

O-186-20

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF

TRADE MARK APPLICATION NO 3305564

IN THE NAME OF MATTHEW D'ARCY & COMPANY LIMITED AND

OPPOSITION THERETO (UNDER NO. 60000925) BY

TRINITY HOLDINGS (NI) LIMITED

&

TRADE MARK REGISTRATION NO 3256335

IN THE NAME OF TRINITY HOLDINGS (NI) LIMITED AND THE

APPLICATION FOR CANCELLATION THEREOF (UNDER NO. 502235)

BY MATTHEW D'ARCY & COMPANY LIMITED

BACKGROUND

1) This dispute concerns a consolidated trade mark opposition and application for cancellation. The parties to the dispute are Trinity Holdings (NI) Limited ('Party A') and Matthew D'Arcy & Company Limited ('Party B').

2) On 22 April 2018, Party B applied to register **Matt D'Arcy's** as a trade mark in respect of various goods in services in classes 21, 25, 30, 33 & 43. The application was published in the Trade Marks Journal on 11 May 2018 for opposition purposes and subsequently opposed by Party A under the fast track opposition procedure. The latter claims that Party B's application offends under section 5(2)(b) of the Trade Marks Act 1994 ('the Act'). The opposition is directed to classes 33 and 43 only of Party B's application. Two trade mark registrations are relied upon by Party A, the details of which are, as follows:

- UKTM No 3039011 for the trade mark **D'ARCY'S** which was applied for on 23 January 2014 and entered in the register on 25 April 2014 in respect of 'Alcoholic beverages; whiskey, but in so far as whisky and whisky based liqueurs are concerned, only Irish whiskey and Irish whiskey-based liqueurs produced in Ireland' in class 33.
- UKTM No 3256335 for the trade mark **MATTHEW D'ARCY** which was applied for on 13 September 2017 and entered in the register on 15 December 2017 in respect of 'Alcoholic beverages, spirits, whiskey' in class 33.

3) Party A's registrations are earlier marks, in accordance with section 6 of the Act. As the date of entry in the register of the earlier marks is less than five years prior to the publication date of the contested mark, neither earlier mark is subject to the proof of use conditions, as per section 6A of the Act.

4) On 06 September 2018, Party B filed an application to have Party A's abovementioned registration for **MATTHEW D'ARCY** declared invalid. Party B claims that the trade mark registration offends under sections 5(4)(a) and 3(6) of the

Act. Under section 5(4)(a), Party B claims that it has used the sign **MATT D'ARCY** in Northern Ireland since 07 September 2017 in relation to 'distilling, rectifying and blending of spirits, namely, whiskey'. It also states that:

"The Applicant accrued significant goodwill through extensive publicity in Northern Ireland in the week prior to the filing of the subject application in the mark MATT D'ARCY in respect of whiskey and a related distillery and visitor's centre to be located in Newry, Northern Ireland."

It is claimed that, due to the visual, aural and conceptual similarities between the respective marks, consumers in Northern Ireland would believe that Party A's goods come from Party B resulting in confusion and damage to the business of Party B.

5) Under section 3(6) of the Act, Party B contends that the mark was applied for in bad faith because:

- the original proprietor, Margot Campbell, became aware of the plans of the Applicant, Matt D'Arcy & Company Limited, due to the publicity surrounding their plans to revive and renovate an old distillery, for the distillation of whiskey and provide a visitor's centre under the trade mark MATT D'ARCY'S and consequently, Margot Campbell chose to file a pre-emptive application for the very similar mark, MATTHEW D'ARCY, to benefit from the Applicant's adoption of the mark MATT D'ARCY; and
- the original proprietor, Margot Campbell, had no bona fide intention to use the mark MATTHEW D'ARCY'S in respect of the goods covered by the application.

6) Both parties filed a counterstatement in defence of their respective trade mark application/registration, denying the claims of the other and putting them to proof thereof. Thereafter, the fast track opposition was converted to a conventional opposition in accordance with Rule 62(1)(j) of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 and consolidated with the application for invalidation.

7) Party A is represented by Bird & Bird LLP; Party B is represented by Ansons. Only Party B filed evidence. That evidence was also accompanied by submissions. Neither party requested to be heard; only Party A filed submissions in lieu. I now make this decision after carefully considering all the papers before me.

Preliminary Issue

8) It has come to my attention that, on 06 June 2019, Party B filed an application for cancellation on the grounds of non-use against Party A's UKTM 3039011, for the trade mark **D'ARCY'S** (cancellation No 502633). Due to the failure of Party A to file evidence of use within the prescribed period, that trade mark registration has been declared revoked, with effect from 26 April 2019 (as per the decision of Mr Raoul Colombo, dated 20 January 2020).

9) In the case before me, UKTM 3039011 is one of the marks relied upon under section 5(2)(b) against the contested mark **Matt D'Arcy's**. I have therefore considered the effect, if any, that the abovementioned decision of Mr Colombo has upon the instant proceedings. As noted above, the effective date of revocation of UKTM 3039011 is 26 April 2019. However, the relevant date for assessing the objection under section 5(2)(b) before me is the filing date of the contested mark i.e. 22 April 2018. The earlier mark, **D'ARCY'S**, was therefore extant on the register at the filing date of the contested mark. It was also extant at the date of filing of the notice of opposition. This means that the **D'ARCY'S** mark can still be relied upon in the proceedings before me, as per the decision of Professor Ruth Annand, sitting as the Appointed Person, in BL O/220/12, [27]-[42].

EVIDENCE FROM PARTY B

10) This comes from two individuals; Mr Andrew Leo Cowan, Chief Executive Officer of Party B and Cherrie Ann Stewart, Director and Chartered Trade Marks Attorney at Ansons (the legal representative of Party B in these proceedings).

11) I will first summarise the evidence from Mr Cowan. He explains that Party B have been working on plans to create a fully restored Victorian bar, restaurant and international visitors centre alongside a whiskey distillery in the home of the historic company Matt D’Arcy & Co. Ltd, Newry, since, at least, 2015.

12) Mr Cowan states that the historic company, Matt D’Arcy & Co. Ltd, operated from a site in Newry and Party B were able to purchase part of this site in February 2017 thus providing a tangible link to the historic business Party B had chosen to revive and adopt.

13) Mr Cowan further explains that Matt D’Arcy & Co. Ltd was a company in Newry in the 19th century and was well known as a distiller of whiskey. He provides samples of advertisements from the original 19th century company and plans showing the site as it looked originally and how it looks now.¹

14) Mr Cowan states that Party B changed its name from Duncan, Alderice & Company Limited to its current name, Matthew D’Arcy & Co. Ltd, on 03 December 2015. He provides a certificate from Companies House showing the date of the name change and that the nature of Party B’s business is listed as “Distilling, rectifying and blending of spirits”.²

15) Mr Cowan states that, on 06 September 2017, Party B held a press conference, at which the owner, director and company secretary of Party B announced plans to create a fully restored Victorian bar, restaurant and international visitors’ centre on the Newry site and to return the site to its former use as a fully functioning whiskey distillery producing whiskey for the premium market under the name “Matt D’Arcy’s”. Mr Cowan provides photographs taken at the press conference. He does not state how many people attended, but the photos appear to show no more than 8-10 attendees. The photos show that posters were shown to the attendees referring to “D’ARCYS OLD Irish Whiskey”, which appear to be those used by the historic company Matt D’Arcy & Co. Ltd (as they include this name on the posters).³

¹ Exhibit ALC1

² Exhibit ALC2

³ Exhibit ALC3

16) Mr Cowan states that the publicity surrounding the announcement meant that the trade mark “Matt D’Arcy’s” became well-known within Northern Ireland within a relatively short space of time. He provides a sample of articles which appeared in the press shortly after the conference.⁴ These consist of:

- An article on the front page of a newspaper called the ‘Newry Democrat’ dated 12 September 2017. The article shows a photograph of the owner of Party B underneath which is the caption which refers to “... his plans for his own distillery ‘Matt D’Arcy & Co’ in Monaghan St. Newry”. The headline of the article states “Cheers for massive whiskey investment – Chamber Chair announces £10 million distillery, pub, restaurant and visitors centre on Monaghan Street’. The body of the article states, inter alia, “The Armaghdown bar, purchased by [the owner] in February, is the site of a former distillery occupied by a Matthew D’Arcy in the early years of the 19th century” and “[The owner] has revived the D’Arcy name... and the enterprise will be called Matt D’Arcy and Co Ltd.” The article continues onto pages 6 and 7 of the newspaper.
- Similar articles from i) www.irishnews.com, dated 07 September 2017, ii) www.downnews.co.uk, dated 06 September 2017, iii) www.mourne-advertiser.com, dated 07 September 2017 and iv) www.thespiritsbusiness.com, dated 11 September 2017.

17) Mr Cowan states that, on 07 September 2017, party B created a Facebook page and began using social media to promote its activities under the trade mark “Matt D’Arcy’s”. Screenshots of the first posts from that page are provided. The posts are dated 07 and 08 September 2017 and include an image from the press conference referred to above and a copy of the poster which is the same as that in exhibit ALC3. 937 people have ‘liked’ the page.

⁴ Exhibit ALC4

18) Mr Cowan states that party B registered the domain name www.mattdarcy.Irish on 02 February 2017 and have since registered the domain name www.mattdarcys.com. Copies of the WHOIS details are provided.⁵

19) Mr Cowan states that, one week after the press conference, an individual wholly unconnected with Party B, Ms Margot Campbell, filed an application to register the similar word mark MATTHEW D'ARCY (UKTM 3256335). He explains that the timing of this application leads Party B to believe that the publicity surrounding the launch of its 'Matt D'Arcy' project was the catalyst for Ms Campbell to file the application. Mr Cowan explains that Party B became aware of the MATTHEW D'ARCY registration when it filed its own application to register the mark, Matt D'Arcy's, and received a notice of threatened opposition from Party A (to whom the MATTHEW D'ARCY registration had been assigned from Ms Campbell, on 11 July 2018). Mr Cowan states that UKTM 3039011, D'ARCY'S, was also assigned to Party A on 30 July 2018 (from a different third party based in the US). He provides copies of the 'event history' from the IPO website, for UKTM Nos 3256335 and 3039011 confirming the changes of ownership of those marks.⁶

20) I now turn to Ms Stewart's evidence. Ms Stewart provides records from the IPO website pertaining to two UK trade marks. The first is UKTM No 3258151 for the mark BOXED WATER IS BETTER and, the second, is UKTM No 3258155 for the trade mark BELFAST TITANIC⁷. She also provides extracts from Companies House database showing details of TQ17 Limited (formerly Belfast Titanic Quarter Whiskey Ltd) and Trinity Holdings (NI) Limited (Party A). Ms Stewart's witness statement provides no supporting narrative; it merely serves to introduce those documents into the proceedings. However, Anson's written submissions of 25 March 2019, which accompanied Ms Stewart's evidence, make the following observations in relation to that evidence:

“As can be seen from the registry extracts attached to the witness statement from Cherrie Stewart, accompanying these submissions, Ms Campbell filed

⁵ Exhibit ALC5

⁶ Exhibits ALC7 and ALC8

⁷ Exhibit CS1

two further applications in September 2017, the first being UK Trade Mark Application No. UK00003258151 for the mark BOXED WATER IS BETTER covering 'non-alcoholic drinks' in Class 32 which was withdrawn on 24 October 2017; the second being UK Trade Mark Application No. UK00003258155 for the mark BELFAST TITANIC covering 'spirits; Irish whiskey' which was also assigned to Belfast Titanic Quarter Whiskey Ltd and then withdrawn.

It is relevant to note that of the three trade mark applications filed by Margot Campbell, one has been withdrawn and the other two have been assigned.

It is further interesting to note that Raymond McLaughlin is the sole director of both Belfast Titanic Quarter Whiskey Ltd (now TQ17 Limited) and Party A, both of which have registered offices in Northern Ireland where Party B is also located and where their goodwill subsists.”

DECISION

21) I will first consider Party B's application to have Party A's **MATTHEW D'ARCY** trade mark registration (UKTM No 3256335) cancelled.

Section 5(4)(a)

22) Section 47(2)(b) of the Act states:

“47(2) The registration of a trade mark may be declared invalid on the ground-

(a) ...

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

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

23) Section 5(4)(a) states:

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

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

(b) [.....]

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

24) In *Discount Outlet v Feel Good UK*, [2017] EWHC 1400 IPEC, Her Honour Judge Melissa Clarke, sitting as a deputy Judge of the High Court, conveniently summarised the essential requirements of the law of passing off as follows:

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

56. In relation to deception, the court must assess whether “*a substantial number*” of the Claimants’ customers or potential customers are deceived, but it is not necessary to show that all or even most of them are deceived (per *Interflora Inc v Marks and Spencer Plc* [2012] EWCA Civ 1501, [2013] FSR 21).”

The relevant date

25) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of s.5(4)(a) of the Act and concluded as follows:

“43. In *SWORDERS TM* O-212-06 Mr Alan James acting for the Registrar well summarised the position in s.5(4)(a) proceedings as follows:

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

26) In the absence of any earlier use of **Matthew D’Arcy’s** by Party A, the only relevant date for assessing the passing-off right claim is the date of application for registration of that mark i.e. 13 September 2017.

Goodwill

27) The concept of goodwill was considered by the House of Lords in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217:

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

28) Party B relies upon use of **MATT D'ARCY** in relation to 'Distilling, rectifying and blending of spirits, namely whiskey' from 07 September 2017 i.e. six days prior to the relevant date. The use claimed is based on pre-launch advertising which is said to have taken place over those six days in Northern Ireland.

29) In *Starbucks (HK) Limited and another v British Sky Broadcasting Group and others (No.2)*⁸ the court supported the proposition that evidence of customers is required to support a passing-off right. Evidence of mere use of a sign in pre-launch advertising being insufficient. Giving judgment for the Supreme Court, Lord Neuberger said:

“47. Although I acknowledge that PCCM's case is not without force (as is well demonstrated by the reasoning in the judgments in ConAgra), I have reached the conclusion that this appeal should be dismissed on the same ground on which it was decided in the courts below. In other words, I consider that we should reaffirm that the law is that a claimant in a passing off claim must establish that it has actual goodwill in this jurisdiction, and that such goodwill involves the presence of clients or customers in the jurisdiction for the products or services in question.”

And:

“52. As to what amounts to a sufficient business to amount to goodwill, it seems clear that mere reputation is not enough, as the cases cited in paras 21-26 and 32-36 above establish. The claimant must show that it has a significant goodwill, in the form of customers, in the jurisdiction, but it is not necessary that the claimant actually has an establishment or office in this country. In order to establish goodwill, the claimant must have customers within the jurisdiction, as opposed to people in the jurisdiction who happen to be customers elsewhere.”

Later in his judgment, Lord Neuberger turned his mind to the question of whether advertising under a mark may be sufficient to establish a passing-off right. He said:

⁸ [2015] UKSC 31

“66. Finally, a point which I would leave open is that discussed in the judgment of Sundaresh Menon CJ in *Staywell* (see para 46 above), namely whether a passing off claim can be brought by a claimant who has not yet attracted goodwill in the UK, but has launched a substantial advertising campaign within the UK making it clear that it will imminently be marketing its goods or services in the UK under the mark in question. It may be that such a conclusion would not so much be an exception, as an extension, to the “hard line”, in that public advertising with an actual and publicised imminent intention to market, coupled with a reputation thereby established may be sufficient to generate a protectable goodwill. On any view, the conclusion would involve overruling *Maxwell v Hogg*, and, if it would be an exception rather than an extension to the “hard line”, it would have to be justified by commercial fairness rather than principle. However, it is unnecessary to rule on the point, which, as explained in para 46, has some limited support in this jurisdiction and clear support in Singapore. Modern developments might seem to argue against such an exception (see para 63 above), but it may be said that it would be cheap and easy, particularly for a large competitor, to “spike” a pre-marketing advertising campaign in the age of the internet. It would, I think, be better to decide the point in a case where it arises.”

30) Although Lord Neuberger left to another day the question of whether advertising by itself could create a protectable goodwill, the Supreme Court did not change the law in this respect. Rather, Lord Neuberger said that the law was as stated in *Maxwell v Hogg*,⁹ which he understood as having decided “*that mere reputation, without customers, was not enough to found a passing off claim*”.

31) Whilst acknowledging the uncertainty, Wadlow’s¹⁰ retains the position that advertising may be enough where it is connected to the imminent launch of a new product or service. The relevant paragraph states:

“3-65

⁹ (1867) LR 2 Ch 307

¹⁰ Paragraph 3-65 of Wadlow’s ‘The Law of Passing Off 5th Ed’.

Despite these reservations, it is suggested that advertising directed at a specific market in actual preparation for trading (or “public advertising with an actual and publicised imminent intention to market”) may indeed generate sufficient goodwill to support the action, even before actual trading commences. Lord Macnaghten’s description of goodwill as “the attractive force which brings in custom” is consistent with goodwill existing because advertising has created a demand for the claimant’s business, even if it might be thought that the following passage “[i]t is the one thing that distinguishes an old established business from a new one at its first start” points the other way. The increasing importance of advertising in creating goodwill has been recognised by the highest authority.”

32) *Allen v Brown Watson*¹¹ and *BBC v Talbot*¹² are authority for the proposition that pre-launch publicity may be enough to generate an actionable goodwill. However, it is important to note that the plaintiffs in those cases already had established businesses and goodwill in the UK, as noted in Wadlow’s:

“In reality, neither *Allen v Brown Watson* nor *BBC v Talbot* actually turned on the existence of goodwill. It is irrelevant to ask whether either advertising or actual use generated goodwill in the title or name itself, because the right protected by passing-off is not a right of property in a particular name or mark, but the goodwill in the claimant’s business as a whole. W.H. Allen was a long-established business with ample goodwill. So was the BBC.”¹³

The real issue in those cases was, therefore, whether the new marks had become distinctive of those established businesses to their existing UK customers through advertising alone.

33) In *Blink* BL O/606/18, Professor Philip Johnson, as the Appointed Person, considered the authorities and the relevant passages in Wadlow’s. He concluded that:

¹¹ [1965] RPC 191

¹² [1981] FSR 228

¹³ See paragraph 3-071 of Wadlow’s ‘The Law of Passing Off 5th Ed’.

“48. Lord Neuberger’s suggestion that *Maxwell v Hogg* would need to be overruled for a claimant to bring a passing off claim without goodwill (which must be in relation to the relevant product or service) based on substantial advertising clearly shows that *Maxwell v Hogg* remains the law. Contrary to the Respondent’s submission, I am bound by *Maxwell v Hogg*. Accordingly, as there was no goodwill in the Blink browser engine (the product) the extensive advertising by Google during the three-week period is not enough to found a claim of passing off in the relevant respect.”

Accordingly, Professor Johnson understood the Supreme Court as re-affirming the requirement for actual customers, not just advertising.

34) In the case before me, Party B has filed no evidence to show, or even suggest, that it was an established business at the relevant date; indeed, there is no evidence to suggest Party B had any customers at all. The position is not therefore akin to that which existed in *Allen v Brown Watson* or *BBC v Talbot*. In such circumstances, it is difficult, bearing in mind all the case law above, to see how Party B can establish the existence of any goodwill at the relevant date, regardless of how extensive its advertising may have been. Nevertheless, as the law on this matter is not entirely clear, I will go on to consider Party B’s evidence of pre-launch advertising in support of its contention that it did have the requisite goodwill.

35) The fact that the advertising was restricted to Northern Ireland is not, in principle, detrimental to Party B’s case because it is well-established that the existence of local goodwill may be sufficient to succeed in a claim of passing-off. I also keep in mind that, as is clear from *Stacey v 2020 Communications*¹⁴ and other cases, a small goodwill (so long as it is more than trivial) is sufficient to justify protection under the law of passing off.

36) The advertising which took place in the short window of time prior to the relevant date appears to have been far from substantial, consisting, as it does, of a few posts

¹⁴ [1991] FSR 49

on facebook and a handful of press articles. Attendance at the press conference appears to have been small; there is no evidence to indicate that it was any larger than that which is depicted in the photographs provided. Further, in relation to the press articles themselves, there is no information about the circulation numbers of the relevant newspapers nor any indication of how many people may have viewed the on-line articles (e.g. website visitor numbers). It is therefore not possible to tell how many people in Northern Ireland are likely to have been exposed to those articles. A further problem for Party A is that the articles do not speak of an imminent launch of the Matt D’Arcy whiskey distillery or products. The Newry Democrat newspaper, for example, refers to Party B’s plans for its new venture to revive an old distillery under the D’arcy name. However, it appears that those plans were still in their infancy at the relevant date in the sense that the distillery would not be up and running for some time because the article also states that “no single malt whiskey will be ready for 15 years” and “The next step is to find someone to actually make the whiskey”. I do not consider that articles of this nature would create the necessary demand for Party B’s goods when those goods will not be available to purchase for such a long period of time. As to the fact that Party A is the proprietor of the domain names www.mattdarcy.Irish and www.mattdarcys.com, this does not assist it; mere ownership of those domain names does not establish the existence of goodwill.

37) I find that the evidence before me is insufficient to show that Party B had the requisite goodwill at the relevant date. **The claim under section 5(4)(a) is dismissed.**

Section 3(6)

38) Section 3(6) of the Act states:

“(6) A trade mark shall not be registered if or to the extent that the application is made in bad faith.”

39) The law in relation to this section of the Act was summarised by Arnold J. in *Red Bull GmbH v Sun Mark Limited and Sea Air & Land Forwarding Limited* [2012] EWHC 1929 (Ch):

“130. A number of general principles concerning bad faith for the purposes of section 3(6) of the 1994 Act/Article 3(2)(d) of the Directive/Article 52(1)(b) of the Regulation are now fairly well established. (For a helpful discussion of many of these points, see N.M. Dawson, "Bad faith in European trade mark law" [2011] IPQ 229.)

131. First, the relevant date for assessing whether an application to register a trade mark was made in bad faith is the application date: see *Case C- 529/07 Chocoladenfabriken Lindt & Sprüngli AG v Franz Hauswirth GmbH* [2009] ECR I-4893 at [35].

132. Secondly, although the relevant date is the application date, later evidence is relevant if it casts light backwards on the position as at the application date: see *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2008] EWHC 3032 (Ch), [2009] RPC 9 at [167] and cf. *Case C-259/02 La Mer Technology Inc v Laboratoires Goemar SA* [2004] ECR I-1159 at [31] and *Case C-192/03 Alcon Inc v OHIM* [2004] ECR I-8993 at [41].

133. Thirdly, a person is presumed to have acted in good faith unless the contrary is proved. An allegation of bad faith is a serious allegation which must be distinctly proved. The standard of proof is on the balance of probabilities but cogent evidence is required due to the seriousness of the allegation. It is not enough to prove facts which are also consistent with good faith: see *BRUTT Trade Marks* [2007] RPC 19 at [29], *von Rossum v Heinrich Mack Nachf. GmbH & Co KG* (Case R 336/207-2, OHIM Second Board of Appeal, 13 November 2007) at [22] and *Funke Kunststoffe GmbH v Astral Property Pty Ltd* (Case R 1621/2006-4, OHIM Fourth Board of Appeal, 21 December 2009) at [22].

134. Fourthly, bad faith includes not only dishonesty, but also "some dealings which fall short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined": see *Gromax Plasticulture Ltd v Don & Low Nonwovens Ltd* [1999]

RPC 367 at 379 and *DAAWAT Trade Mark* (Case C000659037/1, OHIM Cancellation Division, 28 June 2004) at [8].

135. Fifthly, section 3(6) of the 1994 Act, Article 3(2)(d) of the Directive and Article 52(1)(b) of the Regulation are intended to prevent abuse of the trade mark system: see *Melly's Trade Mark Application* [2008] RPC 20 at [51] and *CHOOSI Trade Mark* (Case R 633/2007-2, OHIM Second Board of Appeal, 29 February 2008) at [21]. As the case law makes clear, there are two main classes of abuse. The first concerns abuse vis-à-vis the relevant office, for example where the applicant knowingly supplies untrue or misleading information in support of his application; and the second concerns abuse vis-à-vis third parties: see *Cipriani* at [185].

136. Sixthly, in order to determine whether the applicant acted in bad faith, the tribunal must make an overall assessment, taking into account all the factors relevant to the particular case: see *Lindt v Hauswirth* at [37].

137. Seventhly, the tribunal must first ascertain what the defendant knew about the matters in question and then decide whether, in the light of that knowledge, the defendant's conduct is dishonest (or otherwise falls short of the standards of acceptable commercial behaviour) judged by ordinary standards of honest people. The applicant's own standards of honesty (or acceptable commercial behaviour) are irrelevant to the enquiry: see *AJIT WEEKLY Trade Mark* [2006] RPC 25 at [35]-[41], *GERSON Trade Mark* (Case R 916/2004-1, OHIM First Board of Appeal, 4 June 2009) at [53] and *Campbell v Hughes* [2011] RPC 21 at [36].

138. Eighthly, consideration must be given to the applicant's intention. As the CJEU stated in *Lindt v Hauswirth*:

"41. ... in order to determine whether there was bad faith, consideration must also be given to the applicant's intention at the time when he files the application for registration.

42. It must be observed in that regard that, as the Advocate General states in point 58 of her Opinion, the applicant's intention at the relevant time is a subjective factor which must be determined by reference to the objective circumstances of the particular case.

43. Accordingly, the intention to prevent a third party from marketing a product may, in certain circumstances, be an element of bad faith on the part of the applicant.

44. That is in particular the case when it becomes apparent, subsequently, that the applicant applied for registration of a sign as a Community trade mark without intending to use it, his sole objective being to prevent a third party from entering the market.

45. In such a case, the mark does not fulfil its essential function, namely that of ensuring that the consumer or end-user can identify the origin of the product or service concerned by allowing him to distinguish that product or service from those of different origin, without any confusion (see, inter alia, Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 48)."

40) The relevant date under section 3(6) is the date of application of Party A's mark i.e. 13 September 2017.

41) I remind myself that Party B's objection is as follows:

- the original applicant, Margot Campbell, became aware of the plans of the Applicant, Matt D'Arcy & Company Limited, due to the publicity surrounding their plans to revive and renovate an old distillery, for the distillation of whiskey and provide a visitor's centre under the trade mark MATT D'ARCYS and consequently, Margot Campbell chose to file a pre-emptive application for the very similar mark, MATTHEW D'ARCYS, to benefit from the Applicant's adoption of the mark MATT D'ARCYS; and

- the Registrant, Margot Campbell, had no bona fide intention to use the mark MATTHEW D'ARCY'S in respect of the goods covered by the application.

42) As the case law makes clear, I must establish what the original applicant, Ms Campbell, knew at the time of filing the contested mark and whether, in the light of that knowledge, her conduct was dishonest or otherwise fell short of the standards of acceptable commercial behaviour judged by ordinary standards of honest people. I am also mindful that there is a presumption of good faith and that it is not enough to establish facts which are consistent with both good faith and bad faith.

43) I note that the current proprietor, Party A, to whom the registration was assigned, from Ms Campbell, has filed no evidence in these proceedings. Party A states that it has been unable to contact Ms Campbell to ascertain what her intentions were when she filed the application for the contested mark. There is also no explanation from Party A about the circumstances surrounding the assignment e.g. the nature of its relationship with Ms Campbell, why the trade mark was assigned to it or what its intentions are in respect of use of the trade mark. Such evidence may have been helpful in terms of shedding light upon the position, as it was, at the relevant date (despite emanating from after that date). That said, such evidence would only be necessary if Party B's evidence is sufficient to establish a *prima facie* case of bad faith. Having considered the evidence of Party B, I do not consider that it fulfils this burden for the following reasons.

44) Firstly, there is nothing to suggest that Ms Campbell had seen or been aware of the press conference held by Party A in Sept 2017 nor that she had read any of the subsequent press articles published in Northern Ireland. Further, as the press coverage appears to have been far from extensive, it would not be appropriate to infer that Ms Campbell is likely to have been exposed to the relevant articles, notwithstanding the proximity of those articles to the date of application of the contested mark. It is not as though the mark is so unusual that it could only have been copied after exposure to the press articles. As Party B's own evidence shows, it is a mark which was chosen to honour the historic company with the same name

which had been based in Northern Ireland in the 19th century and therefore it is a name with which those in the whiskey business may already have been familiar with.

45) Secondly, even if Ms Campbell had been aware of the press articles, it is not entirely clear to me what Party B means when it says that it was Ms Campbell's intention to 'benefit from the applicant's adoption of the mark MATT D'ARCY'. A claim of bad faith is a serious allegation which should be clearly and distinctly pleaded. If Party A means that it was Ms Campbell's intention to prevent it from entering the market, I do not consider the evidence establishes this. It is said by Party B that the press articles were the 'catalyst' for Ms Campbell to file the contested mark. Even if that were true, it does not automatically follow that her sole intention was to prevent Party A from using its mark or that her motive was otherwise dishonest or fell short of the standards of acceptable commercial behaviour judged by ordinary standards of honest people.

46) Thirdly, as regards Party B's evidence showing that Ms Campbell applied for three trade marks in September 2017 and then subsequently withdrew one and assigned the other two (including the contested mark), three is not a large number. The withdrawal/assignment of three marks falls far short of establishing that there was, for example, a pattern of behaviour of applying for marks without any intention to use them on the part of Ms Campbell.

47) Finally, as regards Party B's contention that it is 'interesting to note' that the two assignments were made to companies under the control of the sole director of Party A and that both of those companies are based in Northern Ireland, where Party B's claimed goodwill subsists, I do not consider that this assists Party B. This is because i) I have already found that there was no goodwill, ii) even if Ms Campbell had seen/been aware of the press articles, it does not follow that her intentions were in bad faith for reasons already explained above, iii) given that the two assigned registrations cover Irish Whiskey, it is not surprising that they were later assigned to companies based in Ireland, or indeed, Northern Ireland, and iv) the fact that those two companies happen to have the same director sheds little light on the matter. It is not as though there has been, for example, any clear allegation by Party B that Ms

Campbell was known to Party A when she filed the application for the contested mark or that she made the application as a proxy for Party A.

48) In all these circumstances, and for all the above reasons, I am not persuaded that Party B has established a *prima facie* case for Party A to answer. As such, while I have found myself wondering about Ms Campbell's intentions when the application was filed, there is insufficient evidence before me to justify a finding of bad faith.

The claim under section 3(6) of the Act fails.

Party A's opposition to Party B's trade mark application for Matt d'Arcy's

49) Section 5(2)(b) of the Act provides that:

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

(a)

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

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

50) The leading authorities which guide me are from the Court of Justice of the European Union ('CJEU'): *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

The principles

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

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

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

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

(k) if the association between the marks creates a risk that the public 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

51) The respective goods and services are:

Party B's goods and services	Party A's goods
<p>Class 33: Whiskey [whisky]; Blended whisky; Scotch whisky-based liqueurs; Alcoholic beverages (except beers).</p> <p>Class 43: Restaurant, bar and catering services; provision of food and drink; takeaway services; information in relation to all the aforesaid services.</p>	<p><u>Mark '011:</u></p> <p>Class 33: Alcoholic beverages; whiskey, but in so far as whisky and whisky based liqueurs are concerned, only Irish whiskey and Irish whiskey-based liqueurs produced in Ireland.</p> <p><u>Mark '335:</u></p> <p>Class 33: Alcoholic Beverages, Spirits, whiskey.</p>

52) In *Gérard Meric v Office for Harmonization in the Internal Market (Trade Marks and Designs)* (OHIM Case T-133/05) ('*Meric*'), the General Court held:

“29 In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by the trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or when the goods designated by the trade mark application are included in a more general category designated by the earlier mark (Case T-104/01 Oberhauser v OHIM – Petit Liberto (Fifties) [2002] ECR II-4359, paragraphs 32 and 33; Case T-110/01 Vedial v OHIM – France Distribution (HUBERT) [2002] ECR II-5275, paragraphs 43 and 44; and Case T-10/03 Koubi v OHIM – Flabesa (CONFORFLEX) [2004] ECR II-719, paragraphs 41 and 42).”

53) Both of Party A’s earlier marks contain the broad term ‘Alcoholic beverages’. All the goods listed in class 33 of Party B’s specification fall within that term. The respective goods in class 33 are therefore identical in accordance with *Meric*.

54) I now turn to consider Party B’s services in class 43. In doing so, I bear in mind that, in the judgment of the CJEU in *Canon*, Case C-39/97, the Court stated at paragraph 23 of its judgment that:

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

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

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services;

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

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

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

57) In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

"In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase."

58) In terms of being complementary (one of the factors referred to in *Canon Kabushiki Kaisha v. Metro-Goldwyn-Mayer*), in *Kurt Hesse v OHIM*, Case C-50/15 P, the CJEU stated that complementarity is an autonomous criterion capable of being the sole basis for the existence of similarity between goods. In *Boston Scientific Ltd v Office for Harmonization in the Internal Market (Trade Marks and Designs) (OHIM)*, Case T-325/06, the General Court stated that “complementary” means:

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

59) In *Sanco SA v OHIM*, Case T-249/11, the General Court indicated that goods and services may be regarded as ‘complementary’ and therefore similar to a degree in circumstances where the nature and purpose of the respective goods and services are very different, i.e. *chicken* against *transport services for chickens*. The purpose of examining whether there is a complementary relationship between goods/services is to assess whether the relevant public are liable to believe that responsibility for the goods/services lies with the same undertaking or with economically connected undertakings. As Mr 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.”

Whilst on the other hand:

“.....it is neither necessary nor sufficient for a finding of similarity that the goods in question must be used together or that they are sold together.”

Bar services

60) These services differ in nature, purpose and methods of use to the opponent's goods. However, the respective goods and services may coincide in terms of their suppliers and distribution channels. There is also a degree of complementarity as the opponent's goods are indispensable for the provision of the applicant's services and consumers might think that the responsibility for both lies with the same undertakings. Further, there is a degree of competition because a consumer may choose between purchasing an alcoholic beverage at a bar or from a supermarket to drink at home, for example. Overall, I find there to be a low to medium degree of similarity.

Restaurant services

61) Notionally speaking, the opponent's specification covers wine. I consider this type of alcoholic beverage to represent the opponent's strongest case against the services above, because wine is commonly served in restaurants. Wine is different in nature to restaurant services and the method of use and purpose of the respective goods and services is also different. I do not consider that there is any real competitive relationship in play. This is because, whilst it is true that restaurants serve alcoholic drinks, their primary and core purpose is to serve prepared meals. I do not therefore consider it likely that the average consumer will choose between purchasing an alcoholic beverage and utilising the applicant's services. However, there is a degree of complementarity given that, in my experience, restaurants often serve house wines. Overall, I find that there is a low degree of similarity between the applicant's services and the opponent's goods.

provision of food and drink

62) This is a broad term which includes restaurant services and the like. To my mind, similar considerations apply to this term as to those expressed in the preceding paragraph. There is likely to be overlap in distribution channels and a degree of complementarity between these services and the goods of the opponent. There is a

low degree of similarity between these services and the opponent's *alcoholic beverages*.

takeaway services

63) The core meaning of this term is an establishment that provides prepared meals. Whilst, in my experience, they may also provide non-alcoholic beverages (such as fizzy drinks), they do not usually provide alcoholic beverages. As there is no evidence before me to suggest otherwise, I find that there is no similarity between these services and the opponent's goods.

Catering services

64) To my mind, the core meaning of this term is the service of preparing and serving food and drink to the public, usually at a social/business event (such as a wedding or conference). There is no overlap in terms of users, nature, purpose and method of use with the opponent's goods. Whilst providers of catering services may serve alcoholic beverages (such as wine), I see no reason why, and there is no evidence before me to suggest, that consumers would expect those beverages to have been produced by the caterer itself. I also cannot see that there is any real competitive relationship between these services and the opponent's goods. I find no similarity between these services and the opponent's goods.

information in relation to all the aforesaid services.

65) I have found no similarity between the opponent's goods and *catering services* and *takeaway services*. I also see no reason to find that there would be any similarity between the provision of information about those services with the opponent's goods. They are not similar.

66) While I have found there to be some similarity between the opponent's goods and *bar services*, *the provision of food and drink* and *restaurant services*, it does not follow that the same finding applies to the provision of information about those services. Such services do not, in my view share any overlap in nature, purpose,

method of use, competitiveness or complementarity with the opponent's goods. There is no similarity between these services and the opponent's goods.

Average consumer and the purchasing process

67) It is necessary to determine who the average consumer is for the respective goods and the manner in which they are likely to be selected. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

68) The average consumer of the parties' goods in class 33 is a member of the general public, over the age of 18. In my experience these goods are sold through a range of channels including supermarkets, off-licences and their online equivalents, where the goods are likely to be viewed and self-selected by the consumer. Whilst the goods may also be purchased in bars and similar establishments, where they may be requested orally, the goods will still, ordinarily, be on display so that they can be seen¹⁵. Accordingly, the selection of the goods will be primarily visual, although aural considerations will play a part. The goods are not, generally, particularly expensive. However, the average consumer may take account of factors such as type, flavour, aroma and 'Alcohol by volume'. Generally speaking, I would expect the level of attention to be medium.

¹⁵ *Simonds Farsons Cisk plc v OHIM*, Case T-3/04

69) The average consumer of bar and restaurant services and the provision of food and drink in class 43 of the contested mark, is also the general public. The services will be selected primarily visually, having encountered the mark on, for example, signage in the street, advertisements or websites. In general, I would expect the level of attention paid to the selection of the services to be medium.

Distinctive character of the earlier marks

70) The distinctive character of the earlier marks must be considered. The more distinctive they are, either by inherent nature or by use, the greater the likelihood of confusion (*Sabel BV v Puma AG*). In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

71) I note that, in its submissions, Party A asserts that the surname D'Arcy is well-known in the UK consequent upon the use made of that name in popular literature such as Jane Austen's *Pride and Prejudice* and subsequent television adaptations and films based upon that novel. However, as that information has not been provided in evidence, I cannot take it into account. In any event, even if it had been properly deposited, I do not consider that it would assist in determining the distinctiveness of the name D'Arcy in the UK. This is because evidence showing that the name has been used as a surname for literary characters does not establish that the name is a common surname amongst the UK public. On the other hand, there is also nothing before me to suggest that it is a particularly unusual surname in the UK. I therefore come to the view that D'ARCY'S has an average (neither high nor low) degree of inherent distinctiveness.

72) Turning to the earlier MATTHEW D'ARCY mark, again there is no evidence to assist me. The mark will be perceived as a person's full name. I think it fair to conclude, even in the absence of evidence, that Matthew is a common forename in the UK; of itself, it has a below average degree of distinctive character. I have already found that D'ARCY is a name with average distinctiveness. Considering the mark overall, I find it to have an average degree of distinctiveness.

Comparison of marks

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

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

that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

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

Party B's mark	Party A's marks
<p>Matt D'Arcy's</p>	<p>Mark '011:</p> <p style="text-align: center;">D'ARCY'S</p> <p>Mark '335:</p> <p style="text-align: center;">MATTHEW D'ARCY</p>

74) D'ARCY'S does not lend itself to deconstruction into separate components; its overall impression rests in the whole. Turning to MATTHEW D'ARCY, the two words form a full name. However, given my earlier findings as to the relative distinctiveness of the names MATTHEW and D'ARCY, I find that the surname is likely to attract the greater degree of attention and carry the greatest weight in the overall impression of the mark. Similar considerations apply to the mark Matt D'Arcy's given that i) Matt is commonly used as a shortening of the name Matthew in the UK and ii) the possessive 's' in the mark makes no material difference to these considerations. I therefore find that D'Arcy's has greater weight than Matt in the overall impression of that mark.

75) I will first assess the similarity between earlier mark '011 and the contested mark. The presence of Matt in the contested mark, which is absent from mark '011 is a

clear point of visual difference. However, the whole of mark '011 is also contained in the contested mark. Overall, I find a medium degree of visual similarity. Aurally, the comparison is between MATT-DAR-SEES and DAR-SEES. The first syllable of the contested mark is therefore absent from the earlier mark. However, the last two syllables are identical. Overall, I find a medium degree of aural similarity.

76) Conceptually, the parties agree that D'ARCY'S is likely to be perceived as the possessive form of the surname D'ARCY (as opposed to being perceived as a forename) i.e. that these are goods and services provided by a person with that surname. Matt D'Arcy's will be perceived as indicating that the goods and services come from a person with that full name. Both marks therefore send a conceptual message of goods/services emanating from a person with the surname D'ARCY. However, the contested mark refers to a specific person with that surname (Matt); the earlier mark does not. Overall, I find there to be a low degree of conceptual similarity between the marks.

77) I now turn to consider the similarities between earlier mark '335 and the contested mark. There is a point of visual difference in the middle of the marks due to the presence/absence of the letters 'HEW'. There is also a small visual difference created by the possessive 's' in the contested mark. However, in all other respects, the marks are visually the same. I find there to be a high degree of visual similarity overall. Aurally, the comparison is between MATT-DAR-SEES and MATH-YOU-DAR-SEE. The contested mark therefore consists of one less syllable than the earlier mark but shares the same penultimate syllable, a similar final syllable and a similar first syllable. Overall, I find there to be a high degree of aural similarity. Conceptually, given my earlier finding that the name Matt is likely to be perceived as a shortened version of the name Matthew, the marks are conceptually identical.

Likelihood of confusion

78) I must now feed all of my earlier findings into the global assessment of the likelihood of confusion, keeping in mind the following factors: i) the interdependency principle, whereby a lesser degree of similarity between the goods and/or services may be offset by a greater degree of similarity between the marks, and vice versa

(*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*); ii) the more distinctive the earlier mark is, the greater the likelihood of confusion (*Sabel BV v Puma AG*), and; iii) imperfect recollection i.e. that consumers rarely have the opportunity to compare marks side by side but must rather rely on the imperfect picture that they have kept in their mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V.*).

79) I will first consider the likelihood of confusion between Party B's mark and Party A's '335 mark. I have found the latter to have an average degree of inherent distinctiveness. I have also found that the respective marks share a high degree of visual and aural similarity and are conceptually identical. Bearing these factors in mind, I find that an average consumer paying a medium level of attention, is likely, through imperfect recollection, to mistake one mark for the other. Further, even if the consumer does notice the differences between the marks, the similarities are such as to lead them to believe that the respective goods and services emanate from the same or linked undertaking(s). I consider this to be the case in respect of the identical goods in play and the services covered by Party B's mark which share a low/low-medium degree of similarity with Party A's goods. **Party A's ground of opposition under section 5(2)(b) based upon earlier mark '335 therefore succeeds against the following goods and services of Party B:**

Class 33: Whiskey [whisky]; Blended whisky; Scotch whisky-based liqueurs; Alcoholic beverages (except beers).

Class 43: Restaurant, bar services, provision of food and drink.

80) I now turn to consider the likelihood of confusion between Party B's mark and Party A's '011 mark. I am satisfied that the medium degree of visual similarity between the marks, in particular (bearing in mind that the purchase is likely to be mainly visual), is insufficient to lead the average consumer to confuse one mark for the other. There is no likelihood of direct confusion. Turning to the likelihood of indirect confusion, and having borne in mind the comments in *Harman International Industries, Inc v OHIM*, Case C-51/09P and *El Corte Inglés, SA v OHIM*, Case T-39/10, concerning the likelihood of confusion between full names and surnames, I find that the degree of similarity between the marks overall and the average degree

of distinctiveness of Party A's mark are, in all the circumstances, likely to lead an average consumer, paying a medium level of attention, to believe that the respective goods and services emanate from the same or linked undertaking(s). I consider this to be the case in respect of the identical goods in play and the services covered by Party B's mark which share a low/low-medium degree of similarity with Party A's goods. **Party A's ground of opposition under section 5(2)(b) based upon earlier mark '335 therefore succeeds against the following goods and services of Party B:**

Class 33: Whiskey [whisky]; Blended whisky; Scotch whisky-based liqueurs; Alcoholic beverages (except beers).

Class 43: Restaurant, bar services, provision of food and drink.

81) There cannot be a likelihood of confusion between the opponent's goods and the contested services in class 43 which share no similarity. The opposition under section 5(2)(b) must therefore fail to that extent.

OVERALL OUTCOME

82) The application to cancel trade mark registration number 3256335, for the trade mark MATTHEW D'ARCY, fails.

83) Trade mark application number 3305564, for the trade mark Matt D'Arcy's may proceed to registration in respect of the following goods and services only:

Class 21: Whisky glasses; Whisky stones; Household or kitchen utensils and containers; cookware and tableware, except forks, knives and spoons; glassware, porcelain and earthenware.

Class 25: Clothing, footwear, headgear.

Class 30: Coffee, tea, cocoa and artificial coffee; rice; tapioca and sago; flour and preparations made from cereals; bread, pastries and confectionery; edible ices; sugar, honey, treacle; yeast, baking-powder; salt; mustard; vinegar, sauces (condiments); spices; ice (frozen water).

Class 43: Catering services; takeaway services; information in relation to all the aforesaid services.

COSTS

84) Party A has been wholly successful in the cancellation and largely successful in its opposition against classes 33 and 43. It is therefore entitled to an award of costs. Using the guidance in Tribunal Practice Notice 2/2016, I award Party A costs on the following basis:

Preparing statements and considering the other side's statements x 2	£400
Official fee (Form TM7)	£100
Considering Party B's evidence and filing written submissions in lieu of a hearing	£300
Total:	£800

85) I order Matthew D'Arcy & Company Limited to pay Trinity Holdings (NI) Limited the sum of **£800**. 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 20th day of March 2020

Beverley Hedley

For the Registrar, the Comptroller-General