

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

In the matter of an application for registration of Trade Mark No. 247977 and in the matter of an Opposition thereto.

EMMET LYNCH

Applicant

WILLIAM GRANT & SONS IRISH BRANDS LIMITED

Opponent

(Represented by FRKelly)

The Application

1. On 5 April, 2012, Emmet Lynch, of Kilbride Street, Tullamore, Co. Offaly, Ireland made application (No. 2012/00606) under Section 37 of the Trade Marks Act, 1996 (“the Act”) to register the terms “LYNCH’S TULLAMORE BREW” and “LYNCHS TULLAMORE BREW” as a series of 2 trade marks in respect of “*Beers; stout, ale, lager, porter, pills and shandy*” in Class 32. For simplicity sake I shall refer hereafter to both marks as “LYNCH’S TULLAMORE BREW”.
2. The application was accepted for registration and advertised accordingly under No. 247977 in Journal No. 2218 dated 19 December, 2012.
3. Notice of Opposition to the registration of the marks pursuant to Section 43 of the Act was filed on 15 March, 2013 by William Grant & Sons Irish Brands Limited (hereinafter referred to as “WGSIBL”)“, an Irish company, of 4th Floor, Block D, Iveagh Court, Harcourt Road, Dublin 2, Ireland. The Applicant filed a counter-statement on 19 June, 2013 and evidence was, in due course, filed by the parties under Rules 20, 21 and 22 of the Trade Marks Rules, 1996 (“the Rules”).
4. Both parties filed written submissions in lieu of attending a hearing in the matter, and both parties filed written submissions in reply to the other party’s submissions. Acting for the Controller, I decided to dismiss the opposition and to allow the application to proceed to registration. I now state the grounds of my decision and the materials used in arriving thereat in response to a request by the Opponent in that regard pursuant to Rule 27(2) of the Trade Mark Rules 1996.

Grounds of the Opposition

5. In its Notice of Opposition the Opponent refers to its proprietorship of Irish Trade Mark TULLAMORE DEW, registered under No. 40514 as of 18 September, 1945 in respect of “*Whiskey blended in Ireland*” in Class 33, and of its identical Community Trade Mark No. 4525499, with a date of registration of 3 July, 2006 in respect of “*Alcoholic beverages (except beers)*”, also in Class 33. The Opponent then raises objection to the present application under Sections 6, 8, 10 and 37 of the Act, which I shall summarise as follows:

- Section 6(1) - *the mark does not fall within the definition of a trade mark;*
- Section 8(1)(b) – *the mark is devoid of any distinctive character;*
- Section 8(1)(c) – *the mark consists exclusively of signs or indications which may designate characteristics of the goods;*
- Section 8(4)(a) – *use of mark is prohibited by enactment or rule of law;*
- Section 10(2)(b) – *likelihood of confusion on the part of the public, and likelihood of association with the Opponent’s TULLAMORE DEW mark;*
- Section 10(3) – *use of mark would take unfair advantage of, or be detrimental to, distinctive character or reputation of the Opponent’s mark;*
- Section 10(4)(a) – *use of the mark is liable to be prevented by virtue of the law of passing off;*
- Section 37 – *the Applicant is not using the mark applied for, nor does he have a bona fide intention to use the mark.*

In its Notice of Opposition the Opponent also claims the mark applied for is contrary to Council Directive No. 89/104 EEC to approximate the laws of the Member states relating to trade marks and that the application should be refused in accordance with the judgement and/or discretion of the Controller.

Counter-Statement

6. In its Counter-Statement the Applicant denies all the grounds of opposition and only admits that the Opponent is the registered proprietor of the marks cited in the Opponent’s Notice of Opposition. The Applicant calls on the Opponent to provide proof of its claimed extensive use of its trade mark TULLAMORE DEW and to provide evidence to support all the grounds upon which the opposition is based.

Rule 20 Evidence

7. Evidence submitted by the Opponent under Rule 20 consists of a Statutory Declaration, dated 23 December, 2013, of Enda O’Sullivan, a Director of WGSIBL. Mr. O’Sullivan attaches to his declaration, at Exhibit 1, a declaration of James Hoyne, also a Director of WGSIBL, who in turn attaches ten exhibits, labelled “Annex 1” to “Annex 10” to his declaration. The sole purpose of Mr. O’Sullivan’s Statutory Declaration is to confirm that the contents of Mr. Hoyne’s declaration and accompanying exhibits are correct and reflect the true position regarding the trade mark TULLAMORE DEW.
8. For his part Mr. Hoyne states his company’s TULLAMORE DEW whiskeys are some of Ireland’s finest and the world number 2 selling Irish whiskey by volume. The whiskey was first distilled in 1829 in Tullamore, County Offaly, with the name having derived from the initials of an early owner, Daniel E Williams (DEW). He states WGSIBL owns trade mark registrations for TULLAMORE DEW and TULLAMORE D.E.W. in over 80 countries and that TULLAMORE DEW is one of the fastest growing Irish whiskey brands, having almost doubled its worldwide sales to 850,000 cases (10.2 million 70cl bottles) since 2005.
9. In support of WGSIBL’s claims of extensive use and reputation in its mark he provides the following:
 - A table showing sales of TULLAMORE DEW by number of 9 litre cases in various countries in 2011 and a table showing sales of the product in Ireland from 2011-2013 (Annex 1).
 - Examples of advertising posters for TULLAMORE DEW (Annex 2).
 - Details of various awards won across the globe by TULLAMORE DEW whiskey between 2000 and 2011, including 28 Gold Medals in the last 10 years (Annex 3).
 - Details of trade mark registrations for TULLAMORE DEW and TULLAMORE D.E.W. worldwide (Annex 4).
10. He provides material to support his claims of use and reputation in the TULLAMORE DEW mark in Ireland, stating, *inter alia*, that WGSIBL have spent more than £1.3 million on advertising the brand in Ireland between 2007 and 2013. At Annex 5 he attaches two virtually identical letters from Aoife Clarke, one in her capacity as Senior Executive of the Irish Business Employers’ Confederation and the other in her capacity as Senior Executive of the Alcohol Beverage Federation of Ireland certifying that WGSIBL is a member of both

organisations and that TULLAMORE DEW is a mark which is well known in Ireland and throughout the world.

11. Annex 6 consists of a review of TULLAMORE DEW by the Irish Whiskey Society in 2011.
12. Mr. Hoyne states that since purchasing the brand TULLAMORE DEW in 2010 the Opponent has invested a considerable (unspecified) amount in promoting and growing the brand in Ireland and worldwide. In Ireland, in particular, the Opponent invested more than €35 million in developing a brand new distillery in the town of Tullamore, so as to return manufacture of TULLAMORE DEW to where the whiskey was originally produced. He states the new facility is due to open in 2014. Annex 7 contains examples of the publicity in respect of the new distillery in various Irish publications.
13. He avers that, in addition to the construction of a new distillery, the Opponent has invested in a new Tullamore Dew Heritage Centre on the site of the old distillery in Tullamore, which has attracted more than 170,000 visitors since 2000. Also, TULLAMORE DEW has sponsored local and national cultural events for a number of years. He attaches at Annex 8 evidence of TULLAMORE DEW's involvement for a second year with the Castlepalooza music and arts festival in Tullamore in 2013.
14. At Annex 9 Mr. Hoyne attaches evidence of the TULLAMORE DEW brand being featured across a wide range of print and other media in direct advertising, promotion events and various articles and features on the Irish whiskey industry. This, he says, shows that TULLAMORE DEW is widely known to the Irish public.
15. Annex 10 consists of various images of TULLAMORE DEW which are available in Ireland, as well as examples of packaging and point of sale advertising of TULLAMORE DEW in Ireland.

Rule 21 Evidence

16. Evidence submitted by the Applicant under Rule 21 consists of a Statutory Declaration dated 7 April, 2014 and four exhibits marked "EL1" to "EL4", of Emmet Lynch, of Kilbride Street, Tullamore, County Offaly. He states he is a publican and operates "Hugh Lynch's" public house on Kilbride Street, Tullamore. The property has operated as a public house since the early 1800's. His parents Hugh and Mary Teresa Lynch took over the pub in the 1960's and it

has remained in the Lynch family ever since. The pub attracts customers of all ages and has won many awards over the last few years.

17. Mr. Lynch states that in or around 2012 he became interested in micro brewing and brewpubs. He explains the difference between a microbrewery and a brewpub is that a brewpub is a fully licenced public house that brews its own beer on the premises. He attaches at Exhibit “EL1” extracts from Wikipedia which set out a history of micro brewing and brewpubs.
18. He states that over the past number of years Ireland has experienced a revolution in micro-brewing and oftentimes the product names adapted by the microbrewery coincides with the geographical locations of the enterprise. He lists the Dublin Brewing Company, the Carlow Brewing Company, Blacks Brewery Kinsale, the Franciscan Well Microbrewery in Cork, Dwan Tipperary Brewing, and Balbriggan Brewing by way of examples. He attaches at Exhibit “EL2” extracts from the websites of some of these businesses.
19. Mr. Lynch deposes that the concept for LYNCH’S TULLAMORE BREW was born out of his interest in micro-brewing and brewpubs and in an attempt to diversify his business. He selected the name because (i) his surname is “Lynch”, (ii) he runs a pub in Tullamore called “Hugh Lynch’s” and (iii) he wished to produce his own beer like other brewpubs. He states he has not yet entered into production but hopes to do so in the coming years. He made his application for registration of the LYNCH’S TULLAMORE BREW mark in respect of Class 32 for “*Beers; stout, ale, lager, porter, pills and shandy*”. He did not apply to register it in Class 33 for whiskey as he has no interest in distilling whiskey.
20. He states that he received a letter of objection from the Opponent’s Trade Mark Agents, Wildbore & Gibbons LLP on 12 March 2013 to which he responded on 15 March 2013. He attaches at Exhibit “EL3” copies of the letters. The letter from the Opponent’s agents puts the Applicant on notice that an opposition, based on the similarity between the parties’ respective marks and a resulting likelihood of confusion, will be filed against the application if it is not withdrawn. Mr. Lynch’s reply denies that any likelihood of confusion exists and he provides an assessment of why he believes that is the case.
21. In the remainder of his declaration Mr. Lynch conducts a comparison between the respective marks and goods, and concludes there is no likelihood of confusion and that the respective goods are dissimilar. He states the Delhi High Court, in its judgment in *Radico Khaitan Ltd vs*

Carlsberg India Private Ltd, (attached alongside an extract from the Collins Paperback Dictionary at Exhibit “EL4”) having applied the test of identity of composition, identity of consumers, price range and class of consumers, held beer and whisky to be dissimilar goods.

Rule 22 Evidence

22. Evidence filed under Rule 22 consists of a Statutory Declaration of John Harvey, Director of WGSIBL. He submits that the Applicant has failed to file any relevant evidence in support of the Application. He states the majority of the Statutory Declaration of Emmet Lynch contains information which is irrelevant to the proceedings and goes on to identify those specific elements. In particular he points out that the evidence filling stage is not the appropriate time to present legal arguments. He refutes the arguments advanced but indicates that they will be addressed in full at the appropriate stage of the proceedings,
23. He notes the Applicant’s explanation of the derivation of the mark applied for, but questions why the Applicant, who runs a business named “Hugh Lynch’s” did not consider use of the marks “Hugh Lynch’s Brew” or “Lynch’s Brew”.
24. Mr. Harvey states the Applicant has not put the disputed mark to use in Ireland in relation to any products. However, at the date of application the opponent had over 180 years use of its TULLAMORE DEW trade mark. Therefore, the Applicant must have been aware of the significant reputation attached to the TULLAMORE DEW trade mark within the State. He also notes that none of the evidence filed in Enda O’Sullivan’s Statutory Declaration has been refuted by the Applicant.
25. He also questions the relevance of each and every exhibit attached to the declaration of Emmet Lynch. In response to the claim by Mr. Lynch that “*the choice of name often coincides with the location of where the microbrewery is situated*” and for which Mr. Lynch offers Dublin Brewing Company and Carlow Brewing Company by way of examples, Mr. Harvey points out that the Applicant did not apply for Tullamore Brewing Company, but LYNCH’S TULLAMORE BREW.

Written submissions in lieu of attending at a hearing

26. Some space was taken up in written submissions of the parties in dealing with the admissibility of evidence adduced by the Opponent. The Applicant claimed the Opponent has no right to adduce the evidence it submitted as the Opponent was not the owner of the trade

mark TULLAMORE DEW. In reply the Opponent provided details regarding the structure of the various companies and their subsidiaries that make up the William Grant & Sons Group. While the structure is somewhat complicated and involves many layers, I am satisfied that all of the Opponent's evidence is admissible.

27. In its evidence the Opponent draws attention to the Applicant's application, which was lodged on the same day as the disputed mark, to register TULLAMORE BREW. The Opponent points to this as being relevant to these proceedings in that it shows the Applicant was attempting to ride on the coat-tails of the reputation of the Opponent's brand. However, that application was withdrawn and it cannot in any way be considered relevant to my determination of the matter at hand, and I need not say anything further regarding it.

28. In its written submission, filed in lieu of attending at a hearing, the Opponent confined its arguments to the grounds of opposition relating to Sections 10(2)(b), 10(3) and 10(4)(a) of the Act and it is upon these sections that I have decided the matter.

29. Both parties undertook an assessment of the application and what they perceive to be the relevant factors and, unsurprisingly, reached contrary conclusions as regards the registrability of the disputed mark. Each referred to various court judgements and decisions of the Controller and the Office for Harmonisation in Internal Market (OHIM) in support of their position.

Section 10(2) – likelihood of confusion

30. The relevant part of Section 10(2) of the Act, insofar as the present application is concerned, reads 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 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 of the later trade mark with the earlier trade mark.

31. 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)¹ and their applicability in an Irish context has been affirmed by the High Court (Finlay Geoghegan J) in *Cofresco Frischalteprodukte GmbH & Co. KG –v- The Controller of Patents, Designs and Trade Marks and Reynolds Metals Company*². In summary, the relevant principles are:

- (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 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.

32. There are four basic requirements which must be met in order for an objection under Section 10(2)(b) to succeed. The first of these conditions is there must be an earlier mark. The Opponent's Irish trade mark registration No. 40514 was filed on 18 September, 1945 and its Community Trade Mark was filed at the OHIM on 6 July, 2005. By virtue of Section 11(1)(b)

¹ 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 Schufabrik Meyer & Co. GmbH v Klijsen Handel BV*

of the Act, they are clearly earlier trade marks as against the present applications for the purposes of Section 10.

Similarity of the goods

33. The parties differ on the second requirement concerning the identity or similarity between the respective goods. The Opponent argues the goods must be considered identical if not similar and relies upon a number of authorities, including the decision of the Controller in *ARCHERS*³ where, in comparing the goods at issue in that case, the Hearing Officer found as follows:

“The goods of the present application are also clearly similar goods to those in respect of which the earlier trade mark is protected. Apart from the fact that they fall within the same Class, they share the same nature (alcoholic beverages), purpose (for recreational drinking), consumers (aimed at all persons of legal age) and channels of trade (sold through licensed premises and off-licenses) and they are competing products insofar as the targeted consumer may choose one in preference to the other. Of course, a cider is not a wine, a spirit or a liqueur and it is fair to assume that the average person knows that its ingredients and methods of production are different to those other beverages. However, for the purposes of the proceedings, which call for a comparison of the goods in the context of the assessment of likelihood of confusion on the part of the public, I am satisfied that the respective goods should be regarded as highly similar.”

34. Also, the Opponent quotes from the OHIM Guidelines for Examination wherein “*beers in Class 32*” and “*alcoholic beverages (except beers) in Class 33*” are specifically mentioned as being similar.

35. For its part the Applicant relied upon a decision of the Delhi High Court in *Radico Khaitan Ltd. v. Carlsberg India Private Limited*⁴ where the learned judge found that alcoholic spirits in Class 33, like whiskey, rum and gin are not similar to beers and the like in Class 32.

36. It is accepted that the factors to be considered in determining whether goods are similar are (i) the nature and purpose of the goods, (ii) the end users of the goods, (iii) the methods of use, (iv) the channel through which the goods are traded and (v) whether the goods are complimentary or in competition with one another. As well as these factors I must also consider the reality of the marketplace for the goods in question.

² unreported decision dated 14 June, 2007

³ Decision of the Controller of 30 July, 2007 in an opposition by Diageo Brands B.V. to an application by Henry J Archer to register ARCHERS logo.

⁴ 2012 (49) PTC 54 (Del.)

37. Consumers of the goods at issue (alcoholic beverages for recreational consumption) are adults who have distinct preferences when it comes to alcohol. The vast majority have a fondness for a particular type of alcoholic drink (e.g. ale, stout, lager, whiskey, vodka, gin, rum, wine etc.) and have strong brand loyalty within their preferred category. Whiskey producers generally compete for the custom of whiskey drinkers and beer producers compete for the business of beer consumers. If someone's favourite beer was unavailable in a bar, restaurant or off-licence it is highly unlikely that they would select a whiskey instead. It is most likely they would select a different brand of beer. The goods protected by the respective marks are proper to different classes of the Nice Classification and the specification of the Opponent's marks specifically excludes beer. Furthermore, the respective goods are created using different methods of production.
38. The Opponent argues the respective goods are complementary and often consumed together in the form of a beer cocktail or in quick succession as a whiskey chaser. It also claims that breweries and distilleries have experimented with the idea of whiskey and beer crossovers, an example being the Carlow Brewing Company's production of a whiskey barrel-aged barley wine beer. The Opponent also suggests some breweries/distilleries have gone a step further using both brewing and distilling methods to create new products (five examples of where this is happening were given, 4 from the USA and 1 from Japan).
39. On the other hand, the Applicant argued that in hundreds of years of distilling in Ireland not one distillery has ever manufactured a beer. The Opponent itself has been distilling whiskey for over 180 years and has never ventured into brewing.
40. I do not agree that the goods are complementary. In Ireland beers and spirits are not generally combined in an attempt to bring out the best in one another or to increase the enjoyment of either. They may be drunk alternately but not in the same mouthful. The use of whiskey barrels to age beer is purely to infuse into the beer a hint of whiskey essence, but the end product cannot be considered to be a blend of whiskey and beer. It strikes me the Opponent is losing the argument regarding the use of both brewing and distilling methods to produce new products if it can find no examples of such activity closer to home than the USA and Japan. It is the average Irish consumer that concerns me in these proceedings and I am satisfied that he or she would understand that breweries do not distil whiskey and distillers do not brew beer.

41. Nonetheless most drinkers, even the most brand-loyal consumers, will on occasion drink a variety of different types of alcoholic drinks. For example, on a night-out or at a wedding, it would not be unusual to have a glass of wine with a meal, a beer afterwards and, maybe, even finish the night with a spirit. Bearing in mind all the foregoing, I consider the respective goods to be very similar. But they are not complementary or identical.

Similarity of the marks

42. Turning now to the third requirement – the mark applied for must be similar to the earlier mark. I have compared the respective marks on the criteria of visual, aural and conceptual similarity and have attempted to make an overall assessment of the extent to which they should be regarded as similar or different. It is important to stress that this is an assessment of the overall impression the marks make on me, having put myself in the shoes of the average consumer of the goods for which the Applicant is seeking protection. Notwithstanding the detailed comparisons I make below above I am mindful that the European Court of Justice has noted (*Sabel BV v Puma AG and Rudolf Dassler Sport Case C-251/95*) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. For this reason, the appreciation of the visual, aural and conceptual similarity of the marks must be based on the overall impressions given by them, rather than on specific points of detail that are likely to go unnoticed by the average consumer.

43. Again, in their respective written submissions, the parties conduct an assessment of the marks and reach different conclusions. The Opponent claims an average consumer perceiving the Applicant's mark will break it down into elements with concrete meanings or elements that resemble known words and will thus break the mark at issue down into the elements LYNCH'S and TULLAMORE BREW. This claim sets up the Opponent's argument that its mark is almost wholly reproduced within the Applicant's marks and leads the Opponent to compare the present proceedings to those in the THOMSON LIFE / LIFE case⁵ wherein the Court of Justice of the European Union (CJEU) found, *inter alia*, the following:

“30. However, beyond the usual case where the average consumer perceives a mark as a whole, and notwithstanding that the overall impression may be dominated by one or more components of a composite mark, it is quite possible that in a particular case an earlier mark used by a third party in a composite sign including the name of the company of the third party still has an independent distinctive role in the composite sign, without necessarily constituting the dominant element.”

⁵ Medion AG v Thomson Multimedia, case C-120/04

31. In such a case the overall impression produced by the composite sign may lead the public to believe that the goods or services at issue derive, at the very least, from companies which are linked economically, in which case the likelihood of confusion must be held to be established.

...

36. It must therefore be accepted that, in order to establish the likelihood of confusion, it suffices that, because the earlier mark still has an independent distinctive role, the origin of the goods or services covered by the composite sign is attributed by the public also to the owner of that mark.”

44. Continuing with the theme of an earlier mark having an independent distinctive role in a composite mark the Opponent draws similarities with OHIM decisions wherein LEI LEI'S BY BANANA MOON was partially refused on foot of the earlier BANANA MOON⁶ mark and wherein BODEGA SANTA CECILIA was also partially refused on the basis of the earlier SANTA CECILIA⁷ mark.
45. The Opponent argues that visually the marks are highly similar. Both contain the word TULLAMORE and each of their last words, which contain only 3 and 4 letters, end in “EW”. When assessed phonetically the TULLAMORE DEW and TULLAMORE BREW elements are quite close. Conceptually the respective marks relate to alcoholic beverages from Tullamore. The Opponent acknowledges the term LYNCH'S is placed at the beginning of the Applicant's mark but submits that from a conceptual perspective this does not alter the meaning of the term TULLAMORE BREW which clearly suggests an alcoholic beverage from Tullamore.
46. The Applicant rejects the Opponent's arguments and contends the words LYNCH'S and BREW are the respective distinctive and dominant components of the application, which are obviously visually dissimilar to the Opponent's mark. Aurally the marks differ in that the LYNCH'S element does not appear in the Opponent's mark and BREW sounds different to DEW. He argues that conceptually the marks convey completely different messages.
47. I do not accept the Opponent's arguments that these proceedings are comparable to those before the CJEU in Medion⁸. It is clear to me the Court reached its conclusions on the basis of the presence of the entire of the earlier mark in the later mark. The Opponent's claims that the similarity between the respective marks makes this case comparable to Medion are not

⁶ OHIM Board of Appeal Decision R1774/2008-2

⁷ OHIM Opposition Division No. B2250713

sustainable and must be rejected. In these proceedings the entire of the Opponent's mark is not present in nor does it have an independent distinctive role in the Applicant's mark. Therefore the circumstances of Medion are not repeated here and I cannot apply the reasoning of the Court to the present case.

48. I must conduct an overall assessment of the marks as a whole, and in doing so pay attention to the dominant and distinctive elements of each. In my opinion, the dominant element of the Opponent's mark is the word TULLAMORE. The most inherently distinctive element is the word DEW, but the TULLAMORE element, despite merely being a geographic location, has acquired substantial distinctiveness in respect of whiskey products by virtue of the use made of the mark. Consumers are familiar with the use of place-names on Irish whiskey products, and as well as the Opponent's brand there are Bushmills, Midleton, Kilbeggan, Tyrconnell and Clontarf to name a few. At the relevant date I am satisfied the word TULLAMORE dominates the Opponent's mark.
49. The disputed mark also contains the word TULLAMORE but it does not dominate the mark nor is it the most distinctive element. It is merely a reference to the location of where the brewing is carried out. The word BREW is nothing other than a reference to the goods and therefore does not have a distinctive or dominant role. The LYNCH'S element dominates the mark and is the most distinctive element. The use of family names as a brand is common in brewing, with Irish consumers being very familiar with Guinness, Smithwicks, Murphy's and others. The dominant and distinct elements of the respective marks differ, which I must bear in mind when assessing the degree to which they might be considered similar.
50. The Opponent questions why the Applicant did not apply to register the marks HUGH LYNCH'S BREW or simply LYNCH'S BREW instead of the disputed mark. It is obvious that these two terms would not in any way fall foul under Section 10(2)(b) on the basis of the Opponent's early TULLAMORE DEW mark. It is clear the Opponent takes exception to the insertion of the word TULLAMORE between LYNCH'S and BREW. However, in the present case there is more to the mark at issue than the word TULLAMORE. I have already found that the TULLAMORE element does not dominate the Applicant's mark, but that the LYNCH'S element does. I must also consider what the CJEU has to say in *LIMONCELLO*⁹, where in that case, in the context of consideration of the likelihood of confusion, and where

⁸ Medion AG v Thomson Multimedia, case C-120/04

⁹ OHIM v Shaker Case C-334/05 P -

there was one common element between two composite marks, the Court found at paragraphs 41-42 as follows:

“41. ...assessment of the similarity between two marks means more than taking just one component of a composite trade mark and comparing it with another mark. On the contrary, the comparison must be made by examining each of the marks in question as a whole, which does not mean that the overall impression conveyed to the relevant public by a composite trade mark may not, in certain circumstances, be dominated by one or more of its components (see order in Matratzen Concord v OHIM, paragraph 32; Medion, paragraph 29).

42. As the Advocate General pointed out in point 21 of her Opinion, it is only if all the other components of the mark are negligible that the assessment of the similarity can be carried out solely on the basis of the dominant element.”

51. Clearly with the word TULLAMORE appearing in both marks there must be some degree of similarity. Looking at the other elements of the marks I am satisfied there is more aural similarity between the words BREW and DEW than there is visual similarity. The obvious visual and aural difference between the marks is the presence of the name LYNCH’S in one and the absence of it in the other. I would assess the aural similarity as being medium and the visual similarity as being low to medium.
52. Much focus is put on the aural similarity between the respective marks, and rightly so, but in my opinion, the typical scenarios put forward in arguments are not the proper test. The appropriate test concerns how the consumer processes what they hear. It is whether the consumer, who is familiar with goods marketed under the Opponent’s earlier mark and, having heard of goods being marketed under the Applicant’s later mark, is likely to believe the latter goods are associated with the proprietor of the goods with which he is familiar. In making that call the consumer will be considering either purchasing the latter goods, believing them to be of the standard he has come to expect of goods bearing the earlier mark, or avoiding the goods based on a previous bad experience of the goods sold under the earlier mark. It is about the consumer’s impression, not about what the shop assistant, bartender or telephone salesperson the consumer speaks to might think, hear, or think they hear. Of course in turn the shop assistant, bartender or telephone salesperson might also be a consumer but when so, it is their impression that counts and not that of the person who is fulfilling their order.
53. Conceptually both marks refer to something from Tullamore - the largest town in County Offaly. The Applicant’s mark clearly refers to the output from a brewing process. But it is not

just any brew from Tullamore, it is a brew from Tullamore produced by LYNCH'S. The word DEW in the Opponent's mark does not of itself evoke anything to do with brewing or distilling and as such it possesses a degree of inherent distinctiveness in respect of alcohol products. The Opponent explains in its evidence that the term DEW derives from the initials of a past owner of the distillery in Tullamore whose name was Daniel E. Williams. I am aware of some references to the word DEW being used informally to describe Whisky in Scotland or being placed after the word mountain to describe illegal liquor or moonshine in the USA. But neither use appears in common parlance in the drinks trade in Ireland and for obvious reasons the Opponent would not wish its brand to be associated with either of those two products. In reality the term DEW has only one dictionary meaning, i.e. "*moisture condensed from the atmosphere, especially at night, and deposited in the form of small drops upon any cool surface*". Conceptually the Opponent's mark brings to mind the dew that forms in Tullamore and nothing else. I would assess the degree of conceptual similarity between the marks as extremely low.

54. Having completed a global comparison of the marks I am satisfied the marks are far more dissimilar than they are similar. Overall, in my opinion, the marks share a low level of similarity.

Likelihood of confusion

55. The criteria against which the question should be answered has been enunciated in a number of decisions of the European Court of Justice¹⁰ in this area and include the following:

- i. a lesser degree of similarity between the goods may be offset by a greater degree of similarity between the marks, and vice versa,
- ii. the more distinctive the earlier mark, the greater will be the likelihood of confusion,
- iii. in determining the distinctive character of the earlier mark, it is necessary to make an overall assessment of its capacity to identify the goods for which it is registered as coming from a particular undertaking and thus to distinguish those goods from those of other undertakings,
- iv. in making that assessment, account should be taken of the inherent characteristics of the mark; the market share held by it; how intensive, geographically widespread and long-

¹⁰ *Sabel BV –v- Puma AG and Rudolph Dassler Sport* (Case C-251/95) [1998] 1 CMLR 445; *Canon Kabushiki Kaisha –v- Metro-Goldwyn-Mayer Inc.* (Case C-39/97) [1999] 1 CMLR 77; *Lloyd Schuhfabrik Meyer & Co. GmbH –v- Klijsen Handel BV* (Case C-342/97) [1999] 2 CMLR 1343

standing use of the mark has been; the amount invested in its promotion; the proportion of the relevant public which, because of the mark, identifies the goods as originating from a particular undertaking; and statements from chambers of commerce and industry and other trade and professional associations,

- v. a global appreciation of the likelihood of confusion must, as regards the visual, aural and conceptual similarity of the marks in question, be based on the overall impression created by them, and the importance to be attached to each of those elements must take account of the category of goods and the way in which they are marketed,
- vi. the assessment must be made from the perspective of the average consumer who is deemed to be reasonably well-informed, observant and circumspect but who rarely has the chance to make a direct comparison of the marks and must rely on the imperfect picture that he has of them in his mind,
- vii. the likelihood of confusion must be appreciated globally, taking into account all of the factors relevant to the circumstances of the case.

56. In applying those criteria to the facts of the present case, I have reached the following conclusions:

- (a) The Opponent's mark has an obvious capacity to identify the goods for which it is registered as being those of a particular undertaking and thus to distinguish those goods from those of other undertakings.
- (b) The Opponent's mark is long established, recognised easily and known in the State. It is readily associated with spirits, in particular whiskey. I am satisfied it has acquired substantial additional distinctiveness through use and promotion in respect of those products.
- (c) The goods may be purchased legally by persons of 18 years and over and the average consumer for present purposes is, therefore, the average adult person. 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 must 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 a selection.
- (d) The overall impression created by the marks in question is that they are different. Visually and verbally they are more different than similar. Conceptually the marks are almost completely different.

(e) For the reasons set out in paragraphs 42-54 above, I regard the marks in question as having a low level of similarity. However, the goods covered by the Application are very similar to the goods of the earlier registrations, which means the lower level of similarity between the marks could be offset by the higher degree of similarity between the goods, and in theory could allow for a finding that a likelihood of confusion exists.

57. The basic ingredients of an objection under Section 10(2)(b) of the Act – *earlier trade mark, (to some extent) similar marks and similar goods* – are all present in this case and the issue now rests on whether, as a consequence, there is a likelihood of confusion on the part of the public.

58. It is not a question of whether the average consumer would be likely to actually mistake goods of the kind covered by the application for registration with those in respect of which the earlier mark stands protected. In other words, it is not a question whether a person who sets out to purchase whiskey ends up buying beer instead, simply because the latter product is marketed under a similar brand name. Nor, contrary to the Opponent's assertions, is it a question of whether a bartender in a noisy bar might mishear a customer's order and present an unwanted pint of beer when the customer sought a glass of whiskey, which is simply an everyday human error as distinct from confusion as to the commercial origin of a product.

59. Neither question is a valid test of the likelihood of confusion and both would be misrepresentations of the purpose and effect of the prohibition on registration effected by Section 10(2)(b) of the Act. The kind of confusion the Section seeks to avoid is concerned solely with the commercial origin of goods, whereby the average consumer, being familiar with goods sold under the earlier mark and, because of the similarity in the respective marks, attributes to the goods offered under the disputed mark the qualities and characteristics that he associates through experience with the goods offered under the earlier mark.

60. Correctly stated, the question is whether the average person, who knows of whiskey, spirits and the like sold under the TULLAMORE DEW brand and who then encounters *beers; stout, ale, lager, porter, pills or shandy* for sale under the LYNCH'S TUILLAMORE BREW trade mark, would assume that the latter goods were connected with the former in the sense that they were both put on the market by the same undertaking or by commercially related undertakings.

61. I am required to make an overall assessment of the likelihood of confusion that may exist. The confusion in question may be direct confusion, whereby the Applicant's services are mistaken for those of the Opponent, or indirect confusion, whereby the Applicant's goods are associated in the mind of the consumer with that of the Opponent and a common commercial origin is inferred. I must look at the question of likelihood of confusion from a practical perspective in the context of the marketplace and put myself in the shoes of the average consumer.

62. I have applied the aforementioned criteria to the facts of the present case and have reached the conclusion that there is no likelihood of confusion. The marks share an overall low degree of similarity and, while the respective marks contain the word TULLAMORE, there are two words in the disputed mark which are not present in the earlier mark. But, undoubtedly in my opinion, sufficient distance is put between the respective mark by the presence of the word LYNCH'S, which holds a prominent position in the disputed mark and also dominates it, and the presence of the word BREW which, while sharing some degree of visual and aural similarity to the DEW element of the Opponent's mark, is conceptually completely different.

63. There is clearly more dissimilarity between the respective marks than the goods. I am conscious of the principle that a lesser degree of similarity between the marks can be offset by the greater degree of similarity between the goods. However in this case the differences between the marks are so stark that the gap required to find a likelihood of confusion would arise has not been bridged.

64. In light of all the foregoing I am satisfied the average consumer would not be likely to be confused as to the origin of the goods or to believe that such goods were produced by an undertaking associated with the proprietor of the TULLAMORE DEW mark. Therefore, I reject the opposition based on Section 10(2)(b) of the Act.

Section 10(3)

65. There are a number of conditions which must be fulfilled in order for an opposition to succeed under Section 10(3) of the Act, which is written in the following terms:

“A trade mark which—

(a) is identical with or similar to an earlier trade mark, and

(b) is to be registered for goods or services which are not similar to those for which the earlier trade mark is protected,

shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the State (or, in the case of a Community trade mark, in the Community) and the use of the later trade mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier trade mark.”

66. Firstly, there must be identity or similarity of the marks at issue; secondly, there must be a dissimilarity between the respective goods¹¹; thirdly, the earlier mark must have a reputation in the State; fourthly, the use of the later trade mark must be without due cause; and fifthly, that use must take unfair advantage of, or be detrimental to, the distinctive character or reputation of the earlier marks.
67. I have already found that there is some similarity between the respective marks and the respective goods, and that the Opponent’s mark has gained a substantial reputation through the use made of it. It is not necessary for me to assess whether use by the Applicant of his LYNCH’S TULLAMORE BREW mark would cause damage to the distinctive character of the Opponent’s TULLAMORE DEW mark until I have found the Applicant does not have due cause to use his mark.
68. I address that issue now. The Opponent argues it cannot be expected to prove a negative fact, such as the absence of due cause, and submits the Applicant bears the burden of proof to show that it has due cause to use the mark applied for. The Opponent goes further and suggests the absence of any convincing evidence to justify the Applicant’s adoption of the mark must be presumed to constitute a lack of due cause. Furthermore, the Opponent highlights that the Applicant admits that use of the mark has not commenced, nor has the Applicant provided any justification for using the mark, such as a coexistence agreement permitting such use.
69. I agree with the Opponent that the onus is on the Applicant to explain why he believes he has due cause to adopt and use the mark. In his evidence the Applicant confirms his awareness of the Opponent’s mark but rejects the charge that he has not due cause to use his mark. In his evidence he explains (though in this case the explanation appears self-evident) that he choose the mark because his family name is Lynch, the title of his business contains the name Lynch, that business is located in the town of Tullamore and the goods upon which he proposes to use the mark are beer and like products.

¹¹ In light of the CJEU decision in Case C-292/00 *Davidoff* [2003] ECR I-389, it is now more correct to say that there is not a requirement that the goods be similar (although the provision is equally applicable in the case of similar goods).

70. I am completely satisfied that the use of one's family name (LYNCH'S), which is also the family name of the well-established public house run by the Applicant for many years, use of the name of the location (TULLAMORE) in which that family-named business has had a presence for decades, and a reference to the type of product (BREW) the business is producing constitutes due cause to use the mark LYNCH'S TULLAMORE BREW.

71. Having found the Applicant has due cause to use the mark, the question of whether or not use of the mark would cause damage to the Opponent's mark is purely academic, has no practical value and I need not address it. I find the application does not fall foul of Section 10(3) of the Act and, accordingly, I dismiss the opposition under that section.

Section 10(4)(a)

72. The final ground of opposition that falls to be considered is under Section 10(4) of the Act, the relevant part of which reads as follows:

"A trade mark shall not be registered if, or to the extent that, its use in the State is liable to be prevented – 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,"

73. I am satisfied that the determination of the objection under this Section requires consideration of whether, on 5 April, 2012 (the relevant date), the Opponent would have been able to establish the basic elements required to be shown to ground an action for passing-off if the Applicant had used the mark propounded for registration as a trade mark for any of the goods covered by the application. Adopting the test as enunciated by Lord Oliver in the House of Lords¹², and expressing it in the terms of this case, the questions to be considered may be put in the following terms:

- (i) Did the Opponent have a goodwill or reputation attached to goods which it supplies under its TULLAMORE DEW mark?
- (ii) If so, would the sale by the Applicant under the mark applied for of any goods covered by the application for registration have constituted a misrepresentation leading or likely to lead the public to believe that those goods were the goods of the Opponent?

(iii) If so, would the Opponent suffer damage by reason of that erroneous belief?

74. In order to succeed in its opposition under this Section, the Opponent must establish that the use by the Applicant of the said mark in relation to the goods covered by the application would have, as of the relevant date, constituted a misrepresentation that those goods were the goods of the Opponent and that such misrepresentation would have caused damage to the Opponent.

75. In the absence, as I have found, of any likelihood of confusion or association between the respective marks, I cannot see how there could be any misrepresentation as to the provenance of the Applicant's goods by virtue of the use of the said trade mark. I have also found the Applicant has due cause to use the mark. It is also clear from the construct of the mark that anyone viewing the mark on goods would immediately understand the goods to originate from someone with a connection to the name Lynch. There is simply nothing in the mark that suggested it could constitute a misrepresentation, intentional or otherwise, of the Opponent's mark or its goods. Neither is it conceivable that the Opponent could suffer loss or damage if the Applicant's mark was used in a normal and fair manner as a trade mark for the goods for which registration is sought.

76. The basic ingredients of an action for passing off have not been established and I do not believe, therefore, that the use by the Applicant of the mark propounded for registration would have been liable to be prevented by the law of passing off and, accordingly, I dismiss the opposition under Section 10(4) of the Act.

77. For these reasons, I have decided that the prior registration and use of the trade mark TULLAMORE DEW does not constitute grounds for refusal, under Section 10(2)(3), Section 10(3) or Section 10(4)(a) of the Act, of the application to register LYNCH'S TULLAMORE BREW. Therefore, I have decided to dismiss the opposition and to allow the disputed mark to proceed to registration.

Dermot Doyle

Acting for the Controller

19 August, 2015

¹²In *Reckitt & Colman Products Ltd. v Borden Inc. & Ors.* [1990] RPC 406