

O/0453/23

TRADE MARKS ACT 1994

IN THE MATTER OF

TRADE MARK APPLICATION NO. 3606112

IN THE NAME OF JACK & VICTOR LTD.

AND

OPPOSITION THERETO UNDER NO. 426788

BY JACK DANIEL'S PROPERTIES, INC.

Background and pleadings

1. This decision concerns an opposition brought by Jack Daniel's Properties, Inc. ("the opponent") against an application by Jack & Victor Ltd ("the applicant") for the trade mark "JACK & VICTOR", under number 3606112. The trade mark was filed on 8 March 2021 and was subsequently published for the following list of goods and services:

Class 21: Glasses, drinking vessels and barware; Jugs; Bottles.

Class 32: Beer; Flavoured beers; Low-alcohol beer; Lager; Lager tops; Shandy.

Class 33: Alcoholic spirits; Whisky; Whiskey; Bourbon; Rye Whisky; Cream Whisky; Gin; Flavoured Gin; Vodka; Rum; Flavoured alcoholic spirits; Liqueurs; but not cocktails.

Class 35: Retail services connected with the sale of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits, flavoured beer, low-alcohol beer, lager, lager tops, shandy, but not cocktails provided via retail stores, mail order or by means of telecommunications but not via bars and other licensed premises; Promotion of products and services of third parties through sponsoring arrangements; Supply chain management services; Loyalty, incentive and bonus program services.

Class 39: Packaging, storage, delivery and/or transportation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits but not cocktails.

Class 40: Distillation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, and/or other spirits; Distillation services.

2. The application is opposed under ss. 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 ("the Act") and is directed against all of the goods and services in the specification. The opponent filed a notice of opposition in which it relied upon eleven earlier trade marks. All but one of these is subject to the use requirements at s. 6A of the Act. In its skeleton

argument, the opponent identified the terms for which, it says, the evidence supports a finding of genuine use.¹ Consequently, the basis of the opposition under s. 5(2)(b) now appears to be:

	Mark number & relevant dates	Trade mark	Specification relied upon
1.	UK 910532984 Filed: 29.12.2011 Registered: 9.5.2012	JACK	Class 33: Alcoholic beverages; including prepared alcoholic cocktails, and specially excluding cider and perry.
2.	UK 900154211 Filed: 1.4.1996 Registered: 29.9.1998	JACK DANIEL'S	Class 33: Alcoholic beverages (except beers).
3.	UK 2168987 Filed: 10.6.1998 Registered: 18.6.1999	JACK DANIEL'S	Class 21: Glass and plastic drinking containers, glassware, food and beverage containers.
4.	UK 912179438 Filed 27.9.2013 Registered: 19.2.2014	JACK DANIEL	Class 33: Alcoholic beverages; including distilled spirits.
5.	UK 906329081 Filed 5.10.2007 Registered: 29.8.2008	GENTLEMAN JACK	Class 33: Alcoholic beverages; including distilled spirits.

¹ §24.

6.	UK 911569886 Filed: 13.2.2013 Registered: 24.6.2013	JACK HONEY	Class 33: Alcoholic beverages; including distilled spirits.
7.	UK 910221851 Filed: 26.8.2011 Registered: 8.1.2012	WINTER JACK	Class 33: Alcoholic beverages, including pre-mixed alcoholic cocktails.
8.	UK 905151535 Filed: 21.6.2006 Registered: 18.5.2007	JACK LIVES HERE	Class 33: Alcoholic beverages, including, distilled spirits.
9.	UK 913429121 Filed 4.11.2012 Registered: 18.5.2017	JACK ROCKS	Class 33: Alcoholic beverages, except beers. Class 36: Sponsoring music events featuring a variety of activities, namely, music in the nature of live entertainment by music artists and musical groups, music exhibitions, festivals, and contests related thereto.

3. The opponent contends that due to the similarity between the trade marks and the identity or similarity of the goods and services, the application should be refused under s. 5(2)(b). It says that there is a likelihood of confusion with the earlier trade marks both individually and because they are part of a family of trade marks.

4. The opponent also says that its “JACK”, “JACK DANIEL’S” and “GENTLEMAN JACK” trade marks have a reputation for the goods now relied upon. The contested mark would, the opponent claims, create a link in the mind of the consumer, who would assume that the users of the marks were economically connected. In addition, use of the contested mark would give rise to unfair advantage, or be detrimental to the reputation and

distinctive character of the earlier marks. Consequently, the application should be refused under s. 5(3).

5. The opponent further claims that its use of the signs “JACK” and “JACK DANIEL’S” has resulted in a protectable goodwill in relation to the following goods and services:

Glassware; alcoholic beverages; distilled spirits; whiskey; retail services connected with the sale of glassware, alcoholic beverages, distilled spirits, whiskey; advertising; packaging and storage of glassware, alcoholic beverages, distilled spirits, whiskey; distillation of alcoholic beverages, distilled spirits, whiskey; services for providing drink.

6. It says that use of the contested mark would cause a misrepresentation to the relevant public and damage to the opponent’s goodwill. It therefore asserts that the application should be refused under s. 5(4)(a).

7. The applicant filed a counterstatement in which it denies the grounds and put the opponent to proof, including a request that genuine use be demonstrated for all of the earlier marks to which s. 6A of the Act applies. I note in particular that the applicant points to the name “Jack” being a common one and to its own reputation for a television programme with which, it says, “Jack & Victor” has become synonymous.

8. A hearing was requested and held before me, by videoconference, on 22 December 2022. The opponent was represented by Julius Stobbs of Stobbs and the applicant was represented by Jamie Watt of Harper Macleod LLP.

Evidence

9. Both parties filed evidence.

10. The opponent’s evidence is provided by two witnesses. The first is Justin Welch, who is the President of the opponent. His evidence mainly goes to the use of the earlier marks/signs in the UK, though there is also a small amount of evidence about the applicant’s use of the contested mark.

11. The opponent's second witness is Joel McDonald, a trade mark attorney with the opponent's professional representatives. His evidence consists of reports showing the popularity of the applicant's television show and broadcasting reports from Ofcom.

12. The applicant's evidence is provided by Greg Hemphill, one of the founders of the applicant. Most of his evidence concerns two television programmes featuring the Jack and Victor characters and associated stage shows. There is also a small amount of evidence about different types of whisky, its history and marketing.

13. None of the witnesses was cross-examined.

14. I have read all of the evidence. I will refer to it, as appropriate, in the course of this decision.

Preliminary issue: specification amendment

15. On 16 December 2022, the applicant filed a form 21B to limit the specification in classes 33, 35, 39 and 40. A number of goods were deleted and limitations were proposed. The amended specification is shown below, with the limitations at issue underlined:

Class 33: Alcoholic spirits excluding Bourbon, Tennessee Whiskey, Rye Whisky and Whiskey; Scotch Whisky; Gin; Flavoured Gin; Vodka; Rum; Flavoured alcoholic spirits (but excluding those containing Bourbon, Tennessee Whiskey, Rye Whisky or Whiskey); Liqueurs (but excluding those containing Bourbon, Tennessee Whiskey, Rye Whisky or Whiskey); but not cocktails.

Class 35: Retail services connected with the sale of alcoholic spirits, Scotch whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits, flavoured beer, low-alcohol beer, lager, lager tops, shandy, but not cocktails or spirits being or containing Bourbon, Tennessee Whiskey, Rye Whisky or Whiskey, provided via retail stores, mail order or by means of telecommunications but not via bars and other licensed premises; Promotion of products and services of third parties

through sponsoring arrangements; Supply chain management services; Loyalty, incentive and bonus program services.

Class 39: Packaging, storage, delivery and/or transportation of alcoholic spirits, Scotch whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits but not cocktails or spirits being or containing Bourbon, Tennessee Whiskey, Rye Whisky or Whiskey.

Class 40: Distillation of alcoholic spirits, Scotch whisky, gin, flavoured gin, vodka, rum, and/or other spirits; Distillation services; all of the aforesaid excluding such services in so far as they relate to spirits being or containing Bourbon, Tennessee Whiskey, Rye Whisky or Whiskey.

16. Limitations to specifications were considered in the judgment of the Court of Justice of the European Union (“CJEU”) in *Koninklijke KPN Nederland NV v Benelux-Merkenbureau (“Postkantoor”)*, C-363/99, EU:C:2004:86. That case concerned an application to register the Dutch words for “Post Office” for “the services of direct-mail campaigns and the issue of postage stamps, provided they are not connected with a post office” (emphasis added). The CJEU answered the question relevant for present purposes as follows:

“114. [...] where registration is applied for in respect of particular goods or services, it cannot be permitted that the competent authority registers the mark only in so far as the goods or services concerned do not possess a particular characteristic.

115. Such a practice would lead to legal uncertainty as to the extent of the protection afforded by the mark. Third parties — particularly competitors — would not, as a general rule, be aware that for given goods or services the protection conferred by the mark did not extend to those products or services having a particular characteristic, and they might thus be led to refrain from using the signs or indications of which the mark consists and which are descriptive of that characteristic for the purpose of describing their own goods.”

17. The specific requirement for legal certainty identified in the *Postkantoor* case arose again in *Chartered Institute of Patent Attorneys v Registrar of Trade Marks (“IP Translator”)*, C-307/10, EU:C:2012:361, where the CJEU ruled that:

“Directive 2008/95 requires the goods and services for which the protection of the trade mark is sought to be identified by the applicant with sufficient clarity and precision to enable the competent authorities and economic operators, on that basis alone, to determine the extent of the protection sought.”

18. As Sales J. noted in *Total Limited v YouView TV Limited* [2014] EWHC 1963 at [57], the CJEU in *IP Translator* did not find that any degree of uncertainty about the meaning of a word or phrase used in a specification should result in the refusal or invalidation of the trade mark. The issue only arises when a lack of clarity and precision in the specification creates an unacceptable level of uncertainty about the scope of protection to which the trade mark is entitled.

19. The opponent says that the limitation is not acceptable for two reasons. First, Mr Stobbs submitted that a specification should clearly indicate the coverage of a trade mark. He submitted that the limitation is not acceptable either because the average consumer will not understand that “whiskey” and “whisky” are different goods or because “whiskey” will be seen as a misspelling of “whisky”. Secondly, he submitted that the limitations in classes 39 and 40, though it is less clear cut in relation to the latter, are unacceptable because it is impossible to understand the distinction between the services covered and those excluded. For example, it is not possible to identify the difference between packaging services for whiskey and packaging services for Scotch whisky.

20. Mr Watt submitted that whiskey and whisky are fundamentally different products and that it is like comparing apple juice and orange juice: the average consumer knows the difference between the two. He said that the relevant market is primarily whisky/whiskey drinkers and that the evidence showed that whisky/whiskey drinkers know the difference.

21. There is some evidence concerning the distinction between “whiskey” and “whisky”. An undated article from “The Whisky Shop Blog” titled “Bourbon v Scotch: What’s the

Difference” uses “whisky” in relation to Scotch.² It uses “whiskey” for bourbon but I also note that it says “going stateside, for a whiskey to be considered a bourbon the grain mash must be at least 51 percent corn [...]” and refers to “bourbon whiskey”. This suggests that “bourbon” and “whiskey” are not interchangeable but that bourbon is a subset of “whiskey”. This view finds support in the *Collins English Dictionary* definition of “bourbon”, which begins “a whiskey distilled, chiefly in the US, from maize...”.³

22. There is also an article from *Whisky Magazine* (also undated).⁴ It is said to be an industry magazine. It appears that “whisky” is used as an umbrella term: there are references to “whiskey”, in relation to the US market, and to “Scotch”. The article includes mention of “Jack Daniel’s”, which is said to be the international leader in the “American whiskey” market, with “Jack” being “Tennessee whiskey”.

23. Bourbon, Tennessee whiskey and rye whiskey are all different types of whiskey (or whisky). I see no reason why it would not be acceptable to exclude these goods from the specification in class 33. However, the limitation proposed is ambiguous. One interpretation is that “whisky and whiskey” all reads back to “rye”, so that the exclusion is in effect for “rye whisky” and “rye whiskey”. Mr Stobbs’ submissions were made on the basis that “rye whisky and whiskey” means “rye whisky” and “whiskey” separately. Mr Watt did not contend that the former meaning was intended; on the contrary, his submissions focused on the assertion that whisky and whiskey are fundamentally different products.

24. The ambiguity means that those consulting the register may think that “whiskey” is excluded from the specification. The question then is whether this is an acceptable exclusion. I acknowledge that some people may understand “whiskey” to refer to Irish or American whiskey: the *Collins* online dictionary defines “whiskey” as “whisky that is made in Ireland or the United States” in its *COBUILD Advanced Learner’s Dictionary*.⁵ It also seems likely, based on the limited evidence available (that is not a criticism of the parties,

² Exhibit JV4 to Mr Hemphill’s statement.

³ <https://www.collinsdictionary.com/dictionary/english/bourbon> [accessed 25 April 2023].

⁴ JV5.

⁵ <https://www.collinsdictionary.com/dictionary/english/whiskey> [accessed 5 April 2023].

the issue only came to the fore with the filing of the TM21B), that “whisky” will be seen as meaning “a spirit made by distilling fermented cereals, which is matured and often blended”, which includes “whiskey”.⁶ I accept that there will be sections of the relevant public who understand “whiskey” to mean whisky produced in Ireland or the USA. This is likely to include those in the drinks trade and end users who have a particular interest in whiskies but will not necessarily be restricted to these groups. However, it is also likely that there will be a significant proportion of consumers, more likely only occasional drinkers or purchasers of whisky, who do not understand the nuance of the spelling and who may either not notice the difference at all or assume that the spellings are variations with no accompanying change in the goods. In this regard, the *Collins English Dictionary* says that “whiskey” is the usual Irish or US spelling of “whisky”, while the *Cambridge* online dictionary defines “whiskey” as “US or Irish English (UK **whisky**) a strong, pale brown alcoholic drink, originally from Scotland and Ireland, made from grain such as barley, corn, or rye”.⁷ I also note that Amazon UK listings for the opponent’s branded glassware use both “whiskey” and “whisky”.⁸ This supports my view that a significant proportion of consumers will perceive whiskey and whisky as variant spellings, or misspellings, rather than as indicating distinct products. Consequently, excluding “whiskey” does not indicate with sufficient precision the whiskies which are included in the specification and those which are not. This applies to the limitation sought in all of the classes in the specification.

25. The opponent had no other objection to the limitation in class 35. Bearing in mind the close relationship between the goods and corresponding retail services, and that it is not unusual for a retailer to specialise in one type of alcoholic beverage, I am prepared to accept that the limitation would be acceptable, save for the reference to “whiskey” which is, for the reasons given above, insufficiently clear.

26. As regards class 39, Mr Stobbs submitted that there is no distinction between the services which relate to the different goods and that it is impossible to understand the

⁶ <https://www.collinsdictionary.com/dictionary/english/whisky> [accessed 5 April 2023].

⁷ <https://dictionary.cambridge.org/dictionary/english/whiskey> [accessed 6 April 2023].

⁸ JW24.

distinction between packaging services for the goods within the specification and those which are excluded.

27. In *MERLIN Trade Mark* (BL O/043/05) [1997] R.P.C. 871 at [27]–[28], Arnold J. (as he then was) held when sitting as the Appointed Person that the disclaimer “but not including the provision of venture capital” was acceptable, because it was not framed by reference to the absence of particular characteristics of the services, but rather it was a restriction on the scope of the services embraced by the specification. Accordingly, “the effect of [the disclaimer] is simply to excise a particular service from the specification. The mere fact that it is more convenient to express it in negative than positive terms does not make it objectionable.”

28. He also allowed a second disclaimer “and not including the provision of any such services to the pharmaceutical biotechnological [or] bioscientific sectors” for reasons he expressed at [29] as follows:

“The position with regard to the second disclaimer is more debatable, but in my judgment the disclaimer does not relate to a characteristic of the services. I consider that there is a distinction between goods and services here. An article of clothing is an article of clothing regardless of whether it is of a particular style or quality and regardless of the identity and proclivities of the intended purchaser. By contrast, services can be defined in part by the recipient of the service. The opponent’s registration is an example of this, since both the Class 35 and the Class 36 specification are limited to services provided to the pharmaceutical biotechnological and bioscientific sectors. In my view *POSTKANTOOR* does not make it impermissible to define services in this way. That being so, I consider that it makes no difference if the definition is expressed negatively rather than positively.”

29. Although the limitation sought in the present case is to be applied to services rather than goods, which may require a different approach, my view is that the limitation is not acceptable. I accept that packaging, storage, delivery and transportation services covers a very wide range of services used for many different goods. It is possible that such

services will be materially different depending on the goods to be transported. For example, the packaging, storage, transport and delivery of hazardous waste is likely to involve a series of authorisations, precautions and special measures which are alien to the transport etc. of everyday foodstuffs to retailers. However, it is artificial to excise the transport etc. of particular alcoholic beverages from a specification covering those goods: there is no reason to suppose that there is any material difference in the services provided in relation to, for example, Scotch compared to bourbon. For that reason, the exclusion of “cocktails” from the specification in class 39 is also, in my view, unacceptable, because it does not exclude a category of services.

30. In relation to the distillation services in class 40, my view is that the limitation would be acceptable were it not for the reference to “whiskey”, discussed above. It is true that distillation services are likely to share some similar features. However, the end product is a different spirit and there is no obvious reason why a distillery would not produce only one type of spirit, as appears to be the case for many whisky distilleries. The limitation is one which restricts by category rather than a characteristic.

31. There was a more general objection to the limitation of the goods and services to exclude “cocktails”. Apart from the services in class 39, I do not think that this objection is well founded. Whilst I accept that there may be some imprecision at the limits regarding whether certain drinks may be classed as cocktails or, for example, whether a drink such as a gin and tonic is a mixed drink but not a cocktail, the average consumer is likely to consider cocktails a discrete category of alcoholic beverage. The limitation to exclude these goods and related services in classes 33 and 35 is valid.

32. Mr Stobbs accepted that the limitation was unlikely to have any impact on the substance of the relative grounds case. However, as I have found the limitation to be unacceptable, I will disregard it for the purposes of this decision. I will also disregard the exclusion of “cocktails” from the specification in class 39.

Approach

33. Although it was included in the notice of opposition, the opponent's skeleton argument does not list UK 2024025 ("JACK DANIEL'S", registered in class 33 for "whiskey", with a registration date of 13 September 1996) among the trade marks relied upon. It is not clear whether this was deliberate, as at the hearing Mr Stobbs indicated that there was no abandonment of any of the trade marks relied upon. However, UK 2024025 puts the opponent in no better a position than UK 900154211, because the trade marks are identical, the latter has a wider specification than "whiskey" alone and both are subject to proof of use. The reliance on UK 2024025 therefore appears unnecessarily duplicative. Any findings in respect of UK 900154211, to the extent they relate to whiskey, will also apply to UK2024025 and I do not intend to consider this mark separately.

34. Whilst not formally abandoning the case based upon any of the trade marks, and whilst stressing that all of the marks are relevant to the "family of marks" argument and to the assessment of confusion, Mr Stobbs accepted that the opponent's best case under s. 5(2)(b) rests in its "JACK", "JACK DANIEL'S" and "JACK ROCKS" trade marks. I will focus on these marks to begin.

Proof of use

35. The proof of use provisions are at s. 6A of the Act, which at the contested mark's date of application ("the relevant date") read:

"6A—(1) This section applies where

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

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (b) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if –

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

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

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

(5A) In relation to an international trade mark (EC) the reference in subsection (1)(c) to the completion of the registration procedure is to be construed as a reference to the publication by the European Union Intellectual Property Office of

the matters referred to in Article 190(2) of the European Union Trade Mark Regulation.

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

36. Where the earlier marks are comparable marks, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

“7.— (1) Section 6A applies where an earlier trade mark is a comparable trade mark (EU), subject to the modifications set out below.

(2) Where the relevant period referred to in section 6A(3)(a) (the "five-year period") has expired before IP completion day—

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM; and

(b) the references in section 6A(3) and (4) to the United Kingdom include the European Union.

(3) Where [IP completion day] falls within the five-year period, in respect of that part of the five-year period which falls before IP completion day —

(a) the references in section 6A(3) and (6) to the earlier trade mark are to be treated as references to the corresponding EUTM ; and

(b) the references in section 6A to the United Kingdom include the European Union”.

37. In *Walton International Ltd & Anor v Verweij Fashion BV* [2018] EWHC 1608 (Ch) Arnold J. (as he then was) summarised the law relating to genuine use as follows:

“114. [...] The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundesvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Marken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

115. The principles established by these cases may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Leno* at [29]; *Centrotherm* at [71]; *Reber* at [29].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Leno* at [29]; *Centrotherm* at [71]. Accordingly, affixing of a trade mark on goods as a label of quality is not genuine use unless it guarantees, additionally and simultaneously, to

consumers that those goods come from a single undertaking under the control of which the goods are manufactured and which is responsible for their quality: *Gözze* at [43]-[51].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14] and [22]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71]; *Reber* at [29].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Leno* at [29]-[30], [56]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32]”.⁹

38. An assessment of genuine use requires a fair specification to be determined. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Geoffrey Hobbs Q.C., sitting as the Appointed Person, summed up the law as being:

“In the present state of the law, fair protection is to be achieved by identifying and defining not the particular examples of goods or services for which there has been genuine use but the particular categories of goods or services they should realistically be taken to exemplify. For that purpose the terminology of the resulting specification should accord with the perceptions of the average consumer of the goods or services concerned.”

39. In *Property Renaissance Ltd (t/a Titanic Spa) v Stanley Dock Hotel Ltd (t/a Titanic Hotel Liverpool) & Ors* [2016] EWHC 3103 (Ch), Mr Justice Carr summed up the law relating to partial revocation as follows (at [47]):

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification,

⁹ 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. This is why this decision continues to make reference to EU trade mark law.

and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch) ("Thomas Pink") at [52].

iv) In cases of partial revocation, pursuant to section 46(5) of the Trade Marks Act 1994, the question is how would the average consumer fairly describe the services in relation to which the trade mark has been used; *Thomas Pink* at [53].

v) It is not the task of the court to describe the use made by the trade mark proprietor in the narrowest possible terms unless that is what the average consumer would do. For example, in *Pan World Brands v Tripp Ltd* (Extreme Trade Mark) [2008] RPC 2 it was held that use in relation to holdalls justified a registration for luggage generally; *Thomas Pink* at [53].

vi) A trade mark proprietor should not be allowed to monopolise the use of a trade mark in relation to a general category of goods or services simply because he has used it in relation to a few. Conversely, a proprietor cannot reasonably be expected to use a mark in relation to all possible variations of the particular goods or services covered by the registration. *Maier v Asos Plc* [2015] EWCA Civ 220 ("Asos") at [56] and [60].

vii) In some cases, it may be possible to identify subcategories of goods or services within a general term which are capable of being viewed independently. In such cases, use in relation to only one subcategory will not constitute use in relation to all other subcategories. On the other hand, protection must not be cut down to those precise goods or services in relation to which the mark has been used. This would be to strip the proprietor of protection for all goods or services which the average consumer would consider to belong to the same group or category as those for which the mark has been used and which are not in substance different from them; *Mundipharma AG v OHIM* (Case T-256/04) ECR II-449; EU:T:2007:46."

40. The law on use of variant forms was considered in *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22. The Appointed Person said:

“13. [...] While the law has developed since *Nirvana* [BL O/262/06], the recent case law still requires a comparison of the marks to identify elements of the mark added (or subtracted) which have led to the alteration of the mark (that is, the differences) (see for instance, T-598/18 *Grupo Textil Brownie v EU*IPO*, EU:T:2020:22, [63 and 64]).

14. The courts, and particularly the General Court, have developed certain principles which apply to assess whether a mark is an acceptable variant and the following appear relevant to this case.

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v EUIPO*, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EUIPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

16. Thirdly, where a trade mark comprises two (or more) distinctive elements (eg a house mark and a sub-brand) it is not sufficient to prove use of only one of those distinctive elements: T-297/20 *Fashioneast v AM.VI. Srl*, EU:T:2021:432, [40] (I note that this case is only persuasive, but I see no reason to disagree with it). Fourthly, the addition of descriptive or suggestive words (or it is suppose figurative elements) is unlikely to change the distinctive character of the mark: compare, T-258/13 *Artkis*, EU:T:2015:207, [27] (ARKTIS registered and use of ARKTIS LINE sufficient) and T-209/09 *Alder*, EU:T:2011:169, [58] (HALDER registered and use of HALDER I, HALDER II etc sufficient) with R 89/2000-1 CAPTAIN (23 April 2001) (CAPTAIN registered and use of CAPTAIN BIRDS EYE insufficient).

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EUIPO*, EU:T:2022:109 where the General Court was considering whether the use of

various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

41. The relevant period is 9 March 2016 to 8 March 2021.

The “JACK DANIEL’S” mark

42. It is common ground that the slightly stylised “JACK DANIEL’S” mark which appears on the bottles of “Old No. 7 Tennessee whiskey” is an acceptable variant of the registered mark. There does not appear to be any dispute that “JACK DANIEL’S” has been used in relation to (and has a reputation for) a particular alcoholic spirit and drinks containing that spirit; the issue is the name of that spirit and the fair specification which should result. Mr Watt accepted at the hearing that there has been use of the “JACK DANIEL’S” trade mark for bourbon and cocktails containing bourbon. According to the applicant, Tennessee whiskey is bourbon. Mr Stobbs said that the opponent disputes that Tennessee whiskey is bourbon.

43. “JACK DANIEL’S” whiskey has been sold in the UK and EU since 1997.¹⁰ From 2010 to 2020, between 983,000 and 1.26 million 9-litre cases of the “Jack Daniel’s Tennessee Whiskey” product were sold each year in the UK.¹¹ The retail value of such sales has been consistently in excess of \$340 million per annum; since 2015, it has not dropped below \$420 million per year. This product has had a market share of the spirits market by volume of at least 3.2% since 2010; between 2015 and 2020 its market share by retail value fluctuated between 4.29% and 5.23%. In 2021, Jack Daniel’s was reported to be the UK’s favourite whiskey, with the brand having “gained an extra £62.5m- more than all

¹⁰ Welch, §10.

¹¹ JW16.

its rivals in the top 100 combined”.¹² It appears that the whiskey was among the top ten biggest alcohol brands in Britain in 2017, 2018 and 2020 (as well as 2021).¹³

44. In my view, it is clear from the evidence that “JACK DANIEL’S” had by the relevant date been used in the UK on a substantial scale in relation to Tennessee whiskey.

¹⁴ The label is shown below:¹⁵



46. UK sales of this beverage were worth at least \$65 million each year between 2016 and 2020.¹⁶

47. In addition, the evidence shows that the “Jack Daniel’s Winter Jack” product achieved UK sales of more than \$3 million in 2016, \$2 million in 2017 and \$163,000 in 2018.¹⁷ This drink is described as an “apple whiskey punch”. The label is shown below:¹⁸

¹² JW41.

¹³ JW41.

¹⁴ See, for example, JW22.

¹⁵ See, for example, JW17, p. 38.

¹⁶ JW16.

¹⁷ JW16.

¹⁸ JW26, p. 6; JW17.



48. I am satisfied that “JACK DANIEL’S” had by the relevant date been used in relation both to a honey-whiskey drink and in relation to an apple whiskey punch on a scale sufficient to constitute genuine use. The mark used only differs from the accepted variant use because it is in a dark typeface on a pale background rather than white on black. It is minimally stylised and an acceptable variant of the registered mark.

49. In terms of a fair specification in class 33, the “JACK DANIEL’S” trade mark has been used in relation to whiskey. It is clear from the evidence that it is used as a house brand for other beverages and frequently on labels as shown at paragraphs 45 and 47, above. Both the Winter Jack and Tennessee Honey drinks are whiskey-based beverages. Mr Stobbs referred to the Tennessee Honey drink as a liqueur. That is how it appears on the label. However, there is no other evidence of a liqueur sold by the opponent, nor is there evidence of any punch other than the Winter Jack drink. Mr Stobbs accepted at the hearing that the opponent’s business is primarily whisky and whisky-based beverages. He contended that “alcoholic beverages” at large is appropriate for the fair specification. I do not agree. There are significant differences between different types of alcoholic beverages which constitute, in my view, distinct subcategories. However, I think it would be overly pernicky to limit the specification to the precise type of whisky sold. Taking all of the various factors into account, “whisky; whisky-based beverages” is a fair specification for the “JACK DANIEL’S” mark.

50. In relation to the goods in class 21, Mr Welch says that the JACK DANIEL'S marks have been licensed in the UK for glassware since 2017.¹⁹ He provides a print from the licensee's website of a gift set which includes a glass bearing the words "JACK DANIEL'S".²⁰ It is not dated. Prints from various websites show similar gift sets with "JACK DANIEL'S" branded glasses.²¹ A print from the Tesco site has a copyright date of 2021. A print from Amazon UK's website says the product was first available in August 2020. Pairs of "JACK DANIEL'S" branded glasses appear to have been sold on the Amazon UK website since 2014 and on the www.menkind.co.uk website between December 2020 and May 2021. A "JACK DANIEL'S" branded hip flask and tumbler set was first sold on Amazon UK in November 2017. The Amazon prints are not dated but it is a reasonable inference that they were printed around the date of Mr Welch's statement.

51. There is no evidence showing that any other goods in class 21 other than glassware have been offered for sale. I accept that some glassware bearing the "JACK DANIEL'S" brand has been offered for sale on various websites. I also accept that website such as Amazon have national reach. However, in the absence of any information regarding the level of sales of glassware, or any goods in class 21, I do not consider that the limited evidence establishes that the use is warranted in the sector. Genuine use has not been demonstrated in relation to any goods in class 21.

The "JACK" mark

52. The evidence shows that promotion of the "Jack Daniel's Old No. 7 Tennessee Whiskey" has included significant focus on the creator of the drink. There is, therefore, a good deal of evidence which includes the name "Jack" but much of it is in relation to the man. Some of the evidence is ambiguous rather than clear use by the opponent of "JACK" to designate a specific beverage or line of beverages. One example is an advertisement from 2018 titled "JACK & FRANK".²² The advertisement appears to have been accompanied by a piece which clarifies that the "Frank" in question is Frank Sinatra. There

¹⁹ Welch, §39.

²⁰ JW23

²¹ JW24.

²² JW3.

is nothing to suggest that “JACK & FRANK” as a combination was used as a trade mark to designate a particular drink. The piece includes statements such as, “[...] one sip of that smooth sippin’ whiskey was all it took. Jack was little known at the time, but Frank’s ever-present glass changed all of that in the years to follow. [...] the singer became widely known for traveling with an ample supply [...]”. I accept that, even if the consumer’s first impression is not of “JACK” as a drink, by the time they have read the article consumers will have understood the play on meanings.

53. Photographs dated 2017 show the following promotional sign in UK shop windows:²³



54. There is also an image of a neon sign, dated 2019, which shows “JACK LIVES HERE” above “Old No. 7”, along with undated images of that sign in situ, both of which appear to be in bars.

55. There is some evidence that the opponent’s whiskey was sold in a gift box bearing the word “JACK” alone at nine outlets of The Whiskey Shop in December 2020.²⁴ The outlets are in various locations in England. An invoice to The Whiskey Shop’s operator does not show the quantity or sales figures.

²³ JW4.

²⁴ JW15.

56. Promotion from 2016 in *Metro* is headed “Kick Back with Jack”.²⁵ The latter is in relation to the “Jack Daniel’s Tennessee Honey” beverage. There is also a mention of “Jack Friday” and “A little bit of honey. A whole lot of Jack”.

57. The @jackdanielsuk Facebook page was created on 26 August 2009 and a print which appears to date from around the time of Mr Welch’s statement shows over 18 million followers.²⁶ Posts from 2016 and 2018 refer to “Jack Fridays”, the website www.jackfriday.co.uk and “Jack & Coke”, as well as “Jack” and “a bottle of Jack”.²⁷ These are accompanied by images of bottles of Jack Daniel’s whiskey, including the Old No. 7 Tennessee whiskey. There is also reference to “making every last drop of Jack” in an advertisement placed on the London Underground between January 2015 and 2019.²⁸ The exact date is not given but the proof was modified in September 2019.

58. There are videos which were released to a UK audience via social media channels in 2019.²⁹ Three promote drinks consisting of Jack Daniel’s whiskey and various mixers. One is referred to in the advertisement as “Jack & Colas”, a second advertisement invites consumers to “get ready for a weekend of more than just music with a Jack that’s more than just whiskey” and a third says “grab yourself a Jack that’s good to go”. An advertisement in German from May and November 2017 gives a recipe for “Jack & Cola”, which requires “1 part Jack”, alongside an image of “Jack Daniel’s” whiskey.³⁰ There is other advertising material which includes “JACK” prominently but it is not in English so the nature of the use cannot be determined.

59. Images from 2019, from the opponent’s UK Instagram and Twitter accounts, show the following poster accompanied by a post which reads, “Jack & Coke. Enjoyed together for many years”:³¹

²⁵ JW17.

²⁶ JW26. Mr Welch’s statement was given in April 2022. The most recent posts were also in April (year not specified).

²⁷ JW26.

²⁸ JW19; Welch §32.

²⁹ JW27.

³⁰ JW20.

³¹ JW7.



60. The Twitter page also shows a post which reads, “Music changes, but its power to bring people together doesn’t. Wherever there’s good music, you’ll find Jack”. A print dated August 2020 shows the jackdaniels_uk Instagram page, which features the comment: “Corr love a nice Jack and coke on a hot summers day”.³² “JACK” is visible in what appears to be part of the “JACK DANIEL’S” logo (i.e. that shown on bottles).

61. There is evidence of use of “JACK & COKE” in the format shown at paragraph 59, above, in relation to gift sets consisting of a glass, a bottle of Jack Daniel’s whiskey and a bottle of Coke, which were sold in major retailers as well as a “Jack & Coke bundle” consisting of the drinks alone.³³ The gift set was first available on Amazon UK in April 2021; the remaining prints cannot reliably be placed in the relevant period.

62. In the applicant’s evidence, there is also an article which discusses the market position of “Jack Daniel’s” whiskey.³⁴ Having introduced the brand in full, it is subsequently shortened to “Jack”.

63. An undated print from the Urban dictionary defines “jack on the rocks” as “a glass of jack Daniels [sic] whiskey with ice”, whilst a definition dated 2015 says that “jack and ginger” means “Jack Daniels [sic] whiskey and ginger ale soda”.³⁵ A Wikipedia print titled “Jack and Coke” says that “Jack and Coke (also referred to as JD and Coke, Jack Coke, or a Lemmy) is a cocktail made with Jack Daniel’s Whiskey and Coca-Cola”.³⁶ It says that

³² JW7.

³³ JW10, JW11, JW13

³⁴ JV5.

³⁵ JW8, JW9.

³⁶ JW5.

“Jack and Coke” was used in some combined advertising for the two brands but there are no further details. The content indicates it is from after 2016.

64. The results of a survey conducted in 2018 are in evidence.³⁷ Mr Welch says that the results show that there is a very high awareness among UK consumers of the brand element “JACK” as an indicator of origin of the “JACK DANIEL’S” brand. The question asked was, “Which company do you think makes an alcoholic drink named JACK” or “Which company do you think makes an alcoholic drink with Jack in its name?”.³⁸ No permission was requested to file survey evidence, as required by Tribunal Practice Notice 2/2012, though the applicant has not taken that point. More importantly, the survey does not comply with the requirements laid down in *Imperial Group plc & Another v Philip Morris Limited & Another* [1984] RPC 293, at least because the questions appear to be leading and the totality of the answers has not been provided. Even if it were admissible, the questions are an invitation to the respondents to guess and do not show that the respondents knew of the mark. It is of no evidential value.

65. There are no sales figures for any product bearing the “JACK” mark. This appears to be because the primary use of “JACK” has been to designate the whiskey labelled under the brand “JACK DANIEL’S”. As I have indicated, that whiskey has benefited from very substantial sales figures and a prominent position both as a leading whiskey in the UK and among UK alcohol brands in at least 2017, 2018 and 2020.

66. Although the evidence is not well focused, it is tolerably clear that “JACK” has been used by the opponent in relation to whiskey, albeit mainly as a shorthand for “JACK DANIEL’S”. Some of the use is ambiguous as to whether it concerns the man or the whiskey but statements such as “JACK LIVES HERE” juxtaposed with an image of a “JACK DANIEL’S” whiskey bottle are likely to be construed as being a reference to the drink being available in a venue rather than literally meaning that somebody called Jack lives there. On balance, given the sales figures for “JACK DANIEL’S” whiskey, the association between “JACK” and the whiskey itself in the advertising, and the evidence

³⁷ JW36.

³⁸ Welch, §52.

showing both the opponent and third parties before and during the relevant period using “Jack” to refer to the opponent’s whiskey, in particular in the combination “Jack and Coke” (or cola), I am satisfied that there has been sufficient use of the “JACK” mark to constitute genuine use in respect of whisky.

67. There is also some use of “JACK HONEY” in relation to the honey liqueur drink discussed above. The evidence shows promotion from 2016, which appeared in *Metro*, with the strap line, “Sweet like honey, smooth like Jack” or “A little bit of honey, a whole lot of Jack”.³⁹ Table menus from 2017 refer to the honey liqueur as “Jack Honey”, an advertisement reads “Kick back with Jack Honey” (it has a 2017 copyright date) and a print from the Jack Daniel’s Facebook page dated 26 February 2021 refers to “#JackHoney”, as do some of the comments.⁴⁰ I note two third-party references to “Jack Honey” in social media posts from 2019 and one comment on a retailer’s website from 2017.⁴¹ There are also Facebook pages from 2018 which refer to “Jack Honey”, shown alongside an image of the honey liqueur, and to “Honey over ice, done the Jack way. For that bold Jack character with a subtle taste of honey”.⁴²

68. There were no submissions at the hearing regarding whether either “JACK HONEY” or the “Winter Jack” sign shown on the packaging are acceptable use of the trade mark “JACK”. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the CJEU found that the “use” of a mark as part of a composite mark may still be genuine use if the registered trade mark continues to be perceived as indicating the origin of the product at issue. The relevant law on variant use is set out above in the extract from *Lactalis*.

69. As to whether “JACK HONEY” constitutes genuine use of “JACK”, “HONEY” is descriptive of an ingredient in the beverage and will be perceived as such. Although both words have an impact, “JACK” is the distinctive element of the combination. In my view, the use of “JACK HONEY” is qualifying use of “JACK”.

³⁹ JW17

⁴⁰ JW22, pp. 9, 14.

⁴¹ JW22.

⁴² JW26, p. 4

70. I also consider that “WINTER JACK” in its stylised form qualifies as use of “JACK”. While both words play a role in the mark, the balance of distinctiveness is in favour of “JACK”, which is qualified by “WINTER”. It is true that “WINTER” is not wholly descriptive but it is suggestive of a beverage to be drunk at a particular time of year. As regards the stylised presentation, in *Dreamersclub Ltd v KTS Group Ltd*, BL O/091/19, Mr Philip Johnson, as the Appointed Person, found that the use of the mark shown below qualified as use of the registered word-only mark DREAMS. This was because the stylisation of the word did not alter the distinctive character of the word mark. Rather, it constituted an expression of the registered word mark in normal and fair use. This is the mark used:



71. In my view, the same applies to the stylised presentation of “WINTER JACK”.

72. The levels of sales of each of these drinks were sufficient to amount to genuine use. I am, therefore, satisfied that “JACK” has been used in relation to an apple whiskey punch and whiskey/honey blended drink. That leaves the issue of a fair specification. I consider that “whisky; whisky-based beverages” is a fair specification for the “JACK” mark.

73. For completeness, I should also add that there is evidence of a whiskey sold in the UK since 2010 under the name “GENTLEMAN JACK”. Sales over the relevant period rose each year, from \$9.7 million in 2016 to more than \$28.5 million in 2020.⁴³ Although sales of this level are sufficient for genuine use, I do not consider that “GENTLEMAN JACK” constitutes acceptable variant use of “JACK”. By virtue of being a very common name, “JACK” has a weak inherent distinctive character which I consider to be altered by the addition of the qualifying “GENTLEMAN”. This term adds certain characteristics to the name “JACK” (be they class, behaviour, style of dress or all of the above). It is not an ancillary part of the mark but is a distinctive element which forms a coherent whole with the word “JACK”, changing the distinctive character of the latter.

⁴³ Sales figures are at JW16. Examples of the packaging in the relevant period can be seen at JW26.

Section 5(2)(b)

74. Section 5(2)(b) of the Act reads 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.”

75. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, EU:C:1997:528, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, EU:C:1998:442, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, EU:C:1999:323, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, EU:C:2000:339, *Matratzen Concord GmbH v OHIM*, Case C-3/03, EU:C:2004:233, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, EU:C:2005:594, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P, EU:C:2007:333, and *Bimbo SA v OHIM*, Case C-591/12P, EU:C:2016:591:

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

Comparison of goods and services

76. Mr Stobbs indicated at the hearing that the class 36 services in the “JACK ROCKS” trade mark’s specification are “not relevant” to the opposition under s. 5(2)(b). I understood this to mean that the opponent no longer relies, sensibly in my view, upon

these services under s. 5(2)(b). Bearing that in mind, along with my findings regarding the applicant's specification and proof of use, the goods and services to be compared are:

Earlier specifications	Contested specifications
<p>“JACK DANIEL’S” and “JACK”:</p> <p>Class 33: Whisky; whisky-based beverages.</p> <p>“JACK ROCKS”:</p> <p>Class 33: Alcoholic beverages, except beers.</p>	<p>Class 21: Glasses, drinking vessels and barware; Jugs; Bottles.</p> <p>Class 32: Beer; Flavoured beers; Low-alcohol beer; Lager; Lager tops; Shandy.</p> <p>Class 33: Alcoholic spirits; Whisky; Whiskey; Bourbon; Rye Whisky; Cream Whisky; Gin; Flavoured Gin; Vodka; Rum; Flavoured alcoholic spirits; Liqueurs; but not cocktails.</p> <p>Class 35: Retail services connected with the sale of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits, flavoured beer, low-alcohol beer, lager, lager tops, shandy, but not cocktails provided via retail stores, mail order or by means of telecommunications but not via bars and other licensed premises; Promotion of products and services of third parties through sponsoring arrangements; Supply chain management services; Loyalty, incentive and bonus program services.</p>

	<p>Class 39; Packaging, storage, delivery and/or transportation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits.</p> <p>Class 40: Distillation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, and/or other spirits; Distillation services.</p>
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77. In the judgment of the CJEU in *Canon*, 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”.

78. “Complementary” means that “[...] there is a close connection between [the goods/services], 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”.⁴⁴

79. Goods can be considered identical when the goods for which the earlier mark is entitled to protection are included in a more general category of goods in the specification of the later trade mark.⁴⁵

⁴⁴ *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, EU:T:2008:338.

⁴⁵ *Gérard Meric v Office for Harmonisation in the Internal Market*, T- 133/05, EU:T:2006:247.

Class 21

Glasses, drinking vessels and barware; Jugs; Bottles.

80. These goods differ in nature, purpose and method of use from all of the opponent's goods. Although users will overlap, this is not a significant point of similarity given that the average consumer of both is the general public (those over 18 in the case of the opponent's goods). The goods are not usually sold through the same trade channels or, in the case of supermarkets, in close proximity to one another. I acknowledge that it is occasionally the case that a producer of alcoholic beverages will, like the opponent, sell goods proper to class 21 under its brand, or license others to do so. This would typically be for glasses and may even include the sale of glasses and alcohol in a gift set. However, this is, in my view, the exception rather than the rule. Nor is there, in my view, a complementary relationship between the goods. As Daniel Alexander Q.C. noted as the Appointed Person in *Sandra Amelia Mary Elliot v LRC Holdings Limited* BL-0-255-13:

“It may well be the case that wine glasses are almost always used with wine – and are, on any normal view, complementary in that sense - but it does not follow that wine and glassware are similar goods for trade mark purposes.”

81. Although glassware in particular may be used with alcoholic beverages, the link between the respective goods is not generally one which would cause the consumer to believe that goods proper to class 21 and the alcoholic beverages in the opponent's specifications would be produced by the same undertaking or economically connected undertakings. These goods are not similar.

Class 32

Beer; Flavoured beers; Low-alcohol beer; Lager; Lager tops; Shandy

82. The “alcoholic beverages” of the “JACK ROCKS” mark includes all kinds of alcoholic beverage, including drinks such as ciders and punches. The same goods are covered by the term “whiskey-based beverages” in the “JACK DANIEL'S” and “JACK” marks'

specifications. Whilst there are some differences, these goods also overlap with the contested goods in nature, purpose, method of use and users. The drinks are likely to be on different shelves in supermarkets but will be fairly close to one another in both retailers and in licensed premises. They are not complementary but there is a competitive relationship between the goods. They are similar to a high degree.

83. For reasons which will become apparent, it is also necessary to compare the above goods with “whisky”. Although the contested goods are, like whisky, alcoholic beverages which may be drunk by the same users for a pleasurable drinking experience which may include the intoxicating effects of alcohol, there are significant differences between the goods. The production methods are different and the resulting drinks, long on the one hand with a lower alcohol content and short with a high alcohol content on the other, will be perceived as belonging to different families of alcoholic beverages. Whilst there will be an overlap in channels of trade, the respective goods would normally both be sold in the alcoholic beverage aisles in supermarkets but they are likely to be in discrete sections of those aisles; in licensed premises, spirits are generally displayed in optics or as bottles together behind a bar, whilst beers and lagers would be on taps at the front of the bar or in fridges. There may be a degree of competition between the goods but given the differences between them, I do not consider that the competitive choice between the contested goods and whisky will be commonly made. There is a low degree of similarity between these goods.

Class 33

Alcoholic spirits; Whisky; Whiskey; Bourbon; Rye Whisky; Cream Whisky; Gin; Flavoured Gin; Vodka; Rum; Flavoured alcoholic spirits; Liqueurs; but not cocktails

84. All of the above goods are types of alcoholic beverage and are identical to the “JACK ROCKS” mark’s “alcoholic beverages” on the basis outlined in *Meric*.

85. Turning to the “JACK” and “JACK DANIEL’S” marks, “liqueurs” includes whisky-based liqueurs. As I understand it, “cream whisky” is a drink based on whisky. These goods are identical to the earlier marks’ “whisky-based beverages”. In terms of their similarity to

“whisky”, the goods overlap in purpose. They have some similarity in nature, though liqueurs tend to be sweet drinks, which whisky is not; both may be drunk neat. The respective goods will be sold reasonably near to one another, though they are usually in distinct parts of an aisle. The goods are competitive. They are similar to a fairly high degree.

86. Both specifications include “whisky”, which is self-evidently identical. “Whiskey; bourbon; rye whiskey” and “flavoured alcoholic spirits” are or include types of whisky. “Alcoholic spirits” includes “whisky”. These goods are identical on the principle in *Meric*.

87. “Gin; flavoured gin; vodka; rum” are types of alcoholic spirit, like whisky, which coincide in purpose. They are typically drunk mixed with another drink, which may also apply to whisky (an example being whisky and cola, as the evidence shows). The production methods are all based on distillation, though ingredients differ and the resulting drinks have differences in, for example, flavour and colour. These drinks are sold close together in retail outlets and both will be displayed in optics or in bottles behind bars. They are in competition. They are highly similar.

Class 35

Retail services connected with the sale of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits, flavoured beer, low-alcohol beer, lager, lager tops, shandy, but not cocktails provided via retail stores, mail order or by means of telecommunications but not via bars and other licensed premises

88. In *Oakley, Inc v OHIM*, Case T-116/06, at paragraphs 46-57, the General Court (“GC”) held that although retail services are different in nature, purpose and method of use to goods, retail services for particular goods may be complementary to those goods, and distributed through the same trade channels, and therefore similar to a degree. In *Tony Van Gulck v Wasabi Frog Ltd*, BL O/391/14, Geoffrey Hobbs Q.C. as the Appointed Person concluded on the basis of the European courts’ judgments in *Sanco SA v OHIM*, Case C-411/13P and *Assembled Investments (Proprietary) Ltd v. OHIM*, Case T-105/05,

at paragraphs [30] to [35] of the judgment, upheld on appeal in *Waterford Wedgwood Plc v. Assembled Investments (Proprietary) Ltd* Case C-398/07P that:

i) Goods and services are not similar on the basis that they are complementary if the complementarity between them is insufficiently pronounced that, from the consumer's point of view, they are unlikely to be offered by one and the same undertaking;

ii) In making a comparison involving a mark registered for goods and a mark proposed to be registered for retail services (or vice versa), it is necessary to envisage the retail services normally associated with the opponent's goods and then to compare the opponent's goods with the retail services covered by the applicant's trade mark;

iii) It is not permissible to treat a mark registered for 'retail services for goods X' as though the mark was registered for goods X;

iv) The General Court's findings in *Oakley* did not mean that goods could only be regarded as similar to retail services where the retail services related to exactly the same goods as those for which the other party's trade mark was registered (or proposed to be registered).

89. The above services relate to goods covered by the "JACK ROCKS" mark's specification. They share channels of trade, users and have a reasonably pronounced complementary relationship. They have a medium degree of similarity overall.

90. The same applies to "retail services connected with the sale of alcoholic spirits, Scotch whisky, cream whisky [...] liqueurs and/or other spirits", which are retail services associated with goods identical to those covered by the specifications of the "JACK" and "JACK DANIEL'S" marks.

91. As regards the contested "retail services connected with the sale of gin, flavoured gin, vodka, rum", such services are likely to be used by the same consumers and will reach consumers through the same channels of trade as "whisky". For completeness, the same

applies to “retail services connected with the sale of liqueurs” when compared to “whisky” rather than whisky-based beverages. They are similar to a fairly low (i.e. between low and medium) degree.

92. The contested “retail services connected with the sale of flavoured beer, low-alcohol beer, lager, lager tops, shandy” concern goods which have limited similarity to the earlier “whisky” and “whisky-based beverages”. The goods are all consumed by the same adult members of the public and are part of the wider alcoholic beverages market. They will be sold in the same places, namely the same general areas of supermarkets and in off-licences, and through the same websites. However, there is normally a clear demarcation between the areas of retail premises selling such goods and between the different sections on websites and in catalogues. There is a low degree of similarity between these services.

Promotion of products and services of third parties through sponsoring arrangements; Supply chain management services; Loyalty, incentive and bonus program services

93. The opponent says that these services are similar to the earlier goods in class 33 because the goods may be the subject of the services. It also says that the opponent offers a loyalty scheme, which shows that there is a complementary relationship between the goods and services.

94. I do not find either of these points persuasive. There is an obvious difference in nature and method of use between goods and services. The purpose of promotion through sponsorship and that of supply chain management are far removed from the purpose of alcoholic beverages. The users of the services may overlap (both may include businesses) but this is a fairly superficial point of similarity. These goods and services are neither in competition nor complementary. As regards the argument that loyalty, incentive and bonus scheme services are complementary to alcoholic beverages, in my view the respective goods and services are neither essential nor important for one another in the sense described by the case law. These services are essentially marketing or promotional services offered to businesses in order to enable the sale of goods and services or to assist in the retention of customers. These services are not similar.

Packaging, storage, delivery and/or transportation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, liqueurs, and/or other spirits

95. The opponent's position in respect of these services is that the goods of the earlier registrations may be the subject of the services and that they are therefore similar. The nature, purpose, method of use, users and channels of trade for the respective goods and services are all different. There is no competition. In *Sanco SA v OHIM*, Case T-249/11, EU:T:2013:238, the GC held that "chickens" and "transport of chickens" were complementary. However, in the present case, it seems unlikely that a beverage manufacturer would supply the above services. The goods do not require especially specialist treatment, unlike live animals. As far as the UK market is concerned, there is no reason to believe, and there is no evidence to show, that a business engaged in the distance selling of its own beverages would offer the above services per se. That includes delivery services which would, in the UK, usually be provided by separate transport/delivery specialists. Whilst the contested services may be important for the goods, the average consumer is not likely to assume that the provider of the services is the same as a manufacturer of alcoholic beverages. The services are dissimilar.

Distillation of alcoholic spirits, Scotch whisky, cream whisky, gin, flavoured gin, vodka, rum, and/or other spirits; Distillation services

96. The nature of these services differs from that of all of the earlier goods, as does the method of use. The purpose is also different: beverages are to be drunk, for various reasons, whilst the purpose of distillation services is to produce the beverage. Channels of trade may overlap, as it is common for distillers to sell their own products. Distillation services are essential for the production of spirits and a service for distilling an alcoholic drink and the goods themselves will be perceived as the responsibility of the same company. All of the above services are similar to a medium degree to the "JACK ROCKS" mark's "alcoholic beverages, except beers".

97. "Distillation of alcoholic spirits, Scotch whisky, cream whisky [...] and/or other spirits; distillation services" are or include distillation of the goods covered by the earlier specifications. These services are similar to a medium degree to the "whisky" and

“whisky-based beverages” of the “JACK” and “JACK DANIEL’S” marks’ specifications for the reasons given above.

98. I have no evidence to assist in determining whether distillers of gin, flavoured gin, vodka and rum are likely to produce whisky. It seems probable, given that all of these beverages are the product of a distillation process and that the equipment and many of the skills required for their production are likely to be the same, even though the ingredients may differ. The nature and purpose of the goods and services are different, though users and channels of trade may overlap. There is no competition, given the difference in end product. They are not complementary. These goods and services are similar to a fairly low degree.

The average consumer and the nature of the purchasing act

99. The average consumer is a legal construct deemed to be reasonably well informed and reasonably circumspect: *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) at [60]. For the purposes 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 and services in question: *Lloyd Schuhfabrik*.

100. The goods at issue in classes 21, 32 and 33 are all everyday consumer goods which may be purchased by the general public, though in the case of alcoholic beverages the consumer will have reached the age of majority. Retail services connected with the sale of alcoholic beverages will also be used by the adult general public. This average consumer is likely to select the goods and services through primarily visual means, such as from retail shelves, catalogues and websites, though there may be an aural element. The goods and services are routine purchases and are likely to be afforded a medium degree of attention in their selection.

101. The dissimilar services in classes 35 and the services in classes 39 and 40 will be used by businesses and are likely to attract a reasonably high level of attention, as a business will wish to assure itself that the provider is able to meet the required service

levels over a period which may be lengthy or which may involve considerable expense. It is also possible that the goods at issue in classes 32 and 33 will be purchased by businesses, such as restaurants and hotels. The purchasing process will again be largely visual, with exposure to the marks through, for example, written advertising and information, though aural considerations may play a part. The purchasing process will be reasonably high, as larger quantities will be purchased and greater sums expended.

Distinctive character of the earlier trade marks

102. In *Lloyd Schuhfabrik*, 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).”

103. The trade mark “JACK DANIEL’S” is composed of a forename and surname in the possessive, both of which are common names. The combination, however, indicates a specific individual and it is inherently distinctive to an average degree.

104. In view of the large sales figures and the evidence that the “JACK DANIEL’S” whiskey was a leading UK brand in the period preceding the relevant date, I am satisfied that the distinctiveness of the mark has been enhanced and that the mark enjoys a very high degree of distinctiveness for “whisky”. Although the evidence relating to other beverages shows sales figures which are lower, they remain substantial. I am satisfied that the mark has acquired a high degree of distinctiveness for whisky-based beverages.

105. As regards the “JACK” mark, my view is that “JACK” is a very common name. Inherently, it is only weakly distinctive. It is not possible to identify with precision the sales figures attributable to this mark. However, there is an evident association of the “JACK” mark with the “JACK DANIEL’S” whiskey, the sales figures for which are very substantial. There is also evidence of promotion of the “JACK” mark in relation to whiskey from at least 2016 to the relevant date, along with some evidence, albeit limited and in the case of the dictionary definitions not dated, which suggests that the “JACK” mark has some notoriety for whisky with a section of the public. I am prepared to accept that “JACK” has acquired some distinctive character. However, given the weak starting point and the limitations of the evidence, I do not think that “JACK” benefits from more than a fairly low degree of distinctiveness overall. In relation to whiskey-based beverages, I am not prepared to accept that “JACK” has acquired distinctive character. The sales figures for these beverages are smaller and the evidence is not sufficiently solid for me to conclude that “JACK” is known to a significant proportion of the public in relation to beverages other than whiskey.

106. As for the “JACK ROCKS” mark, there is no evidence of the mark having been used in relation to alcoholic beverages. That leaves only the inherent position. I do not think that “JACK ROCKS” will be perceived as a descriptive contraction of “JACK [whiskey] on the rocks”: there is no evidence that this would be a usual shortening of the phrase, even though some people may understand the play on words. Rather, it will be perceived as a

reference to someone named Jack alongside a form of the verb “to rock”. “Rocks” has several possible meanings but none of them is descriptive of the goods. In my view, “JACK ROCKS” has an average degree of distinctive character.

Comparison of trade marks

107. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details: *Sabel* (particularly paragraph 23). *Sabel* 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 CJEU stated at paragraph 34 of its judgment in *Bimbo*, 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”.

108. It would therefore be wrong artificially to dissect the marks, although it is necessary to take into account their distinctive and dominant components. Due weight must be given to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

109. The trade marks to be compared are:

Earlier marks	Contested mark
<p style="text-align: center;">JACK DANIEL'S</p> <p style="text-align: center;">JACK</p> <p style="text-align: center;">JACK ROCKS</p>	<p style="text-align: center;">JACK & VICTOR</p>

Comparison with JACK DANIEL'S

110. The overall impression of the “JACK DANIEL’S” mark is contained in the combination, which will be perceived as a possessive form of a person’s full name. No part of the mark is more dominant than another.

111. The contested mark consists of two forenames connected by an ampersand. The overall impression is contained in the complete phrase, though the names are more distinctive than the ampersand, which nevertheless plays a role. Neither name is more dominant or distinctive than the other.

112. Both marks begin with the word “JACK”. There are important differences arising from the surname and possessive in the earlier mark and the additional forename in the latter. “DANIEL’S” and “VICTOR” share only the letter “I” and are quite different. There is a fairly low degree of visual similarity between these marks.

113. Aurally, the “JACK DANIEL’S” mark will be pronounced entirely conventionally. The ampersand in the “JACK & VICTOR” mark will be articulated as the word “and”. The earlier mark has three syllables, the latter four, the first of which coincides. There is a fairly low degree of aural similarity.

114. Both marks include reference to an individual named “JACK”. However, the earlier mark’s concept is a specific individual whose surname is “DANIEL’S”. The latter mark uses the forename only, to which is added a second individual’s name, “VICTOR”. There is a low degree of conceptual similarity.

Comparison with “JACK”

115. The overall impression of the “JACK” mark rests in that word.

116. Both marks start with the name “JACK”, to which are added the words “& VICTOR” in the later mark which create an obvious visual and aural difference. There is a medium degree of both visual and aural similarity.

117. Conceptually, both marks share the concept of an unspecified person named “JACK”. The later mark adds to this the concept of an unspecified person named “VICTOR”. There is a medium degree of conceptual similarity.

Comparison with “JACK ROCKS”

118. “JACK ROCKS” will be seen as a whole, with the overall impression resting in the combination and no part of the mark being significantly more dominant than the other.

119. Again, both of the trade marks contain “JACK” as the initial word. I accept that there are some shared letters in the later parts of the respective marks but “& VICTOR” and “ROCKS” do not share any significant visual or aural similarity. There is a fairly low degree of both visual and aural similarity.

120. Both marks share a reference to an individual named “JACK” who is not otherwise defined. The earlier mark is most likely to be perceived as someone named “JACK” “dancing in the rock-and-roll style”.⁴⁶ There may be some consumers who perceive “ROCKS” as swaying backwards and forwards;⁴⁷ either way, the earlier mark will be taken to mean a person called “JACK” performing a particular movement. This indication of movement is a distinction from the later mark, which also contains a difference because of the second person named. There is a fairly low degree of conceptual similarity.

⁴⁶ See definition at 4 of the *Collins English Dictionary* for the verb: <https://www.collinsdictionary.com/dictionary/english/rock> [accessed 2 May 2023].

⁴⁷ See definition 1 of the same *Collins English Dictionary* entry (fn. 46 of this decision).

Likelihood of confusion

121. In determining whether there is a likelihood of confusion, all of the above factors need to be borne in mind. They must be considered globally (*Sabel*), from the perspective of the average consumer. In making my assessment, I must keep in mind that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them he has retained in his mind (*Lloyd Schuhfabrik*). The factors considered above have a degree of interdependency (*Canon*): for example, a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective goods and vice versa.

122. The opponent claims that the confusion which affects the average consumer will, in this case, be indirect. Iain Purvis Q.C., sitting as the Appointed Person explained indirect confusion in *LA Sugar Limited v Back Beat Inc.*, BL O/375/10, where he said:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: “The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark.

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)."

123. In *Liverpool Gin Distillery Ltd & Ors v Sazerac Brands, LLC & Ors* [2021] EWCA Civ 1207, Arnold L.J. referred to the comments of James Mellor Q.C (as he then was), sitting as the Appointed Person in *Cheeky Italian Ltd v Sutaria* (BL 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 L.J. 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.

124. If there is no similarity between goods and services, there can be no confusion.⁴⁸ Where I have held goods and services to be dissimilar, the opposition under s. 5(2)(b) is dismissed.

125. Taking the "JACK DANIEL'S" mark first, I do not consider that there is a likelihood of confusion, whether direct or indirect, for any of the goods and services, even where they are identical. While the earlier mark has a high or very high level of distinctiveness, the differences between the marks, particularly the conceptual differences, are sufficient to rule out any confusion. Regarding indirect confusion, the differences are such that there is, in my view, no proper basis for concluding that "JACK & VICTOR" is a plausible brand

⁴⁸ *Waterford Wedgwood plc v OHIM*, C-398/07 P.

evolution of the “JACK DANIEL’S” mark, or vice versa: it would not be usual to drop a distinctive part of one trade mark and replace it with another, different, distinctive element.

126. Nor do I think that there is any likelihood of confusion with the “JACK ROCKS” mark for any of the goods or services. The differences between the marks are too significant to go unremembered and there is no logical reason for a brand to develop by changing the later element from a verb to a second forename, or vice versa.

127. The opponent’s best case on the marks is its “JACK” mark. There is a medium degree of visual, aural and conceptual similarity between that mark and the contested mark. The earlier mark is distinctive to a fairly low degree. However, even where the goods are identical, the additional elements “& VICTOR” in the contested mark are sufficient to rule out a likelihood of direct confusion: the marks will not be mistaken for one another.

128. As regards indirect confusion, the opponent submits that this case requires a “straightforward analysis” following the judgment of the CJEU in *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*, C-120/04, EU:C:2005:594. It says that “JACK” is an independent distinctive element in the contested mark and that “& VICTOR” will have no impact on the “standalone” element “JACK”. It also says that the average consumer “is accustomed to enjoying products bearing the Opponent’s mark mixed with another beverage (e.g. Jack & Coke). The JACK & VICTOR mark is therefore likely to indicate to consumers that the product consists of the JACK product with another mixer marketed under the brand name VICTOR”. It also says that there is a risk of indirect confusion on the basis that “it is commonplace in the drinks industry for companies to create a number of brands around the same brand element, including plays on the brand name” and that “expansion in the spirits market frequently also includes expansion into different products”.

129. 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.”

130. I accept that “JACK”, in the phrase “JACK & VICTOR”, does not have a different meaning from the word used on its own. I also recognise that a mark which links two elements by use of an ampersand could be perceived as joining two independent distinctive elements and that “JACK” is a distinctive word which has the capacity to function as an independent distinctive element. However, I disagree with the opponent that in the contested mark “JACK” will be seen as an independent distinctive element. The contested mark is a logical unit which conveys the image of two individuals, named JACK and VICTOR, together and there is no clear reason why these names would be perceived as two different brands juxtaposed: it is not, for example, an obvious house mark/sub-brand combination or a house mark with an invented word. It is, of course, possible that there may at some point be a mixer sold under the brand name “VICTOR”. However, given that VICTOR is not an especially unusual name and that there is no evidence to show that the use of forenames as brands is common in the sector, the situation posited by the opponent strikes me as a theoretical possibility rather than a real risk. I bear in mind that the opponent relies upon use in the marketplace of “JACK & Coke”. However, the comparison is not on all fours: “Coke” is plainly not another person’s name. It is also a very well established brand in its own right, which is more likely to suggest to the consumer that it is an exercise in co-branding. I do not think that even a good deal of knowledge of usage of “JACK & Coke” among average consumers would lead them to conclude that the use of “JACK” in the combination “JACK & VICTOR” is use of the opponent’s brand alongside another brand name, even for identical goods. Consequently, *Medion* confusion does not apply.

131. As regards indirect confusion of the type outlined in *LA Sugar*, the opponent accepts that “& VICTOR” is not descriptive (category (b)) but says that either of the other two categories might apply. I do not agree. “JACK” is not, in my view, so strikingly distinctive that the average consumer would assume that any use of it would be by or associated with the opponent and I do not consider that the manner of its use in the contested mark would cause the consumer to believe that there was such a connection. Nor, in my view, is there a logical reason why “JACK & VICTOR” would be a likely extension of the “JACK” mark. I accept that many brands, not only in the spirit business, will use variations on a theme in their brand strategy. However, I cannot see a good reason why a second name

added to an existing single-name trade mark would be considered by the average consumer to be a brand extension. For these reasons, and those given at paragraph 130, above, I do not consider that the average consumer will perceive the addition of “& VICTOR” as pointing towards co-branding, cross-over or collaboration of brands.

132. The opponent relies on the evidence of its other brands separately from its family of marks case. Mr Stobbs submitted in relation to its family of marks case that the “JACK & VICTOR” mark mimics the structure of marks in the opponent’s family of “JACK” marks because “JACK” is the initial element. However, that is the only point of coincidence. In my view, none of the variations either relied upon or shown in the evidence sufficiently resembles the “JACK & VICTOR” combination, nor does “JACK & VICTOR” sit comfortably in the pattern of brand expansion represented by the various “JACK” marks, for the consumer to conclude that “JACK & VICTOR” is a probable brand extension or other mark of the opponent. The evidence of one advertisement which featured “JACK & FRANK” about a specific famous individual who enjoyed JACK DANIEL’S whiskey is insufficient to show that “JACK & VICTOR” is a reasonable brand extension. I conclude that there is no confusion, whether direct or indirect, even for identical goods.

Family of marks

133. The leading case on a “family” of trade marks is *Il Ponte Finanziaria SpA v OHIM* (“*Bainbridge*”), case C-234/06 P, EU:C:2007:514, where the CJEU said:

“62. While it is true that, in the case of opposition to an application for registration of a Community trade mark based on the existence of only one earlier trade mark that is not yet subject to an obligation of use, the assessment of the likelihood of confusion is to be carried by comparing the two marks as they were registered, the same does not apply where the opposition is based on the existence of several trade marks possessing common characteristics which make it possible for them to be regarded as part of a ‘family’ or ‘series’ of marks.

63 The risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion within the meaning of Article 8(1)(b) of Regulation No 40/94 (see *Alcon v OHIM*, paragraph 55, and, to that effect, *Canon*, paragraph 29). Where there is a ‘family’ or ‘series’ of trade marks, the likelihood of confusion results more specifically from the possibility that the consumer may be mistaken as to the provenance or origin of goods or services covered by the trade mark applied for or considers erroneously that that trade mark is part of that family or series of marks.

64 As the Advocate General stated at paragraph 101 of her Opinion, no consumer can be expected, in the absence of use of a sufficient number of trade marks capable of constituting a family or a series, to detect a common element in such a family or series and/or to associate with that family or series another trade mark containing the same common element. Accordingly, in order for there to be a likelihood that the public may be mistaken as to whether the trade mark applied for belongs to a ‘family’ or ‘series’, the earlier trade marks which are part of that ‘family’ or ‘series’ must be present on the market.

65 Thus, contrary to what the appellant maintains, the Court of First Instance did not require proof of use as such of the earlier trade marks but only of use of a sufficient number of them as to be capable of constituting a family or series of trade marks and therefore of demonstrating that such a family or series exists for the purposes of the assessment of the likelihood of confusion.

66 It follows that, having found that there was no such use, the Court of First Instance was properly able to conclude that the Board of Appeal was entitled to disregard the arguments by which the appellant claimed the protection that could be due to ‘marks in a series’.”

134. As any opposition based upon s. 5(2)(b), whether based upon a “family” case or not, requires that there be some similarity between the respective goods and/or services, the

opposition must be dismissed to the extent that I have found the goods and services to be dissimilar.

135. I have already held that the “JACK DANIEL’S” and “JACK” marks have been used for whisky and whisky-based beverages. The use appears to have been continuing at the relevant date and I am satisfied that both of these marks were on the market for the same goods at the relevant time. I am also satisfied, in view of the turnover figures described above and the evidence of the mark on the product, that the “GENTLEMAN JACK” mark was on the market at the relevant date. The “WINTER JACK” product was on the market in the UK between 2013 and 2018. In *Easygroup Ltd v Easy Live (Services) Ltd & Ors* [2022] EWHC 3327 (Ch), Sir Anthony Mann held at [149]-[150] that a mark is not excluded simply because it was not present on the market at the date of assessment. He said, “[the] perception of the family by the average consumer may still be affected by a recently retired mark if it is likely to be still in his/her mind. [...] Of course, if a mark has been retired for some considerable time it will not, as a matter of fact, be likely to be playing on the mind of the consumer”. Accordingly, the “WINTER JACK” mark, which was used for a whisky-based beverage, may be taken into account, though the impact of this mark will be reduced because not only were its sales smaller but it had also ceased to be on the market three years prior to the relevant date. Consequently, the opponent had a family of at least four marks, three of which remained on the market at the relevant date, which share the common distinctive element “JACK”.

136. Nevertheless, despite the presence on the market of four marks which feature the common word “JACK”, I am not persuaded that the average consumer would consider the contested mark to be a part of that family. I do not accept Mr Stobbs’ contention that the contested mark mimics the structure of the marks in the family: whilst some of the earlier marks begin with “JACK”, that is the only similarity, whereas the differences are significant. The distance between the contested mark and the family of earlier marks is too great for the average consumer to attribute the use of “JACK” in the contested mark to more than coincidence. Even assuming that all of the marks relied upon are part of the family, I reach the same conclusion. The family of marks argument also fails in respect of s. 5(2)(b).

Section 5(3)

137. Section 5(3) states:

“(3) A trade mark which-

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

138. Section 5(3A) states:

“(3A) Subsection (3) applies irrespective of whether the goods and services for which the trade mark is to be registered are identical with, similar to or not similar to those for which the earlier trade mark is protected.”

139. The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, EU:C:1999:408, *General Motors* [1999] ETMR 950; Case 252/07, EU:C:2008:655 *Intel*, [2009] ETMR 13; Case C-408/01, EU:C:2003:582, *Adidas-Salomon*, [2004] ETMR 10; and C-487/07, EU:C:2009:378, *L’Oréal v Bellure* [2009] ETMR 55; Case C-323/09, EU:C:2011:604, *Marks and Spencer v Interflora*; and Case C-383/12P, EU:C:2013:741, *Environmental Manufacturing LLP v OHIM*. The law appears to be as follows:

(a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public: *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind: *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness: *Intel*, paragraph 42.

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future: *Intel*, paragraph 68; whether this is the case must also be assessed globally, taking account of all relevant factors: *Intel*, paragraph 79.

(f) the more immediately and strongly the earlier mark is brought to mind by the later mark, the greater the likelihood that use of the latter will take unfair advantage of, or will be detrimental to, the distinctive character or the repute of the earlier mark: *L'Oréal v Bellure NV*, paragraph 44.

(g) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future: *Intel*, paragraphs 76 and 77 and *Environmental Manufacturing*, paragraph 34.

(h) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character: *Intel*, paragraph 74.

(i) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark: *L'Oréal v Bellure NV*, paragraph 40. The stronger the reputation of the earlier mark, the easier it will be to prove that detriment has been caused to it: *L'Oréal v Bellure NV*, paragraph 44.

(j) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oréal v Bellure*).

140. Mr Stobbs complained that there is little reference in the counterstatement to s. 5(3). He said that the applicant does not deny reputation and it does not deny link. It is true that a reputation is not denied (as I indicated above, a reputation for "JACK DANIEL'S" is accepted for bourbon and cocktails containing bourbon). However, the applicant put the opponent to proof of use of its marks. Reputation is a higher bar and it is perverse to claim that a reputation must be considered admitted in the face of a requirement for the lower standard of genuine use. As to link, the pleadings are not explicit. Paragraph 29 of the counterstatement reads:

"Therefore, there cannot be any confusion between the Opponent's marks and the Applicant's mark, as the Applicant's mark will be associated with the Programme and the Main Characters, and not the Opponent. Further, given that association, there cannot be a misrepresentation for the purposes of the law relating to passing

off. Lastly, given that no association with the Opponent will result and given that the only commonality between the marks is a common name, there can be no detriment to or unfair advantage taken of the Opponent's marks".

141. The reference to "association" in the third sentence is ambiguous. However, bearing in mind the sequential requirements for a successful opposition under s. 5(3) and that the reference to "association" is immediately followed by a denial that detriment or unfair advantage could occur due to the absence of "association", it is more likely than not that this is a denial of link. My view is that the applicant's counterstatement does not contain any concessions regarding reputation or link and I proceed on that basis.

Reputation

142. In *General Motors*, the CJEU gave the following guidance for the assessment of a trade mark's reputation:

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

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

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

28. Territorially, the condition is fulfilled when, in the terms of Article 5(2) of the Directive, the trade mark has a reputation 'in the Member State'. In the absence of any definition of the Community provision in this respect, a trade mark cannot be

required to have a reputation 'throughout' the territory of the Member State. It is sufficient for it to exist in a substantial part of it".

143. Mr Watt accepted that the "JACK DANIEL'S" mark has a reputation for bourbon and cocktails containing bourbon. For the reasons given at paragraphs 103-105 above, I am satisfied that the "JACK DANIEL'S" mark had at the relevant date a strong reputation for whisky and a smaller but still significant reputation for whisky-based beverages, and that the "JACK" mark had a modest reputation for whisky. As for the "GENTLEMAN JACK" mark, I find that the length of use and turnover demonstrated show a modest reputation for whisky at the relevant date. There is very little evidence beyond this (e.g. advertising, articles) and no evidence of the mark having been used for goods other than whisky. I do not think a finding of a stronger reputation is justified.

Link

144. Whether the public will make the required mental 'link' between the marks must take account of all relevant factors. The factors identified in *Intel* are:

The degree of similarity between the conflicting marks

145. For the reasons given at paragraphs 110 to 117, the contested mark has a fairly low degree of visual, aural and conceptual similarity to the "JACK DANIEL'S" mark, and a medium degree of visual, aural and conceptual similarity to the "JACK" mark.

146. Regarding the "GENTLEMAN JACK" mark, the overall impression of that mark is of the phrase as a whole, in which neither word is materially more dominant. Whilst both marks contain the word "JACK", there are significant visual and aural differences arising from the different position of that word and the inclusion in both marks of elements which have no resemblance to the other parts of the competing mark. There is a low degree of visual and aural similarity. The earlier mark conveys the image of someone named JACK who is also a gentleman. That concept may be somewhat variable but it is not a concept shared by the contested mark. The contested mark, in contrast, refers to a second individual. These marks have a fairly low degree of conceptual similarity.

The nature of the goods or services for which the conflicting marks are registered, or proposed to be registered, including the degree of closeness or dissimilarity between those goods or services, and the relevant section of the public

147. I compared the goods and services at paragraphs 80 to 98, above, and I adopt those findings here including, where they relate to “whisky” in the earlier specifications, in relation to the “GENTLEMAN JACK” mark.

148. In relation to the average consumer, I adopt my findings from paragraphs 100 to 101. For convenience, the general public will purchase the goods in classes 21, 32 and 33 and the similar services in class 35 with a medium level of attention. The consumer of the goods in classes 32 and 33, along with the dissimilar services in class 35 and the services in classes 39 and 40 is or may include a business person who will pay a reasonably high level of attention. The selection will be mainly but not exclusively visual for both groups of consumer.

Strength of the earlier mark’s reputation

149. At the relevant date, the “JACK DANIEL’S” mark had strong reputation for whisky and a smaller but still significant reputation for whisky-based beverages. The “JACK” and “GENTLEMAN JACK” marks each had a modest reputation for whisky.

The degree of the earlier mark’s distinctive character, whether inherent or acquired through use

150. For the reasons given at paragraphs 103 to 104, “JACK DANIEL’S” has a very high level of distinctiveness for whiskey and is highly distinctive for whisky-based beverages. “JACK” has a fairly low degree of distinctiveness for whisky.

151. The sales of “GENTLEMAN JACK” are of sufficient size and duration to have enhanced the distinctiveness of the mark but, absent other supporting evidence, only to a modest degree. Taking into account the average inherent distinctiveness of the mark, it enjoys an above average level of acquired distinctive character.

Whether there is a likelihood of confusion

152. I have held that there is no likelihood of confusion in respect of the “JACK DANIEL’S” or “JACK” marks individually or in respect of the opponent’s family of marks which includes “GENTLEMAN JACK”. I also find that there is no likelihood of confusion in respect of the “GENTLEMAN JACK” mark individually, even for identical goods. The differences between the marks are such that the relevant public will not be confused.

153. Taking all of the above into account, I find that despite the strength of its reputation, the “JACK DANIEL’S” mark will not be called to mind by the contested mark. The differences between the marks themselves are too great for the earlier mark to be called to mind, particularly when the commonness of “JACK” is taken into account. I also find that the “GENTLEMAN JACK” mark will not be called to mind. The different construction of the marks and their differences in concept, notwithstanding the use in both of “JACK”, and in light of the more limited reputation of “GENTLEMAN JACK”, will not cause the consumer to think of the earlier mark.

154. However, whilst the “JACK” mark only benefits from a modest reputation, and for a significant part of the relevant public there will be no association, however fleeting, I find that for another significant part of the relevant public the contested mark will be called to mind where there is a medium degree of similarity or more between the goods and services, i.e. for all of the alcoholic beverages in class 33 and for retail and distillery services in relation to whisky. This is because for that part of the relevant public, the word “JACK” at the beginning of another mark in relation to these goods and services will be enough to trigger a mental association with the earlier “JACK” mark.

Unfair advantage

155. In *Jack Wills Limited v House of Fraser (Stores) Limited* [2014] EWHC 110 (Ch) Arnold J. (as he then was) considered the earlier case law and concluded that:

“80. The arguments in the present case give rise to two questions with regard to taking unfair advantage. The first concerns the relevance of the defendant’s intention. It is clear both from the wording of Article 5(2) of the Directive and Article

9(1)(c) of the Regulation and from the case law of the Court of Justice interpreting these provisions that this aspect of the legislation is directed at a particular form of unfair competition. It is also clear from the case law both of the Court of Justice and of the Court of Appeal that the defendant's conduct is most likely to be regarded as unfair where he intends to benefit from the reputation and goodwill of the trade mark. In my judgment, however, there is nothing in the case law to preclude the court from concluding in an appropriate case that the use of a sign the objective effect of which is to enable the defendant to benefit from the reputation and goodwill of the trade mark amounts to unfair advantage even if it is not proved that the defendant subjectively intended to exploit that reputation and goodwill."

156. The opponent's pleaded case is that the relevant public will believe that the contested mark is used by the opponent or by a party economically connected with or endorsed by the opponent. It further claims that use of the contested mark would constitute free-riding by the applicant on the reputation of the opponent. In his skeleton argument, Mr Stobbs expanded this to a claim that the opponent has an image of a "cool, iconic brand" (it is not entirely clear whether this means all of the marks relied upon or not).

157. The first part of this pleading relies on the average consumer mistakenly believing that there is a trade connection between the users of the respective marks. Consequently, it is predicated on the existence of a likelihood of confusion, which is something that I have dismissed whether on the basis of the marks individually or as a family. Having reached that conclusion, I am bound to dismiss the first limb of the unfair advantage claim.

158. As to free-riding, the evidence does not establish that there was any subjective intention to take unfair advantage. On the contrary, Mr Hemphill has given unchallenged evidence which explains in detail that the contested mark consists of the names of the protagonists in the *Still Game* television programme. That programme first aired between 2002 and 2007, returning to UK television for a further run of episodes between 2016 and

2019, to some renown, at least in Scotland.⁴⁹ Mr Stobbs pointed to the similarities between the labels used by the parties.⁵⁰ The labels of the applicant's goods show use of white lettering on a black background, which is also used for the "JACK DANIEL'S" Old No. 7 whiskey. However, there are also differences, such as a device of two figures in silhouette and the use of a diamond-shaped, gold-edged label rather than a plain rectangular label which wraps round the bottle. The applicant's label also looks much busier overall than the opponent's. There is one photograph in evidence which shows two bottles, one labelled "JACK" and the other "VICTOR" but these appear to be the contents of a gift box bearing the mark "JACK AND VICTOR" in white on a grey background; the remainder of the box is a predominantly grey tartan and the silhouette device is present. I do not think that the similarities between the labels show that there was a subjective intention to take advantage of the earlier mark's reputation.

159. Turning to whether there is an objective unfair advantage, my view is that there is not. Whilst I have accepted that there will be a link for the earlier "JACK" mark, I do not consider that the applicant will derive any advantage from the link. It will, in my view, be no more than a momentary bringing to mind of the opponent's mark. Any brief wondering about a connection will be swiftly dismissed because of the dissimilarities between the marks, which will cause the consumer to conclude that these are two unconnected brands which happen to include the name "JACK". It will not result in a leg up for the applicant's mark on the basis of the "JACK" mark's reputation, whether by means of a marketing advantage or an image transfer.

Detriment to reputation

160. In *Unite The Union v The Unite Group Plc*, BL O/219/13, Ms Anna Carboni as the Appointed Person considered whether a link between an earlier mark with a reputation and a later mark with the mere potential to create a negative association because of the

⁴⁹ See, for example, exhibits JV1, JV15, JV16, JV20, JV22, JV24, JV25 and JV29 to Mr Hemphill's statement. See also JM2 and JM3 to Mr McDonald's statement. The former includes reference to a 2018 episode which was the most watched programme in Scotland in May 2018 with 55.8% market share (p. 14).

⁵⁰ He directed me to JV33, JV34 and JW42.

identity of the applicant or the potential quality of its goods/services was sufficient to found an opposition based on detriment to reputation. She said:

“46. Indeed, having reviewed these and other opposition cases, I have not found any in which the identity or activities of the trade mark applicant have been considered in coming to a conclusion on the existence of detriment to repute of an earlier trade mark. I can understand how these matters would form part of the relevant context in an infringement case, but I have difficulty with the notion that it should do so in an opposition. After all, many, if not most, trade mark applications are for trade marks which have not yet been used by the proprietor; some are applied for by a person or entity that intends to license them to a third party rather than use them him/itself; and others are applied for by an entity that has only just come into existence.

47. I do not exclude the possibility that, where an established trading entity applies to register a mark that it has already been using for the goods or services to be covered by the mark, in such a way that the mark and thus the trader have already acquired some associated negative reputation, perhaps for poor quality goods or services, this fact might be taken into account as relevant “context” in assessing the risk of detriment to repute of an earlier trade mark. Another scenario might be if, for example, a trade mark applicant who was a known Fascist had advertised the fact prior to the application that he was launching a new line of Nazi memorabilia under his name: I can see how that might be relevant context on which the opponent could rely if the goods and services covered by the application appeared to match the advertised activities. But I would hesitate to decide an opposition on that basis without having had confirmation from a higher tribunal that it would be correct to take such matters into account.”

161. The opponent’s case on tarnishing is entirely speculative. There is no evidence that the applicant has already acquired a negative reputation and there is nothing inherent in the mark or the goods and services which would be likely to damage the reputation of the “JACK” mark. This head of damage is dismissed.

Detriment to distinctive character

162. In *Environmental Manufacturing LLP v OHIM*, Case C-383/12P, the CJEU stated that:

“34. According to the Court’s case-law, proof that the use of the later mark is, or would be, detrimental to the distinctive character of the earlier mark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier mark was registered, consequent on the use of the later mark, or a serious likelihood that such a change will occur in the future (*Intel Corporation*, paragraphs 77 and 81, and also paragraph 6 of the operative part of the judgment)”.

It went on:

“42. Admittedly, Regulation No 207/2009 and the Court’s case-law do not require evidence to be adduced of actual detriment, but also admit the serious risk of such detriment, allowing the use of logical deductions.

43. None the less, such deductions must not be the result of mere suppositions but, as the General Court itself noted at paragraph 52 of the judgment under appeal, in citing an earlier judgment of the General Court, must be founded on ‘an analysis of the probabilities and by taking account of the normal practice in the relevant commercial sector as well as all the other circumstances of the case’.⁵¹

163. The opponent says that uncontrolled use of the contested mark has the capacity to weaken the distinctiveness of the earlier mark. It also claims that there is no evidence in these proceedings that “the element ‘JACK’ is used by other parties in the context of alcoholic beverages or related goods”.⁵² The claim is somewhat undermined by the

⁵¹ See also *32Red Plc v WHG (International) Limited and others* [2011] EWHC 665 (Ch) at [133], in which the judge held that a change in consumers’ economic behaviour could be inferred from the inherent probabilities of the situation and para. 137 of - *Ziff Management Europe Ltd v Och Capital LLP* [2011] F.S.R. 11 (HC).

⁵² Opponent’s skeleton argument, §112.

survey filed by the opponent, which lists both “Frosty Jack’s” and “Scrumpy Jack” among the responses to the question “Which company do you think makes an alcoholic drink named Jack?”.⁵³ That appears to indicate that at least some consumers thought that there were other brands operating in the alcoholic beverage sector who use the name “Jack” and that the opponent’s claim to exclusive use of “JACK” in the market is exaggerated.

164. In my view, there is no evidence that a bringing to mind of the earlier mark will result in a change in the economic behaviour of the average consumer of the earlier mark’s goods. Nor is there a serious likelihood that this would happen in the future. The marks as wholes are too different for this to be a real risk.

165. The opposition under s. 5(3) fails accordingly.

Section 5(4)(a)

166. Section 5(4)(a) states:

“(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.”

167. Subsection (4A) of Section 5 reads:

⁵³ JW36.

“(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.”

168. In *Reckitt & Colman Products Limited v Borden Inc. & Ors* [1990] RPC 341 HL, Lord Oliver of Aylmerton described at [406] the ‘classical trinity’ that must be proved in order to reach a finding of passing off:

“First, he must establish a goodwill or reputation attached to the goods or services which he supplies in the mind of the purchasing public by association with the identifying ‘get-up’ (whether it consists simply of a brand name or a trade description, or the individual features of labelling or packaging) under which his particular goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of the plaintiff’s goods or services. Secondly, he must demonstrate a misrepresentation by the defendant to the public (whether or not intentional) leading or likely to lead the public to believe that the goods or services offered by him are the goods or services of the plaintiff. Thirdly, he must demonstrate that he suffers or, in a quia timet action, that he is likely to suffer damage by reason of the erroneous belief engendered by the defendant’s misrepresentation that the source of the defendant’s goods or services is the same as the source of those offered by the plaintiff.”

169. There is no evidence that the contested mark was used prior to the date of application. The relevant date is, therefore, the date of application, i.e. 8 March 2021.⁵⁴

Goodwill

170. For the reasons given above, I am satisfied that the opponent had goodwill in relation to its business in whisky and whisky-based beverages, of which the signs “JACK DANIEL’S” and “JACK” were distinctive. I am not satisfied that there was a substantial goodwill in relation to any other goods. The evidence does not show any use in relation

⁵⁴ See *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O/410/11 at [43].

to advertising, packaging or storage. Nor does it show any use for retail services or services for providing drink and, whilst the opponent clearly operates a distillery in the US to produce its own beverages, there is no evidence that it has offered distillery services per se to third parties in the UK.

Misrepresentation

171. For essentially the same reasons as given at paragraphs 12 to 136, above, there will be no misrepresentation. The differences between “JACK & VICTOR” and “JACK DANIEL’S” are too great for the relevant public to believe that the contested goods are those of the opponent, despite the strong reputation of the earlier sign, even for identical goods. Similarly, although “JACK” is replicated in the later mark, it has a lesser reputation and the relevant public is unlikely to be deceived into thinking that use of the combination “JACK & VICTOR” indicates that the goods are those of the opponent. Any similarity attributed to the use of “JACK” in the opponent’s marks, singly or as a group, will not result in the mistaken belief that the contested mark is a further development of the opponent’s brands. The s. 5(4)(a) ground is not made out.

Overall conclusion

172. The opposition has failed. Subject to appeal the trade mark will proceed to registration.

Costs

173. The applicant has been successful and is entitled to an award of costs. Costs are sought on the usual scale, which is found in Tribunal Practice Notice 2/2016. I award costs to the applicant as follows:

Considering the notice of opposition and filing the counterstatement:	£600
Preparing evidence and considering the other party’s evidence:	£1,800
Preparing for and attending the hearing:	£800

Total:

£3,200

174. I order Jack Daniel's Properties, Inc. to pay Jack & Victor Ltd the sum of **£3,200**. 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 15th day of May 2023

Heather Harrison

For the Registrar

The Comptroller-General