediately clear. The words CASKMATES in the opponent's mark may be considered to be referring to two or more individuals (such as in the words playmates or classmates). The words COMPANION CASK in the applicant's mark may be considered to refer to the cask itself. However, the exact meanings of the marks are not obvious. If no clear meaning is identified by the average consumer then the marks will be conceptually neutral. If the average consumer does identify a meaning then the marks will be conceptually similar to a low degree.

Distinctive character of the earlier trade mark

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

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in *Joined Cases C-108/97 and C-109/97 Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in 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).”

60. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities.

61. I have lengthy submissions from the parties on the distinctive character of the earlier mark and, whilst I do not propose to reproduce those here, I have taken them into account in reaching my decision.

62. The opponent claims that the distinctiveness of its mark has been enhanced through use. This is denied by the applicant. The relevant market for assessing enhanced distinctiveness is the UK market. The opponent has provided evidence to show that its goods are widely available in the UK from both supermarkets and online retailers. The opponent has provided examples of invoices which have been issued to UK customers prior to the relevant date, however as these have been redacted it is not clear how much these invoices are for. Ms Wilmann-Courteau confirmed that in the UK, 9,581 litres of CASKMATES were sold between June 2016 and July 2017 and 23,488 litres were sold between July 2017 and February 2018. However, as the priority date claimed by the applicant is 19 May 2017, the sales that fall after that date do not assist the opponent in demonstrating enhanced distinctiveness. The majority of these sales fall after the relevant date. The evidence shows that CASKMATES had won a number of awards prior to the relevant date. However, it appears that these were voted for by industry experts rather than member of the general public (albeit the results were published in articles that were publicly available). In particular, the opponent notes that the results of the Irish Whiskey Masters are published on the Spirits Business website which has 300,000 unique viewers each month, 40% of which are from Europe. However, it is not clear what percentage of these visitors are from the UK. In my view, the level of sales shown for the UK prior to the relevant date are relatively low given the size of the market in question. No indication of market share has been provided. Notwithstanding the awards won by the opponent and the references to the mark in publications, I do not consider that the evidence is sufficient

to demonstrate that the opponent's mark had been enhanced through use by the relevant date in relation to the UK market.

63. I can, therefore, only consider the inherent distinctiveness of the earlier mark. The opponent's mark consists of the two ordinary dictionary words CASK and MATES which have been conjoined. The word CASK cannot be described as descriptive of the goods for which the mark is registered. It is allusive as casks will be used during the production process for a variety of alcoholic drinks. However, I must consider the inherent distinctiveness of the earlier mark as a whole and the distinctiveness of the mark lies in the conjoining of the word CASK with the word MATES. In my view, the earlier mark has a medium degree of inherent distinctive character.

64. For the avoidance of doubt, if I am wrong in my finding that the distinctiveness of the opponent's mark has been enhanced through use, then it would only have been enhanced to a moderate degree.

Likelihood of confusion

65. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and services and vice versa. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the opponent's trade mark, the average consumer of the goods and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.

66. I have found the marks to be visually and aurally similar to a low degree. I have found the marks to be either conceptually neutral or conceptually similar to a low degree. I have found the opponent's mark to have a medium degree of inherent distinctive character. I have identified the average consumer to be a member of the general public who is over 18 or business users who will select the goods primarily by visual means (although I do not discount an aural component). I have concluded that the level of attention paid during the purchasing process will be average. I have found the parties' goods to be identical.

67. In my view, notwithstanding the principle of imperfect recollection, even if there is a degree of conceptual similarity between the marks the visual and aural differences are sufficient to avoid the marks being misremembered as each other. This is particularly the case given that visual considerations will dominate the selection process and an average degree of attention will be paid by the average consumer. I do not, therefore, consider that there is a likelihood of direct confusion.

68. I will now consider whether there is a likelihood of indirect confusion. Indirect confusion was described in the following terms by 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.”

69. In *Duebros Limited v Heirler Cenovis GmbH*, BL O/547/17, Mr James Mellor Q.C., sitting as the Appointed Person, stressed that a finding of indirect confusion should not be made merely because the two marks share a common element. He pointed out that it is not sufficient that a mark merely calls to mind another mark. This is mere association not indirect confusion.

70. In its written submissions, the opponent states:

“54.... As can be seen from the evidence, the Opponent already has two existing products in the CASKMATES range of whiskey. It is therefore quite conceivable that identical goods sold under the Contested Mark could be perceived as a further edition in the Opponent’s CASKMATES range of whiskey.”

71. I disagree. As noted above, the distinctive character of the opponent’s mark lies in the conjoining of the words CASK and MATES. Indeed, the evidence shows that the different products sold by the opponent as part of the CASKMATES range use the word CASKMATES in combination with additional matter, not a different mark entirely. The word CASK is allusive of the goods for which the mark is registered and cannot be considered to have distinctive significance independent from the whole³⁰. Bearing in mind my conclusions summarised at paragraph 66 above, there is no reason, in my view, why the average consumer would assume that the marks come from the same or economically linked undertakings. At best, the later mark might call to mind the earlier mark. I am, therefore, satisfied that there is no likelihood of indirect confusion.

72. For the avoidance of doubt, my decision would have been the same even if the distinctiveness of the opponent’s mark has been enhanced through use to a moderate degree.

³⁰ *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch)

CONCLUSION

73. The opposition has been unsuccessful and the application will proceed to registration.

COSTS

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

Providing a statement and considering the opponent's statement	£250
Preparing evidence and considering the opponent's evidence	£500
Preparing written submissions in lieu of a hearing	£300
Total	£1,050

75. I therefore order Irish Distillers Limited to pay Inver House Distillers Limited the sum of £1,050. This sum should be paid within 14 days of the expiry of the appeal period or, if there is an appeal, within 14 days of the conclusion of the appeal proceedings.

29th January 2019

S WILSON

For the Registrar