

O/246/20

**TRADE MARKS ACT 1994**

**IN THE MATTER OF APPLICATIONS UNDER NOS. 502652 AND 502653  
BY TOMATIN TRADING COMPANY LIMITED**

**TO INVALIDATE TRADE MARKS NOS. 3314854 AND 3299605**

**REGISTERED IN THE NAME OF  
THE TOMATIN DISTILLERY COMPANY LIMITED**

**The issue**

1. On 11 February 2020, The Tomatin Distillery Company Limited (“the proprietor”) applied to transfer two applications for invalidation launched by Tomatin Trading Company Limited (“the applicant”) to the Court of Session in Edinburgh. The issue to be decided is the Registrar’s response to that application for a transfer of proceedings.

**Background**

2. The invalidity actions are consolidated and relate to the following trade marks:

3314854 (CA000502652)



Filing date 01 June 2018

Registration date 24 August 2018

Goods and services

Class 33: Scotch whisky; alcoholic beverages, but insofar as whisky and whisky based liqueurs are concerned only Scotch whisky and Scotch whisky based liqueurs produced in Scotland.

Class 35: Retail services connected with the sale of whisky and distilled spirits, beers, food, beverages, calendars, printed matter, magazines, greeting cards, jewellery, glassware, earthenware, tableware, t-shirts and clothing, caps and headgear, tea towels, aprons, Christmas tree decorations.

Class 41: Education and entertainment services all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; provision of museum, presentation and exhibition facilities all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; provision of visitor centres (for educational and entertainment purposes) all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; whisky tasting services (for education and entertainment purposes).

Class 43: Bar services; bars; café and restaurant services; cafes; catering (food and drink); pubs and public houses; provision of meeting, conference, convention and exhibition facilities; banqueting services; consultancy services relating to the production of drinks and alcoholic beverages; corporate hospitality services (food and drink); provision of information relating to whisky and other distilled spirits: whisky tasting services (provision of beverages).

3299605 (CA000502653)

**TOMATIN**

Filing date 26 March 2018

Registration date 31 August 2018

Goods and services

Class 35: Retail services connected with the sale of whisky and distilled spirits, beers, food, beverages, calendars, printed matter, magazines, greeting cards, jewellery, glassware, earthenware, tableware, t-shirts and clothing, caps and headgear, tea towels, aprons, Christmas tree decorations. Retail services connected with the sale of whisky and distilled spirits, beers, food, beverages, calendars, printed matter, magazines, greeting cards, jewellery, glassware,

earthenware, tableware, t-shirts and clothing, caps and headgear, tea towels, aprons, Christmas tree decorations.

Class 41: Education and entertainment services all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; provision of museum, presentation and exhibition facilities all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; provision of visitor centres (for educational and entertainment purposes) all relating to the manufacture, production, sale, history and consumption of whisky and other distilled spirits; whisky tasting services (for education and entertainment purposes).

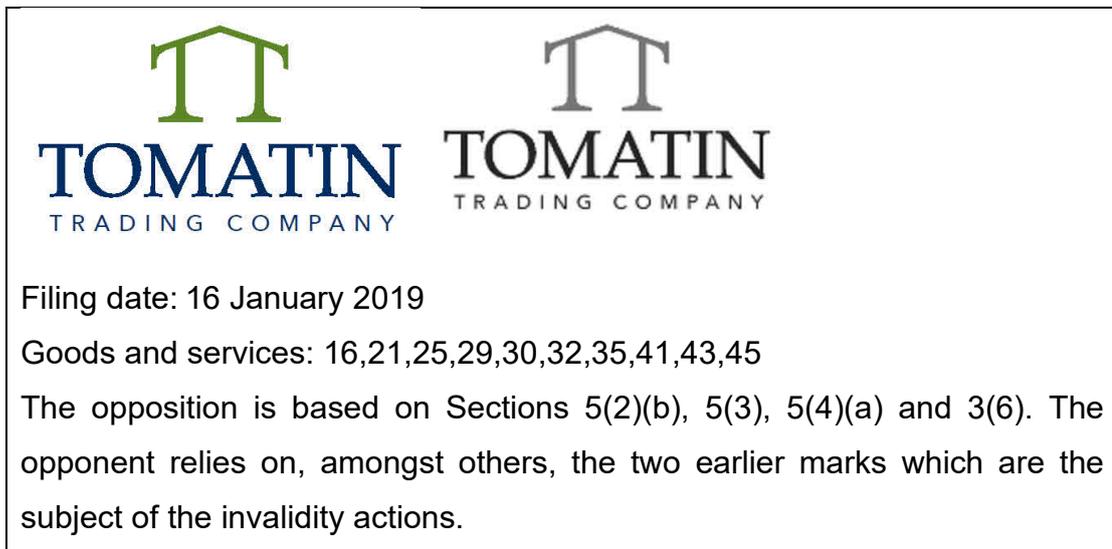
Class 43: Bar services; bars; café and restaurant services; cafes; catering (food and drink); pubs and public houses; provision of meeting, conference, convention and exhibition facilities; banqueting services; consultancy services relating to the production of drinks and alcoholic beverages; corporate hospitality services (food and drink); provision of information relating to whisky and other distilled spirits: whisky tasting services (provision of beverages).

3. The invalidity actions against the above marks were filed on 21 June 2019.

4. The invalidity actions are based on the same grounds, namely Sections 3(1)(c), 3(6) and (3)(3)(a) of the Trade Mark Act ("the Act"). The applicant claims that the marks are descriptive because TOMATIN is the name of a village in the Scottish Highlands and so they designate the geographical origin of the goods and services. It also claims that the marks are contrary to public policy because geographical indications should be kept available for use by traders. On the Section 3(6) ground, the applicant claims that the applications were made in bad faith because (1) the proprietor is a producer of whisky and has a number of registrations covering only goods in class 33, all of which were filed before the contested marks and (2) the contested marks have a broader specification and were filed only to prevent the applicant from using the mark TOMATIN in relation services in class 35 and 43. In this connection, the applicant says that the contested marks were applied for after the proprietor discovered the applicant's plans to open a new hotel, food and retail village at the Tomatin junction under the name TOMATIN TRADING COMPANY.

5. In addition to the invalidity actions, the proprietor and the applicant are involved in parallel proceedings concerning:

- (i) An opposition (417748) filed by the proprietor against an application filed by the applicant for the following mark (UK3367610, series of two):



- (ii) Court proceedings launched by the proprietor on 6 November 2019 against the applicant, based on infringement and passing off. The infringement action is based on the claim that the applicant has infringed the proprietor's trade marks, two of which are those that are the subject of the invalidity actions.

## Decision

6. Section 47(3) of the Act states:

“An application for a declaration of invalidity may be made by any person, and may be made either to the registrar or to the court, except that—

- (a) if proceedings concerning the trade mark in question are pending in the court, the application must be made to the court; and

- (b) if in any other case the application is made to the registrar, he may at any stage of the proceedings refer the application to the court.

7. The two leading authorities on whether a transfer should be granted in circumstances such as the present ones are *Sears plc v Sears, Roebuck & Co* [1993] RPC 385 and *Genius Trade Mark* [1999] RPC 741.

8. The following principles emerge from those authorities:

1. If there are two courts faced with substantially the same question or issue, that question or issue should be determined in only one of those courts, and the court will if necessary stay one of the actions. (Quoted by *Lindsay J in Sears* at p.388, lines 32-35, and taken from *Halsbury's Laws and Thames Launches v Trinity House* [1961] Ch 197. See also *Lindsay J's* reference to the Court of Appeal's ruling in *Airport Restaurants Ltd v Southend-on-Sea Corp* [1960] 2 All ER 888, at p.390, lines 31-33).
2. In deciding questions relating to a multiplicity of litigation, complete identity between any two proceedings is not essential; nor is it essential for one to be determinative of the other. (*Lindsay J in Sears* at p.391, lines 12-16)
3. The possibility of conflicting decisions of the Registry and the High Court are to be avoided. (*Lindsay J in Sears* at p 393, lines 36-42).
4. A party is not free to pick one tribunal over another. Under Section 49(2) of the Supreme Court Act 1981 the court must itself take an interest to avoid a multiplicity of proceedings. (*Lindsay J in Sears* at p.395, lines 44-49.)

9. Having read the parties' submissions on the requests, my decision is to grant the proprietor's request of transfer the invalidity proceedings to the Court. My reasons are as follows:

10. Generally speaking, a pursuer approaches the Court to restrain acts of infringement because it alleges that his business has been damaged and continues to be damaged by the infringement acts which the defendant has carried out. The proprietor's Court claim includes a request that, if the Court finds that the applicant has infringed the proprietor's trade mark rights, the Court should order that the

applicant's application to register the trade mark 3367610 is withdrawn. Whilst I bear in mind that:

- (i) if the invalidity proceedings are transferred to the Court, the UKIPO will need await the outcome of the invalidity proceedings before making a decision in the opposition proceedings because the marks which are the subject of the invalidity proceedings are relied upon by the proprietor in the opposition against the applicant's mark, and
- (ii) the applicant has argued that if that happens, a defence under Section 11(1) of the Act will not be available to the applicant at the time when the Court has to determine the issue of infringement.

11. I am minded to grant the proprietor's request, because:

- If the UKIPO retains the invalidity actions, it is likely to prejudice the proprietor by causing a delay to the trial of the issue of infringement because two of the marks allegedly infringed are those which are the subject of the invalidity actions;
- I have also considered that the applicant/defender relies on winning the opposition in order to obtain a Section 11(1) defence, which it does not yet have, and would not be available to the applicant/defender if the outcome of the opposition was delayed. However, the defence is only available to valid later marks, and the validity of the later mark, if registered, appears to be linked to the validity of the earlier marks so it would be better for the Court to consider both issues, e.g. validity of the earlier marks and infringement;
- Furthermore, the proprietor's claim includes a request for the application for the applicant's trade mark to be withdrawn. Consequently, if the invalidity actions are transferred to the Court and the Court considers the whole case and finds infringement, it will also consider the proprietor's request that the application for the applicant's trade mark is withdrawn. If the proprietor's

request is granted and the application is withdrawn, the opposition will fall away. If the proprietor's request is only partially granted, the opposition will continue in respect of the goods and services which are found not to infringe and for which withdrawal is not ordered, reducing the risk of inconsistent decisions.

12. As regards the opposition proceedings, the proprietor has already filed its evidence in the opposition proceedings. I do not see why the opposition process should not continue at this stage whilst the decision on the opposition may be suspended until the court resolve the invalidity actions.

13. I will therefore refer the invalidity actions to the Court.

14. The opposition will continue with the current deadline for the filing of the applicant's evidence being 30 May 2020, but the opposition decision will be stayed.

### **Appeal**

15. Any appeal against this decision should be made to the Court dealing with the infringement case.

### **Costs**

16. Costs normally follow the event. The merits of the applications will now fall to be determined by the judge who hears the case and will also consider the issue of costs.

Dated this 21<sup>st</sup> day of April 2020

T Perks

For the Registrar,

The Comptroller – General