

**DECISION OF THE CONTROLLER OF PATENTS, DESIGNS AND TRADE
MARKS IN PROCEEDINGS UNDER THE TRADE MARKS ACT, 1996**

BETWEEN

LODESTAR ANSTALT

Proprietor/Holder

and

AUSTIN NICHOLS & CO, INC

Applicant for Declaration of Invalidity/Opponent

CONCERNING

**Registered Trade Marks Nos. 203925 and 208660 and International Trade
Marks Nos. 737715 and 814790**

Background

1. Lodestar Anstalt, of Lova-Centre, PO Box 1150, SI-9490 Vaduz, Liechtenstein, (“Lodestar”) is the proprietor of trade mark registrations having the following particulars:

Number: 203925
Mark: WILD GEESE
Class/Goods: 33 - Wines, spirits and liqueurs

Number: 208660

Mark:  (series of two)

Class/Goods: 33 - Wines, spirits and liqueurs

Number: 737715
Mark: WILD GEESE
Class/Goods: 32 - Beers; mineral and aerated waters and other non-alcoholic drinks; fruit drinks and fruit juices; syrups and other preparations for making beverages
33 – Alcoholic beverages (except beers)

Number: 814790
Mark: WILD GEESE RARE IRISH WHISKEY
Class/Goods: 33 – Whiskey, all products of Irish origin

2. Registrations Nos. 203925 and 208660 were made pursuant to applications filed with the Controller on 20 February, 1997 and 10 July, 1997, respectively, under Section 37 of the Trade Marks Act, 1996 (“the Act”) by Wild Geese Wines & Spirits Limited, an Irish company, of Lough Guittane, Killarney, Co. Kerry, predecessor in title to Lodestar.
3. Registrations Nos. 737715 and 814790 are International Registrations made by the International Bureau of the World Intellectual Property Organisation pursuant to the Madrid Agreement Concerning the International Registration of Marks and the Protocol relating thereto. Ireland is one of the countries designated under these International Registrations, the respective dates of designation being 10 December, 2001 (No. 737715) and 19 November, 2003 (No. 814790¹). Designation of the State constitutes a request for the extension to the State of the protection resulting from the International Registrations and, by virtue of Regulation 3 of the Trade Marks (Madrid Protocol) Regulations, 2001 (S.I. 346 of 2001), the Act applies to the requests for protection as it applies to an application for registration under the Act.

¹ claiming priority of an application filed in Liechtenstein on 26 May, 2003

4. Austin Nichols & Co, Inc, doing business as Pernod Ricard, of 777 Westchester Avenue, White Plains, 10604 New York, United States of America (“Austin Nichols”) has applied for declarations of invalidity in respect of Trade Mark Registrations Nos. 203925 and 208660 and has opposed the extension to the State of the protection resulting from International Registrations Nos. 737715 and 814790. The applications for declarations of invalidity were filed under Section 52 of the Act on 22 March, 2004 and the notices of opposition were filed under Section 43 of the Act on 27 January, 2004 (No. 737715) and 19, May, 2004 (No. 814790), i.e., in each case, within the prescribed period of three months of the date of publication in the Journal of the acceptance of the requests for protection of the marks. Lodestar has filed notices of opposition under Rule 41(3) of the Trade Marks Rules, 1996 (“the Rules) against the applications for declarations of invalidity and counter-statements under Rule 19 of the Rules against the Austin Nichols notices of opposition. The parties have also filed evidence under Rules 20, 21 and 22², as appropriate.
5. The proceedings became the subject of a hearing before me, acting for the Controller, on 17 January, 2008. The parties were notified on 6 February, 2008 that I had decided to refuse the applications for declarations of invalidity and to dismiss the oppositions, thereby allowing Registrations Nos. 203925 and 208660 to remain as validly registered marks and allowing International Registrations Nos. 737715 and 814790 to proceed to final protection. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by Austin Nichols in that regard pursuant to Rule 27(2) filed on 11 February, 2008.

Scope of the proceedings

6. The notices of opposition and the statements of grounds accompanying the applications for declarations of invalidity filed by Austin Nichols define the scope of the present proceedings. In them, Austin Nichols refers to its proprietorship of the trade mark WILD TURKEY and trade marks incorporating that name, which

² the same evidence was filed in respect both of the applications for declarations of invalidity and the oppositions and so references to Rules 20, 21 and 22, which relate to opposition, are to be taken as also including Rule 41(4), which provides for the filing of evidence in invalidity proceedings

it has registered³ and which it claims to have used extensively for many years. On that basis, it objects to the registration of Lodestar's marks under Section 10 of the Act. The principal objection is that there is a likelihood of confusion on the part of the public as between goods bearings the respective trade marks WILD TURKEY and WILD GEESE and that registration of the latter is therefore prohibited by virtue of Section 10(2) of the Act. Austin Nichols also claims that Lodestar's applications for registration of its trade marks were made in bad faith and are objectionable under Section 8(4)(b) of the Act. In the case of the applications for declarations of invalidity only, Austin Nichols claims that the marks in question are of such a nature as to deceive the public and that registration is therefore prohibited by Section 8(3)(b) of the Act. Lodestar denies all of these claims. Further grounds of objection are raised in both the notices of opposition and the applications for declarations of invalidity but these have neither been substantiated by evidence nor supported by any argument and I am satisfied that they may simply be ignored.

The evidence filed and facts claimed

7. Evidence submitted by Austin Nichols under Rule 20 consisted of an Affidavit (and Exhibits AN1-AN8) dated 17 May, 2005 of Thomas Lalla Jr., its General Counsel and a Statutory Declaration (and Exhibits AN9 and AN10), dated 20 May, 2005, of Kate Hilder, an employee of Messrs. MacLachlan & Donaldson, Trade Mark Agents. Evidence submitted by Lodestar under Rule 21 consisted of a Statutory Declaration (and Exhibits KG1-KG11) dated 31 October, 2005 of Ken Griffin, a United Kingdom registered trade mark attorney and advisor to Lodestar in relation to its trade mark portfolio. Evidence in reply submitted by Austin Nichols under Rule 22 consisted of a Declaration (and Exhibits AN8-AN10) dated 11 July, 2006 of Adam Tracy, its Intellectual Property Counsel.

8. I would summarise the relevant facts averred to in the evidence as follows. Austin Nichols' WILD TURKEY brand was introduced in the United States of America in 1942 in respect of a bourbon whiskey. The name was chosen in homage to an annual hunting trip undertaken by the company's then president for one of

³ see Schedule 1

America's indigenous birds. In the period 1991-2004, approximately 68,000 bottles of WILD TURKEY were sold in the State. In 1994, 240 retailers throughout the State sold the product. WILD TURKEY is sold throughout the world and is one of the world's best selling premium bourbons with more than 44.7 million litres sold worldwide in the period 1999-2005. In May, 2005, a 700ml bottle of 8 year old WILD TURKEY was retailing in Dublin at €43.75.

9. The trade mark WILD GEESE was selected for its historical connotations, being the name given to Irish soldiers of fortune who left the country at various times of historical significance, including after the flight of the Earls (1607) and the Battle of the Boyne (1690). The trade mark is used in relation to whiskey (though not a bourbon whiskey), which is produced and labelled under licence in the State by an undertaking called Avalon Group Inc. and which was sold through two outlets in Dublin in 2004 and 2005. The trade mark has been registered in several countries throughout the world.

The hearing and arguments of the parties

10. At the hearing Austin Nichols was represented by Cliff Kennedy, Trade Mark Agent of MacLachlan & Donaldson and Lodestar by Paul Coughlan, BL instructed by LK Shields, Solicitors.
11. At the outset, Mr. Kennedy objected to the admissibility of certain of Lodestar's evidence on the basis that it was given by Mr. Griffin, who is not an officer of Lodestar but merely an external advisor to it in relation to trade mark matters. For that reason, Mr. Kennedy claimed that Mr. Griffin was not in a position to give first-hand evidence as to matters of fact concerning information that is internal to Lodestar. The averments in Mr. Griffin's Statutory Declaration to which Mr. Kennedy objected concerned the motivation behind the adoption of the trade mark WILD GEESE and the licensing arrangement under which WILD GEESE is marketed in the State. Mr. Coughlan denied that Mr. Griffin was disentitled to give evidence as to the matters of fact contained in his Statutory Declaration simply because he is an advisor to Lodestar and not an officer of that company. He pointed out that Mr. Griffin had disclosed the source of his knowledge as to the facts in question and he asserted that they were matters that a person in Mr.

Griffin's position might reasonably be expected to know. Mr. Griffin had given evidence as to these matters in other jurisdictions and no question had been raised as to his capacity to do so.

12. As regards the substance of the objection on the so-called relative grounds, Mr. Kennedy asserted that a likelihood of confusion was evident as between alcoholic beverages⁴ marketed under the trade marks WILD TURKEY and WILD GEESE as the general impression given by each mark is of the word WILD combined with the name of a bird, which is traditionally eaten at Christmastime. In comparing marks consisting of words, extra emphasis must be placed on the first or opening parts of the marks, which are identical in this case – the word WILD. The distinction between the marks created by the different second words is not significant as the turkey and goose would be closely associated in the mind of the average Irish consumer so that the overall impression created by the marks is highly similar. It is significant also that Austin Nichols' earlier trade mark, WILD TURKEY, is highly distinctive, both inherently and because of the additional distinctiveness acquired by it through long and extensive use. The use by Lodestar of a highly similar mark on the same or similar goods is bound to lead to an association in the minds of consumers between those goods and the goods that they have previously seen marketed under Austin Nichols' mark.
13. On the question of Austin Nichols' claim that Lodestar's adoption of the trade mark WILD GEESE was in bad faith, Mr. Kennedy stated that the adoption of the mark appeared to be for the purpose of trading on the goodwill and reputation of Austin Nichols' WILD TURKEY trade mark. The claim that the mark was adopted in reference to Irish soldiers of fortune did not ring true in light of the fact that Lodestar is a Liechtenstein-based company and it was notable that no officer of the company had been prepared to give evidence in support of this claim.
14. Finally, in relation to the objection under Section 8(3)(b) to the effect that Lodestar's trade mark is deceptive, Mr. Kennedy asserted that, if I was to accept

⁴ Mr. Kennedy stated that Austin Nichols was not pursuing the objection against the protection of International Registration 737715 insofar as it covered non-alcoholic goods in Class 32

that the appellation WILD GEESE referred to Irish soldiers of fortune, then I would have to find that its use as a trade mark in respect of goods of non-Irish origin would be deceptive and that the mark could not be, or remain, protected in respect of such goods.

15. Mr. Coughlan responded to the effect that, when compared in their entireties, the trade marks WILD TURKEY and WILD GEESE conveyed different concepts, such that it was unlikely that the average consumer would make a connection between them. WILD TURKEY designates a bird that is unknown in the State and the name would necessarily connote a foreign origin in the mind of the average consumer here. WILD GEESE, on the other hand, is evocative of exiled Irish soldiers of a bygone era. No conceptual connection may be inferred between the marks on the basis, as claimed in Austin Nichols' evidence, that each describes a large game bird because that is not the impression that would be likely to be formed by the marks on the mind of the average Irish consumer. The differences between the marks are obvious and are sufficient to ensure that there is no likelihood of confusion on the part of the average person, exercising reasonable care in the purchase of goods, which the evidence shows to be relatively expensive.

16. As regards the allegation of bad faith against Lodestar, Mr. Coughlan argued that the objection on that ground had not been properly particularised by Austin Nichols in the notices of opposition nor the applications for declarations of invalidity as filed. It did not therefore fall to be dealt with, in accordance with the decision of the High Court (O'Sullivan J) in *The Zockoll Group Limited –v- The Controller of Patents, Designs and Trade Marks and 1-800-FLOWERS.COM, Incorporated*⁵. In any event, the claim that WILD GEESE was confusingly similar to WILD TURKEY fell to be considered under Section 10 and a separate claim of bad faith based on an intention to confuse could not be sustained if the Section 10 objection was found to be without merit. As to the suggestion that WILD GEESE would be deceptive of goods not of Irish origin, Mr. Coughlan argued that the term was merely evocative of an aspect of Irish history and did

⁵ unreported decision dated 17 October, 2006

not constitute a directly deceptive indication in the sense intended by Section 8(3)(b) of the Act.

Grounds of decision

Admissibility of Lodestar's evidence

17. I consider first the objection against the admissibility of certain elements of Lodestar's evidence, being the averments of Mr. Griffin with regard to Lodestar's reasons for adopting the trade mark WILD GEESE and the trade that has been carried on in the State in goods bearing that mark. I declined to rule on that objection on the day of the hearing, preferring to hear the parties' respective submissions on the substantive issues before deciding whether it was necessary for the purposes of deciding the case to make a ruling on the admissibility question. Having heard and considered those submissions, I have decided that it is not necessary for me to make such a ruling. I have been able to decide this case without placing any reliance on Mr. Griffin's disputed averments and it is not necessary, therefore, for me to determine whether or not those averments are admissible. Nor is it desirable that I should make a determination on the matter simply because it was raised before me. To do so might have the effect of depriving Lodestar of certain of its evidence in the event of an appeal from my decision on the substantive issues whereas no such negative consequences ensue for Austin Nichols from my refusal to rule on its objection. If it wishes, it can raise the same objection on appeal.

Relative grounds objection

18. The relevant parts of Section 10 of the Act, insofar as the present application is concerned, read as follows:

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

(a).....

*(b) it is similar to an earlier trade mark and would be registered for goods
..... 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 of the later trade mark with the earlier trade mark.*

19. The principles of interpretation to be applied in determining an objection under Section 10(2)(b) of the Act are not in dispute. They have been set out in detail in several decisions of the European Court of Justice (ECJ)⁶ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischaltheprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*⁷. In summary, the relevant principles are that –

- (i) the likelihood of confusion must be appreciated globally, having regard to all of the relevant factors, including the degree of similarity between the marks and between the goods, the likelihood that the public will make an association between the earlier mark and the mark seeking registration, and the distinctiveness of the earlier mark;
- (ii) the similarity between the marks must be determined by reference to the degree of visual, aural and conceptual similarity between them and the importance to be attached to each of these elements must be assessed by reference to the category of goods and the circumstances in which they are marketed;
- (iii) the assessment must be made from the perspective of the average consumer of the goods in question, who must be deemed to be reasonably observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely, instead, on the imperfect picture of them that he keeps in his mind;
- (iv) the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by them, bearing in mind their distinctive and dominant components, because the average consumer

⁶ including Case No. C-251/95, *Sabel BV v Puma AG and Rudolf Dassler Sport*, Case No. C-39/97, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc.* and Case No. C-342/97, *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*

⁷ unreported decision dated 14 June, 2007

normally perceives a mark as a whole and does not analyse its various details;

- (v) the higher the distinctiveness of the earlier mark, whether inherent or acquired through use, the greater the protection granted to it, and vice versa.

20. At the hearing, I was referred to a number of decisions of competent authorities in other jurisdictions in proceedings between Austin Nichols and Lodestar concerning the proposed registration by the latter of the trade mark WILD GEESE and I have read those decisions with interest. In my opinion, none of the decisions in question sets out any new or nuanced principle of interpretation of the relevant law over and above those that have become firmly established by virtue of the ECJ jurisprudence (and nor do they purport to). The application of those principles to the facts of the instant case is a matter that falls within the discretion of the Controller and, in the exercise of that discretion, it is not appropriate to take guidance from the findings of foreign tribunals, which are based, of course, on the particular facts in play in the relevant jurisdictions.

21. The undisputed facts in these proceedings are that Austin Nichols' trade marks listed in Schedule I constitute "earlier trade marks" as against all four of Lodestar's registrations and that those earlier trade marks are protected in respect of goods that are the same as or similar to those in respect of which Lodestar's marks are registered. Although two of Lodestar's registrations contain more than just the words WILD GEESE, those words are, in my view, the dominant and distinctive components of the marks in question so that I think it permissible to treat the comparison of marks as simply between WILD TURKEY and WILD GEESE, which was the approach taken by the parties' representatives at the hearing.

The comparison of the trade marks

22. In comparing those marks, I have tried to focus on their overall identities rather than analysing individual points of similarity or dissimilarity. The visual and aural comparison is, in my view, a relatively straightforward exercise. The marks

look and sound somewhat similar because they each consist of two words, the first of which is the word WILD in each case. The second words are of similar length but they are very different looking and different sounding words. The marks could be described as 50% identical and 50% completely different from a visual and aural aspect, although that might appear to fall foul of the dictum that marks should be appreciated and compared in their entireties. On an overall visual and aural assessment, I would say that they are marginally more similar to each other than they are different because the identity between them occurs in the first word, which tends to have more of an impact on the eye and the ear in terms of the overall impression formed by most two-word marks. They are certainly not highly similar, either visually or aurally.

23. As regards the conceptual comparison, it would be wrong, in my opinion, to simply say that the marks each convey the same idea, i.e., a wild bird or birds. While that may be strictly correct, it is no more relevant to the question under consideration than the fact, say, that LONG ISLAND and LONG BEACH each connote a geographic feature that is long, or that BIG DADDY and BIG MAMMA each signify a large parent. The point of these rather extreme examples is that the commonality of meaning as between trade marks such as those under consideration here may sometimes be evident only upon an analysis of them, however slight. Keeping in mind that the average consumer is not apt to make such an analysis and is likely, rather, to be influenced more by the overall impressions formed by the marks, I think that the conceptual comparison must be based on the essential and immediate message given by each of the respective marks.

24. Looked at in that light, I believe that a clear distinction is apparent between the conceptual impacts made by the present marks. Since turkeys do not live in the wild in Ireland, the immediate conceptual impact formed on the mind of the average consumer in this jurisdiction by the trade mark WILD TURKEY would be of something quite alien and exotic. For this reason, it is a striking name that would be likely to form a strong and distinctive impression on the mind of the average consumer. Geese, on the other hand, are to be found both in the wild and domestically in this country and the name WILD GEESE conjures an image that

is familiar and commonplace. In short, the essential message given by each mark is fixed to the particular species of bird that it names; on the one hand, a turkey and, on the other, geese. The idea of wildness, per se, is not a separate concept within the respective marks. The fact is that a turkey is not a goose, and *vice versa*, and I see no reason to suppose that the name of one would cause the average person to think of the other. In this regard, the fact that turkeys and geese are both large birds that are traditionally eaten at Christmastime does not really affect the conceptual comparison in a significant way. I cannot imagine that the idea of fowl eaten for Christmas dinner is one that is called to mind in any way by either name, WILD TURKEY or WILD GEESE. Notwithstanding, therefore, that both the names WILD TURKEY and WILD GEESE connote birds in a wild state, I regard them as conceptually quite different, having regard to the likely impression that would be formed by each of them on the mind of the average consumer.

25. In making the conceptual comparison of the trade marks, I have not had to have regard to the fact relied on by Lodestar that WILD GEESE has an historic conceptual significance that is unrelated to geese. Mr. Coughlan suggested at the hearing that I could take judicial notice of that fact and that it would be strange indeed if the fact of the story of the Wild Geese had to be proven by evidence in proceedings in this jurisdiction. Mr. Kennedy objected, asserting that the onus was on Lodestar to prove its factual claims in this regard. For my part, I can say that the history of the Wild Geese formed part of the curriculum during my schooldays, such that persons of my generation would have been exposed to it some 20 years ago and more. Whether it has continued to be taught and, more importantly, to what extent knowledge of the Wild Geese has remained in the consciousness of the public generally, I cannot say. So, while I think it likely that very many consumers would have a sense of WILD GEESE as signifying something of historical significance, I am not satisfied that that fact is so obviously true as to be capable of being assumed without some corroborating evidence. Out of caution (perhaps an excess of caution), I have decided, therefore, to consider the literal meaning only of Lodestar's mark in making the conceptual comparison.

The distinctiveness of the earlier trade mark

26. Lodestar have not seriously challenged Austin Nichols' claim that WILD TURKEY is an inherently distinctive trade mark in respect of alcoholic drinks such as whiskey. It clearly is. Not only is it completely unrelated to any aspect of the product's character or origin, it is, as I have already said, a striking name and concept that is likely to make a strong impact on the average consumer. Nor is it similar to the kinds of names one frequently finds used in relation whiskey, such as personal names (POWERS, JAMESON, JACK DANIELS) and place names (BUSHMILLS, GLENLIVET, MIDDLETON).

27. Austin Nichols claims that, in addition to its inherent distinctiveness, WILD TURKEY has acquired a factual distinctiveness by virtue of the use that has been made of it but Lodestar disputes this claim insofar as it relates to this jurisdiction. The evidence on the point is to be found in Mr. Lalla's Statutory Declaration filed under Rule 20, which is summarised in paragraph 8 above. In my opinion, that evidence does not support a claim to an enhanced level of distinctiveness over and above that which is inherent in the mark itself. There is no evidence as to the size of the whiskey market in the State but I cannot imagine that average sales of 4,500 bottles per annum constitute a significant share of that market. Nor is there a basis, in my view, for finding that Mr. Lalla's claims with regard to the worldwide sales of WILD TURKEY (most of which have taken place in its home market of the United States of America) have resulted in the name becoming particularly well known in this jurisdiction.

The average consumer and the circumstances of product selection

28. Alcohol may be purchased legally by persons of 18 years and over and the average consumer for present purposes is, therefore, the average adult person. The product selection process depends to some extent on the particular category of alcoholic beverage in question, whether wines, beers or spirits, but, on the whole, it may be said that the average consumer looks for a product that suits both his taste and his pocket. Alcohol is a product that is consumed on an habitual basis by the majority of those who use it and a certain degree of brand loyalty may be assumed on the part of consumers; in other words, people tend to know what they

want and the average consumer may be expected to exercise a reasonable level of care in making his selection.

29. In the context of off-licence sales, the consumer chooses between various brands that are displayed for viewing on open shelves so that the visual characteristics of the trade marks are more significant than the aural in determining the likelihood of confusion. In the case of consumption on licensed premises, on the other hand, the desired brand must be asked for by name and it is the aural similarity that matters most. In the latter scenario, the consumer is essentially asking to be served a brand that he already knows and confusion is really only likely through miscommunication or mishearing on the part of the bar person. In either scenario, a strong conceptual similarity as between different trade marks may serve to create an association between them in the mind of the consumer. That is particularly true in the present case, which is concerned with word trade marks conveying meaningful concepts such that their respective brand identities are created by the concepts they evoke rather than simply by their look or sound

Likelihood of confusion, including confusion by association

30. Having regard to all of the foregoing considerations, I have tried to assess the likelihood of confusion arising in a scenario in which the average consumer, who has some familiarity with the WILD TURKEY brand used in relation to alcoholic drinks, is exposed to the same goods bearing the trade mark WILD GEESE in an outlet where those goods are typically sold, either a bar or an off-licence. I have reached the conclusion that confusion is unlikely in that scenario. In my opinion, the visual, aural and conceptual differences between the trade marks are so obvious that a person exercising reasonable care would be unlikely to select or be served WILD GEESE in place of WILD TURKEY. The trade marks do not look or sound sufficiently similar to make direct confusion between them a real likelihood. As to the possibility of conceptual confusion, I would say that the impression likely to be left on the mind of the average person by exposure to the trade mark WILD TURKEY is so strong as to make it unlikely that he would remember it in the vague way, as suggested on behalf of Austin Nichols, as “wild something” or “some wild bird”. Even allowing for imperfect recollection, confusion seems unlikely because the distinctive and dominant features of WILD

TURKEY, which create its lasting impression, are not reproduced or really suggested in WILD GEESE.

31. Nor do I think it likely that the average person would assume an association between WILD TURKEY and WILD GEESE because of their alleged conceptual connection. The notion that WILD GEESE might be a new line of products from the makers of WILD TURKEY seems to me to not accord with the norms of brand exploitation or extension, in which the essential identity of the “parent” mark is clearly preserved and capitalised on in the later mark. There is an insufficient conceptual link between WILD TURKEY and WILD GEESE, given their ordinary meanings, to suggest a connection between the goods that would amount to confusion by association of the marks.

32. At the hearing, Mr. Kennedy suggested that confusion could easily arise in a scenario in which a person, having attended a dinner party and noticed that his host drank WILD TURKEY whiskey, decided subsequently to buy him a bottle as a gift. He suggested that such a person might well, through imperfect recollection, purchase a bottle of WILD GEESE whiskey because of the conceptual connection between the two brands. I do not agree that such a possibility constitutes a valid basis on which to hold that WILD GEESE is precluded from registration by virtue of Section 10(2)(b) of the Act. For one thing, I do not think that the scenario suggested, in which the consumer has a kind of vague, “second-hand” awareness of the earlier mark, represents the model against which the likelihood of confusion is to be assessed. If one assumes a lack of any real knowledge of the earlier trade mark on the part of the consumer, then a likelihood of confusion may be inferred even in the case of the use of a quite different mark. Also, the assumption that WILD GEESE would trigger a mistaken recollection of WILD TURKEY relies on the proposition that the impression likely to be formed by a fleeting exposure to the latter mark is merely of some wild bird or other. As I have already stated, I do not accept that proposition. The identity of the trade mark WILD TURKEY is firmly rooted in the identity of the bird that it actually names, i.e., a turkey, and the striking aspect of the name is that it is, specifically, a wild turkey. If, therefore, one is to assume an imperfect recollection only of the trade mark based on a passing exposure to it, one must, nevertheless, assume recollection of the

impression given by the word “turkey”. That concept is not reproduced in WILD GEESE and I do not agree that confusion between the marks is likely even in the scenario suggested on behalf of Austin Nichols.

33. In reaching this conclusion, I have taken account of the fact that WILD TURKEY is an inherently distinctive trade mark and that the likelihood of confusion arising from the use of a similar mark is increased accordingly. I have decided, however, that the feature of WILD TURKEY that gives it its distinctiveness as a trade mark is not to be found in WILD GEESE and that, in the present case, the similarity of the marks is more superficial than real such that confusion is not likely in practice. For these reasons, I have decided that the objection raised under Section 10(2)(b) against the continued registration of Lodestar’s marks Nos. 203925 and 208660 and the protection of its International Registrations Nos. 737715 and 814790 is not supported and should be dismissed.

Absolute grounds objections

Trade mark of such a nature as to deceive

34. Section 8(3)(b) of the Act prohibits the registration of a trade mark that is of such a nature as to deceive the public, for instance as to the nature, quality or geographical origin of the goods or services in respect of which registration is sought. By virtue of Section 52(1), the registration of a trade mark may be declared invalid if the mark was registered in breach of that provision and Austin Nichols has sought invalidation of Lodestar’s registrations Nos. 203925 and 208660 on that basis, the reasons being as set out in paragraph 14 above, namely, that the trade mark WILD GEESE may connote Irish origin to certain consumers and that its use in relation to non-Irish goods would therefore serve to deceive such consumers.

35. I do not agree that Lodestar’s registrations may be declared invalid on that basis. The use in Section 8(3)(b) of the words “*of such a nature*” suggests that the prohibition on registration provided for in that Section relates to trade marks that are inherently deceptive as to some characteristic of the relevant goods or services. The Section does not provide a basis to refuse registration or to declare it invalid merely because of an incorrect inference that some consumers may draw

from the use of the mark, unless the clear and unmistakable message given by it supports that inference and permits of no other reasonable interpretation. In the present case, it seems to me to be perfectly reasonable to assume that, for those consumers who know their history, the use of the trade mark WILD GEESE will evoke memories of our national heritage but to say that such persons would be convinced that its use signified Irish origin in the relevant goods is to go too far. There is a difference between, on the one hand, evoking (and even appealing to) a sense of Irishness and, on the other, expressing as a statement of fact, *“these goods are of Irish origin”*. In my opinion, WILD GEESE clearly falls into the former category and cannot be said to be of a such a nature as to deceive, within the meaning of Section 8(3)(b) of the Act.

Bad faith


36. Section 8(4)(b) of the Act prohibits the registration of a trade mark if, or to the extent that, the application for registration is made in bad faith by the applicant. Once again, Section 52(1) provides for invalidation of the registration of a mark registered in breach of that provision. Although Austin Nichols laid a charge of bad faith against Lodestar in the notices of opposition and applications for declarations of invalidity as filed, it did not particularise that charge in any way in those documents. It has, rather, engaged in mere speculation in its evidence and oral submissions as to Lodestar’s motives in adopting the trade mark WILD GEESE, from which it invites me to infer a degree of impropriety amounting to bad faith. That is an entirely unacceptable manner in which to make, or seek to support, the very serious charge of bad faith and I have no hesitation in dismissing out of hand the objection raised under Section 8(4)(b) of the Act.

Tim Cleary

Acting for the Controller

19 February, 2008

Trade Mark Registrations relied on by Austin Nichols

No.	Mark	Date	Class/Goods
74596		30/07/1968	Class 33 Whiskey
186452 ⁸	WILD TURKEY	01/04/1996	Class 33 Alcoholic beverages

⁸ Community Trade Mark