

BL O/1034/22

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003590980

BY CURRAGHMORE WHISKEY LIMITED

TO REGISTER THE TRADE MARK:

LADY LOUISA WATERFORD

IN CLASS 33

AND

IN THE MATTER OF OPPOSITION THERETO

UNDER NO. 426607

BY WATERFORD DISTILLERY GROUP LIMITED

BACKGROUND AND PLEADINGS

1. On 5 February 2021, Curraghmore Whiskey Limited (“the applicant”) applied to register the trade mark shown on the cover page of this decision in the UK. The application was published for opposition purposes on the 4 June 2021. The applicant seeks registration for the following goods:

Class 33 Alcoholic beverages, except beer; whiskey; gin; alcoholic preparations for making beverages.

2. The application was opposed by Waterford Distillery Group Limited (“the opponent”) on 3 September 2021. The opposition is based upon section 5(2)(b) of the Trade Marks Act 1994 (“the Act”). The opponent relies upon the following trade marks:

WATERFORD

UK registration no. UK00914354716

Filing date 13 July 2015; Registration date 30 November 2015.

(“The First Earlier Mark”)

WATERFORD TEIREOIR

UK registration no. 3299184

Filing date 23 March 2018; Registration date 29 June 2018.

(“The Second Earlier Mark”)

3. Relying upon all of the goods for which both earlier marks are registered, namely:

Class 33 Spirits.

4. The opponent claims that there is a likelihood of confusion because of the identity of the respective goods and the high degree of similarity between the signs.

5. The applicant filed a counterstatement denying the claims made.

6. The opponent is represented by Marks & Clerk LLP and the applicant is represented by FRKelly. Neither party requested a hearing, but the opponent filed evidence in chief and the applicant filed written submissions. Both parties filed submissions in lieu. I make this decision having taken full account of all the papers, referring to them as necessary.

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.

EVIDENCE

8. The opponent's evidence consists of the witness statement of Mark Reynier dated 25 May 2022. Mr Reynier is the founder and CEO of Waterford Distillery Group Limited, a position which he has held since 25 June 2014. Mr Reynier's statement was accompanied by 11 exhibits (MR1-MR11).

9. Firstly, I note that **exhibit MR1** provides a history of the Waterford Distillery using a variety of articles. It is clear that Mr Reynier brought the Guinness Brewery in Waterford in 2014, and within a year created the Waterford Distillery.¹ The objective of the distillery was to produce the first terroir-driven Irish single malt whisky.²

10. In the article "Distillery In the Spotlight: Waterford Distillery",³ dated 26 January 2020, it mentions that the opponent planned to launch its "1st Cuvee; Pilgrimage" on 25 April 2020 at an open day event, for which 1,000 bottles were especially labelled "I Was There". However, due to the covid pandemic the launch was cancelled, but all the guests who had tickets to this event were sent their inaugural releases to their

¹ **Exhibit MR1**, page 23

² **Exhibit MR1**, page 19

³ **Exhibit MR1**, page 19, 'whiskyauctioneer.com'

homes. The following picture of the 1st Cuvee; Pilgrimage bottle was depicted on the website:



11. The article also includes the following pictures of their Bannow Island: Edition 1.1 and its Ballykilcavan: Edition 1.1 whiskies:



12. I note that the above bottles are also displayed in an article called “The First Whisky Launch by Waterford Distillery” dated 9 June 2020.⁴ This article clarifies that 70 farms,

⁴ Article from “onthesauceagain.com”. This article is also exhibited in **MR3**

19 types of soil and three methods of farming are involved in providing barley to the distillery used to create its whisky, “capturing the very essence of terroir” which focuses on how “the type of barley, the specific soil and location where it grows can enhance the flavour of any spirit”.

13. The article also references the “Single Farm Origin series” which includes the releases of the above Bannow Island: Edition 1.1 and Ballykilcavan: Edition 1.1, as well as the Ratheadon: Edition 1.1 whisky. A bottle of these 3 whiskies range from €70 to €79, with each one made using the barley from the 2015 harvest.

14. All of the above Single Farm Origin series whiskies were distilled in January 2016, and made publicly available in 2020⁵ in specialist UK retailers from 11 June, and a total of 1,500 bottles of each whiskey was created for the UK market”.⁶ However, I note 2,000 bottles of the Ratheadon: Edition 1.1 whiskey was available exclusively online or from the distillery.⁷

15. Due to the high demand of the above Single Farm Origin whiskies, and the “unexpected success” of the first commercial bottlings, which sold out within a matter of hours in major retailers across Europe, the opponent launched another two new Single Farm editions including the Ballymorgan: Edition 1.1 and Sheestown: Edition 1.1, and two slightly older second editions; Bannow Island: Edition 1.2 and Ballykilcavan: Edition 1.2.⁸ Each bottle is priced at £70 and was available from specialist retailers from August 2020 onwards, with 9,000 bottles of each whisky available throughout Europe.⁹

16. **Exhibit MR3** also contains screenshots displaying the bottles of its whisky using the WATERFORD mark on its website, which also displays a WATERFORD mark prominently on the top left hand corner of the website as follows:

⁵ **Exhibit MR3**, page 46

⁶ **Exhibit MR3**, page 45

⁷ **Exhibit MR3**, page 45

⁸ **Exhibit MR3**, page 51

⁹ **Exhibit MR3**, page 51

ONE PLACE, ONE FARM, ONE SPIRIT



17. The website states that “to cope with the excessive demand in Ireland, 1,400 bottles of SFO Ratheadon: Edition 1.1. [depicted above] has now been allocated as an exclusive available only in Ireland, mostly from retailers in the local region”.¹⁰

18. I note that **exhibit MR4** contains multiple photos of the opponent’s whisky range which mirror the above photo examples contained within this decision (a purple bottle with the word WATERFORD clearly displayed at the top). In his witness statement, Mr Reynier also provides a table of Waterford whiskies which is to be used alongside **exhibit MR4**. I note that out of the opponent’s 21 whiskies, 10 were released before the relevant date (5 February 2021), which include the following:

Product	Distillation Date	Bottled Date	Release Date	No. of Bottles Produced
Waterford Bannow Island: Edition 1.1	09.06.2016	27.05.2020	01.06.2020	8616
Waterford Bannow Island: Edition 1.2	09.06.2016	08.07.2020	01.09.2020	9522

¹⁰ Exhibit MR3, page 50

Waterford Ballykilcaven: Edition 1.1	09.02.2016	03.06.2020	01.06.2020	8640
Waterford Ballykilcaven: Edition 1.2	04.02.2016	08.07.2020	01.09.2020	9078
Waterford Ballymorgan: Edition 1.1	01.06.2016	08.07.2020	01.09.2020	9576
Waterford Ballymorgan: Edition 1.2	01.06.2016	28.09.2020	01.10.2020	29424
Waterford Organic Gaia: Edition 1.1	Multiple Dates	24.08.2020	01.09.2020	17964
Waterford Ratheadon: Edition 1.2	14.05.2016	24.08.2020	01.09.2020	9810
Waterford Sheestown: Edition 1.1	17.06.2016	08.07.2020	01.09.2020	9522
Waterford Sheestown: Edition 1.2	17.06.2016	28.09.2020	01.10.2020	29400

19. I note that the above amount of bottles produced total to 141,522.

20. **Exhibit MR5** contains a list of the distributors used by the opponent to supply retailers with whisky in the UK and EU. Mr Reynier has highlighted 20 EU distributors within this exhibit, including the UK distributor ‘Speciality Brands’. Screenshots dated 20 September 2020 and 20 January 2021, clearly shows the ‘Waterford Range’ on Speciality Brand’s website, and clearly displays the purple bottle on these pages, with its WATERFORD logo.¹¹

21. The above evidence is supported by **exhibit MR7** which contains examples of the opponent’s whisky being sold by UK and EU retailers during the relevant period. The first 2 screenshots are from thewhiskyexchange.com website, dated 1 November 2020 and 4 March 2021.¹² The 70cl bottles of Waterford whisky are priced at £69.95. The next 6 screenshots are from whiskyshop.com, dated 1 November 2020, 4 March 2021, 31 October 2020 and 18 January 2021.¹³ These screenshots show that the majority of the 70cl bottles of Waterford whisky for sale were priced at £69.99, with some reduced to £59.99 or £69.99, and others being “sold out”.

¹¹ **Exhibit MR5**, page 78

¹² **Exhibit MR7**, page 111

¹³ **Exhibit MR7**, pages 112-113

22. Screenshots from houseofmalt.co.uk, dated 20 January 2021,¹⁴ also shows the opponent’s whiskies for sale. 6 of the opponent’s whisky goods are reduced from £69.95 to £59.95. The Bannow Island and Ballykilcavan 1.1 whiskies are priced at £79.99. The Micro Cuvee Lohmar whisky is priced at £89.95. The Sheestown whisky is priced at £64.95. Lastly, the Organic Gaia is reduced from £76.95 to £69.95.

23. **Exhibit MR7** also contains a screenshot from celticwhiskyshop.com, dated 15 January 2021, which shows the opponent’s Ballymorgan whisky 1.1 priced at €75, but out of stock. I note that in the description it says, “following the dramatic success and sellout of the first commercial bottlings from Waterford Whisky, we are delighted to bring you the latest release, one of four new bottlings”.¹⁵

24. Another 3 screenshots of websites selling the opponent’s whiskies are contained within **exhibit MR7**. This includes a screenshot from “whisky.fr” dated 24 October 2020 showing opponent’s whisky on sale for €79.90. The screenshots from “whisky.lu” and “auspreiser.de” show the opponent’s whisky priced from €53 to €69. However, these screenshots only have an accessed date of 20 April 2022.¹⁶

25. Screenshots, which were accessed 20 April 2022, from whiskybase.com,¹⁷ contained in **MR7**, also shows the following wide range of whiskies that the opponent has to offer, including:

2020 bottles:





















Name	Stated Age	Strength	Size	Bottled	Casknumber	Rating
 Waterford Ballykilcavan: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020		82.69
 Waterford Ballykilcavan: Edition 1.2 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020		82.91
 Waterford Ballymorgan: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020		82.92
 Waterford Ballymorgan: Edition 1.2 <i>Single Farm Origin</i>	04	50.0 % Vol.	700 ml	2020		82.49
 Waterford Bannow Island: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020		83.60

¹⁴ **Exhibit MR7**, page 114






¹⁵ **Exhibit MR7**, page 115








¹⁶ **Exhibit MR7**, pages 116-117

¹⁷ **Exhibit MR7**, pages 118-119

 Waterford Bannow Island: Edition 1.2 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	82.31
 Waterford Broomlands: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	84.80
Waterford Broomlands: Edition 1.2 <i>Single Farm Origin</i>	03	50.0 % Vol.	700 ml	2020	87.00
 Waterford Cooladine: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	88.00
 Waterford Donoughmore: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	82.75
 Waterford Dunbell: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	750 ml	2020	83.88
 Waterford Bannow Island: Edition 1.2 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	82.31
 Waterford Broomlands: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	84.80
Waterford Broomlands: Edition 1.2 <i>Single Farm Origin</i>	03	50.0 % Vol.	700 ml	2020	87.00
 Waterford Cooladine: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	88.00
 Waterford Donoughmore: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	82.75
 Waterford Dunbell: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	750 ml	2020	83.88
 Waterford Dunmore: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	750 ml	2020	83.75
 Waterford Gaia: Edition 1.1 <i>The Arcadian Series</i>		50.0 % Vol.	700 ml	2020	83.83
 Waterford Gaia: Edition 1.2 <i>The Arcadian Series</i>		50.0 % Vol.	700 ml	2020	85.10
 Waterford Lómhar <i>Micro Cuvée</i>		50.0 % Vol.	700 ml	2020	89.94
 Waterford Pilgrimage <i>1st Cuvée</i>		50.0 % Vol.	700 ml	2020	87.64
 Waterford Rathclogh: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	750 ml	2020	82.25
 Waterford Ratheadon: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	85.68
 Waterford Ratheadon: Edition 1.2 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	87.18
 Waterford Sheestown: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2020	83.78
 Waterford Sheestown: Edition 1.2 <i>Single Farm Origin</i>	04	50.0 % Vol.	700 ml	2020	82.79

2021 bottles:

Name	Stated Age	Strength	Size	Bottled	Casknumber	Rating
 Waterford Ballyroe: Edition 1.1 <i>Single Farm Origin</i>	04	50.0 % Vol.	700 ml	2021		84.80
 Waterford Blood Brothers <i>Micro Cuvée</i>		50.0 % Vol.	700 ml	2021		85.22
 Waterford Gaia: Edition 2.1 <i>The Arcadian Series</i>		50.0 % Vol.	700 ml	2021		85.80
 Waterford Grattansbrook: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2021		85.18
 Waterford Hearth <i>Micro Cuvée</i>		50.0 % Vol.	700 ml	2021		89.63
 Waterford Hook Head: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2021		83.60

 Waterford Knockroe: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2021	85.50
 Waterford Lacken: Edition 1.1 <i>Single Farm Origin</i>	03	50.0 % Vol.	700 ml	2021	86.30
 Waterford Lakefield: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2021	84.26
 Waterford Luna 1.1 <i>Biodynamic The Arcadian Series</i>	03	50.0 % Vol.	700 ml	2021	85.40
 Waterford Micro Cuvée : <i>Pique-Nique Trade Sample - Not For Sale</i>	03	50.0 % Vol.	150 ml	2021	
 Waterford Micro Cuvée: <i>Hearth Trade Sample - Not For Sale</i>		50.0 % Vol.	150 ml	2021	
 Waterford Mortarstown: Edition 1.1 <i>Single Farm Origin</i>		50.0 % Vol.	700 ml	2021	85.56

26. Mr Reynier has also provided a small sample of invoices showing the sales of the opponent's whisky in the UK and EU.¹⁸ It contains the following invoices that fall before the relevant date:

Date	Location	Goods	Quantity
12/06/2020	Belgium	Bannow Island Whisky Ballykilvcavan Whisky	65 cases of each
06/06/2020	France	Bannow Island Whisky Ballykilvcavan Whisky	120 cases of each
12/06/2020	Germany	Bannow Island Whisky Ballykilvcavan Whisky	240 cases of each
26/08/2020	Holland	Bannow Island Whisky Ballykilvcavan Whisky Sheestown Whisky Ballymorgan Whisky	132 cases of Bannow 68 cases of Ballykilvcavan 100 of Sheestown 101 cases of Ballymorgan
12/10/2020	Hungary	Arcadian Organic Whisky Ballymorgan Whisky Sheestown Whisky	22 cases of Arcadian 23 cases of Ballymorgan and Sheestown
11/06/2020	London	Bannow Island Whisky Ballykilvcavan Whisky	170 cases of each
23/06/2020	London	Bannow Island Whisky Ballykilvcavan Whisky	80 cases of each
21/08/2020	London	Bannow Island Whisky Ballykilvcavan Whisky Sheestown Whisky Ballymorgan Whisky	250 cases of each
09/10/2020	London	Arcadian Organic Whisky	250 cases
18/11/2020	London	Arcadian Organic Whisky Lomhar Ballymorgan Whisky	250 cases of Arcadian, Ballymorgan and sheestown

¹⁸ Exhibit MR6

		Sheestown Whisky	28 cases of Lomhar
11/06/2020	Cork	Bannow Island Whisky Ballykilvcavan Whisky	136 cases of each
12/06/2020	Italy	Bannow Island Whisky Ballykilvcavan Whisky	84 cases of each
03/09/2020	Poland	Bannow Island Whisky Ballykilvcavan Whisky Sheestown Whisky Ballymorgan Whisky	15 cases of each
15/11/2020	Spain	Sheestown Whisky Ballymorgan Whisky Arcadian Organic Whisky	25 cases of Sheestown and Ballymorgan 18 cases of Arcadian
11/06/2020	London	Bannow Island Whisky Ballykilvcavan Whisky	170 cases of each
19/10/2020	Bulgaria	Arcadian Organic Whisky Ballymorgan Whisky Sheestown Whisky	20 cases of Arcadian 24 cases of Ballymorgan and Sheestown

27. Firstly, I note that the total on the above invoices has not been provided. However, Mr Reynier clarifies that each case contains six 70cl bottles. Furthermore, at the top of every invoice, it shows the following mark:



28. To support the exhibit, Mr Reynier provides the following approximate net sales value of cases sold by the opponent in the EU and UK in 2020 and 2021:

Year	EU	UK
2020	>€1,250,000	>€350,000
2021	>€1,500,000	>€150,000

29. Mr Reynier also provides the following approximate marketing and advertising figures:

Year Amount

2020 >€500,000

2021 >€750,000

30. To support the figures above, Mr Reynier has provided a selection of press articles and reviews of the opponent and its whisky in **exhibit MR8**. I note that many of the screenshots provided haven't added to the context above, nor do many of the articles have actual 'reviews' of the whisky. Furthermore, some of the screenshots are blurry and I am unable to read any of the information within them. Therefore, I only note the following articles and extracts which provide context or actually review the goods:

- Two screenshots from whiskyfun.com.¹⁹ One which describes the Waterford Ballymorgan 1.2 as "superb", and the other which describes the Waterford Gaia as "very good", dated 5 January and 12 January 2021.
- An article called "Wine with Leslie: Burgundy bargains and wines that show off their regional terroir" from the Irish Examiner.²⁰ This article provides clarity on the terroir process in regard to wines, it says it's all about the grapes grown, the soil structure, the elevations, shelter and the micro-climate of the wine region plays a role. "Terroir also includes the people and how they farm the land and it also has local traditions". It mentions the opponent's line of whiskies and how they "have found a way to coax as much flavour from the barley they use as possible, through temperature-controlled slow malting and slower distillations, and you really can notice the difference". I note that I have only been provided with an accessed date of 20 April 2022 for this article.
- A review of the Waterford Organic Gaia dated 11 November 2020, on thewhiskyjack.com blog.²¹ I note that this whisky was harvested in 2015 and

¹⁹ **Exhibit MR8**, pages 126-127

²⁰ **Exhibit MR8**, page 129

²¹ **Exhibit MR8**, page 130

bottled in 2020. The blog notes that they love the whisky and that “within seconds you know this is for consuming, for enjoying- don’t hold back on your guests! Fill their glasses! Raise the roof!”.

- A review of the Waterford Organic Gaia dated 19 October 2020, on bexsonn.com.²² It states that the opponent “have the finest quality raw materials; the purest of spring water from renowned ancient wells; a team of passionate distillers that share the vision; and arguably the very best barley in the world”.
- A review of the Waterford Organic Gaia dated 5 October 2020 on wordsofwhisky.com.²³ It states that in the first year of farming, 2015, the opponent “recruited six farmers to produce Irish-grown organic barley. While the yield is lower than regular malted barley, Waterford still manages to lay down 400 to 600 casks of organic spirit a year”.
- An article called “New Waterford Distillery whisky coming to UK” from whiskymag.com.²⁴ This states that “following the launch of Waterford Organic Gaia 1.1 in 2020, Speciality Brands is launching Grattansbrook 1.1, a single farm origin whisky, as a UK exclusive”. “It will be the first in a series of single farm origin whiskies from Waterford exploring Irish terroir, including how varieties of barley, areas of cultivation, microclimates and other growing conditions affect a whisky’s flavour”. The Managing director of Speciality Brands said that “Waterford launched to great acclaim last year as the quality of the spirit and its modern, disruptive approach have both resonated with British whisky enthusiasts”.
- An article called “Ireland’s Waterford Finds Quick Whisky Success So Adds More Releases” dated 28 July 2020, on thewhiskywash.com.²⁵ This article states that the opponent has already seen success “with initial releases from a few months back selling out quickly”.

²² Exhibit MR8, page 132

²³ Exhibit MR8, page 134

²⁴ Exhibit MR8, page 138

²⁵ Exhibit MR8, page 141

- The last 4 pages of this exhibit are screenshots from google which lists reviews of the opponent’s goods, including references to the flavours and taste. These are dated from May 2020 to 8 February 2021.²⁶

31. **Exhibit MR9** also contains screenshots from 16 websites showing the interviews which have been conducted to promote the opponent, its whisky and “awareness of terroir in whisky”. All of the interviews are with Mr Reynier, and have been conducted as early as 11 December 2014. I note that the screenshots provided do not show particular detail of the interviews, with the majority of the screenshots just showing the website name and the article/interview title.

32. However, I note the following which explores the idea of terroir in more detail:

- The interview with Mark Reynier dated 25 January 2016 on malt-review.com highlights that terroir in whisky is “how the landscape and barley affects the spirit”.²⁷
- The article called “The Search For Whisky Terroir: A Round Table Discussion” on Forbes dated 2 February 2020. It states that “in recent years, the idea of “whisky terroir” the notion that a whisky should be uniquely expressive of the time, place and ingredients from which it was fashioned, has become increasingly popular”.²⁸

33. I note that the opponent submits that both exhibits **MR8** and **MR9** “are in English and are mainly targeted at English-speaking consumers in the UK and EU”.

34. The opponent also has multiple social media accounts, as demonstrated in **exhibit MR10**. I note that its Facebook page, “Waterford Distillery”, has over 47,000 followers on 20 April 2022. I note that a variety of posts are provided within the evidence, however, I will focus on the most pertinent examples:

²⁶ **Exhibit MR8**, pages 146-149

²⁷ **Exhibit MR9**, page 153

²⁸ **Exhibit MR9**, page 159

- A post which is dated 23 September 2021 shows the promotion of its whisky made from “biodynamic barley” which has gained as many as 3,000 likes.²⁹
- A post which is dated 2 November 2020 shows that they had produced 1,100 bottles of the “Lomhar” whisky which “will be appearing in handful of retailers in Ireland, France, UK & Germany from mid-November”.³⁰
- A post which is dated 20 October 2020 shows that a consumer had asked how many bottles of the Organic Gaia 1.1 was produced, to which the opponent replied 24,000. On a post which is dated 9 October 2020, it makes it clear that the Organic Gaia 1.1 is also to be “available worldwide from October 12 onwards”.³¹
- A post which is dated 20 July 2020 highlights that the “new Single Farm Origins will now be in the market mid-August”, with “new bottles of Waterford whisky on sale from 23 July in Ireland”.³²
- A post which is dated 12 June 2020 states that “1,400 bottles of SFO Ratheadon Edition: 1.1 will now be released alongside the other two Single Farm Origins – but available only in Ireland”.³³

35. The opponent also has its “Waterford Distillery” twitter page which has 5,993 followers on 20 April 2022. Its “waterforddistillery” Instagram page has 11.9k followers and 587 posts. Its YouTube page has 811 subscribers and has videos which date back to 5 years ago. Finally, its LinkedIn page has 2,203 followers, and its bio states that it is the “world’s biggest producers of organic & biodynamic whisky”.

36. Lastly, **exhibit MR11** contains the awards won by the opponent, which includes the following:

- Distiller of the year and Brand Innovator of the year 2021 from Whisky Magazine’s 2021 Icons of Whisky Ireland.

²⁹ **Exhibit MR10**, page 163

³⁰ **Exhibit MR10**, page 168

³¹ **Exhibit MR10**, page 169

³² **Exhibit MR10**, page 176

³³ **Exhibit MR10**, page 179

- Retail Award Winner for the National Organic Awards 2020, for its Organic Gaia 1.1.
- Shortlisted for the UK Packaging Awards 2020.
- Gold Irish Whisky and Barrel Consumer Choice 2020 for its Single Farm Origin Irish Single Malt.

Proof of use

37. 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 ... or international trade mark (UK) ... 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,

(aa) a comparable trade mark (EU) or a trade mark registered pursuant to an application made under paragraph 25 of Schedule 2A which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

(ab) a comparable trade mark (IR) or a trade mark registered pursuant to an application made under paragraph 28, 29 or 33 of Schedule 2B which has a valid claim to seniority of an earlier registered trade mark or protected international trade mark (UK) even where the earlier trade mark has been surrendered or its registration has expired;

[...]

38. Section 6A of the Act states:

“(1) This section applies where

- (a) an application for registration of a trade mark has been published,
- (b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and
- (c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

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

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

(3) The use conditions are met if –

- (a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or
- (b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes –

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

not the trade mark in the variant form is also registered in the name of the proprietor), and

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

(5)-(5A) [Repealed]

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

39. As the earlier mark is a comparable mark, paragraph 7 of Part 1, Schedule 2A of the Act is also relevant. It reads:

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

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

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

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

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

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

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

40. The opponent’s marks qualify as earlier marks in accordance with section 6(1)(a) and 6(1)(ab) as their filing dates are earlier dates than the filing date of the applicant’s mark.

41. As the First Earlier Mark has completed its registration process more than five years before the priority date of the mark in issue, it is subject to proof of use pursuant to section 6A of the Act.

42. As the Second Earlier mark had not completed its registration process more than five years before the relevant date, the use provisions at section 6A of the Act do not apply. The opponent may rely on all of the goods it has identified without demonstrating that it has used its mark.

43. I must assess whether, and to what extent, the above evidence supports the opponent’s statement that it has made genuine use of its First Earlier Mark in relation to the goods for which it is registered. The relevant period for this purpose is the five years ending on the filing date of the applicant’s mark, i.e. 6 February 2016 to 5 February 2021.

44. The relevant provisions about proof of use in opposition proceedings are contained in section 6A of the Act, which I have highlighted above. Section 100 of the Act is also relevant, which reads:

“100. If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

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

“114.....The CJEU has considered what amounts to “genuine use” of a trade mark in a series of cases: Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, *La Mer* (cited above), Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bundervsvereinigung Kamaradschaft ‘Feldmarschall Radetsky’* [2008] ECR I9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], [2013] ETMR 16, Case C-609/11 P *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], [2014] ETMR, Case C-141/13 P *Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089] and Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434], [2017] Bus LR 1795.

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

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

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

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

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

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

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

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

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use

of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus there is no de minimis rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72] and [76]-[77]; *Leno* at [55].

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

Form of the mark/how the marks are used

46. In *Colloseum Holdings AG v Levi Strauss & Co.*, Case C-12/12, which concerned the use of one mark with, or as part of, another mark, the Court of Justice of the European Union (“CJEU”) found that (my emphasis):

“31. It is true that the ‘use’ through which a sign acquires a distinctive character under Article 7(3) of Regulation No 40/94 relates to the period before its registration as a trade mark, whereas ‘genuine use’, within the meaning of Article 15(1) of that regulation, relates to a five-year period following registration and, accordingly, ‘use’ within the meaning of Article 7(3) for the purpose of registration may not be relied on as such to establish ‘use’ within the meaning of Article 15(1) for the purpose of preserving the rights of the proprietor of the registered trade mark.

32. Nevertheless, as is apparent from paragraphs 27 to 30 of the judgment in *Nestle*, the ‘use’ of a mark, in its literal sense, generally encompasses both its independent use and its use as part of another mark taken as a whole or in conjunction with that other mark.

33. As the German and United Kingdom Governments pointed out at the hearing before the Court, the criterion of use, which continues to be fundamental, cannot be assessed in the light of different considerations according to whether the issue to be decided is whether use is capable of giving rise to rights relating to a mark or of ensuring that such rights are preserved. If

it is possible to acquire trade mark protection for a sign through a specific use made of the sign, that same form of use must also be capable of ensuring that such protection is preserved.

34. Therefore, the requirements that apply to verification of the genuine use of a mark, within the meaning of Article 15(1) of Regulation No 40/94, are analogous to those concerning the acquisition of a sign of distinctive character through use for the purpose of its registration, within the meaning of Article 7(3) of the regulation.

35. Nevertheless, as pointed out by the German Government, the United Kingdom Government and the European Commission, a registered trade mark that is used only as part of a composite mark or in conjunction with another mark must continue to be perceived as indicative of the origin of the product at issue for that use to be covered by the term 'genuine use' within the meaning of Article 15(1)". (emphasis added)

47. In *Lactalis McLelland Limited v Arla Foods AMBA*, BL O/265/22, Phillip Johnson, sitting as the Appointed Person, considered the correct approach to the test under s. 46(2). He said:

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

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

15. First, when comparing the alterations between the mark as registered and used it is clear that the alteration or omission of a non-distinctive element does not alter the distinctive character of the mark as a whole: T-146/15 *Hypen v*

EU IPO, EU:T:2016:469, [30]. Secondly, where a mark contains words and a figurative element the word element will usually be more distinctive: T-171/17 *M & K v EU IPO*, EU:T:2018:683, [41]. This suggests that changes in figurative elements are usually less likely to change the distinctive character than those related to the word elements.

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

17. It is also worth highlighting the recent case of T-615/20 *Mood Media v EU IPO*, EU:T:2022:109 where the General Court was considering whether the use of various marks amounted to the use of the registered mark MOOD MEDIA. It took the view that the omission of the word “MEDIA” would affect the distinctive character of the mark (see [61 and 62]) because MOOD and MEDIA were in combination weakly distinctive, and the word MOOD alone was less distinctive still”.

48. Where the opponent’s First Earlier Mark has been used as registered this will, clearly, be use upon which the opponent can rely.

49. As highlighted above, I note that the mark has been used in the following variants:

1)



2)



50. The distinctive character of the First Earlier Mark lies in the word WATERFORD. I note that this word is present in both variant 1 and 2 above.

51. However, variant 1 presents the word WATERFORD in a white typeface against a purple background. I do not consider that these stylistic differences alter the distinctive character, and therefore I consider that variant 1 is acceptable use of the mark.

52. Variant 2 is found on all the bottles and invoices of the opponent's goods. Variant 2 presents the word WATERFORD in a slightly stylised purple typeface, with the wording "IRISH SINGLE MALT WHISKY" presented underneath in a capitalised grey typeface. Again, I do not consider that the stylistic differences alter the distinctive character of the mark. Furthermore, and as highlighted above, at paragraph 16 in *Lactalis McLelland Limited*, the addition of descriptive or suggestive words is unlikely to change the distinctive character of the mark. Consequently, I do not consider that the additional text "IRISH SINGLE MALT WHISKY" alters the distinctive character because it is wholly descriptive of the opponent's goods. Therefore, variant 2 is also acceptable use of the mark.

Conclusions from the evidence on genuine use

53. An assessment of genuine use is a global assessment, which includes looking at the evidential picture as a whole, not whether each individual piece of evidence shows use by itself.³⁴

³⁴ *New Yorker SHK Jeans GmbH & Co KG v OHIM*, T-415/09

54. As indicated in the case law cited above, use does not need to be quantitatively significant in order to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.

55. As the opponent’s First Earlier Mark is a comparable mark, the relevant territory for the period before IP Completion Day (31 December 2022) is the EU, and for the remainder of the period is the UK.

56. The opponent clearly founded its distillery in 2014, with it officially opening and producing its whisky in 2015, with the earliest of its whiskies being sold in 2020. In the opponent’s submissions, it states that there is a regulation which provides that whisky must be manufactured for at least three years in wooden casks before it can be sold as ‘whisky’. This correlates with my own personal knowledge that whisky is distilled and then has to be aged for a period of time before it can be distributed and sold. Consequently, the opponent can only show sales from 2020 onwards. I note that the opponent has provided approximate sales figures for the UK. These amounted to over €350,000 in 2020 and over €150,000 in 2021. However, I note that some of the sales for 2021 will fall after the relevant date. Although I have not been provided with any market share figures, I consider that the figures provided seem notable for what is likely to be a significant market within the UK. I also note that the overall advertising figures spent for the years 2020 to 2021 amount to €1,250,000. However, it isn’t broken down into specific EU or UK territories. Furthermore, the only evidence of marketing activity shown by the opponent is in the form of social media posts and YouTube videos, as well as multiple third party publications which mention the opponent’s whiskies and uses the opponent’s mark. However, I note that a proportion of the third party publication screenshots are cropped and therefore doesn’t detail the full articles. I also note that the opponent has won 4 awards all in relation to its whisky. Therefore, taking all of the above into account, I am satisfied that the opponent has demonstrated genuine use of its First Earlier Mark, with use of variant 1 and 2, in the UK, during the relevant period.

Fair Specification

57. I must now consider whether, or the extent to which, the evidence shows use of the services relied upon. In *Euro Gida Sanayi Ve Ticaret Limited v Gima (UK) Limited*, BL O/345/10, Mr Geoffrey Hobbs Q.C. as the Appointed Person summed up the law as being:

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

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

“iii) Where the trade mark proprietor has made genuine use of the mark in respect of some goods or services covered by the general wording of the specification, and not others, it is necessary for the court to arrive at a fair specification in the circumstance, which may require amendment; *Thomas Pink Ltd v Victoria’s Secret UK Ltd* [2014] EWHC 2631 (Ch) (“Thomas Pink”) at [52].

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

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

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

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

59. The goods for which the First Earlier Mark is registered and upon which the opponent relies is spirits in class 33. However, it is clear from all of the opponent's evidence that the only goods they produce, and sell, is whisky. Albeit whisky is a type of spirit, I consider that the First Earlier Marks specification is too wide because it covers a whole range of spirits other than whisky such as vodka, gin and rum, which the opponent does not produce. Consequently, I consider a fair specification for the First Earlier Mark to be:

Class 33 Whisky.

Section 5(2)(b)

60. Section 5(2)(b) reads as follows:

"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.”

61. In making this decision, I bear in mind the following principles gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P:

- (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

62. The competing goods are as follows:

Opponent's goods	Applicant's goods
<p>The First Earlier Mark</p> <p><u>Class 33</u> Whisky.</p> <p>The Second Earlier Mark</p> <p><u>Class 33</u> Spirits.</p>	<p><u>Class 33</u> Alcoholic beverages, except beer; whiskey; gin; alcoholic preparations for making beverages.</p>

63. When making the comparison, all relevant factors relating to the goods and services in the specifications should be taken into account. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 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.”

64. Guidance on this issue has come from Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, where he identified the factors for assessing similarity as:

- (a) The respective uses of the respective goods or services;
- (b) The respective users of the respective goods or services;
- (c) The physical nature of the goods or acts of service;
- (d) The respective trade channels through which the goods or services reach the market;

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

65. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T- 133/05, the General Court (“GC”) stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 *Institut 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.”

66. 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.”

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

The First Earlier Mark

68. I consider that “whisky” in the First Earlier Mark is clearly self-evidently identical to “whiskey” in the applicant’s specification.

69. I consider that the opponent’s “whisky” falls within the applicant’s broader category of “alcoholic beverages, except beer”. I consider them identical on the principle outlined in *Meric*.

70. I consider that the opponent’s “whisky” is highly similar to the applicant’s “gin”. While both goods are produced using different raw ingredients, they both are made using a distilling process, and they are both considered as different types of spirits, which are strong alcoholic drinks. Therefore, they overlap in nature. The goods can be consumed neat, as a short drink, or combined with a soft drink (such as tonic water or soda) or other types of mixers (as ingredients in cocktails), meaning that they will overlap in method of use. The goods are commonly consumed for pleasure whilst socialising, or with the intention to become intoxicated, and as a result, overlap in purpose. The goods also overlap in user, being consumed by adults over the age of 18. Taking the above into account, I also consider that the goods are likely to be in competition and they will also overlap in distribution channels as they are likely to be sold by the same retailers, being displayed in the same aisle/on the same shelves in

close proximity. Furthermore, the goods are likely to be displayed near each other behind a bar. Taking all of the above into account, I consider that the goods are similar to a high degree.

71. I consider that “alcoholic preparations for making beverages” in the applicant’s specification are alcoholic substances, but would not include an alcoholic beverage or spirit. For example, I consider that these goods would include bitters and alcoholic essences. I therefore consider that these goods will overlap with the opponent’s “whisky”. I consider that all of the goods are alcoholic and are to be consumed, meaning they overlap in nature and purpose. However, I note that the applicant’s goods have to be mixed with other alcoholic and non-alcoholic drinks, in very small quantities, whereas the opponent’s goods can be consumed either neat or mixed. Therefore, to some extent they overlap in method of use. The goods are commonly consumed for pleasure whilst socialising, or with the intention to become intoxicated, and as a result, overlap in purpose. The goods also overlap in user, being consumed by adults over the age of 18. I do not consider that the goods would be in competition, nor complementary. However, I consider that the goods may be sold in the same aisle/on the same shelves in close proximity in a retail establishment. Therefore, I consider that the goods are similar to between a medium and high degree.

The Second Earlier Mark

72. I consider that the opponent’s “spirits” falls within the applicant’s broader category of “alcoholic beverages, except beer”. I consider them identical on the principle outlined in *Meric*.

73. I consider that the applicant’s “whisky” and “gin” falls within the opponent’s broader category of “spirits”. I consider them identical on the principle outlined in *Meric*.

74. I consider that “alcoholic preparations for making beverages” in the applicant’s specification overlaps with the opponent’s “spirits”. I consider that the same comparison applies in paragraph 71 above. Therefore, the goods are similar to between a medium and high degree.

The average consumer and the nature of the purchasing act

75. As the case law above indicates, it is necessary for me to determine who the average consumer is for the respective parties' goods. I must then determine the manner in which the goods are likely to be selected by the average consumer. 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 (as he then was) 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 word “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

76. The average consumer of the goods will be adult members of the general public over the age of 18. The cost of the goods in question is likely to vary, however, on balance it is likely to be relatively low. The majority of the goods will be purchased relatively frequently. The average consumer will take various factors into consideration such as the origin and age of the goods, the cost, flavour, ingredients and alcohol percentage. Taking all of this into consideration, I consider it likely that a medium degree of attention will be paid during the purchasing process.

77. Spirits and alcoholic beverages are likely to be purchased by self-selection from the shelves of a range of retail outlets such as supermarkets and off-licences, and their online equivalents. Such goods are also sold in public houses, bars, and restaurants where they will be publicly displayed behind the counter or on a drinks menu. A similar process will apply to websites, where the consumer will select the goods having viewed an image displayed on a webpage. Visual considerations are, therefore, likely to dominate the selection process. However, I do not discount that there will also be an aural component to the purchase given that the goods could be

verbally ordered at a bar, or if stocked behind a counter, the average consumer must ask the sales assistant for them.

78. Alcoholic preparations for making beverages, which as established above, would include bitters and alcoholic essences, are normally used when making cocktails/alcoholic beverages. I consider that they would be purchased by self-selection from the shelves of a range of retail outlets such as supermarkets and off-licences and their online equivalents. Such goods are also sold in bars and restaurants, where they will be publicly displayed at the bar or written on a cocktail menu, most likely listed in the ingredients list for the cocktail. Visual considerations are, therefore, likely to dominate the selection process. I consider it highly unlikely that there will be an aural component to the purchase given that the goods are not consumed neat, they are only really used to make alcoholic beverages. Therefore, only the cocktail/beverage name will be verbally ordered. However, I do not discount that the consumer may request that a certain alcoholic preparation be used whilst making their drink order.

Comparison of the trade marks

79. It is clear from *Sabel BV 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. 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.”

80. 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.

81. The respective trade marks are shown below:

Opponent's trade mark	Applicant's trade mark
<p style="text-align: center;">WATERFORD ("The First Earlier Mark")</p> <p style="text-align: center;">WATERFORD TEIREOIR ("The Second Earlier Mark")</p>	<p style="text-align: center;">LADY LOUISA WATERFORD</p>

Overall Impression

82. The First Earlier Mark consists of the word WATERFORD. There are no other elements to contribute to the overall impression which lies in the word itself.

83. The Second Earlier Mark consists of the words WATERFORD TEIREOIR. The word WATERFORD will be recognised as the geographical location in Ireland. The word TEIREOIR would be recognised as an invented word with no meaning. Therefore, the combination of these words do not qualify each other to create its own unitary meaning. The words remain as separate components. Therefore the two words play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element of the mark (an invented word with no conceptual meaning).

Consequently, I consider that the word TEIREOIR plays a greater role in the overall impression of the mark, with the word WATERFORD playing a lesser role.

84. The applicant's mark consists of the words LADY LOUISA WATERFORD. I consider that these three words, together, will be recognised as a title, first name and surname. I consider that as a general rule, surnames are more distinctive than forenames and that the surname WATERFORD appears to be slightly more unusual than the forename LOUISA. However, it is also true that the consumer tends to pay more attention to the beginning of marks. Therefore, I consider that the overall impression of the mark lies in the combination of these elements.

Visual Considerations

The First Earlier Mark and the applicant's mark

85. Visually, the marks coincide in the presence of the word WATERFORD. However, the applicant's mark begins with the words LADY and LOUISA. As highlighted above, the consumer tends to pay more attention to the beginning of marks. Consequently, I consider that the marks are visually similar to no more than a medium degree.

The Second Earlier Mark and the applicant's mark

86. The same considerations apply as above in paragraph 85; however, in addition, the Second Earlier Mark ends in the word TEIREOIR. Therefore, I consider that the marks are visually similar to between a low and medium degree.

Aural Considerations

The First Earlier Mark and the applicant's mark

87. Aurally, the First Earlier Mark will be pronounced as WAR-TER-FORD. The applicant's mark will be pronounced as LAY-DEE LOO-EE-SAH WAR-TER-FORD. Consequently, the beginnings of the marks differ aurally. However, as the marks

overlap in the pronunciation of WATERFORD, I consider that they are aurally similar to no more than a medium degree.

The Second Earlier Mark and the applicant's mark

88. The applicant's mark and the first word in the Second Earlier Mark will be pronounced as indicated above in paragraph 87; however, the Second Earlier Mark ends in the word TEIREOIR. I consider that this may be pronounced as either TEAR-EE-OR or TIER-EE-OR by the average consumer. Consequently, I consider that the marks are aurally similar to between a low and medium degree.

Conceptual Considerations

The First Earlier Mark and the applicant's mark

89. The applicant submits that the opponent's mark "will be perceived as being the name of the county in Ireland with geographical significance as to the origin". I agree that the average consumer would recognise the First Earlier Mark as a geographical location. The applicant further submits that their mark will be perceived as "the name of a titled person from that county". However, I disagree. I consider that if this concept was to be assigned to the mark, it would be presented as LADY LOUISA **OF** WATERFORD. The 'OF' would be an indication that LADY LOUISA is from WATERFORD. Therefore, I consider that, as highlighted above, the applicant's mark will be recognised as the title LADY, with the first name LOUISA and surname WATERFORD.

90. I refer to the case of *Luciano Sandrone v EUIPO* T-268/18 wherein the GC stated that:

"85. [...] a first name or a surname which does not convey a 'general and abstract idea' and which is devoid of semantic content, is lacking any 'concept', so that a conceptual comparison between two signs consisting solely of such first names or surnames is not possible.

86. Conversely, a conceptual comparison remains possible where the first name or surname in question has become the symbol of a concept, due, for example, to the celebrity of the person carrying that first name or surname, or where that first name or that surname has a clear and immediately recognisable semantic content.

87. The Court has thus previously held that the relevant public would perceive marks containing surnames or first names of persons as having no specific conceptual meaning, unless the first name or surname is particularly well known as the name of a famous person (see, to that effect, judgments of 18 May 2011, *IIC v OHIM—McKenzie (McKENZIE)*, T502/07, not published, EU:T:2011:223, paragraph 40; of 8 May 2014, *Pedro Group v OHIM—Cortefiel (PEDRO)*, T38/13, not published, EU:T:2014:241, paragraphs 71 to 73; and of 11 July 2018, *ANTONIO RUBINI, T707/16*, not published, EU:T:2018:424, paragraph 65).”

91. With the above case law in mind, the applicant’s mark will be considered as a name which will hold no specific concept. However, as the First Earlier Mark assigns a geographical meaning to the word WATERFORD, I consider that the marks are, therefore, conceptually dissimilar.

The Second Earlier Mark and the applicant’s mark

92. The word WATERFORD is followed by the word TEIREOIR in the Second Earlier Mark. Neither party made submissions on the meaning of TEIREOIR, but throughout the opponent’s evidence, reference is made to “terroir” which is a term normally used in regard to wine, referring to the qualities of the wine derived from the soil structure, the elevations, shelter, the micro-climate of the wine region, the people and how they farm the land.³⁵

93. However, the spelling of TERROIR differs to TEIREOIR. Therefore, I do not consider that the average consumer would make a conceptual connection between

³⁵ Exhibit 8, page 129

the two words, especially as it is being used in regard to whisky and spirits, to which the process of terroir is not normally applied. Consequently, I consider that a significant proportion of UK average consumers would not recognise the word TEIREOIR, and would read it as an invented word with no meaning.

94. I consider that the word WATERFORD would still be recognised as the geographical location within Ireland. Therefore, as the overall meaning of the Second Earlier Mark, a geographical location and an invented word, differs to the meaning of the applicant's mark, which is a name which holds no specific concept, I consider that the marks are conceptually dissimilar.

Distinctive character of the earlier trade mark

95. 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 C108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-2779, 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 promotion of 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).”

96. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctiveness of a mark can be enhanced by virtue of the use that has been made of it.

97. I will begin by assessing the inherent distinctive character of the First and Second Earlier Marks.

98. As highlighted above, the First Earlier Mark is the word WATERFORD, registered for whisky. WATERFORD is geographical location in Ireland, and Ireland is a location known for its production of whisky.

99. I bear in mind that in the recent appeal decision by Amanda Michaels, sitting as the Appointed person, in *Cambridge NeuroTech v The University of Cambridge*, Case BL-O/003/20, it was highlighted that when assessing the distinctiveness of a mark, which consists of a geographical location it “must be assessed in the same way as any other kind of mark, and so must include consideration of the distinctiveness of the mark for the goods and services in the specification”.

100. In this instance, I consider that the geographical location WATERFORD is more distinctly known for its “Waterford Crystal”. I consider that this is supported by the opponent’s evidence whereby Waterford is described as a harbour town “best known for the iconic *Waterford Crystal* glass makers whose origins date back to 1783, although like many whisky distilleries in Ireland, they’ve had a few sabbaticals since then”.³⁶

101. Albeit Ireland is known for its whisky production, I do not have any evidence before me to suggest that WATERFORD is specifically known for the production of

³⁶ Exhibit MR9, page 161

whisky, or any other alcoholic beverages. Therefore, the opponent's First Earlier Mark may consist of a geographical location, but it is not one which is known for the production of whisky goods, for which the First Earlier Mark is registered. Consequently, I consider that the First Earlier Mark is inherently distinctive to a medium degree.

102. The Second Earlier Mark is composed of the words WATERFORD TEIREOIR, with the word WATERFORD denoting the geographical location not known for the production of the opponent's goods, and the word TEIREOIR being recognised as an invented word with no meaning. As highlighted above, I consider that the two words play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element within the mark. Therefore, taking the mark as a whole into account, I consider that it is inherently distinctive to a high degree.

103. I note that the opponent has not pleaded that its marks have acquired enhanced distinctiveness. However, for the sake of completeness, I will make a finding as to whether I consider the evidence sufficient to demonstrate enhanced distinctiveness. The relevant market for assessing this is the UK market.

104. The opponent has provided sales figures to enable me to assess the extent of use that has been made of the earlier marks. The approximate UK sales figures amounted to over €350,000 in 2020 and over €150,000 in 2021, making a total of €500,000. However, as highlighted by the above evidence, the earliest that the opponent's whisky was available to buy was around June 2020. Therefore, I consider that these figures seem notable for around one and a half year of sales, and for what is likely to be a significant market within the UK. However, I note that some of the sales for 2021 will fall after the relevant date. From 2020, the opponent has also won 4 awards in relation to its whisky, and has provided evidence showing that the opponent has advertised its mark in third party publication articles. However, I haven't been provided any evidence of UK readership for these publications and therefore I am unable to determine how many people in the UK read these articles regarding the opponent and its whisky. Furthermore, I note that although the opponent has a distributor in the UK, called Specialty Brands, the invoice evidence only shows the goods being sent to its London location. Consequently, I do not consider that there is

evidence of geographical spread of the mark within the UK. Albeit the opponent provides advertising figures spent for the years 2020 to 2021 which amount to €1,250,000, it isn't broken down into specific territories and therefore I do not know which proportion is attributed to the UK. Therefore, taking all of the above into account, I do not consider that the evidence is sufficient to establish enhanced distinctiveness.

Likelihood of confusion

105. 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 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. 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.

106. The following factors must be considered to determine if a likelihood of confusion can be established:

- The opponent's First Earlier Mark consists of the word WATERFORD. There are no other elements to contribute to the overall impression which lies in the word itself.
- The opponent's Second Earlier Mark consists of the word WATERFORD TEIREOIR. I consider that the two words play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element

within the mark, and therefore, playing a greater role in the overall impression, with the word WATERFORD paying a lesser role.

- The applicant's mark consists of the words LADY LOUISA WATERFORD. I consider that the overall impression of the mark lies in the combination of these elements.
- I have found the First Earlier Mark and the applicant's mark to be visually and aurally similar to no more than a medium degree.
- I have found the Second Earlier Mark and the applicant's mark to be visually and aurally similar to between a low and medium degree.
- I have found all of the marks to be conceptually dissimilar.
- I have found the opponent's First Earlier Mark to be inherently distinctive to a medium degree.
- I have found the opponent's Second Earlier Mark to be inherently distinctive to a high degree.
- I have identified the average consumer as adult members of the general public, who will select the goods primarily by visual means, although I do not discount an aural component.
- I have concluded that a medium degree of attention will be paid during the purchasing process for the goods.
- I have found the parties' goods to be identical to similar to between a medium and high degree.

The First Earlier Mark

107. Taking all of the factors listed in paragraph 106 into account, particularly the visual, aural and conceptual differences between the marks, I am satisfied that the marks are unlikely to be mistakenly misremembered as each other.

108. I note that the only common element between the marks is the presence of the word WATERFORD. However, this word has completely different meanings within each mark. The word WATERFORD in the opponent's mark will be recognised as the geographical location within Ireland. The word WATERFORD in the applicant's mark

is presented after the words LADY and LOUISA, meaning it will be recognised as a last name.

109. Furthermore, and as established above, the beginning of marks tend to make more of an impact than the ends. Consequently, I do not consider that the average consumer would overlook the beginning words LADY or LOUISA in the applicant's mark. Especially as the effect is to change the word from designating a geographical location to becoming a surname for LADY LOUISA. Therefore, taking all of the above into account, I do not consider there to be a likelihood of direct confusion.

110. It now falls to me to consider the likelihood of indirect confusion. Indirect confusion was described in the following terms by Iain Purvis Q.C., sitting as the Appointed Person, in *L.A. Sugar Limited v By Back Beat Inc*, Case BL-O/375/10:

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

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

112. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. I do not consider that the average consumer would think the applicant's trade mark was connected with the opponent or vice versa on the basis that they both contain the word WATERFORD. It is more likely to be viewed as a coincidence, especially, as highlighted above, the average consumer does not dissect the mark, it will be viewed as a whole. Consequently, they are not natural variants or brand extensions of each other. Therefore, taking all of the above into account, I do not consider there to be a likelihood of indirect confusion.

The Second Earlier Mark

113. In *Annco, Inc. V OHIM*, Case T-385/09, the General Court considered an appeal against OHIM's decision that there was no likelihood of confusion between ANN TAYLOR LOFT and LOFT (both for clothing and leather goods) and found that:

“48. In the present case, in the light of the global impression created by the signs at issue, their similarity was considered to be weak. Notwithstanding the identity of the goods at issue, the Court finds that, having regard to the existence of a weak similarity between the signs at issue, the target public, accustomed to the same clothing company using sub-brands that derive from the principal mark, **will not be able to establish a connection between the signs ANN TAYLOR LOFT and LOFT, since the earlier mark does not include the ‘ann taylor’ element, which is, as noted in paragraph 37 above (see also paragraph 43 above), the most distinctive element in the mark applied for.** (emphasis added)

49. Moreover, even if it were accepted that the ‘loft’ element retained an independent, distinctive role in the mark applied for, the existence of a likelihood of confusion between the signs at issue could not for that reason be automatically deduced from that independent, distinctive role in that mark.

50. Indeed, the likelihood of confusion cannot be determined in the abstract, but must be assessed in the context of an overall analysis that takes into consideration, in particular, all of the relevant factors of the particular case (*SABEL*, paragraph 18 above, paragraph 22; see, also, Case C-120/04 *Medion* [2005] ECR I-8551, paragraph 37), such as the nature of the goods and services at issue, marketing methods, whether the public's level of attention is higher or lower and the habits of that public in the sector concerned. The examination of the factors relevant to this case, set out in paragraphs 45 to 48 above, do not reveal, *prima facie*, the existence of a likelihood of confusion between the signs at issue."

114. As highlighted above, I consider that the words WATERFORD and TEIREOIR in the Second Earlier Mark play independent distinctive roles, with the word TEIREOIR being the most dominant and distinctive element within the mark, and therefore, playing a greater role in the overall impression. This is on the basis that the word TEIREOIR would not be recognised by a significant proportion of average consumers, and therefore would be perceived as an invented word with no conceptual meaning. Consequently, and as highlighted by the case law above, since the applicant's mark does not include the TEIREOIR element, which is the most distinctive element in the Second Earlier Mark, I do not consider that there would be a likelihood of direct confusion. I do not consider that the TEIREOIR element would be overlooked in the opponent's mark, nor do I consider that the words LADY and LOUISA at the beginning of the applicant's mark, would be overlooked. Taking the above into account, I do not consider there to be a likelihood of confusion.

115. It now falls to me to consider the likelihood of indirect confusion. Having noticed that the competing trade marks are different, I see no reason why the average consumer would assume that they come from the same or economically linked undertakings. Albeit both marks contain the word WATERFORD, I do not consider that they are natural variants or brand extensions of each other because the applicant's mark does not share the dominant and distinctive element of the Second Earlier Mark; TEIREOIR. Therefore, I do not consider that the average consumer would think that the applicant's trade mark was connected with the opponent. Consequently, I consider there is no likelihood of indirect confusion.

CONCLUSION

116. The opposition is unsuccessful, and the application may proceed to registration.

COSTS

117. The applicant has been successful and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of **£600** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Considering the Notice of opposition and preparing a Counterstatement	£200
Preparing and filling written submissions and written submissions in lieu	£400
Total	£600

118. I therefore order Waterford Distillery Group Limited to pay Curraghmore Whiskey Limited the sum of £600. This sum is to 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 24th day of November 2022

L FAYTER

For the Registrar