

O/0240/23

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3484415
IN THE NAME OF VINCENT HURL
IN RESPECT OF THE TRADE MARK**

Crosskeys 1654 Irish Poitín

IN CLASS 33

AND

**THE OPPOSITION THERETO UNDER NO. 422038
BY AMBER BEVERAGE GROUP**

AND

**IN THE MATTER OF TRADE MARK REGISTRATION NUMBERS 3484414 &
3300022**

IN THE NAME OF VINCENT HURL

FOR THE MARKS

Lady Of The Island Crosskeys Irish Gin

Crosskeys 1654 Irish Whiskey

IN CLASS 33 & CLASSES 25 & 33

**AND THE TWO APPLICATIONS FOR THE INVALIDATION THEREOF UNDER
NOS. 503475 & 503476**

BY AMBER BEVERAGE GROUP

Background and pleadings

1. Vincent Hurl (“Mr Hurl”) applied to register the trade mark no. 3484415 for the mark ‘Crosskeys 1654 Irish Poitín’ in the UK on 26 April 2020. It was accepted and published in the Trade Marks Journal on 11 September 2020 in respect of the following goods:

Class 33: Alcoholic beverages (except beer) Spirits and Liquors; Preparations for making alcoholic beverages; all of the afore mentioned goods conforming with the specification of the geographical indication Irish Poitín.

2. On the 11 November 2020, AMBER BEVERAGE GROUP (“Amber”) opposed the trade mark on the basis of Section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). This is on the basis of its earlier International Trade Mark registration no. 1413693 for the **CROSS KEYS GIN** mark . This registration holds a priority date of 6 March 2018 and a designation date of 23 May 2018. By virtue of its earlier priority date, this mark constitutes an earlier mark in accordance with section 6 of the Act. The following goods are relied upon in this opposition:

Class 33: Gin.

3. Amber argues that the respective goods are identical or similar and that the marks are similar, and that as such, there is a likelihood of confusion between the same.

4. Mr Hurl filed a counterstatement defending his application. Within the counterstatement, Mr Hurl claimed to own earlier rights in the mark and stated:

“I deny the claims outlined in the statements of “grounds of opposition”, based on the following:

1.) Similarity of Trademark

The mark Crosskeys as referred to in our application is protected in an earlier trade mark which we hold (No. UK00003300022). We also have a reputation established within the UK/Ireland and internationally which is recognised and protected under Good Will.

2.) *Identity/Similarity of Goods*

The trade mark application for Crosskeys 1654 Irish Poitín clearly states Irish Poitín. Irish Poitín is protected geographically and this protection identifies a “spirit drink as originating in a region or locality of a particular country.” The product packaging will be labelled accordingly.”

5. On 1 December 2020, Amber applied to invalidate Mr Hurl’s trade mark registration no. 3484414 for the mark ‘Lady Of The Island Crosskeys Irish Gin’ in accordance with section 47(2)(a) and relying upon section 5(2)(b) of the Act. This registration holds a filing date of 26 April 2020 and a registration date of 11 August 2020, and is registered in respect of the following goods:

Class 33: Gin

6. The application for invalidation relies upon the same earlier mark as the opposition above, which in accordance with section 6 of the Act, also constitutes an earlier mark within these invalidation proceedings.

7. Also on 1 December 2020, Amber applied to invalidate Mr Hurl’s registration no. 3300022 for the mark Crosskeys 1654 Irish Whiskey in accordance with section 47(2)(a) and relying on section 5(2)(b) of the Act. This registration holds a filing date of 28 March 2018 and a registration date of 29 June 2018, and is registered in respect of the following goods:

Class 25: Clothing, shirts and head gear.

Class 33: Irish Whiskey.

8. Again, the application for invalidation relies upon the same earlier mark as the opposition above, which in accordance with section 6 of the Act, also constitutes an earlier mark within these invalidation proceedings.

9. Mr Hurl filed a counterstatement defending his registrations in both of the above-mentioned invalidations. In his counterstatement filed in respect of the application to

invalidate his registration no. 3484414, Mr Hurl again claimed to hold earlier rights in the mark, stated that he denies the claims outlined in the statement of grounds and stated that the product offered under his own mark is different, on the basis that it is distilled in Pot Stills, a method which he states is unique to Ireland.

10. Mr Hurl had professional representation by the time he filed his third counterstatement in respect of the invalidation filed against his registration no. 3300022. The counterstatement filed reiterates that Mr Hurl holds earlier rights in respect of his mark, accepts that both marks contain the element 'crosskeys' or 'CROSS KEYS', but states this is where the similarity ends. It also states that the element that is common between the marks is the name of a number of geographical locations and points out that whilst both the earlier goods and 'Irish whiskey' are categorised as 'spirits', Irish whiskey is a Geographical indicator which must meet specific criteria. It is denied also that the goods in class 25 are similar.

11. Following the receipt of the three counterstatements above, the proceedings were consolidated.

12. Neither side filed evidence in these proceedings, but Amber filed written submissions during the evidence rounds. No hearing was requested, however both sides filed written submissions in lieu of a hearing. These submissions will not be summarised but have been considered and will be referred to where appropriate. This decision is taken following a careful consideration of the papers.

13. Amber is represented in these proceedings by Withers & Rogers LLP. Mr Hurl is represented by Ansons.

14. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. That is why this decision continues to refer to the case law of the EU courts.

Proof of use

15. The earlier mark relied upon in these proceedings had not been registered for a period of five years at the date on which the application subject to the opposition was filed, or at the date on which the two applications for invalidity were filed. As such, the earlier mark is not subject to proof of use in these proceedings in accordance with section 6A and section 47(2A) of the Act.

Preliminary issues

16. Both the counterstatements and the submissions in lieu filed on behalf of Mr Hurl reference his claimed earlier rights, including his claimed earlier goodwill. Within the final written submissions filed on behalf of Mr Hurl, the following statement is made:

“4. While goodwill in the mark was not deemed sufficient to cancel the trade mark registration upon which these current actions are based, namely UK Designation of International Trade Mark Registration No. 1413693 for the mark **CROSS KEYS GIN** in class 33, we feel it is pertinent to raise this again since the use of the trade mark ‘Crosskeys’ has been used in respect of services complementary to the goods covered in class 33 for a substantial amount of time.”

17. These proceedings concern only the oppositions and invalidations filed against the three referenced marks in the name of Mr Hurl. There is no attack against the earlier mark to consider in these proceedings, and it stands as a valid earlier right in respect of the same. Further, whilst I note the comments stating that the contested mark has been used for a “substantial amount of time” in respect of complementary services, Mr Hurl has not filed any evidence to this effect. There is also no evidence showing that Amber is using its mark in respect of its goods relied upon. Whilst in certain circumstances it may be the case that the absence of confusion despite evidence of side-by-side use on the market may assist an argument that it is unlikely there will be confusion moving forward,¹ in this case there is clearly no evidence to support this. In

¹ *Roger Maier and Another v ASOS*, [2015] EWCA Civ 220

addition, I note that even if evidence of side-by-side use had been filed, whether this would be of any assistance to Mr Hurl would be dependent on what the evidence showed, including the extent of the use of the marks made in respect of the actual goods as registered/contested, and whether there had been an opportunity for confusion to occur. I therefore give no further consideration to Mr Hurl's pleadings or submissions regarding earlier or concurrent use of his marks.

Decision

Section 5(2)(b)

18. Section 5(2)(b) of the Act is as follows:

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

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

19. Section 5A provides:

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

Section 47(2)(a)

20. Section 47(2)(a) of the Act provides:

“47 Grounds for invalidity of registration

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

(a) that there is an earlier trade mark in relation to which the conditions set out in section 5(1), (2) or (3) obtain, or

...

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

21. Subsection 2A referred to above refers to the proof of use provisions I have already addressed and which are not applicable within these proceedings. Subsection 2G (and 2H) provide as follows:

“2G) An application for a declaration of invalidity on the basis of an earlier trade mark must be refused if it would have been refused, for any of the reasons set out in subsection (2H), had the application for the declaration been made on the date of filing of the application for registration of the later trade mark or (where applicable) the date of the priority claimed in respect of that application.

(2H) The reasons referred to in subsection (2G) are—

(a) that on the date in question the earlier trade mark was liable to be declared invalid by virtue of section 3(1)(b), (c) or (d), (and had not yet acquired a distinctive character as mentioned in the words after paragraph (d) in section 3(1));

(b) that the application for a declaration of invalidity is based on section 5(2) and the earlier trade mark had not yet become sufficiently distinctive to support a finding of likelihood of confusion within the meaning of section 5(2);

[...]”

22. Section 47(5) provides:

“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.”

23. 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 great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

Comparison of goods

24. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

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

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;
- (e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- (f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

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

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

27. In *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the GC stated there is “complementary” where:

“...there is a close connection between them, in the sense that one is indispensable or important for the use of the other in such a way that customers may think that the responsibility for those goods lies with the same undertaking”.

28. 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 fur 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”.

29. With the above in mind, the goods for comparison are as follows:

Earlier goods	Contested goods
<i>Class 33: Gin</i>	Under application no. 3484415 (“the first contested mark”) <i>Class 33: Alcoholic beverages (except beer) Spirits and Liquors; Preparations for making alcoholic beverages; all of the afore mentioned goods conforming with the</i>

	<i>specification of the geographical indication Irish Poitín.</i>
	Under registration no. 3484414 (“the second contested mark”) <i>Class 33: Gin</i>
	Under registration no. 3300022 (“the third contested mark”) <i>Class 25: Clothing, shirts and head gear.</i> <i>Class 33: Irish Whiskey.</i>

30. I note Mr Hurl submits within his counterstatement that the product offered under his own mark is different to Amber’s goods under its second contested mark, on the basis that it is distilled in Pot Stills, a method which he states is unique to Ireland. I note here that the comparison I must make is a notional one, based on the earlier goods as registered and the contested goods as filed and registered. The product offered by Mr Hurl under his mark is not relevant to this assessment, and in any case, I note that where Amber holds protection for goods such as gin, this will include all types of gin, regardless of the method or location of the production of the same. I will therefore conduct a notional comparison of the goods as filed and registered below.

The first contested mark

31. The contested terms *Alcoholic beverages (except beer) Spirits and Liquors; all of the afore mentioned goods conforming with the specification of the geographical indication Irish Poitín* will in my view not be identical to the earlier goods *Gin* due to the requirement for the contested goods to conform with the specification of the GI Irish Poitín. Irish Poitín is, to my knowledge, a type of spirit in its own right. However, I still consider that to an extent they will be of a similar nature to the earlier *gin* with these both being spirits containing a high alcohol content. The method of use will largely be shared. The goods will share the purpose of being consumed for enjoyment or relaxation. Whilst the goods are unlikely to be placed directly next to each other in

shops such as supermarkets, they are likely to be placed very near each other in a 'spirits' section of the same, and there may be an overlap in trade channels. Users will be shared by way of both the general public and professionals stocking bars and public houses, and other establishments where alcohol is served. There may also be a degree of competition between the goods, with the consumer choosing between gin or an Irish Poitín from a store to enjoy at home, or from a drink's menu within a bar or public house, but the goods will not be complementary. Overall, considering all of the relevant factors, I find the goods to be similar to a fairly high degree.

32. I consider the contested goods *preparations for making alcoholic beverages; all of the aforementioned goods conforming with the specification of the geographical indication Irish Poitín*. I have had no submissions or evidence from the parties regarding the type of goods this term may include. It is my view these may comprise goods such as alcoholic essences and extracts for the inclusion in alcoholic drinks, to the extent that they conform with the limitation applied. The earlier goods are gin per se. As it is my view that the contested goods may include those which contain alcohol, there is a small overlap in nature, although I note the contested goods may not include ready to drink beverages, such as the earlier gin. I also note these goods will likely be sold in different types of receptacles to the earlier goods. In terms of purpose and method of use, there may again be a degree of overlap, for example where *gin* and the *preparations for making alcoholic beverages* are both used for the purpose of making drinks such as cocktails. In terms of users, I consider that gin may be purchased both by the general public in supermarkets, or by professional consumers for the purpose of stocking bars for example. I also consider that the preparations for making alcoholic beverages may be purchased by the general public for making drinks such as cocktails at home and may also be purchased by professionals including those running bars and other establishments where alcoholic beverages are offered, for making drinks to serve to consumers. I find it unlikely these goods will be directly next to each other in retail shops, although they will likely be placed near each other in the alcohol section, and there will likely be a degree of overlap in trade channels. I do not find these goods will be complementary, or that they will be in competition. However, overall, I find at least a low level of similarity between these goods.

The second contested mark

33. The contested goods, namely *gin* are self-evidently identical to the earlier goods.

The third contested mark

34. Within its submissions filed during the evidence rounds, Amber submitted:

“For Class 25, "clothing, shirts and head gear" complement Party A's Goods. These items could be used to further advance the sales and marketing of Party A's Goods. For example, it is commonplace for alcohol brands to promote their goods via "clothing, shirts and head gear". It follows that Party B's Class 25 Goods complement Party A's Goods. The respective goods are similar.”

35. It is clear that with regard to its meaning in the context of trade mark law, clothing and headgear are not complementary to *gin*. I note the submissions that one may be used to promote the other, but I do not consider this renders the goods important or essential for one another. Further, I do not consider that the consumer would generally believe on this basis that clothing/headgear and *gin* would be produced by the same entity. The goods do not share a nature, method of use or intended purpose. The goods are not in competition with one another and would not commonly share trade channels or be placed next to each other in stores. Overall, in accordance with the factors for consideration as set out in the case law, I find these goods to be dissimilar.

36. In respect of the contested *Irish whiskey*, I consider again that to an extent this will share a nature with the earlier *gin* with these both being spirits containing a high alcohol content. These are both drinks that may be drunk neat or be mixed with another beverage. When they are served neat, they may be served in similar receptacles. Again, the method of use will largely be shared and the goods will share the purpose of being consumed for enjoyment or relaxation. Whilst these goods are also unlikely to be placed directly next to each other in shops such as supermarkets, they are likely to be placed very near each other in a 'spirits' section of the same, and there will likely be a degree of overlap in trade channels. Users will be shared by way of both the general public and professionals stocking bars and public houses, and

other establishments where alcohol is served and again there may be a degree of competition between the goods, with the consumer choosing between gin or a whiskey from a store to enjoy at home, or from a drink's menu within a bar or public house. The goods will not be complementary. Overall, considering all of the relevant factors, I find the goods to be similar to a fairly high degree.

Comparison of marks

37. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The Court of Justice of the European Union 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.”

38. It would be wrong, therefore, to dissect the trade marks artificially, 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.

39. The respective trade marks are shown below:

Earlier trade mark	Contested trade marks
CROSS KEYS GIN	Crosskeys 1654 Irish Poitín

	Lady Of The Island Crosskeys Irish Gin
	Crosskeys 1654 Irish Whiskey

40. The earlier mark comprises the three words CROSS KEYS GIN. Due to its directly descriptive nature, the word GIN plays at best only a very small role in the overall impression of the mark, which is dominated by the non-descriptive elements CROSS KEYS.

41. Within the first and third contested mark, the wording ‘Irish Poitín’/‘Irish Whiskey’ is directly descriptive of the goods in class 33, and therefore plays at best only a very small role in the overall impression of the mark when considering the same. The 1654 element in the middle of the marks appears to indicate a year, which in my view may be considered to allude to a characteristic of the alcoholic goods, for example the year in which the production of the goods or the use of a production method originated. It may also be construed as a reference to a batch number in respect of these goods. This somewhat reduces its distinctiveness in relation to the same, although I do not consider this element to be negligible, and it still contributes to the overall impression. However, being the most distinctive element positioned at the beginning of the marks where the consumer tends to place most importance,² I find wording Crosskeys plays the greatest role in the overall impression of the marks.

42. In respect of the second contested mark, I find the element ‘Irish Gin’ to again be descriptive of the goods themselves, and I find it to play at best a very small role in the overall impression. I consider that the element ‘Lady of the Island’ forms a unit and being a distinctive element placed at the beginning of the mark, I find it plays the greatest role in the overall impression of the same. The element Crosskeys appears to act as a separate distinctive element within the mark, and whilst its position means it does not play the most dominant role, it still plays a significant role within the overall impression of the same.

² *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Visual comparison

The first and third contested marks

43. The first and third contested marks coincide with the earlier mark through the use of the most distinctive and dominant element of each mark, namely CROSS KEYS/ Crosskeys. Whilst I note the earlier mark includes a space in between CROSS and KEYS, this makes very little difference to this element visually. I note the contested marks are filed as word marks which protects the words contained in the mark, whatever form, colour or typeface are used: see *LA Superquimica v EUIPO*, Case T-24/17, paragraph 39. As such the use of lowercase lettering in the contested marks compared to the uppercase letter of the earlier mark does not add to the visual differences. However, the marks do differ visually through the use of the element 1654 present in the contested marks which does not have an equivalent in the earlier mark, and via the descriptive terms GIN, Irish Poitín and Irish Whiskey. Considering all of these factors, by way of the distinctive common element placed at the beginning of the marks, I find them to be visually similar to between a medium and high degree.

The second contested mark

44. The second contested mark coincides with the earlier mark by way of the element CROSS KEYS/Crosskeys, in addition to the descriptive word GIN. Again, the use of the space between CROSS and KEYS makes very little difference visually, and the use of upper and lowercase lettering again makes no difference visually for the reasons set out in respect of the marks above. However, I note this element is placed in different positions in each mark, and the first element of the contested mark, that being 'Lady Of The Island', has no counterpart in the earlier mark. The inclusion/omission of this element creates a significant point of visual difference between the marks. I also note the use of the descriptive word Irish in the contested mark, which is not included within the earlier mark. Overall, I consider these marks to be visually similar to between a low and medium degree.

Aural comparison

The first and third contested marks

45. The first and third earlier marks and the contested marks all begin with the identical aural elements cross-keys, which I find will be pronounced in the normal way. However, they differ aurally through the use of 1654 and the descriptive wording GIN and Irish Poitín/Irish Whiskey. On the basis that the latter elements are directly descriptive of the alcoholic goods, I find it likely that a significant portion of consumers will not pronounce the same when considering these. However, for those that do, these will create points of aural difference. The element 1654 also creates a point of aural difference between the marks, increasing the length of the contested mark by and additional five syllables. Considering the points of aural similarity and the differences, it is my view that regardless of whether the descriptive elements of each of the marks are pronounced or not, by way of the identical elements at the beginning of each of the marks, the marks are aurally similar to a medium degree.

The second contested mark

46. Whilst the second earlier mark shares the aural elements 'cross-keys' in addition to the descriptive word 'gin' (if this is pronounced within the marks), the cross-keys elements are placed in different positions in the marks, and the use of 'Lady Of The Island' at the beginning of the contested mark creates a significant point of aural difference between the same. It is my view that whether or not 'gin' is pronounced in each of the marks, they will share only a low to medium level of aural similarity.

Conceptual comparison

The common element CROSS KEYS/Crosskeys

47. Within the submissions filed on behalf of Amber it is argued:

“30. The respective marks coincide conceptually to the extent that they both refer to CROSSKEYS/CROSS KEYS. The meanings of the words CROSS and KEYS are well-known in the English language, and will be known by the average consumer. They will be given their normal dictionary definition. As a result, the marks are conceptually similar to a high degree.”

48. On the contrary, it is clear from the submissions filed on behalf of Mr Hurl that at least in respect of the second contested mark, he believes that the element Crosskeys will be viewed as the name of an islands, stating:

“13. The word “gin” is the descriptor for the goods themselves and therefore is not distinctive of the goods. The word ‘Crosskeys’ is situated in the middle of the mark in between the prefix “Lady Of The Island” and “Irish Gin”. The elements of the mark hang together and the word ‘crosskeys’ does **not** retain an independent role within the trade mark instead it merely suggests that ‘Crosskeys’ is the name of an island where the “Lady” originates.”

49. In addition, within the counterstatement filed on behalf of Mr Hurl in respect of the third contested mark, it is submitted:

“We should also point out that the one element in common between the marks is the name of a number of geographical locations within the United Kingdom, including the village of Crosskeys in Wales, Walpole Cross Keys in Norfolk and Crosskeys in the townland of Ardnaglass.”

50. I consider firstly the submission filed on behalf of Amber claiming that these elements will simply be conceptualised in line with their dictionary definitions. I consider that the word KEYS will have more than one meaning, but it will most commonly be understood by the consumer as a reference to the plural of the word key, meaning:

“A key is a specially shaped piece of metal that you place in a lock and turn in order to open or lock a door, or to start or stop the engine of a vehicle.”³

51. The English word ‘Cross’ also has several meanings, but I consider that in the context of the elements CROSS KEYS and Crosskeys, it will most likely be considered to mean overlapping, rather than referencing anger or having connotations of a religious symbol. It is my view that there will be a significant portion of consumers to whom this element of the marks conveys the idea of crossed keys, and I find that this will be common in respect of this element across the earlier and contested marks.

52. However, I also note the submissions filed on behalf of Mr Hurl. Whilst I have no evidence on this point, I note the submissions that Crosskeys is the name of a number of geographical locations in the UK. I consider that this element may well therefore be interpreted by a portion of consumers conceptually as being a reference to one of these locations, although I find it unlikely that the majority of consumers would identify this as being a reference to a particular place (or island), and there is no evidence to suggest that the general UK population would associate this with a single geographical location in particular, although those in the locality of an area named Crosskeys may connect it with the same. It is my view that where identified, this possible reference to a geographical location will be shared across the contested marks and the earlier mark. However, I find that for the majority of consumers this element may just as easily be interpreted purely as being an indication of economic origin, with the concept being conveyed by the meaning of the words themselves, as previously defined.

The first and third contested marks

53. The first and third contested marks also include the element ‘1654’. It is my view that this number reads like a date and would likely be considered as one. Considering this date is from such a long time ago, it is my view that it is unlikely to be construed by consumers as indicating that the goods actually being offered were made in 1654, which a reference to a more recent date in respect of alcoholic beverages may well indicate. However, it may well convey to the consumers that something about these

³ <https://www.collinsdictionary.com/dictionary/english/key> [accessed 19 February 2023]

goods, for example a recipe or method of production, stems from the same, or be considered as a reference to a batch number. I do not find the concept created by this element to be particularly strong or direct. These marks also contain descriptive wording conveying the type of goods offered under the marks. To the extent that this wording creates a point of conceptual difference between the marks I find this to be weak in the context of the goods. Overall, considering the conceptual similarities in the marks created by the element CROSS KEYS/Crosskeys, I find the first and third contested marks to be similar to the earlier mark to between a medium and high degree.

The second contested mark

54. I note the arguments filed on behalf of Mr Hurl that in this mark, the element Crosskeys 'hangs together' with the element Lady Of The Island in the second contested mark. It is my view that reaching this conclusion would be a bit of a stretch. Whilst I accept that there may be a few consumers who read this mark as meaning Lady Of *The Island Crosskeys* (i.e. lady of the island named Crosskeys), I do not find this reading of the mark to be a particularly natural one. There is no evidence relating to the existence of an island names Crosskeys, and I find that at least a significant portion of consumers will read this mark as Lady Of The Island – Crosskeys Irish Gin. In respect of the element Lady Of The Island, it is my view that this conveys the concept of a female individual in a position of importance on an island. It is my view the element Crosskeys in this mark will be interpreted conceptually within this mark as previously outlined.

55. It is my view that the strong concept created by the Lady Of The Island element in this contested mark creates a significant point of conceptual difference between the marks, but the fact they will both share the same concept by way of the elements CROSS KEYS/Crosskeys means they remain conceptually similar to at least between a low and medium degree.

Average consumer and the purchasing act

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

57. 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.”

58. The relevant consumer of all of the goods in this instance will include members of the general public over the age of 18. As mentioned previously, there may also be a portion of professional consumers purchasing the goods on behalf of a business, or for the purpose of running a business themselves. It is my view that a significant portion of members of the general public over the age of 18 will purchase the goods fairly frequently, either in a retail or hospitality environment, whereas the professional public is more likely to purchase these in a wholesale environment. I note the price point of the goods will range from relatively inexpensive to very expensive, but this will not mean a high level of attention will be paid to the category of goods in general, and I find the purchase will not be one generally undertaken by the public with a particularly heightened level of care. The general public will likely consider various factors when purchasing the goods, including the type, taste and alcoholic content, and so I find a medium level of attention will be paid. In respect of professionals, it is my view their attention will be enhanced due to the increased responsibility of purchasing these

goods on behalf of a business, and the increased liability that will come with serving or selling the goods to consumers. I find the professional consumer will likely pay at least an above medium degree of attention when making a purchase.

59. Where these goods are purchased in a retail environment, the consumer will rely predominantly on the visual inspection of the goods on shelves. Where the goods are purchased in a café, bar, restaurant, pub or nightclub, again this will be a predominantly visual purchase with marks most likely being displayed on and chosen from a drinks menu or displayed on the bottles or boards visible behind the bar. However, I consider that verbal orders will often be placed in these scenarios, and as such aural considerations cannot be completely discounted. I find that professionals will also make predominantly visual purchases, although on occasion orders may be placed verbally and so I also cannot completely disregard the aural comparison in respect of professionals either.

Distinctive character of the earlier trade mark

60. 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-0000, 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).”

61. I have not been provided with any evidence of use of the earlier mark, and as such I only have the inherent position to consider.

62. I do not consider that the earlier mark is descriptive or allusive of the goods themselves. Earlier in this decision, I noted that the element CROSS KEYS may be considered by some consumers as a reference to a geographical location. However, I did not consider that this will convey to the vast majority of consumers a particular geographical location, and there is no evidence to suggest that there is a location named CROSS KEYS which has a particular association with the goods themselves. Further, I did not find this would be the case in respect of all relevant consumers, with a significant portion interpreting this as simply conveying the concept of crossed keys. The element GIN adds nothing to the distinctive character of the mark in relation to these goods, which overall I find to be medium.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion

63. Prior to reaching a decision under Section 5(2)(b), I must first consider all relevant factors, including those as set out within the principles A-K at paragraph 23 of this decision. I must view the likelihood of confusion through the eyes of the average consumer, 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 they have kept in their mind. I must consider the level of attention paid by the average consumer, and consider the impact of the visual, aural and conceptual similarities of the marks by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. I must consider that the level of distinctive character held by the earlier mark will have an impact on the likelihood of confusion. I

must remember that the distinctiveness of the common elements is key.⁴ I must keep in mind that a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa. I must also consider that both the degree of attention paid by the average consumer and how the goods are obtained will have a bearing on how likely the consumer is to be confused.

64. There are two types of confusion that I may find. The first type of confusion is direct confusion. This occurs where the average consumer mistakenly confuses one trade mark for another. The second is indirect confusion. This occurs where the average consumer notices the differences between the marks, but due to the similarities between the common elements, they believe that both products derive from the same or economically linked undertakings.⁵

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

The first and third contested marks

66. I found the first and third contested marks to be similar to the earlier mark visually to between a medium and high degree, aurally to a medium degree and conceptually to between a medium and high degree. I found the goods to range from similar to a fairly high degree to dissimilar. I found that the earlier mark holds a medium degree of distinctive character based on the element CROSS KEYS. I found the general public will pay a medium level of attention to the goods, whereas the professional consumer would pay an above medium level of attention in respect of the same. I consider that CROSS KEYS/Crosskeys is the dominant and distinctive element in each of the marks, and it is the element of the mark that will provide the consumer with the

⁴ See *Kurt Geiger v A-List Corporate Limited*, BL O-075-13, in which Mr Iain Purvis Q.C. as the Appointed Person pointed out that the level of 'distinctive character' is only likely to increase the likelihood of confusion to the extent that it resides in the element(s) of the marks that are identical or similar.

⁵ *L.A. Sugar Limited v Back Beat Inc*, BL O/375/10

strongest concept. With consideration to the principle of imperfect recollection, it is my view that the element 1654 and the descriptive wording may easily go unnoticed or be forgotten by the consumer when recalling the marks. Considering all of these factors, it is my view that, at least in respect of the general public, there will be a likelihood of direct confusion between these marks where there is at least a low degree of similarity between the goods.

67. Where the goods are considered dissimilar, an invalidation based on section 5(2)(b) of the Act must fail. This applies in respect of the following goods as registered under the third contested mark:

Class 25: Clothing, shirts and head gear.

The second contested mark

68. In respect of the second contested mark, I found there to be a low to medium level of visual, aural and conceptual similarity between the marks. I remind myself that I found the earlier mark holds a medium degree of distinctive character based on the element CROSS KEYS. In respect of this contested mark I found the goods to be identical, and I found that the consumers will include members of the general public paying a medium degree of attention to the goods, in addition to professionals who will pay an above medium level of attention in respect of the same. Considering the relevant factors, keeping in mind the consumers imperfect recollection and notwithstanding the fact that the identity of the goods can help to outweigh the differences between the marks, it is my view that in this instance the differences between the marks, particularly due to the addition of 'Lady Of The Island' at the beginning of the same, are too great to be misremembered entirely by the consumer. I therefore find no likelihood of direct confusion between the earlier mark and the second contested mark.

69. I move on to consider if there is a likelihood of indirect confusion between the marks. In *L.A. Sugar* Mr Iain Purvis Q.C. (as he then was), as the Appointed Person set out three examples of when indirect confusion may occur as below:

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (“26 RED TESCO” would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as “LITE”, “EXPRESS”, “WORLDWIDE”, “MINI” etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (“FAT FACE” to “BRAT FACE” for example).”

70. I note that the examples above were intended to be illustrative and are not exhaustive. However, I also note *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, in which Arnold LJ referred to the comments of James Mellor QC (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (O/219/16), where he said at [16] that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion”. Arnold LJ agreed, pointing out that there must be a “proper basis” for concluding that there is a likelihood of indirect confusion where there is no likelihood of direct confusion.

71. In *Whyte and Mackay Ltd v Origin Wine UK Ltd and Another* [2015] EWHC 1271 (Ch), Arnold J. (as he then was) considered the impact of the CJEU’s judgment in *Bimbo*, Case C-591/12P, on the court’s earlier judgment in *Medion v Thomson*. The judge said:

“18 The judgment in *Bimbo* confirms that the principle established in *Medion v Thomson* is not confined to the situation where the composite trade mark for

which registration is sought contains an element which is identical to an earlier trade mark, but extends to the situation where the composite mark contains an element which is similar to the earlier mark. More importantly for present purposes, it also confirms three other points.

19 The first is that the assessment of likelihood of confusion must be made by considering and comparing the respective marks — visually, aurally and conceptually — as a whole. In *Medion v Thomson* and subsequent case law, the Court of Justice has recognised that there are situations in which the average consumer, while perceiving a composite mark as a whole, will also perceive that it consists of two (or more) signs one (or more) of which has a distinctive significance which is independent of the significance of the whole, and thus may be confused as a result of the identity or similarity of that sign to the earlier mark.

20 The second point is that this principle can only apply in circumstances where the average consumer would perceive the relevant part of the composite mark to have distinctive significance independently of the whole. It does not apply where the average consumer would perceive the composite mark as a unit having a different meaning to the meanings of the separate components. That includes the situation where the meaning of one of the components is qualified by another component, as with a surname and a first name (e.g. BECKER and BARBARA BECKER).

21 The third point is that, even where an element of the composite mark which is identical or similar to the earlier trade mark has an independent distinctive role, it does not automatically follow that there is a likelihood of confusion. It remains necessary for the competent authority to carry out a global assessment taking into account all relevant factors.”

The first and third contested marks

72. I consider again that the elements CROSS KEYS / Crosskeys are the most dominant and distinctive element in each of these marks. Keeping in mind the

consumer's imperfect recollection, it is my view that they are unlikely to recall or notice the addition or omission of the space within these elements, which in my view will likely be recalled as identical in both the earlier mark and the contested marks. I find these elements play an independent distinctive role in each mark. Considering all of the factors, it is my view that should the other differences between the marks be noticed, it would be entirely logical for the consumer to consider the dominant and distinctive element CROSS KEYS / Crosskeys located at the beginning of each mark to be an independent indicator of the economic origin of the goods. I find it likely the element 1654 may be considered to indicate a sub-brand or brand extension in relation to the similar goods, with 1654 possibly alluding to a particular year and possibly to a particular recipe or production method originating in that year for example, or to a particular batch number. The rest of the wording, being entirely descriptive, will likely just be considered to describe the similar goods offered by the same entity. I therefore find there to be a likelihood of indirect confusion between these marks in respect of all of the similar goods. Where there is no similarity between the goods, I reiterate here that the opposition under section 5(2)(b) of the Act must fail.

The second contested mark

73. As set out earlier in this decision, the submissions filed on behalf of Mr Hurl argue that the element Crosskeys does not retain an independent role within this trade mark. However, as I have previously mentioned, I am not convinced that, at least for a significant portion of consumers, the word 'Crosskeys' in the mark will be interpreted as a reference to the name of the island, and for this reason it is my view this does not form a unit with the earlier element Lady Of The Island as is submitted. On the contrary, it is my view this element does retain an independent distinctive role within this contested mark. I agree with Mr Hurl's submissions that the word GIN is not distinctive in respect of the goods, and I find that the element IRISH GIN in the contested mark will also be considered as a descriptive element indicating the goods themselves.

74. As it is my view that both CROSS KEYS and Crosskeys maintain an independent distinctive role within each of the marks, I must consider whether it follows that there will be a likelihood of indirect confusion between the marks. I consider that, in my

experience, it would not be uncommon in the spirits sector for a single producer of gin to offer a range of different types of the product. It is my view that in this instance, the use of the two elements 'Lady Of The Island' and 'Crosskeys' within the mark as a whole, may easily and logically be perceived by the consumer as the combination of two marks, namely a mark representing of a particular variety or sub brand of the gin ('Lady Of The Island') followed by a house mark ('Crosskeys'). I find the likelihood of the mark being perceived in this way will be exacerbated where consumers have already come across the earlier mark CROSS KEYS GIN. As previously stated, it is my view that consumers are highly likely not to notice or to misremember the addition of the space between CROSS and KEYS in the earlier mark or the lack thereof in the contested mark and will perceive this as an identical element indicating that the marks represent two different versions of a gin deriving from the same economic origin. I therefore find there to be a likelihood of indirect confusion in respect of the marks.

Final Remarks

75. The opposition filed against the application no. 3484415 has succeeded in its entirety, and subject to any successful appeal, the application will be refused.

76. The application for invalidation filed against registration no. 3484414 has succeeded in its entirety, and subject to any successful appeal, the registration will be considered invalid.

77. The application for invalidation against application no. 3300022 has been partially successful, and subject to a successful appeal, the registration will be considered invalid in respect of following goods:

Class 33: Irish Whiskey.

78. However, this mark will remain registered in respect of the following goods:

Class 25: Clothing, shirts and head gear.

COSTS

79. Amber has been mostly successful across the three sets of proceedings and is entitled to a contribution towards its costs. In the circumstances I award the costs in the consolidated proceedings as follows:

Prior to consolidation

OP000422038

Official fees:	£100
Preparing and filing the TM7 and considering the TM8 and counterstatement:	£200

CA000503475

Official fees:	£200
Preparing and filing the TM26(I) and considering the TM8 and counterstatement:	£200

CA000503476

Official fees:	£200
Preparing and filing the TM26(I) and considering the TM8 and counterstatement:	£200

Following consolidation

Preparing and filing written submissions within the proceedings:	£500
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Total:	£1600
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80. I therefore order Vincent Hurl to pay AMBER BEVERAGE GROUP the sum of £1600. The above sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

Dated this 6th day of March 2023

**Rosie Le Breton
For the Registrar**