

O/919/21

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003617022

BY RSD WHISKY BRANDS LTD

TO REGISTER:

Heart of Edinburgh

AS A TRADE MARK IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 600001830 BY

ANDY LYNDON BAILEY

BACKGROUND AND PLEADINGS

1. On 26 March 2021, RSD Whisky Brands Ltd (“the applicant”) applied to register the trade mark shown on the cover of this decision (“the applicant’s mark”) in the UK for the following goods:

Class 33: Scotch whisky and Scotch whisky-based spirit drinks complying with the specifications of the PGI Scotch whisky.

2. The application was published for opposition purposes on 25 June 2021 and, on 20 July 2021, it was opposed by Andy Lyndon Bailey (“the opponent”) under the fast track opposition procedure. The opposition is based on section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies on the following series of marks:

Heart of scotland gin

Heart of scotland vodka

Heart of scotland rum

(series of three)

UK registration no: 3518097

Filing date 31 July 2020; registration date 13 November 2020

Relying on all goods, namely:

Class 33: Gin; Vodka; Rum; Spirits [beverages]; Distilled spirits; Potable spirits.

(“the opponent’s registration”)

3. The opponent submits that as a result of the similarity between the parties’ marks and goods, there exists a likelihood of confusion. The applicant filed a counterstatement denying the claims made.
4. Rule 6 of the Trade Marks (Fast Track Opposition) (Amendment) Rules 2013, S.I. 2013 2235, disapplies paragraphs 1-3 of Rule 20 of the Trade Mark Rules 2008 but provides that Rule 20(4) shall continue to apply. Rule 20(4) states that:

“(4) The registrar may, at any time, give leave to either party to file evidence upon such terms as the registrar thinks fit.”

5. The net effect of these changes is to require the parties to seek leave in order to file evidence in fast track oppositions. No leave was sought in respect of these proceedings.
6. Neither party is represented. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary. Both parties filed written submissions in lieu of a hearing. This decision is made after careful consideration of the papers.
7. 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 on in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

PRELIMINARY ISSUE

8. In its counterstatement, the applicant stated that:

“[T]here are already other marks registered, prior to “Heart of Scotland”, such as “Heart of Alba” – Alba being in Scotland commonly believed to be the Gaelic name for “Scotland”. There are also existing marks such as “Heart of Islay”, “Heart of England”.”

9. The applicant expanded further upon this point in its submissions wherein it made reference to additional marks such as ‘Heart of Stone’ and ‘Heart of Sweden’, amongst others. While not expressly argued, the applicant appears to be arguing that the distinctiveness of the opponent’s registration has been weakened due to

the frequent use of the prefix 'HEART OF' in the marketplace. However, for reasons that I will now explain, the applicant's point regarding the existence of marks on the register with the prefix 'HEART OF' has no bearing on the outcome of this opposition.

10. I note that in the case of *Zero Industry Srl v OHIM, Case T-400/06*, the General Court ("GC") stated that:

"73. As regards the results of the research submitted by the applicant, according to which 93 Community trade marks are made up of or include the word 'zero', it should be pointed out that the Opposition Division found, in that regard, that '... there are no indications as to how many of such trade marks are effectively used in the market'. The applicant did not dispute that finding before the Board of Appeal but none the less reverted to the issue of that evidence in its application lodged at the Court. It must be found that the mere fact that a number of trade marks relating to the goods at issue contain the word 'zero' is not enough to establish that the distinctive character of that element has been weakened because of its frequent use in the field concerned (see, by analogy, Case T 135/04 GfK v OHIM – BUS(Online Bus) [2005] ECR II 4865, paragraph 68, and Case T 29/04 Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH) [2005] ECR II 5309, paragraph 71). "

11. The fact that there may be a number of entities that have registered trade marks beginning with the words 'HEART OF' is not a relevant factor to the distinctiveness of the opponent's mark. The applicant has filed no evidence regarding any marks on the register or any evidence to demonstrate that these marks are actually in use in the marketplace. The outcome of this opposition will be determined by making a global assessment whilst taking into account all relevant factors and the state of the register is not relevant to that assessment.

DECISION

Section 5(2)(b): legislation and case law

12. Section 5(2)(b) of the Act reads as follows:

“(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 or association with the earlier trade mark.”

13. Section 5A of the Act states as follows:

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

14. An earlier trade mark is defined in section 6 of the Act, the relevant parts of which state:

“(6)(1) In this Act an “earlier trade mark” means –

(a) a registered trade mark, international trade mark (UK) or Community trade mark or international trade mark (EC) which has a date of application for registration earlier than that of the trade mark in question, taking account (where appropriate) of the priorities claimed in respect of the trade marks.

15. The opponent’s registration qualifies as a series of earlier trade marks under the above provisions. I note that in its counterstatement, the applicant sought to put the opponent to proof of use of its registration. However, as the opponent’s registration had not completed its registration process more than 5 years before the application date of the mark in issue, it is not subject to proof of use pursuant

to section 6A of the Act. Consequently, the opponent can rely upon all of the goods for which its mark is registered.

16. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v Office for Harmonization in the Internal Market (Trade Marks and Designs) ("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.

- (a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;
- (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;
- (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;
- (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;
- (e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

- (f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;
- (g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;
- (h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;
- (i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;
- (j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;
- (k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

Comparison of goods

17.I note that the applicant has not expressly denied whether it considers there to be any level of similarity or not between its goods and those of the opponent. While this may be tantamount to an acceptance that the goods are similar, there is no comment as to what level the applicant considers them to be similar. Therefore, it remains necessary for me to undertake a full comparison of the goods at issue, which are as follows:

The opponent's goods	The applicant's goods
<u>Class 33</u> Gin; Vodka; Rum; Spirits [beverages]; Distilled spirits; Potable spirits.	<u>Class 33</u> Scotch whisky and Scotch whisky-based spirit drinks complying with the specifications of the PGI Scotch whisky.

18. The GC confirmed in *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, that, even if goods are not worded identically, they can still be considered identical if one term falls within the scope of another (or vice versa):

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

19. The term “Scotch whisky and Scotch whisky-based spirit drinks complying with the specifications of the PGI Scotch whisky” in the applicant’s specification covers two types of whisky drinks that are required to be compliant with the specifications of the PGI Scotch whisky. Whisky is widely considered to be a type of spirit. While the opponent’s term “spirits [beverages]” does not specifically refer to a requirement that its goods be compliant with the same specifications, it does not mean that it cannot cover goods that do comply with them. As a result, I am of the view that the applicant’s goods fall within the broader term. These goods are, therefore, identical under the principle outlined in *Merici*.

The average consumer and the nature of the purchasing act

20. The case law, as set out earlier, requires that I determine who the average consumer is for the respective parties’ goods. I must then decide the manner in which these goods are likely to be selected by the average consumer in the course of trade. 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.”

21. I find that the average consumer of the goods at issue will be a member of the general public over the age of 18. The goods at issue are most likely to be sold through a range of retail outlets such as supermarkets and off-licences or their online equivalents. The goods will also be sold in restaurants, bars and public houses. In retail outlets, the goods at issue will be displayed on shelves, where they will be viewed and self-selected by the consumer. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. In outlets such as restaurants, bars and public houses, the goods are likely to be on display, for example, behind the counter at bars or on drinks menus. While I do not discount there may be an aural component in the selection and ordering of the goods in eating and drinking establishments, this is likely to take place after a visual inspection of the goods or a menu. The selection of the goods at issue will, therefore, be primarily visual, although I do not discount that aural considerations may play a part by way of word of mouth recommendation or advice from bar/restaurant/sales staff.

22. The goods at issue are not everyday beverage products but are likely to be purchased on a semi-regular basis. The costs of the goods at issue will likely range from fairly inexpensive spirits to relatively expensive barrel aged single malt whiskys, for example. When selecting the goods, the average consumer is likely to consider such things as the goods’ origin, age, size, flavour, use by/best before dates and alcoholic content. The average consumer is, therefore, likely to pay a medium degree of attention during the selection process of the goods.

Comparison of marks

23. It is clear from *Sabel v Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade 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 trade marks must be assessed by reference to the

overall impressions created by the trade marks, bearing in mind their distinctive and dominant components.

24. 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.”

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

26. The respective trade marks are shown below:

The opponent's registration	The applicant's mark
Heart of scotland gin Heart of scotland vodka Heart of scotland rum (series of three)	Heart of Edinburgh

Overall Impression

27. The applicant's mark consists of the words 'Heart of Edinburgh'. There are no other elements that contribute to the overall impression of the mark, that lies in the words themselves.

28. The opponent's registration is a series of three word only marks. The first mark in the series is 'Heart of scotland gin', the second is 'Heart of scotland vodka' and the third is 'Heart of scotland rum'. Given their purely descriptive nature, I consider that the words 'gin', 'vodka' and 'rum' have little impact on the overall impression of the marks across the opponent's registration. As a result, I consider that the overall impression of the marks is dominated by the words 'Heart of scotland' with 'gin', 'vodka' and 'rum' playing much lesser roles.

Visual Comparison

29. Visually, the marks share the first two words, being 'Heart of'. The marks differ in the following words, being 'scotland' across the marks in the opponent's registration and 'Edinburgh' in the applicant's. Given that these words form part of the dominant element of both parties' marks, they act as significant points of visual difference. The marks differ further in the presence of 'gin', 'vodka' and 'rum' across the marks in the opponent's registration. However, I have found that these words have little impact, meaning that they only constitute slight points of visual difference. Taking all of this into account and given that the beginnings of the marks are identical, being where the average consumer tends to focus,¹ I consider that the marks are visually similar to a medium degree.

Aural Comparison

30. Aurally, both parties' marks will be pronounced in the ordinary way. Despite playing much lesser roles, I consider that 'gin', 'vodka' and 'rum' across the opponent's registration will still be pronounced. Therefore, the marks across the opponent's registration consist of either five or six syllables and the applicant's mark consists of six syllables. The first two syllables across the marks are identical whereas the remaining syllables all differ. Given that the identity falls at the beginning of the marks and the fact that the marks are all of equal (or roughly equal) lengths, I consider them to be aurally similar to a medium degree.

¹ *El Corte Inglés, SA v OHIM*, Cases T-183/02 and T-184/02

Conceptual Similarity

31. The differences across the marks in the opponent's registration, being the words 'gin', 'vodka' and 'rum', are all purely descriptive of the goods offered under the marks. As a result, when they are viewed by the average consumer, they will have limited impact on the opponent's registration. As for the words 'Heart of Scotland', I am of the view that they form a unit and, on the goods at issue, they will be seen as indicative of a product that comes from *the heart of Scotland*. I have submissions from the applicant where it is argued that this will be understood as a reference to the central area of Scotland, being the area around Stirling, Perth and Pitlochry, all being relatively close to the opponent's base of operations. The applicant also provided alternative meanings for the heart of Scotland, none of which being Edinburgh. While noted, I do not consider that the explanations put forward by the applicant would be well known to a significant proportion of average consumers in the UK.
32. Turning to the applicant's mark, the words 'Heart of Edinburgh' also form a unit and, on the goods at issue, they will be seen as indicative of a product that comes from *the heart of Edinburgh*. Edinburgh is the capital city of Scotland and I am of the view that the majority of average consumers will be aware of this. I appreciate that Edinburgh is synonymous with the symbol of a heart, being known locally as 'The Heart of Midlothian' or the name of the local football team, however, I do not consider that a significant proportion of average consumers would make this connection.
33. When comparing the conceptual impact of both parties' marks, it is clear that their concepts are dominated by their reference to the heart of a location. While there is a point of conceptual difference between Edinburgh and Scotland, that difference is very slight on the basis that the consumer will be aware of the fact that Edinburgh is the capital city of Scotland. Further, the differences created by the words 'gin', 'vodka' and 'rum' across the opponent's registration will also, in my view, be very slight given their descriptiveness. Overall, given that both parties' marks are dominated by their references to the heart of a location in Scotland, be that its capital or not, I consider that the marks are conceptually similar to a high degree.

Distinctive character of the opponent's mark

34. 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).”

35. Registered trade marks possess various degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods or services, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The opponent has not submitted that its mark has been enhanced through use, nor has it filed any evidence to that effect. Therefore, I have only the inherent position to consider.

36. The opponent's registration is a series of three word only marks. The first mark in the series 'Heart of scotland gin', the second is 'Heart of scotland vodka' and the third is 'Heart of scotland rum'. As the different words across the marks, being

'whisky', 'gin' and 'rum', are purely descriptive, I do not consider that they will contribute to the distinctiveness of the marks. The consistent element across the registration is the words 'Heart of Scotland'. I have set out above that these words form a unit and, on the goods at issue, I am of the view that they will be seen as indicative of a product that comes from 'the heart of Scotland'. While indicative of the goods' origins, its reference is somewhat vague in that it is not entirely clear what is meant by Scotland's heart. For example, it could be a physical reference to its geographical centre, its capital city or a metaphorical reference to the heart of Scotland's culture. Bearing in mind the registration's reference to the origin of its goods, albeit vague, I consider that it enjoys between a low and medium degree of inherent distinctive character.

Likelihood of confusion

37. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and/or services down to the responsible undertakings being the same or related. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind. The first is the interdependency principle i.e. 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. As I mentioned above, it is necessary for me to keep in mind the distinctive character of the earlier mark, the average consumer for the goods and the nature of the purchasing process. In doing so, I must be alive to the fact 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 that he has retained in his mind.

38. I have found the applicant's goods to be identical with the opponent's. I have found the average consumer for the goods to be members of the general public over the age of 18. I have found that the goods will be selected through primarily visual means (although I do not discount an aural component). I have concluded that the average consumer will pay a medium degree of attention.

39. I have found the applicant's mark to be visually and aurally similar to a medium degree and conceptually similar to a high degree with the opponent's registration. I have found the opponent's registration enjoys between a low and medium degree of inherent distinctive character. I have taken these factors into account in my assessment of the likelihood of confusion between the marks.

40. I am reminded that just because I have found the opponent's registration to have a weaker level of distinctive character, this does not preclude a finding of likelihood of confusion between the marks.²

41. Taking all of the above factors and the principle of imperfect recollection into account, I am of the view that it is likely that the average consumer would misremember the differences between the marks. I make this finding on the basis that the conceptual similarities between the marks, in that they both relate to the heart of a location in Scotland (be that its capital or the country itself), would lead the average consumer to mistakenly recall the marks as each other. For example, if an average consumer was ordering the opponent's goods at a bar upon a word of mouth recommendation, I consider it plausible that the consumer would misremember which product was recommended to them and they may, therefore, mistakenly order the applicant's product instead, particularly given its identical prefix and the subsequent reference to a location (be it Scotland or its capital city). Consequently, I am satisfied that there is a likelihood of direct confusion between the marks. However, if I am wrong on my finding of direct confusion, I will proceed to consider indirect confusion.

42. Indirect confusion involves recognition by the average consumer of the differences between the marks. In the present case, I am of the view that the common element, being 'Heart of', that sits at the beginning of the marks, will result in the average consumer believing that the applicant's mark is another brand of the owner of the opponent's registration, or vice versa.³ This is particularly the case given the high conceptual similarities between the marks in that they all refer to the heart of a location, either being Scotland or its capital, Edinburgh. In my view, the average

² *L'Oréal SA v OHIM*, Case C-235/05 P

³ Paragraphs 16 & 17 of *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10

consumer, when confronted with both parties' marks, may understand the applicant's mark to be a sub-brand of the opponent's registration in that it focuses on a more specific location within Scotland or that it is produced in a different location within Scotland itself. For example, it is common for distilleries to be named after their location so that, when confronted with the 'Heart of Edinburgh' mark, the average consumer may consider it to be a sub-brand of the 'Heart of Scotland' group of companies, albeit operating out of a different distillery situated within Edinburgh itself. Consequently, I consider there to be a likelihood of indirect confusion between the parties' marks.

CONCLUSION

43. The opposition has succeeded in its entirety. The application is, therefore, refused.

COSTS

44. The opponent has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2015. In the circumstances, I award the opponent the sum of **£400** as a contribution towards the costs of proceedings. The sum is calculated as follows:

Considering the notice of opposition and preparing a counter statement:	£200
Preparing written submissions in lieu:	£100
Official fee:	£100
Total	£400

45. I therefore order RSD Whisky Brands Ltd to pay Andy Lyndon Bailey the sum of £400. This sum should be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 16th day of December 2021

A COOPER

For the Registrar