

BL O/644/20

TRADE MARKS ACT 1994

IN THE MATTER OF TRADE MARK REGISTRATION 3367402
IN THE NAME OF DAVID HOLLIDAY LIMITED
OF THE FOLLOWING TRADE MARK IN CLASS 32:

Jackalope

AND

AN APPLICATION FOR INVALIDATION UNDER NO. 502793

BY

GREEN JACK BREWING CO. LTD

BACKGROUND AND PLEADINGS

1. On 16 January 2019 David Holliday Limited (the proprietor) applied for the trade mark shown on the cover page of this decision. It was subsequently registered on 26 April 2019 for:

Class 32

Beer; Beers; Malt beer; Beer wort; Wheat beer; Flavored beer; Black beer; Imitation beer; Craft beer; Saison beer; Bock beer; Flavoured beers; Flavored beers; Craft beers; Black beer [toasted-malt beer]; Coffee-flavored beer; Beer-based cocktails; Barley wine [beer]; Low-alcohol beer; Low alcohol beer; De-alcoholized beer; Non-alcoholic beer; De-alcoholised beer; Beer-based beverages; Barley wine [Beer]; Ginger beer; Root beer; Root beers; Root beers, non-alcoholic beverages; Hop extracts for manufacturing beer; Hops (Extracts of -) for making beer; Extracts of hops for making beer; Lager; Lagers.

2. Green Jack Brewing Co. Ltd (the applicant) seeks invalidation of the registration under the provisions of section 47 of the Trade Marks Act 1994 (the Act). It does so on grounds under section 5(4)(a) of the Act. In summary the grounds are that the proprietor's use of the mark for identical or related goods in class 32 amounts to passing off. The registration is the word 'Jackalope' which is identical to the applicant's unregistered sign 'JACKALOPE' used by the applicant since 2016 in respect of beers.

3. The proprietor filed a counterstatement denying the grounds raised by the applicant.

4. Both parties filed evidence. The applicant filed written submissions in lieu of attendance at a hearing. The proprietor filed a skeleton argument. A hearing took place by video at which the proprietor was represented by Mr Jan-Caspar Rebling of Stobbs IP. The applicant did not attend.

5. Both sides seek an award of costs.

THE EVIDENCE

Applicant's evidence

Witness statement by Timothy Richard Dunford with exhibits TD1 – TD14

6. Mr Dunford is the founder and current Director of Green Jack Brewing Company (the applicant). His statement is dated 11 February 2020. He submits that the applicant is a real ale brewery, based in Lowestoft in Suffolk, which was founded in 1993.

7. Mr Dunford submits that the applicant, “has grown to be one of the largest real ale breweries in East Anglia” and points to more than one hundred awards won by its beers both regionally and nationally.¹ The earliest award listed is for a beer named ‘Ripper’ which won gold in the barley wine category at Peterborough in 1996. Since that date, awards are shown every year up to and including 2019, in respect of fifteen different beers.

8. With regard to the signs JACKALOPE and JACK-ALOPE, Mr Dunford states:

“7. My Company has used the marks JACKALOPE and JACK-ALOPE in relation to a particular variety of our ale. The ale was originally named 'JACK-ALOPE' in terms of how it was presented to end-consumers, as a play on words in combination with my Company's name - i.e. GREEN JACK-ALOPE. The ale was also originally launched as a new variation sold alongside our already established standard Golden Best ale, in order to help generate interest in it straight away. Further, our Golden Best ale won the SIBA East of England 2012 award for Standard Bitters, and so our launch of JACK-ALOPE as a new variation had an immediate impact on consumers

¹ See exhibit TD1.

8. As the ale became more established and popular, we evolved the branding to the standalone name JACKALOPE, emphasising the ale as a standalone product in its own right.”

9. He states that the first products bearing the JACK-ALOPE mark were made available in April 2016, specifically to the Star Inn and Triangle Tavern, located in Suffolk and Lowestoft respectively. In May 2016 the applicant sold the beer to Folk East Production Limited in preparation for the 2016 Folk East Festival in August of that year. The festival began in 2012 and had approximately 3000 attendees per day. Since then it has occurred annually in August. The festival listing for 2019 puts the attendees at 10,000 per day for the August folk festival which happens across four days in August and attracts internationally renowned folk artists, to seven different stages.²

10. He says:

“14. Preparation for the launch of our product obviously took place before April 2016 - including planning, testing, and promotion of the product to Star Inn, Triangle Tavern, and the Folk East Festival. Above and beyond consumers being able to purchase the ale in those locations in April-August 2016, we also started our consumer-facing marketing campaign at the same time, comprising of pump clips that consumers would be faced with each time they purchased our products (in order to help our branding start resonating with them) and beer mats bearing our JACK-ALOPE branding.”

11. At paragraph 16 of his statement, Mr Dunford submits that beer mats were ordered with the intention of giving them away to customers. An invoice with a due date of 3 June 2016 shows an order of 20,000 beer mats, which Mr Dunford states showed the following:³

² See exhibits TD20 and TD21.

³ See exhibits TD6 and TD7.



12. Mr Dunford provides the following figures which he describes as ‘sales of ale bearing the Jackalope brand’:

Year:	Sales:
2016	£14,552.10
2017	£24,322.16
2018	£36,061.06
2019	£42,141.53

13. He has provided what he describes as a ‘representative, but non-exhaustive, selection of sales invoices’ showing sales of the applicant’s products bearing the ‘Jackalope’ name.⁴ The 43 invoices (up to the relevant date) are dated between 4 April 2016 and 14 January 2019. They show sales of ‘Jackalope’ ranging from £71.75 to £2900.75. Mr Dunford states that the branding was always presented to wholesale customers as ‘Jackalope’. The majority of the invoices describe the product as ‘Jackalope 3.8%’. A few describe it as ‘Jackalope 18 gallons’ and one of the invoices, dated 16 August 2018, shows both descriptions on the same invoice, with two different prices given. Sales have been made to three different public houses (in Lowestoft and Suffolk) and annually to a branch of the Green Party and the Folk East festival.

14. Mr Dunford states that sales for the 2016/17 and 2017/18 Folk East festivals totalled 8,496 pints amounting to £25,488 retail price to customers.⁵

⁴ See exhibit TD9.

⁵ See paragraph 24 of Mr Dunford’s first witness statement.

15. Mr Dunford provides a print of a page taken from *UNTAPPD* which contains reviews of its beer between 18 August 2016 and 23 August 2016.⁶ In each case the person's username is followed by, '*...is drinking a Green Jackalope by Green Jack brewing company*'. Four of the reviews provide a tagged location, one being 'Folk East' and three being 'Glemham Hall' (which was confirmed at the hearing as one of the venues for the Folk East Festival).

16. The applicant has provided what it describes as examples of how the brand has been used.⁷ Included are examples of two different pump clips, though they are not dated and it is not clear when the style was changed. They are shown as follows:



17. I will refer to these as 'pump clip 1' and 'pump clip 2', throughout the decision.

18. A print from the applicant's Twitter page shows a tweet dated 18 May 2017 and titled, '@FolkEast launch party – just a few pictures from the press launch!'. The image shows a beer pump with pump clip 1 displayed on the front. The final page of the exhibit is a list of beers which were made available at The Cobbold Arms during Folk East 2018. The sixteen beers are listed in alphabetical order, with the brewery

⁶ See exhibit TD4.

⁷ See exhibit TD7.

presented in the first column and the beer in the second. The tenth on the list is by Green Jack and is described as Green Jackalope. The list looks to have been taken from a *Twitter* page, though no date is shown.

19. Mr Dunford submits that as well as its own sales and marketing, the applicant has been promoted by third party reviews, articles and promotion.⁸ Examples are provided which include a tweet from The Hop Inn bar team at the Folk East Festival 2017 which shows a pint of beer being poured from a tap, with a pump clip behind it which is the same as pump clip 1, shown above.⁹

20. A further tweet is dated 18 August 2017 from The Halfway Inn. The tweet reads, "Come and see Mark at the Halfway Inn". The photograph shows a man behind a bar, wearing a Folk East bar team t-shirt. He is raising a Folk East branded glass and is standing next to a beer pump which shows pump clip 1 referred to above.

21. A list of reviews from *UNTAPPD* is provided and relates to beer described as Green Jackalope from Green Jack Brewing Company. The 44 reviews are dated between 16 August 2016 and 14 March 2020 (eight were posted after the relevant date). Some of the reviews include a picture taken by the reviewer, in most cases a pump clip or beer mat for the beer being reviewed. Pump clip 2, shown above at paragraph 16 first appears in two reviews dated 24 November 2018, both at the Hanover Inn. The reviewers are described as drinking Green Jackalope by Green Jack Brewing Company at The Hanover Inn.

22. A review dated 20 August 2016 describes the Green Jackalope beer as, 'Refreshingly farty green hop beer.'¹⁰

23. A review dated 26 October 2018, from the Triangle Tavern, says that the beer is: 'A new one on me, says Jackalope on the board.'

⁸ See paragraph 29 of Mr Dunford's first witness statement.

⁹ See exhibit TD10.

¹⁰ As above.

24. A review dated 16 November 2018 includes a photograph of the beer mat showing the top half, 'GREEN JACK-ALOPE' and the top of the picture of a jackalope. The reviewer is described as drinking Green Jackalope at Beccles Public Hall and Theatre.

25. A further review dated 16 August 2019 is written by a reviewer described as drinking Green Jackalope by Green Jack Brewing Company at Folk East and says:

“The trusty Jackalope. An easy one to sip down, close your eyes an’ it’s gone”.

26. Most reviewers include where they are drinking the reviewed beer and where it was purchased. The following locations are included within the reviews in this exhibit:¹¹ Glemham Hall, Elgoods Brewery and Gardens, The Ship, Folk East, The Triangle Tavern, Beccles Public Hall & Theatre, The Hanover Inn, The King’s Head – Laxfield, Greyline Brewing Company.

27. An article from 'East Anglian Times' is titled, 'Countdown to Folk East begins with Glemham Hall launch party featuring award winning Young 'uns.' The article includes the following:

“There was also a specially-brewed festival ale the Green Jackalope, named after a mythical creature, which has become intertwined in the festival’s folklore.”

28. A tweet from Folk East is dated 18 May 2017 and reads: *“Thank you for providing the Festival Ale! The Green Jackalope makes a welcome return to #FolkEast17.”* The accompanying photograph is pump clip 1 referred to above.

29. A tweet from Folk East is dated 1 December 2017 and reads: *“Known as The Green Jackalope to #FolkEasters...a firm favourite.”*

¹¹ I only include those reviews which were posted before the relevant date.

30. A tweet from an attendee at the festival is dated 18 August 2018 and reads, “1st beer of the weekend. Green Jackalope! V nice. Going to work my way through the list over the weekend! @FolkEast.” Accompanying photographs are of a pint of beer and a blackboard with a beer list from The Cobbold Arms. The list of beers includes ‘Green Jack – Green Jackalope’.

31. A tweet from an attendee at the festival, dated 20 August 2018, listed her favourite beers at the festival, the first of which is ‘Green Jackalope’.

32. In addition to the evidence summarised above, Mr Dunford submits that actual confusion has occurred between the applicant’s Green Jackalope beer and the proprietor’s Jackalope Ginger Lager. His evidence in support of this submission is a series of tweets. The first is by the proprietor and is dated 1 March 2019. It reads:

“My name is Jackalope – I am born out of folklore; part hare, part antelope – a unique creation. Find out more about me on 21 March – new names, new look @ moongazerale.”

33. Below the text the following photograph appears:



34. The next tweet is from an individual and says: “An ideal beer for @FolkEast I would suggest...!!”

35. Folk East replied to these tweets on 3 March 2019 with a photograph which, whilst incomplete, looks to be pump clip 1. The text reads: *“To go alongside our Green Jackalope Festival Ale perhaps!”*

Proprietor’s evidence

Witness statement by David Bryan Holliday with exhibits DH1 – DH19

36. Mr Holliday is the co-founder and current Director of the proprietor. His statement is dated 9 April 2020. He describes his company as a craft brewery, based in Hindringham, Norfolk which brews real ale and craft lager.

37. Mr Holliday provides evidence to support his statement that since 2012 the proprietor has used its MOONGAZER trade mark to promote a range of beers using that mark with imagery depicting the side profile of a hare. For example:¹²



38. Mr Holliday provides evidence to support his statement that the parties in this case know of each other. This includes a City of Ale Beer Festival programme for 2012 in

¹² See exhibit DH2.

which the proprietor and the applicant were active participants¹³ and an article from 'Evening News' dated 13 January 2013. The article lists both parties' breweries as having been selected for The Campaign for Real Ale's (CAMRA) Winter Ales Festival 2017. Mr Holliday states that they were neighbouring brewery bars at the festival, for five days.

39. In addition, Mr Holliday provides evidence of the size of the craft beer market in the UK. The key points from this evidence are as follows:

- In 2019 there were 2,300 UK breweries selling more than 10,000 different beers – Cask Ale Report 2019.¹⁴
- CAMRA lists 13,000 different real ales on sale in the UK in 2020 – CAMRA 2020 Good Beer Guide App.¹⁵
- Cask real ale is a subsector of the overall beer market representing - according to CGA Strategy Beer Quality Report 2016 - approximately 17% of the UK sales.¹⁶
- The number of breweries and beer brands is increasing year on year and in 2019 amounted to 1750+ real ale breweries marketing 7500+ real ales.¹⁷
- Both parties are members of the Society of Independent Brewers (SIBA) – a trade body.
- In 2016, 835 SIBA members produced 532 million pints of beer. Each brewer brewed, on average, 4-6 core beers (in 2015 between 3,412 and 5118 different beers), with additional seasonal beers.¹⁸
- Outlets in the UK known to sell real ale numbered in excess of 50,000 in 2019.¹⁹
- In 2016 sales of cask real ale in the UK (out of home) reached £1.7bn.²⁰
- The number of craft real ale breweries in Suffolk, Norfolk and Essex was 112 in 2016, 133 in 2017, 138 in 2018 and 140 in 2019.²¹

¹³ As above.

¹⁴ See exhibit DH3.

¹⁵ See exhibit DH4.

¹⁶ Paragraph 2 of the witness statement of David Holliday.

¹⁷ See CAMRA Good Beer Guide at exhibit DH5.

¹⁸ SIBA Beer Market Report 2016 at exhibit DH7.

¹⁹ See exhibit DH3.

²⁰ See exhibit DH12.

²¹ See exhibit DH19.

40. Mr Holliday raises a number of points concerning the applicant's evidence. He draws my attention to Good Beer Guides for 2016, 2017, 2018 and 2019 for the applicant's Triangle Tavern and states that the highlighted beer listings do not include Green Jack-alope or Jackalope.²²

41. In addition, Mr Holliday submits that the applicant's beer is only available for the Folk East festival each year. He draws my attention to the listing on the beer review website UNTAPPD which describes the applicant's ale as: *"A light, golden bitter brewed every summer by Green Jack exclusively for Folk East..."*²³ and also to the applicant's website, a recent addition (2020) to which describes the ale as: "A crisp and hoppy pale ale brewed for the Folk East Festival every August and seen all year round in selected Suffolk outlets...".²⁴

42. Mr Holliday further submits:

"I visited the Green Jack Brewing website (<http://www.green-jack.com/>) on 11th September 2019 and note that there was no mention in text or graphics of a GREEN JACK- ALOPE or JACKALOPE ale on the website at all. The website has pages dedicated to the Permanent Ale range or Green Jack Seasonal & Occasional Brews.

*I also visited the website on the 19th October 2019 and found the same absence of any reference to JACKALOPE or GREEN JACK-ALOPE."*²⁵

Mr Holliday concludes that the first time the applicant added Jackalope ale to its website was in 2020.

Applicant's evidence in reply

Second witness statement by Timothy Richard Dunford with exhibits TD15 – TD22

²² See exhibit DH16.

²³ See exhibit DH17.

²⁴ As previous.

²⁵ See paragraph 8 of Mr Holliday's witness statement and exhibit DH18.

43. Mr Dunford's second statement is dated 10 August 2020 and includes evidence relating to the renown of the applicant's brewery and beers. For the purposes of this summary the relevant points are the following:

44. An article from SUFFOLK magazine, dated 1 August 2017, is titled 'Food for thought (& frolicking)' and includes the following:

"From full-blown meals to must-try nibbles and flavoursome liquid refreshments, Folk East is full of local suggestions to tickle the taste buds sheer deliciousness with sound provenance! Here are just a few ideas to enjoy.

FROM LOWESTOFT

- Tim Dunford's Jackalope ale from Green Jack Brewery – just £3 a pint!"

45. An article from the East Anglian Times, dated 15 August 2019 and titled 'Everything you need to know about Folk East 2019' which includes the following:

*"When it comes to refreshment, two authentic 'village' pubs will be serving competitively-priced ales (including Suffolk-based Green Jack Brewery's festival ale Green Jackalope) or you can squeeze into possibly the smallest pub in the UK, the 6' x 4' Halfway Inn."*²⁶

46. Two articles from Spiral Earth (a music magazine), dated 10 January 2019 and 1 April 2019 and titled (respectively), 'Folk East's Magnificent Seven' and 'Folk East keeps on growing', both include the following:

"With its ever present mythical emblem The Jackalope, it offers a refreshingly different line-up across its seven stages (including the 'Sanctuary' stage at St Andrew's Church, the open air Sunset Stage and the hidden woodland solar-powered Soapbox Stage), with two authentic

²⁶ See exhibit TD19.

‘village’ pubs serving competitively-priced ales (including Suffolk based Green Jack Brewery’s festival ale Green Jackalope) plus possibly the smallest pub in the UK, the 6’ x 4’ Halfway Inn.”

47. Mr Dunford provides evidence which he states shows the wider renown of the Folk East Festival. I note that he refers to a feature in the music journal Folk Radio UK and a review of the festival in The Guardian newspaper. These do not appear to be included in the relevant exhibit or in the wider evidence. Articles which are included are:²⁷

- an article from the BBC News website, dated 27 November 2012, which highlights the festival moving location and includes a photograph of Bellowhead performing at Folk East.
- A listing on the eFestivals website for Folk East 2019, which includes the confirmed and rumoured line up of performers.

Issues arising from the evidence

Images displayed on social media pages

48. During the hearing, the proprietor made reference to the fact that images on social media and review sites can be changed, so may not reflect the situation at a given date. As I understand it, that is certainly the case with images such as profile pictures and backgrounds. However, a photograph taken at a particular time and uploaded as part of a review on a site cannot be updated at a later date. It can be deleted, but a new photograph would appear at the new date; it wouldn’t replace an old post in a timeline.

49. In considering the evidence in this case I have borne in mind the nature and location of the evidence and the extent to which it may have evolved over time and make my findings accordingly.

²⁷ See exhibit TD21.

The statutory provisions

50. Section 5(4)(a) of the Act has application in invalidation proceedings by virtue of section 47 of the Act, the relevant parts of which are as follows:

“...(2) Subject to subsections (2A) and (2G), the registration of a trade mark may be declared invalid on the ground-

(a) ...

(b) that there is an earlier right in relation to which the condition set out in section 5(4) is satisfied,

unless the proprietor of that earlier trade mark or other earlier right has consented to the registration.

[...]

(5) Where the grounds of invalidity exist in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only.

(5A) An application for a declaration of invalidity may be filed on the basis of one or more earlier trade marks or other earlier rights provided they all belong to the same proprietor.

(6) Where the registration of a trade mark is declared invalid to any extent, the registration shall to that extent be deemed never to have been made: Provided that this shall not affect transactions past and closed.”

51. Section 5(4) of the Act states:

“5(4) 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, where the condition in subsection (4A) is met,

(aa) ...

(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.”

52. Subsection 4A of section 5 of the Act states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

53. In *Discount Outlet v Feel Good UK*,²⁸ Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

“55. The elements necessary to reach a finding of passing off are the ‘classical trinity’ of that tort as described by Lord Oliver in the Jif Lemon case (*Reckitt & Colman Product v Borden* [1990] 1 WLR 491 HL, [1990] RPC 341, HL), namely goodwill or reputation; misrepresentation leading to deception or a likelihood of deception; and damage resulting from the misrepresentation. The burden is on the Claimants to satisfy me of all three limbs.

56. In relation to deception, the court must assess whether “a substantial

²⁸ [2017] EWHC 1400 IPEC

number" of the Claimants' customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

54. Halsbury's Laws of England Vol. 97A (2012 reissue) provides further guidance with regard to establishing the likelihood of deception. In paragraph 309 it is noted (with footnotes omitted) that:

“To establish a likelihood of deception or confusion in an action for passing off where there has been no direct misrepresentation generally requires the presence of two factual elements:

(1) that a name, mark or other distinctive feature used by the plaintiff has acquired a reputation among a relevant class of persons; and

(2) that members of that class will mistakenly infer from the defendant's use of a name, mark or other feature which is the same or sufficiently similar that the defendant's goods or business are from the same source or are connected.

While it is helpful to think of these two factual elements as successive hurdles which the plaintiff must surmount, consideration of these two aspects cannot be completely separated from each other, as whether deception or confusion is likely is ultimately a single question of fact.

In arriving at the conclusion of fact as to whether deception or confusion is likely, the court will have regard to:

(a) the nature and extent of the reputation relied upon;

(b) the closeness or otherwise of the respective fields of activity in which the plaintiff and the defendant carry on business;

(c) the similarity of the mark, name etc. used by the defendant to that of the plaintiff;

(d) the manner in which the defendant makes use of the name, mark etc. complained of and collateral factors; and

(e) the manner in which the particular trade is carried on, the class of persons who it is alleged is likely to be deceived and all other surrounding circumstances.

In assessing whether confusion or deception is likely, the court attaches importance to the question whether the defendant can be shown to have acted with a fraudulent intent, although a fraudulent intent is not a necessary part of the cause of action.”

The relevant date

55. In *Advanced Perimeter Systems Limited v Multisys Computers Limited*,²⁹ Mr Daniel Alexander QC, as the Appointed Person, endorsed the registrar’s assessment of the relevant date for the purposes of section 5(4)(a) of the Act, as follows:

“43. In *SWORDERS TM*³⁰ Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

‘Strictly, the relevant date for assessing whether s.5(4)(a) applies is always the date of the application for registration or, if there is a priority date, that date: see Article 4 of Directive 89/104. However, where the applicant has used the mark before the date of the application it is necessary to consider what the position would have been at the date of the start of the behaviour complained about, and then to assess whether

²⁹ BL O-41011

³⁰ BL O-212-06

the position would have been any different at the later date when the application was made.”

56. The filing date of the subject trade mark is 16 January 2019. There is no evidence or claim by the proprietor that it has used its mark prior to this. The proprietor refers to 16 January 2019 as the relevant date in its skeleton argument. Accordingly, the matter need only be assessed as of 16 January 2019.

Goodwill

57. The first hurdle for the applicant is to show that it had the required goodwill at the relevant date. In *Inland Revenue Commissioners v Muller & Co's Margarine Ltd*³¹ the Court stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

58. It has long been established that a small business which has more than a trivial goodwill can protect signs which are distinctive of that business under the law of passing off even though its reputation may be small. In *Stacey v 2020 Communications*,³² Millett J. stated that:

“There is also evidence that Mr. Stacey has an established reputation, although it may be on a small scale, in the name, and that that reputation preceded that of the defendant. There is, therefore, a serious question to be tried, and I have to dispose of this motion on the basis of the balance of convenience.”

³¹ [1901] AC 217 (HOL)

³² [1991] FSR 49

59. See also: *Stannard v Reay* [1967] FSR 140 (HC); *Teleworks v Telework Group* [2002] RPC 27 (HC); *Lumos Skincare Limited v Sweet Squared Limited and others* [2013] EWCA Civ 590 (COA).

60. The proprietor submits that:

“10...the evidence submitted by the Applicant only shows, if it does show at all, use of the signs GREEN JACKALOPE, GREEN JACK-ALOPE, and GREEN JACK-ALOPE GOLDEN BEST (hereinafter the “Green Marks”), instead of the Pledged Signs. The Applicant appears to claim in the witness statement of Mr Timothy Dunford (“the Applicant’s Witness Statement”) that it has used the marks JACKALOPE and JACK-ALOPE interchangeably, and there is some kind of re-brand where it switched between the marks. The Owner submits this is not supported at all by the evidence, and the evidence does not show use of the Pledged Signs before the Relevant Date.”³³

61. In its submissions, received on 13 February 2020, the applicant submits that its use of its signs in a variety of forms is common practice within the beer/ale industry and concludes that this is due to the ways in which the mark is displayed, inter alia, on invoices, beer mats, pump clips and on the product itself.

62. The evidence shows that the original branding used on the applicant’s product was GREEN JACK-ALOPE. Over time this has changed to GREEN JACK JACKALOPE and this was the case by, at least, November 2018. The beer review site and the beer menus at the Folk East folk festival, where the beer was launched in 2016, list the beer as Green Jackalope.

63. The evidence shows that on invoices, which have been provided for regular dates throughout the relevant period (since April 2016), the applicant’s beer is described as JACKALOPE. This supports the applicant’s submission that throughout the period the sign used by the applicant to identify its beer to trade customers is ‘Jackalope’. The

³³ See the proprietor’s skeleton argument, dated 19 October 2020.

proprietor submitted at the hearing that all of the sales are to Green Jack pubs and so the applicant did not need to use any other identifier. I do not agree with this statement as the evidence shows sales via a theatre bar, to a branch of the Green Party and to bars other than those where the applicant launched its beer. I accept Mr Dunford's position that trade customers have always encountered the product as JACKALOPE.

64. The later pump clip design, referred to as pump clip 2, describes the beer as 'Green Jack' 'Jackalope'. Green Jack is presented at the top, an image of a jackalope is shown in the centre and the word 'JACKALOPE' can be seen underneath. This change of branding seems to have occurred at about November 2018, as can be seen by an *UNTAPPD* review from that date. That is not to say that references to 'Jackalope' solus are only evident after that date; for example, an article in *Suffolk Magazine* dated 1 August 2017 describes the festival beer as 'Tim Dunford's Jackalope Ale', and a review on *UNTAPPD* dated 26 October 2018 states that the beer is described as Jackalope on the board in the bar where they are drinking (the Triangle Tavern in this case).

65. The proprietor draws my attention to a number of descriptions of the applicant's beer as a seasonal product brewed only for the Folk East festival. The applicant states that it is brewed for the festival but is also available throughout the year. The pattern of invoices in evidence supports the applicant's statement as there are sales to trade customers throughout the year as they demonstrate regular sales of Jackalope beer made during the autumn and winter months.

66. I note the evidence filed by the proprietor describing the size of and variety within the UK beer industry. However, I do not find that this defeats the applicant's claim to have a legitimate goodwill in its business. There are many hundreds of small and craft breweries within the UK and many national and regional festivals and food fairs where they are able to launch and sell products. There is clearly goodwill in the applicant's brewery business, which has won more than 100 regional and national awards for its beers.

67. Sales by the applicant brewery are, not unexpectedly, made to traders such as public houses who then sell the beer on to end customers. Mr Dunford's breakdown

of sales of Jackalope beer to its trade customers amounts to approximately £75,000 at trade price between 2016 and 2018. Whilst this cannot be said to be the highest number of sales, bearing in mind the size of the UK brewing industry, I do not find it to be insignificant. The evidence clearly shows that these customers encounter the applicant's product under the sign 'Jackalope'.

68. Marketing which has been directed at the end consumer, namely, inter alia, pump clips on bar counters and beer mats, has always included a picture of a jackalope, which is a cross between a rabbit/hare and an antelope - put simply, a rabbit or hare with antlers. This further reinforces the association of 'Jackalope' with the applicant's beer. However, I consider that the manner of overall use means that the goodwill is associated with the word per se.

69. At the hearing, Mr Rebling, for the proprietor, submitted that use of Green Jackalope is not use of Jackalope and referred me to the case law common to decisions relating to proof of use of a registered trade mark. Whilst, of course, use of a sign is a necessary element in assessing goodwill, the key factor is whether there is goodwill in the applicant's business and if so, for me to identify where that goodwill lies. In other words, what is the attractive force which brings in custom. It is often the case, and is the case here, that multiple signs may be used by one undertaking. It is not uncommon for a brewery to offer a range of named (branded) beers under the umbrella sign which represents the brewery itself. The applicant's business is the Green Jack brewery under which it provides a range of goods. The beer at issue is listed as Green Jackalope on the festival menu boards and on the beer review site UNTAPPD, but this does not mean that there has not also been use of Green Jack Jackalope, and Jackalope, during the same period. With regard to the use of 'Green' alongside 'Jackalope', I find, from the evidence that it may be seen by the relevant public as a reference to the brewery, it may describe a characteristic of the jackalope or it may be seen as referring to the green hops used to make the applicant's jackalope beer.³⁴ None of these alters the message conveyed to the relevant public which is that the applicant provides a beer under the Jackalope sign.

³⁴ See exhibit TD10, page 10.

70. Many of the sales of the applicant's beer have taken place at the Folk East festival every August. This is a regular event with many thousands of attendees and at each one of the festivals since 2012 it is the applicant's Jackalope beer which is the official beer of the festival. Some of the reviews at exhibit TD10 refer to customers drinking the beer at more than one festival, in successive years and being as good as they remembered. There have been sales outside this particular event as bars local to the Suffolk/Lowestoft area have bought the beer from the applicant all year round.

71. Taking all of the factors into account, I find that the evidence is sufficient to demonstrate that at the relevant date the applicant had small but nonetheless protectable goodwill in JACKALOPE for beers.

Misrepresentation

72. In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc. [1990] R.P.C. 341 at page 407* the question on the issue of deception or confusion is

‘is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents' [product]?’

The same proposition is stated in *Halsbury's Laws of England 4th Edition Vol.48 para 148*. The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd. (1941) 58 R.P.C. 147 at page 175*; and *Re Smith Hayden's Application (1945) 63 R.P.C. 97 at page 101*.”

73. And later in the same judgment:

“... for my part, I think that references, in this context, to ‘more than *de minimis*’ and ‘above a trivial level’ are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993). It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

74. The proprietor has submitted that its Jackalope product is a ginger lager and is therefore different to the applicant's goods. The proprietor has not claimed use before the relevant date and its mark is registered for a wide range of beer products in class 32. It is that specification which I must consider. I have found the applicant to have goodwill in respect of beers. The applicant makes its passing off claim in respect of the proprietor's goods which are, in essence, a list of different types of beer. Clearly the parties operate in the same field of activity. For the record, I would have found flavoured lager to fall within the broader term of beers in any case.

75. Despite the fact that the goodwill shown in evidence is less than national, this does not prevent the claim succeeding since the registration is a UK registration which, notionally, may be used in the same geographic area.

76. The applicant's goodwill is associated with the sign JACKALOPE. The proprietor's mark comprises the word ‘Jackalope’. I have borne in mind the proprietor's submission that its Moongazer brewery has a history of using a hare in its branding, on a range of products, but it is the word ‘Jackalope’ which is the mark at issue in these proceedings and is the mark challenged by the applicant. Clearly, the words are identical.

77. I find the word ‘Jackalope’ to be distinctive to a higher than average degree in respect of beer, though not the highest level.

78. I consider that a person who is aware of the applicant's Jackalope beer would believe that the proprietor's beer being sold under the contested mark originated from the same undertaking, that of the applicant. In conclusion, use of the proprietor's mark

at the relevant date would have constituted a misrepresentation to a substantial number of people.

Damage

79. Having found that the goodwill and misrepresentation limbs of the test have been satisfied and that the parties' respective goods are identical, it follows that damage to the applicant's goodwill will arise, most obviously, by diverting trade from the applicant to the proprietor.

80. I note that in *WS Foster & Son Limited v Brooks Brothers UK Limited* [2013] EWPC 18, Mr Recorder Iain Purvis QC stated:

“Damage

55 Although proof of damage is an essential requirement of passing off cases, it will generally be presumed where a misrepresentation leading to a likelihood of deception has been established, since such deception will be likely to lead to loss of sales and/or more general damage to the exclusivity of the Claimant's unregistered mark. Mr Aikens accepted that if there was a misrepresentation in the present case, then he had no separate case on damage. I hold that damage is inevitable, at least in the sense recognised in *Sir Robert McAlpine v Alfred McAlpine* [2004] RPC 36 at 49 (the 'blurring, diminishing or erosion' of the distinctiveness of the mark).”

81. I find that to be the case here. I therefore find that use of the proprietor's mark at the relevant date was liable to be restrained under the law of passing off. **The invalidation succeeds under sections 47(2)(b) and 5(4)(a).**

COSTS

82. Green Jack Brewing Co. Ltd has been successful and is entitled to a contribution towards its costs which I award on the following basis, bearing in mind that the applicant did not attend the hearing:

Official Fee -	£200
Preparing statements and considering the other side's statements -	£400
Filing and considering evidence -	£800
Total	£1400

83. I order David Holliday Limited (the proprietor) to pay Green Jack Brewing Co. Ltd the sum of £1400. This sum is to be paid within 21 days of the expiry of the appeal period or within 21 days of the final determination of this case if any appeal against this decision is unsuccessful.

Dated this 18th day of December 2020

Al Skilton
For the Registrar,
The Comptroller-General