

O/1042/22

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

IN THE MATTER OF APPLICATION NUMBERS 3597933 AND 3597937

BY IGNITE INTERNATIONAL, LTD.

TO REGISTER:

IGNITE

IN CLASSES 1, 3, 5, 29, 30, 31 AND 32

AND



IN CLASSES 1, 3, 5, 29, 30, 31, 32, 33 AND 34

AND

OPPOSITIONS THERETO UNDER NUMBERS 426673 AND 426695

BY SAZERAC BRANDS, LLC

BACKGROUND AND PLEADINGS

1. On 19 February 2021, Ignite International, Ltd. (“the applicant”) applied to register the trade marks shown on the cover page of this decision (numbers 3597933 (“the word-only IGNITE”) and 3597937 (“the stylised IGNITE”) in the UK. The applications, which are effectively re-filings of pending European Union trade marks, were filed pursuant to Article 59 of the Withdrawal Agreement between the United Kingdom and the European Union (hereafter referred to as “Article 59”). The EU filing dates were 28 November 2018 (3597933) and 4 December 2018 (3597937) and so, in accordance with Article 59, the contested applications are deemed to have the same filing dates as the corresponding pending EU applications. The UK applications were published on 4 June 2021 for the classes of goods and services listed on the cover page. These are listed in full in the Annex to this decision.¹

2. On 6 September 2021, Sazerac Brands, LLC (“the opponent”) opposed the applications under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (“the Act”) in respect of the following goods:

Application 3597933 – the word-only IGNITE

Class 32 *Sports drinks; Non-alcoholic beverages flavored with tea; non-alcoholic beverages flavored with coffee; non-alcoholic fruit juice beverages; bottled drinking water; beer.*

Application 3597937 – the stylised IGNITE

Class 32 *Sports drinks; non-alcoholic beverages flavored with tea; non-alcoholic beverages flavored with coffee; non-alcoholic fruit juice beverages; bottled drinking water; beer.*

Class 33 *Vodka, tequila and seltzers only.*

¹ Following the filing of a Form TM12 on 1 February 2022, application 3597933 was divided and the class 34 within that application proceeded to registration under application 3764499.

3. In both oppositions, under sections 5(2)(b) and 5(3), the opponent relies upon UK trade mark (“UKTM”) number 905423108 (“the earlier mark”)² - **IGNITE THE NITE** - which has a filing date of 27 October 2006, a registration date of 20 August 2007 and is registered for goods in class 33. For the purpose of these proceedings, the opponent relies upon: *whiskey and flavoured liqueurs; whiskey-based liqueurs; spirits and liqueurs.*

4. Under section 5(2)(b), the opponent claims that there is a likelihood of confusion on the basis that the marks and the respective goods are highly similar. Under section 5(3), the opponent claims that its earlier mark has a reputation for the goods relied upon and that use of the contested marks would, without due cause, take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier mark. In accordance with section 6A of the Act, the earlier mark is subject to proof of use; the opponent made a statement of use in relation to all the goods relied upon.

5. In both oppositions, under section 5(4)(a), the opponent relies upon the sign **IGNITE THE NITE** which it claims to have used throughout the UK since 2010 in relation to *whiskey and flavoured liqueurs; whiskey-based liqueurs; spirits and liqueurs.* According to the opponent, use of the contested marks would constitute a misrepresentation to the public that would damage the reputation in its business. Therefore, use of the contested marks would be contrary to the law of passing off.

6. The applicant filed counterstatements to both oppositions on 29 November 2021 denying each ground of opposition and putting the opponent to proof of use of the earlier mark for all the goods relied upon. Opposition numbers 426673 and 426695 were subsequently consolidated.

² On 1 January 2021 the UK left the EU. Under Article 54 of the Withdrawal Agreement between the UK and the EU, the UK IPO created comparable trade marks for all right holders with an existing EU trade mark (“EUTM”). As a result of the opponent’s EUTM number 05423108 being registered before the end of the transition period, a comparable UKTM (the earlier mark) was created. Comparable trade marks are recorded on the UK trade marks register and retain their EU filing date. They are enforceable rights in the UK, consisting of the same sign, for the same goods or services.

7. The opponent is represented by Fieldfisher LLP and the applicant by Sonder & Clay.³ Both parties filed evidence, which I will summarise to the extent I consider it necessary. Neither party requested a hearing but both parties filed written submissions in lieu.

EVIDENCE AND SUBMISSIONS

8. The opponent filed evidence in chief in the form of the witness statement of Stephanie Burset, dated 3 March 2022, and its corresponding 19 exhibits (SB01 – SB19). Ms Burset is Brand Manager at Sazerac Company, Inc., the parent company of the opponent. Ms Burset provides some history of the opponent company and explains the relationship between the earlier mark IGNITE THE NITE and the opponent's FIREBALL product – a whisky.

9. The applicant filed evidence in chief in the form of the witness statement of Sophia Karim, dated 9 May 2022, and its corresponding eight exhibits (SK1 – SK8). Ms Karim is a Legal Assistant at D Young & Co LLP, the former representative of the applicant. The purpose of the applicant's evidence is to dispute the opponent's claims of reputation and goodwill.

10. The opponent filed evidence in reply in the form of the witness statement of Matthew Palmer, dated 18 July 2022, and its corresponding 20 exhibits. Mr Palmer is a Chartered Legal Executive at Fieldfisher LLP, the opponent's representative.

11. I have considered the evidence in its entirety and will refer to it where necessary during my decision.

DECISION

Relevance of EU law

³ D Young & Co LLP were replaced as the applicant's representative by Sonder & Clay on 31 August 2022.

12. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied upon in these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case law of EU courts.

Proof of use

13. I will begin by assessing whether there has been genuine use of the earlier mark. The relevant statutory provisions are as follows:

“6A (1) This section applies where -

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

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

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

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

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

(3) The use conditions are met if -

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

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

(4) For these purposes -

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

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

(5)-(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.”

14. 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.”

15. Accordingly, for the purposes of assessing proof of use, the earlier mark will be treated as an EUTM since the relevant periods (as discussed later in this decision) expire before IP completion day.

16. 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.”

Relevant case law

17. 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 I-

9223, 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].”

18. In *Awareness Limited v Plymouth City Council*, Case BL O/236/13, Mr Daniel Alexander QC (as he then was) as the Appointed Person stated that:

“22. The burden lies on the registered proprietor to prove use. [...] However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public.”

And further at paragraph 28:

“28. [...] I can understand the rationale for the evidence being as it was but suggest that, for the future, if a broad class, such as “tuition services”, is sought to be defended on the basis of narrow use within the category (such as for classes of a particular kind) the evidence should not state that the mark has been used in relation to “tuition services” even by compendious reference to the trade mark specification. The evidence should make it clear, with precision, what specific use there has been and explain why, if the use has only been narrow, why a broader category is nonetheless appropriate for the specification.

Broad statements purporting to verify use over a wide range by reference to the wording of a trade mark specification when supportable only in respect of a much narrower range should be critically considered in any draft evidence proposed to be submitted.”

19. In *Dosenbach-Ochsner Ag Schuhe Und Sport v Continental Shelf 128 Ltd*, Case BL 0/404/13, Mr Geoffrey Hobbs QC (as he then was) as the Appointed Person stated that:

“21. The assessment of a witness statement for probative value necessarily focuses upon its sufficiency for the purpose of satisfying the decision taker with regard to whatever it is that falls to be determined, on the balance of probabilities, in the particular context of the case at hand. As Mann J. observed in *Matsushita Electric Industrial Co. v. Comptroller- General of Patents* [2008] EWHC 2071 (Pat); [2008] R.P.C. 35:

‘[24] As I have said, the act of being satisfied is a matter of judgment. Forming a judgment requires the weighing of evidence and other factors. The evidence required in any particular case where satisfaction is required depends on the nature of the inquiry and the nature and purpose of the decision which is to be made. For example, where a tribunal has to be satisfied as to the age of a person, it may sometimes be sufficient for that person to assert in a form or otherwise what his or her age is, or what their date of birth is; in others, more formal proof in the form of, for example, a birth certificate will be required. It all depends who is asking the question, why they are asking the question, and what is going to be done with the answer when it is given. There can be no universal rule as to what level of evidence has to be provided in order to satisfy a decision-making body about that of which that body has to be satisfied.’

22. When it comes to proof of use for the purpose of determining the extent (if any) to which the protection conferred by registration of a trade mark can legitimately be maintained, the decision taker must form a view as to what the

evidence does and just as importantly what it does not ‘show’ (per Section 100 of the Act) with regard to the actuality of use in relation to goods or services covered by the registration. The evidence in question can properly be assessed for sufficiency (or the lack of it) by reference to the specificity (or lack of it) with which it addresses the actuality of use.”

20. What I take from this case law is that there is no requirement to produce any specific form of evidence, but that I must consider what the evidence as a whole shows me and whether on this basis I can reasonably be satisfied on the balance of probabilities that there has been genuine use of the mark.

21. Whether the use shown is sufficient will depend on whether there has been real commercial exploitation of the earlier mark, in the course of trade, sufficient to create or maintain a market for the goods at issue in the EU during the relevant five-year periods. In making the assessment, I am required to consider all relevant factors, including:

- i) The scale and frequency of the use shown;
- ii) The nature of the use shown;
- iii) The goods for which use has been shown;
- iv) The nature of those goods and the market(s) for them; and
- v) The geographical extent of the use shown.

22. Pursuant to section 6A of the Act, the relevant periods for assessing whether there has been genuine use of the earlier marks are the five-year periods ending with the dates of the applications in issue. Since the filing dates of the contested marks differ, so do the relevant periods, albeit only slightly. The relevant period in relation to the word-only IGNITE is 29 November 2013 to 28 November 2018; the relevant period in relation to the stylised IGNITE is 5 December 2013 to 4 December 2018.

Assessment

23. In the case before me there is an abundance of evidence filed in relation to sales of the opponent’s FIREBALL whisky, but the IGNITE THE NITE mark is said to have

been used in relation to those whisky products. The relationship between the mark and the goods is explained as follows:⁴

“5. FIREBALL is a whisky flavoured with cinnamon and is categorized as a whisky or whisky liqueur depending on local regulatory or trade provisions. [...]

6. IGNITE THE NITE has appeared on the back of every FIREBALL bottle since 2006. IGNITE THE NITE is also used in promotional material concerning FIREBALL. As a result, consumers associated the mark IGNITE THE NITE with FIREBALL cinnamon whisky and its fiery cinnamon kick. The mark IGNITE THE NITE has come to stand for and represent the Fireball product and is associated with the Opponent.”

24. Many of the exhibits in evidence make it clear that there have been sales of FIREBALL whisky across the EU and the UK during the relevant periods, such as the invoices at exhibits SB6 and SB12. The invoices are supported by various extracts from the websites of online retailers.⁵ However, I must also be satisfied that there has been use of the mark relied upon as a trade mark on or in relation to these goods.

25. It is clear to me that the opponent’s whisky goods are sold under the mark FIREBALL. It is this mark which is on the front of every bottle of whisky and is how the goods are referred to by Ms Burset in her witness statement, by online retailers and on every invoice that has been provided. What I must decide is whether IGNITE THE NITE has been used as an additional trade mark which guarantees to consumers the origin of the goods. Ms Burset states that IGNITE THE NITE has appeared on the back of every FIREBALL bottle since 2006. Images of the front and rear of the FIREBALL bottles have been provided, as follows:⁶

⁴ Paragraphs 5 and 6 of the witness statement of Ms Burset.

⁵ Exhibits SB8, SB9 and SB13.

⁶ Exhibit SB5.



26. The above images are undated but are corroborated by images within exhibit SB8.

27. Ms Buset explains that exhibit SB9 shows examples of retailers specifically referring to the IGNITE THE NITE mark in connection with the FIREBALL product.⁷ The online retailers within that exhibit, whose product descriptions refer to IGNITE THE NITE, are Tesco, mySupermarket and Ocado. On each of the websites, the product is listed as “Fireball Liqueur 70Cl”, “Fireball Liqueur Blended with Cinnamon

⁷ Paragraph 17 of her witness statement.

& Whisky” and “Fireball Liqueur with Cinnamon & Whisky”. IGNITE THE NITE is included within the product descriptions further down the pages: it is certainly not immediately visible and I consider it unlikely for consumers to even scroll down the page far enough to see the words.

28. Ms Burset also makes reference to the use of IGNITE THE NITE on social media. The related evidence shows use of “#IgniteTheNite” on social media platforms Facebook, Twitter and Instagram between 2017 and 2020 (I note that the use in 2019 and 2020 falls outside the relevant periods). On Facebook, there are nine posts during the relevant periods for which the captions include “#IgniteTheNite”.⁸ In 2017, use of the hashtag seems, from the image below, to relate to a competition:⁹



29. On Twitter, there are three tweets during the relevant periods: one includes “#IgniteTheNite”; one includes “...#summer...#ignitethenite @FireballWhisky”; and one includes “#FireballFriday”.¹⁰

⁸ Exhibit SB10.

⁹ Page 16 of exhibit SB10.

¹⁰ Exhibit SB10. Incorrectly numbered pages.

30. The hashtag “#ignitethenite” was used in nine posts on Instagram during the relevant periods, along with the hashtags “#shotsfired”, “#FireballWhisky” and “FireballOnTheRocks”.¹¹

31. There is some use of IGNITE THE NITE in Spanish¹² and German¹³ social media, though nothing in the latter is dated within either of the relevant periods. Five Instagram posts from the Spanish account display IGNITE THE NITE: one of which is an image of the back of the bottle; one is within the photo itself but written as IGNITE THE NIGHT; and three contain “#ignitethenite” or “ignitethenight” amongst other hashtags:



¹¹ Exhibit SB10. Incorrectly numbered pages.

¹² Exhibit SB16.

¹³ Exhibit SB17.



32. Finally, marketing material has been provided for Germany¹⁴ and Spain.¹⁵ None of the German marketing material is dated; it is explained in Ms Burset's witness statement as being from "the last 18 months", which falls outside the relevant periods given the date of the statement. The Spanish marketing material is said to be from between 2017 and 2019 and contains a handful of images containing either "IGNITE THE NITE" or "INCENDIA LA NOCHE". However, this material is not of much use since there is no explanation as to the purpose of the marketing or where it occurred for me to establish who it was visible to.

33. As I have indicated above, I must be satisfied from the evidence that IGNITE THE NITE has been used as a trade mark in accordance with its essential function, which is to guarantee the identity of the origin of the goods. I have already explained that the goods appear to be sold under the mark "FIREBALL", however, I recognise that it is possible for two or more trade marks to be used jointly and autonomously on the same goods or services, though both marks must be perceived as indicative of the origin of the product. In *Apple Inc. v EUIPO*, the General Court stated:¹⁶

¹⁴ Exhibit SB18.

¹⁵ Exhibit SB19.

¹⁶ Cases T-26/21 to T-28/21 EU:T:2022:350.

“87. It is true, as is apparent from the case-law relied on by the applicant, that there is no precept in the EU trade mark system that obliges its proprietor to prove the use of its earlier mark on its own, independently of any other mark or any other sign. Therefore, the case could arise where two or more trade marks are used jointly and autonomously, with or without the name of the manufacturer’s company (see, to that effect, judgments of 8 December 2005, *Castellblanch v OHIM – Champagne Roederer (CRISTAL CASTELLBLANCH)*, T-29/04, EU:T:2005:438, paragraphs 33 and 34; of 14 December 2011, *Völkl v OHIM – Marker Völkl (VÖLKL)*, T-504/09, EU:T:2011:739, paragraph 100; and of 6 November 2014, *Popp and Zech v OHIM – Müller-Boré & Partner (MB)*, T-463/12, not published, EU:T:2014:935, paragraph 43). Thus, as the applicant has argued, the joint use of another mark with the contested marks cannot, in itself, undermine the function of that other mark as a means of identifying the goods concerned.

88. However, a registered trade mark that is used 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) of Regulation No 207/2009 (see, by analogy, judgment of 18 April 2013, *Colloseum Holding, C-12/12*, EU:C:2013:253, paragraph 35).”

34. In the same case it was found that the way in which the mark was used did not constitute use as a trade mark:

“93. In the present case, as the photographs of the iMac computer packaging in the file illustrate, the word elements ‘think different’ do not appear on the labels affixed to the box packaging in a way which particularly draws the consumer’s attention. On the contrary, as the Board of Appeal correctly pointed out in paragraph 30 of the contested decisions, those word elements are placed under the technical specifications of the iMac computers, and just above the barcode in a relatively small character size.

94. It must therefore be concluded that the way in which the contested marks are used on iMac computer packaging does not ground the conclusion that they

have been used as trade marks, that is to say, in accordance with their essential function of giving an indication of the commercial origin of the goods concerned.”

35. In the present case, the mark is applied to the back of the bottles of whisky. I do not consider this placement of the words to draw the consumer’s attention in a way which would indicate the origin of the goods. In my view, it is likely to go unnoticed by the average consumer as I am not persuaded that they will be paying a minute attention to the details on the reverse of the bottles when they are choosing or consuming the product. Further, IGNITE THE NITE is not the mark by which consumers refer to the goods, would select them from the shelves of physical stores or order them from a bar or other establishment. I note that the GC found in *Aldi v EUIPO* that it was not relevant that the mark was not affixed to the front of the packaging.¹⁷ However, the circumstances in that case involved use of the company name, which was affixed to the packaging of the goods. The Court found that there was use in relation to goods where a party affixed the sign constituting its company name to the goods which it marketed. That is not the case here; IGNITE THE NITE is not the company name of the undertaking marketing FIREBALL whisky. To my mind, the evidence indicates that IGNITE THE NITE is a promotional message or marketing slogan. Aside from its use on the back of the whisky bottles, IGNITE THE NITE is used on social media predominantly as a hashtag and usually amongst other hashtags. This points to an advertising method rather than an attempt to guarantee to the consumer the identity of the origin of the goods. I do not consider the use of IGNITE THE NITE to be consistent with the essential function of a trade mark.

36. I find that the opponent has not shown that it has made genuine use of the earlier mark and so the section 5(2)(b) and 5(3) grounds fail.

Section 5(4)(a)

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

¹⁷ Case T-391/15 EU:T:2016:741 at [31].

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

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, where the condition in subsection (4A) is met,

(aa) [...]

(b) [...]

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

38. Subsection (4A) of Section 5 states:

“(4A) The condition mentioned in subsection (4)(a) is that the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.”

Relevant law

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

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

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

Goodwill

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

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

41. Whilst I acknowledge that the test under the law of passing off is different to the test for a likelihood of confusion under section 5(2)(b), if a mark has not been shown to have been used as a trade mark, to my mind it cannot possibly have accrued goodwill as a trade mark. This is because use of a sign relied upon under passing off must relate to use of the mark for the purposes of distinguishing goods or services. I have already found that the use shown in evidence does not amount to use as a trade mark, the essential function of which is to enable consumers to distinguish goods or services of one undertaking from those of another undertaking. IGNITE THE NITE has not been shown to distinguish the opponent’s goods from other undertakings and so it cannot satisfy the same criterion under the law of passing off.

42. Regardless of whether the opponent as a business possessed a protectable goodwill in the UK at the relevant date, I am not satisfied that it has shown that the sign relied upon, IGNITE THE NITE, is distinctive of that potential goodwill in that it identifies the trade origin of the goods it relies upon.

CONCLUSION

43. The oppositions under numbers 426673 and 426695 have been unsuccessful and the contested applications may proceed to registration.

COSTS

44. The applicant has been successful and is entitled to a contribution towards its costs in line with the scale set out in Tribunal Practice Notice 2/2016. In the circumstances, I award the applicant the sum of £1,950, calculated as follows:

Considering the other side's statement of grounds and preparing a counterstatement	£350
Preparing evidence and considering the other side's evidence	£1,200
Preparing submissions in lieu of a hearing	£400
Total	£1,950

45. I therefore order Sazerac Brands, LLC to pay Ignite International, Ltd. the sum of £1,950. 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 final determination of the appeal proceedings.

Dated this 25th day of November 2022

E FISHER (née VENABLES)
For the Registrar

Annex

Application 3597933

- Class 1 *Plant extracts for use in the manufacture of creams, lotions and cosmetic products.*
- Class 3 *Tanning lotions and oils; non medicated stimulating lotions for the skin, not for massage purposes and not for purposes of sexual stimulation; Bar soap; liquid bath soaps; skin soap; perfumed soap; make up removing milk, gel, lotions and creams; make up primer; Facial make up, namely, powder, foundation, primer, lipstick, lip gloss.*
- Class 5 *Herbal teas for medicinal purposes; Herbal extracts for medical purposes; Medicated lotion; Medicated bath soaps in liquid, solid or gel form.*
- Class 29 *Edible oils.*
- Class 30 *Bakery goods and dessert items, namely, cakes, cookies, pastries, candies, and confections.*
- Class 31 *Sowing seeds; plant clones other than those of botanical genus Coprosma, Grevillea, Triticum.*
- Class 32 *Sports drinks; Non-alcoholic beverages flavored with tea; non-alcoholic beverages flavored with coffee; non-alcoholic fruit juice beverages; bottled drinking water; beer.*

Application 3597937

- Class 1 *Plant extracts for use in the manufacture of creams, lotions and cosmetic products.*

- Class 3 *Tanning lotions and oils; non-medicated stimulating lotions for the skin.*
- Class 5 *Herbal teas for medicinal purposes; herbal extracts for medical purposes; medicated lotion; medicated bath soaps in liquid, solid or gel form.*
- Class 29 *Edible oils.*
- Class 31 *Sowing seeds and live plants, other than those of botanical genus Coprosma, Grevillea, Triticum.*
- Class 32 *Sports drinks; non-alcoholic beverages flavored with tea; non-alcoholic beverages flavored with coffee; non-alcoholic fruit juice beverages; bottled drinking water; beer.*
- Class 33 *Vodka, tequila and seltzers only.*
- Class 34 *Cigarette cases; cigarette lighters; cigarette rolling papers; tobacco pipes; tobacco water pipes; smokers' clips for securing hand rolled cigarettes; ashtrays for smokers made of non-precious metals; smokers' rolling trays; pocket machines for rolling cigarettes; oral vaporizers for smoking purposes.*